



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

**Citation: 2017 TMOB 74**

**Date of Decision: 2017-06-23**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Global Tobacco, LLC**

**Requesting Party**

**and**

**Rothmans, Benson & Hedges Inc.**

**Registered Owner**

**TMA112,833 for CLASSIC**

**Registration**

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA112,833 for the trade-mark CLASSIC (the Mark), owned by Rothmans, Benson & Hedges Inc. (the Owner).

[2] The Mark is registered for use in association with cigarettes.

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

THE PROCEEDING

[4] On July 29, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to the Owner. The notice was sent at the request of Global Tobacco, LLC (the Requesting Party).

[5] The section 45 notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between July 29, 2012 and July 29, 2015 (the Relevant Period), in association with the registered goods. 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.

[6] 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.

[7] 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. The criteria for establishing use are not demanding and an overabundance of evidence is unnecessary. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the goods or services specified in the registration at any time during the relevant period [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use of the trade-mark [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 53 CPR (2d) 62 (FCA)].

[8] Accordingly, in response to the Registrar’s notice, the Owner filed the affidavit of Kenneth Morrison, sworn on October 27, 2015 with references to Exhibits A and B.

[9] Only the Owner filed written representations and was present at a hearing

## THE OWNER'S EVIDENCE

[10] In his affidavit, Mr. Morrison identifies himself as the Owner's Director Commercial Deployment. In this position, he is responsible for sales and distribution of the Owner's manufactured tobacco products. He has held this position since April 2014 and has been employed by the Owner in other capacities since May 1985. He states that based on his personal experience and his review of the Owner's records he has personal knowledge of the facts set out in his affidavit.

[11] Mr. Morrison states that the Owner manufactures and sells tobacco products, including cigarettes, to wholesalers across Canada who, in turn, sell them to retailers across Canada, who in turn, sell these products to consumers through their retail stores in Canada. He adds that in some instances, the Owner sells its tobacco products directly to retailers in Canada.

[12] Mr. Morrison states that the Owner typically sells and distributes cigarettes to its wholesalers or retailer customers in cartons that, in the case of cigarettes in association with the Mark, contain 10 packages, with each package containing 20 cigarettes (200 cigarettes per carton). He adds that on occasion the Owner may also sell individual packages to its wholesale or retail customers when the amount requested is something less than a carton.

[13] Mr. Morrison attaches to his affidavit images of the front and the back of a cigarette package used over the Relevant Period which bears the Mark on the side of the packaging. Mr. Morrison adds that the business name Rock City Tobacco Company, appearing on the packaging, is a registered business name of the Owner.

[14] Mr. Morrison provides in paragraph 9 of his affidavit the details of the monthly sales by the Owner of cigarettes sold in Canada by the Owner in association with the Mark from August 2012 to July 2015, in terms of cartons sold, packages sold and the total number of cigarettes sold.

[15] Mr. Morrison attaches as Exhibit B to his affidavit sample invoices dated from August 2012 to August 2015 showing sales of cigarettes by the Owner in packaging displaying the Mark as shown in Exhibit A. He states that the mentions "Classic Smooth Regular 20" on the

English invoices and “Classique Exquise Regulier 20” on the French invoices refer to cigarettes sold in association with the Mark in Canada in packaging depicted in Exhibit A.

ANALYSIS OF THE OWNER’S EVIDENCE

[16] In the absence of representations from the Requesting Party either in writing or at a hearing, and given the evidence described above, I am satisfied that the Owner has established use of the Mark in association with the Goods in Canada in the normal course of trade during the Relevant Period within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[17] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration TMA112,833 is maintained on the register.

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Jean Carrière,  
Member  
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:** June 15, 2017

**APPEARANCES**

Kelly Gill FOR THE REGISTERED OWNER

No one appearing FOR THE REQUESTING PARTY

**AGENTS OF RECORD**

Gowling WLG FOR THE REGISTERED OWNER

Ridout & Maybee LLP FOR THE REQUESTING PARTY