



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

Citation: 2011 TMOB 184
Date of Decision: 2011-10-11

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Lapointe Rosenstein, LLP against
registration No. TMA457,308 for the trade-mark de
HAVILLAND in the name of Bombardier Inc.**

[1] On December 8, 2008, at the request of Lapointe Rosenstein, LLP, 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) to Bombardier Inc. (Bombardier), the registered owner of registration No. TMA457,308 for the trade-mark de HAVILLAND (the Mark). The Mark is registered in association with “aircraft and parts therefor”.

[2] Section 45 requires the registered owner of a trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and/or services listed 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 use since that date. In this case, the relevant period for showing use is any time between December 8, 2005 and December 8, 2008 (the Relevant Period). What qualifies as use of a trade-mark is defined in s. 4 of the Act.

[3] 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. 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.)]. As stated by Mr. Justice

Russell in *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270 (F.C.) at para. 58:

...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 owner's business and merchandising practices.

[4] Although inconsequential in the present proceeding, I note that the first footnote to the registration page shows that Bombardier was recorded as owner of the registration on March 2, 2001 further to an amalgamation of February 2, 1998.

[5] In response to the Registrar's notice, Bombardier filed a first affidavit of Lance Kessler, sworn on June 8, 2009 (the principal affidavit) and a second affidavit of Mr. Kessler, sworn on June 9, 2009 (the supplementary affidavit). Only Bombardier filed written representations and was represented at an oral hearing.

[6] Mr. Kessler is Senior Operations Executive, Commercial Aircraft, Contracts with Bombardier Aerospace, the division that conducts Bombardier's aerospace activities. He states at paragraph 6 of his principal affidavit:

The trade-mark de HAVILLAND has been continuously used by Bombardier (and by its predecessor in title de Havilland Inc.) in connection with the Dash8 aircraft (sometimes referred to as the DHC-8) and now known as the QSeries aircraft (eg Q200, Q300 and Q400 hereinafter the "Aircraft"). DHC is an internal code referring to de Havilland Canada.

[7] Mr. Kessler files with his principal affidavit photographs showing the Mark displayed on the control columns located in the cockpit of an aircraft in front of the pilot and co-pilot seats [Exhibit LK-1]. He also files a photograph showing the Mark displayed on the interphone at the entrance of an aircraft [Exhibit LK-2]. Mr. Kessler states that the photographs "are representative of how Bombardier has been using its [Mark] over the years in connection with its Aircraft", including during the Relevant Period.

[8] Mr. Kessler also files with his principal affidavit copies of bills of sale [Exhibit LK-3], Certificates of Receipt/Acceptance of aircrafts by customers in Canada [Exhibit LK-4] and Certificates of Receipt of payment by Bombardier [Exhibit LK-5]. All of these documents cover the Relevant Period and specifically refer to the Mark in the product description.

[9] In his principal affidavit, Mr. Kessler explains that all the aircrafts are inspected in Canada by the customers prior to sale. The inspection process takes about four days. It involves (i) a physical ground inspection of the aircraft, which includes an inspection of the cockpit, telecommunication devices and cabin; (ii) a detailed review of technical documentation; and (iii) an acceptance flight. A number of technical documents, which bear the Mark, are given to the customers at, or prior to, the time of the inspection. Mr. Kessler files pages of technical documents [Exhibit LK-6 to his principal affidavit] and photocopies of CD-Roms [Exhibit LK-1 to his supplementary affidavit] as representative of certain technical documents and CD-Roms used by Bombardier during the inspection of aircrafts during the Relevant Period.

[10] At paragraph 22 of his principal affidavit, Mr. Kessler states:

The aircraft industry is highly regulated and aircraft parts are built according to specific safety and durability standards. Although there is continuous volume of sales for aircraft parts, the sales of each specific part may be sporadic as the demand is subject to wear and tear of the parts, etc.

[11] Mr. Kessler goes on to explain that the various aircrafts parts associated with the Mark and sold by Bombardier, such as valves, power control units, interphones and medallions (to be affixed to the control column of the cockpit), are housed at the facility of Learjet Inc., a wholly owned subsidiary of Bombardier, in Chicago. Customers' orders for aircraft parts are typically placed with Bombardier in Canada and the parts are delivered by Learjet Inc. Mr. Kessler states at paragraph 25: "For sales to Canadian customers, titles to the parts are transferred (intercompany) from Learjet Inc. to Bombardier, and Bombardier in turn sells the parts to customers."

[12] Mr. Kessler files with his principal affidavit photographs showing the Mark displayed on valves, power control units, interphones and control column medallions as representative

specimens of use of the Mark in association with aircraft parts during the Relevant Period [Exhibit KL-7].

[13] Mr. Kessler also files invoices and related shipping documents showing sales and shipments of control column medallions to customers in Canada on March 19, 2008 and August 27, 2007 as well invoices and related shipping documents showing sales and shipments of interphones to customers in Canada on December 11, 2008, May 19, 2009 and May 27, 2009 [Exhibit LK-8 to his principal affidavit]. Mr. Kessler states that he has been unable to locate evidence of sales of valves and power control units during the Relevant Period, which he explains by the fact that the sale of aircraft parts is sporadic. However, Mr. Kessler confirms that valves and power control units were available for sale during the Relevant Period.

[14] Mr. Kessler concludes his principal affidavit by discussing the publication by Bombardier, including during the Relevant Period, of a catalogue that bears the Mark and includes illustrations of aircraft parts.

[15] In my opinion, the evidence as a whole is sufficient to enable me to conclude that the Mark has been used in Canada by Bombardier in the normal course of trade, during the Relevant Period, in association with “aircraft and parts therefor” pursuant to the provisions of s. 4(1) of the Act.

Disposition

[16] 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, registration No. TMA457,308 will be maintained.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office