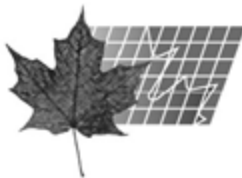


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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2019 TMOB 7**

**Date of Decision: 2019-01-29**

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

**Bacardi & Company Limited**

**Requesting Party**

**and**

**La Fée LLP**

**Registered Owner**

**TMA834,461 for NV**

**Registration**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA834,461 for the trade-mark NV (the Mark), owned by La Fée LLP.

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

- (1) Alcoholic drinks, namely, alcoholic drinks containing absinthe or anise; liqueurs; absinthe; cutlery and spoons; table mats and place mats; beverage dispensing machines; beverage glassware; tableware; printed material, namely books, booklets, magazines, newsletters, newspapers, pamphlets and periodicals.
- (2) Alcoholic drinks, namely, alcoholic drinks containing absinthe or anise; anis-based spirits; liqueurs; anis-based liqueurs; absinthe.

[3] For the reasons that follow, I conclude that the registration ought to be maintained with respect to “absinthe”, but amended to delete the remaining goods.

## THE PROCEEDING

[4] On August 24, 2016, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to La Fée LLP (the Owner). The notice was sent at the request of Bacardi & Company Limited (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between August 24, 2013 and August 24, 2016, in association with each of the goods specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use 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.

[7] 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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered services [see *Uvex Toko, supra*; and *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of George William Rowley, sworn November 17, 2016, together with Exhibits A to N.

[9] While only the Requesting Party filed written representations, both parties attended an oral hearing in the matter.

## THE EVIDENCE

[10] In addition to being the Managing Partner of the Owner, Mr. Rowley attests that he is the Managing Director of Bohemia Beer House Limited, trading as BBH Spirits (BBH). BBH, he explains, is in the business of wholesale sales of alcohol and other beverages, and is also the worldwide brand manager of the Owner's "absinthe, gin, vodka, rum and whisky, and the Owner's Mark".

[11] Mr. Rowley attests that BBH has a written license from the Owner to use the Mark in Canada in association with the registered goods, in which the "Owner has direct control of the character and quality of the NV Goods to which BBH applied the Trade-mark" imported into and sold in Canada. He explains that as per terms of the licence agreement with the Owner, BBH has engaged a French manufacturer, Compagnie d'Armagnac Ducastaing (Ducastaing), to manufacture, label, release and ship the Owner's NV branded absinthe, directly to customers in Canada and other countries. He states that BBH maintains control of the application of pre-printed labels bearing the Mark, on the bottles containing the Owner's absinthe.

[12] Mr. Rowley states that the Owner, through its licensees, has imported and sold the registered goods in Canada in the normal course of its business, during the relevant period, with the Mark applied to the registered goods and to the packaging therefor. In particular, he states that one of the registered goods that BBH imports and sells in Canada in the category of "*Alcoholic drinks, namely, alcoholic drinks containing absinthe or anise; anis-based spirits; liqueurs; anis-based liqueurs; absinthe*" is the Owner's absinthe, marketed and branded under the Mark.

[13] Mr. Rowley attests that during the relevant period, the Owner's absinthe was sold in Canada in bottles bearing the Mark, and was shipped to customers in Canada in cartons bearing the Mark. Further to this, he explains that BBH receives a purchase order for the Owner's absinthe from various customers in Canada, such as liquor boards; BBH then contacts Ducastaing to supply the Owner's absinthe directly to the customer, Ducastaing invoices BBH, and BBH then invoices the customer.

[14] In support of the aforementioned, Mr. Rowley provides the following:

**Exhibits B and G** – copies of representative purchase order received from two provincial liquor control boards, both dated within the relevant period, for a total of 30 cases of the Owner’s absinthe.

**Exhibits C and H** – copies of representative labelling instructions BBH provided to Ducastaing for fulfilling the Exhibits B and G purchase orders. The instructions both include a representation of the bottle with a label clearly bearing the Mark, which Mr. Rowley states is representative of the goods sold in Canada during the relevant period.

**Exhibits D and E** – photographs of a representative bottle of the Owner’s absinthe and its shipping carton, both of which clearly bear the Mark, which he states was sold in Canada during the relevant period.

**Exhibits F and I** – copies of French export documents filed by Ducastaing with French customs, both dated during the relevant period and which correspond respectively with the Exhibits B and G purchase orders.

**Exhibits J and K** – copies of representative invoices Ducastaing sent to BBH for the purchase orders made by the respective provincial liquor control boards shown in Exhibits B and G.

**Exhibits L and M** – copies of representative invoices BBH sent to the provincial liquor control boards respectively for the purchases evidenced throughout Exhibits B and G.

**Exhibit N** – a copy of a representative invoice by which BBH invoiced ICON Fine Wine and Spirits located in Vancouver, BC, dated five months prior to the relevant period, for the sale of 84 bottles of the Owner’s absinthe.

#### **ANALYSIS AND REASONS FOR DECISION**

[15] The Requesting Party submits that the Owner has failed to show even a single use of the Mark itself, or establish that either BBH or Ducastaing are properly considered licensees within the meaning of the Act. The Requesting Party submits that although Mr. Rowley has included instructions for labelling absinthe bottles with the Mark, he has provided no evidence that these instructions originated from or were agreed upon by the Owner; to the contrary, at paragraph 19 of his affidavit, Mr. Rowley states that BBH provided Ducastaing with the instructions attached to the affidavit as Exhibit C. Thus, the Requesting Party submits, it appears that it is BBH and not the Owner that is exercising control over the character or quality of the Owner’s goods.

[16] The Requesting Party submits that while it is not necessary to produce a written license agreement and a license need not be in writing, the Owner has failed to explain the relationship between the Owner and BBH, other than Mr. Rowley’s positions within these companies [citing

3082833 *Nova Scotia Co v Lang Michener LLP*, 2009 FC 928, [2009] FCJ No 1142 at para 32].

The Requesting Party submits that it takes more than just a statement that there is a license agreement to satisfy section 50 of the Act; evidence of control, which would have easily been within the Owner's ability to demonstrate, has to be adduced.

[17] In any event, the Requesting Party submits that the only good included in the list of goods referenced in any of the evidence provided by the Owner is absinthe.

[18] Lastly, the Requesting Party submits that the affidavit contains no statement describing the nature of the Owner's business, its customers or its channels of trade. Instead, the affidavit describes the customers and channels of trade of BBH. The Owner therefore offers no description of the normal course of trade for its products. Without this information, it is impossible to determine if the alleged sales, as detailed in the invoices attached as exhibits to the affidavit, occurred in the normal course of trade.

[19] With respect to licensing, the Owner submits that Mr. Rowley is the controlling mind of both the Owner and BBH, and he has stated several times under oath that the requisite control exists. In addition, the Owner submits that the evidence, which references both entities, shows that they share common premises, and that BBH is the worldwide brand manager of the Owner's absinthe and not the owner of the Mark; thus, the relationship between the two entities is clear. The Owner submits that the evidence need not be perfect [citing *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428] and, as such, following the decision in *Nova Scotia, supra*, the evidence in the present case is sufficient. I agree.

[20] Indeed, as stated by the Federal Court, there are three main methods by which a trademark 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 the license agreement that provides the requisite control [per *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248 at paragraph 84]. Applied to the present case, not only has Mr. Rowley provided a sworn statement attesting to the Owner's control over BBH [see *Rubicon Corp v Comalog Inc* (1990), 33 CPR (3d) 58 (TMOB) re: sworn statements], the evidence as a whole offers further support to infer that such control exists [see for example

*Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FC) re: common controlling minds]. Furthermore, Mr. Rowley has clearly attested that as per terms of the license agreement with the Owner, BBH has contracted the manufacture of the goods and maintains control over the labelling of the Mark on the Owner's absinthe by the manufacturer, Ducastaing.

[21] With respect to the Requesting Party's submissions that the evidence only relates to "absinthe", the Owner submits that there are different ways of saying the same thing. That is, if one looked at definitions of the goods in this case, one would find that they fall within the meaning of absinthe, whereas in *Labatt, supra*, the goods were distinct goods.

[22] However, I agree with the Requesting Party that just as the Court maintained only for "beer" even though beer is a "malt beverage" in *Labatt, supra*, the goods in the present case must also be considered separately. Indeed, the consideration of each registered good as distinct is highlighted in the evidence, as the Exhibit E label for the Owner's absinthe includes text suggesting that the absinthe can be mixed with "lemonade, gingerale, or your favorite energy drink". As per *Labatt, supra*, specification of goods other than absinthe suggests, in the absence of proof to the contrary, that each registered good is indeed different in some degree; otherwise, such specification would be superfluous.

[23] Lastly, with respect to the Requesting Party's submissions alleging a lack of evidence regarding the Owner's normal course of trade, I disagree. In this regard, I find that Mr. Rowley has provided clear sworn statements and supporting evidence regarding the chain of transactions of the Owner's absinthe, originating from the Owner to customers in Canada such as provincial liquor control boards [see *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD)].

[24] Having regard to the aforementioned, I am satisfied that the Owner has demonstrated use of the Mark in association with "absinthe" in the manner required by sections 4(1) and 45 of the Act. However, the Owner has failed to establish use with the remaining goods, and special circumstances have not been demonstrated that would excuse the absence of such use. Consequently, the remaining goods will be deleted from the registration.

DISPOSITION

[25] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the goods other than “absinthe” in compliance with the provisions of section 45 of the Act.

[26] As such, the amended statement of goods will now read as follows:

(1) Absinthe.

(2) Absinthe.

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Kathryn Barnett  
Hearing Officer  
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** 2018-09-25

**APPEARANCES**

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Gervas Wall

FOR THE REQUESTING PARTY

**AGENTS OF RECORD**

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Deeth Williams Wall LLP

FOR THE REQUESTING PARTY