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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2018 TMOB 99

Date of Decision: 2018-09-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Weaver, Simmons LLP

Requesting Party

and

Lion-Beer Spirits and Wine (NZ)

Registered Owner

Limited

TMA686,212 for BLACK ROCK

Registration

[1] At the request of Weaver, Simmons LLP (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 August 12, 2016 to Lion-Beer Spirits and Wine (NZ) Limited (the Owner), the registered owner of registration No. TMA686,212 for the trade-mark BLACK ROCK (the Mark).

[2] The Mark is registered for use in association with the following goods:

Preparations for making beverages namely hop essences and extracts, maltwort; non-alcoholic beverages namely mineral and aerated waters, fruit drinks, fruit juices, syrups for making beverages; brew kits and ingredients therefor namely malted barley, barley, water, and one or more of hops, hop extracts, and caramel.

[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 goods 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 August 12, 2013 and August 12, 2016.

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

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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], 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 goods specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Richard Robb, corporate representative of the Owner, sworn on November 3, 2016.

[7] Neither party filed written representations; an oral hearing was not requested.

OVERVIEW OF THE EVIDENCE

[8] In his affidavit, Mr. Robb states that the Owner is engaged in the production, sale and distribution of “preparations for making beverages namely hop essences and extracts, maltwort; brew kits and ingredients therefor namely malted barley, barley, water, and one or more of hops, hop extracts, and caramel; syrups for making beverages” (the Products). He specifies that the “syrups for making beverages” relate to ciders. I note that the Products correspond to the registered goods other than the omitted “non-alcoholic beverages namely mineral and aerated waters, fruit drinks, fruit juices”.

[9] Mr. Robb attests that the Products have been distributed in Canada in association with the Mark since 2002, including throughout the relevant period.

[10] In particular, attached as Exhibit A to his affidavit is a printout of unit sales data, representing sales of the Products by the Owner to a Canadian distributor for the years 2013 to 2017.

[11] Exhibit B is a copy of a pamphlet listing some of the Products and describing the Owner's process for creating such Products. Mr. Robb attests that the pamphlet is distributed to the Owner's Canadian distributors and subsequently distributed to consumers at the time of purchase. Mr. Robb attests that "thousands of copies" of the pamphlet were so distributed during the relevant period. The Mark appears throughout the pamphlet, including on images of the Products.

[12] Exhibits C through G are website printouts from various Canadian retailers advertising and selling BLACK ROCK Products. Mr. Robb correlates images on the printouts with each of the Products. For example, Exhibit G is a printout from *www.mywinesense.com*, which Mr. Robb identifies as a Manitoba-based retailer. The page advertises various BLACK ROCK Products, which Mr. Robb correlates to "preparations for making beverages namely hop essences and extracts, maltwort; brew kits and ingredients therefor namely malted barley, barley, water, and one or more of hops, hop extracts, and caramel". Mr. Robb confirms that the images of the Products are accurate representations of the Products sold to Canadian customers. I note that the Mark is prominently displayed on each Product.

[13] With respect to sales and distribution, attached as Exhibits J to N to Mr. Robb's affidavit are printouts in respect of particular shipments to Canadian distributors during the relevant period. For example, Exhibit L includes a printout of a Sea-Waybill document regarding a shipment from the Owner to a distributor based in Port Coquitlam, British Columbia, on June 30, 2016. The shipment is identified on the document as "216 cases brewing ingredients packed on 20 pallets".

[14] Mr. Robb confirms that such Products shipped to distributors in Canada are subsequently distributed to retailers across Canada, including the retailers identified in Exhibits C through G.

Mr. Robb attests that “the Products are quickly sold to end-use consumers by a variety of retailers”.

[15] Mr. Robb also attaches to his affidavit a blank order form for the Products from an Ontario-based retailer (Exhibit H) and printouts from a product review website (Exhibit I).

ANALYSIS

[16] First, I note that Mr. Robb’s affidavit is silent with respect to the registered goods “non-alcoholic beverages namely mineral and aerated waters, fruit drinks, fruit juices”. As there is no evidence before me of use of the Mark in association with such goods, nor evidence of special circumstances excusing such non-use, the registration will be amended accordingly.

[17] Otherwise, the Owner has provided representative images to show that the Mark is displayed on the Products that it sold to Canadian distributors (Exhibits B and C through G). Furthermore, the Owner has provided representative evidence of such sales of the Products to Canadian distributors during the relevant period, in the form of sales summaries and shipment confirmations (Exhibits A and J through N).

[18] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the following registered goods only: “Preparations for making beverages namely hop essences and extracts, maltwort; ... syrups for making beverages; brew kits and ingredients therefor namely malted barley, barley, water, and one or more of hops, hop extracts, and caramel.”

DISPOSITION

[19] Accordingly, 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 amended to delete the following from the statement of goods: “...non-alcoholic beverages namely mineral and aerated waters, fruit drinks, fruit juices”.

[20] The amended statement of goods will be as follows:

Preparations for making beverages namely hop essences and extracts, maltwort; syrups for making beverages; brew kits and ingredients therefor namely malted barley, barley, water, and one or more of hops, hop extracts, and caramel.

Andrew Bene
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

Neil F. Kathol (Field LLP)

For the Registered Owner

Jordan E. Duplessis

For the Requesting Party