

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 194**

**Date of Decision: 2021-08-31**

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

**Creekside Estate Winery Inc.**

**Requesting Party**

**and**

**Northam Beverages Ltd.**

**Registered Owner**

**TMA950,387 for CREEKSIDE**

**Registration**

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA950,387 for the trademark CREEKSIDE (the Mark).

[2] The Mark is registered for use in association with “Alcoholic brewery beverages”.

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

## THE PROCEEDING

[4] At the request of Creekside Estate Winery Inc. (the Requesting Party), the Registrar of Trademarks issued a notice on September 27, 2019, pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Northam Beverages Ltd. (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with 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 between September 27, 2016 and September 27, 2019.

[6] The 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 response to the Registrar's notice, the Owner submitted the affidavit of Bruce Dean, President and Founder of the Owner, sworn on April 29, 2020.

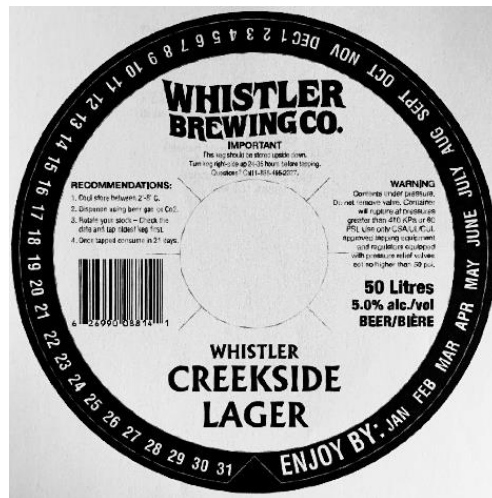
[8] Both parties filed written representations. No oral hearing was requested.

## SUMMARY OF THE OWNER'S EVIDENCE

[9] Mr. Dean explains that the Owner is in the business of producing and selling alcoholic beverages and alcoholic brewery beverages to Canadian consumers. He further explains that such goods are sold through Canadian liquors boards and through bars, restaurants and nightclubs.

[10] Mr. Dean attests that, during the relevant period, the Owner produced and offered for sale “alcoholic beverages and alcoholic brewery beverages to Canadian consumers in association with [the Mark]”.

[11] As Exhibit A to his affidavit, Mr. Dean attaches the following artwork for the collar that was attached to kegs shipped to bars, restaurants and nightclubs in Canada during the relevant period:



[12] As Exhibit B to his affidavit, Mr. Dean attaches a photograph of kegs. Keg collars such as the one depicted in the Exhibit A artwork are attached to each of the kegs.

[13] Mr. Dean also provides a yearly breakdown of “kegs sold” for the years 2015 to 2019, as well as annual sales figures for “kegs bearing [the Mark]”. I note that in the two full years of the relevant period, namely 2017 and 2018, the annual sales volumes were more than 1,000 kegs, amounting to annual sales figures of well over \$100,000.

[14] Finally, as Exhibit C to his affidavit, Mr. Dean attaches representative invoices from the British Columbia Liquor Distribution Board to bars, restaurants and nightclubs. The invoices are dated within the relevant period and are issued to customers in Canada. The invoiced products are identified as “Whistler Brewing – Creekside Lager 50L”.

## ANALYSIS AND REASONS FOR DECISION

[15] The Requesting Party questions certain statements made by Mr. Dean such as his statement regarding cumulative sales volumes “during the relevant period and preceding calendar year” (my underline). Similarly, the Requesting Party points to a purported distinction made by Mr. Dean between the description “kegs sold” in respect of the sales volumes and “kegs bearing [the Mark]” in respect of sales figures. The Requesting Party also questions the relationship between Whistler Brewing Co. and the Owner, and submits that the Owner failed to provide evidence in this regard.

[16] First, I note that the relationship between Whistler Brewing Co. and the Owner is inconsequential. The Owner is the owner of record for the subject registration; the evidence filed pertains to sales of goods produced and offered for sale by the Owner. While Whistler Brewing Co. may be featured on the keg collars instead of the Owner, there is no requirement to identify a trademark owner on goods [see *Novopharm Ltd v Monsanto Canada Inc* (1998), 80 CPR (3d) 287 (TMOB)].

[17] With respect to the other points raised, the Requesting Party takes the incorrect approach of isolating certain pieces of evidence – an approach that can lead to incorrect conclusions as it does not consider other relevant or related evidence. Indeed, in the context of section 45 proceedings, it is important to consider the evidence 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); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[18] In the present case, Mr. Dean provides yearly breakdowns of the sales volumes and sales figures for alcoholic brewery beverages; he also provides representative invoices showing transfers of these goods during the relevant period and sworn statements attesting to sales of the goods by the Owner. Moreover, the Owner provides the artwork for keg collars, along with a photograph showing how such keg collars are attached to kegs.

[19] Considering the evidence as a whole, I accept that, during the relevant period, the Owner sold kegs of alcoholic brewery beverages which were identified with the exhibited keg collars when they were sold and shipped to customers in Canada.

[20] Finally, I note that the Mark is surrounded by additional words on the keg collars. Nevertheless, I find that the Mark did not lose its identity and remained recognizable [*Registrar of Trade-marks v Cie internationale pour l'informatique CII Honeywell Bull*, (1985), 4 CPR (3d) 523 (FCA)]. Indeed, use of a trademark in combination with additional words or design features generally qualifies as use of the trademark if the public, as a matter of first impression, would perceive the trademark *per se* as being used. The issue is a question of fact, dependent upon such factors as whether the trademark stands out from the additional material, for example, by virtue of different lettering or sizing, or whether the additional material would be perceived as purely descriptive matter or as a separate trademark or trade name [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[21] In this case, given that the keg collar features an entity identified as Whistler Brewing Co., the word WHISTLER, displayed in smaller font above the Mark, would likely be perceived by a consumer as a separate mark [see *AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (Fed TD) at 272 for the principle that multiple trademarks can be used together]. Moreover, the word LAGER, displayed below the Mark, is – at a minimum – highly suggestive of the goods.

[22] As a result, the trademark stands out from the additional material and, in my view, a consumer would perceive the Mark *per se* as being used [per *Nightingale*, at para 7]. I am therefore satisfied that the Mark was displayed on the goods within the meaning of section 4 of the Act.

#### DISPOSITION

[23] In view of the foregoing, I conclude that the Owner has shown use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

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.

---

Eve Heafey  
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**

Fasken Martineau DuMoulin LLP

For the Registered Owner

Ridout & Maybee LLP

For the Requesting Party