



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2010 TMOB 137**  
**Date of Decision: 2010-08-18**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Coastal Trademark Services against  
registration No. UCA09770 for the trade-mark A.A.A. in  
the name of The American Automobile Association**

[1] On February 8, 2007, at the request of Coastal Trademark Services (the Requesting Party), the Registrar of Trade-marks issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to The American Automobile Association (the Registrant), the registered owner of registration No. UCA09770 for the trade-mark A.A.A. (the Mark). The Mark is registered in association with:

shipping boxes, cartons, containers, portfolios, pocket books, card cases, typewriter ribbons, carbon paper, key rings, ash trays, signs, tire covers, stationery, wrapping paper, pen and pencil holders, book covers, maps, pamphlets and books, prints, label stickers, decalcomanias, posters, badges, medals, pins and buttons, overalls, raincoats and belts.

[2] Section 45 requires the registered owner of a trade-mark to show whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice, in this case between February 8, 2004 and February 8, 2007 (the Time Period). If the mark has not been used during that time period then the registered owner is required to indicate the date on which it was last used and the reason why it has not been used since that date. The onus on a registered owner under s. 45 is not

a heavy one [*Austin Nichols & Co. v. Cinnabon, Inc.* (1998), 82 C.P.R. (3d) 513 (F.C.A.)]. Evidentiary overkill is not required [*Union Electric Supply Co. Ltd. v. Registrar of Trade-marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)]. Also, the purpose of s. 45 must be born in mind, as enunciated by Mr. Justice Tremblay-Lamer in *Ridout & Maybee LLP v. Omega SA* (2004), 39 C.P.R. (4th) 261 (F.C.), at paragraph 22:

Time and again, this Court and the Court of Appeal has maintained that s. 45 is intended to establish a "simple, summary and expeditious procedure for clearing the register of trade-marks which are not bona fide claimed by their owners as active trade-marks": *Carter-Wallace, supra* at para. 17, quoting *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289 (Fed. T.D.) at 293. "Deadwood" is to be cleared but the resolution of contentious issues between competing commercial interests are not the object of a s. 45 inquiry: *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 17 C.P.R. (3d) 237 (Fed. C.A.).

[3] What qualifies as use of a trade-mark in association with wares is defined in s. 4(1) and (3) of the Act, which are reproduced below:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[4] In response to the s. 45 notice, the Registrant filed affidavits of David Steventon and James G. Brehm.

[5] The Requesting Party filed and served its written argument. The Registrant simultaneously filed and served its written argument and requested a retroactive extension of time to file a supplemental affidavit of James G. Brehm as part of its evidence. This supplemental evidence was intended to respond to what the Registrant referred to as "technical

objections” raised in the Requesting Party’s written argument. By letter dated June 9, 2008, the Registrar refused the request and returned the supplemental affidavit to the Registrant.

[6] Upon reviewing the Registrant’s written argument, the Requesting Party noted that it referred to facts that are not in evidence and wrote to the Registrar to submit that the Registrant’s written argument should be struck in whole or in part. By letter dated December 5, 2008, the Registrar advised that if it was found that the Registrant introduced evidence by way of its written argument then such evidence would be disregarded at the decision stage.

[7] An oral hearing was held, in which only the Registrant participated.

#### Preliminary Comment

[8] I agree that the Registrant’s written argument improperly refers to information that was allegedly contained in the supplemental affidavit that is not part of the record in this proceeding. I also note that the Requesting Party’s written argument refers to information that is not part of the record in this proceeding, in particular information that it obtained from the Internet. All such inappropriate references have been disregarded.

#### Analysis of the Evidence

[9] Mr. Brehm states that he is “Corporate Counsel and a Managing Director of the American Automobile Association, **Inc.**” (emphasis added). He does not explain what relationship, if any, the American Automobile Association, Inc. has to the Registrant (The American Automobile Association). As a result, I see no need to address the remainder of his evidence as it is not apparent that it relates to any activities of the Registrant.

[10] Mr. Steventon states that he is “the Manager, Standards & Accreditation with the Canadian Automobile Association (hereinafter referred to as the ‘CAA’)”. He states that the CAA is a federation of 9 automotive clubs with almost 5 million members across Canada in 2006.

[11] Before proceeding further, I want to acknowledge that there are references in Mr. Steventon’s evidence to American Automobile Association. Although the Registrant’s name is

**The** American Automobile Association (emphasis added), I am prepared to accept that references to American Automobile Association *simpliciter* are in fact references to the Registrant.

[12] Paragraph 5 of Mr. Steventon's affidavit reads:

5. The Canadian Automobile Association is a member of the American Automobile Association. As part of the membership commitment, the CAA represents the American Automobile Association in Canada and provides reciprocal services to visiting AAA members. This establishes the perception of a seamless delivery of AAA branded goods and services throughout North America.

Although Mr. Steventon refers to the Registrant by name in paragraph 5, in paragraph 8 he states, "The American Automobile Association, **Inc.** (hereinafter referred to as "AAA") is the owner of Canadian registration No. UCA 09770, for the trade-mark A.A.A." (emphasis added) His assignment of the abbreviation AAA to The American Automobile Association, Inc. results in confusion as to what is done by the Registrant, as opposed to by The American Automobile Association, Inc. For example, references by Mr. Steventon to the role of AAA (his abbreviation for The American Automobile Association, Inc.) include, at paragraph 8, "The CAA is licensed by the AAA to use its trade-marks in Canada" and, at paragraph 12, "attached as Exhibit 'G' are photocopies of... publications provided by the AAA for distribution in Canada". The ensuing ambiguities must be resolved against the interest of the Registrant [*Plough (Canada) Ltd v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)].

[13] Mr. Steventon has not stated that the Mark has been used in Canada in association with the wares listed in the registration. He does however provide the following information concerning maps and books, at paragraphs 12-14 of his affidavit:

12. In the delivery of auto travel services in 2006 to CAA members and visiting AAA members, CAA Clubs handed out 1,697,436 AAA branded TourBooks, CityBooks, CampBooks and maps. Attached as Exhibit "G" are photocopies of the front, back and relevant inside pages of sample TourBook publications provided by the AAA for distribution in Canada by CAA Clubs to their members.

13. In the delivery of auto travel services in 2006 to CAA members and visiting AAA members, CAA Clubs handed out 7,250,150 AAA branded strip maps which are used to compile TripTiks (personalized routings). Attached as Exhibit “H” are photocopies of the front and back of representative samples of these maps which are provided by the AAA for distribution in Canada by CAA Clubs to their members.

14. Attached as Exhibit “I” is a representative sample of a TripTik® distributed through a CAA club.

[14] I accept that the CAA was acting as a distributor of AAA branded maps and books. It is therefore not necessary to consider if the CAA’s actions fall within s. 50 of the Act; rather I will look at the distributed wares to determine who has been using the Mark that appears thereon.

[15] The maps in Exhibit “H” bear the notice “Published by AAA” while the maps in Exhibit “I” bear the notice “Copyright AAA 2005”. I am uncertain if Mr. Steventon’s defined meaning for AAA should be applied to these materials. However, in at least one location on the Exhibit “I” maps, at page 901, the name of the Registrant (American Automobile Association) appears at the bottom of the page. Based on this single appearance of the Registrant’s name, I am prepared to maintain maps in the registration. Although the appearance of the Registrant’s name may be singular, as noted earlier, millions of maps were distributed in Canada in 2006. The fact that the branded wares may bear the names of more than one entity might arguably affect the distinctiveness of the Mark, but that is not an issue here as s. 45 is concerned simply with whether the Registrant has made some use of the Mark.

[16] The pages of books provided as Exhibit “G” indicate that the books were published by AAA Publishing. As Mr. Steventon has defined the AAA as an entity other than the Registrant and has not explained who AAA Publishing might be, I cannot find that these books show use of the Mark by the Registrant.

[17] Mr. Steventon has also provided as Exhibit “F” a 2007 catalogue showing many AAA branded items; Mr. Steventon states that the “catalogue contains printed publications and merchandise that CAA Clubs can order for resale.” However, this exhibit refers to the entities AAA Publishing Marketing, AAA Product Development & Sales, and AAA Publishing, without

any explanation of these entities' relationship to the Registrant. I am therefore not prepared to find that this catalogue supports a conclusion that the Registrant was using the Mark in association with the advertised wares.

[18] I note that Mr. Steventon has not set out any reasons why the Mark may not have been in use in association with any of the registered wares during the Time Period. Therefore, I find that there is no basis on which any of the wares, other than maps, may be maintained in the registration.

[19] Before closing, I should mention that although the Mark as registered shows periods after each A, the exhibits generally display either AAA or an AAA Design, the latter comprising three capital letter As inside an oval. However, I do not consider the differences between the Mark as registered and the marks being used to be significant. The Registrant cites *Wardair Canada Inc. v. Peoples Jewellers Ltd.* (1989), 24 C.P.R. (3d) 123 (T.M.O.B.) for the proposition that there is no difference between a series of letters separated by periods and the same series of letters without periods. In my view, use of either AAA or the AAA Design qualify as use of the Mark based on the logic set out in *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.) and *Registrar of Trade Marks v. Compagnie Internationale Pour L'Informatique CII Honeywell Bull Societe Anonyme et al.* (1985), 4 C.P.R. (3d) 523 (F.C.A.).

#### Disposition

[20] Pursuant to the authority delegated to me under s. 63(3) of the Act, in compliance with the provisions of s. 45 of the Act, the registration will be restricted to maps.

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Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office