

Federal Court



Cour fédérale

Date: 20170606

Docket: T-1949-16

Citation: 2017 FC 552

Ottawa, Ontario, June 6, 2017

PRESENT: The Honourable Mr. Justice Manson

BETWEEN:

MIGUEL TORRES, S.A.

Applicant

and

**BARRETTE LEGAL INC. AND THE
REGISTRAR OF TRADE-MARKS**

Respondents

JUDGMENT AND REASONS

I. Introduction

[1] This is an appeal pursuant to section 56 of the *Trade-marks Act*, RSC 1985, c T-13, from a decision of the Registrar of Trademarks (the “Registrar”), dated September 13, 2016 (the “Decision”), ordering that Registration No. TMA717,319 for the trademark TORRES 5 be expunged from the Register, pursuant to section 45(4) of the *Trade-marks Act*.

II. Background

[1] Miguel Torres, SA, of Barcelona, Spain (the “Applicant”) owns the Canadian Trademark Registration No. TMA717,319 (the “319 Registration”) for the trademark TORRES 5. The ‘319 Registration has been registered for use in association with brandy since June 23, 2008, based upon use of the trademark in Canada since at least as early as March 19, 1993.

[2] On May 3, 2016, Barrette Legal Inc. (the “Respondent”) requested the Registrar issue a Notice pursuant to section 45 of the *Trade-marks Act*, with respect to the Applicant’s TORRES 5 trademark (the “TORRES Notice”). On May 13, 2016, the Registrar allegedly sent the TORRES Notice and 11 other section 45 Notices, regarding brandy related trademarks, to the Applicant’s representative for service, Marks & Clerk. Marks & Clerk never received the TORRES Notice; however, between May 18 and May 20, 2016, Marks & Clerk did receive the 11 other section 45 Notices.

[3] On September 13, 2016, the Registrar sent a further notice to the Applicant advising that, by reason of the failure to file evidence, the TORRES 5 trademark was to be expunged from the Register, pursuant to section 45(5) of the *Trade-marks Act*, unless an appeal was filed. On October 7, 2016, Marks & Clerk wrote to the Trademarks Office requesting a retroactive extension to time to submit evidence in respect of the section 45 proceedings. This request was denied by the Registrar, on October 19, 2016, as the Registrar was *functus officio* and had no authority to grant such a request after issuance of the final decision under section 45(3) of the *Trade-marks Act*.

[4] Between November 9 and November 14, 2016, Marks & Clerk sent further correspondence to the Trade-marks Office, again requesting a retroactive extension of time. On November 14, 2016, the Trademarks Office sent another letter to Marks & Clerk maintaining that the Registrar has no authority to grant a retroactive extension of time under section 47(2) of the *Trade-Marks Act*.

III. Issue

[5] The only issue in this appeal is whether the Applicant has filed sufficient evidence demonstrating use, as defined by sections 2 and 4 of the *Trade-marks Act*, within the relevant period, to maintain the registration for the TORRES 5 trademark.

IV. Analysis

[6] The Applicant has filed new filed evidence on appeal. Therefore the standard of review to be applied is correctness (*Molson Breweries v John Labatt Ltd* (2000), 5 CPR (4th) 180 (CA)).

[7] Section 45 of the *Trade-marks Act* is a housekeeping measure that is intended to rid “deadwood” from the Register (*McDowell v Laverana GmbH & Co KG*, 2016 FC 1276; *Fraser Sea Food Corp v Fasken Martineau Dumoulin LLP*, 2011 FC 893). On appeal, the evidentiary threshold necessary to demonstrate use of the trademark in question is low and the appellant needs only establish a prima face case of use (*Sport Maska Inc v Bauer Hockey Corp*, 2016 FCA 44 at para 55). Further, the case law has established that an affidavit that provides sufficient

evidence will usually meet the evidentiary requirement of use during the relevant period (*Supershuttle International Inc v Fetherstonhaugh & Co*, 2015 FC 1259 at para 38).

[8] The Applicant filed the affidavit of Ms. Ana Manchón, Area Manager for Canada of Miguel Torres, SA. As a result of her position, Ms. Manchón is familiar with the current and past sales of the Applicant's brandy in Canada that is branded with the TORRES 5 trademark. Attached to the Ms. Manchón's affidavit are representative invoices that demonstrate sale in Canada of the Applicant's TORRES 5 marked brandy from the relevant period, and photos of the TORRES 5 brandy in liquor stores in Ontario.

[9] Although the pictures are not of good quality, this evidence is sufficient to demonstrate use during the relevant period. As such, the appeal is granted and the decision of the Registrar is set aside.

JUDGMENT

THIS COURT'S JUDGMENT is that

1. The appeal is allowed;
2. The decision by the Registrar of Trademarks dated September 13, 2016, ordering registration no. TMA717,319 for the trademark TORRES 5 be expunged from the register, be set aside;
3. Trademark registration no. TMA717,319 for the trademark TORRES 5 in association with brandy be maintained in the Register;
4. On agreement of the parties, no costs are awarded.

"Michael D. Manson"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1949-16

STYLE OF CAUSE: MIGUEL TORRES, S.A. v BARRETE LEGAL ET AL.

PLACE OF HEARING: OTTAWA, ONTARIO

DATE OF HEARING: JUNE 6, 2017

JUDGMENT AND REASONS: MANSON J.

DATED: JUNE 6, 2017

APPEARANCES:

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Ms. Coleen Morrison

FOR THE APPLICANT

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