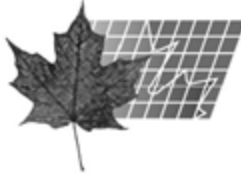


OPIC



CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 118

Date of Decision: 2019-10-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Miller Thomson LLP

Requesting Party

and

Groupe Modulo Inc.

Registered Owner

TMA655,151 for ALLEZ, HOP!

Registration

[1] At the request of Miller Thomson LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on December 2, 2016 to Groupe Modulo Inc. (the Owner), the registered owner of registration No. TMA655,151 for the trade-mark ALLEZ, HOP! (the Mark).

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

Collection de livres et matériel didactique en éducation physique, notamment livres de l'élève, guides d'enseignement, cahiers d'exercices, cédéroms pré-enregistrés ne contenant pas de logiciel, cassettes audio-visuelles pré-enregistrées, pour l'enseignement au secondaire.

[TRANSLATION: Collection of books and teaching materials in the area of physical education, namely books for students, teaching guides, exercise books, pre-recorded CD-ROMs containing no software, pre-recorded audio-visual cassettes, for teaching at the secondary school level.]

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the goods specified in the registration, at any time between December 2, 2013 and December 2, 2016. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reason for the absence of such use since that date.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) 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.

[5] 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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448]. However, the registered owner must still establish a *prima facie* case [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. In this respect, sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar’s notice, the Owner furnished the declaration of its General Manager (“*Directeur général*”), Patrick Lutzy, affirmed February 28, 2017. Both parties filed written representations and attended an oral hearing.

THE OWNER’S EVIDENCE

[7] In his declaration, Mr. Lutzy states that the Owner used the Mark in Canada during the relevant period in association with a collection of books and teaching materials in the area of physical education, namely books for students, teaching guides, and exercise books, for teaching at the secondary school level (the Goods). He explains that the Goods are for the secondary

school market and are sold directly online on the website *www.groupemodulo.com* or to school bookstores or directly to schools through the Owner's exclusive distributor TC Média Livres Inc. He provides annual sales figures for such Goods for the years 2014 to 2016.

[8] In support of his assertions, Mr. Lutzky attaches three exhibits to his declaration.

[9] Exhibit P-1 consists of cover and title/credits pages for two coil-bound ALLEZ, HOP! publications, identified on their respective covers as "*MANUEL-CAHIER 1*" and "*MANUEL-CAHIER 2*". Mr. Lutzky attests that these are the first pages of Goods bearing the Mark and representative of the manner in which the Owner used the Mark in Canada in association with the Goods during the relevant period. I note that the information at the bottom of the credits pages refers to each publication as a "*livre*" (book), while the cover pages indicate that each publication is for "*Éducation physique et à la santé — 1er cycle du secondaire*" (physical and health education for the first cycle of secondary school). The Mark is prominently displayed as a title on each cover page and is also included among the publication particulars on the credits pages. I also note that the Owner is named on the cover pages for each publication and is identified as the copyright holder on the credits pages.

[10] Exhibit P-2 consists of two extracts from the website *www.scolaire.groupemodulo.com*, describing the Owner as a publisher of pedagogical resources and depicting various ALLEZ, HOP! publications similar to those at Exhibit P-1. Mr. Lutzky attests that these pages show Goods offered for sale online by the Owner and are representative of the ALLEZ, HOP! Goods the Owner offered and sold in Canada during the relevant period.

[11] The first extract is a webpage titled "*Manuel scolaire et matériel pédagogique primaire & secondaire / Modulo*" (referring to Modulo textbooks or manuals and pedagogical material for primary and secondary school). It lists the results of a search of the Owner's goods using the keywords "allez hop". It contains nine printed pages of hits for ALLEZ, HOP! publications, with subjects ranging from the general, such as fitness ("*OPÉRATION CONDITIONNEMENT PHYSIQUE*") and team sports ("*L'ÉQUIPE ET LES SPORTS COLLECTIFS*"), to the specific, such as muscle-building ("*OPTION MUSCULATION*") and flag football ("*L'ABC DU FOOTBALL DRAPEAU*"). The educational level is not specified, but the depicted cover pages show athletes whose age appears consistent with secondary school. The cover pages also

prominently display the Mark. In their lower left corners, the cover pages feature a number between 1 and 11 in large print; superimposed on some of these numbers, and just barely legible, is the word “*FASCICULE*”. There is also text printed in the upper right corners; although it is difficult to make out, the Owner submits in its representations that the text reads “*Manuel de l’élève*” and the shape of the text is consistent with this interpretation.

[12] The search results in the first extract also include two other publications: “*Guide pédagogique 1er cycle*”, discussed below, and “*Ensemble d’affiches du 1er cycle*”, which would appear from its name to be a set of posters, although no image or further description is provided.

[13] The second extract is a webpage titled “*Allez Hop! – Guide pédagogique 1er cycle – Éducation physique et à la santé / Modulo*” (Modulo Allez Hop! pedagogical guide for 1st cycle physical and health education). It features an ALLEZ, HOP! publication titled “*Guide pédagogique*”, described on this webpage as being approved in Alberta, Nova Scotia and Quebec, for the first secondary school cycle in Quebec and for grades 7 and 8 in the rest of Canada. The description also mentions that the guide includes “*les affiches*” (the posters). The Mark is prominently displayed on the depicted cover page.

[14] Exhibit P-3 contains copies of 13 invoices—ten of which are dated during the relevant period—addressed to various Canadian recipients which, judging from their names, include schools and bookstores. The invoices are from TC Média Livres Inc., which is identified on the invoices as the exclusive distributor for “MODULO” and three other entities. Eight of the invoices from the relevant period include an entry for one or more units of “*ALLEZ, HOP / MANUEL-CAHIER 1*”, whose international standard book number (ISBN) matches that of the first publication at Exhibit P-1. Another invoice from the relevant period includes a similar entry for a “*MANUEL-CAHIER 2*”, whose ISBN matches that of the second publication at Exhibit P-1. The remaining invoice from the relevant period is for one “*ALLEZ, HOP / 2E CYCLE - FASCIC*” and one “*ALLEZ, HOP / GUIDE PÉD. 2E CYC*”. Considering these entries together with the publications shown at Exhibit P-2, I accept that “*FASCIC*” is an abbreviation for “*FASCICULE*” or “*FASCICULES*”; “*GUIDE PÉD.*” is an abbreviation for “*Guide pédagogique*”; and both “*2E CYC*” and “*2E CYCLE*” reference the second cycle of secondary

school in Quebec. I also note that each of these entries is followed by the notation “LOISELLE”, which is consistent with the author identified on the pages at Exhibit P-1.

ANALYSIS

[15] In its written representations and at the hearing, the Owner conceded that the evidence does not establish use of the Mark in association with pre-recorded CD-ROMs or audio-visual cassettes. Indeed, there is neither any evidence of the Mark being displayed on or otherwise associated with such goods nor any evidence of such goods being sold or otherwise transferred in Canada during the relevant period. There is also no evidence before me of special circumstances excusing non-use of the Mark, as also conceded by the Owner. Accordingly, the registered goods “*cédéroms pré-enregistrés ne contenant pas de logiciel, cassettes audio-visuelles pré-enregistrées*” will be deleted from the registration.

[16] At the hearing, the Requesting Party took issue with the fact that this lack of use, its length and the reasons for it, were not addressed by the Owner’s evidence. However, section 45(3) of the Act provides that where, by reason of the failure to furnish any evidence, it appears to the Registrar that a trademark was not used in Canada with respect to some of the goods or services specified in the registration during the relevant period and that the absence of use has not been due to special circumstances that excuse it, the registration of the trademark is liable to be “amended accordingly”. I therefore see no reason to deviate from the Registrar’s usual practice of simply deleting such goods from the registration.

[17] With respect to the remaining goods specified in the registration, Mr. Lutzky makes a clear assertion of use of the Mark in Canada in association with such goods. His assertion is supported by representative images of the Mark displayed on such goods—namely on their cover pages—and by invoices showing sales of such goods in Canada during the relevant period through the Owner’s distributor. However, the Requesting Party questions the sufficiency of this evidence, as discussed below.

Display of the Mark on each of the Goods

[18] The descriptions and depictions at Exhibits P-1 and P-2 confirm that the Owner's ALLEZ, HOP!-branded goods are publications in the area of physical education intended for students at the secondary school level. Furthermore, I am prepared to accept the publications depicted and described in these exhibits as a collection of books and teaching materials, namely books for students, teaching guides, and exercise books, corresponding to the registered goods "*Collection de livres et matériel didactique..., nommément livres de l'élève, guides d'enseignement, cahiers d'exercices*".

[19] The Requesting Party submits that such correlations are not clear from Mr. Lutzy's declaration and that his evidence is ambiguous as to the nature of the Owner's goods. At the hearing, the Requesting Party also took issue with the Owner's position that its "*MANUEL-CAHIER*" corresponds to both "*livres de l'élève*" and "*cahiers d'exercices*" and that "*manuel*" and "*livre*" are synonyms. In this respect, the Requesting Party also objected to the inclusion of extracts from two online thesauruses in the Owner's written representations. In the Requesting Party's submission, section 45(2) of the Act requires evidence to be in the form of an affidavit or statutory declaration and, as such, does not permit taking judicial notice of dictionary definitions and the like. The Owner responded to this submission by noting that it is a well-established practice of the Registrar to take judicial notice of dictionary definitions.

[20] I would first note that "judicial notice" refers to the acceptance of facts *without* requiring proof thereof, such that the provisions of the Act relating to *evidence* of facts would not appear to apply. However, in the present case, it is not necessary to resort to the thesaurus entries referenced by the Owner or to consider whether it would be appropriate to take judicial notice based on these particular sources.

[21] It is well established that, when interpreting a statement of goods in a section 45 proceeding, one is not to be "astutely meticulous when dealing with [the] language used" [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17]. Furthermore, one should avoid "expunging a trade-mark, the use of which is established in accord with s-s. 45(1), solely on the basis of an ambiguous description of the wares subject to [the] trade-mark" [see *Fetherstonhaugh & Co v ConAgra Inc*, 2002 FCT 1257 at para 23]. The latter result "would be

inconsistent with the purpose of s. 45, i.e., to provide an expeditious process to expunge trademarks from the Register where use is not established in the relevant period, absent special circumstances that would explain failure to use the mark” [*ibid*].

[22] In the present case, I find that the titles, identifications and descriptions of the Owner’s publications, as they appear in the exhibited materials, provide sufficient confirmation that the publications sold in association with the Mark correspond to the particular collection of books and teaching materials defined in the registration.

[23] In this respect, the registration lists three specific types of printed publications: “*guides d’enseignement*”, “*cahiers d’exercices*”, and “*livres de l’élève*”.

[24] I accept that the registered good “*guides d’enseignement*” refers to the type of publication identified at Exhibit P-2 as a “*Guide pédagogique*”, being a guide for teachers.

[25] In addition, I accept that the registered good “*cahiers d’exercices*” corresponds to the type of publication identified at Exhibit P-1 as a “*MANUEL-CAHIER*”, which I understand to be a publication for students that has a “*cahier*” element in the nature of a workbook for written and/or physical exercises.

[26] With respect to “*livres de l’élève*”, in the context of the statement of goods as a whole, I understand this good refers to books for students containing information or instruction, as opposed to workbooks. Accordingly, I am prepared to accept that the remaining types of publications in evidence fall into this remaining category. Specifically, I am prepared to accept the series of numbered publications identified as “*FASCICULE*” on the cover—addressing a range of physical education subjects from fitness and team sports to muscle-building and flag football—as such books for students, published in parts or installments (*i.e.* in fascicles).

[27] I would also be prepared to accept the “*manuel*” portion of the “*MANUEL-CAHIER*” publications as being in the nature of a textbook or instructional guide for students falling under the category “*livres*”. In this respect, I note that the credits pages at Exhibit P-1 identify each of these coil-bound publications as a “*livre*”. I am therefore prepared to accept “*livres*” as a broad term that may encompass both educational texts or manuals and workbooks, and that may

encompass such content in bindings other than hardcover and softcover, for example, coil-bound publications.

[28] On a fair reading of the registered statement of goods, the ALLEZ, HOP! collection of printed publications comprises instructional texts for students, as well as student exercise books and teacher guides, and the evidence is consistent with a collection offering all three types of publications.

Transfers during the relevant period

[29] With respect to transfers of the Goods in Canada during the relevant period, I accept that the February 2016 invoice at Exhibit P-3 for “*2E CYCLE – FASCIC*” refers to “*FASCICULES*” of the type depicted at Exhibit P-2; that the entry for “*GUIDE PÉD. 2E CYC*” on the same invoice refers to a “*Guide pédagogique*” of the type depicted at Exhibit P-2; and that the invoices from the relevant period for a “*MANUEL-CAHIER*” refer to the publications with the same ISBN depicted at Exhibit P-1. As such, I accept that the invoices from the relevant period cover all of the Goods.

[30] The Requesting Party notes a difference in punctuation between the Mark as registered and the Mark as rendered on the invoices. This minor deviation notwithstanding, I accept that the notation “*ALLEZ, HOP !*” on the invoices refers to the collection of ALLEZ, HOP! publications shown in Exhibit P-1 and P-2. In any event, since I am satisfied that the Mark is consistently printed on the goods themselves in the manner shown in these two exhibits, it is not necessary to rely on the invoices as additional evidence of the Mark’s display.

[31] The Requesting Party also notes that the copyright notices for “*MANUEL-CAHIER 1*” and “*MANUEL-CAHIER 2*” date from 2005 and 2006 respectively. However, these notices merely indicate the year from which copyright is claimed and are not necessarily inconsistent with distribution of the works in later years. Indeed, the invoice entries from the relevant period include ISBNs matching those of the publications at Exhibit P-1. Moreover, the printouts at Exhibit P-2, dated February 27, 2017, show the Mark displayed on publications’ cover pages in the same manner, suggesting continuity in the manner of display. Indeed, Mr. Lutzzy’s declaration confirms that the Mark was displayed in the same manner during the relevant period.

[32] Given that I have accepted the exhibited invoices as evidence of transfers of the Goods in Canada during the relevant period, it is not necessary to rely on the sales figures provided in Mr. Lutzky's declaration. In the circumstances, the Requesting Party's observation that the sales figures are not broken down by Good and are not said to be limited to sales in Canada need not be considered.

Use by the Owner through a distributor

[33] Finally, the Requesting Party submits that sales by TC Média Livres do not enure to the Owner's benefit, because there is no evidence that the Owner licensed this entity to use the Mark or exercised the requisite control over the goods sold under licence. Conversely, the Owner submits that, where a trademark owner applies a trademark to a product or its packaging, any use of that trademark resulting from sales of the product by a distributor or reseller is use by the trademark owner [citing *Reckitt Benckiser (Canada) Inc v Tritap Food Broker*, 2013 TMOB 65; and *Malcolm Johnston & Associates v A & A Jewellers Ltd* (2000), 8 CPR (4th) 56 (FCTD), rev'g 78 CPR (3d) 527 (TMOB)].

[34] At the hearing, the Requesting Party responded to the Owner's submission by arguing that the cited cases are not applicable and should be restricted to their facts and, in particular, the fact that, in each of those cases, the trademark owner and its distributor were related entities. The Requesting Party further submitted that, in the present case, since the invoices indicate that TC Média Livres distributes several companies' goods, it is not clear that the invoiced sales would accrue to the Owner specifically.

[35] However, as correctly noted by the Owner, it is well established that a trademark owner's ordinary course of trade will often involve distributors, wholesalers and/or retailers, and that distribution and sale through such entities enures to the owner's benefit without the need for a licence, so long as the owner has initiated the first link in the chain of transactions [see *Manhattan Industries v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD); and *Osler, Hoskin & Harcourt v Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD)].

[36] In the cases cited by the Owner, any corporate relationship between the trademark owner and the distributor did not factor into the analysis of which entity had used the mark at issue.

[37] In *Reckitt Benckiser*, the Registrar confirmed that “a distributor of goods does not require a license from the trade-mark owner to distribute them” [at para 14, emphasis added]. The Registrar inferred that the apparent seller in that case was merely a distributor based on the owner’s normal course of trade and the seller’s name; the fact that the trademark owner and the seller were related companies was not considered in this respect [at para 13].

[38] Moreover, in *A & A Jewellers*, although the Registrar had evidence that the companies selling goods under the mark at issue were wholly owned subsidiaries of the trademark owner, this corporate relationship did not suffice for a finding that use of the mark accrued to the owner’s benefit. What convinced the Federal Court to maintain the registration on appeal was the submission of new evidence establishing that the sellers were “merely distributors” of the owner’s goods, as opposed to “licensees” using the mark [at paras 10-12].

[39] In the present case, I am satisfied that, as Mr. Lutzky attests, TC Média Livres is merely the Owner’s distributor for the Goods and, as such, merely an intermediary along the chain of transactions between the Owner and the ultimate consumer. The fact that TC Média Livres also distributes other companies’ publications, yet issues invoices that do not correlate each publication with its source, is irrelevant. There is no requirement to identify the trademark owner on invoices or otherwise in association with the mark [see *Novopharm Ltd v Monsanto Canada Inc* (1998), 80 CPR (3d) 287 (TMOB); and *Gowling Lafleur Henderson LLP v Classical Remedia Ltd*, 2008 CarswellNat 4604 (TMOB)]. In any event, as demonstrated by Exhibit P-1, the cover and credits pages of the Owner’s publications themselves identify the Owner, not TC Média Livres, as the source of the goods. Moreover, the evidence at Exhibit P-2 shows that the same goods are offered for sale by the Owner directly, as Mr. Lutzky attests.

[40] As I am satisfied that the Owner is the first link in the distribution chain to the ultimate consumer, evidence of licensed use under section 50 of the Act is not required.

DISPOSITION

[41] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act only with respect to the following registered goods:

Collection de livres et matériel didactique en éducation physique, notamment livres de l'élève, guides d'enseignement, cahiers d'exercices, [...] pour l'enseignement au secondaire.

[TRANSLATION: Collection of books and teaching materials in the area of physical education, namely books for students, teaching guides, exercise books, [...] for teaching at the secondary school level.]

[42] Furthermore, there is no evidence before me of special circumstances excusing the absence of use with respect to the remaining registered goods.

[43] Accordingly, 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 amended to delete the following registered goods:

[...] cédéroms pré-enregistrés ne contenant pas de logiciel, cassettes audio-visuelles pré-enregistrées [...].

[TRANSLATION: [...] pre-recorded CD-ROMs containing no software, pre-recorded audio-visual cassettes [...].]

[44] The amended statement of goods will be as follows:

Collection de livres et matériel didactique en éducation physique, notamment livres de l'élève, guides d'enseignement, cahiers d'exercices, pour l'enseignement au secondaire.

Oksana Osadchuk
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2019-06-06

APPEARANCES

Isabelle Jomphe

FOR THE REGISTERED OWNER

Karen Durell

FOR THE REQUESTING PARTY

AGENTS OF RECORD

Lavery, de Billy, LLP

FOR THE REGISTERED OWNER

Miller Thomson LLP

FOR THE REQUESTING PARTY