



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

Citation: 2015 TMOB 206
Date of Decision: 2015-11-23

IN THE MATTER OF A SECTION 45 PROCEEDING

Barrette Legal Inc.	Requesting Party
and	
Casella Wines Pty Limited	Registered Owner
TMA718,239 for [yellow tail] bubbles	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 25, 2013 to Casella Wines Pty Limited (the Owner), the registered owner of registration No. TMA718,239 for the trade-mark:

[yellow tail] bubbles (the Mark)

[2] The Mark is registered for use in association with: wine, sparkling wine (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 25, 2010 and November 25, 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 American Market Manager and has held that position for more than 9 years. He states that the Owner produces, exports, distributes and sells wines in over fifty countries, including Canada.

[8] As for the allegation of use of the Mark in Canada in association with the Goods, I can summarize Mr. Raccanello's statements in the following terms:

- During the Relevant Period, the Owner sold Goods in association with the Mark in the normal course of trade, i.e. to various provincial liquor boards in Canada such as the

Liquor Control Board of Ontario (LCBO), who in turn sold the Goods to Canadian consumers in their various outlets in Canada;

- The Mark appears directly on the Goods or on the packaging in which the Goods are sold in Canada;
- Exhibit JR-1 to his affidavit are photos of the packaging of the Goods shipped to Canada and of a bottle of the Goods contained in the said packaging, illustrative of the Mark as it was displayed on the packaging in which the Goods were sold in Canada by the Owner during the Relevant Period. (I note that the trade-mark displayed on the packaging and the bottle is [yellow tail]® bubbles);
- Exhibit JR-2 are representative invoices evidencing sales by the Owner to the LCBO of the Goods bearing the Mark during the Relevant Period;
- The Owner sold during the Relevant Period no less than 63,500 cases (12x750ml) of Goods bearing the Mark in Canada.

Analysis of the evidence

[9] The Requesting Party is raising three issues:

- Exhibit JR-1 consists of photos of packaging of the Goods and of a bottle. Mr. Raccanello is stating that they are ‘illustrative’ of the Mark. Consequently, according to the Requesting Party, there is no evidence of the labels used in Canada during the Relevant Period.
- The symbol ® appears on the packaging and the bottle photographed and filed as exhibit JR-1 after [yellow tail] and thus the Owner considers the mark used to be [yellow tail] and not the Mark.
- The invoices filed refer to the trade-mark yellow tail and not the Mark.

[10] Mr. Raccanello refers to exhibit JR-1 in the following terms in paragraph 8 of his affidavit:

(...) I confirm that these images are illustrative of the [Mark] as it was displayed on the packaging in which the [Goods] were sold by the [Owner] directly to various liquor boards in Canada during the Relevant Period.

[11] *The Canadian Oxford Dictionary* defines ‘illustrative’ as: ‘serving as an explanation or example’. Clearly, these photos serve as example to show how the Mark was used on the Goods in Canada during the Relevant Period.

[12] As for the appearance and location of the symbol ®, I make mine the following comments of the Registrar in *Aramark Canada Ltd v 637870 Ontario Ltd* 2002CanLII 61286 (CA TMOB), (2002), 22 CPR (4th) 409, wherein the registered trade mark was BUBI’S AWESOME EATS and the trade-mark used was BUBI’S ® AWESOME EATS:

Concerning the placement of the ® indicia in association with the trade-mark, in my view it does not negate the fact that the trade-mark BUBI’S AWESOME EATS is also being used it merely provides the message that BUBI’S is also a trade-mark on its own.

[13] In the present case, the Owner provides the message that [yellow tail] is also a trade-mark of its own.

[14] As for the reference to ‘yellow tail’ in the invoices and not the Mark, again the filing of the invoices must be viewed in the context of the allegations concerning these invoices. Mr. Raccanello states in paragraph 9 of his affidavit that they were filed to evidence sales by the Owner to the LCBO of the Goods bearing the Mark during the Relevant Period. They were not filed as evidence of use of the Mark wherein the Mark would appear on the invoices. They were filed merely to evidence the transfer of property of the Goods bearing the Mark, during the Relevant Period, from the Owner to LCBO.

[15] At the hearing, I questioned the Owner on the fact that exhibit JR-1 refers to ‘sparkling wine’ and that there is no photo or evidence of use of the Mark in association with ‘wine’. The Owner argued that ‘sparkling wine’ is inclusive of ‘wine’. Consequently, there would be evidence of use of the Mark in association with each of the Goods.

[16] In *Stikeman Elliott LLP v Parmx Cheese Co. Ltd*, 2015 TMOB 102 (CanLII) my colleague Andrew Bene had to deal with a similar issue and disposed of it in the following terms:

Given that the Owner made a distinction in its statement of goods, the Owner is required to provide evidence of use of the Mark for each of these goods [in this respect, see *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228

(FCA), *Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 1997 CanLII 16206 (FC), 72 CPR (3d) 195 (FCTD) and *Fogler, Rubinoff LLP v Canada Safeway Ltd*, 2013 TMOB 227 (CanLII) at para 10]. Similar to these cases, for the Owner to maintain its registration for the broader categories of goods “milk products” and “dairy products”, it had to show use in association with such goods otherwise than by reference to “processed cheese”, “unprocessed cheese” or “non standardised cheese products”.

[17] Similarly, if the Owner decided to register the Mark in association with sparkling wine and wine, it had to show use of the Mark in association with each of those goods.

Conclusion

[18] In all, I conclude that the Owner has discharged its burden to prove that it has used the Mark in Canada, within the meaning of section 4(1) of the Act, in association with sparkling wine during the Relevant Period. The Owner has not provided any evidence of use of the Mark in Canada during the Relevant Period in association with wine, nor has it filed any evidence of special circumstances within the meaning of section 45(3) of the Act justifying the non-use of the Mark in association with those goods. The registration will be amended accordingly.

Disposition

[19] Pursuant to the authority delegated to me under section 63(3) of the Act, registration TMA718,239 will be amended to delete the following goods: ‘wine’ in compliance with the provisions of section 45 of the Act.

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

Hearing Date: 2015-11-12

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