

SECTION 45 PROCEEDINGS
TRADE-MARK: COPE
REGISTRATION NO.: TMA 329,931

On September 3, 1997, at the request of Digital Rain Inc., the Registrar forwarded a Section 45 notice to Pulse Publications, Inc., the registered owner of the above-referenced trade-mark at the time. Through assignment, Media America, Inc. became the new owner and was entered as such on the register on March 25, 1998.

The trade-mark COPE is registered for use in association with the following wares:

Periodical publication, namely, a magazine devoted to the subject of living with cancer, written for cancer patients, their families and friends and cancer care professionals published at bi-monthly, monthly or bi-weekly intervals.

In response to the notice, the affidavit of Mike Holt, Chief Executive Officer and Publisher of Media America, Inc., was furnished. Each party filed a written argument. An oral hearing was requested and scheduled, however as both parties advised that they would not be attending, the hearing was cancelled.

Having considered the evidence furnished I am satisfied that it shows use of the trade-mark in Canada by Media America, Inc. in association with the registered wares during the relevant period. Mr. Holt has described the registrant's normal course of trade, he has shown that sales of the wares have occurred in Canada during the relevant period, and he has shown the manner the trade-mark is associated with the wares at the time of transfer. He has provided a selection of publications bearing dates during the relevant period showing the trade-mark on the front cover as well as a copy of a list of Canadian residents to whom the publications were shipped during 1996.

In view of the evidence furnished, it is clear that the trade-mark was being used in Canada during the relevant period and that such use was in compliance with the requirements of Section 4(1) of the Trade-marks Act.

The requesting party has argued that as the recordal of the assignment from Pulse Publications to Media America, Inc., was not made until March 25, 1998, well after the date of the Section 45 notice, then the registered owner at the date of the notice was Pulse Publications, and thus the evidence filed by Media America, Inc. does not suffice since it does not show use by the registered owner at the relevant date.

It relies on the case *Martin J. Marcus v. Quaker Oats Co. of Canada*, 20 C.P.R. (3d) 46, and in particular the following passage:

. . . Must the person who is the registered owner of the mark on the date of the S. 44 [now S. 45] notice, be the party making use of the mark in Canada; can it be an assignee, although not recorded as such? (at 49)

The requesting party states that the Court then held that use for the purposes of Section 45 must be use by the registered owner at the time of the Registrar's notice.

However, as properly argued by the registrant's agents, the assignment of the trade-mark in this case occurred several years prior to the date of the Registrar's notice. Consequently the facts in the present situation clearly differ from the *Marcus* case supra. Consequently, the *Marcus* decision does not apply here. The present case is more in line with the decision *Sim & McBurney v. Buttino Investments Inc. et al*, 66 C.P.R. (3d) 77 affirmed 76 C.P.R. (3d) 482. In that case, the Federal Court dealt with a situation similar to the present one and at the Trial level the Court stated:

It is true that the registrant did not register the assignment with the Trade Marks Office prior to the date of the s. 45 notice. However, according to *Philip Morris Inc. v. Imperial Tobacco Ltd.* 7 C.P.R. (3d) 254 at pp. 267-8 (FCTD); affirmed 17 C.P.R. (3d) 289, . . . an assignment may be valid even if not registered.

In the present case, as Media America, Inc. was the proper owner during the relevant period and entitled to be recorded as registered owner during that period, I conclude that the use shown satisfies the requirements of the Act. The fact that it did not register the assignment with the Trade-marks Office prior to the date of the Section 45 notice is irrelevant.

Consequently, Registration No. TMA 329,931 will be maintained in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 21st DAY OF October, 1999.

D. Savard
Senior Hearing Officer
Section 45