LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 208
Date of Decision: 2012-11-15

IN THE MATTER OF A SECTION 45 PROCEEDING requested by David John Critchley against registration No. 596,209 for the trade-mark KICK ASS KOOLER in the name of Leo Johnson

[1] At the request of David John Critchley (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on October 25, 2010 to Leo Johnson (the Registrant), the registered owner at the time of registration No. TMA596,209 for the trade-mark KICK ASS KOOLER (the Mark).

[2] The Mark is registered for use in association with the wares "coffee beverage non-alcoholic".

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares or services specified in the registration at any time within the three year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between October 25, 2007 and October 25, 2010 (the Relevant Period).

[4] The relevant definition of "use" is set out in section 4(1) of the Act:

> 4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is

in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing "deadwood" from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar's notice, the Registrant filed his own affidavit, sworn on December 17, 2010. Both parties filed written representations; only the Requesting Party attended an oral hearing.

[7] In his affidavit, the Registrant states that he is the owner of the subject registration and that Kicking Horse Coffee Ltd. (Kicking Horse) is the exclusive licensee of the Mark in Canada pursuant to a formal license agreement. He attests that during all material times, he had direct or indirect control of the character and quality of the wares sold in association with the Mark. As such, I am satisfied that any demonstrated use enures to the benefit of the Registrant pursuant to section 50 of the Act.

[8] The Registrant asserts that Kicking Horse used the Mark in Canada in association with non-alcoholic coffee beverages during the Relevant Period. Although I note that the affidavit lacks specificity, it would appear that the wares were sold in at least one Canadian café during the Relevant Period by Kicking Horse. In support of the Registrant's assertion of use, attached as Exhibit A is a photograph of a coffee beverage in a plastic cup. I note that the Mark appears as registered on the side of the cup, underneath a "Kicking Horse Coffee" logo. Furthermore, attached as Exhibit B is a photograph of a menu board which the Registrant describes as "at a Canadian café at which the product is sold", displaying "Kick Ass Kooler $3.75", amongst other menu items.

[9] As proof of sales, attached as Exhibit C to his affidavit is a sales summary table for 2010, showing sales of cold beverages by Kicking Horse. The first line shows an item description for "KICKASS KOOLER", with a quantity of 1060 and dollar amount of $3975. Given the nature of the beverages and the large totals, notwithstanding that the table is dated December 9, 2010, I

accept that the table reflects at least some sales of the wares by Kicking Horse during the Relevant Period.

[10] As noted by the Requesting Party, the Registrant has provided little explicit detail regarding the normal course of trade. However, in the context of a section 45 proceeding, the evidence as a whole must be considered and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)]. In addition, the burden on the owner in a section 45 proceeding is not onerous and a mark will be maintained so long as there is some use within the three year period preceding the section 45 notice [*Brouillette Kosie Prince v Great Harvest Franchising Inc* (2009), 77 CPR (4th) 247 (FC)].

[11] Accordingly, I accept that, in view of the evidence as a whole, the three exhibits suffice in combination to reach a conclusion that the Registrant, through its licensee, used the Mark in association with "coffee beverage non-alcoholic" during the Relevant Period within the meaning of sections 4 and 45 of the Act.

Disposition

[12] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be maintained.

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Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office