



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 106

Date of Decision: 2023-06-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Croll & Co. Ltd. dba Origins IP

Registered Owner: Eli Gershkovitch

Registration: TMA950,484 for SISU

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. TMA950,484 for the trademark SISU (the Mark).

[2] The Mark is registered for use in association with “Beer”.

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

PROCEEDING

[4] At the request of Croll & Co. Ltd. dba Origins IP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on December 7, 2021, to Eli Gershkovitch (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark was 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 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 December 7, 2018 to December 7, 2021.

[6] The relevant definition of “use” in the present case is 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.

[7] Where the owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Eli Gershkovitch, sworn March 3, 2022, to which were attached Exhibits A to G.

[9] Neither party submitted written representations and no oral hearing was held.

EVIDENCE AND ANALYSIS

[10] In his affidavit, Mr. Gershkovitch states that his beer is produced and sold under license by Gastown Brewing Co. Ltd., carrying on business as Steamworks Brewing Co. (the Licensee). He also states that he is the sole shareholder and President of the Licensee. He confirms that he has complete control over how the Mark is used in association with beer [paras 2 and 6].

[11] With respect to the use of the Mark, Mr. Gershkovitch states that the Mark has been used in Canada during the relevant period. In particular, he states that the Licensee sold within that period the Owner's beer bearing the Mark in 4-bottle cases of 1.5 liters each. In this respect, he states that the bottled beer was sold to the British Columbia Liquor Distribution Board (the BCLDB) for further sale to end-consumers through local retailers. He further states that the Owner's beer was also sold directly to consumers at the Licensee's brewery and retail outlet located in British Columbia [paras 2 and 6-7].

[12] As Exhibit C, Mr. Gershkovitch attaches a photograph of a 1.5 liters beer bottle which label prominently displays the Mark. He attests that this photograph shows the bottled beer as it was commercialized during the relevant period [para 5]. As Exhibits D, E and F, he attaches three invoices. The first two invoices are issued by the Licensee to the BCLDB during the relevant period and each invoice show sales of 96 cases of 1.5 liters of bottled beer. The third invoice is issued by the Licensee to its retail outlet and shows sales of 2 cases of 1.5 liters of bottled beer. I note that the Owner's beer is identified with the Mark in the body of the three invoices.

[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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 38] 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] In the present case, the representative photograph demonstrates how the Mark was displayed in association with beer during the relevant period, and the invoices provide evidence of transfers of such good in the normal course of trade during that period. I am therefore satisfied that the Owner has shown use of the Mark in association with these goods pursuant to sections 4(1) and 45 of the Act.

DISPOSITION

[15] Accordingly, 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.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

No hearing held

AGENTS OF RECORD

For the Requesting Party: Amy Croll (dba Origins IP)

For the Registered Owner: Vantek Intellectual Property LLP (AKA D/B/A
Vantek IP LLP)