



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

Citation: 2012 TMOB 25
Date of Decision: 2012-02-16

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Heenan Blaikie, LLP, against registration
No. UCA31,352 for the trade-mark OASIS in the name of
LVD Acquisitions, LLC.**

[1] At the request of Heenan Blaikie, LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on January 26, 2009, to Zohar Waterworks LLC, the registered owner at that time, of registration No. UCA31,352 for the trade-mark OASIS (the Mark). Subsequent to the issuance of the notice, the registration was assigned to the current owner, LVD Acquisitions (the Registrant).

[2] The Mark is registered for use in association with the following wares:

Water cooling apparatus having electrically powered refrigerating units.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares or services listed on the registration at any time within the three year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of use since that

date. In this case, the relevant period for showing use is any time between January 26, 2006 and January 26, 2009 (the Relevant Period).

[4] The relevant definition of “use” in the present case is set out in s. 4(1) of the Act as follows:

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.

[5] In response to the Registrar’s notice, the Registrant furnished the affidavit of John Kucharik, the President and CEO of LVD Acquisitions, LLC, doing business as Oasis International. Both parties filed written arguments and made submissions at an oral hearing.

[6] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary, and expeditious procedure for removing deadwood from the register. While mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 C.P.R. (2d) 194, aff’d (1980), 53 C.P.R. (2d) 63 (F.C.A.)], the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)]. However, a registered owner must nevertheless provide sufficient facts to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares or services specified in registration during the relevant period.

[7] In his affidavit, Mr. Kucharik states that prior to assuming his current responsibilities with the Registrant, he served as President and CEO of Zohar Waterworks LLC (Zohar), the Registrant’s predecessor-in-title and owner of the Mark during the Relevant Period. This former position, he explains, involved similar responsibilities, including the oversight of marketing, sales and distribution of products bearing the Mark in the United States and Canada.

[8] Mr. Kucharik explains that during the Relevant Period, Zohar conducted business as Tri-Palm International and Tri-Palm International LLC (Tri-Palm). The Requesting Party submits that the designation LLC indicates a limited liability company, while Zohar is different. Furthermore, it argues that the Registrant has not provided evidence of the relationship between the Zohar and Tri-Palm. Given these ambiguities, the Requesting Party argues that the Registrar must either conclude that Zohar was consistently and impermissibly misidentifying itself as another company or that Tri-Palm and Zohar were in fact different corporate entities.

[9] However, I agree with the Registrant that the Kucharik affidavit provides that Tri-Palm International and Tri-Palm International LLC were alternate trade-names employed by Zohar during the Relevant Period, and I see no reason to doubt Mr. Kucharik's sworn statement in this regard [*Rubicon Corp. v. Comalog Inc.* (1990), 33 C.P.R. (3d) 58 (T.M.O.B.)]. Furthermore, whether the use of the designation "LLC" as part of an alternate trade-name is permissible is not a relevant consideration in s. 45 proceedings [*Meredith and Finlayson v. Berg Equipment Investments Ltd.* (1996), 72 C.P.R. (3d) 387 (T.M.O.B.); *Lewis Thompson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 21 C.P.R. (3d) 483 (F.C.T.D.)].

[10] With respect to the normal course of trade, Mr. Kucharik explains that Zohar was in the business of manufacturing, distributing and selling a range of products including the registered wares under various trade-marks including the Mark. Specifically with regard to business operations in Canada, Mr. Kucharik explains that Zohar, doing business as Tri-Palm, commercialized such products bearing the Mark through occasional direct retail sales, but more often through a dealer network of various Canadian plumbing wholesalers who would then sell to plumbers and/or plumbing retailers, who would in turn retail to end-users. In support, he provides as Exhibits B and C, advertisements featuring what he describes are OASIS branded products. Mr. Kucharik also attaches as Exhibits F, G, and H, additional advertising and promotional materials, including excerpts from a catalogue.

[11] The bulk of the advertisements/promotional materials feature photographic images of water coolers, which I accept as falling within the description of the registered wares; for example, the "Odyssey Series Premium Water Cooler" and the "R1P" model water cooler. I note that the photographic images of the Odyssey cooler clearly show the Mark appearing on the

front of the cooler. While the resolution of the photographic images of the R1P model cooler is quite poor, given that the trade-mark that is displayed on the front of this cooler follows a pattern of display of what is clearly the Mark throughout the evidence as a whole, I find it reasonable to accept that the R1P model also bears the Mark.

[12] The remaining relevant evidence is summarized as follows:

- Exhibit I: consists of a 2008 Canadian price list for what Mr. Kucharik identifies as OASIS branded products. I note that included on this list are premium models of the Odyssey Series water cooler, listed under item numbers 504123C, 504124C, and 504252C. I further note that the R1P model water cooler appears on this list under item number 503802 and model name R1P.
- Exhibits K, L, and M: consist of printouts from the Registrant's sales records demonstrating the sale and shipment of what Mr. Kucharik describes are OASIS branded products to various Canadian entities during the Relevant Period. Included in these records are item numbers that Mr. Kucharik states correspond to item, model or product numbers from one of the various OASIS product catalogues. Although Exhibit K does not include such item numbers, I note that the sales records in Exhibits L and M clearly indicate quantities of item numbers 504123C, 504252C (Odyssey Series water coolers) and R1P PRO3 PROSELECT CHILLERS have been sold.
- Exhibits N, O, and P: consist of randomly selected invoices which demonstrate sales in Canada during the Relevant Period of what Mr. Kucharick identifies as OASIS branded products. I note that the invoices clearly include sales of an item listed as the R1P PRO3 PROSELECT CHILLER, under item number 503802. In addition, I note that Exhibit O contains an invoice which reflects sales of an item referred to in the body of the invoice as the "Oasis Spring Leap a Bracket Cooler". The invoice lists the party/address to be billed as the same party/address to be shipped to.

[13] The Requesting Party argues that the Registrant has failed to meet its evidentiary burden to show use of the Mark in association with the wares, arguing that there is no evidence of notice of association of the Mark with the wares at the time of transfer. In this vein, the Requesting

Party argues that the product catalogues and other such promotional/advertising materials in evidence do not qualify as evidence of use in relation to wares.

[14] I note that Mr. Kucharik does not provide any information regarding the circulation of the catalogues and promotional/advertising materials in evidence, nor is there evidence to support the fact that these materials would have been visible at the time of transfer of the property in, or possession of, the wares. Furthermore, I accept that advertising generally does not constitute use in association with wares. However, the distinction to be made here is that I am not relying on such advertising and promotional material as providing the requisite notice of association pursuant to s. 4(1). The value in these exhibits is that they contain photographic images of the wares clearly displaying the Mark. In taking these images together with statements made by Mr. Kucharik and the evidence as a whole, I am prepared to infer that the sales demonstrated in the evidence included sales of the registered wares bearing the Mark. Specifically, the evidence shows that Zohar made sales of the Odyssey Series and RIP model water coolers during the Relevant Period, and that such wares displayed the Mark, as per the photographic images.

[15] Although there were no submissions on this point, I will add that I consider the appearance of the item referred to as the “Oasis Spring Leap a Bracket Cooler” in the body of the invoice filed under Exhibit O, constitutes use of the Mark which satisfies s. 4(1) as well. When correlating the product numbers associated with this item in this invoice with the product catalogues and the 2008 Canadian price list, it is readily apparent that this item falls within the description of the registered wares. Furthermore, as the invoice lists the party/address to be billed as the same party/address to be shipped to, and indicates that the invoice is dated the day of shipment, I accept that the invoice would have been viewed by the same party who received the wares; this has been accepted as providing sufficient notice of association to satisfy s. 4(1) of the Act for the purposes of s. 45 [*Riches, McKenzie & Herbert LLP v. KOM Networks Inc.* (2005), 51 C.P.R. (4th) 65; *Novopharm Ltd. v. Novo Nordisk A/S* (2005), 41 C.P.R. (4th) 188 (T.M.O.B.); *Bereskin & Parr v. Star-Kist Foods, Inc.* (2004), 37 C.P.R. (4th) 188 (T.M.O.B.)].

Disposition

[16] In view of the above, I conclude that the Registrant has evidenced use of the Mark in association with the wares as registered within the meaning of s. 45 and s. 4 of the Act during the

Relevant Period. Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office