



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

Citation: 2016 TMOB 109
Date of Decision: 2016-07-06

IN THE MATTER OF A SECTION 45 PROCEEDING

Relativity Media, LLC

Requesting Party

and

Dandrade Designs Inc.

Registered Owner

TMA558,904 for IMMORTAL

Registration

[1] At the request of Relativity Media, LLC (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 28, 2014 to Dandrade Designs Inc. (the Owner), the registered owner of registration No. TMA558,904 for the trade-mark IMMORTAL (the Mark).

[2] The Mark is registered for use in association with the following goods: “Wearing apparel, namely, t-shirts, shirts, sweatshirts, hats and jackets.”

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the goods 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 November 28, 2011 to November 28, 2014.

[4] The definitions of “use” in association with goods are set out in section 4 of the Act as follows:

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

...

4(3) A trade-mark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Ian D'Andrade, sworn on December 30, 2014 in Ottawa. Only the Requesting Party filed written representations; an oral hearing was not requested.

The Owner's Evidence

[7] Mr. D'Andrade's affidavit is brief and consists only of the following substantive paragraphs and no exhibits:

I, Ian D'Andrade, do solemnly swear that the information contained in this document is true and to the best of my knowledge. This affidavit is to verify that each of the following wares for the trademark IMMORTAL are currently being used in Canada. I have been actively promoting my merchandise to penetrate the market.

I am continuously working to promote Immortal and establish the brand in Canada. You can visit my website which will provide you with all the wares that are available for sale at www.ImmortalClothing.com

For further evidence, I can send the Canadian Intellectual Property Office the following wares;

1. T-shirts
2. Shirts
3. Sweatshirts
4. Hats
5. Jackets
6. Decals
7. Posters

Insufficiency of Evidence

[8] In its written representations, the Requesting Party submits that the Owner's evidence fails to demonstrate any of the following with respect to the relevant period:

- a) transfers of the registered goods during the normal course of trade;
- b) transfers of the registered goods to Canadian customers; and
- c) display of the Mark in association with the registered goods.

[9] Indeed, although Mr. D'Andrade asserts that the Mark is "*currently* being used" (emphasis added), his affidavit is silent regarding the relevant period.

[10] With respect to transfers, Mr. D'Andrade merely states that the registered goods "are available for sale", without providing any evidence of actual sales or transfers of any of the registered goods during the relevant period, in Canada or otherwise.

[11] Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], some evidence of transfers in the normal course of trade in Canada is necessary [*John Labatt, supra*]. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements.

[12] However, as in this case, it is insufficient to merely assert that goods were made available for purchase to Canadians [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB); and *Riches, McKenzie & Herbert LLP v Cleaner's Supply Inc*, 2012 TMOB 211, CarswellNat 5229].

[13] In any event, the evidence fails to demonstrate how the Mark would have been associated with the registered goods at the time of any transfer. Although Mr. D'Andrade invites the Registrar to visit his website, I note that section 45(2) of the Act states that the Registrar "shall not receive any evidence other than the affidavit or statutory declaration." As such, if the Owner wanted the website to be considered as evidence, it should have furnished relevant exhibits such as webpage printouts. Similarly, Mr. D'Andrade could have attached samples or representative photographs of the referenced clothing items as exhibits to his affidavit.

[14] In the absence of such supporting exhibits, I am unable to conclude that the Mark was displayed in association with the registered goods at the time of transfer in the normal course of trade.

[15] Even when considered as a whole, Mr. D'Andrade's statements in his affidavit amount to a mere assertion of use, rather than statements of fact showing use of the Mark.

[16] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods within the meaning of sections 4 and 45 of the Act. Furthermore, the Owner furnished no evidence of special circumstances excusing such non-use of the Mark.

Disposition

[17] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be expunged.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE: No Hearing Held

AGENTS OF RECORD

No Agent Appointed

For the Registered Owner

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For the Requesting Party