

Federal Court
of Appeal



Cour d'appel
fédérale

Date: 20111206

**Dockets: A-91-11
A-92-11**

Citation: 2011 FCA 340

**CORAM: DAWSON J.A.
GAUTHIER J.A.
TRUDEL J.A.**

BETWEEN:

SHAPIRO COHEN

Appellant

and

**EMPRESSA CUBANA DEL TABACO
Trading also as CUBATABACO and
THE REGISTRAR OF TRADE-MARKS**

Respondents

Heard at Ottawa, Ontario, on December 6, 2011.

Judgment delivered from the Bench at Ottawa, Ontario, on December 6, 2011.

REASONS FOR JUDGMENT OF THE COURT BY:

DAWSON J.A.

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REASONS FOR JUDGMENT OF THE COURT
(Delivered from the Bench at Ottawa, Ontario, on December 6, 2011)

DAWSON J.A.

[1] These are two appeals from a decision of the Federal Court, cited as 2011 FC 102, 383 F.T.R. 164. In this decision, a Judge of the Federal Court allowed the appeals from two decisions of the Registrar of Trade-marks made under section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (Act). In the first decision, the Registrar expunged the trade-mark COHIBA

(TMA277,250). In the second decision, the Registrar expunged the trade-mark COHIBA & DESIGN (TMA373,446). The registered owner of each trade-mark is Empresa Cubana del Tabaco (Cubatabaco), one of the respondents to this appeal. One appeal is brought in respect of each trade-mark. Both appeals were heard together by this Court and a copy of these reasons will be placed in each court file.

[2] Two issues are raised on these appeals. First, did the Judge err in finding that Cubatabaco had demonstrated direct or indirect control over the character or quality of the wares sold in Canada by its licensee, so as to benefit from the licensee's use in Canada? Second, did the Judge err in finding that the registration for "manufactured tobacco for smoking and chewing" in the statement of wares for the COHIBA trade-mark included cigars and cigarillos?

[3] With respect to the first issue, we see no error of law in the reasons given by the Judge for concluding that Cubatabaco exercised control over the character and quality of the cigars and cigarillos sold in Canada by its licensee under the trade-marks COHIBA and COHIBA & DESIGN. Indeed, in oral argument counsel for the appellant acknowledged that what is being challenged is the Judge's application of the legal test to the facts of these cases. However, we see no palpable or overriding error in the Judge's appreciation of relevant evidence or in his application of the relevant legal principles to his findings of fact. On this appeal the appellant in effect challenges the weight given to certain evidence by the Judge.

[4] With respect to the second issue, there was additional evidence before the Federal Court, not available to the Registrar of Trade-marks, with respect to the composition and construction of the cigars at issue. The new evidence, coupled with the dictionary definitions of “cigar” and “cigarillo,” supported the Judge’s conclusions that the new evidence would have materially affected the Registrar’s decision, and that cigars and cigarillos are manufactured tobacco for smoking thus falling within the statement of wares for the COHIBA trade-mark. Further, we see no palpable or overriding error in paragraph 73 of the Judge’s reasons.

[5] For these reasons, each appeal will be dismissed. The appellant shall pay to the respondent Cubatabaco one set of costs in respect of both appeals.

“Eleanor R. Dawson”

J.A.

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKETS: A-91-11
A-92-11

STYLE OF CAUSE: SHAPIRO COHEN v. EMPRESSA CUBANA DEL
TABACO also trading as CUBATABACO and
THE REGISTRAR OF TRADE-MARKS

PLACE OF HEARING: OTTAWA, ONTARIO

DATE OF HEARING: DECEMBER 6, 2011

REASONS FOR JUDGMENT OF THE COURT BY: (DAWSON, GAUTHIER,
TRUDEL J.J.A.)

DELIVERED FROM THE BENCH BY: DAWSON J.A.

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