

## TRADUCTION/TRANSLATION

PROCEEDING UNDER SECTION 45  
TRADE-MARK: MONEYLINE  
REGISTRATION NO.: 402,666

On June 28, 2001, at the request of Cassels Brock & Blackwell, the Registrar issued the notice prescribed by section 45 of the *Trade-marks Act* to Plesman Communications Inc., which was the registered owner of the registration referred to above on the date of the notice. Subsequently, the trade-mark was transferred. The current registered owner is Medias Transcontinental S.E.N.C.

The MONEYLINE trade-mark is registered for use in association with the following services:

On line computerized catalogue services advertising the availability of computer hardware, computer software and computer peripherals, namely, computers, computer software, computer peripheral devices, computer communication devices, computer cabling and connectors and computer add-in cards.

Section 45 of the *Trade-marks Act* requires that the registered owner of the trade-mark to show whether the trade-mark was in use in Canada in association with each of the wares or services listed 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. The relevant period in this case is any time between June 28, 1998, and June 28, 2001.

In response to the notice, the affidavit of Pierre Poirier was furnished. Both parties filed a written argument. A hearing was not requested in this case.

In his affidavit, Mr. Poirier states that Plesman Communications Inc. (“the owner”) was not able to show the use of the trade-mark in Canada in association with the services because of special circumstances, but he adds that the owner still intends to use the trade-mark.

He submits that during the relevant period, Plesman Communications Inc. had undergone a corporate reorganization, and as Exhibit PP-1, he furnished an excerpt from the registry of the Inspector of Financial Institutions of Quebec. He indicates that the reorganization resulted in changes in management, *inter alia*, and that there have been changes in the company’s business plans.

He says that the absence of use of the trade-mark during the relevant period is attributable to economic circumstances, which have particularly affected the various sectors of the New Economy, including the sale and supply of wares and services on the Internet, and to the corporate reorganization. He adds that there are plans at this moment for services bearing the trade-mark to be offered in the normal course of trade in the near future.

The requesting party argues that the evidence does not show any use of the trade-mark and that the inference is that the trade-mark has never been in use in Canada. It also submits that the evidence does not show that the absence of use has been due to special circumstances that excuse

it. The owner submits that the absence of use is due to special and exceptional circumstances and that the Registrar should uphold the trade-mark.

It is clear that the evidence does not show any use of the trade-mark. Accordingly, the issue to be determined is whether the evidence shows that the absence of use is attributable to special circumstances, which excuse it. The question of what constitutes special circumstances was considered by the Court of Appeal in *Registrar of Trade Marks v. Harris Knitting Mills Ltd.*, 4 C.P.R. (3d) 488 at pages 492 and 493, the judge wrote:

[TRANSLATION] Under section 44 [now 45], where it appears from the evidence furnished to the Registrar that the trade-mark is not in use, the Registrar shall order that the registration of the trade-mark be expunged, unless the evidence shows that the absence of use was “due to special circumstances that excuse such absence of use” (“a été attribuable à des circonstances spéciales qui le justifient”). The general rule is therefore that absence of use of a trade-mark is sanctioned by expunging it. In order for an exception to be made to that rule, subsection 44(3) [45(3)] requires that the absence of use be attributable to special circumstances that justify or excuse it. With respect to this provision, we would note first that the circumstances to which it refers must justify or excuse the absence of use in the sense that it must be possible to conclude from those circumstances that, in a particular case, the absence of use should not be “punished” by expunging the trade-mark. Those circumstances must be “special” in that they must be circumstances that are not found in a majority of cases involving absence of use of a trade-mark. In addition, subsection 44(3) [45(3)] requires that the special circumstances that excuse the absence of use be circumstances to which the absence of use is attributable. That is, in order to determine, in a specific case, whether the absence of use should be excused, the reasons for the absence of use must be examined and it must be determined whether those reasons are such that an exception must be made to the general rule that the registration of a trade-mark that is not in use must be expunged. I would also add that the absence of use that must be so excused is the absence of use before the owner received the notice from the Registrar.

It is impossible to say precisely what the circumstances referred to in subsection 44(3) [45(3)] must be in order to excuse the absence of use of a trade-mark. However, the importance, in this respect, of the length of the non-use and the probability that the period of non-use will extend over a long time: circumstances may excuse absence of use for a brief period of time, but will not excuse an extended period of non-use. It is also crucial to determine the extent to which the absence of use is attributable solely to the choice of

the owner of the trade-mark rather than to obstacles beyond its control. It is difficult to see why an absence of use attributable solely to the choice of the owner of the trade-mark would be excused.

In *Ridout & Maybee v. Sealy Canada Ltd/Ltée*, 87 C.P.R. (3d) 307, Lemieux J. described the salient facts in *Harris* as follows:

- (a) it is impossible to define precisely the circumstances in subsection 44(3) (now 45(3)) which may excuse non-use;
- (b) the circumstances of non-use must be special; that is circumstances which do not exist in the majority of cases involving non-use;
- (c) the reason for non-use cannot be a voluntary one on the part of the registered owner; non-use must be beyond the control of the owner; the registered owner must show at least serious inconvenience for not continuing the use of the mark;
- (d) the length of use [sic] and probability of continued non-use is a factor;
- (e) special circumstances are an exception to the general rule that trade-mark which is not used should be expunged.

What can therefore be taken from those cases is that in order to be able to determine whether the absence of use is attributable to special circumstances, three criteria must be taken into consideration: first, the length of time during which the trade-mark has not been used; secondly, it must be determined whether the registered owner's reasons for not using its mark were due to circumstances beyond his control; thirdly, one must find whether there exists a serious intention to shortly resume use.

With respect to the first criterion, the period of non-use, as stated in *Ridout & Maybee, supra*:

Section 45(1) is clear, the registered owner must show the date when it [the trade-mark] was last so in use.

This criterion is important, because in order to decide whether the circumstances cited in Mr. Poirier's affidavit are special circumstances which may excuse the absence of use, I must examine them in relation to the length of the time the absence of use lasted. As stated in *Harris, supra*, circumstances may justify absence of use for a brief period of time but will not justify an extended period of non-use.

In this case, Mr. Poirier failed to furnish the date of last use of the trade-mark. It is therefore impossible to determine whether the trade-mark has ever been in use in Canada. In cases where a date of last use is not furnished, the Registrar considers the period of absence of use beginning on the date of registration of the trade-mark (see *GPS (U.K.) Limited v. Rainbow Jean Co.*, 58 C.P.R. (3d) 535). In this case, the date of registration is September 11, 1992. Accordingly, the owner in this case had to provide reasons for the absence of use since that date.

Although the reasons furnished, the "corporate reorganization" and the "economic circumstances which have affected the various sectors of the New Economy", could have excused an absence of use for a brief period of time, they are not sufficient to excuse the absence of use of the trade-mark since September 11, 1992. Nothing in the evidence explains why the trade-mark was not in use in Canada before the corporate reorganization.

With respect to the third criterion, whether the owner has shown a serious intention to use the trade-mark again in the near future in association with the services, no details and no evidence were furnished to support Mr. Poirier's allegation that there are plans for the services bearing the trade-mark to be offered in the near future (see *Lander Co. Canada Ltd. v. Alex E. MacRae & Co.*, 46 C.P.R. (3d) 417 and *Arrowhead Water Corp. v. Arrowhead Spring Water Ltd.*, 47 C.P.R. (3d) 217). Accordingly, I find that the owner has not proved that it intends to begin using the trade-mark shortly.

Having regard to the foregoing, I find that the registration of the trade-mark should be expunged. Registration No. 402,666 will be expunged in accordance with the provisions of section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 16<sup>TH</sup> DAY OF DECEMBER 2004.

D. Savard  
Senior Hearing Officer  
Section 45 Division