



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 201
Date of Decision: 2015-11-10

IN THE MATTER OF A SECTION 45 PROCEEDING

Barrette Legal Inc.	Requesting Party
and	
Casella Wines Pty Limited	Registered Owner
TMA651,779 for CASELLA	Registration

[1] At the request of Barrette Legal Inc. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 27, 2013 to Casella Wines Pty Limited (the Owner), the registered owner of registration No. TMA651,779 for the trade-mark CASELLA (the Mark).

[2] The Mark is registered for use in association with alcoholic beverages namely wines (the Goods).

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the Goods, at any time between November 27, 2010 and November 27, 2013 (the Relevant Period). If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of use with respect to goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc*, (1980) 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods and services specified in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Julian Raccanello. Only the Owner filed written representations. A hearing was held and attended by both parties.

The Owner's Evidence

[7] Mr. Raccanello is the Owner's Global Sales Support & South America Market Manager and has held this position for more than 9 years. He states that the Owner produces, exports, distributes and sells wines in over fifty countries, including Canada.

[8] Mr. Raccanello states that the Owner is the registered owner of the Mark, certificate of registration TMA651,779 in association with the Goods.

[9] As for the allegation of use of the Mark in Canada in association with the Goods, I reproduce paragraphs 6 and 7 of his affidavit:

6. During the Relevant Period, the Owner was using the [Mark] in the normal course of trade in Canada, in association with the [Goods]. When I refer to the normal course of trade, I refer to sales made by the Owner directly to various provincial liquor boards in Canada, such as the LCBO (Liquor Control Board of Ontario) who in turn sold the [Goods] to Canadian consumers in their various outlets in Canada. When I refer to use of the [Mark], I refer to the [Mark] as it appeared on the invoices for the [Goods] sold to the LCBO.

7. As illustrative examples of the use of the [Mark] in Canada during the Relevant Period, I attach hereto in bulk as Exhibit JR-1 in support of my affidavit, representative invoices for the Owner's [Goods], on which the [Mark] prominently appears. The invoices attached thereto as Exhibit JR-1 in support of my affidavit, accompanied the [Goods] sold to the LCBO during the Relevant Period.

Analysis of the evidence

[10] The sole issue to be determined in this case is whether the invoices filed as Exhibit JR-1 constitute proper evidence of use of the Mark in association with the Goods during the Relevant Period.

[11] As mentioned by the Requesting Party, the best evidence of use of a trade-mark in association with goods is the filing of labels, bearing the mark, that are attached to the goods at the time of their transfer, or the filing of a sample of the packaging of the goods bearing the mark. In the case of wines, the best evidence of use of a trade-mark would have been the filing of labels or pictures of an actual bottle of wine bearing the mark. Unfortunately, in our case, we do not have such evidence.

[12] However, this is not fatal for the Owner. Section 4(1) of the Act states that there are other manners in which notice of association between the goods and a trade-mark can be provided. One of them, considered by the case law, has been the appearance of a trade-mark on invoices under certain conditions. Through the affidavit of Mr. Raccanello the Owner is relying solely on the invoices attached to his affidavit as evidence of use of the Mark.

[13] Certain criteria need to be met in order for a trade-mark appearing on invoices to constitute use of that trade-mark in association with goods, such as :

- Prominence of the trade-mark and the manner in which it is displayed at the top of the invoice;
- The invoice accompanied the goods at the time of their transfer;
- The purchaser would clearly understand that the goods listed in the invoice were being sold in association with the mark appearing on the invoice;
- No other trade-mark appears on the invoice;

[see *Hortilux Schreder BV v Isawaki Electric Co. Ltd* 2011 FC 967].

[14] I do not consider this list to be exhaustive and that all of these criteria must be met. They serve, with perhaps others, as guidelines to determine if in fact there has been use of a trade-mark in association with goods within the meaning of section 4(1) of the Act [see *Cameron IP v Haldex AB*, 2015 FC 1000 (CanLII) at para 24].

[15] In order to understand the parties' arguments, I reproduce the top portion of one of the invoices filed:



TAX INVOICE

Casella Wines Pty Ltd
 P.O. Box 281
 Yenda NSW 2681
 A.B.N. 96 060 745 315
 Ph. (02) 6961 3000
 Fax. (02) 6961 3099

INVOICE NO: 30101203
 DATE: 06/12/10
 CUSTOMER: LCBO

BILL TO: Liquor Control Board of Ont.
 55 Lake Shore Blvd. E
 Toronto, M5E 1A4
 Canada

DELIVER TO:
 Durham Regional Warehouse
 2000 Boundary Road
 Whitby, Ontario L1N 7G4
 Canada

ORDER NO	119687.00	A.B.N.	
ORDER DATE	08/11/10	SALES REP	ANGUS MCPHERSON
REFERENCE	102-00075733	DESPATCH TYPE	CMA CGM ORCHID
CARTONS	1428	DESPATCH DATE	08/12/10

[16] The Requesting Party argues that it is not the Mark that appears on the invoices but rather CASELLA WINES and Crown design. I note that the generic word ‘wines’ is written in much smaller letters. Also, the crown design is smaller than the word CASELLA. I am of the opinion that the use of CASELLA WINES and Crown design constitutes use of the Mark [see *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA*, (1985) 4 CPR (3d) 523 (FCA)].

[17] The Requesting Party argues that the date of each invoice filed does not match the ‘despatch date’ identified on the invoices. Therefore, according to the Requesting Party, there is a contradiction between what appears on the invoices filed and the statement made by Mr. Raccanello that the invoices accompanied the Goods sold. There is no contradiction. The ‘despatch date’ appearing on the invoices is always subsequent to the ‘invoice date’. If it had been the opposite situation, then I would have been inclined to agree with the Requesting Party.

[18] The Requesting Party pleads that there is more than one trade-mark referred to on the invoices. This fact is not contested by the Owner. There is reference to the trade-mark Yellow Tail in the description of the goods sold. Consequently, according to the Requesting Party, one of the conditions listed in *Hortilux* has not been met and, therefore, the invoices filed cannot constitute evidence of use of the Mark in association with the Goods during the Relevant Period.

[19] The Owner replies that it is always possible for a trade-mark owner to use more than one trade-mark on goods. I do not think that this point is contested. Moreover, according to the Owner, the criteria listed above need not all be met.

[20] Finally, the Requesting Party is relying on the Registrar’s decision in *Moffat & Co v Conagra, Inc* (1994), 52 CPR (3d) 564, wherein it was ruled that the use of a trade-mark on the top of an invoice, without any reference to the trade-mark in the body of the invoice may constitute, at best, use of a trade-mark in association with services.

[21] In the present case, we have not only the trade-mark CASELLA WINES and Crown Design on the top left corner of the invoices, but also another trade-mark in the description of the goods in the body of the invoices. Therefore, even though the purchaser of the Goods is not the

end user (in this case the LCBO), and is an entity familiar with this type of goods, there is still reference to two different trade-marks. I am aware that two different trade-marks can appear on labels or packaging of goods.

[22] However, I distinguish a situation where two trade-marks appear on labels or packaging of goods and the present case. Here, there is a trade-mark (Yellow Tail) identifying the brand of wines sold by the Owner to LCBO. It is not clear from the invoices that the trade-mark CASELLA WINES and Crown Design is another trade-mark used in association with wines as opposed to a trade-mark used in association with the services of selling wines. Moreover, Mr. Raccanello does not state that the Mark is used as a house mark for the Goods in conjunction with other sub-brand marks of the Owner. Any ambiguities in the evidence filed by the Owner must be interpreted against it [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, (2010), 90 CPR (4th) 428], especially since the Owner could have filed labels or pictures of bottles bearing the Mark.

[23] I conclude that there is no evidence of use of the Mark in association with the Goods in Canada during the Relevant Period.

[24] I note that there is also no evidence of special circumstances justifying the non-use of the Mark in Canada during the Relevant Period, within the meaning of section 45(3) of the Act.

Disposition

[25] Pursuant to the authority delegated to me under section 63(3) of the Act, registration TMA651,779 will be expunged in compliance with the provisions of section 45 of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-10-22

Appearances

Stella Syrianos

For the Registered Owner

Bruno Barrette

For the Requesting Party

Agents of Record

Robic

For the Registered Owner

Barrette Legal Inc..

For the Requesting Party