



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

**Citation: 2013 TMOB 189**  
**Date of Decision: 2013-10-31**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Nickola Trajanovski against registration  
No. TMA668,944 for the trade-mark WORLD BEAT LP  
& Design in the name of KMC Music, Inc.**

[1] On May 26, 2011, at the request of Nickola Trajanovski, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to KMC Music, Inc. (the Registrant), the registered owner of registration No. TMA668,944 for the trade-mark WORLD BEAT LP & Design (the Mark), shown below:



- [2] The Mark is registered for use in association with the following wares:  
Musical instruments; namely, percussion instruments, bells, tambourines, drum mounts, brackets for instruments, instrument stands, rainsticks, chimes, instrument wheels, drum sticks, castanets, whistles, which are specifically designed as musical instruments, thumb pianos, cymbals, bags which are fitted to carry specific musical instruments.
- [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 and services specified in 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 such use since

that date. In this case, the relevant period for showing use is between May 26, 2008 and May 26, 2011.

[4] The relevant definition of “use” in association with wares is set out in section 4(1) 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant furnished the declaration of Joe Vasco, Vice President of the Registrant, sworn on December 16, 2011. Only the Registrant filed written representations; an oral hearing was not held.

#### Evidence of Use during the Relevant Period

[7] In his declaration, Mr. Vasco describes the Registrant as “the world’s largest independent distributor of musical instruments and accessories”. He attests that the Registrant has used the Mark in Canada “since at least as early as August 1991 in association with musical instruments, namely percussion instruments, such as belt tambourine, drum mounts, rain stick, chimes, drum sticks, castanets, whistles, thumb pianos, cymbals and related accessories, such as stands, instrument wheels and bags (casings)”. Mr. Vasco states that the Registrant sells its products across Canada primarily through its wholly-owned subsidiary, B&J Music Ltd.

[8] With respect to the relevant period, he further states at paragraph 4 of his declaration that the Registrant has been using the Mark in Canada “on musical instruments and more specifically on percussion instruments...during the relevant period”. In support, he attaches to his declaration the six exhibits described below.

[9] Exhibit 1 consists of three multi-page invoices from the Registrant to B&J Music dated within the relevant period showing the sale of “a wide variety of musical instruments”. I note that the “Bill To” and “Ship To” addresses are to the same address in Mississauga, Ontario. However, Mr. Vasco states that only “some” of the percussion instruments listed in the Exhibit 1 invoices bore the Mark.

[10] In this respect, Exhibit 2 consists of a photograph of a “Caribbean Conga” drum which Mr. Vasco states is representative of the type of drum sold by the Registrant and delivered to B&J Music as shown in two of the Exhibit 1 invoices. I note that the Mark appears on the side of the drum and on the drum’s box packaging.

[11] Exhibit 3 consists of three further invoices dated May 11, 2009, April 16, 2010, and April 13, 2011. Mr. Vasco states that these invoices evidence sales of percussion instruments in Canada by B&J Music specifically in association with the Mark. Amongst the items listed in the invoices, I note that the descriptions appear to show sales of the following identifiable instruments: “tunable bodhran” (identified by Mr. Vasco as a type of drum), tambourine, cow bell, and cymbals. Mr. Vasco does not otherwise provide any explanation as to the meaning of the item codes or of the abbreviated descriptions in the invoices.

[12] Exhibit 4 consists of photographs of bodhran drums. Mr. Vasco explains that these drums are representative of the type listed in the Exhibit 1 and Exhibit 3 invoices. Although he states that “we can clearly see the [Mark]” on the bodhran, I note that the images are not clear in this respect and that, at best, the trade-mark displayed appears to be a variation of the Mark. In this respect, I note that, unlike the Mark as registered, the word WORLD appears above the globe design and the word BEAT appears below the globe design. As well, it is not clear that the stylized LP element appears as part of the trade-mark displayed on the sides of the bodhans.

[13] Exhibit 5 consists of a one-page spreadsheet which Mr. Vasco attests is “a spreadsheet of the percussion instruments bearing the [Mark] that were sold in Canada by [the Registrant] between 2009 and 2011.” I note that the spreadsheet includes item codes and listings for “congas”, “rainsticks”, “percussion parts for resale”, and various types of drums.

[14] Finally, Exhibit 6 consists of printouts from what appears to be three retail websites, which Mr. Vasco attests are “web pages accessible from Canada offering WORLD BEAT LP & Design percussion instruments for sale”. Mr. Vasco does not explain who operates the websites; however, the printouts appear to be from 2011 and advertise the sale of “World Beat” drums, congas and rainsticks. I note that the images of the instruments are of very poor quality, such that it is difficult to determine whether the Mark appears on the instruments or not.

#### Use of the Mark as registered

[15] As noted above, the drums in Exhibit 4 appear to bear a variation of the Mark as registered. However, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I consider the omission of the “LP” element and the re-positioning of the words “WORLD” and “BEAT” constitutes a minor deviation from the Mark. In my view, the dominant features are the words “WORLD BEAT” and the globe design. As such, when used in combination, the identity of the Mark is preserved and the deviation would not, in my opinion, mislead an unaware purchaser [per *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

#### Use of the Mark in association with the wares

[16] In its written representations, the Registrant submits that showing use for all of the wares listed in the registration is not necessarily required when the declaration clearly states that the trade-mark is used on all of the wares and that adequate examples of use is shown [per *Saks & Co v Canada Registrar of Trade-marks*, (1989), 24 CPR (3d) (49) (FCTD)].

[17] Indeed, when the furnished evidence is viewed as a whole, I am satisfied that the Registrant has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act

in association with the following: drums (supporting “percussion instruments”), cowbells (supporting “bells”), as well as tambourines, rainsticks and cymbals.

[18] However, I note that Mr. Vasco’s statements are not clear regarding use of the Mark with respect to the remaining wares. As noted above, at paragraph 2 of his declaration, he states that the Registrant has used the Mark in association with all of the associated wares since “at least as early as August 1991”. This statement does not clearly address whether the Mark was used in association with all of the wares *during the relevant period*. When introducing the exhibits in later paragraphs, Mr. Vasco’s statements regarding use of the Mark are limited to “percussion instruments” and not to other instruments or the accessory-type wares, such as instrument stands, drum mounts, and brackets.

[19] Furthermore, at paragraph 10 of his declaration, Mr. Vasco states that the Exhibit 5 spreadsheet is of “the percussion instruments bearing the [Mark] that were sold between 2009 and 2011.” I note that the following instruments are not listed in that spreadsheet: chimes, drum sticks, castanets, whistles and thumb pianos. I would also note that none of these wares appear to be listed in any of the Exhibit 3 invoices.

[20] While some instruments, including whistles, appear in the Exhibit 1 invoices, Mr. Vasco makes it clear that not all of the instruments listed in those invoices bore the Mark. The Registrant confirms in its written representations that “Mr. Vasco has provided invoices ... showing a wide variety of musical and percussion instruments *some* bearing the [Mark]” [emphasis added].

[21] Similarly, while Mr. Vasco states that the invoices in Exhibit 3 represent sales of percussion instruments displaying the Mark, not all of the descriptions on the invoices are self-explanatory. As noted above, although I am able to identify certain wares as appearing on the Exhibit 3 invoices, Mr. Vasco does not otherwise explain the meaning of the product descriptions and whether they correspond with any of the remaining wares. In this respect, the Registrant’s written representations do not shed any further light either.

[22] While the Registrant may have sold a wide variety of instruments and related accessories in association with the Mark in the past, it would appear that, during the relevant period, the

Registrant's use of the Mark was limited to certain percussion instruments only. This conclusion is reinforced by Mr. Vasco's own statements and the supporting exhibits.

[23] As such, I find that the evidence furnished by the Registrant is insufficient to establish that the Mark was used in association with the following wares during the relevant period: "drum mounts", "brackets for instruments", "instrument stands", "chimes", "drum sticks", "instrument wheels", "castanets", "whistles, which are specifically designed as musical instruments", "thumb pianos", and "bags which are fitted to carry specific musical instruments."

[24] Furthermore, the Registrant has furnished no evidence to establish special circumstances justifying non-use of the Mark with respect to these wares. The registration will be amended accordingly.

Disposition:

[25] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete the following: "...drum mounts, brackets for instruments, instrument stands ... chimes, instrument wheels, drum sticks, castanets, whistles, which are specifically designed as musical instruments, thumb pianos ... bags which are fitted to carry specific musical instruments".

[26] The amended statement of wares will be as follows:

Musical instruments, namely, percussion instruments, bells, tambourines, rainsticks, and cymbals.

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