



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

Citation: 2016 TMOB 193
Date of Decision: 2016-12-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Hartmann USA, Inc. **Requesting Party**

and

McKin Health Care Specialties Inc. **Registered Owner**

TMA343,644 for FREE & ACTIVE **Registration**

[1] At the request of Hartmann USA, Inc. (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 April 7, 2015 to McKin Health Care Specialties Inc. (the Owner), the registered owner of registration No. TMA343,644 for the trade-mark FREE & ACTIVE (the Mark).

[2] The Mark is registered for use in association with the following goods:

Incontinence panties, incontinence briefs, and incontinence absorbent pads.

[3] Section 45 of the Act requires the registered owner of a trade-mark to show, with respect to each of the goods or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date. The relevant period in this case is any time between April 7, 2012 and April 7, 2015.

[4] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing deadwood from the register. While

mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1979), 45 CPR (2d) 194, aff'd (1980), 53 CPR (2d) 63 (FCA)], the threshold for establishing use in these proceedings is quite low [see *Lang, Michener, Lawrence & Shaw v Woods Canada Ltd* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [see *Union Electric Supply Co v Canada (Registrar of Trade-marks)* (1982), 63 CPR (2d) 56 (FCTD)]. However, 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 or services specified in the registration during the relevant period.

[5] For the purposes of this decision, the relevant definition of “use” is set out in section 4(1) 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.

[6] In response to the Registrar’s notice, the Owner furnished an affidavit of its President, Alison O’Brien, sworn June 26, 2015, together with Exhibits A to C.

[7] Only the Owner filed written representations and no hearing was requested.

The Owner’s evidence

[8] Ms. O’Brien states that, during the relevant period, the Owner sold “incontinence panties, incontinence briefs, and incontinence absorbent pads” in association with the Mark in Canada. She collectively refers to these products as the “Products” and I will do the same while reviewing her affidavit.

[9] Ms. O’Brien explains that the Owner sold the Products to Canadian customers by selling directly to distributors, drug stores and other retailers and to end consumers directly in the normal course of trade.

[10] In support, Ms. O’Brien attaches the following exhibits to her affidavit:

- Exhibit A, which she describes as a collection of promotional material, advertising, pamphlets and brochures displaying the Mark thereon. Ms. O'Brien confirms that these brochures and advertisements were distributed to the Owner's customers in Canada during the relevant period.
- Exhibit B, which she describes as a sampling of invoices showing Canadian sales of the Products by the Owner in its normal course of trade.
- Exhibit C, which she describes as a picture of the Owner's branded products showing how the Mark was displayed on the Products.

Analysis

[11] Ms. O'Brien's affidavit sufficiently demonstrates how the Mark was used during the relevant period in association with each of the registered goods.

[12] In this respect, the collection of promotional material at Exhibit A and the picture at Exhibit C show the existence of a family of products for incontinence care needs under the trademark DIGNITY. Three of these products are clearly marked with the Mark as a sub-brand, namely a "**Dignity Free & Active** ® Absorbent Panty with built-in protective padding" for women; a "**Dignity Free & Active** Absorbent brief (fly-front) with built-in protective padding" for men; and "**Dignity Free & Active** Super Absorbent Pads". Exhibits A and C include photographs of the products and their packaging, which prominently display the Mark. The sampling of invoices at Exhibit B shows that transfers and sales of the registered goods to Canadian customers were made during the relevant period in the normal course of trade.

[13] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4(1) and 45 of the Act.

Disposition

[14] Pursuant to the authority delegated to me under section 63(3) of the Act, and in compliance with section 45 of the Act, the registration will be maintained.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

Riches, McKenzie & Herbert LLP

FOR THE REGISTERED OWNER

Ridout & Maybee LLP

FOR THE REQUESTING PARTY