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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 250

Date of Decision: 21-11-18

IN THE MATTER OF A SECTION 45 PROCEEDING

**Blyth Cowbell Brewery Limited
Partnership**

Requesting Party

and

**Big Rock Brewery Limited
Partnership**

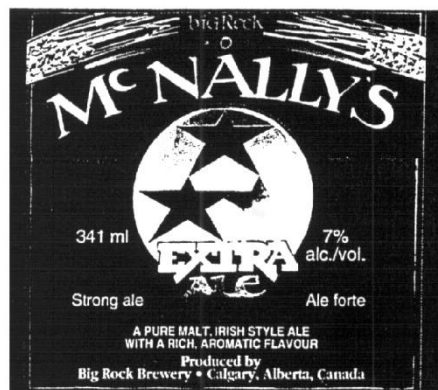
Registered Owner

**TMA499,797 for McNALLY's &
LABEL Design**

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. TMA499,797 for McNally's & Label Design (the Mark), shown below.



[2] The Mark is registered for use in association with the following goods: “Brewed alcoholic beverages.”

[3] At the request of Blyth Cowbell Brewing Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on February 4, 2020 to the registered owner of the Mark, Big Rock Brewery Limited Partnership (the Owner).

[4] The notice required the Owner to show whether the trademark 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 February 4, 2017 to February 4, 2020.

[5] 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.

[6] It is well established that bare statements that a trademark was in use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these 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)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] In the absence of use, pursuant to section 45(3) of the Act, a trademark registration 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 the affidavit of Brad Goddard, Director of the Owner, sworn on April 20, 2020 in Calgary, Alberta.

[9] Only the Owner submitted written representations; no oral hearing was requested.

[10] While the Owner’s evidence and representations are identical to those in the concurrent section 45 proceeding for registration No. TMA944,278 for the trademark MCNALLY’S EXTRA & DESIGN, a separate decision will issue for that registration.

[11] Only those parts of the evidence relevant to this proceeding will be addressed below.

THE EVIDENCE

[12] In his affidavit, Mr. Goddard attests that the Owner is an independent craft brewery founded in 1985 and that it has used the Mark in Canada in association with “beer” since September 2011, including during the relevant period.

[13] Mr. Goddard further attests that the Owner “caused” the Mark to appear on “...product packaging, signage, advertising, promotional items and printed material published or displayed in Canada in connection with beer.”

[14] In particular, Mr. Goddard states that the Owner used and displayed the Mark on: (a) bottles and cans of beer sold in Canada; (b) packaging for beer sold in Canada; (c) its website, *www.bigrockbeer.com*, advertising beer sold in Canada; (d) advertising posters and signage for beer in Canada; and (e) t-shirts. In support, Mr. Goddard provides the following exhibits:

- Exhibit 1 is a photograph, shown below, that Mr. Goddard states is an example of beer produced by the Owner and sold in Canada during the relevant period. I note that the trademark which appears in the exhibit is a variation of the Mark.



- Exhibit 4 consists of three invoices that Mr. Goddard states are from the Owner to the Alberta Gaming and Liquor Commission (AGLC), for sales of beer in association with the Mark. The invoices include sales of different quantities of “McNally’s Extra Ale – 330ml Bottle – 6 Pack”. Mr. Goddard states that the beer was shipped to retailers in Canada between February and May 2017, and resold to customers at later dates.

ANALYSIS AND REASONS FOR DECISION

[15] In its written representations, the Owner states that, “The Affidavit clearly describes the manner in which [the Owner] used the Marks in Canada on beer ... during the Relevant Period, and attaches exhibits that clearly substantiate that use.”

[16] As evidence of transfers, Exhibit 4 consists of three invoices from the Owner to AGLC, dated within the relevant period. Mr. Goddard confirms that these invoices are for beer, which corresponds to the registered goods “Brewed alcoholic beverages”. I accept that these invoices show transfers in the normal course of trade of the registered goods.

[17] The issue, then, is whether display of the variation on such beer products as shown in Exhibit 1 constitutes display of the Mark as registered.

[18] Where the trademark as used deviates from the trademark as registered, the question to be asked is whether the trademark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see if the “dominant features” have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[19] The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[20] In this case, I find the dominant features of the Mark to be the words “McNALLY’S EXTRA” in combination with design elements consisting of three stars, forming a triangle. This combination of words and design elements is present in the evidenced label.

[21] Given the retention of the Mark's dominant features, I find that the Mark as used has not lost its identity and remains recognizable in spite of the differences between the form in which it was registered and the form in which it was used. In view of the foregoing, I am satisfied that the trademark displayed on the Owner's beer as shown in Exhibit 1 constitutes display of the Mark as registered.

[22] In view of the foregoing, I am satisfied that the Owner has shown use of the Mark in association with the registered goods "Brewed alcoholic beverages" within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[23] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Tracey Mosley
Member
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

DLA Piper (Canada) LLP

For the Registered Owner

David R. Canton

For the Requesting Party