



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 090**

**Date of decision: 2022-04-28**

**[UNREVISED ENGLISH  
CERTIFIED TRANSLATION]**

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

**CNS Law Corporation**

**Requesting Party**

**and**

**JTI-Macdonald TM Corp.**

**Registered Owner**

**TMA260,119 for STUDIO**

**Registration**

**INTRODUCTION**

[1] At the request of CNS Law Corporation (the Requesting Party), the Registrar of Trademarks sent the notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on April 12, 2018, to JTI-Macdonald TM Corp. (the Owner), the current owner of registration No. TMA260,119 for the trademark STUDIO (the Mark).

[2] The Mark is registered for use in association with the good described as:  
[TRANSLATION] “Cigarettes.”

[3] The notice required the Owner to show whether the Mark had been used in Canada in association with the good 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 of the Mark is from April 23, 2016 to April 23, 2019.

[4] The relevant definition of “use” in this 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.

[5] In response to the Registrar’s notice, the Owner filed an affidavit of Luc Phaneuf, dated September 26, 2019, together with Exhibits LP-1 to LP-3.

[6] Neither party submitted written representations, and only the Owner was represented at the hearing.

[7] For the reasons that follow, I find that the registration ought to be maintained.

#### THE EVIDENCE

[8] Mr. Phaneuf has been the President of the Owner since February 2015. He has also been director general of manufacturing services at JTI-Macdonald Corp. [the licensee], the Owner’s licensee, since November 2012.

[9] Mr. Phaneuf states that a [TRANSLATION] “licence for use of the STUDIO mark in Canada was granted to the licensee JTI by the owner...at least as early as November 15, 1999”. He also states that the Owner: [TRANSLATION] “directly or indirectly controls the features and quality” of the cigarettes manufactured, distributed and sold in Canada.

[10] Mr. Phaneuf states that the Mark was displayed on the cigarette packages and on the cigarette cartons sold during the relevant period. The Owner attached photographs of cigarette

packages displaying the Mark as Exhibit LP-2. He attests that these photographs are representative of the packages sold during the relevant period.

[11] Mr. Phaneuf explains that the cigarettes are sold by the licensee to various retailers in Canada, such as Loblaws Inc., Distribution CMD Inc. and Coremark International Inc., who resell them to their own clients. The Owner attached several invoices issued by the licensee to various Canadian retailers, labelled Exhibit LP-3. Mr. Phaneuf states that the cigarettes sold in the packages photographed in Exhibit LP-2 are identified on the invoices by [TRANSLATION] “the word STUDIO followed by the letters SMTH to refer to *SMOOTH*, FF to refer to *Full Flavour*”.

[12] Mr. Phaneuf also claims that, in 2017 and 2018, more than 25,000,000 packages of cigarettes were sold by the licensee in Canada and that those cigarettes were in packages displaying the Mark, as seen in the photographs in Exhibit LP-2.

#### ANALYSIS AND REASONS FOR DECISION

[13] 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. In light of this, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3].

[14] Given Mr. Phaneuf’s statements concerning the Owner’s control over the licenced use by the licensee, I am satisfied that all use of the Mark by the licensee benefits the Owner under section 50(1) of the Act.

[15] Moreover, given that the photographs in Exhibit LP-2 show that the Mark is displayed on the cigarette packages, that Mr. Phaneuf states that those packages are representative of the packages sold during the relevant period and that the invoices show the transfer of cigarettes in those packages in Canada, I find that the Owner has demonstrated use of the Mark in association with cigarettes within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[16] 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.

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Ann-Laure Brouillette  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

Certified Translation  
Gerald Woodard

The English is WCAG compliant.

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** February 14, 2022

**APPEARANCE**

Barry Gamache

For the Current Owner

None

For the Requesting Party

**AGENTS OF RECORD**

ROBIC

For the Current Owner

CNS Law Corporation

For the Requesting Party