

TRADUCTION/TRANSLATION



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

Citation: 2012 TMOB 85
Date of Decision: 2012-04-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by 88766 Canada Inc. against registration
No. TMA423462 for the trade-mark RIDE in the name of
the K-2 Corporation**

[1] On February 3, 2010, at the request of 88766 Canada Inc. (the Requesting Party), the Registrar issued a notice under section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to K-2 Corporation (the Registrant), the registered owner of the above-mentioned trade-mark.

[2] The trade-mark RIDE (the Mark) is registered in association with "clothing and footwear for snowboarding, namely, snowboard boots, snowboard gloves, snowboard hats, and snowboard mitts; snowboards; and snowboard accessories, namely snowboard bindings and snowboard leashes."

[3] Section 45 of the Act requires the registered owner of the trade-mark to demonstrate whether the trade-mark has been used in Canada in association with each of the wares and/or services specified in the registration 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. In this case, the relevant period to demonstrate use is any time between February 3, 2007, and February 3, 2010 (the Relevant Period).

[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; as such,

the evidentiary threshold that the registered owner must meet is quite low. As stated by Judge Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.), at 282:

[...] 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 owners' business and merchandising practices.

[5] Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares or services specified in the registration at any time within the relevant period.

[6] Use in association with wares is set out in subsection 4(1) of the Act:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[7] In response to the Registrar's notice, the Registrant provided two affidavits from Mr. Louis Boudreault, filed April 16, 2010 (Affidavit A) and April 29, 2010 (Affidavit B). Both parties filed written representations.

[8] In his Affidavit A, Mr. Boudreault identifies himself as the Chief Executive Officer and Senior Vice President of Sales and Marketing of the Registrant's licensee, K2 Corporation of Canada.

[9] In paragraphs 3, 4, 6 and 10 of his Affidavit A, Mr. Boudreault indicates that K2 Corporation of Canada is a subsidiary and licensee of the Registrant. He adds in paragraph 8 that

during the Relevant Period, the Registrant had direct and indirect control over the character and quality of the wares bearing the Mark being sold in Canada by K2 Corporation of Canada.

[10] Specifically, the Registrant controlled the nature, quality, construction, manufacture, style, and materials used for all wares associated with the Mark. Furthermore, the Registrant established all the specifications and standards that the licensee was to meet in terms of advertising, advertising materials, packaging, labelling, and promotional materials. Samples of wares and promotional materials were also sent to the Registrant for approval prior to the marketing in Canada of the wares associated with the Mark. The Registrant could also inspect K2 Corporation of Canada's facilities to verify inventory as well as promotional products associated with the Mark.

[11] Mr. Boudreault's statements convinced me that the Registrant exercised control over the wares associated with the Mark and sold by its licensee, K2 Corporation of Canada, during the Relevant Period, pursuant to subsection 50(1) of the Act.

Transfer of wares associated with the Mark in the Registrant's normal course of trade for the Relevant Period

[12] In his Affidavit A, Mr. Louis Boudreault files as evidence Exhibits B, C and D, which relate to the Relevant Period. Exhibit B represents a copy of the 2008/2009 season catalogue, illustrating certain wares bearing the Mark. He indicates in paragraph 10 of his Affidavit A that the wares in the photographs are representative of the wares sold and delivered to Canadian retailers. Exhibit C represents a copy of prices lists for wares that are associated with the Mark and distributed to Canadian retailers through the catalogue. Finally, Exhibit D represents copies of invoices for the sale of wares associated with the Mark by K2 Corporation of Canada to certain Canadian retailers.

[13] In paragraph 10 of his Affidavit A, Mr. Boudreault presents a table correlating information found in the three (3) Exhibits, namely B, C and D. He indicates that he only provided invoices for the following kinds of wares: "snowboard boots", "snowboard hats" as well as "snowboards" and "snowboard bindings".

[14] This evidence allows me to conclude that the Mark had been used in association with the wares listed above during the Relevant Period by the Registrant's licensee.

[15] However, it is to be noted that I could find no illustration in the catalogue (Exhibit A) nor mention in the invoices (Exhibit C) of the following kinds of wares: "snowboard gloves", "snowboard mitts" and "snowboard leashes". Further, Mr. Louis Boudreault mentions in paragraph 3 of Affidavit B the use of the Mark in association with "snowboards", "snowboard boots", "snowboard bindings" and "snowboard hats" by K2 Corporation of Canada but fails to mention wares of the type "snowboard gloves", " snowboard mitts" and "snowboard leashes".

[16] In paragraphs 13 and 14 of its representations, the Registrant submits that it is unnecessary to show evidence for each ware. The Registrant indicates that it meets the requirements of the Act because the wares described in its registration represent a wide array of similar wares [*Westinghouse Air Brake Co v. Moffat & Co.* (2001), 14 C.P.R. (4th) 257 (F.C.T.D.) [*Westinghouse*]], and that it presents at least one piece of evidence that supports the entire line of wares [*Saks & Co. v. Canada (Registrar of Trade-marks)* (1989) 24 C.P.R. (3d) 49 (F.C.T.D.) [*Saks*]].

[17] I am of the opinion, however, that the criteria from *Westinghouse* and *Saks* do not apply here.

[18] The Court indicates in paragraph 22 of *Westinghouse* that "...it is only necessary to demonstrate use on association with some of the wares where the registered wares fall into one broad category and [underlining and italics added] that some of the wares are constituent parts of the devices comprised in the category [...]". In this case, wares of the type "snowboard gloves", "snowboard mitts" and "snowboard leashes" are not parts of the devices included in their category.

[19] The Registrant registered only seven (7) types of wares as compared to the Registrant in *Saks*, which registered twenty-eight (28) categories, each containing several dozens of wares. The Court in *Saks* indicated that it would be too onerous for the registrant to provide evidence for each of the wares associated with the mark and, as a consequence, accepted that the registrant would only present a few examples for each category. However, in this case, I am of the opinion

that it would not have been onerous for the Registrant to provide additional evidence for each of the wares of the type "snowboard gloves", "snowboard mitts" and "snowboard leashes". I would also add that in addition to the fact that none of the supporting documents indicate the sales of such wares, no statements made in Affidavit B indicate the sale of such wares, contrary to *Saks* where there was a clear statement of the sale of the wares.

Disposition

[20] In view of all of the foregoing, pursuant to the authority delegated to me under subsection 63(3) of the Act, the registration will be amended to delete the following wares: "snowboard gloves", "snowboard mitts" and "snowboard leashes".

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
[Jane Kuna]