

TRADUCTION/TRANSLATION

SECTION 45 PROCEEDING

TRADE-MARK: TAIKIDO JIU-JITSU AND DESIGN

REGISTRATION NO.: TMA339896

On September 28, 2005, at the request of BCF LLP, the Registrar sent a notice pursuant to section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to André Lauzon (current owner) owner of the trade-mark contemplated by the above-mentioned registration.

The trade-mark TAIKIDO JIU-JITSU and design (the Mark) as illustrated hereunder



is registered in association with the following services: the operation of a martial arts school (the Services).

Section 45 of the Act requires the registered owner of a trade-mark to establish the use of the Mark in Canada in association with each of the wares and/or each of the services specified in the registration, at any time during the three year period immediately preceding the date of the notice

and, if not, to provide 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 from September 28, 2002 to September 28, 2005.

In response to the notice, the current owner provided the solemn declaration of André Lauzon, to which exhibits were attached but not described or referred to in this solemn declaration. The parties filed written arguments and only the current owner was present.

In his declaration, Mr. Lauzon stated the following:

[TRANSLATION]

- (1) The trade-mark “TAIKIDO JIU-JITSU” and design were used in Canada during the three (3) years preceding the date of the CIPO’s notice, namely September 28, 2005, in regard to each of the services or each of the wares appearing on the register for at least three (3) years;
- (2) All of the alleged facts are true.

This matter raises the following questions:

- (i) Does Mr. Lauzon’s solemn declaration satisfy the evidentiary requirements imposed by the case law for responding to a notice issued by the Registrar pursuant to section 45 of the Act?
- (ii) Do the documents appended to this solemn declaration establish that there was use of the mark within the meaning of subsection 4(2) of the Act?

In the matter of *Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1980), 53 C.P.R. (2d) 62, Mr. Justice Thurlow of the Federal Court of Appeal had to deal with an analogous situation and stated the following:

The mark was registered in 1958 as the trade mark of Pharmaco (Canada) Ltd., for use in association with pharmaceutical preparations and was transferred to the appellant in 1973. On September 7, 1978, at the request of the respondent made on July 6, 1978, a notice in the terms of s-s. 44(1) of the Act was given by the Registrar to the appellant requiring the

appellant to furnish within three months an affidavit or statutory declaration showing with respect to each of the wares or services specified in the registration, whether the trade mark was in use in Canada, and if not, the date when it was last in use and the reason for the absence of such use since such date.

To this, the appellant responded with an affidavit of its president stating:

2. THAT Plough (Canada) Limited is currently using and was on September 7, 1978 using the registered trade mark PHARMACO in the normal course of trade in Canada in association with pharmaceutical preparations.

...

I do not think that the use in this context of the expression "a mere declaration of user" is anything but a way of putting a name on what is required. It is by no means a definition of what is required to show user. In my opinion, the expression . . . is not fairly open to an interpretation that what is required to establish use for the purposes of s. 44 is a mere bald statement that the trade mark is used or has been used.

...

Section 44(1) requires an affidavit or statutory declaration not merely stating but showing use of the mark by describing the use of the mark within the meaning of the definition of trade mark in s. 2 and of use in s. 4 of the Trade Marks Act.

[Emphasis added.]

In light of these guidelines it is clear that the solemn declaration does not respect the requirements of section 45 of the Act.

There were nevertheless documents attached to this solemn declaration. Yet Mr. Lauzon does not refer to these documents at all in his solemn declaration. For that reason I consider that they cannot be admitted into evidence [See *Bereskin & Parr v. Teletronic Communications Ltd.* (1997), 78 C.P.R. (3d) 406]. There is no information regarding the source and the significance of these documents. It is not the Registrar's place to speculate on these points. These shortcomings were raised by the applicant in its written arguments and the current owner did not see fit to remedy them.

I would add that even if I were disposed to accept this evidence for the purposes of this matter, the only documents bearing a date within the relevant period are those resembling advertising signs. However, even though we find the Mark on these signs, we have no evidence that there is connection between the current owner of the Mark and these signs. To the contrary, the documents refer to Raynald Boutin. There is no evidence that there is a verbal or written licence between Mr. Boutin and the current owner of the Mark. Therefore, even if I were to find that this evidence satisfied the requirements of section 4 of the Act regarding the use of the Mark in association with the Services during the relevant period, this use cannot benefit the current owner by the operation of section 50 of the Act. As for the photocopies of photographs, there is no evidence of what they represent and the written notes appearing on them cannot be evidence of their content without explanation.

In the circumstances, the current owner did not discharge his burden of establishing the use of the Mark within the meaning of subsection 4(2) of the Act during the relevant period or of explaining the special circumstances justifying the non-use of the Mark.

Registration number LMC339896 will be expunged from the register in accordance with subsection 45(5) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, ON JANUARY 30, 2008.

Jean Carrière,
Member of the Trade-Marks Opposition Board