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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 207**

**Date of Decision: 2021-09-21**

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

**BCF LLP**

**Requesting Party**

**and**

**Oliver Twist Estate Winery**

**Registered Owner**

**TMA947,157 for NOSTALGIA**

**Registration**

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA947,157 for the trademark NOSTALGIA (the Mark), currently owned by Oliver Twist Estate Winery.

[2] All references are to the Act as amended June 17, 2019 (the Act), unless otherwise noted.

[3] The Mark is registered for use in association with the following goods: “wine”.

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

#### THE PROCEEDINGS

[5] At the request of BCF LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on September 5, 2019, to Oliver Twist Estate Winery (the Owner), the registered owner of the Mark.

[6] The notice required the Owner to show whether the trademark 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 September 5, 2016 to September 5, 2019 (the Relevant Period).

[7] The relevant definition of use in the present case is set out in section 4(1) 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.

[8] 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 evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[9] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[10] In response to the Registrar's notice, the Owner furnished an affidavit of Gina Fernandes Harfman, sworn on October 17, 2019, to which were attached Exhibits "A", "B" and "C".

[11] Both parties submitted written representations. No oral hearing was held.

#### THE EVIDENCE

[12] The affidavit was filed by Ms. Gina Fernandes Harfman, who describes herself as a Director of Oliver Twist Estate Winery Inc.

[13] The affiant states that the Owner has sold wine in association with the Mark from 2013 up to 2018. The company produces and sells two different series of wines including the NOSTALGIA series.

[14] In support, the following relevant exhibits are attached:

- Exhibit "A" consists of 17 pages of 'bottle shots'; full-colour photos of the bottles of different wines, all bearing the Mark, including photos of the same product from different vintage years. The names of the separate wines included in the series bearing the Mark include *Rockabilly Red*, *Boogie Woogie White*, *Pink Cadillac*, *Chantilly Lace*, *The Girls Red*, *The Girls Rosé*, *The Girls White* and *Cherry Baby*.
- Exhibit "B" consists of 29 pages of detailed inventory and sales reports. The list individually details the eight wine labels in the collection in association with the Mark, with the vintage, date of sale, to whom the sale was made, including sales over the counter at the Owner's and to the Alberta Gaming and Liquor Board, the quantity sold and with the total sales per vintage shown at the bottom of the end page of that vintage. All of these inventory items bear the subject Mark.

- Exhibit “C” consists of four pages of actual colour photos of the labels, front and back for seven of the eight wines bearing the Mark.

#### ANALYSIS AND REASONS FOR DECISION

##### Normal course of trade

[15] The Inventory Quick Report refers to sales made in Canada, for example to the Overwaites Food Group in various BC locations including Kamloops, Langley and Prince George, as well as the Alberta Liquor and Gaming Board and the Winnipeg Liquor Store.

##### Use of trade name or trademark

[16] The Requesting Party refers to the interpretation of the term ‘trademark’ citing section 2 of the Act, but does not continue to then include the definition of ‘trade name’ or the term ‘use’ as is included below:

***Trademark*** means

- (a) a sign or combination of signs that is used or proposed to be used by a person for the purpose of distinguishing or so as to distinguish their goods or services from those of others, or
- (b) a certification mark

***trade name*** means the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual;

***use***, in relation to a trademark, means any use that by section 4 is deemed to be a use in association with the goods or services;

[17] The Requesting Party submits the labels in Exhibit “C” to the Affidavit include the word NOSTALGIA in conjunction with the words BY OLIVER TWIST ESTATE WINERY, and of particular note; on the back label, are then followed below by the address of the Registrant. It

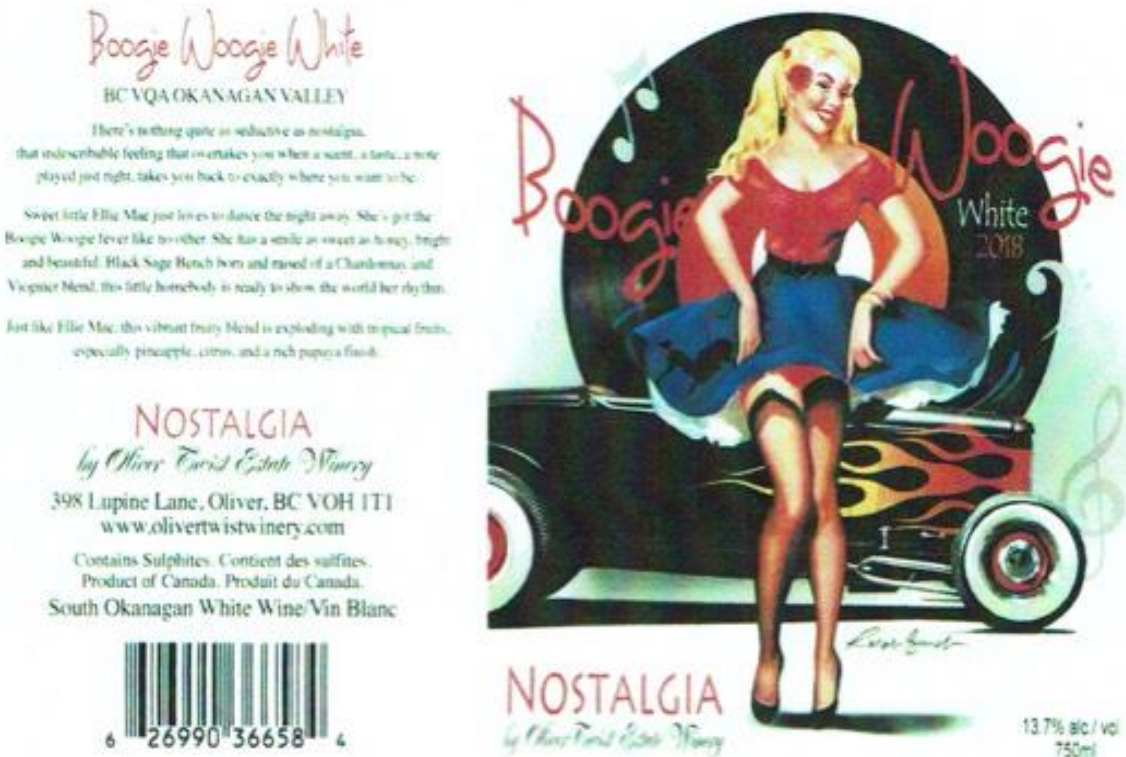
submits this display of the Mark in conjunction with the company name amounts to the use of the Mark as a trade name, not as a trademark.

[18] The Requesting Party also posits that the Registrant is using instead, the names of the eight separate labels; *Rockabilly Red*, *Boogie Woogie White*, *Pink Cadillac*, *Chantilly Lace*, *The Girls Red*, *The Girls Rosé*, *The Girls White* and *Cherry Baby* as trademarks for the purpose of distinguishing its goods from those of others.

[19] As stated in *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 98 (TMOB), “trade-mark and trade-name usage are not necessarily mutually exclusive” [at para 14]. The question is whether the registered owner has shown use of its trademark in such a way that it is identifiable as a trademark and not merely as a corporate name or corporate identifier. Relevant factors to consider include whether the trademark stands apart from the corporate address and other corporate identifier information to the extent that the public would perceive such use as a trademark and not merely as identification of a legal entity [see *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD) at para 16; *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) at para 7].

[20] The Registrant has provided in Exhibit “C”, photos of the front and back labels for seven of the eight wines produced under the Mark ‘NOSTALGIA’. In all of the pictures, the prominent features include the name of the particular wine, i.e., ‘Rockabilly Red’ or ‘Boogie Woogie White’, the year of the wine’s release as well as the Mark and the name of the winery.

[21] I reproduced below one of the labels attached as Exhibit C:



One can see that on the front label, shown on the right side of the image, the artwork is prominent in full colour and the particular wine ‘Boogie Woogie White’ and the year of the release is included in the illustration. Below and to the left is the Mark ‘NOSTALGIA’ in an upper-case non-script font style, coloured in red. Below that, in a dark green, smaller, lower case and scripted font, lie the words ‘by Oliver Twist Estate Winery’; quite distinct and less noticeable than the Mark. On the left side of the image, one can see the back label including again in a larger, distinct and red-coloured text, the name of the wine and the Mark. Also, again, on the back label one can see, in a dark green, smaller, lower case and scripted font style, the name and address of the winery, whereas the Mark appears in an upper-case non-script font style, coloured in red.

[22] Regarding the inclusion of the name of the winery in proximity of the Mark itself, one can see in Exhibits “A” and “C”, that in four of the eight products, the text for the company

name is in a different colour than the Mark. In the other 4 products, the coloring is not different but the font style and sizing are consistent with the above image. The Mark and the text including the name of the winery are consistently distinct from one another in all of the eight products.

[23] There is nothing in the Act that precludes a trademark owner from using more than one trademark at the same time in association with the same goods [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

[24] I am satisfied that in all eight products, the Mark is displayed in greater prominence and created a “distinctive element” [see *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984)]. The Registrant has shown use of its trademark in such a way that it is identifiable as a trademark and not merely as a corporate name or corporate identifier.

[25] I am satisfied that the Owner has established use of the Mark in Canada in association with wine during the Relevant Period within the meaning of section 4(1) of the Act.

#### DISPOSITION

[26] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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Jean Carrière  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**AGENTS OF RECORD**

BCF LLP

For the Registered Owner

No Agent Appointed

For the Requesting Party



