



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 288

Date of Decision: 2021-12-21

IN THE MATTER OF A SECTION 45 PROCEEDING

John H. Simpson (Shift Law)

Requesting Party

And

**Big Rock Brewery Limited
Partnership**

Registered Owner

TMA736,344 for the trademark SPY

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA736,344 for the trademark SPY (the Trademark).

[2] The Trademark is registered for use in association with “Brewed alcoholic beverages”.

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

PROCEEDING

[4] On November 19, 2018, at the request of John H. Simpson (Shift Law) (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Fireweed Brewing Corp. doing business as Tree Brewing, the owner of the registration at the time (the Registrant). The notice required the Registrant to put forward evidence showing how it used the Trademark during the three years preceding the notice, so that the Registrar may assess whether the facts qualify as use of the trademark pursuant to section 4 of the Act.

[5] In this case, the relevant period for showing use is between November 19, 2015 and November 19, 2018, and the relevant definition of “use” 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] While evidentiary overkill is not required and representative evidence can be furnished in section 45 proceedings, a registered owner must still establish a *prima facie* case of use of its trademark in association with the goods specified in the registration [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA); see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[7] In response to the Registrar’s notice, the Registrant submitted the statutory declaration of Tod Melnyk, declared on May 14, 2019, together with Exhibits A and B.

[8] Both parties submitted written representations. Only the Requesting Party attended an oral hearing.

[9] Before proceeding, I note that the registration was recently assigned to Big Rock Brewery Limited Partnership by way of an assignment dated September 10, 2021. The assignment was recorded by the Registrar on November 5, 2021 and has no bearing on this decision.

EVIDENCE

[10] Mr. Melnyk states that he is a director of the Registrant, and the sole director of Tree Beer Institute Ltd. (TBI). He also states that the Registrant is the sole shareholder of TBI.

[11] Mr. Melnyk explains that TBI operates a “small batch craft brewery and tasting room” in Kelowna, British Columbia, and that TBI produces a variety of the Registrant’s unpackaged brewed alcoholic beverage products “under authority of the [Registrant] for sale to TBI’s customers”.

[12] According to Mr. Melnyk, the product “sold under the Trademark is a specialty raspberry porter style brewed alcoholic beverage product”, which has been produced and sold “by the [Registrant] and/or TBI at various times during the [relevant period]”.

[13] As Exhibit A to his declaration, Mr. Melnyk attaches a document he refers to as a “Tree Brewing Beer Institute Beer Tracking Sheet” for a product identified on the sheet itself as “SPY PORTER”. He explains that this document is commonly known in the industry as a “brew sheet”, and that it documents the production of the “raspberry porter brewed alcoholic beverage product under the Trademark” from March 1, 2017 to March 22, 2017. He declares that the product in question was subsequently “sold under the Trademark to patrons of TBI between March 22, 2017 and May 10, 2017”.

[14] Similarly, as Exhibit B to his declaration, Mr. Melnyk attaches the brew sheet for a product identified as “RASPBERRY PORTER” on the sheet itself. He explains that this brew sheet documents the production of the same product as that shown in Exhibit A, this production taking place from December 15, 2017 to January 1, 2018. He declares that the product was subsequently “sold under the Trademark to patrons of TBI between January 1, 2018 and

March 17, 2018” and that 100 liters of this product was moved to kegs for subsequent sale “later in 2018”.

[15] With respect to display of the Trademark, Mr. Melnyk states at paragraph 11 of his declaration that :

The brewed alcoholic beverage products described in Exhibit “A” and “B” were sold to patrons of TBI under Trademark by displaying the Trademark on menu boards and written menus made available to those patrons which enabled the patrons to order the product by reference to the Trademark and associated the Trademark with the products.

[16] Mr. Melnyk provides no evidence further explaining or showing how the Trademark appeared on menu boards and written menus.

ANALYSIS

[17] I would first note that there is no evidence showing actual sales of the SPY PORTER “raspberry porter style brewed alcoholic beverage product”. While Mr. Melnyk provides a bare statement that this product was sold “at various times” during the relevant period, without any factual particulars regarding such sales, their context is unclear.

[18] In any event, even if I were to accept that the SPY PORTER product was transferred within the meaning of section 4(1) of the Act, I am not satisfied that the Trademark was associated with the product sold.

[19] The Owner argues that notice of association was given to patrons of the tasting room by way of the menu boards and written menus made available to those patrons, who could then “order the product by reference to the Trademark”. The Owner submits that it was “reasonable and necessary” for the Trademark to be displayed in this way because the product was served in a glass rather than in a bottle or a can. In support of this contention, the Owner relies on case law regarding the use of trademarks on products sold in bulk and, in particular, the Federal Court’s decision in *Central Soya of Canada Ltd v 88766 Canada Inc* (1993), 51 CPR (3d) 509 (FCTD), where the Court allowed an appeal from a decision of the Registrar expunging a trademark

registered in association with bulk feed for animals. In that case, the Court notably considered a price board posted for the benefit of customers which bore the trademark at issue.

[20] While it is true that the display of a trademark on signage in close proximity to goods at the time of transfer of possession or property of those goods may satisfy the requirements of section 4(1) of the Act, each case must be considered on its own merits. When considering whether notice of association is given “in any other manner”, the context is important [*McMillan LLP v April Cornell Holdings Ltd*, 2015 TMOB 111 at para 24].

[21] In fact, in *Central Soya*, the Registrar found that the exhibited materials which pertained to the relevant period did not show the association between the trademark and the goods, and refused to maintain the registration solely on the basis of statements in evidence that the trademark was displayed on feed bags, interior and exterior signage, brochures and product manuals. The correctness of Registrar’s decision was not contested on appeal; instead, the owner tendered additional evidence from which the Federal Court ultimately concluded that the trademark was used.

[22] In this case, as pointed out by the Requesting Party, there is no evidence showing how the Trademark appeared on menu boards and written menus and, consequently, there is no evidence from which to determine whether the requisite notice of association was given to customers at the time of transfer.

[23] I therefore consider Mr. Melnyk’s statement that the menu boards and written menus bore the Mark and “enabled the patrons to order the product by reference to the Trademark” to be a mere assertion of use (as a matter of law), rather than an assertion of fact demonstrating use [see *Mantha & Associés/Associates v Central Transport Inc* (1995), 64 CPR (3d) 354 (Fed CA)].

[24] As was the case before the Registrar in *Central Soya*, without further evidence, I am unable to determine whether the Trademark was so closely associated with the goods at the time of transfer of the goods as to meet the provisions of section 4(1) of the Act.

[25] Before concluding, I note the Registrant's submission that the Trademark was "also displayed on brew sheets for the Registrant's products". However, without evidence that they were distributed or shown to customers, I am not satisfied that the brew sheets provided the requisite notice of association.

[26] In sum, I am not satisfied that the Melnyk declaration demonstrates use of the Trademark in association with the registered goods pursuant to sections 4 and 45 of the Act. As there is no evidence of special circumstances excusing the absence of use, the registration will be expunged.

DISPOSITION

[27] 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 expunged.

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: November 18, 2021

APPEARANCES

No one appearing

For the Registered Owner

John H. Simpson

For the Requesting Party

AGENTS OF RECORD

DLA Piper (Canada) LLP

For the Registered Owner

John H. Simpson (Shift Law Professional Corporation)

For the Requesting Party