



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

**Citation: 2010 TMOB 144**  
**Date of Decision: 2010-09-14**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Stevenson Hood Thornton Beaubier LLP  
against registration No. TMA568,732 for the trade-mark  
MOTOR KING & Design in the name of Deedee Bodnar**

[1] At the request of Stevenson Hood Thornton Beaubier LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on January 30, 2008 to Deedee Bodnar (the Registrant), the registered owner of registration No. TMA568,732 for the following trade-mark:



[2] The trade-mark MOTOR KING & Design (the Mark) is registered for use in association with “used motor vehicles namely consumer trucks and cars used for transportation on land” (the Wares).

[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 wares and 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 between January 30, 2005 and January 30, 2008 (the Relevant Period).

[4] “Use” in association with wares is set out in s. 4(1) and 4(3) of the Act:

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.

In this case, s. 4(1) applies.

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and as such, the evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owners' business and merchandising practices.

[6] In response to the Registrar’s notice, the Registrant filed his own affidavit, sworn on September 30, 2008, together with Exhibits A through D. Neither party filed written submissions; an oral hearing was not requested.

[7] In his affidavit, Mr. Bodnar states that he is the sole director, President and Secretary of Motor King Inc. (Motor King). He states that he granted a licence to Motor King to use the Mark in Canada in association with the Wares prior to the Relevant Period, and that during the Relevant Period and continuing through the date of his affidavit, Motor King used the Mark in Canada under this licence in association with the Wares. He further states that pursuant to the licence he has control of the character and quality of the Wares in association with which Motor King uses the Mark.

[8] He provides in Exhibit D copies of sample Bills of Sale/Offer to Purchase dated from April to October 2006 (during the Relevant Period), demonstrating sales of used cars and trucks by Motor King to customers in Alberta. He explains that during the Relevant Period, the Mark was prominently displayed on stickers and licence plate holders affixed to the vehicles available for sale by Motor King. He also states that these stickers and licence plate holders remained affixed to the vehicles at the time of purchase and transfer of ownership to customers. In Exhibits B and C, he provides a copy of the sticker and a photograph of the licence plate holder, which he states are identical to the ones which were applied by Motor King to the Wares during the Relevant Period. I note that the sticker and licence plate holder in Exhibits B and C clearly display the Mark. In my view, the word EDMONTON that appears below the Mark, in smaller lettering, on the sticker would not be perceived as part of the trade-mark, but rather as identifying the location of the business (which I note from the evidence is located in Edmonton). As such, I find that the trade-mark as it appeared was recognizable as the trade-mark as registered [*Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.), *Registrar of Trade Marks v. Compagnie Internationale pour l'informatique CII Honeywell Bull, Societe Anonyme* (1985), 4 C.P.R. (3d) 523 (F.C.A.), and *Promafil Canada Ltée v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.)].

[9] Concerning the use by Motor King, I find that sufficient facts have been provided to permit me to conclude that the use of the Mark enures to the Registrant pursuant to s. 50(1) of the Act. The evidence demonstrates that the Mark was used by Motor King under a licence, and that the Registrant exercised control over the character and quality of the Wares pursuant to the licence. It is well established that, for the purposes of s. 45, such sworn statements of fact are sufficient to conclude that the licensed use is deemed to be use by the Registrant pursuant to s.

50(1) of the Act [see *Gowling, Strathy & Henderson v. Samsonite Corp.* (1996), 66 C.P.R. (3d) 560 (T.M.O.B.) and *Mantha & Associés/Associates v. Central Transport Inc.* (1995), 64 C.P.R. (3d) 354 (F.C.A.)].

[10] The evidence also shows that the Wares were sold to customers in Canada during the Relevant Period, and that the Mark was associated with the Wares in the manner required by s. 4(1) of the Act.

[11] Based on the evidence furnished, I find that the Mark was in use during the Relevant Period in association with the Wares, and that such use accrued to the Registrant.

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

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Ronnie Shore  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office