



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 178

Date of Decision: 2021-08-12

IN THE MATTER OF A SECTION 45 PROCEEDING

Aceites del Sur-Coosur, S.A.

Requesting Party

and

Aceitunas La Española S.L.

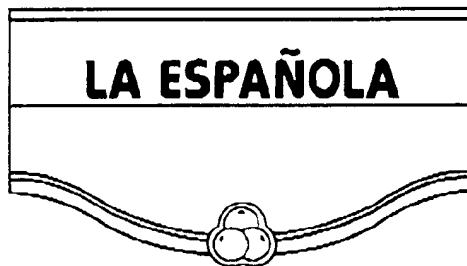
Registered Owner

TMA683,041 for LA ESPAÑOLA

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. TMA683,041 for the trademark LA ESPAÑOLA (& design) (the Mark), shown below:



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

PROCEEDINGS

[3] At the request of Aceites del Sur-Coosur, S.A. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on May 1, 2017, to Aceitunas La Espanola S.L. (the Owner), the registered owner of the Mark.

[4] The Mark is registered for use in association with “preserved olives of all kinds”.

[5] The notice required the 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 May 1, 2014, to May 1, 2017.

[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] 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 need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence need only supply facts from which a conclusion of use may follow as a logical inference [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[8] In response to the Registrar’s notice, the Owner furnished the affidavits of Ignacio Alberola Jordá, sworn on September 20, 2017 and Georgi Paskalev, sworn on December 1, 2017.

[9] Both parties submitted written representations. No oral hearing was held.

EVIDENCE

[10] Mr. Jordá is the Chief Executive Officer of La Espanola Alimentaria Alcoyana, S.A. (the Predecessor), the registered owner of the Mark prior to March 10, 2017. He is also overseeing the operations of the Owner. In his affidavit, he states that the Owner and the Predecessor are food product manufacturers and distributors that specialize in the production and sale of olive-based products. As such, they sell their products both directly to grocery stores and specialty food markets, as well as through third-party distributors.

[11] With respect to display of the Mark, Mr. Jordá explains that it has always been “prominently featured on our food products themselves and/or product labels or packaging affixed to our food products at the time of their sale in Canada”.

[12] Mr. Jordá states that the Owner and the Predecessor sold between 1,500 and 12,000 kilograms of olive and food products in association with the Mark every year from 2000 to 2017, including during the relevant period.

[13] In support, the following relevant exhibits are attached to Mr. Jordá’s affidavit:

- Exhibit 5 consists of representative images of the goods, displaying a variation of the Mark on their packaging. Mr. Jordá states that these images are representative of how the Mark appeared on the products sold in Canada since 1984 to the day of the affidavit by the Owner or the Predecessor.
- Exhibit 6 consists of representative sales invoices issued by the Predecessor to retail customers in Canada, for different products, including olives. I note that only two of these invoices are from the relevant period.

[14] Mr. Paskalev is an employee of the firm representing the Owner. He states that he investigated and purchased registered goods during the relevant period.

[15] In support, the following relevant exhibits are attached to Mr. Paskalev’s affidavit:

- Exhibits 1 through 4 consists of photographs of four different kinds of olives purchased by Mr. Paskalev on March 10, 2017. All of these goods display a variation of the Mark.

- Exhibit 6 consists of the sales receipt from a grocery store in Montreal, for the olive goods bought by Mr. Paskalev on March 10, 2017.

ANALYSIS AND REASONS FOR DECISION

[16] The Requesting Party submits that the Owner's evidence does not show use of the Mark as registered in association with the registered goods during the relevant period. Their main arguments are that the trademarks in the images shown in Exhibit 5 to the Jordá affidavit and Exhibits 1 through 4 to the Paskalev affidavit do not amount to the Mark as registered, that the Owner registered a new trademark in relation with the same goods, and that the relevant period is not referenced in the Jordá affidavit.

Deviation of the Mark

[17] The Requesting Party submits that the Mark does not appear as registered on the packaging shown in evidence. I note that a variation of the Mark is displayed on the products shown in Exhibit 5 to the Jordá affidavit and Exhibits 1 through 4 to the Paskalev affidavit. In particular, the olives are omitted entirely, and the borders to the words LA ESPAÑOLA has been changed. Notwithstanding the Requesting Party's submissions, in applying the principles as set out in *Registrar of Trade Marks v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I consider the changes to be minor deviations from the Mark. In my view, the word LA ESPAÑOLA is the dominant feature and the curved borders and absence of the olives would not mislead an unaware purchaser. Consequently, I accept that any display showed in the Exhibit 5 images to the Jordá affidavit and Exhibits 1 through 4 to the Paskalev affidavit amount to display of the Mark as registered.

Registration of Another Trademark

[18] The Requesting Party submits that the Owner registered another trademark similar to the one illustrated in Exhibit 5 images to the Jordá affidavit and Exhibits 1 through 4 to the Paskalev affidavit regarding the same goods. Therefore, it should be considered as an abandonment of the Mark by the Owner.

[19] A registered owner's filing of a new trademark application has no bearing in the determination of whether or not evidence furnished shows use of a registered trademark [in this respect, see *Oyen Wiggs Green & Mutala v Rubicon Products Ltd* (2007), 65 CPR (4th) 54 (TMOB) at para 9]. Each registration subject to a section 45 notice must be dealt with on its own merits. As such, the fact that the Owner subsequently applied for and registered another trademark is irrelevant to the question of whether the trademark as used shown in the evidence constitutes use of the registered trademark.

Use of the Mark during the Relevant Period

[20] The Jordá affidavit was originally filed in an opposition regarding the registration of a trademark by the Requesting Party. As such, there is no specific reference to the relevant period. However, even though the affidavit refers to use of the Mark between 1984 and the date of the affidavit, some statements and exhibits clearly refer to the use of the Mark during the relevant period. For example, Exhibit 6 invoices contains two invoices dated during the relevant period and in paragraph 22, Mr. Jordá confirms that the Exhibit 5 images represent how the Mark appeared on the products sold by the Owner or the Predecessor from 1984 to September 20, 2017, including during the relevant period.

[21] As for the Paskalev affidavit, the affiant purchased registered goods during the relevant period in Montreal. Photographs of these particular goods bought by the affiant were attached to his affidavit. Therefore, the Exhibits 1 through 4 photographs show how the Mark appeared during the relevant period in Canada.

[22] Given the invoices attached to both affidavits, dated within the relevant period, showing sales of the registered goods in Canada, and the images shown in Exhibit 5 to the Jordá affidavit and Exhibits 1 through 4 to the Paskalev affidavit demonstrating how the Mark was displayed in association with such goods during the relevant period, I am satisfied that the Owner has shown use of the Mark in association with the registered goods.

DISPOSITION

[23] 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.

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

All the trademark agents at Gowling WLG (Canada) LLP	For the Registered Owner
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Paula Clancy (Clancy Professional Corporation)	For the Requesting Party
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