



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 029

Date of Decision: 2024-02-22

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Vinicola Del Norte, S.A.

Registered Owner: Disprodal S.A.

Registration: TMA881,094 for BAKARA

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. TMA881,094 for the trademark BAKARA (the Mark), owned by Disprodal S.A. (the Owner).

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

[3] For the reasons below, I conclude that the registration should be maintained.

PROCEEDING

[4] At the request of Vinicola Del Norte, S.A. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on May 5, 2023, to the registered owner of the Mark.

[5] 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. The relevant period for showing use is from May 5, 2020, to May 5, 2023.

[6] In response to the notice, the Owner furnished the affidavit of Jacques Eric Baboun, its President.

[7] Neither party submitted written representations and no oral hearing was requested.

OVERVIEW OF THE OWNER'S EVIDENCE

[8] Mr. Baboun identifies himself as the Owner's President since 1999 [para 1].

[9] He explains that the Owner manufactures and packages its rum at its facilities in Haiti [para 3]. Its rum is then exported, including to Canada, by the Owner's parent company Boissons Agricoles Nationales S.A. (BANSA) [para 4].

[10] He indicates that, during the relevant period, BANSA's sales of the Owner's rum to the Société des Alcools du Québec (SAQ) totalled approximately 50,000 CAD [paras 5-6]. Mr. Baboun includes a representative sample invoice, which is dated during the relevant period and clearly identifies sales of hundreds of bottles of "BAKARA" rum [para 7, Exhibit A].

[11] Mr. Baboun states that all the bottles of rum, sold by the Owner through BANSA in Canada during the relevant period, prominently displayed the Mark. He attaches representative photographs showing rum bottles with labels on which the Mark is clearly

visible, and specifies that the labels shown are identical to those used in Canada during the relevant period [para 8, Exhibit B].

ANALYSIS AND REASONS FOR DECISION

[12] 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.

[13] 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; the Owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[14] It is well established that distribution and sale of goods through various entities such as exporters, distributors, wholesalers and/or retailers can constitute trademark use that enures to the owner’s benefit, so long as the owner has initiated the first link in the chain of transactions [*Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD)].

[15] Mr. Baboun’s statements and documentary evidence clearly show (i) the Mark directly on the goods; (ii) the Owner’s normal course of trade, including export of the goods it manufactures to Canada through its parent company BANSAs; and (iii) the sale of such goods in Canada in such normal course of trade during the relevant period. I am therefore satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with the goods “rum”.

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.

Emilie Dubreuil
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Robic Agence PI S.E.C./Robic IP Agency LP

For the Registered Owner: Gowling WLG (Canada) LLP