



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2019 TMOB 122**

**Date of Decision: 2019-11-18**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Marks & Clerk**

**Requesting Party**

**And**

**Opel Automobile GmbH**

**Registered Owner**

**TMA735,184 for INSIGNIA**

**Registration**

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA735,184 for the trademark INSIGNIA (the Mark), owned by Opel Automotive GmbH.

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

Motor vehicles, namely, cars, with the exception of vehicle tires.

[3] For the reasons that follow, I conclude that the registration ought to be expunged.

INTRODUCTION

[4] At the request of Sim & McBurney, now operating under the name of Marks & Clerk (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on December 8, 2016, to Adam Opel AG, the registered owner of the Mark at that time. Subsequent

to the issuance of the notice, the Registrar recorded a change in title of the registration to Opel Automotive GmbH (the Owner). This change of title is not at issue in this proceeding.

[5] The notice required the Owner to show whether the trademark 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 December 8, 2013 to December 8, 2016.

[6] The relevant definition of use for goods is set out in section 4 of the Act as follows:

4(1) A trademark 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.

[7] It is well established that bare statements that a trademark is in 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 these proceedings is 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 trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] On October 10, 2017, in response to the Registrar's notice, the Owner furnished the affidavit of Stefan Zimmerman, sworn on October 5, 2017. Neither the Requesting Party nor the Owner filed written representations. Only the Requesting Party requested to make representations at an oral hearing.

## THE OWNER'S EVIDENCE

[9] Mr. Zimmerman states that he is the Lead Counsel Sales & Marketing of Opel Group, a German corporation. The relationship between Opel Group and the Owner is not explained. He explains that the Mark “is currently used to identify a model of car in many countries around the world”, which first came to market in 2008. He states that INSIGNIA-brand cars are sold in many countries around the world. As Exhibit A, he attaches photographs of three different models of the INSIGNIA-brand car. I note that in each image, the cars have European-style licence plates.

[10] Mr. Zimmerman states that the Mark is prominently displayed on the rear exterior of the cars. In support, as Exhibit B, he attaches photographs of the Mark displayed on the rear sides of several different cars. Again, each of the cars appears to have a European licence plate.

[11] Further, Mr. Zimmerman states that the Mark appeared on materials that accompanied the cars at the time of transfer. As Exhibit C, he attaches a copy of the front page of the INSIGNIA-brand car's owner's manual, on which the Mark is displayed prominently as “Opel Insignia”.

[12] Mr. Zimmerman states that during the relevant period, “many thousands of INSIGNIA brand cars were sold around the world”, each prominently displaying the Mark. In addition, he states that the cars are heavily promoted and advertised around the world in association with the Mark, including on the Owner's websites. As Exhibit D, he attaches screenshots showing images of various cars. The Mark is prominently displayed on each screenshot as “Insignia GSi Limousine”, “Insignia Grand Tour”, and other similar combinations. In addition, I note that each screenshot says “Pressroom EUROPE” in the top left corner, and once again, each car appears to have a European-style licence plate.

[13] Lastly, I note that none of the attached exhibits have signed jurat pages; however, there is a “Notary Deed” page at the end of the affidavit signed by a notary public in Rüsselsheim, Germany.

## ANALYSIS

[14] As a preliminary matter, I note that the Requesting Party raised several issues regarding Mr. Zimmerman's affidavit at the oral hearing, including the fact that he identified himself as lead counsel for the "Opel Group", rather than the Owner, and the fact that the jurats for the exhibits are undated and not commissioned. Further, the Requesting Party submitted that the Mark does not appear on its own in Exhibits C and D, but rather as "Opel Insignia" in Exhibit C and as "Insignia GSi Limousine", "Insignia Grand Tour" and other similar configurations in Exhibit D. However, it is not necessary for me to consider these issues in this decision, since even if I were to decide each issue in the Owner's favour, the Owner's evidence would still be insufficient to establish use of the Mark within the meaning of the Act for the reasons detailed below.

[15] In particular, Mr. Zimmerman's affidavit does not contain any statements or documentary evidence referring to sales of the registered goods in Canada. Rather, he repeatedly refers to sales and promotion of INSIGNIA-brand cars "around the world." In fact, there is no specific reference to Canada whatsoever in Mr. Zimmerman's affidavit, and nothing to suggest that Canada is one of the "many countries around the world" in which these vehicles are sold. Moreover, each of the vehicles shown in the exhibits attached to Mr. Zimmerman's affidavit has a European-style license plate, and each of the screenshots shown in Exhibit D says "Pressroom EUROPE". There is no evidence showing a transfer in Canada, in the normal course of trade or otherwise.

[16] As such, I cannot conclude that the Owner's evidence establishes use of the Mark in Canada in association with the registered goods within the meaning of sections 4 and 45 of the Act. In reaching this conclusion, I am guided by the long-standing principle that because evidence in section 45 proceedings is not subject to cross-examination, a registered owner's affidavit must be considered from the point of view of what it does not say [see *Plough and Borden Elliot Scott & Ayles v House of Kwong Sang Hong International Ltd*, 2004 FC 554 at para 33]. Further, the Owner has provided no special circumstances that would excuse non-use of the Mark in Canada in association with the registered goods.

DISPOSITION

[17] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA735,184 will be expunged in compliance with the provisions of section 45 of the Act.

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G.M. Melchin  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** 2019-09-12

**APPEARANCES**

Sanjukta Tole

For the Requesting Party

**AGENTS OF RECORD**

Gowling WLG (Canada) LLP

For the Registered Owner

Marks & Clerk

For the Requesting Party