



EDITOR'S NOTE: This document is subject to editorial revision before its reproduction in final form in the *Federal Courts Reports*.

TRADEMARKS

Appeal from decision of Registrar of Trademarks to cancel or expunge from trademarks register appellant's registration for North Brewing — Although respondent initiated summary cancellation proceedings, not taking any position in appeal — Appellant registered trademark North Brewing (Mark) on April 8, 2015 for use in association with following goods: (1) brewed alcoholic beverages (namely, beer, ale, lager, malt liquor); (2) promotional items (namely, beer glasses, mugs, bottle openers, key chains) clothing (namely, shirts, hats, jackets, pants) (registered goods) — At respondent's request, Registrar issued notice to appellant dated May 31, 2021 under *Trademarks Act*, R.S.C., 1985, c. T-13 s. 45 (s. 45 Notice) which required appellant to furnish within three months: (1) evidence of use of Mark within three years immediately preceding s. 45 Notice (May 2018 to May 2021) with respect to each of registered goods; or date when appellant last used Mark in Canada, reasons for absence of use since that date — Appellant not receiving s. 45 Notice in 2019 because of unrecorded change of address; thus, not furnishing requested evidence to Registrar — Registrar subsequently sending appellant letter in October 2021 informing it of decision to expunge Registration (decision) for failure to respond to s. 45 Notice unless appellant filing appeal under Act, s. 56 within time period specified in s. 45 — Letter readdressed to appellant's current address; hence, appellant filed appeal in time — Issues: whether appellant's new evidence was material; if yes, whether it established appellant's use of Mark during relevant period in association with registered goods, such that registration should be maintained — To be considered "material," new evidence must be sufficiently substantial, significant, of probative value — Test not whether new evidence would have changed Registrar's mind but whether it would have material effect on decision — Further to Act, s. 56(5), finding of materiality permitting Court to exercise any discretion vested in Registrar — In present case, Registrar making no findings of fact relevant to appeal in light of appellant's lack of response to s. 45 Notice — Appellant incorporated under laws of province of Nova Scotia in July 2011; Peter Burbridge company's president since then — Appellant has operated craft micro-brewery, retail store, tap room at its current location since 2019; since 2018, appellant has operated craft micro-brewery, retail store inside beer park called Battery Park — Appellant sold following items from locations or online store to customers in Canada during relevant period: brewed alcoholic beverages, namely, beer, ale, lager; promotional items, namely beer glasses, mugs, bottle openers, key chains, clothing, namely shirts, hats — Appellant acknowledged no evidence relating to malt liquor, pants, jackets; thus, these specific goods should be deleted from Registration — According to Mr. Burbridge, appellant also sold brewed alcoholic beverages through Nova Scotia Liquor Corporation, restaurants, bars — Appellant sold promotional items through its physical retail locations, online store or gave them away to customers — Photos provided of Mark used during relevant period on different items, such as beer glasses, mugs, invoices, promotional items, etc. — Evidence appellant providing describing appellant's use of Mark during relevant period would have had material effect on decision had it been before Registrar of Trademarks for consideration, given that appellant not responding to s. 45 Notice — Court may admit, consider new evidence in appeal where no evidence was before Registrar — Accordingly, having regard to Act, s. 56(5), Court may exercise any discretion vested in Registrar — Fact that respondent taking no position in this matter not absolving appellant from establishing, or lessening appellant's burden to establish, to Court's satisfaction: (a) materiality of its evidence on appeal from decision; (b) that Mark was used in Canada during relevant period — Even after excluding malt liquor, pants, jackets from consideration because of appellant's acknowledgement that there was no evidence of use for these

registered goods, appellant using Mark during relevant period for some, but not all, of remaining registered goods — Cancellation proceedings under Act, s. 45 are summary in nature, intended to clear from register trademarks that have fallen into disuse — To maintain its registration, trademark owner must make assertions of fact showing use, as opposed to mere or bald assertions of use — Under Act, s. 4(1), trademark is deemed to be used in association with goods where there is evidence that registered owner or its licensee sold relevant goods in Canada during relevant period, that trademark was marked on goods themselves or on packages in which they were distributed or was in any other manner associated with goods at time of sale (*Randy River Inc. v. Osler, Hoskin & Harcourt LLP*, 2022 CF 1015) — Where, as here, trademark owner providing asserted examples of trademark usage that differ from registered trademark, Court must consider extent to which deviations or variations nonetheless demonstrate use of registered trademark — Federal Court of Appeal case law articulating test of use of registered trademark to be applied — Test can be divided into two parts both focussed on differences between form of trademark as registered, as used — First part would examine whether differences in versions of mark under consideration likely would deceive public as to origin of applicable goods (or services) — If there were no possibility of deception to public, then second part of test would focus on whether mark was used in such way that mark not losing its identity, remained recognizable in spite of differences between form in which it was registered, form in which it was used (*Registrar of Trade Marks v CII Honeywell Bull*, [1985] 1 F.C. 406 (C.A.)) — Appellant's evidence showing sufficient use of Mark as registered to maintain registration for brewed alcoholic beverages, namely, beer, ale, lager, promotional items, namely, beer mugs, key chains, but not for remaining promotional items — There was no issue regarding whether demonstrated uses of Mark, including variations, occurred during relevant period — Issue existing however as to whether variations shown in appellant's evidence nonetheless maintained same dominant features of Mark, were so unimportant as not to mislead unaware purchaser — Court having reservations about specific logos such as those depicted on cans for brewed alcoholic beverages, invoices for these, beer glasses, shirts, some hats — Logos at issue involved more than just addition of merely descriptive or minor element but involved creation of composite mark with significant design feature — However, these logos would not result in consumer being deceived or likely to be deceived regarding origin of goods associated with logos — Words NORTH BREWING not being used as dominant feature of trademark; rather, were subsumed in these logos — In conclusion, Registrar's decision set aside; Registration maintained on register with brewed alcoholic beverages, namely, beer, ale, lager; promotional items (namely beer mugs, bottle openers, key chains) clothing (namely, hats) during relevant period — However, malt beverages, beer glasses, shirts, pants, jackets deleted from Registration — Appeal allowed.

NORTH BREWING COMPANY LTD. V. DLA PIPER (CANADA) LLP (T-1881-21, 2023 FC 1188, Fuhrer J., reasons for judgment August 31, 2023, 29 pp.)