



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 040

Date of Decision: 2022-03-10

IN THE MATTER OF A SECTION 45 PROCEEDING

McInnes Cooper

Requesting Party

and

IPack B.V.

Registered Owner

TMA701,559 for LUCIFER

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. TMA701,559 for the trademark LUCIFER (the Mark).

[2] The Mark is registered for use in association with the following goods:

Beers, ales (the Goods)

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

THE PROCEEDING

[4] On October 8, 2020, at the request of McInnes Cooper (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to IPack B.V. (the Owner). The notice required the Owner to show whether the Mark was used in Canada in association with each of 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 the Mark 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 October 8, 2017 and October 8, 2020 (the Relevant Period).

[5] In response to the Registrar's notice, the Owner submitted the affidavit of Michel Moortgat, the Managing Director of IPack B.V., sworn on March 18, 2021.

[6] No party submitted written representations and no oral hearing was held.

THE OWNER'S EVIDENCE

[7] Mr. Moortgat states that he has knowledge of all areas of the Owner's operations, which includes manufacturing, warehousing, sales, and administration. He explains that the Owner, based in the Netherlands, has granted an exclusive license for the Mark to Het Anker who imports and distributes beers and ales into Canada [paras 1, 2 and 3].

[8] In support, Mr. Moortgat attaches the following relevant exhibits to his affidavit:

- Exhibit "B": Two invoices issued by Het Anker during the Relevant Period to Société des Alcools du Québec in Montreal. One of the products listed on the invoices is identified as "1021000001 - Lucifer 24x33cl OW". Mr. Moortgat states that Het Anker sold approximately 22 cases of the Goods bearing the Mark in Canada in 2018 [para 5].
- Exhibit "C": Photographs of three bottles, labels and glasses bearing the Mark. The first bottle is labeled as "Sterk Bier, Strong Ale, Bière Forte", the second as "Belgian Ale", and the third as "Belgian Beer". The labels of the second and third bottles also

state “Brewed by Het Anker”; the quality of the photograph of the first bottle does not allow to see the “Brewed by” statement on the label. Mr. Moortgat explains that the photographs are samples of how the Goods were sold in Canada during the Relevant Period [para 6].

ANALYSIS AND REASONS FOR DECISION

[9] While the evidence in a section 45 proceeding need not be perfect, a registered owner must still establish a prima facie case of use, meaning that the evidence must supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at paras 2, 9]. In this case, the evidence falls short of establishing that there is a prima facie case that use by Het Anker enures to the benefit of the Owner pursuant to section 50 of the Act.

USE BY A LICENSEE

[10] When the owner of a trademark seeks to benefit from the use of its trademark by another party, the owner must show direct or indirect control of the character or quality of the goods or services associated with that trademark [section 50(1) of the Act].

[11] As stated by the Federal Court, there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the license agreement that provides for the requisite control [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84].

[12] There is no such evidence in this case. Mr. Moortgat does not state that Owner had control over the character or quality of the Goods; does not provide any facts demonstrating that such control exists; nor does he provide a copy of a license agreement that explicitly provides for the requisite control.

[13] In his affidavit, Mr. Moortgat states that he has knowledge of all areas of the Owner's operations, but he does not provide any statements identifying the business of the Owner, the role he plays for the Owner as its "Managing Director", or his relationship with the Licensee. Given the aforementioned, I find this is not a case where the requisite control over the character or quality of the goods can be inferred from the evidence. In other words, this case is distinguishable from cases where the requisite control was inferred owing to the presence of a common controlling individual for the trademark owner and the licensee [see, for example, *Lindy v Canada (Registrar of Trade Marks)*, 1999 CarswellNat 652 (FCA); *Petro-Canada v 2946661 Canada Inc.* (1998), 83 CPR (3d) 129 (FCTD)].

[14] Furthermore, I also note that two of the labels in Exhibit C indicate that the product is "Brewed by Het Anker" with no mention of the Owner and the licensed use of the Mark. Therefore, there is no evidence provided in this case that public notice of the licensed use was given such that the Owner may benefit from the presumption created by section 50(2) of the Act.

[15] If Mr. Moortgat had attested in his affidavit that, during the Relevant Period, the Owner controlled the character or quality of the Goods, or provided a copy of the license agreement explicitly providing for the requisite control, my decision would have been different.

[16] Accordingly, I am not satisfied that the evidence establishes use of the Mark in association with the Goods pursuant to sections 4(2) and 45 of the Act. Further, the affidavit does not put forward special circumstances to justify the absence of use in association with the Goods.

DISPOSITION

[17] 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.

Martin Béliveau
Chairperson
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

Rideout & Maybee LLP

For the Registered Owner

Michael Melvin

For the Requesting Party