



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

**Citation: 2016 TMOB 159**  
**Date of Decision: 2016-09-28**

**IN THE MATTER OF SECTION 45 PROCEEDINGS**

**Brouillette & Associés/Partners**

**Requesting Party**

**and**

**Constellation Brands U.S. Operations, Inc.**

**Registered Owner**

**TMA663,274 for REX-GOLIATH**  
**TMA679,429 for HRM REX-GOLIATH & DESIGN**

**Registrations**

[1] At the request of Brouillette & Associés/Partners (the Requesting Party), the Registrar of Trade-marks issued notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on September 23, 2014, to Constellation Brands U.S. Operations, Inc. (the Owner), the registered owner of registration No. TMA663,274 for the trade-mark REX-GOLIATH (the Word Mark) and registration No. TMA679,429 for the trade-mark HRM REX-GOLIATH & DESIGN, reproduced below (the Design Mark):



[2] Both trade-marks (the Marks) are registered for use in association with the goods “wines”.

[3] Section 45 of the Act requires the registered owner of a trade-mark to show whether the trade-mark has been 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 trade-mark 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 between September 23, 2011 and September 23, 2014.

[4] The relevant definition of “use” in association with 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 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*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 filed two substantially identical affidavits of Steven Bolliger, each sworn on December 19, 2014. Only the Owner filed written representations; an oral hearing was not requested.

#### The Owner’s Evidence

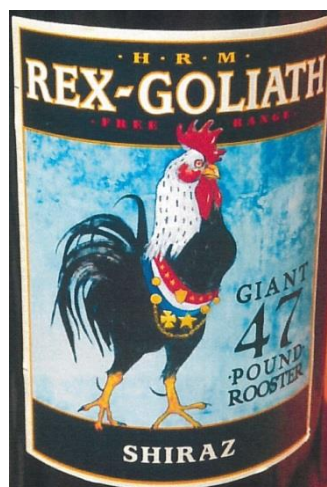
[7] In his affidavits, Mr. Bolliger identifies himself as Senior Vice-President, Marketing, at Constellation Brands, Canada Inc. (Constellation Canada). Mr. Bolliger explains that Constellation Canada manages and distributes all products manufactured by or for the Owner and sold in Canada, including wines sold in association with the Marks. He attests that the Owner has used the Marks in Canada in association with wines in the ordinary course of trade since at least as early as May 2002 and, in particular, during the relevant period. He specifies that

the Owner “prominently displayed” the Marks on wine distributed in Canada through Constellation Canada and sold to Canadian consumers.

[8] Mr. Bolliger attests that, outside Quebec, alcoholic beverages are generally sold in Canada at retail outlets operated by provincial liquor control boards. At paragraph 10 of his affidavits, Mr. Bolliger provides combined sales figures for Nova Scotia together with Newfoundland and Labrador, covering each of the fiscal years ending during the relevant period. Specifically, Mr. Bolliger states that net sales of wine in association with the Marks in those provinces exceeded \$2,500 in fiscal 2012, \$1,450 in fiscal 2013 and \$1,350 in fiscal 2014.

[9] In support of his assertion of use of the Marks, Mr. Bolliger attaches the following exhibits to his affidavits:

- Exhibit B consists of 19 “representative” invoices, some with corresponding purchase orders, for wines sold in Canada to various provincial liquor control boards. Thirteen of the invoices are dated within the relevant period. Those invoices list various products, including “Rex Goliath Shiraz” and “Rex Goliath Pinot Grigio”, in various quantities.
- Exhibit C consists of seven photographs showing bottles of shiraz. Mr. Bolliger attests that these photographs are representative of the bottles of wine sold in Canada during the relevant period. Indeed, some of the photographs show the bottles on store shelves. The bottles feature a large label on which appears a variation of the Design Mark, reproduced below (the Label Design):



- Exhibit D consists of two photographs, showing the front and back of a bottle of shiraz. Mr. Bolliger attests that these photographs are also representative of the wine sold in Canada during the relevant period. The label on the front of the bottle is the same as the large label shown at Exhibit C. The label on the back of the bottle contains product information, including a section on the origin of the brand, under the heading “THE LEGEND OF REX-GOLIATH”. The back label also indicates that the wine is vinted and bottled by HRM Rex-Goliath Winery, which Mr. Bolliger attests is a trade name of the Owner. The website address displayed on the label is *www.rexgoliath.com*.

#### Analysis - Transfers in the Normal Course of Trade

[10] With respect to transfers of the registered goods in the normal course of trade, the evidenced invoices and sales figures clearly show sales of “Rex-Goliath” wine by the Owner to provincial liquor control boards during the relevant period. As noted above, Mr. Bolliger attests that sale of wine to provincial liquor control boards is the Owner’s normal course of trade.

[11] The key issue in this case is whether such transfers of wines were in association with the Marks as registered.

#### Display of the Word Mark

[12] As evidence of the manner in which the Marks were displayed on the registered goods at the time of transfer, Mr. Bolliger provides representative photographs of the Owner’s wine bottles sold in Canada during the relevant period. As shown above, the exhibited Label Design incorporates the Word Mark with additional word and design elements.

[13] Generally, use of a word mark in combination with additional words or design features qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. The issue is a question of fact, dependent upon such factors as whether the word mark stands out from the additional material, for example, by the use of different lettering or sizing, or whether the additional material would be perceived as purely descriptive matter or as a separate trade

mark or trade name [see *Nightingale, supra*; and *Canadian Council of Professional Engineers v Ing Loro Piana & C SPA*, 2009 FC 1096, 2009 CarswellNat 3400]. Moreover, a registration for a word mark can be supported by use of that mark in any stylized form and in any colour [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)].

[14] In the present case, I am satisfied that the Word Mark maintains a separate identity within the Label Design. The Word Mark appears in large white letters against the label's black background, whereas the nearest word elements, namely HRM and FREE RANGE, appear in smaller, coloured lettering. By virtue of its size and contrasting colour, the Word Mark stands out from the surrounding word and design elements.

[15] Furthermore, I note that the Word Mark also appears within the product listings of the exhibited invoices. The evidence is not clear as to whether such invoices accompanied the goods at the time of transfer. Nonetheless, an invoice can provide context informing the Registrar as to what consumers would recognize to be a trade-mark [see, for example, *Method Law Professional Corp v Black & Decker Corp*, 2015 TMOB 226, 2015 CarswellNat 8204]. In the present case, the appearance of REX-GOLIATH on its own within the invoiced product listings supports the conclusion that consumers, as a matter of first impression, would perceive REX-GOLIATH as a trade-mark in itself. Similarly, display of the Word Mark in the text and as part of the Internet address on the wine bottles' back label reinforces the impression that REX-GOLIATH stands on its own.

[16] Accordingly, I am satisfied that the evidenced use of the Label Design on wine bottles sold in Canada constitutes use of the Word Mark *per se*.

#### Display of the Design Mark

[17] In considering whether display of the Label Design also constitutes display of the Design Mark, the question to be asked is whether the trade-mark was used in such a way that it 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 [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the "dominant features" of the mark have been

preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. As expressed in *Promafil*:

The law of trademarks does not require the maintaining of absolute identity of marks in order to avoid abandonment, nor does it look to miniscule differences to catch out a registered trademark owner acting in good faith and in response to fashion and other trends. It demands only such identity as maintains recognizability and avoids confusion on the part of unaware purchasers. [at paragraph 40]

[18] In its written representations, the Owner submits that the dominant elements of the Design Mark are the words HRM REX-GOLIATH and the rooster design, which “remain prominently on the labels”. I agree with the Owner’s characterization of the Design Mark’s dominant features.

[19] I also agree with the Owner that the changes to the font, layout and punctuation are minor deviations from the Design Mark as registered. The “modernization” of those stylistic elements does not change the aforementioned dominant features. Furthermore, although additional word and design elements appear in the Label Design, I do not consider those elements to alter the mark’s identity. First, the word SHIRAZ is descriptive of the product. Second, the words FREE RANGE and GIANT 47 POUND ROOSTER relate to and, in my view, reinforce the rooster design as a dominant feature of the mark. Third, the colour scheme is immaterial, as it is well established that registration of a trade-mark in black and white covers use of that mark in any combination of colours. Finally, the background and box outline do not provide sufficient visual interest to constitute substantial differences.

[20] Accordingly, I find that the dominant features of the trade-mark as registered, namely the words HRM REX-GOLIATH and the particular rooster design, have been maintained and that the additional word and design elements are minor variations. In short, the registered Design Mark remains recognizable in the Label Design.

[21] Therefore, I accept that the evidenced use of the exhibited Label Design constitutes use of the Design Mark as registered.

**Disposition**

[22] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Marks in association with the registered goods within the meaning of sections 4(1) and 45 of the Act.

[23] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, both registrations will be maintained.

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Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** No Hearing Held

**AGENTS OF RECORD**

Goodmans LLP

For the Registered Owner

Brouillette & Associés/Partners

For the Requesting Party