



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

Reference: 2013 TMOB 172
Date of Decision: 2013-10-08
TRANSLATION

**IN THE MATTER OF A SECTION 45 PROCEEDING,
requested by Sim & McBurney, against Registration Nos.
TMA499527 and TMA656265 for the trade-marks T-FAL
INGENIO Drawing and INGENIO respectively, in the
name of TEFAL a simplified joint-stock company**

[1] This decision covers two summary expungement procedures concerning registrations TMA499527 and TMA656265 for the T-FAL INGENIO Drawing (shown below) and INGENIO trade-marks, respectively (hereinafter sometimes referred to collectively as the Marks).

[2] On January 18, 2011, at the request of Sim & McBurney (the Requesting Party), the registrar sent, for each of the above-mentioned registration files, a notice stipulated in Section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to TEFAL a simplified joint stock company (the Registrant), registered owner of these registrations. These notices enjoined the Registrant to show that its Marks had been used in Canada, at any given time between January 18, 2008 and January 18, 2011 (the Relevant Period), in association with each of the wares specified in the registrations, i.e. the wares described in Appendix A hereto.

[3] 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 clearing the register of “deadwood.” Although the applicable test is not very demanding and an overabundance of evidence is not necessary, sufficient facts must be presented to enable the registrar to conclude that the trade-mark has been used in association with each ware or service mentioned in the registration during the Relevant Period [*Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 CPR (4th) 270 (CF)]. Mere claims of use are insufficient [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 CPR (2d) 62 (FCA)].

[4] In reply to each notice from the registrar, the Registrant produced an affidavit from Gontran Paquette-Barrette. Only the Registrant submitted written representations in each file. However, each party was represented at the hearing held for these two files.

[5] Considering in greater detail the evidence submitted by the Registrant, I agree with the Requesting Party that the affidavit made by Mr. Paquette-Barrette proves insufficient to show use of the Marks during the Relevant Period for the following reasons:

[6] Subsection 4(1) of the Act defines use in association with wares as follows:

A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property 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 this case, the Registrant's evidence is ambiguous at the very least.

[8] As pointed out by the Requesting Party at the hearing, the main problem posed by Mr. Paquette-Barrette’s affidavit is that it mentions nothing about what binds him to the Registrant or his personal knowledge of the elements of the evidence he is introducing.

[9] In the introduction to the affidavit, Mr. Paquette-Barrette is identified as “student.” Nothing else. Mr. Paquette-Barrette then contents himself to say that:

1. On January 18, 2011, the registrar issued a notice pursuant to subsection 45 of the [Act] regarding one or other of the registrations in question.

2. For the purposes of replying to this notice, the Registered Owner [of the Marks] had to provide evidence of use of each of these marks in Canada during the Relevant Period for the wares covered by the registrations.

[10] Mr. Paquette-Barrette continued his affidavit in submitting, without further explanation, exhibits A-1 to A-5, which he describes as follows:

- Exhibit A-1: “Various invoices and transit documents showing sales and deliveries to Canadian companies”;

- Exhibit A-2: “Four of the six sides of a box containing INGENIO or T-FAL INGENIO kitchen items”;

- Exhibit A-3: “Copies of registrations 260579, 167233 and 522594 regarding the T-FAL mark as obtained from CIPO’s Strategis database”;

- Exhibit A-4: “Various pages downloaded from the *www.tefal.com* and *www.tefalingenio.com* websites”, dated August 17, 2011. Mr. Paquette-Barrette adds that “the print date is the download date”; and

- Exhibit A-5: “Various elements downloaded from the *t-fal.ca* website which promotes the T-FAL products in Canada”, also dated August 17, 2011. Mr. Paquette-Barrette adds that “the print date is the download date, and that the screenshot date is the same.”

[11] Although an affidavit made by a person other than the Registered Owner can be validly submitted as evidence in reply to a notice pursuant to Section 45 of the Act, here again such an affidavit must make it possible to establish the personal knowledge of that person and the source of evidence submitted. These elements are sadly lacking in this case.

[12] These deficiencies are of such significance that they cannot be described as a mere technicality. Accordingly, I agree with the Requesting Party that it is impossible to assess the reliability of the evidence submitted. In this regard, it is important to recall that under these procedures the Requesting Party cannot cross-examine a person submitting evidence. It is also important to recall that any ambiguity in the evidence must be interpreted against the Registrant

[*Plough (Canada)*, cited above; and *Diamant Elinor Inc. v. 88766 Canada Inc.* (2010), 90 CPR (4th) 428 (CF)].

[13] In the circumstances, Mr. Paquette-Barrette's affidavit must be set aside, since it constitutes hearsay.

[14] Although this conclusion is sufficient to dispose of each of these files, I would like to add the following comments concerning the evidence submitted.

[15] Mr. Paquette-Barrette's affidavit contains no statement to the effect that each of the Marks had, in fact, been used in Canada in association with each of the wares described in the registrations in question during the Relevant Period.

[16] Furthermore, the Registrant's normal business practice is not explained.

[17] Exhibits A-1 to A-5 provide no light on the matter. None of these exhibits identify or make it possible to identify the Registrant, with the exception of the copies of registrations submitted as Exhibit A-3. These registrations have no relevance in establishing use of the Marks nor do they make it possible to establish the Registrant's normal business practice in Canada during the Relevant Period.

[18] Regarding more specifically Exhibit A-1, although Mr. Paquette-Barrette describes it as "various invoices and transit documents," the Registrant acknowledged at the hearing that they were not "invoices" properly speaking. In fact, the documents submitted seem more to consist in printouts from a computer database of unknown origin. With the exception of the printout appearing on the first page showing delivery of an Ingenio 12-piece set, dated 07/23/08, to the company I.T.G. Corp. in Thornhill, Ontario, all of the other printouts submitted as Exhibit A-1 concern an Ingenio removable handle. The seller's name and contact details did not appear on the printouts.

[19] At the hearing, the Registrant explained that these printouts came, in fact, from "TFAL Canada." This so-called explanation should have been included in the Registrant's evidence. Moreover, it gives no details of the commercial relationship that existed between "TFAL Canada" and the Registrant.

[20] Even in presuming these were documents demonstrating sales, the fact remains that there is no indication to the effect that these documents accompanied the wares in question at the time of transfer of ownership or possession such that the notice of association was provided [*Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000), 8 CPR (4th) 471 (CF 1st inst)].

[21] Returning to the Ingenio 12-piece set and the Ingenio removable handle referred to in these documents, these wares as such are not described in either statement of wares covered by the registrations covered by these procedures.

[22] At the hearing, the Registrant argued that Exhibit A-1 must be considered jointly with the box submitted as Exhibit A-2 and that both illustrated use of the Marks in association with the wares described as “household or kitchen utensils and containers, namely: saucepans, fry pans, Dutch ovens, casseroles, stockpots, sauté pans, grills, pressure cookers, covers, glassware, moulds, vacuum flasks” (under registration TMA656265) and “cookware, namely fry and sauté pans, saucepans and lids for fry and sauté pans, saucepans” (under registration TMA499527).

[23] However, there is no indication to the effect that Exhibit A-2 is representative of the boxes used during the Relevant Period. According to the information presented on four of the six sides of the box submitted, it concerns a “26-piece set” of stackable saucepans, fry pans and lids with removable handles, whereas Exhibit A-1 concerns a 12-piece set. Furthermore, the sides of the boxes copied do not describe the identity of the manufacturer or other similar information regarding the source of the product. Accordingly, it is impossible to connect Exhibit P-2[sic] to the Registrant.

[24] The webpage printouts submitted as Exhibits A-4 and A-5 are of no assistance to the Registrant. They are all dated after the Relevant Period. Furthermore, although Exhibit A-4 apparently refers to sets of “Ingenio” saucepans, it proves as imprecise as Exhibit A-2. In addition, it does not show how each of the Marks is displayed on or otherwise associated with these saucepans during the transfer of ownership or possession of the latter within the meaning of Section 4 of the Act. As to Exhibit A-5, it only lists the points of sale of “T-FAL products” in Canada, but does not identify them or connect them to the Registrant.

[25] I can even less subscribe to the Registrant's argument that, based on the case of Saks & Co. v. Registrar of Trade-marks (1989), 24 CPR (3d) (CF 1st inst), the use of the nominal mark INGENIO can be inferred from the evidence submitted with the rest of the wares described in registration TMA656265 comprising wares as diverse as "washing machines," "dishwashers," "electric esthetic massage appliances," "electric hairdryers," "air conditioning units," etc., belonging to categories of wares totally different from cookware.

[26] Given all of the above, I deem that is not necessary to comment further on the evidence submitted by the Registrant or to address specifically the issue of determining whether Exhibit A-2 demonstrates use of the T-FAL INGENIO Drawing mark as registered.

[27] In exercising the authority delegated to me pursuant to the provisions of subsection 63(3) of the Act, each of the registrations will therefore will be expunged from the register in compliance with the provisions of Section 45 of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Alan Vickers, trad.

Appendix "A"

Wares described in Registration TMA656265:

Washing machines, dishwashers, washer-dryers, sauce makers, citrus squeezers, electric kitchen appliances, fruit and vegetable blenders, food processors, electric knives, electric coffee mills, electric bottle openers; flatware, forks and spoons; electric irons, weighing equipment and instruments, namely bathroom scales; devices for sending and receiving sound and pictures, namely radios with transmitter and receiver for monitoring babies and young children; electrical esthetic massage equipment, blood pressure monitoring devices, namely sphygmomanometers; medical thermometers; lighting, heating, steam production, cooking, refrigeration, drying, ventilation, water distribution devices and sanitary facilities, namely electric radiators, radiators (radiant), electric wall convectors, clothes dryers, electric hairdryers (with attachments), electric hair tongs, electric steam generators, ironing stations, steam ironing boards, fans, air conditioners, aerators, electric humidifiers, kettles, electric teamakers, electric fryers, electric woks, electric planchas; electric hairbrushes, steam hairbrushes, toothbrushes, electric combs and brushes, electric toothbrushes, oral hygiene devices, namely dental sprays; non-electric waffle irons, non-electric fryers, non-electric kettles, household or kitchen utensils and containers, namely: saucepans, fry pans, Dutch ovens, casseroles, stockpots, sauté pans, grills, pressure cookers, covers, glassware, moulds, vacuum flasks.

Wares described in Registration TMA499527:

Cookware, namely fry and sauté pans, saucepans and lids for fry and sauté pans, saucepans.

These wares were translated as follows in the *Journal des marques de commerce*:

Batterie de cuisine, nommément poêles et sauteuses, casseroles et couvercles pour poêles et sauteuses, casseroles.