



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

**Citation: 2017 TMOB 31**  
**Date of Decision: 2017-03-17**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Dallevigne S.P.A.**

**Requesting Party**

**and**

**Maison des Futailles SEC**

**Registered Owner**

**TMA762,137 for MONALISA**

**Registration**

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA762,137 for the trade-mark MONALISA (the Mark), owned by Maison des Futailles SEC.

[2] The Mark is registered for use in association with the goods “liqueurs”.

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

The Proceeding

[4] On October 31, 2014, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Centre de recherche et de développement Melville Inc. / Melville Research and Development Centre Inc. (Melville), then registered as owner of the Mark. The notice was sent at the request of Dallevigne S.P.A. (the Requesting Party).

[5] I note that the registration page shows that Maison des Futailles SEC became the owner of registration No. TMA762,137 by assignment from Melville on June 28, 2016, which assignment was recorded on January 11, 2017. Since the change of owner stems from an assignment that occurred after the date of the section 45 notice, the change of owner has no consequence in this case.

[6] The section 45 notice required Melville to furnish evidence showing that it had used the Mark in Canada, at any time between October 31, 2011 and October 31, 2014 (the Relevant Period), in association with the registered goods. If the Mark had not been so used, Melville was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[7] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[8] 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. The criteria for establishing use are not demanding and an overabundance of evidence is unnecessary. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the goods or services specified in the registration at any time during the relevant period [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use of the trade-mark [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 53 CPR (2d) 62 (FCA)].

[9] In response to the Registrar’s notice, Melville filed the affidavit of Sylvain Fontaine, sworn on May 28, 2015. This affidavit pertains to the present proceeding and two concurrent section 45 proceedings with respect to registration Nos. TMA252,123 and TMA387,264 for the trade-marks MONALISA & Design. A separate decision will issue for those two registrations.

[10] Both parties filed written representations; a hearing was not held.

### Melville's Evidence

[11] I note that my use of "the MONALISA Marks" in my review of the evidence reflects Mr. Fontaine's collective reference to the Mark and the trade-marks MONALISA & Design (TMA252,123 and TMA387,264) in his affidavit.

[12] Mr. Fontaine identifies himself as the President of Melville and the Senior Vice-President, Sales and Marketing of Maison des Futailles s.e.c. (MdF). He states that Melville is a subsidiary of MdF.

[13] Mr. Fontaine explains that Melville granted MdF two consecutive licences to use the MONALISA Marks. I note that the second licence referenced by Mr. Fontaine covers the Relevant Period.

[14] Mr. Fontaine states that MdF is a producer, bottler and distributor of alcoholic beverages, including almond liqueurs (amaretto) and coffee liqueurs. He explains that, in Québec, MdF sells its liqueurs to the Société des alcools du Québec (SAQ), which in turn sells the liqueurs to restaurants and bars, as well as through its own retail branches. He states that, in other provinces, MdF sells its liqueurs to analogous bodies, for example, the Alberta Gaming & Liquor Commission (AGLC) which distributes the liqueurs to various alcoholic beverage retailers in Alberta.

[15] Mr. Fontaine states that MdF sold almond liqueurs and coffee liqueurs in Canada during the Relevant Period in bottles with labels bearing the MONALISA Marks as shown in the following images contained in the affidavit (the MONALISA Label Designs):



[16] Mr. Fontaine attests that such liqueurs met certain quality standards, which are stipulated in the licence MdF received from Melville. Mr. Fontaine further states that he himself, as President of Melville, as well as Senior Vice-President, Sales and Marketing of MdF, is the one who ultimately approves the quality of the MONALISA liqueurs.

[17] In support, Mr. Fontaine attaches the following exhibits to his affidavit:

- Exhibit SF-1 is a printout of Melville's corporate particulars from the Registraire des entreprises du Québec, as of May 25, 2015. I note that Mr. Fontaine is listed as Melville's President.
- Exhibit SF-2 is a copy of the second licence agreement between Melville and MdF. I note that section 5.1 of the licence agreement requires MdF to maintain goods sold in association with the Mark at a level of quality consistent with the Mark's existing reputation and prestige. In addition, section 5.2 of the agreement allows Melville to verify that this quality standard is being maintained, by checking goods branded with the Mark and by inspecting the premises used by MdF in connection with such goods. Section 5.2 also allows Melville to communicate with retailers of the goods to ensure that the stipulated quality standard is being respected. I note as well section 10.2 of the agreement which provides for termination of the licence by either party if the other side fails to meet its material obligations under the agreement.

- Exhibit SF-3 is a printout from the SAQ website, advertising a bottle of “Monalisa Amaretto” almond liqueur. I note that an image of the liqueur bottle is shown on the exhibited webpage. The design on the depicted bottle appears to be the MONALISA Label Design for amaretto, although the text on the label is illegible. The printout is dated after the Relevant Period, but Mr. Fontaine attests that the depicted product was advertised the same way during the Relevant Period.
- Exhibit SF-4 consists of six invoices from MdF showing sales of various products, including “Amaretto Monalisa 1.14 L” and “Monalisa Liqueur de café 750ml”, to the SAQ and AGCL. Mr. Fontaine attests that the invoiced liqueurs were sold in bottles bearing the MONALISA Label Designs. Five of the invoices are dated within the Relevant Period; the remaining invoice is dated several days before the beginning of the period, but Mr. Fontaine attests that the invoiced products were sold by the SAQ during the Relevant Period.
- Exhibit SF-5 consists of artwork for two advertisements. Mr. Fontaine attests that such advertisements were posted in certain Québec pool halls in January 2014 and May 2014, to promote beverages made with MONALISA almond liqueur. The design on one of the bottles depicted in each advertisement appears to be the amaretto version of the MONALISA Label Designs.
- Exhibit SF-6 consists of artwork for a discount coupon. Mr. Fontaine attests that such coupons were hung on bottles of MONALISA almond liqueur offered on SAQ’s retail shelves from March 30, 2014 to June 21, 2014. A bottle of almond liqueur bearing the amaretto version of the MONALISA Label Designs is depicted on the coupon.

### Analysis

[18] In its representations, the Requesting Party does not contest that the evidence demonstrates sales of the registered goods in Canada in the normal course of trade in bottles displaying the word MONALISA during the Relevant Period. Indeed, the evidenced invoices show sales of “Monalisa” liqueurs by MdF to provincial liquor control boards during the

Relevant Period and Mr. Fontaine attests that such liqueurs were sold in bottles displaying the MONALISA Label Designs.

[19] However, the Requesting Party contends that such sales do not constitute use of the Mark by Melville. The Requesting Party's submissions in this respect are two-fold: first, that any use of the Mark by MdF does not accrue to Melville's benefit and, second, that the trade-mark displayed on MdF's liqueur bottles is not the Mark as registered.

*Use by the Registered Owner*

[20] Pursuant to section 50(1) of the Act, for MdF's use of the Mark to be deemed use by Melville, Melville must maintain "direct or indirect control of the character or quality of the goods" sold in association with the Mark.

[21] As stated by the Federal Court, there are three main methods by which a trade-mark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of a licence agreement that provides for the requisite control [per *Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248].

[22] In the present case, the Requesting Party argues that the licence agreement provided by Mr. Fontaine at Exhibit SF-2 is insufficient to demonstrate the requisite control, because the agreement (i) does not define the quality standard that MdF is required to meet, (ii) does not indicate that Melville sets the quality standard, (iii) does not give Melville any power if the standard is not met, and (iv) does not explicitly employ the word "control" or a close synonym.

[23] Notwithstanding the Requesting Party's submissions, I am satisfied that the exhibited licence agreement meets the requirements of section 50(1) of the Act for the purposes of this proceeding. Specifically, I am satisfied that the exhibited licence agreement sufficiently provides for Melville's control of the quality of the goods sold in association with the Mark. Indeed, as I previously indicated, the agreement requires MdF to maintain the quality of the goods at a level consistent with the Mark's existing reputation and prestige and grants Melville various inspection rights to ensure that this level of quality is maintained. Furthermore, the agreement

empowers Melville to terminate Mdf's licence should Mdf not meet its obligations under the agreement.

[24] In view of the foregoing, I am satisfied that any demonstrated use of the Mark by Mdf constitutes use of the Mark enuring to the benefit of Melville.

*Use of the Mark as Registered*

[25] The remaining issue is whether the Mark was displayed on, or otherwise associated with, the registered goods at the time of transfer. In this respect, the Requesting Party submits that Melville did not use the Mark as registered on the liqueur bottles sold in Canada during the Relevant Period. Rather, the Requesting Party argues that the word MONALISA was used as part of a new, composite trade-mark. The Requesting Party submits that there is nothing, such as a "TM" or "®" symbol, to indicate that the MONALISA element is independent of the other elements in the "composite mark".

[26] Generally, use of a word mark in combination with additional words or design features qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. The presence or absence of a trade-mark symbol is not necessarily determinative of this issue. Rather, the issue is a question of fact, dependent upon such factors as whether the word mark stands out from the additional material, for example, by the use of different lettering or sizing, or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name [*Nightingale, supra*; see also *Loro Piana SPA v Canadian Council of Professional Engineers (CCPE)*, 2009 FC 1096, 2009 CarswellNat 3400]. Moreover, a registration for a word mark can be supported by use of that mark in any stylized form and in any colour [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)].

[27] Applying these principles to the present case, I am satisfied that the Mark maintains its identity as a distinct trade-mark within the MONALISA Label Designs. Not only are the other words on the labels descriptive, but the Mark stands out from them by virtue of its font, size and

positioning. The size and positioning of the Mark are also such that it stands apart from the labels' design elements.

[28] Additionally, I note that the Mark appears within the product listings of the invoices at Exhibit SF-4. Mr. Fontaine does not specify whether such invoices accompanied the goods at the time of transfer. Regardless, an invoice can provide context informing the Registrar as to what consumers would recognize to be the trade-mark. In the present case, the appearance of MONALISA on its own beside the generic product descriptions in the exhibited invoices supports the conclusion that consumers would, as a matter of first impression, perceive MONALISA as a trade-mark in itself.

[29] Accordingly, I am satisfied that the evidenced use of the MONALISA Label Designs on liqueur bottles sold in Canada during the relevant period constitutes use of the Mark *per se*.

#### Disposition

[30] In view of all of the foregoing, I am satisfied that Melville has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4(1) and 45 of the Act.

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

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Céline Tremblay  
Acting Chair  
Trade-marks Opposition Board  
Canadian Intellectual Property Office



**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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HEARING DATE: No Hearing Held

AGENTS OF RECORD

BCF s.e.n.c.r.l. / BCF LLP

For the Registered Owner

MacRae & Co.

For the Requesting Party