



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 012

**Date of Decision:** 2023-01-26

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

**Requesting Party:** Robert Anton Nissen

**Registered Owner:** Japan Tobacco Inc.

**Registration:** TMA215,779 for MORE

### **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. TMA215,779, for the trademark MORE (the Mark).

[2] The Mark is registered for use in association with cigarettes.

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

## **THE PROCEEDING**

[4] On January 8, 2021, at the request of Robert Anton Nissen, the Registrar of Trademarks issued a notice under section 45 of the Act to Japan Tobacco Inc. (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with cigarettes 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 use since that date. In this case, the relevant period for showing use is between January 8, 2018 and January 8, 2021 (the Relevant Period).

[6] 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.

[7] In response to the Registrar’s notice, the Owner submitted the solemn declaration of Ronald van Tuijl, declared in Geneva, Switzerland, dated August 4, 2021.

[8] Only the Owner submitted written representations. A hearing was held on January 19, 2023, which only the Owner’s representative attended.

## **THE OWNER’S EVIDENCE**

[9] Mr. van Tuijl is the Attorney-in-Fact of the Owner [para 1]. He is also the Trademark & Design Director of JT International SA (JTI), a subsidiary of the Owner [para 2].

[10] Mr. van Tuijl states that since 1999 JTI has operated the international tobacco business of the Owner, including in Canada. The Owner and JTI have entered into a license agreement in respect of the Owner’s trademarks, including the Mark [para 10].

[11] Mr. van Tuijl states that, during the Relevant Period JTI manufactured MORE-branded cigarettes under license from the Owner, and that the Owner indirectly controlled the character and quality of these cigarettes, for example, by inspecting samples to ensure that the Owner's standards for quality control were respected at all times [para 12].

[12] Mr. van Tuijl provides the following relevant exhibits:

- Exhibit 2: photographs of packages of cigarettes, some of which prominently display the Mark. Mr. van Tuijl states that the packages of cigarettes shown in Exhibit 2 have been produced by JTI and sold in Canada during the Relevant Period. He also states that these pictures depict how consumers in Canada were able to see the Mark when they purchased the cigarettes during the Relevant Period [para 13];
- Exhibit 3: invoices from the Relevant Period, showing sales of "MORE FF 120's20" from JTI-Macdonald Corp. (JTI-Macdonald) to various buyers having addresses in Canada. Mr. van Tuijl explains that JTI-Macdonald imports and distributes MORE-branded cigarettes on behalf of JTI in Canada. He further explains that the products identified on the invoices as "MORE FF 120's20" are "Full Flavour" cigarettes of 120 mm sold in packs of 20 in the packages shown in Exhibit 2 [para 14].

### **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. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [see *Diamant* at para 9].

### ***Use under license***

[14] In the case of trademarks used by other parties under license, the owner must demonstrate that they maintain control over the character or quality of the goods sold in association with the mark [Act, section 50(1)]. There are three main methods by which an owner can demonstrate the requisite control: 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 Tabaco Trading v Shapiro Cohen*, 2011 FC 102 at para 84, aff'd 2011 FCA 340].

[15] In this case, Mr. van Tuijl has clearly attested to the fact that JTI is licensed by the Owner to produce and sell cigarettes in association with the Mark [para 10], and that the Owner indirectly controls the character and quality of these cigarettes under the license, for example, by inspecting samples to ensure that the Owner's quality standards are being met [para 12]. I am therefore satisfied that any evidence use of the Mark in Canada by JTI is to the Owner's benefit.

### ***Use of the Mark***

[16] In view of the foregoing, the only question left to determine is whether the evidence establishes use of the Mark in Canada during the Relevant Period, within the meaning of section 4(1) of the Act. Since the cigarettes produced by JTI have been sold via a distributor to buyers in Canada during the Relevant Period [para 14 and Exhibit 3], and since the cigarettes were sold in packages on which the Mark was prominently displayed [para 13 and Exhibit 2], I am satisfied that the Owner has shown use of the Mark in Canada within the meaning of sections 4 and 45 of the Act.

**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 maintained.

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Martin Béliveau  
Chairperson  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2023-01-19

## **APPEARANCES**

**For the Requesting Party:** No one appearing

**For the Registered Owner:** Barry Gamache

## **AGENTS OF RECORD**

**For the Requesting Party:** Nissen Patent Law

**For the Registered Owner:** Robic