

**DOES SIZE MATTER? MARK APPEARING IN MINUSCULE TYPE NOT CONSIDERED  
USED, FEDERAL COURT OF CANADA RULES IN EXPUNGEMENT CASE**

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Canada's Federal Court recently ruled that a trade-mark appearing in minuscule type as part of a larger design was not actually used and ordered its expungement from the trade-mark register (*Brouillette Kosie Prince v. Andrés Wines Ltd.*, 2004 CF 812 (June 7, 2004, Tremblay-Lamer, J.)).

Canadian wine producer Andrés Wines Ltd. is the owner of the word trade-mark IN VINO VERITAS, which was registered in Canada in association with wines on October 11, 1974 under registration TMA 202,357, on the basis of use of such trade-mark in Canada since at least as early as 1961.

At the request of Montreal based trade-mark agents Brouillette Kosie Prince, the Registrar of trade-marks issued a Section 45 Notice to Andrés Wines Ltd., the recorded owner of the IN VINO VERITAS registration. Under Section 45 of Canada's *Trade-marks Act*, R.S.C. 1985, c. T-13, the Registrar may at any time and, at the written request made after three years from the date of the registration of a trade-mark by any person who pays the prescribed fee shall, unless the Registrar sees good reason to the contrary, give notice to the registered owner of the trade-mark requiring the registered owner to furnish within three months an affidavit or a statutory declaration showing, with respect to each of the wares or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date. Basically, Section 45 is a "Use It or Lose It" provision under Canada's *Trade-marks Act* which enables the Registrar to rid the register of trade-marks which have become deadwood and are no longer actively used. It was such Section 45 Notice which Andrés Wines Ltd. received from the Registrar on

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November 16, 2000. In response to the Notice, Andrés Wines Ltd. filed evidence of use of its IN VINO VERITAS trade-mark, in affidavit form, and the Registrar, after reviewing the evidence, decided to maintain the registration.

Brouillette Kosie Prince (probably acting on behalf of one of their clients who wished to remain anonymous) appealed the Registrar's decision before Canada's Federal Court. On appeal Brouillette Kosie Prince argued that Andrés Wines Ltd. was not actually making use of its IN VINO VERITAS mark as the words IN VINO VERITAS appeared in small type, a minuscule portion of a much larger coat of arms which appeared on its labels. Madame Justice Tremblay-Lamer agreed with Brouillette Kosie Prince and ruled that the mark which was used by Andrés Wines Ltd. was not the mark it had registered thirty years ago: In the Court's view, the registered mark was only constituted of the words IN VINO VERITAS without any accompanying decorative element. The mark as used was seen as very different than the three words IN VINO VERITAS: on Andrés Wines Ltd.'s labels, those words appeared on the listel of a coat of arms and was always used in such format; moreover, in the Court's view, the words could not be separated from the coat of arms and formed a minuscule part of a much larger decorative component appearing on Andrés Wines Ltd.'s labels. The Court therefore concluded that the mark registered was not the mark used and ordered the expungement of registration TMA 202,357 for the trade-mark IN VINO VERITAS.

It is worth noting that the Court's decision is a departure from the generally accepted rule that any registered word mark (as opposed to a registered design mark) will be found to be used as long as the words forming the trade-mark (all of them and no more) appear on a party's labels (for wares) and function as a trade-mark i.e. to distinguish, irrespective of the size of those words. Moreover, case law is clear that more than one trade-mark can be used on a label and that two or more trade-marks can co-exist in close proximity on the same label and all will retain their individuality (see for example *Renaud Cointreau & Cie v. Cordon Bleu International Ltd.*, (2000) 11 C.P.R. (4th) 95 (F.C.T.D., Tremblay-Lamer J.), affirmed (2002) 18 C.P.R. (4th) 415 (F.C.A.)). Moreover, registration of word marks are encouraged as it gives their owners more flexibility when using them with design components. If this recent decision is followed, it would appear that size does matter when using a trade-mark. Trade-mark owners in Canada must therefore take note and exercise care when using their trade-marks as they should make sure that these marks can easily be seen by consumers.

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