



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 196
Date of Decision: 2011-10-21

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Shapiro Cohen against registration
No. TMA318,758 for the trade-mark MONTE CARLO in
the name of Gottfried Paul Hildebrandt**

[1] At the request of Shapiro Cohen (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on January 26, 2006, to Gottfried Paul Hildebrandt, the registered owner (the Registrant) of registration No. TMA318,758 for the trade-mark MONTE CARLO (the Mark).

[2] The Mark is registered in association with the following wares:

Cigarettes, cigars and tobacco.

[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 and/or services listed on 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 use since that date. In this case, the relevant period for showing use is any time between January 26, 2003 and January 26, 2006.

[4] “Use” in association with wares is set out in subsections 4(1) and 4(3) of the Act as follows:

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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, s. 4(1) applies.

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary, and expeditious procedure for removing deadwood from the register. While mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding (*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 C.P.R. (2d) 194, aff’d (1980), 53 C.P.R. (2d) 63 (F.C.A.)), the threshold for establishing use in these proceedings is quite low (*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)), and evidentiary overkill is not required (*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)). However, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares or services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant, Gottfried Paul Hildebrandt furnished his own affidavit, sworn April 7, 2006, together with Exhibits A to D. Neither party filed written submissions, however, the requesting party made submissions at an oral hearing.

[7] In his affidavit, Mr. Hildebrandt indicates that he does business under the name G. Hildebrand Co. He states that he has “sold in the normal course of trade in Canada MONTE CARLO cigars during the past three years.” In support of his statement, the relevant exhibits provided, include Exhibits B, C, and D.

[8] Exhibit B includes two invoices evidencing sales to two different customers in Canada, during the relevant period. The invoices were issued by G. Hildebrand Co., and include sales of cigars described in the body of the invoices as “Rothschild Monte Carlo Maduro” and “Rothschild Monte Carlo EMS”.

[9] Exhibits C and D consist of photographs of cigar boxes. The tops of the cigar boxes in these exhibits display the word “Rothschild” as the dominant feature, in large, fanciful script, with a smaller design feature appearing above, and the words “seleccion suprema” appearing in smaller script below. In Exhibit C, the side view of the box displays the words “Rothschild Monte Carlo”; each of these words being of the same size and style of font, etc. Mr. Hildebrandt explains that MONTE CARLO cigars have been sold in boxes such as those shown in Exhibit C, during the relevant period. I understand this statement to mean that this box is representative of the manner in which the cigars were packaged with the Mark affixed thereto, during the relevant period. In Exhibit D, which Mr. Hildebrand explains are photos of a variety of “cigar boxes of other brands I sold”, I note that the sides of the boxes follow a similar pattern of labelling as in Exhibit C, except that they display the following: “25 Rothschild Monte Carlo”, “25 Rothschild No. 1”, and “25 Rothschild Robusto”.

[10] At the oral hearing, the Requesting Party made three main submissions regarding the Registrant’s evidence. To begin with, the Requesting Party submitted that Mr. Hildebrandt’s affidavit only discusses use with “*cigars*” and that there is no use of the Mark in association with cigarettes and tobacco. Consequently, it is the Requesting Party’s position that “*cigarettes and tobacco*” should be struck from the registration. I agree. There is no evidence of use of the Mark in association with the wares identified as “*cigarettes and tobacco*”, nor is there evidence of special circumstances that would excuse the absence of such use. Furthermore, as these wares are separately identified in the registration and it would not have required evidentiary overkill to have furnished evidence of such use, these wares will be deleted from the registration [see *John Labatt Ltd. v. Rainier Brewing Co.* (1984), 80 C.P.R. (2d) 228 (F.C.A.); *Union Electric Supply Co. v. Canada (Registrar of Trade Marks)*, *supra*].

[12] With respect to the remaining ware, namely, “*cigars*”, the Requesting Party submits that the evidence does not show use of the registered mark. In particular, it submits that the invoices

in Exhibit B show the mark in combination with other matter, wherein the Mark is not distinguished from such matter. Further to this, it submits that if it is considered that the invoices display the proper mark, the invoices do not constitute “use” of the Mark, as there is neither evidence nor a statement from the affiant that the invoices accompanied the wares. Lastly, with respect to the photographs in Exhibits C and D, the Requesting Party argues that the public would perceive that the trade-mark being used is “Rothschild Monte Carlo”, not “Monte Carlo”, as “Monte Carlo” does not stand out as a separate mark.

[13] It is true that there is no evidence that the invoices accompanied the wares at their time of transfer. While they do not provide the requisite notice of association of the Mark with the wares, I accept the invoices as documentary support of the affiant’s statement that sales in the normal course of trade of the “*cigars*” took place, during the relevant period, in Canada.

[14] As for the display of the Mark on the boxes, the word Rothschild is in dominant script on the top of the cigar boxes. This, in my view, would lead the purchasing public to view the word “Rothschild” as designating a line of cigars, which are then further designated as “Monte Carlo”, “No. 1”, and “Robusto” cigars. Thus, “Monte Carlo” functions as a separate, secondary trade-mark, and would be perceived as such [see for example *Mantha & Associates v. Old Time Stove Co. Inc.* (1990) 30 C.P.R. (3d) 574 (T.M.O.B.); *Comstock Ltd. v. Commodity Quotations Inc.* (1997) 83 C.P.R. (3d) 240 (T.M.O.B.); *A.W. Allen Ltd. v. Warner-Lambert Canada Inc.* (1985), 6 C.P.R. (3d) 270 (F.C.T.D.)].

[15] The last submission of the Requesting Party pertains to ownership of the Mark. In this vein, it argues that the evidence shows that the Registrant is not a manufacturer, but is an importer of the goods, importing someone else’s product bearing someone else’s trade-mark. Section 45 proceedings however, are limited in scope; the determination to be made is whether or not the Registrant is using the registered trade-mark within the meaning of sections 4 and 45 of the Act. Issues such as ownership, distinctiveness, etc., are not to be dealt with in this forum [see *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289 at 293 (F.C.T.D.)]. In the present circumstance, the Registrant has shown use of the Mark in association with “*cigars*” in the manner prescribed by sections 4 and 45 of the Act; that is all that is required.

[16] In view of the above, I conclude that use has been shown of the Mark for the wares described as “*cigars*”; use has not been shown for the remaining wares in the registration and there is no evidence of any special circumstances excusing the absence of use. Consequently, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete the wares: “*cigarettes and tobacco*”, in compliance with the provisions of s. 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

