

**Case Comment by Sandra Ward**

Coors Brewing Company and Molson Canada 2005 recently sought to expunge a registration for the trade-mark **GRAB SOME BUDS** owned by Anheuser-Busch, LLC relying on the *Thymes* [*The Thymes, LLC v. Reitmans (Canada) Limited* 2013 FC 127] decision. In that decision, it was decided, in part, that if an application for a trade-mark is based upon a home registration and use abroad, that such use must have taken place as of the Canadian filing date. The GRAB SOME BUDS application was filed on the basis of proposed use in Canada. Prior to advertisement, the applicant amended the application to delete the proposed use basis and to insert a filing basis relying on the corresponding United States application and use in the United States. The “use” occurred after the date of filing of the Canadian application but before the amendment to allege use in the U.S. was made in Canada. Although this is common practice for applicants, Coors/Molson argued that in view of the *Thymes* decision, the GRAB SOME BUDS registration should be expunged.

The court pointed out that expungement proceedings are not the only way to challenge registration and that the *Trade-marks Act* also provides for opposition proceedings. Section 18 of the *Act* governs in challenging the validity of existing registrations and provides a narrower scope for attack than the provisions governed by Section 38 which deal with opposition. In other words, attacking an application through opposition is one thing, but a post-registration attack is entirely different.

In the case at hand, the court discussed the law on invalidity of trade-mark registrations and summarized the four statutory grounds for invalidity as: a) non-registrability; b) non-distinctiveness; c) abandonment; and d) non-entitlement. In addition, a misstatement in a trade-mark application may invalidate a registration where a) the misstatement was intentional and fraudulent, and b) where the misstatement was innocent but fundamental to the registration, in the sense that the registration could not have been secured without the misstatement.

The Court found that in the application for the trade-mark GRAB SOME BUDS, **no misstatement had been made**. The applicant claimed proposed use at the time of filing. The applicant removed the proposed use basis and in its place inserted a foreign use and application basis. The Court found that no misstatement was made at the time each of these claims was made in the application. Since the presence of a misstatement is a necessary precondition for expungement, the application for expungement of the registration was dismissed.