

SECTION 45 PROCEEDINGS
TRADE-MARK: STUDIO
REGISTRATION NO.: TMA 218,213

On January 2, 1998, at the request of Cosmoda Concept Corporation, the Registrar forwarded a Section 45 notice to Walter A. Nufer trading as: Nufer-Optik Neostyle Walter A. Nufer, the registered owner of the above-referenced trade-mark registration. The registration page shows that the registered owner changed its name on February 12, 1993 and again on April 1, 1993 which changes were recorded on the registration on May 28, 1999. The owner's name now reads Neostyle Nufer-Optik GmbH & Co. KG.

The trade-mark STUDIO is registered for use in association with the wares "sunglasses, spectacle frames".

In response to the notice, an affidavit of Walter A. Nufer was furnished together with exhibits. Each party filed a written argument and was represented at the oral hearing.

In his affidavit, Mr. Nufer states that he is a partner of Neostyle Nufer-Optik GmbH & Co., KG a Germany Limited partnership of Modernoptik GmbH and of Mr. Nufer and Mrs. Gudrun Nufer (formerly known as Walter A. Nufer trading as: Nufer Optik Neostyle Walter A. Nufer).

He submits that the trade-mark STUDIO has been used in Canada in association with "spectacle frames" and that Neostyle S.R.L. (a Limited Corporation) is licensed, with the authority of Neostyle Nufer-Optik GmbH & Co., KG to use the trade-mark and that under the terms of the license Neostyle Nufer-Optik GmbH & Co., KG, has direct and indirect control of the character and quality of the wares. He then goes on to describe the use that has been made of the trade-mark in association with spectacle frames.

One argument raised by the requesting party is that the document with respect to the registrant's change of names, submitted in the Assignment Section of the Trade-Marks Office, raises questions in that it appears to show something other than a mere change of name of the registered

owner. The requesting party argues that the term “GmbH” is recognized as referring to a company. It submits that as the registered owner Water A. Nufer trading as: Nufer-Optik Neostyle Walter A. Nufer appears to be an individual doing business under a trading style or trade-name, the change to Neostyle Nufer-Optik GmbH & Co., KG cannot be a mere change of name.

I tend to agree with the requesting party that something more than a change of name seems to have occurred. In his affidavit Mr. Water A. Nufer states that he is a “partner” of Neostyle Nufer-Optik GmbH & Co., KG a Germany Limited Partnership. It seems therefore that Neostyle Nufer-Optik GmbH & Co., KG is a limited partnership, consequently, in my view, a separate legal entity from Walter A. Nufer, the individual who was the registered owner at the date of the notice. Consequently, if the partnership is now the owner of the trade-mark, the documents showing the transfer of the trade-mark from Walter A. Nufer to the partnership should have been furnished.

The only document furnished in this case is that which was submitted with the Assignment Section of the Office, that is a certified copy of an extract (in the German language) from the Commercial Register of the District Court at Ludwigsburg, Federal Republic of Germany, accompanied by a declaration from a translator. The translator states that the entry recorded on February 12, 1993 shows that Walter A Nufer trading as Nufer-Optik Neostyle Walter A. Nufer changed its name to Neostyle Nufer Optik KG, and that the entry recorded on April 1, 1993 shows that Neostyle Nufer Optik KG changed its name to Neostyle Nufer-Optik GmbH & Co KG.

However, as pointed out by the requesting party at the hearing, the translator did not translate the document word per word. Rather, she seems to have provided her own interpretation of what the document contains. As there is no indication that she is a person who has knowledge or is familiar with the different entries the commercial register may contain, I am of the view that her interpretation concerning the entries therein cannot be given much weight.

Counsel for the registrant submits that as it is clear from the official document that the changes

occurred in 1993, i.e. prior to the date of the Section 45 notice, the Registrar has no authority to question the dates the changes occurred. However, the issue is not one concerning the dates but one concerning the types of changes that took place. As the new owner, Neostyle Nufer-Optik GmbH & Co. KG is a German Limited partnership (affidavit- paragraph 1), then more than a change of name seems to have occurred. The registrant is the person that could and should have clarified the matter, however, it chose not to. As stated in *Marcus, carrying on business as Marcus & Associated v. Quaker Oats Co. of Canada*, 20 C.P.R. (3d) 46, when the true circumstances are peculiarly within the knowledge of one party, he should bring that evidence forward. It is unreal and unfair to lay the onus on another who, in the scheme of things, has no power to compel production of evidence.

Consequently, when there is a real question as to the truth of a matter, the evidence must be weighed with care. Here, the only evidence furnished is a document in the German language, and I have no idea what it shows except that entries were made in 1993. As I cannot accept the document as showing mere changes of name of the owner, and as there is no evidence showing the transfer of the trade-mark to the partnership, I am not prepared to recognize Nufer-Optik GmbH & Co KG as the registered owner during the relevant period. Consequently, for purposes of the present Section 45 proceedings, the registered owner is still Walter A. Nufer trading as: Nufer-Optik Neostyle Walter A. Nufer.

As the evidence of use furnished is by Nufer-Optik GmbH & Co KG, I conclude that the use shown by such entity or its licensee is not use accruing to the registered owner Walter A. Nufer trading as Nufer Optik Neostyle Walter A. Nufer. As stated in *Lindy v. Registrar of Trade Marks*, 57 C.P.R. (2d) 127 and in *Marcus*, supra, for purposes of Section 45 of the Act, “use in Canada” means use in Canada by the registered owner.

Consequently, as the evidence does not show use by the registered owner, I conclude that the trade-mark registration ought to be expunged.

I would add, however, that if I had been satisfied that Neostyle Nufer-Optik GmbH & Co., KG

(Neostyle) had been properly recorded as registered owner, I would have concluded that the evidence was sufficient to show use of the trade-mark in association with “spectacle frames”.

Registration No. TMA 218,213 will be expunged in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 25th DAY OF APRIL, 2000.

D. Savard
Senior Hearing Officer
Section 45