

RE: SECTION 45 PROCEEDINGS  
Trade-mark: CAPS'N PLUGS & Design  
Registration No. 261,603  
Registration Date: August 14, 1981

At the request of Protective Closures Co., Inc., the Registrar of Trade-marks issued a Section 45 notice on July 14, 1989 to John Coupland, the registered owner of the trade-mark CAPS'N PLUGS & Design, registration No. 261,603. The trade-mark CAPS'N PLUGS & Design, a representation of which is set out below, was registered August 14, 1981 in association with "Plastic closures".

An affidavit of John Coupland dated January 11, 1990 was submitted in response to the Section 45 notice. On the same date as he filed his evidence in response to the Section 45 notice, the registrant filed an assignment with the Trade-marks Office assigning his rights in the registered trade-mark CAPS'N PLUGS & Design to Jay Cee Enterprises Limited. The assignment was dated January 11, 1990 and was identified as being effective September 23, 1976. Further, on April 26, 1990, the registrant filed an amended assignment document with the Trade-marks Office which is dated April 23, 1990 and is identified as being effective October 14, 1976. Jay Cee Enterprises Limited was recorded as registered owner on June 8, 1990.

Both parties filed written submissions with the Registrar of Trade-marks and an oral hearing was conducted at which both parties were represented.

The first issue in this proceeding is whether the Nunc Pro Tunc assignment from John Coupland to Jay Cee Enterprises Limited is a valid confirmation of an earlier assignment that had occurred between Coupland and Jay Cee Enterprises Limited but had not been recorded. In this regard, the decision of the Federal Court of Appeal in Marcus, carrying on business as Marcus & Associates v. Quaker Oats Co. of Canada, 20 C.P.R. (3d) 46 is authority for the proposition that the Registrar in a Section 45 proceeding should view with scepticism transactions post-dating the Section 45 notice. Accordingly, it is necessary to carefully consider the evidence filed by the registrant in order to determine whether there was, in fact, an earlier assignment of trade-mark rights from Coupland to Jay Cee Enterprises.

In his affidavit, Mr. Coupland, President of Jay Cee Enterprises Limited, states the following:

4. That I caused my company to be incorporated on October 14, 1976, and I at that time transferred to my company the assets of the business which I had carried on as said proprietorship. Now shown to me and marked Exhibit "A" to this my Affidavit is a copy of an agreement by which said transfer of assets was accomplished.
5. That transfer of assets included the transfer of rights to said trade mark. Now shown to me and marked Exhibit "B" to this my Affidavit is a copy of a Nunc Pro Tunc Assignment, dated January 11, 1990, and affirming the earlier transfer of trade mark rights.

The agreement annexed to the Coupland affidavit is dated September 23, 1976 and appears to have been prepared in anticipation of the incorporation of Jay Cee Enterprises in that paragraph 4 of the agreement provides for completion of the agreement in the following manner:

4. This transaction of purchase and sale shall be completed at the offices of the purchaser on the     day of             , 1976, or at such time and such later date as the Purchaser may approve.

Further, included in the assets and property of John Coupland covered by the agreement are "intangible assets, intellectual property".

The requesting party has pointed to a discrepancy in the Nunc Pro Tunc document

accompanying the Coupland affidavit in that Jay Cee Enterprises was incorporated October 14, 1976, subsequent to the effective date of the assignment. However, the registrant filed an amended assignment document with the Trade-marks Office which, in addition to providing that the assignment is effective October 14, 1976, includes the following statement:

"John Coupland further acknowledges and confirms an agreement (sic) executed by him in this matter dated September 23, 1976 and completed on October 14, 1976."

I am satisfied that the Coupland affidavit and accompanying agreement, together with the amended Nunc Pro Tunc assignment document, confirm the transfer of rights in the registered trade-mark owned by John Coupland to Jay Cee Enterprises.

The requesting party has also submitted that the evidence filed in response to the Section 45 notice does not show use of the registered trade-mark in association with "plastic closures" within the scope of Sections 2 and 4(1) of the Trade-marks Act, but rather evidences use of a business name or trade style. In paragraph 6 of his affidavit, Mr. Coupland states that his company's business is the "wholesale of protective closure devices". He goes on to note that in the normal course of its business, his company distributes various catalogues and product illustration sheets describing the products which are available for sale, a number of which fall within the general description of plastic closures. According to Mr. Coupland, orders are placed by his company's customers from the catalogues and the wares are shipped to customers in containers, a sample of which is annexed to his affidavit. In paragraph 10, the affiant states that to his knowledge, all shipments of products made by his company were in packages of different sizes but substantially the same as the container of Exhibit "D" and all such containers bore shipping labels substantially the same as the labels of Exhibit "D". I would note, however, that the container annexed to the Coupland affidavit is identified as Exhibit "E", and not Exhibit "D".

While I agree that the registrant may be using the mark Caps'n Plugs as a trade-name or trading style, I am of the view that it is also using the mark CAPS'N PLUGS & Design as a trade-mark to distinguish wares sold by it to its customers from those of others in that the trade-mark appears on packages in which the registrant's closures are sold and is thereby associated with the closures at the time of transfer of possession in those wares in the normal course of trade. Additionally, the invoices annexed to the Coupland affidavit confirm the sale of various wares most of which could, in my opinion, be considered as falling within the generic description of plastic closures even though they are otherwise described in the registrant's catalogues as grips, fasteners, glides, caps or plugs of various kinds.

In view of the above, I am satisfied that the registered trade-mark CAPS'N PLUGS & Design was in use in Canada in association with plastic closures as of the date of the Section 45 notice. Accordingly, I have concluded that the present registration ought to be maintained.

DATED AT HULL, QUEBEC THIS 19th DAY OF June, 1991.

G.W. Partington,  
Chairman,  
Trade Marks Opposition Board.