



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

Citation: 2013 TMOB 158
Date of Decision: 2013-09-25

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Marks & Clerk against registration
No. TMA330,707 for the trade-mark ERICSON in the
name of The Ericson Manufacturing Company.**

[1] At the request of Marks & Clerk (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on June 27, 2011 to The Ericson Manufacturing Company (the Registrant), the registered owner of registration No. TMA330,707 for the trade-mark ERICSON (the Mark).

[2] The Mark is registered for use in association with the following wares:

(1) Electrical wiring plugs and sockets for plugs, portable safety transformers and circuit interrupters, electrical extension cords and electric cord shields and ducts, but not including couplings for electrical conduits, electronic instrumentation, electronic communication equipment or electronic signalling equipment; electronic trouble lights and temporary lighting fixtures.

[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 June 27, 2008 and June 27, 2011.

[4] The relevant definition of “use” with respect to 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 the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of John Ericson Jr., President of the Registrant, sworn on December 13, 2011. Only the Registrant filed written representations; no oral hearing was held.

Evidence Submitted by the Registrant

[7] In his affidavit, Mr. Ericson asserts that, during the relevant period, the Registrant sold all of the registered wares in Canada in the normal course of trade and furthermore that the Mark appeared on all of the wares or their packaging.

[8] While Mr. Ericson makes no clear statements regarding the business operations of the Registrant, it would appear that the Registrant is a U.S.-based manufacturer and distributor of electrical supplies and equipment with customers in Canada.

[9] In support of his assertion of use in association with all of the wares as registered, Mr. Ericson furnishes photographs of each ware as part of Exhibit 1 to his affidavit, namely: a) an electrical wiring plug and socket; b) a portable safety transformer; c) a circuit interrupter; d) an electrical extension cord; e) an electric cord shield; f) an electrical cord duct; g) an electronic trouble light; and h) a temporary lighting fixture.

[10] He attests that each of the depicted wares is representative of the wares sold in Canada during the relevant period. I note that the wares display the Mark, either as a word mark or as a design mark with a stylized letter “O” element in “ERICSON”. Although the photographs for the circuit interrupter and the electrical cord duct do not show the Mark clearly, Mr. Ericson

acknowledges this in his affidavit and attests to the location on each product where the Mark appears.

[11] In addition to the exhibited photographs, for each of the depicted and registered wares, Mr. Ericson also furnishes eight representative invoices issued by the Registrant to various Canadian customers. Although Mr. Ericson does not clearly attest to whether the invoices accompanied the wares when shipped, I note that the Mark appears on the invoice in several places. In any event, I note that each invoice has an order date and shipping date within the relevant period, showing sales of various goods, including the particular registered ware identified by Mr. Ericson. As such, I accept that the invoices are representative of transfers in Canada of all of the registered wares in the normal course of trade during the relevant period.

Disposition

[12] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark in association with all of the wares as registered within the meaning of sections 4 and 45 of the Act.

[13] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be maintained.

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