



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

Citation: 2018 TMOB 137

Date of Decision: 2018-11-14

IN THE MATTER OF A SECTION 45 PROCEEDING

McMillan LLP

Requesting Party

and

Promotion In Motion Inc.

Registered Owner

**TMA515,061 for
TUXEDOS BLACK TIE**

Registration

INTRODUCTION

[1] At the request of McMillan LLP, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on December 6, 2016 to Promotion In Motion Inc. (the Owner), the registered owner of registration No. TMA515,061 for the trade-mark TUXEDOS BLACK TIE (the Mark).

[2] The Mark is registered for use in association with “Candy”.

[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 December 6, 2013 to December 6, 2016.

[4] The relevant definition of use for goods is set out in section 4 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.

[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 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar’s notice, the Owner furnished the declaration of Michael G. Rosenberg, President of the Owner, sworn on June 29, 2017 in Allendale, New Jersey. Neither party filed written representations; a hearing was not requested.

THE OWNER’S EVIDENCE

[7] In his affidavit, Mr. Rosenberg attests that the Owner is in the business of manufacturing and selling candy, chocolate and fruit snacks. He asserts use of the Mark in Canada during the relevant period in association with the registered goods, “candy”.

[8] In particular, Mr. Rosenberg attaches to his declaration, as Exhibit A, 20 invoices or shipping confirmations showing shipments of “sampler packs” of goods to Canada from May 5, 2015 to April 7, 2017. Mr. Rosenberg confirms that such shipments included sampler packs of the Owner’s TUXEDOS BLACK TIE candy. I note that some of the invoices describe the goods as “FREE CANDY SAMPLES NO RETAIL VALUE NOT FOR RESALE”. However, Mr. Rosenberg explains that the “distribution of these samples packs was sent as a regular step in the normal course of trade in the business of selling candy, chocolate, and fruit snacks”.

[9] Mr. Rosenberg also provides, as Exhibit B to his declaration, “an invoice of an actual sale and shipment of the goods TUXEDOS BLACK TIE candy to Canada on May 12, 2017”. The invoice shows a sale of 100 “3.5 oz TUXEDOS Chocolate Almonds Concession Box 48ct” to a Canadian customer, amounting to a total of \$4571.98. I note that the customer is one of the customers to which the Owner shipped several sampler packs, as shown in the shipments referenced in Exhibit A.

[10] Attached as Exhibit C is a photograph showing a bag and box of TUXEDO BLACK TIE BRAND milk chocolate almonds. An acceptable variation of the Mark is prominently displayed on both the bag and the box. Mr. Rosenberg confirms that the goods shown are representative of the goods shipped as part of the sampler pack shipments evidenced at Exhibit A and of the goods sold as evidenced at Exhibit B.

ANALYSIS

[11] The Federal Court has held that, generally, the free delivery of samples does not constitute transfers in the normal course of trade, except in particular circumstances [see *JC Penney Co v Gaberdine Clothing Co*, 2001 FCT 1333, 16 CPR (4th) 151]. For example, in *ConAgra Foods, Inc v Fetherstonhaugh & Co*, 2002 FCT 1257, 23 CPR (4th) 49, the Court accepted the free distribution of samples as a regular step in the normal course of trade in the industry where the owner of the trade-mark was seeking to develop a market. The Court's conclusion was supported by the fact that actual sales closely followed the relevant period in that case.

[12] In this case, the Owner has evidenced the free distribution of samples of its TUXEDOS BLACK TIE candy in Canada during the relevant period and asserted that such distribution was in its normal course of trade. This assertion is supported by evidence of a subsequent "actual" sale in Canada to one of the customers to which sampler packs had been shipped.

[13] Although the evidence of subsequent sales in Canada is not overwhelming, in my view, it is sufficient for purposes of this proceeding. Indeed, evidence of a single sale in the normal course of trade may suffice to show use of a trade-mark in association with goods. In *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD), the Federal Court stated that "[e]vidence of a single sale, whether wholesale or retail, in the normal course of trade may well suffice so long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration of the trade mark" [at 293].

[14] In this case, although the May 12, 2017 sale occurred after the relevant period, it supports the conclusion that the transfers of sampler packs of the registered goods to Canadian customers during the relevant period were in the normal course of the Owner's trade.

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

DISPOSITION

[16] 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 maintained.

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

Ridout & Maybee LLP

For the Registered Owner

McMillan LLP

For the Requesting Party