



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 003

**Date of Decision:** 2023-01-12

**[UNREVISED ENGLISH**

**CERTIFIED TRANSLATION]**

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

**Requesting Party:** Jensen IP

**Registered Owner:** Bernard Caron

**Registration:** TMA756,124 for INFINILAB

### **INTRODUCTION**

[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. TMA756,124, for the trademark INFINILAB (the Mark).

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

Electronic equipment, namely, electronic test bench for testing telephone networks and telecommunication projects.

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

### **THE PROCEEDING**

[4] At the request of Jensen IP (the Requesting Party), the Registrar of Trademarks gave the notice under section 45 of the Act on October 17, 2019, to Bernard Caron (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark had been used in Canada in association with the good 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 the Mark 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 January 23, 2017 to January 23, 2020.

[6] The relevant definition of “use” 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] In the absence of use as defined above, a trademark registration is liable to be expunged, unless the absence of use is due to special circumstances.

[8] 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. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. The burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant Elinor Inc v. 88766 Canada Inc*, 2010 FC 1184 at para 9].

[9] In response to the notice, the Owner filed Bernard Caron's solemn declaration, which was made on January 18, 2021 in Montréal, Quebec.

[10] Only the Requesting Party submitted written representations and was represented at an oral hearing.

### **THE EVIDENCE**

[11] In his declaration, Mr. Caron identifies himself as the President of Néo Technologie Inc. (Néo), the company that markets his goods. He claims to have developed a large number of goods and by-products under the Mark.

[12] In support of his declaration and [TRANSLATION] "as evidence of use over the last three years", Mr. Caron attached three invoices dated between February and July 2018. The invoices were issued by Néo to two addresses in Quebec. The email address *bcaron@neotechnologie.com* appears among Néo's corporate information. The Mark appears on all the invoices in the "Details" section. In the [TRANSLATION] "Good" section on the second invoice, I read: "BB PCB TH".

[13] Also as evidence of use of the Mark, Mr. Caron attached four photos that correspond to two goods that he described, respectively, as follows:

[TRANSLATION]

"The first good is a versatile circuit board that features many connections to facilitate the assembly of prototypes for the testing and development of an electronic good"; and

"The second good is a mini-laboratory for experimenting with the concepts of electronics".

[14] The first two photographs correspond to two different views of the same good. In the first photograph, although blurred, I can distinguish the Mark below the mathematical symbol representing infinity; in the second photograph, I read the following signs on the good: "P/N: BB PCB TH". The last two photographs also correspond to two different views of another good; the Mark clearly appears on the photographed good.

## **ANALYSIS AND REASONS FOR DECISION**

[15] In its written and oral representations, the Requesting Party maintains that the Owner did not fulfill its burden of demonstrating the use of the Mark in association with the goods specified in the registration. Although the Requesting Party always refers to the goods, in the plural, the Requesting Party's representative conceded at the hearing that the registration concerned only one good, namely, a test bench.

### ***Sales to the Owner's benefit***

[16] The Requesting Party alleges that the Owner's normal course of trade was not detailed. In this regard, it points out that the name of the Owner does not appear on the invoices issued by Néo and alleges that he did not demonstrate that the sales made by Néo are attributable to it.

[17] It is well established that there is no particular type of evidence that must be provided to show the normal course of trade in a section 45 proceeding and the evidence need not be perfect [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)].

[18] Although Mr. Caron could have been more explicit, given his declarations and the good covered by the registration, I find that the Owner's activity consists of developing a test bench and selling it to his customers through Néo. In this regard, given that Mr. Caron claims to market his goods through Néo, I accept that the sales of Néo are part of the Owner's normal course of trade. In addition, given the purpose of section 45 of the Act and the position occupied by Mr. Caron within Néo, it is reasonable to assume that the sales made by Néo were under the control of the Owner. As a result, the sales made by Néo during the relevant period are attributable to the Owner under section 50(1) of the Act [for similar findings, see *Bedessee Imports Ltd v Procter & Gamble Health Limited*, 2022 TMOB 207; and *Gowling Lafleur Henderson LLP v Croxall*, 2013 TMOB 1].

[19] Thus, in light of all the evidence, I am satisfied that the sales made by Néo benefit the Owner and that goods were transferred in its normal course of trade.

### ***Use of the Mark***

[20] The Requesting Party points out that Mr. Caron does not attest to either the representativeness of the photos attached to his declaration or to the sale of the photographed goods. In addition, it alleges that the descriptions of the photographed goods are unclear and that no link can be established between them and the goods listed on the invoices. The Requesting Party further alleges that the nature of the goods listed on the invoices has not been explained and, because of this, the correlation with the good specified in the registration has not been established. Furthermore, it argues that Mr. Caron failed to indicate that the invoices accompanied the goods sold at the time of their transfer.

[21] First, I point out that the evidence in a section 45 proceeding must be considered as a whole, and focusing on individual pieces of evidence in isolation is not the proper approach [see *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc (2009)*, 78 CPR (4th) 278 (TMOB)]. In addition, the Registrar may make reasonable inferences based on the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64]. Thus, the solemn declaration must be analyzed as a whole and the exhibits reviewed in light of the information provided in the declaration.

[22] In this case, the evidence includes photographs of goods bearing the Mark. It also includes invoices issued by Néo during the relevant period to Canadian customers of the Owner. Following the principles set out in *Fraser* and *Eclipse*, supra, and given Mr. Caron's declarations and the documentary evidence, I find it reasonable to conclude that the photographs provided are representative of the goods sold during the relevant period. In fact, since the reference "BB PCB TH" appears both in the [TRANSLATION] "Good" section of the second invoice and on the second photograph, I find that the photographed good corresponds to the good invoiced in Canada during the relevant period. Although the Mark is blurry in the photograph in question, the fact that it is clearly presented on other photographs allows me to conclude that the photographed goods correspond to the goods sold and identified with the Mark on the invoices. Since the Mark is presented on the goods themselves and they correspond to the goods sold during the relevant period, I find that the notice of association between the Mark and the

goods sold was given at the time of the transfer, that is, when the goods were delivered. In this context, the Owner was not required to demonstrate that the photographed goods were in fact sold during the relevant period. He was also not required to show that the invoices accompanied the goods at the time of the transfer of possession.

[23] In addition, since Mr. Caron states that these photographs and invoices are his evidence of use of the Mark, I accept that these documents correspond to the good covered by the registration. Furthermore, I find that the description made by Mr. Caron of the photographed goods reasonably corresponds to the good specified in the declaration. Thus, I conclude that Mr. Caron's declarations regarding use of the Mark in Canada in association with the good specified in the registration are corroborated by the documentary evidence.

[24] In view of the above, I am satisfied that the Owner provided sufficient factual evidence for me to conclude that the Mark was used in Canada in association with the good specified in the registration during the relevant period.

### **DISPOSITION**

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

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Maria Ledezma  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

Certified translation  
Tony Santin  
The English is WCAG compliant

# Appearances and Agents of Record

**HEARING DATE:** 2022-12-16

## **APPEARANCES**

**For the Requesting Party:** Heidi Jensen

**For the Registered Owner:** No one appearing

## **AGENTS OF RECORD**

**For the Requesting Party:** Jensen IP

**For the Registered Owner:** No agent appointed