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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 50**

**Date of Decision: 2021-03-15**

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

**St. Lawrence Law Firm LLP**

**Requesting Party**

**and**

**Great Lakes Brewing Company Inc.**

**Registered Owner**

**TMA626,733 for GOLDEN  
HORSESHOE PREMIUM LAGER**

**Registration**

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA626,733 for the trademark GOLDEN HORSESHOE PREMIUM LAGER (the Mark), owned by Great Lakes Brewing Company Inc. (the Owner).

[2] The Mark is registered in association with a single good, namely “alcoholic brewery beverages”.

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

## THE PROCEEDINGS

[4] At the request of St. Lawrence Law Firm LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on August 20, 2018, to the Owner.

[5] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the Goods 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 August 20, 2015 to August 20, 2018 (the Relevant Period).

[6] The relevant definition of use in the present case is set out in section 4(1) of the Act as follows:

4(1) A trademark 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] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[8] In response to the Registrar's notice, the Owner furnished an affidavit of Michael Lobraico sworn on January 6, 2019 (the Affidavit), to which were attached Exhibits A and B.

[9] Both parties submitted written representations.

[10] No oral hearing was held.

## THE EVIDENCE

[11] In the Affidavit, Michael Lobraico identifies himself as the General Manager of the Owner. As such, he has access to all the Owner's books and record and he is aware of its business activities.

[12] He explained that the goods, namely “alcoholic brewery beverages”, are produced, packaged and then sold in Canada to bars and restaurants in bulk format, in kegs. These beer kegs are not labelled with the Mark; however, the Mark appears on the invoices and these invoices are given to the customers with the delivery of the beer kegs. A few examples of invoices dated during the Relevant Period are included in the file as Exhibit A.

[13] Mr. Lobraico explained that the sales values of the goods, in association with the Mark, are highly confidential, but they were at least 3 725 000 \$ during the Relevant Period.

[14] The Mark also appears on coasters. These coasters are sold in the Owner's retail stores and are given to customers upon delivery of beer kegs, at least half the time. Exhibit B is a picture of a coaster.

#### ANALYSIS AND REASONS FOR DECISION

[15] 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 evidence in a section 45 proceeding need not be perfect; indeed, a registered owner needs only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[16] The Requesting Party raised four main arguments: that the affiant does not refer to the normal course of trade in the Affidavit, that the free distribution of coasters do not show the use of the Mark, that there is no evidence of the sales figures stated in the Affidavit and that the name of the Owner does not appear on the invoices and there is no mention in the Affidavit as to who is Great Lakes Brewery.

[17] Even though the affiant does not use the expression “normal course of trade” in the Affidavit, he states that “the goods, namely alcoholic brewery beverages are produced, packaged and sold in Canada. The goods in(sic) sold in bulk format in the nature of beer kegs to bars and restaurants in (the Customers)”. That described the Owner’s normal course of trade.

[18] The free distribution of coasters to some of the customers is not relevant. It has been held that the free distribution of a good merely to promote one's own brand does not constitute a transfer in the normal course of trade [see *Smart & Biggar v Sutter Hill Corp*, 2012 TMOB 121; and *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd* (2005), 50 CPR (4th) 391 (TMOB)]. Moreover, the Mark is registered for "alcoholic brewery beverages", not for coasters. So this Exhibit, by itself, does not demonstrate the use of the Mark.

[19] The Affiant states that the sales values of the goods in association with the Mark is at least 3 725 000 \$ during the Relevant Period. The threshold for establishing use in section 45 expungement proceedings is 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 Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. As such, evidence of a single sale can be sufficient to establish use for the purposes of these proceedings, as long as it follows the pattern of a genuine commercial transaction and is not seen as deliberately manufactured or contrived to protect the registration [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at para 12].

[20] The Owner has filed as Exhibit A three invoices illustrating the sale of the registered goods in Canada in association with the Mark during the Relevant Period. These invoices appears to follow the pattern of genuine commercial transactions, therefore, I conclude that the evidence filed is sufficient to demonstrate that the Owner used the Mark in association with the registered goods in the Relevant Period.

[21] The last argument of the Requesting party is the absence of the Owner's name on the invoices. The invoices seem to be from "Great Lakes Brewery". Evidence in a section 45 proceeding must be considered as a whole, and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)]. As well, reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)].

[22] The exhibits should be read in conjunction with the information provided in the affidavit. The affidavit is silent concerning who is "Great Lakes Brewery", but the Affiant states that the

Owner used the Mark and that this is shown in the invoices, filed as Exhibit A. Considering the evidence as a whole, I am satisfied that the Owner used the Mark in association with the registered goods.

[23] It is stated in the Affidavit that the Mark does not directly appear on the goods. It is well established that display of a trademark on an invoice that accompanies the goods at the time of transfer may satisfy the requirements of section 4(1) of the Act, if it provides the requisite notice of association between the Mark and the goods [see *Gordon A MacEachern Ltd v National Rubber Co Ltd* (1963), 1963 CanLII 566 (FC), 41 CPR 149 (Ex Ct); and *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 2000 CanLII 16133 (FC), 8 CPR (4th) 471 (FCTD)]. The major consideration is “whether the trade-mark is being used as a trade-mark in describing the wares” and “whether appropriate notice of such use is being given to the transferee of the wares” [see *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440 at paragraph 32].

[24] In the present case, the Mark appears in the body of the invoices, to identify specific invoiced goods. In these circumstances, I am satisfied that the listings “Golden Horseshoe Premium Lager” in the invoices distributed to the Canadian customers provided the customers with the requisite notice of association between the Mark and the goods. These invoices are given to the retailers at the time of delivery of the beer kegs, therefore at the time of the transfer of the possession of the goods.

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

#### DISPOSITION

[26] 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.

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Ann-Laure Brouillette  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Miltons IP/P.I.

For the Registered Owner

Cabinet juridique St. Lawrence s.e.n.c.r.l.

For the Requesting Party