



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

Citation: 2016 TMOB 128
Date of Decision: 2016-07-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Gowling Lafleur Henderson LLP

Requesting Party

and

Banks DIH Ltd.

Registered Owner

TMA390,325 for BANKS

Registration

[1] At the request of Gowling Lafleur Henderson LLP (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 July 17, 2014 to Banks DIH Ltd. (the Owner), the registered owner of registration No. TMA390,325 for the trade-mark BANKS (the Mark).

[2] The Mark is registered for use in association with the goods “Beer, ale and lager”.

[3] Section 45 of the Act requires the registered owner of the 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 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 between July 17, 2011 and July 17, 2014.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act:

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 specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Deonarain Seepaul, Assistant Company Secretary of the Owner, sworn on February 16, 2015 in Georgetown, Guyana. Both parties filed written representations; an oral hearing was not requested.

The Owner's Evidence

[7] In his affidavit, Mr. Seepaul attests that the Owner and Banks Breweries Ltd. (Banks) processes and manufactures beverage products, such as beer, ale, and lager, for sale in Canada.

[8] Mr. Seepaul explains that the Owner and Banks are related entities and that Banks is licensed to use the Mark in Canada. He attests that the Owner and Banks formed a joint venture, Beverage Caribbean Inc., to export beverage products labelled with the Mark into Canada. Mr. Seepaul confirms that such beverage products are exported into Canada "under the care and control" of the Owner.

[9] In particular, Mr. Seepaul attests that the Owner's beverage products are distributed in Ontario through the Liquor Control Board of Ontario (LCBO), which subsequently sells such products to consumers at LCBO retail locations.

[10] Mr. Seepaul identifies three examples of the Owner's beverage products, namely: BANKS Caribbean Lager, BANKS Shandy, and BANKS Malta. He states that sales in Canada over the course of the relevant period were: \$26,982 in 2010-2011; \$65,880 in 2011-2012; and \$65,988 in 2012-2013. However, he confirms that only BANKS Caribbean Lager was sold in Canada during the relevant period.

[11] Mr. Seepaul states that, during the relevant period, the Owner spent approximately \$83,376 advertising its beverage products in Canada through website advertising and promotional campaigns. For example, he attests that the Owner promoted its beverage products at the 2011, 2012 and 2013 Toronto Beer Festivals.

[12] In support, Mr. Seepaul attaches to his affidavit the following exhibits:

- Exhibit B1 is a photograph of a bottle of "BANKS Caribbean Lager" that Mr. Seepaul states is representative of the labelling on the Owner's beverage products. The Mark is clearly displayed on the bottle.
- Exhibit B2 consists of screenshots from the LCBO website, showing a bottle of BANKS Caribbean Lager. Again, the Mark is clearly displayed on the bottle.
- Exhibit C consists of screenshots from the Owner's website, *banksdih.com*, advertising various alcohol products, including BANKS Caribbean Lager. The Mark is clearly displayed on the depicted bottle. Mr. Seepaul attests that this website was accessible to Canadians throughout the relevant period.
- Exhibit D consists of screenshots from *ca.banksbeer.com*, the Canadian website of the Owner's licensee, Banks. Again, bottles of BANKS Caribbean Lager are shown on the website. Mr. Seepaul attests that several photographs in the screenshots, showing bottles of BANKS Caribbean Lager, are from the 2013 Toronto Beer Festival.
- Exhibit E1 is a photograph of an LCBO store showing bottles of BANKS Caribbean Lager, which Mr. Seepaul attests were available at LCBO stores during the relevant period.

- Exhibit E2 is a copy of a product flyer showing a bottle of BANKS Caribbean Lager. Mr. Seepaul attests that this flyer was available to Canadian customers in 2011.
- Exhibit F consists of three invoices that Mr. Seepaul attests are representative of sales of the Owner’s beverage products. The invoices show bulk sales from Beverages Caribbean Inc. to the LCBO, all dated within the relevant period. The only product listed on the invoices is “CANADA BANKS BEER 330ML GLASS 4x6-PACK”.

Analysis

[13] In its written representations, the Requesting Party submits that the evidence is only sufficient to maintain the registered goods “lager”.

[14] Indeed, the evidence only demonstrates the sale of one product in Canada. In this regard, while the exhibited invoices list this product as “CANADA BANKS BEER”, Mr. Seepaul clearly states that the Owner only sold BANKS Caribbean Lager in Canada during the relevant period. Furthermore, in all of the supporting exhibits (such as the photographs, screenshots and flyer), the product is clearly identified and labelled as a “lager”. As such, I accept that “lager” is the ordinary commercial term of the product in question and that the exhibited invoices show sales of the depicted BANKS Caribbean Lager.

[15] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “lager” within the meaning of sections 4 and 45 of the Act.

[16] With respect to “beer” and “ale”, the Owner nevertheless submits that the terms “beer”, “lager” and “ale” are interchangeable and therefore the registration should be maintained in its entirety.

[17] In support, the Owner cites *Sim & McBurney v Hugo Boss AG* (1996), 67 CPR (3d) 269 (TMOB). However, that decision turned on whether the registered good “jogging type shoes” should be interpreted broadly to include “tennis shoes”. As such, I do not find that it supports the Owner’s position that evidence with respect to one good can be used to maintain three separate registered goods.

[18] Here, the issue is not whether the evidenced “lager” product falls within the scope of “beer” or even “ale”. The issue here is that, having distinguished “beer” and “ale” from “lager” in its registration, the Owner is obligated to provide some evidence with respect to each of the listed goods accordingly [per *John Labatt Ltd v Rainer Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)]. However, as noted above, the only product shown in the evidence is “BANKS Caribbean Lager” and Mr. Seepaul clearly states in his affidavit that only this lager product was sold in Canada during the relevant period.

[19] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “beer” and “ale” within the meaning of sections 4 and 45 of the Act. Furthermore, the Owner has provided no evidence of special circumstances excusing the absence of use of the Mark.

Disposition

[20] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete “beer” and “ale” from the statement of goods.

[21] The amended statement of goods will read as follows: “Lager”.

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**

No Hearing Held

AGENTS OF RECORD

Fasken Martineau Dumoulin LLP

For the Registered Owner

Gowlings WLG (Canada) LLP

For the Requesting Party