



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2025 TMOB 42

**Date of Decision:** 2025-03-04

## IN THE MATTER OF A SECTION 45 PROCEEDING

**Requesting Party:** Fasken Martineau DuMoulin LLP

**Registered Owner:** Zoe International Distributing Inc D/B/A HBI Canada

**Registration:** TMA687,848 for Kingpin & design late 1994 us

## 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. TMA687,848 for the trademark Kingpin & design late 1994 us (the Mark) reproduced below.



[2] The Mark is registered for use in association with the following goods listed by Nice class (CI):

CI 34 (1) Cigars, cigarette rolling papers, tobacco.

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

**PROCEEDING**

[4] At the request of Fasken Martineau DuMoulin LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 29, 2023, to Zoe International Distributing Inc D/B/A HBI Canada (the Owner), the registered owner of the Mark (the Owner).

[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 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 from November 29, 2020 to November 29, 2023.

[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] Where the Owner does not show “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 its Chief Executive Officer, Demetra Georganas, sworn on February 27, 2024, together with Exhibits A to C.

[9] Only the Owner submitted written representations; no oral hearing was held.

[10] I note that the same Requesting Party also initiated a section 45 proceeding against the Owner's registration No. TMA664,223 for KINGPIN. Although the same evidence was furnished for both files, a separate decision will be issued with respect to that proceeding.

### **EVIDENCE AND ANALYSIS**

[11] In her affidavit, Ms. Georganas states that the Owner has been in the business of manufacturing and wholesale distribution of accessory products for the "roll your own" or "make your own" smoking markets for over two decades. The Owner sells products to retailers located in Canada, which in turn sell them to consumers online or in their stores across Canada [paras 3 and 5].

[12] Ms. Georganas asserts that the Owner "extensively" used the Mark in Canada during the relevant period in association with "smoking accessory products" [paras 9 and 20].

[13] As evidence of such use, Ms. Georganas states that the Owner publishes annual catalogs that showcase smoking accessory products bearing the Mark. She explains that Canadian retailers select products from these catalogs and place orders on the Owner's website at *hbicanada.com* (the Website) [paras 11-13]. In support, Ms. Georganas provides, as Exhibits A and B, the Owner's catalogs for 2021 and 2022. She asserts that the products shown in the catalogs are representative of the goods sold in Canada during the relevant period [paras 16 and 18]. The catalogs show products identified as "hemp wraps" with packaging that displays the word component of the Mark [Exhibit A and B, page 60].

[14] As evidence of transfers, Ms. Georganas provides, as Exhibit C, a sample of 15 representative invoices issued by the Owner to Canadian retailers and dated during the relevant period. Among other invoiced goods, the “hemp wraps” are identified in the description field of the invoices as “KINGPIN HEMP WRAPS”.

[15] Lastly, Ms. Georganas asserts that the Owner’s “hemp wraps” are sheets of rolling paper cut to size to prepare “a smoking product with tobacco or cannabis, including a cigarette”. She correlates the “hemp wraps” shown in the catalogs and listed in the invoices with “cigarette rolling papers” [paras 15 to 17].

### ***The display of the Mark***

[16] As noted above, the hemp wraps in evidence only display the word component of the Mark.

[17] In applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and in *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I find the word “KINGPIN” to be the dominant feature of the Mark as registered given its font style, size and positioning. In my view, as the word component is preserved, the Mark remains recognizable and does not lose its identity despite the omission of the design.

[18] As such, for purposes of this decision, I accept that the evidenced display constitute display of the Mark as registered.

### ***Use is shown in association with “cigarette rolling papers”***

[19] 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].

[20] In the present case, I accept Ms. Georganas’ above-mentioned correlation of the Owner’s products with “cigarette rolling papers”. As a result, the evidenced catalogs show how the Mark was associated with “cigarette rolling papers” during the relevant period, and the invoices show transfers of these goods within the Owner’s normal course of trade in Canada during the same period.

[21] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with “cigarette rolling papers” in Nice class 34 (1) within the meaning of sections 4 and 45 of the Act.

***No use is shown in association with “cigars” and “tobacco”***

[22] While evidentiary overkill is not required and representative evidence can be furnished in section 45 proceedings, the registered owner must still establish a *prima facie* case of use of the trademark in association with *each* of the goods specified in the registration [*John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA); see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[23] Having distinguished “cigars”, “cigarette rolling papers” and “tobacco” in Nice class 34 (1), the implication is that each good is somewhat different from the others. It follows that the Owner should have provided separate evidence of use of the Mark in association with “cigars” and “tobacco” as it did for “cigarette rolling papers”.

[24] Although Ms. Georganas’ states throughout her affidavit that the Owner’s rolling papers can be *used* to prepare a smoking product with tobacco (i.e., to prepare a “tobacco cigarette”), nowhere in her affidavit does

she clearly assert use of the Mark in association with “tobacco” alone. Ms. Georganas does not clearly assert use of the Mark in association with “cigars” either.

[25] Regardless of whether the Owner’s rolling papers can be used to prepare a smoking product with tobacco, the fact remains that there is no evidence of use of the Mark in association with goods other than “cigarette rolling papers”.

[26] In view of the above, I am not satisfied that the Owner has demonstrated use of the Mark in association with “cigars” and “tobacco” in Nice class 34 (1) within the meaning of sections 4 and 45 of the Act. As the Owner has not provided any evidence of special circumstances excusing the absence of use of the Mark in association with these goods, the registration will be amended accordingly.

#### **DISPOSITION**

[27] 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 “cigars” and “tobacco” from the statement of goods.

[28] The amended statement of goods will read as follow:

CI 34 (1) Cigarette rolling papers.

Maria Ledezma  
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:** Fasken Martineau Dumoulin LLP

**For the Registered Owner:** DLA Piper (Canada) LLP