



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 037

Date of Decision: 2023-02-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: MBM Intellectual Property Law LLP

Registered Owner: Sunocean Wineries and Estate Inc.

Registration: TMA759,822 for QUINTESSENTIAL – THE PERFECT EMBODIMENT OF A CLASS

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. TMA759,822 for the trademark QUINTESSENTIAL – THE PERFECT EMBODIMENT OF A CLASS (the Mark) registered for use in association with the goods “wine” and the services “sale of wine”.

[2] For the reasons that follow, I conclude that the registration ought to be amended to delete the services “sale of wine”.

THE PROCEEDING

[3] At the request of MBM Intellectual Property Law LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 8, 2021 to the registered owner of the Mark, Sunocean Wineries and Estate Inc. (the Owner).

[4] The notice required the Owner to show whether the Mark was used in Canada in association with the goods and services 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 November 8, 2018 to November 8, 2021 (the Relevant Period). In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[5] The relevant definitions of use are set out in section 4 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.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] 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. As such, the evidentiary threshold that the Owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448] and evidentiary overkill is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the Mark was used in association with the goods and services specified in the registration.

[7] In response to the Registrar’s notice, the Owner furnished the Affidavit of Chang Liao, sworn on February 4, 2022, together with Exhibits A to D.

[8] Only the Owner submitted written representations. No hearing was held.

THE EVIDENCE

[9] Chang Liao is the President of the Owner, which he describes as a producer and seller of wine products.

[10] Mr. Liao explains that the Mark was originally registered by Church & State Wines, Inc. The Owner acquired the business and trademarks of Church & State Wines, Inc., including the Mark, in 2017 and continues to operate under the name Church & State.

[11] Mr. Liao states that the Owner's wine is sold through liquor and wines stores in Canada including in the British Columbia VQA Wine Information Store.

[12] Mr. Liao states that the first batch of wine bearing the Mark was a 2005 vintage, first sold in 2007. New batches were bottled periodically up until 2018.

[13] Mr. Liao states that the Owner's "older vintages" sold out in October 2019 but that, in the period November 8, 2018 to October 2019, the Owner sold twelve bottles of wine bearing the Mark with sales totaling \$358.79.

[14] As Exhibit A, Mr. Liao provides a sales data report for sales within the Relevant Period by Sunocean Wineries and Estate Inc. dba Church and State Wine of wine identified as the "2013 Coyote Bowl Quintessential". As Exhibit C, Mr. Liao provides copies of three invoices, each of which is listed in the Exhibit A sales data report. Each invoice is from Sunocean Wineries and Estate Inc. dba Church and State Wine, is dated within the Relevant Period, is to a Canadian customer and lists amongst the products sold the "2013 Coyote Bowl Quintessential". As Exhibit B, Mr. Liao provides a photograph of a bottle of wine he identifies as the "2013 Coyote Bowl Quintessential" (the 2013 Vintage). The product displays the Mark.

[15] With respect to the services, Mr. Liao asserts that the Owner used the Mark in association with the "sale of wine", prior to and during the Relevant Period, "by

displaying the [Mark] in connection with advertising of the [services] on their website". In support, he provides, as Exhibit D, a print out from the Owner's website *shop.churchandstatewines.com* which he says "advertises Quintessential wine" and depicts the 2013 Vintage as shown in Exhibit B. He states that the content was on the Owner's website during the entirety of the Relevant Period.

ANALYSIS AND REASONS FOR DECISION

[16] In its submissions, the Owner noted that the Mark as displayed does not have a hyphen between QUINTESSENTIAL and THE PERFECT EMBODIMENT OF CLASS, as is shown in the registration. The Owner submitted that the absence of the hyphen was a minor variation and I agree. The Mark remains recognizable and has not lost its dominant features [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[17] Turning to the goods, wine, the evidence described above clearly shows that the Mark was used in Canada during the Relevant Period in association with wine. In particular, the Owner has provided a photograph of the 2013 Vintage bearing the Mark and invoices for the sale of the 2013 Vintage to Canadian customers during the Relevant Period. Although sales of the 2013 Vintage in the Relevant Period only comprised twelve bottles, I am satisfied that the sales followed the pattern of a genuine commercial transaction.

[18] Accordingly, I am satisfied that the Mark was used in Canada by the Owner in association with the goods "wine" during the Relevant Period within the meaning of sections 4(1) and 45 of the Act.

[19] With respect to the services "sale of wine", the Owner relies on the Exhibit D print out from the Owner's website at *shop.churchandstatewines.com*, which promotes the 2013 Vintage.

[20] I have kept in mind that the services should be given a broad and liberal interpretation but I am not satisfied that the evidence submitted by the Owner, namely that the 2013 Vintage was promoted on the Owner's website, without anything more, provides sufficient facts to allow me to conclude that the services "sale of wine" were offered or performed in Canada in association with the Mark.

[21] Accordingly, I am not satisfied that the Owner has established use of the Mark in association with the services "sale of wine" within the meaning of sections 4(2) and 45 of the Act. As there is no evidence of special circumstances to justify non-use, the registration will be amended accordingly.

DISPOSITION

[22] 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 amended to delete the services "sale of wine".

[23] The registration will be maintained for the goods "wine".

Robert A. MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: MBM Intellectual Property Agency

For the Registered Owner: Lawson Lundell LLP