



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 39

Date of Decision: 2020-04-08

IN THE MATTER OF A SECTION 45 PROCEEDING

John H. Simpson (Shift Law)

Requesting Party

and

Imperial Tobacco Products Limited

Registered Owner

TMA427,462 for CANADIAN GOLD

Registration

[1] At the request of John H. Simpson (Shift Law) (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on February 16, 2018 to Imperial Tobacco Products Limited (the Owner), the registered owner of registration No. TMA427,462 for the trademark CANADIAN GOLD (the Mark).

[2] The Mark is registered in association with the goods “Smoking tobacco, cigarettes and cigarette papers”.

[3] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between February 16, 2015 and February 16, 2018, in association with the goods specified in the registration. If the Mark had not been so used, the Owner was required to

furnish evidence providing the date when the Mark was last in use 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 of the Act as follows:

4(1) A trademark 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 trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) [*John Labatt*]].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Nada Aoude, sworn May 14, 2018 in Montreal, Quebec.

[7] Only the Owner submitted written representations; an oral hearing was not requested.

THE OWNER'S EVIDENCE

[8] In her affidavit, Ms. Aoude identifies herself as a manager with Imperial Tobacco Canada Limited (ITCan) [para 1].

[9] Ms. Aoude explains that the Owner is a wholly-owned subsidiary of ITCan and that a license agreement exists and did exist during the relevant period such that the Owner had direct control over the quality and character of goods sold in association with the Mark by ITCan during the relevant period [para 2].

[10] Ms. Aoude states that, during the relevant period, ITCan sold CANADIAN GOLD-brand cigarettes in Canada through cigarette retailers such as grocery stores, convenience stores, bars and gas stations, as well as through ITCan's distributor, Imperial Tobacco Company Limited [para 4]. As will be discussed further below, Ms. Aoude asserts that "Cigarettes are themselves comprised of smoking tobacco and cigarette paper" [para 3].

[11] Attached as Exhibit A to the affidavit are six photographs of "cigarettes king size" packaging, which Ms. Aoude attests is representative of the "1700 packages of the CANADIAN GOLD cigarettes" sold in Canada in 2017, during the relevant period. Indeed, the Mark is displayed in stylized fonts on the front, back, top and bottom sides of the packaging shown.

[12] Further, attached as Exhibit B to the affidavit are five sample invoices showing sales of "Canadian Gold" products to Canadian retailers during the relevant period. Ms. Aoude confirms that the invoiced products were cigarettes in packaging bearing the Mark, as shown in Exhibit A [para 6].

ANALYSIS

[13] In its written representations, *inter alia*, the Owner submits that the evidenced sales of CANADIAN GOLD cigarettes is sufficient to establish use of the Mark in association with *each* of the registered goods, including "smoking tobacco" and "cigarette papers".

[14] In this respect, the Owner submits that "smoking tobacco and cigarette paper are components of the CANADIAN GOLD cigarettes, which are sold together in the same package". In support, it cites *Ogilvy Renault LLP/SENCRL v Mephisto Inc*, 2012 TMOB 58, which dealt with the sale of "shoes" and "soles for footwear", sold together [*Mephisto*, para 9].

[15] However, in my view, at best *Mephisto* turned on its particular facts. First, it is trite law that each case must be decided based on its own merits [see *Express File Inc v HRB Royalty Inc*, 2005 FC 542, 39 CPR (4th) 59]. Second, while the Registrar in *Mephisto* referred to the soles as "component" parts of the shoes sold, this was in the context of considering whether a consumer would associate the subject trademark displayed on the soles as also being associated with the shoes. Notably, the soles at issue were removable [para 8]. As such, that decision can be understood as a question of whether a trademark can be associated with two goods sold together,

rather than whether use of a trademark in association with a good can also support use in association with the component parts of that good.

[16] Here, the exhibited product packaging clearly identifies the goods as “cigarettes”; there is no doubt that the Owner (through its licensee) only sold “cigarettes” in association with the Mark during the relevant period. To the extent the Owner sold the component “smoking tobacco” and “cigarette papers”, the evidence shows it was only through the sale of such “cigarettes”. Generally, use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration; having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [per *John Labatt, supra*]. For the Owner to maintain its registration for the goods “smoking tobacco” and “cigarette papers”, it had to show transfer and sales of such goods otherwise than by reference to “cigarettes”.

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

[18] As there is no evidence of special circumstances excusing non-use of the Mark before me, the registration will be amended accordingly.

DISPOSITION

[19] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the goods “smoking tobacco ... and cigarette papers”. The amended statement of goods will be: “Cigarettes”.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No Hearing Held

AGENTS OF RECORD

Smart & Biggar LLP

For the Registered Owner

John H. Simpson (Shift Law Professional Corporation)

For the Requesting Party