

Federal Court



Cour fédérale

Date: 20230831

Docket: T-1881-21

Citation: 2023 FC 1188

Ottawa, Ontario, August 31, 2023

PRESENT: The Honourable Justice Fuhrer

BETWEEN:

NORTH BREWING COMPANY LTD.

Appellant

and

DLA PIPER (CANADA) LLP

Respondent

JUDGMENT AND REASONS

I. Overview

[1] At the heart of this matter is the thorny issue of the extent to which variations of a registered trademark used by the trademark owner will constitute use of the registered trademark, thus avoiding (or, more accurately in this case, reversing) summary cancellation for non-use.

[2] North Brewing Company Ltd. [NBCL] appeals the decision of the Registrar of Trademarks [Registrar], under section 45 of the *Trademarks Act*, RSC 1985 c T-13 [TMA], to cancel or expunge from the trademarks register the company's registration for North Brewing. See Annex "A" below for relevant legislative provisions.

[3] Although the Respondent, DLA Piper (Canada) LLP [DLA] initiated the summary cancellation proceedings, DLA takes no position in this appeal.

[4] Having considered NBCL's new and material evidence and its arguments, I allow the appeal. The Registrar's decision to expunge the registration for North Brewing is set aside and the trademark registration is maintained, but amended, for the reasons and on the terms provided below.

II. Background

[5] NBCL registered the trademark North Brewing [Mark] under registration number TMA900498 on April 8, 2015 [Registration] for use in association with the following goods: (1) Brewed alcoholic beverages, namely, beer, ale, lager, malt liquor; (2) Promotional items, namely, beer glasses, mugs, bottle openers, key chains, clothing, namely, shirts, hats, jackets, and pants [Registered Goods].

[6] At the request of DLA, the Registrar issued a notice to NBCL dated May 31, 2021 under section 45 of the *TMA* [Section 45 Notice] which required the company to furnish within three months: (1) evidence of use of the Mark within the three years immediately preceding the

Section 45 Notice, that is May 31, 2018 to May 31, 2021 [Relevant Period] with respect to each of the Registered Goods; or (2) the date when NBCL last used its Mark in Canada and the reason for absence of use since that date.

[7] According to the affidavit of Peter Burbridge, president, director and majority shareholder of NBCL [Burbridge Affidavit], submitted in support of this appeal, NBCL did not receive the Section 45 Notice in 2019 because of an unrecorded change of address and, thus, did not furnish the requested evidence to the Registrar. NBCL previously represented itself before the Registrar of Trademarks and had omitted updating its address prior to receiving the Section 45 Notice.

[8] The Registrar subsequently sent a letter to NBCL on October 12, 2021 to the same former address informing NBCL of the decision to expunge the Registration [Decision] for failure to respond to the Section 45 Notice, unless NBCL filed an appeal under section 56 of the *TMA* within the time period specified in the latter provision. The Burbridge Affidavit describes that the current occupant of the premises at NBCL's former address, familiar with NBCL, readdressed the envelope they received from the Registrar to NBCL's current address; hence, NBCL filed this appeal in time.

III. Issues and Standard of Review

[9] The issues before this Court are whether NBCL's new evidence is material and, if yes, whether it establishes NBCL's use of the Mark during the Relevant Period in association with the Registered Goods, such that the registration should be maintained.

[10] An appellate standard of review applies where, as in the case before me, there is a statutory right of appeal: *Canada (Minister of Citizenship and Immigration) v Vavilov*, 2019 SCC 65 paras 36-37, citing *Housen v Nikolaisen*, 2002 SCC 33. The starting point is a consideration of whether any new evidence would have affected the Registrar’s decision materially: *The Clorox Company of Canada, Ltd. v Chloretec SEC*, 2020 FCA 76 [*Clorox*] at para 19; *Caterpillar Inc. v Puma SE*, 2021 FC 974 [*Puma*] at para 32, aff’d 2023 FCA 4.

[11] To be considered “material,” the new evidence must be sufficiently substantial and significant, and of probative value: *Clorox*, above at para 21 (citations omitted); *Sea Tow Services International, Inc v Trademark Factory International Inc*, 2021 FC 550 at para 16; *Vivo Mobile Communication Co, Ltd v Garmin Switzerland GmbH*, 2022 FC 1410 at para 18. The test is not whether the new evidence would have changed the Registrar’s mind, but rather whether it would have a material effect on the decision: *Scott Paper Limited v Georgia Pacific Consumer Products LP*, 2010 FC 478 at para 49. In that regard, quality, not quantity, is key: *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707 at para 27.

[12] Further to subsection 56(5) of the *TMA*, a finding of materiality permits the Court to “exercise any discretion vested in the Registrar.” The Court need not defer to the decision maker’s reasoning process, and undertaking its own analysis, the Court may decide whether it agrees with the decision maker’s determinations or whether it will substitute its own views: *Dunsmuir v New Brunswick*, 2008 SCC 9 at para 50; *Clorox*, above at para 21.

[13] In sum, I must assess the nature, significance, probative value, and reliability of NBCL's new evidence, in the context of the record, and determine whether it adds something of "significance" and hence, whether it would have affected the Registrar's decision materially: *Seara Alimentos Ltda v Amira Enterprises Inc*, 2019 FCA 63 at paras 23-26 [*Seara*]. In other words, would the evidence have enhanced or otherwise clarified the record in a way that might have influenced the Registrar's conclusions on a finding of fact or exercise of discretion, had it been available at the time of the Decision?

[14] Further, even where new evidence is admitted on appeal, this does not displace the Registrar's findings necessarily in respect of every issue, but rather only for those issues in respect of which the evidence is provided and admitted: *Seara*, above at para 22. That said, in the case before me, the Registrar made no findings of fact relevant to this appeal in light of NBCL's lack of response to the Section 45 Notice.

IV. New Evidence

[15] According to the Burbridge Affidavit, NBCL was incorporated under the laws of the province of Nova Scotia on July 22, 2011, and Peter Burbridge has been the company's president since that time.

[16] Mr. Burbridge explains that NBCL has operated a craft micro-brewery, retail store and tap room at its current location since 2019. He further explains that, since 2018, NBCL has operated a craft micro-brewery and retail store inside a beer park called Battery Park.

[17] According to the Burbridge Affidavit, NBCL sold the following items from its brick and mortar locations or online store to its customers in Canada during the Relevant Period: brewed alcoholic beverages, namely, beer, ale, lager; promotional items, namely beer glasses, mugs, bottle openers, key chains, clothing, namely shirts and hats. In its written submissions, NBCL acknowledges that there is no evidence relating to malt liquor, pants and jackets, and thus these specific goods should be deleted from the Registration.

[18] According to Mr. Burbridge, NBCL sold brewed alcoholic beverages through the Nova Scotia Liquor Corporation and restaurants and bars, in addition to its own retail stores, tap room and online store.

[19] Mr. Burbridge further explains that NBCL sold promotional items through its physical retail locations and online store or gave them away to customers.

[20] The exhibits to the Burbridge Affidavit include photographs of NBCL's cans which, Mr. Burbridge asserts, prominently feature the Mark. Mr. Burbridge states that these products were sold to customers during the Relevant Period. He attests that these photographs are representative of the manner in which the Mark was displayed on each can of beer, ale and lager sold by NBCL during the Relevant Period. He states that more than 5,000 cans marked in this manner were sold during the Relevant Period, but that exact figures are understated for confidentiality reasons.

[21] Mr. Burbridge similarly provided photographs of the Mark used during the Relevant Period on: boxes in which NBCL shipped its cases of cans of brewed alcoholic beverages; beer

glasses and mugs used to serve customers in the physical locations; on promotional items that were sold and given away; invoices; NBCL's website; signs over the entrance doors to NBCL's retail locations and tap room under which customers passed; and signage for events.

V. Analysis

[22] I am persuaded that this appeal should be allowed and the Decision be set aside. I address each issue in turn.

A. *NBCL's new evidence is material*

[23] I am satisfied that the Burbridge Affidavit, which describes NBCL's use of the Mark during the Relevant Period, would have had a material effect on the Decision had it been before the Registrar of Trademarks for consideration, given that NBCL did not respond to the Section 45 Notice: *Clorox*, above at para 19; *Puma*, above at para 32; *Randy River Inc v Osler, Hoskin & Harcourt LLP*, 2022 FC 1015 [*Randy River*] at para 9.

[24] Further, the Court may admit and consider new evidence in an appeal such as this, where no evidence was before the Registrar: *Roebuck v Canada (Registrar of Trade Marks)* (1987), 15 CPR (3d) 113, 1987 CarswellNat 629 (FCTD) at paras 3, 16; *Trademark Tools Inc v Miller Thomson LLP*, 2016 FC 971 at para 8, aff'd 2017 FCA 98.

[25] Accordingly, having regard to the *TMA* s 56(5), the Court may exercise any discretion vested in, and hence effectively steps into the shoes of, the Registrar.

[26] I add that the fact of DLA taking no position in this matter in itself does not absolve NBCL from establishing, or somehow lessen the burden on NBCL to establish, to the Court's satisfaction: (a) the materiality of its evidence on appeal from the Decision; and (b) that the Mark was used in Canada during the Relevant Period. Nor in my view, does the decision in *Randy River* support this proposition. Having determined the former issue, I turn to the latter issue.

B. *NBCL used the Mark during the Relevant Period*

[27] Based on the Burbridge Affidavit, I am satisfied that, even after excluding malt liquor, pants and jackets from consideration because of NBCL's acknowledgement that there is no evidence of use for these Registered Goods, NBCL used the Mark during the Relevant Period for some, but not all, of the remaining Registered Goods. I outline next the applicable principles, and then consider both the Mark as used and the variations disclosed in NBCL's evidence.

(1) *Applicable Principles*

[28] Cancellation proceedings under the *TMA* s 45 are summary in nature and intended to clear from the register trademarks that have fallen into disuse. To maintain its registration, the trademark owner must make assertions of fact showing use, as opposed to mere or bald assertions of use. Evidentiary overkill is not required (that is, not all examples of use must be evidenced). The use threshold in a section 45 proceeding is low or not "stringent." These principles are summarized in *Swabey Ogilvy Renault v Golden Brand Clothing (Canada) Ltd*, 2002 FCT 458 at para 7, and in numerous other section 45 decisions, including *Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 [*Hilton Worldwide*] at para 9.

[29] Under subsection 4(1) of the *TMA*, a trademark is “deemed to be used in association with goods where there is evidence that the registered owner or its licensee sold the relevant goods in Canada during the relevant period and that the trademark was marked on the goods themselves or on the packages in which they are distributed or was in any other manner associated with the goods at the time of sale”: *Randy River*, above at para 10.

[30] Where, as here, the trademark owner provides asserted examples of trademark usage that differ from the registered trademark, the Court must consider the extent to which the deviations or variations nonetheless demonstrate use of the registered trademark.

[31] In the case of a trademark that is registered only in textual form (i.e. a word mark), the registration of such a mark permits the owner to use it in any size and with any style of lettering, color or design: *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 [*Masterpiece*] at para 55. Justice Rothstein provides an example of what this means in terms of the scope of a registration for the trademark “Masterpiece Living.” In his view, nothing would prevent the registered owner from highlighting the word “Masterpiece” and giving “Living” less prominence or from changing the font or style of lettering: *Masterpiece*, above at para 58. What the Supreme Court of Canada did not consider in *Masterpiece*, however, was the addition of other elements to the trademark as registered (i.e. resulting in the formation of a composite mark, as in the case before me) in connection with its confusion analysis.

[32] In the seminal case of *Registrar of Trade Marks v CII Honeywell Bull*, 1985 CanLII 5537 (FCA), [1985] 1 FC 406 [*Honeywell*], the Federal Court of Appeal considered whether the

combination of the words CII, HONEYWELL and BULL, forming the composite mark CII HONEYWELL BULL, nonetheless constituted use of the registered trademark BULL. The Court explained that it did not.

[33] The oft cited test from *Honeywell* is framed as follows (at 409):

The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

[Emphasis added.]

[34] In my view, however, the underlined wording contradicts the introductory words to that paragraph, as well as the subsequent conclusion. The Court (Justice Pratte) prefaced the test with the following (at 408-409):

The problem to be resolved is not whether CII deceived the public as to the origin of its goods. It clearly did not. The real and only question is whether, by identifying its goods as it did, CII made use of the trade mark “Bull”. That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used.”

[Emphasis added.]

[35] The Court concluded (at 409):

Viewing the problem in that light and applying that test, we cannot escape the conclusion that, in using the composite mark “CII Honeywell Bull”, CII did not use its mark “Bull”.

[36] The Federal Court of Appeal later attempted to reconcile the different ways in which Justice Pratte expressed the test, as follows, in another seminal section 45 case, *Promafil Canada Ltée v Munsingwear Inc*, 1992 CanLII 12831 (FCA), 44 CPR (3d) 59 [*Promafil*] at 66:

Pratte J.A. expressed the same test in two ways: in a theoretical way, as to the maintenance of identity and recognisability in spite of the different forms of the mark; in a practical way, by estimating the likely confusion of an unaware purchaser. The practical test must clearly be one of probability, because, as a general rule, one could not lay down such a test in terms requiring certainty of conclusion.

[37] The court in *Promafil* found the *Honeywell* tests adequate but opined that “they are not to be taken as precluding other ways of expressing the same thing...” (at 66).

[38] Having regard to the circumstances before the Court in the *Honeywell* case and based on the Court’s application of the articulated test, it seems to me that the test could be divided into two parts (whether theoretical or practical), both focussed on the differences between the form of the trademark as registered and as used. The first part would examine whether the differences in the versions of the mark under consideration likely would deceive the public as to the origin of the applicable goods (or services). In other words, the differences result in versions that are so far apart, there can be no question that the trademark as registered no longer is in use and further, the version in use likely would deceive the public as to the origin of the associated goods or services.

[39] If there were no possibility of deception to the public, then the second part of the test would focus on whether “the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used.” This makes sense, in my view, when one considers the

purpose of section 45, which is to clear “dead wood” or marks that have fallen into disuse from the register. The starting point for the latter or second part of the test is the result in *Honeywell*, where the combination mark CII HONEYWELL BULL resulted in a loss of identity and recognition of the registered trademark BULL alone; there was no question that the public was not deceived as to the origin of the applicable goods in that case.

[40] I add that in *Promafil*, the Court referred (at 70) not only to “the maintenance of the identity and recognizability” of the registered trademark but also to “the preservation of dominant features.” The Court focussed on the latter in finding that the two penguin designs at issue differed “only in petty details” and concluding that the corpulent penguin design “is a mere variation of the slim penguin, because it maintains the same dominant features” and is “an almost identical second design”: *Promafil*, above at 70-71.

[41] I note that the two penguin designs were used contemporaneously which, in my view, adds context for the oft quoted observation from *Promafil* (at 71) that “Canadian law does not incorporate a linear view of the trade mark registration but can tolerate multiple variants of a mark.” [Emphasis added.]

[42] The Court further opined (at 71) that “with every variation the owner of the trade mark is playing with fire[; b]ut cautious variations can be made without adverse consequences, if the same dominant features are maintained and the differences are so unimportant as not to mislead an unaware purchaser.”

[43] Questions of what elements are the dominant features of a trademark and whether the variation is so minor as to find that the trademark as registered has been used are questions of fact to be determined on a case-by-case basis: *Padcon Ltd v Gowling Lafleur Henderson LLP*, 2015 FC 943 at para 108; *Fasken Martineau Dumoulin LLP v Gentec*, 2022 FC 327 at para 89, citing *Robichaud v Clio/Oz Division of Mainline Fashions Inc*, 2015 TMOB 210 at para 27.

[44] Bearing these principles in mind, I consider next NBCL's evidence of the Mark as used and the variations shown in the Burbridge Affidavit.

(2) The Mark and Variations as Used by NBCL

[45] As explained below, I find that NBCL's evidence shows sufficient use of the Mark as registered to maintain the registration for brewed alcoholic beverages, namely, beer, ale, lager, and promotional items, namely, beer mugs, key chains, but not for the remaining promotional items.

[46] I am satisfied, based on the Burbridge Affidavit, that there is no issue regarding whether the demonstrated uses of the Mark, including variations, occurred during the Relevant Period. There is an issue, however, whether the variations shown in NBCL's evidence nonetheless maintain the same dominant features of the Mark and are so unimportant as not to mislead an unaware purchaser.

[47] The Burbridge Affidavit confirms that NBCL's normal course of trade is to sell its goods from its physical and online retail outlets directly to customers for consumption off-premises, to

the Nova Scotia Liquor Corporation, to restaurants and bars, and directly to customers for consumption on-premises at its tap room. I emphasize, however, that the Mark is not registered for any services.

[48] The exhibits to the Burbridge Affidavit include photographs of the Registered Goods or their packaging on which NBCL asserts the Mark has been used, namely, cans of brewed alcoholic beverages, the boxes in which the beverages are sold and shipped, the glasses and mugs in which the beverages are served to customers, as well as shirts, hats, beer mugs, bottle openers, and key chains. Although Mr. Burbridge has not provided sales figures of such goods, he provides estimated amounts of items sold or given away. The table in Annex “B” below captures many of NBCL’s examples of asserted use of the Mark during the Relevant Period (based on the Burbridge Affidavit, including exhibits).

[49] As can be seen from Annex “B,” many of the asserted uses of the Mark involve variations. Starting with the Registered Goods, “brewed alcoholic beverages, namely beer, ale, lager,” I am satisfied that the Burbridge Affidavit establishes use of the Mark for these goods during the Relevant Period, for several reasons.

[50] Mr. Burbridge attests that NBCL’s brewed alcoholic beverage, namely ale, has been shipped to the Nova Scotia Liquor Corporation in more than 100 branded boxes bearing the following:



[51] Although the word COMPANY has been added to the words NORTH BREWING which comprise the Mark, albeit in upper and lower case letters, I am satisfied that this is an inconsequential or minor addition, with the dominant feature, i.e. the words North Brewing, maintained: *Fairweather Ltd v Registrar of Trade-marks*, 2006 FC 1248 at paras 57-61; *Conduit Law Professional Corp v Great Western Brewing Co*, 2021 TMOB 182 at paras 18-20. As *Masterpiece* guides (at paras 55 and 58), a word mark can be used in any stylized form.

[52] Mr. Burbridge further attests that NBCL served its brewed alcoholic beverages, namely beer, ale, and lager, ordered by customers for consumption at its tap room or on-premises at Battery Park in mugs and glasses such as the following:



[53] Regarding the beer mug on the left, I am of the view that the depiction of partially filled and filled glasses of a yellow beverage (such as beer) are a descriptive addition to the Mark in association with brewed alcoholic beverages. In other words, I find that the transfer of possession of the ordered beer in glassware such as these examples to customers in the ordinary course of trade constitutes use of the Mark during the Relevant Period. I note that I might have found to the contrary, were there evidence of third party brewed alcoholic beverages being sold. NBCL's

evidence, however, is that it is a brewery that sells its own beverages to customers, either in cans or for consumption at its locations in glassware such as those depicted in the preceding paragraph: *Lapointe Rosenstein Marchand Melançon LLP v American Dairy Queen Corporation*, 2014 TMOB 185 [*Lapointe*] at para 28.

[54] Because the Burbridge Affidavit describes that the mug on the left (depicted in paragraph 52 above) was sold and given away during the Relevant Period, I find that the Mark was used for the Registered Goods, “promotional items, namely, mugs.” There is no information in the Burbridge Affidavit, however, about whether the glass on the right was sold or given away.

[55] The Burbridge Affidavit also describes exterior signage at NBCL’s locations, including the tap room at the Portland Street location, displaying the words NORTH BREWING CO., either horizontally or stacked (as depicted in row 8 of Annex “B” below). Exterior signage can function to provide necessary association between a trademark displayed on the sign and food prepared on premises (or brewed alcoholic beverages, I add, such as in the case of a brewery): *Lapointe*, above at para 28; *Goudreau, Gage, Dubuc & Martineau Walker v Cinnabon Inc*, (1997) 81 CPR (3d) 281 (TMOB) at para 6. In light of my earlier finding that the addition of COMPANY (or CO. as in these examples) is an inconsequential or minor addition, I find that these examples are evidence of NBCL’s use of the Mark during the Relevant Period.

[56] The Burbridge Affidavit additionally describes NBCL’s website from which customers can and did order brewed alcoholic beverages, namely beer, ale, lager. The archived pages of NBCL’s website depict signage similar to that discussed in the preceding paragraph (see row 6

of Annex “B” below). As well, Mr. Burbridge states that the top of each webpage showed the following during the Relevant Period, visible to each customer that ordered brewed alcoholic beverages, namely beer, ale, lager, from the website:



[57] I see no substantial difference between this variation of the Mark and that used on the mug discussed above. In both cases, the words NORTH BREWING appear prominently as the first or dominant element. I thus find the examples described above in paragraph 56 also support maintenance of the Registration for brewed alcoholic beverages, namely, beer, ale, lager, during the Relevant Period: *Kirby Eades Gale Baker v Endress+Hauser Group Services AG*, 2021 TMOB 284 at para 24.

[58] For similar reasons, I find that NBCL’s evidence showing use of NORTH BREWING CO. (or COMPANY), depicted with or without the partially filled and filled glasses of beer, on bottle openers, key chains and hats, during the Relevant Period, is sufficient to warrant maintenance of the Registration for such goods. My finding in this paragraph in respect of hats is based only on the logo used on the hat on the right in row 12 of Annex “B.” The logo on the hat on the left is discussed in the paragraphs below.

[59] I have reservations, however, about the logos such as the following depicted on cans for the brewed alcoholic beverages and invoices for the latter (that Mr. Burbridge states accompany the goods), beer glasses, shirts and some hats:



[60] In my view, these logos involve more than just the addition of a merely descriptive or minor element, such as the word COMPANY or CO, but rather they involve the creation of a composite mark with a significant design feature: *Likörfabrik v Registrar of Trade-Marks*, 1997 CanLII 4743 (FC). Further, as in the case of *Honeywell*, these logos would not result in a consumer being deceived or likely to be deceived regarding the origin of the goods associated with the logos.

[61] I find instead that the words NORTH BREWING *per se* are not being used as the dominant feature of a trademark; rather, they are subsumed in these logos, the dominant features of which are the word NORTH in an oval superimposed on a substantial stylized compass or star design. These logos are analogous in my view to the three graphics that this Court considered in *Universal Protein Supplements Corporation v H Young (Operations) Limited*, 2018 FC 1261 [*Universal Protein*], and concluded (at para 59) that the graphics left the impression that the registered trademark ANIMAL in design form had been amalgamated into a composite mark, and did not remain a dominant feature.

[62] Paraphrasing Justice Roy, similarly one does not know, and NBCL has provided no rationale as to, how the dominant feature of the Mark is preserved in the context of the above

logos. In my view, this is not a case, such as in *Brouillette & Associés v Constellation Brands US Operations, Inc*, 2016 TMOB 159, where “[b]y virtue of its size and contrasting colour, the Word Mark stands out from the surrounding word and design elements,” thereby maintaining a separate identity (para 14). I find this is particularly the case in respect of the middle logo depicted in paragraph 59, where the words BREWING and COMPANY are separated from the NORTH and compass/star design and shown in a different colour than the word NORTH. These logos are far busier, in my view, than the accepted logo depicted on the hat on the right in row 12 of Annex “B,” and what stands out in them and is their dominant element is the compass/star design with the superimposed word NORTH in an oval: *Universal Protein*, above at paras 58-59.

[63] One of the shirts shown in row 11 of Annex “B” displays a Unicorn logo (with the words NORTH BREWING COMPANY superimposed on a cloud beneath the unicorn design). In my view, this composite logo suffers from the same issues as described in paragraph 61 above, i.e. that the words NORTH BREWING are not the dominant feature of the logo.

[64] In addition to the black and white logo depicted on the right in paragraph 59 above, the invoices also show the words North Brewing Company in bold above NBCL’s address and phone number. In my view, this example falls squarely within the trade name usage described in *88766 Canada Inc v Phillips*, 2008 CarswellNat 2206 (TMOB) at para 19, as cited in *Hortilux Schreder BV v Iwasaki Electric Co Ltd*, 2011 FC 967 at para 62, aff’d 2012 FCA 321.

VI. Conclusion

[65] For the above reasons, I thus conclude that NBCL's evidence shows its use of the Mark in the normal course of trade with respect to brewed alcoholic beverages, namely, beer, ale, lager; and promotional items, namely, mugs, bottle openers, key chains, clothing, namely, hats during the Relevant Period. The Mark, therefore, is not "dead wood": *Hilton Worldwide*, above at para 9.

[66] As a result, this appeal is granted. The Registrar's Decision dated October 12, 2021 is set aside. The Registration will be maintained on the register with brewed alcoholic beverages, namely, beer, ale, lager; and promotional items, namely beer mugs, bottle openers, key chains, clothing, namely, hats. For clarity, the following specific goods will be deleted from the Registration: malt beverages, beer glasses, shirts, pants, and jackets.

JUDGMENT in T-1881-21

THIS COURT'S JUDGMENT is that:

1. The Applicant's appeal is granted in part.
2. The decision of the Registrar of Trademarks dated October 12, 2021 is set aside.
3. Registration No. TMA900498 for the trademark North Brewing is maintained for the following goods: (1) Brewed alcoholic beverages, namely, beer, ale, lager; (2) Promotional items, namely, mugs, bottle openers, key chains, clothing, namely, hats.
4. Registration No. TMA900498 is amended to delete the following specific goods: malt liquor, beer glasses, shirts, jackets, and pants.

"Janet M. Fuhrer"

Judge

Annex “A”: Relevant Provisions

Trademarks Act (R.S.C., 1985, c. T-13)
Loi sur les marques de commerce (L.R.C. (1985), ch. T-13)




<p>When deemed to be used</p> <p>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.</p>	<p>Quand une marque de commerce est réputée employée</p> <p>4 (1) Une marque de commerce est réputée employée en liaison avec des produits si, lors du transfert de la propriété ou de la possession de ces produits, dans la pratique normale du commerce, elle est apposée sur les produits mêmes ou sur les emballages dans lesquels ces produits sont distribués, ou si elle est, de toute autre manière, liée aux produits à tel point qu’avis de liaison est alors donné à la personne à qui la propriété ou possession est transférée.</p>
<p>Registrar may request evidence of use</p> <p>45 (1) After three years beginning on the day on which a trademark is registered, unless the Registrar sees good reason to the contrary, the Registrar shall, at the written request of any person who pays the prescribed fee — or may, on his or her own initiative — give notice to the registered owner of the trademark requiring the registered owner to furnish within three months an affidavit or a statutory declaration showing, with respect to all the goods or services specified in the registration or to those that may be specified in the notice, whether the trademark was in use in Canada at any time during the three-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date.</p> <p>...</p> <p>Effect of non-use</p>	<p>Le registraire peut exiger une preuve d’emploi</p> <p>45 (1) Après trois années à compter de la date d’enregistrement d’une marque de commerce, sur demande écrite présentée par une personne qui verse les droits prescrits, le registraire donne au propriétaire inscrit, à moins qu’il ne voie une raison valable à l’effet contraire, un avis lui enjoignant de fournir, dans les trois mois, un affidavit ou une déclaration solennelle indiquant, à l’égard de chacun des produits ou de chacun des services que spécifie l’enregistrement ou que l’avis peut spécifier, si la marque de commerce a été employée au Canada à un moment quelconque au cours des trois ans précédant la date de l’avis et, dans la négative, la date où elle a été ainsi employée en dernier et la raison pour laquelle elle ne l’a pas été depuis cette date. Il peut cependant, après trois années à compter de la date de l’enregistrement, donner l’avis de sa propre initiative.</p> <p>...</p> <p>Effet du non-usage</p>

<p>(3) Where, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence, it appears to the Registrar that a trademark, either with respect to all of the goods or services specified in the registration or with respect to any of those goods or services, was not used in Canada at any time during the three year period immediately preceding the date of the notice and that the absence of use has not been due to special circumstances that excuse the absence of use, the registration of the trademark is liable to be expunged or amended accordingly.</p> <p>Notice to owner</p> <p>(4) When the Registrar reaches a decision whether or not the registration of a trademark ought to be expunged or amended, he shall give notice of his decision with the reasons therefor to the registered owner of the trademark and to the person at whose request the notice referred to in subsection (1) was given.</p> <p>Action by Registrar</p> <p>(5) The Registrar shall act in accordance with his decision if no appeal therefrom is taken within the time limited by this Act or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.</p>	<p>(3) Lorsqu'il apparaît au registraire, en raison de la preuve qui lui est fournie ou du défaut de fournir une telle preuve, que la marque de commerce, soit à l'égard de la totalité des produits ou services spécifiés dans l'enregistrement, soit à l'égard de l'un de ces produits ou de l'un de ces services, n'a été employée au Canada à aucun moment au cours des trois ans précédant la date de l'avis et que le défaut d'emploi n'a pas été attribuable à des circonstances spéciales qui le justifient, l'enregistrement de cette marque de commerce est susceptible de radiation ou de modification en conséquence.</p> <p>Avis au propriétaire</p> <p>(4) Lorsque le registraire décide ou non de radier ou de modifier l'enregistrement de la marque de commerce, il notifie sa décision, avec les motifs pertinents, au propriétaire inscrit de la marque de commerce et à la personne à la demande de qui l'avis visé au paragraphe (1) a été donné.</p> <p>Mesures à prendre par le registraire</p> <p>(5) Le registraire agit en conformité avec sa décision si aucun appel n'en est interjeté dans le délai prévu par la présente loi ou, si un appel est interjeté, il agit en conformité avec le jugement définitif rendu dans cet appel.</p>
<p>Appeal</p> <p>56 (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.</p> <p>...</p> <p>Additional evidence</p> <p>(5) On an appeal under subsection (1), evidence in addition to that adduced before</p>	<p>Appel</p> <p>56 (1) Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l'avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit avant, soit après l'expiration des deux mois.</p> <p>...</p> <p>Preuve additionnelle</p> <p>(5) Lors de l'appel, il peut être apporté une preuve en plus de celle qui a été fournie</p>



the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.

devant le registraire, et le tribunal peut exercer toute discrétion dont le registraire est investi.


Annex “B”: Examples of Asserted Use of Mark

Examples	Registered Goods
<p>1.</p>  <p>(as depicted on a photograph of a can – Exhibit PB-7)</p>	<p>Brewed alcoholic beverages, namely, beer</p>
<p>2.</p>  <p>(as depicted on a photograph of a can – Exhibit PB-8)</p>	<p>Brewed alcoholic beverages, namely, ale</p>
<p>3.</p>  <p>(as depicted on a photograph of a can – Exhibit PB-9)</p>	<p>Brewed alcoholic beverages, namely, lager</p>

Examples	Registered Goods
<p>4.</p>  <p>(as depicted on a photograph of boxes of cans sold and shipped to the Nova Scotia Liquor Corporation – Exhibit PB-11)</p>	<p>Brewed alcoholic beverages, namely, ale</p>
<p>5.</p>  <p>(as depicted on photographs of beer glasses and mugs used by NBCL to serve customers at its physical locations – Exhibits PB-12, PB-12a)</p>	<p>Brewed alcoholic beverages, namely, beer, ale, lager</p>
<p>6.</p>  <p>(as depicted in archived website homepage snips on the Wayback Machine – Exhibit PB-14)</p>	<p>Brewed alcoholic beverages, namely, beer, ale, lager</p>

Examples	Registered Goods
<p>7.</p>  <p>(as depicted in the Burbridge Affidavit, para 66, and described as appearing at top of webpages and visible to customers when ordering brewed alcoholic beverages from the website)</p>	<p>Brewed alcoholic beverages, namely, beer, ale, lager</p>
<p>8.</p>  <p>(exterior signage at Portland Street and Ochterloney Street locations in Halifax, Nova Scotia as depicted in Exhibits PB-5 and PB-6)</p>	<p>Brewed alcoholic beverages, namely, beer, ale, lager</p>
<p>9.</p>  <p>(as depicted in Exhibit PB-17)</p>	<p>Promotional items, namely, bottle openers</p>

Examples	Registered Goods
<p>10.</p>  <p>(as depicted in Exhibit PB-18)</p>	<p>Promotional items, namely, key chains</p>
<p>11.</p>  <p>(as depicted in Exhibit PB-19)</p>	<p>Clothing, namely, shirts</p>

Examples	Registered Goods
<p data-bbox="203 268 246 300">12.</p>  <p data-bbox="548 743 938 779">(as depicted in Exhibit PB-20)</p>	<p data-bbox="1240 285 1406 352">Clothing, namely, hats</p>

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1881-21

STYLE OF CAUSE: NORTH BREWING COMPANY LTD. v DLA PIPER
(CANADA) LLP

**MOTION IN WRITING CONSIDERED AT OTTAWA, ONTARIO PURSUANT
TO RULE 369 OF THE *FEDERAL COURTS RULES***

JUDGMENT AND REASONS: FUHRER J.

DATED: AUGUST 31, 2023

APPEARANCES:

Bayo Odutola FOR THE APPELLANT
Julie Daet

Sangeetha Punniyamoorthy FOR THE RESPONDENT
Christina Mihalceanu

SOLICITORS OF RECORD:

Bayo Odutola FOR THE APPELLANT
Julie Daet
OLLIP P.C.
Ottawa, Ontario

DLA Piper (Canada) LLP FOR THE RESPONDENT
Toronto, Ontario