



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

Citation: 2013 TMOB 107
Date of Decision: 2013-06-17

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by De Tomaso Automobili S.p.A. dba De
Tomaso S.p.A. against registration No. TMA239,099 for
the trade-mark PANTERA in the name of Martin
Krupka**

[1] At the request of De Tomaso Automobili S.p.A. dba De Tomaso S.p.A. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on October 5, 2010 to Martin Krupka (the Registrant), the registered owner of registration No. TMA239,099 for the trade-mark PANTERA (the Mark).

[2] The section 45 notice required the Registrant to furnish evidence showing that he had used the Mark in Canada in association with the wares specified in the registration within the time period between October 5, 2007 and October 5, 2010.

[3] The wares specified in the registration are: “automobiles of the sports type”.

[4] The definition of “use” with respect to wares is set out in sections 4(1) and 4(3) 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. ...

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[5] For the reasons set out below, I am satisfied that the Registrant has demonstrated use of the Mark in association with “automobiles of the sports type” during the relevant period within the meaning of sections 4(3) and 45 of the Act.

The Registrant’s Evidence

[6] In response to the Registrar’s notice, the Registrant filed his own affidavit, sworn on April 28, 2011.

[7] In his affidavit, he states that, since the 1970s, he has assembled and sold “automobiles of the sports type”, all of which bear the Mark. Attached as Exhibit 1 to his affidavit is a photograph of “a representative PANTERA automobile”. He attests that every PANTERA automobile has four plates affixed throughout the vehicle, including on the hood, in the engine compartment and in front of the windshield. Representative pictures of such plates are attached as Exhibit 2, and I note that each plate displays the Mark.

[8] With respect to sales during the relevant period, the Registrant attaches, as Exhibit 3 to his affidavit, six “statements” regarding sales of PANTERA automobiles, all dated during the relevant period. Mr. Krupka clarifies that the name appearing on the statements, “Pantera Sports Car Company Canada” is the name under which he sometimes does business as a sole proprietorship. He further attests that each of the automobiles were assembled in Montreal and then shipped to the addresses on the statements. I note that the addresses are all located in South America or the Caribbean.

Requesting Party Submissions

[9] In its written and oral submissions, the Requesting Party questioned the credibility of the Registrant’s evidence and asked that the Registrar take judicial (or official) notice of three points. First, that under Quebec provincial law, sole proprietorships such as that operated by the Registrant must be registered as such with Revenu Quebec. Second, that the Registrant’s business was not, in fact, registered with Revenu Quebec’s Registraire des Entreprises during the

relevant period. Third, that on one of the exhibited statements, the purported addressee is not a living individual or the name of a company but rather is actually a reference to a street corner in Lima, Peru.

[10] The Requesting Party noted that the Registrar has previously taken judicial notice of provincial laws, but noted a specific instance where the Registrar refused to take judicial notice of Revenu Quebec's business registry [*Magyar v Loblaws Inc* (1995), 61 CPR 3d 267 (TMOB)]. However, the Requesting Party submitted that at the time of that decision, the registry was not as easily accessible as it is now.

[11] As such, the Requesting Party further submitted that in view of the fact that the Registrant was not in compliance with provincial laws and that one of the exhibited statements was demonstrably flawed, it would cast doubt on the reliability of the Registrant's evidence as a whole.

[12] However, I would first note that 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Furthermore, the evidence as a whole must be considered and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Ltd* (2005), 47 CPR (4th) 209 (TMOB)]. Section 45 proceedings are not intended to provide an alternative to the usual *inter partes* attack on a trade-mark envisaged by section 57 [*Meredith & Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)]. As such, statements in an affidavit must be accorded substantial credibility [*Ogilvy Renault v Compania Roca-Radiadores SA*, 2008 CarswellNat 776 (TMOB)].

[13] In my view, taking judicial notice to the extent and for the purpose argued for by the Requesting Party would be contrary to these principles. A registered owner would have to provide an overabundance of evidence in anticipation of questions beyond the narrow scope of these proceedings and would have its hands tied in the face of any judicial notice casually taken, considering that a registered owner is barred from submitting reply evidence to such unanticipated notice. Similarly, a requesting party is barred from submitting its own evidence in

a section 45 proceeding. As such, it should not be able to do with calls for judicial notice that which it is prohibited from doing by way of evidence or cross-examination.

[14] In any event, even if I were to take judicial notice as indicated by the Requesting Party, such notice would not render the evidence before me as unclear or ambiguous. If, in fact, the Registrant has not, for example, complied with Quebec language or business registration laws, then this is still not immediately relevant to the question of “use”. It is well-established that compliance with other Acts is not at issue in section 45 proceedings [see *Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. Similarly, the Registrant is not required to meet a standard of perfection in relation to his record-keeping. The statements furnished at Exhibit 3 are consistent with the sworn statements of the Registrant in his affidavit regarding the sale and export of the wares – I would note, for example, that the exhibited statements merely accompanied the automobiles and did not necessarily constitute the means by which the shipments were addressed. As such, the omission or mistaken identification of the addressee noted by the Requesting Party is irrelevant, in my view.

[15] As such, in view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark in association with the wares within the meaning of section 4(3) and section 45 of the Act.

Disposition

[16] Accordingly, 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.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office