

TRADUCTION/TRANSLATION

SECTION 45 PROCEEDINGS
TRADE-MARK: OMEGA & DESIGN
REGISTRATION NO.: 307,956

On July 18, 2001, at the request of Ridout & Maybee LLP, the Registrar forwarded a Section 45 notice to Omega SA (Omega AG) (Omega Ltd), the registered owner of the above-referenced trade-mark registration.

The trade-mark OMEGA & Design (shown below) covers the following wares and services:

wares:

Appareils relatifs aux activités sportives, nommément: chronomètres, tableaux de pointage et tableaux indicateurs, pour le pointage, le contrôle et la mesure du temps, des distances, des scores, des heures, des dates; appareils relatifs aux activités de transport, nommément: tableaux indicateurs d'horaire, de dates, de véhicules, des départs et arrivées; appareils relatifs aux activités bancaires, nommément: tableaux indicateurs de données économiques, taux de change, cours de valeurs; appareils relatifs aux activités publicitaires, nommément: enseignes et enseignes lumineuses.

services:

Services de conseil relativement à la planification et installation d'appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement aux domaines sportif, scientifique et industriel; services de traitement informatique de données servant à la gestion et la diffusion d'informations destinées aux entreprises de transport, de publicité ainsi qu'aux banques.



Section 45 of the Trade-marks 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 and/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. The relevant period in this case is any time between July 18, 1998 and July 18, 2001.

In response to the notice, the affidavits of Peter Stierli and Philippe Lefebvre were furnished. Each party filed a written argument and was represented at the oral hearing.

In the Stierli affidavit, the affiant alleges use of the trade-mark during the relevant period in association with the following wares and services:

“Appareils relatifs aux activités sportives nommément: des chronomètres et des tableaux de pointage et tableaux indicateurs, pour le pointage, le contrôle et la mesure du temps, des distances, des scores, des heures et des dates.”

“Des services de conseil relativement à la planification et installation d’appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement au domaine sportif.”

Concerning the above-mentioned wares, it is stated that the registrant has granted a license to Omega Electronics SA to use the trade-mark in Canada. At paragraph 13 of the affidavit, it is stated that the registrant has control over the character and quality of the wares sold and the use and advertisement of the trade-mark by Omega Electronics SA. At paragraph 15, it is indicated

that several sales of the wares were made. For example, in 1998 and 1999, Canadian sales concerning wares including the above mentioned wares amounted to at least 100,000 Swiss francs each year. It is specified that the wares are sold to specialized buyers such as sports committees.

It is also indicated that the registrant has granted a license to Omega Electronics SA with respect to the above-mentioned services. Pursuant to the terms of the license and under the authority of the registrant, Omega Electronics SA has entrusted Servtrotech Inc. with the distribution of the wares in Canada and the performance of the services and Servtrotech has been authorized to use the trade-mark in association with the distribution of the wares and the performance of the services. At paragraph 19, it is stated that the registrant exercises control over the character and quality of the wares and exercises indirect control of the character and quality of the services performed in Canada by Servtrotech which services are directly controlled by the registrant's licensee Omega Electronics SA.

In his affidavit, Mr. Lefebvre states that he is "Directeur du Marché sportif" of Servtrotech Inc. He indicates that Servtrotech is a distributor of OMEGA products throughout North America and he explains that the products emanate from Omega Electronics SA. He adds that Servtrotech also performs services in association with the trade-mark.

He indicates that amongst the wares sold and emanating from Omega Electronics SA are the following associated with the registered trade-mark OMEGA & Design:

- Appareils relatifs aux activités sportives, notamment: chronomètres, tableaux de pointage et tableaux indicateurs, pour le pointage, le contrôle et la mesure du temps, des distances, des scores, des heures, des dates.

Amongst the services performed, the following are associated with the registered trade-mark

OMEGA & Design:

- Services de conseil relativement à la planification et installation d'appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement au domaine sportif.

As Exhibit PL-0 he attaches copies of invoices showing sales of the above-mentioned wares. As Exhibit PL-1 he provides copies of invoices for the wares "chronomètre". As Exhibit PL-2, he provides a copy of a leaflet which shows the wares "chronomètre" bearing the trade-mark. As Exhibit PL-3, he provides an invoice showing the sale of a "tableau indicateur et de pointage" and a copy of an excerpt from a product sheet which is given to the clients at the time of purchase of such ware. Mr. Lefebvre specifies that "such wares" (as well as the other wares emanating from Omega Electronics SA) are delivered to the clients in boxes emanating from Omega Electronics SA and bearing the trade-mark.

Concerning the services mentioned above, he indicates that the trade-mark was used in association with such services during the relevant period and to illustrate such use he provides as Exhibits PL-4, PL-5, and PL-8 several invoices emanating from Servtrotech and concerning the performance of the above-mentioned services. He then explains that the trade-mark is used in the performance of the services to the extent that when the employees of Servtrotech perform the

services they wear clothing bearing the trade-mark (Exhibits PL-6 and PL-7). At paragraph 19, he confirms that SERVTROTECH is available for any question or control by Omega Electronics SA and he states that during the relevant period Omega Electronics SA did exercise its right regarding the services.

The requesting party's main arguments are summarized as follows:

As no use has been alleged or shown for the following wares and services: “appareils relatifs aux activités de transport, nommément: tableaux indicateurs d’horaire, de dates, de véhicules, des départs et arrivées; appareils relatifs aux activités bancaires, nommément: tableaux indicateurs de données économiques, taux de change, cours de valeurs; appareils relatifs aux activités publicitaires, nommément: enseignes et enseignes lumineuses”; “Services de conseil relativement à la planification et installation d’appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement aux domaines scientifique et industriel; services de traitement informatique de données servant à la gestion et la diffusion d’informations destinées aux entreprises de transport, de publicité ainsi qu’aux banques” and as no reason for the absence of use in association with those wares and services has been given, those wares and services ought to be deleted from the trade-mark registration.

Concerning the remaining wares, the requesting party submits that any use shown is not of the trade-mark OMEGA & Design “per se” and not use accruing to the registered owner pursuant to Section 50 of the Act.

Concerning the remaining services “services de conseil relativement à la planification et installation d’appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement au domaine sportif” it argues that the evidence furnished is insufficient. The requesting party submits that as there is no reference to the term “conseil” in any of the invoices furnished in evidence, it cannot be concluded that “services de conseil relativement à la planification et installation d’appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement au domaine sportif” were performed during the relevant period. In addition, it submits that the evidence fails to show that the trade-mark was used or displayed in the advertisement or performance of the services. It argues that the mere wearing by an individual performing the services of a garment adorned with a trade-mark is not sufficient to associate the trade-mark with the services being performed by the individual, particularly so where the individual does not work for the company who owns the trade-mark. Further, it adds that any use shown with “services” is not use of the trade-mark OMEGA & Design “per se” and not use accruing to the registered owner pursuant to Section 50 of the Act.

In its written argument and at the oral hearing, the registrant conceded that the evidence did not show use with the wares “appareils relatifs aux activités de transport, nommément: tableaux indicateurs d’horaire, de dates, de véhicules, des départs et arrivées; appareils relatifs aux activités bancaires, nommément: tableaux indicateurs de données économiques, taux de change, cours de valeurs; appareils relatifs aux activités publicitaires, nommément: enseignes et enseignes lumineuses” and the services “services de conseil relativement à la planification et

installation d'appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement aux domaines scientifique et industriel; et services de traitement informatique de données servant à la gestion et la diffusion d'informations destinées aux entreprises de transport, de publicité ainsi qu'aux banques” and that such wares and services could be deleted from the trade-mark registration. Accordingly, such wares and services will be deleted from the registration.

Concerning the remaining registered wares “appareils relatifs aux activités sportives, nommément: chronomètres, tableaux de pointage et tableaux indicateurs, pour le pointage, le contrôle et la mesure du temps, des distances, des scores, des heures, des dates”, it is clear, and the requesting party has conceded, that the evidence shows that such wares were sold during the relevant period. I am also satisfied that the use shown complies with the requirements of Section 4(1) of the Trade-marks Act.

Concerning the remaining registered services “services de conseil relativement à la planification et installation d'appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement au domaine sportif”, I find the evidence is sufficient to permit me to conclude that such services were performed during the relevant period. Mr. Stierli and Mr. Lefebvre have clearly indicated that the services were performed during the relevant period and Mr. Lefebvre provided invoices with respect to such services. Although the invoices do not refer to the term “conseil”, Mr. Lefebvre has sworn that the invoices relate to such services (see paragraphs 16 and 18 of the affidavit), and therefore I am prepared to infer that the services that

were provided would have included “services de conseil”. (see *Mantha & Associates v. Central Transport Inc.*, 64 C.P.R. (3d) 354.) I am also satisfied that the use shown in association with such services was in accordance with Section 4(2) of the Trade-marks Act as Mr. Lefebvre has indicated that employees of Servtrotech wore a garment adorned with the trade-mark when performing the services and as I am satisfied that this amounts to use or display of the trade-mark in the performance of the services.

The next issue I will consider is whether the trade-mark shown to be in use with the above-mentioned wares and services is the registered trade-mark or constitutes use of the registered trade-mark.

With respect to the services, I am satisfied that the garment shown in Exhibit PL-7 clearly bears the trade-mark as registered. Accordingly, I conclude that one trade-mark shown to have been used in the performance of the services during the relevant period is the registered trade-mark.

With respect to the wares, the trade-mark shown to be in use is as follows:

The requesting party argues that the above-mentioned trade-mark does not constitute use of the registered trade-mark “per se”. It submits that as the name of the licensee is Omega Electronics SA and as the name appears at the bottom of each invoice and on the documentation, the customer dealing with Omega Electronics SA would likely perceive the trade-mark as being OMEGA ELECTRONICS & Design rather than OMEGA & Design as it would probably make the association between the trade-mark and such entity. The requesting party has a point, however, having regard to the evidence as a whole, I am not convinced that the trade-mark OMEGA & Design “per se” would not be perceived also as the trade-mark being used. In the mark as used, the word “electronics” appears in a size which differs from the word OMEGA and the Greek letter Ω, and it is separated from the trade-mark OMEGA & Design by a line of oblongs. Consequently, I find the trade-mark OMEGA & Design stands out sufficiently from the additional matter as to be perceived as a distinct trade-mark. (see *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535 Principle1). The requesting party relied on decisions of the United Kingdom Trade Marks Registry in Revocation proceedings of Registration No. 699057 (particularly paragraph 41 of that decision), and Registration No. 1456848 (in particular, paragraph 51 thereof), in support of its argument that the use shown does not constitute use of the registered trade-mark. I have reviewed those decisions, however, I cannot find that such decisions support the requesting party’s contentions. The comments made in those paragraphs are clearly obiter and, therefore, are of no weight in this proceeding.

The final issue is whether the use shown by the evidence enured to the registrant. Contrary to the requesting party’s contentions, I am of the view that the evidence is sufficient, for purposes of

Section 45, to permit me to conclude that the use shown was in compliance with Section 50(1) of the Trade-marks Act.

It is clear from the evidence that the registrant has licensed Omega Electronics SA to use the trade-mark in association with the registered wares (paragraph 10 of the Stierli affidavit) and in association with the registered services (paragraph 17). It is also clear that with respect to the services, Omega Electronics SA with the authority of the registrant has sublicensed the use of the trade-mark in association with the services to Servtrotech Inc. As properly argued by the registrant, and consistent with the jurisprudence, there is no requirement that a license be in writing (see *Quarry Corp. Ltd. v. Bacardi & Co.*, 72 C.P.R. (3d) 25 and 86 C.P.R. (3d) 127). Concerning the control required, for purposes of Section 45, so long as the use is under license and there is a statement in the affidavit that the owner has direct or indirect control over the character and quality of the wares and/or the services, the Registrar will, in the absence of indications to the contrary, accept that the use is in compliance with Section 50 of the Act (see *Sara Lee Corp. v. Intellectual Property Holding Co.*, 76 C.P.R. (3d) 71, *Fitzsimmons, MacFarlane v. Caitlin Financial Corp. N.V.*, 79 C.P.R. (3d) 154 at a57, *Sim & McBurney v. Lesage Inc.*, 67 C.P.R. (3d) 571 and the *Federated Department Stores Inc. v. John Forsyth Co.*, 10 C.P.R. (4th) 571).

Here, I am prepared to conclude from the statements contained in paragraphs 13, 18, 19 and 20 of the Stierli affidavit that the registrant had direct control over the character or quality of the wares manufactured by Omega Electronics SA and indirect control over the character or quality of the

services provided by Servtrotech. (regarding indirect control see *Le Niagara Frontier Hockey LP* [1995] TMOB No. 183. and *Pitblado Buchwald Asper v. 8 Hockey Ventures, Inc.*, 25 C.P.R. (4th) 71).

In view of the above, I conclude that the use shown accrued to the registered owner.

As I have concluded that use of the trade-mark accruing to the registrant has been shown only in association with the following wares and services:

wares:

“Appareils relatifs aux activités sportives nommément: des chronomètres et des tableaux de pointage et tableaux indicateurs, pour le pointage, le contrôle et la mesure du temps, des distances, des scores, des heures et des dates.”

services:

“Des services de conseil relativement à la planification et installation d’appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement au domaine sportif.”

I conclude that the trade-mark registration ought to be amended to refer to only those wares and services.

Registration No. 307,956 will be amended accordingly in compliance with the provisions of
Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 30TH DAY OF SEPTEMBER 2003.

D Savard
Senior Hearing Officer
Section 45