

OPIC



CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 52

Date of Decision: 2021-03-24

IN THE MATTER OF A SECTION 45 PROCEEDING

Broue-Alliance Inc.

Requesting Party

and

Motovino Wines Inc.

Registered Owner

TMA853,768 for CONTRABAND

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. TMA853,768 for the trademark CONTRABAND (the Mark), currently owned by Motovino Wines Inc. (the Owner).

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

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

THE PROCEEDINGS

[4] At the request of Broue-Alliance Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 20, 2018, to the former owner, Alderlea Vineyards Ltd.

[5] The notice required the registered owner to show whether the trademark has been used in Canada in association with the registered 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 July 20, 2015, to July 20, 2018 (the Relevant Period).

[6] On March 23, 2021, the Registrar updated the registration to record an assignment of the Mark to Motovino Wines Inc., the current owner of the Mark, effective as of April 20, 2017.

[7] 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.

[8] 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.

[9] In response to the Registrar's notice, the Owner furnished an affidavit of Julie Powell declared on October 17, 2018 (the Affidavit).

[10] Neither party submitted written representations and no oral hearing was held.

THE EVIDENCE

[11] In the Affidavit, Julie Powell identifies herself as a Director of the Owner. She states that the Owner acquired the Mark from Alderlea Vineyards Inc. by assignment dated April 20, 2017,

and that the Owner is currently doing business as Alderlea Vineyards. The Affidavit can be summarized as follows:

- The affiant states that the Mark has been used during the Relevant Period by the Owner and by a licensee, The Masthead Restaurant (the Licensee), a restaurant located in British Columbia;
- The affiant states that the Owner “exerts the requisite control over the character and quality of the CONTRABAND wine sold by the Licensee”;
- Since at least early February 2018, the Owner has produced and sold wine in bottles and cases displaying the Mark.

[12] As part of evidence, the Owner filed nine exhibits. The relevant exhibits can be described as follows:

- Exhibit 3: Six invoices from Alderlea Vineyards selling different types of wine to the Licensee. On every invoice, at least two cases of wine are sold to the Licensee and are identified with the Mark in the body of the invoices. All of the invoices are dated in the Relevant Period.
- Exhibit 8: A photograph of a wine bottle with a label affixed on it, displaying the Mark. The affiant states that this photograph is representative of the goods sold by the Owner during the Relevant Period.
- Exhibit 9: A photograph of a case of wine bottles with a label affixed on it, displaying the Mark. The affiant states that this photograph is representative of the cases sold by the Owner during the Relevant Period.

ANALYSIS AND REASONS FOR DECISION

[13] 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 to

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].

[14] In the evidence, Ms. Powell has provided photographs of how the Mark appears on the Owner's wine bottles and cases, and has stated that these photographs are representative of how the goods appeared during the Relevant Period. Furthermore, the Owner's evidence also includes six invoices, dated during the Relevant Period, demonstrating that these goods were sold in Canada to the Licensee.

[15] Given that the Mark was displayed on the goods themselves and associated with the goods in the body of the invoices, and given that the invoices show transfers in the normal course of trade in Canada during the Relevant Period, 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] 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.

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

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Stephen R. Burri

For the Registered Owner

Richard S. Gareau

For the Requesting Party