



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

Citation: 2010 TMOB 75
Date of Decision: 2010-05-19

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Clark Wilson LLP against registration
No. TMA585,759 for the trade-mark OPERATION
TRUE BLUE in the name of Xentel DM Incorporated**

[1] At the request of Clark Wilson LLP (the requesting party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on May 9, 2008 to Xentel DM Incorporated, the registered owner of the above-referenced trade-mark (the registrant).

[2] The trade-mark OPERATION TRUE BLUE (the Mark) is registered for use in association with the following services:

(1) Marketing promotions, namely contests, television advertising, magazine advertising, newspaper advertising, direct mail advertising, flyer advertising; telemarketing, namely direct marketing techniques using 1-800 and 1-900 telephone numbers, surveys, polls and research, all of which relate to sporting and entertainment events.

(2) Professional fundraising services offered to others, namely promoting a variety of sports and entertainment events including but not limited to live theatre, variety acts, circuses, amateur and professional rodeos, sporting events, charitable functions, concerts, singing, dancing, magic acts and movies; and the provision of related services, namely recording music; consulting respecting entertainment; acting as booking agents and artistic managers; and buying, leasing, developing and marketing related computer hardware and software.

(3) Providing assistance to others in the area of fundraising through the promotion of sporting events.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or services specified in the registration at any time within the three year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is any time between May 9, 2005 and May 9, 2008.

[4] “Use” in association with services is set out in s. 4(2) of the Act:

4. (2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] In response to the Registrar’s notice, the registrant furnished the statutory declaration of Paul D. Gornall sworn on October 9, 2008. Only the requesting party filed written submissions; an oral hearing was not requested.

[6] I reproduce below the entire body of Mr. Gornall’s statutory declaration:

I, Paul D. Gornall, Trade-mark Agent for the Registrant, Xentel DM Incorporated, hereby declare that:

1. The trade-mark OPERATION TRUE BLUE has not been used with the wares or services in the three year period from May 2005 to May 2008.
2. The trade-mark was last in use for the services in 2000.
3. The absence of use since that date is for the reason that the Registrant’s client, the Toronto Police Union, became involved in a disagreement with the Toronto Police Service Board over how the trademark should be used by the Registrant in association with its fundraising services for the Toronto Police Union.
4. The Registrant intends to use the mark with the services again, for the same or similar clients, when personnel and policies have changed to make it appropriate.

Solemnly declared at Vancouver, BC this 9th day of October, 2008.

[7] The requesting party submits that the statutory declaration is inadmissible since there is no indication that Mr. Gornall, a trade-mark agent who is not an employee of the registrant, had personal knowledge of the facts asserted in the declaration. In other words, the requesting party argues that the content of the declaration is based on hearsay, the reliability and the necessity of which have not been established. In support, it relies on the case of *Canadian Council of Professional Engineers v. AEC Inc.* (2002), 22 C.P.R. (4th) 399 (T.M.S.H.O.).

[8] Having considered the statutory declaration in its entirety, I agree with the requesting party's submission. Not only is Mr. Gornall not an officer or a director of the registrant, he has not indicated whether he has any personal knowledge of the matters discussed in the evidence. Furthermore, there is no mention of the bases on which his statements are made. Even if the allegations made in Mr. Gornall's statutory declaration are based on information and belief, it was held in *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) that statements of this nature in an affidavit are *prima facie* inadmissible hearsay evidence unless they satisfy the criteria of *necessity* and *reliability*. In the present case, Mr. Gornall, who identifies himself as the registrant's trade-mark agent, failed to explain the reasons why a person with direct knowledge regarding the use of the Mark was unable to provide the evidence in question and he also failed to provide the grounds for belief that the facts so stated in the evidence are true. Consequently, the registrant has not established the necessity of submitting evidence by way of a statutory declaration of its trade-mark agent and the reliability of the evidence furnished. Under these circumstances, I find the evidence in this proceeding to be inadmissible hearsay evidence [see *MBM & CO. v. I. Shor Canada, Ltd.* (2007), 63 C.P.R. (4th) 250 (T.M.O.B.)].

[9] As I have concluded that the evidence furnished constitutes inadmissible hearsay, I need not decide whether there exist special circumstances that may excuse non-use of the Mark during the relevant period. I would however comment that the registrant does not appear to have properly addressed the three criteria outlined in *Canada (Registrar of Trade Marks) v. Harris Knitting Mills Ltd.* (1985), 4 C.P.R. (3d) 488 (F.C.A.) and *Smart & Biggar v. Scott Paper Ltd.* (2008), 65 C.P.R. (4th) 303 (F.C.A.) regarding special circumstances. In particular, the registrant did not provide any evidence of use of the Mark with any of the registered services at any time except for a bare assertion of use with "services" in 2000; it failed to explain how one of its clients' disagreement constitutes a reason for non-use beyond its control for more than eight years; and it failed to detail any concrete steps taken to demonstrate a serious intention to shortly resume use of the Mark.

[10] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, it is my conclusion that the trade-mark OPERATION TRUE BLUE of the registration

No. TMA585,759 ought to be expunged from the Register for failure to show use in compliance with the provisions of section 45 of the Act.

P. Fung
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office