



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

**Citation: 2010 TMOB 173**  
**Date of Decision: 2010-10-20**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Ridout & Maybee LLP against registration  
No. TMA596,991 for the trade-mark COLUMBIA in the  
name of PI-Design AG**

[1] At the request of Ridout & Maybee LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on June 18, 2008 to PI-Design AG (the Registrant), the registered owner of the above referenced trade-mark.

[2] The trade-mark COLUMBIA (the Mark) is registered for use in association with the following wares “non-electric coffee makers, non-electric tea makers, all for household purpose” (the Wares).

[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 18, 2005 and June 18, 2008 (the Relevant Period).

[4] “Use” in association with wares is set out in s. 4(1) and 4(3) of the Act. In this case, only s. 4(1) applies:

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 s. 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. As stated by Mr. Justice Russell in *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owners' business and merchandising practices.

[6] In response to the Registrar's notice, the Registrant filed a single affidavit, with accompanying exhibits, sworn by two of its employees, Jacob Rode and Susanne Muff-Staffelbach, on December 4, 2008, in accordance with the laws of Switzerland. Neither party filed written submissions; an oral hearing was not requested.

[7] At the outset of the affidavit, it is stated that by virtue of their positions, both affiants have personal knowledge of the matters deposed therein. Accordingly, I am prepared to accept that both affiants have the same knowledge, are presenting the same facts, and that all the statements in the affidavit are the sworn statements of each of them.

[8] The affiants describe the Registrant as a member of a group of companies collectively known as the Bodum Group, headquartered in Switzerland. They attest that in Canada, the Registrant licenses the use of its trade-marks, including the Mark, to Peter BODUM A/S, a Danish company, which sub-licenses the use of these trade-marks in Canada to BODUM Inc. They note that each company is a member of the Bodum Group.

[9] The affiants state that BODUM Inc. operates in Canada selling and distributing housewares and kitchenwares, including coffee makers, tea makers and related products under a variety of licensed trade-marks, including the Mark. These products are purchased by BODUM Inc. from Peter BODUM A/S, then offered for retail sale to retailers and wholesale to businesses for retail sale to individuals in Canada, the United States and elsewhere, in packaging specified by the Registrant which displays the Mark. BODUM Inc. employs a regional sales manager for Canada in Montreal. Pursuant to the licence agreements between the Registrant, Peter BODUM A/S and BODUM Inc., the Registrant controls the character and quality of the products sold in Canada by BODUM Inc. in association with the Mark. I conclude on the basis of this evidence that any use shown by BODUM Inc. is deemed to be use by the Registrant pursuant to s. 50(1) of the Act.

[10] Attached to the affidavit as Exhibit B are “representative samples of packaging applied to non-electric coffee makers and non-electric tea makers and related products, all for household purposes, sold by BODUM Inc. in association with the trade-mark COLUMBIA licensed from Pi-Design (through Peter BODUM A/S) namely, non-electric tea and coffee press (model no. 1303-16 and 1308-16), a non-electric teapot (model no. 1315-16), and a set of sugar and creamer dispensers (model no. 1305-16).” The affiants state that this packaging is identical to the packaging which currently appears and has appeared on these products at the time of their sale and delivery to customers in Canada throughout the Relevant Period. I note that the Mark can be clearly seen on all of the relevant packaging samples provided. Although a second trade-mark – “BODUM” in white lettering on a dark background with a ® symbol on the right hand side – also appears on the packaging, the law is clear that there is nothing to prevent two trade-marks from being used at the same time in association with the same wares [see *A. W. Allen Ltd. v. Warner-Lambert Canada Inc.* (1985), 6 C.P.R. (3d) 270 (F.C.T.D.)]. In this case, due to their placement on the packaging and their different colours and fonts, I am satisfied that the trade-marks COLUMBIA and BODUM would be perceived as separate trade-marks.

[11] The affiants state that BODUM Inc. sold the Wares in the packaging shown in Exhibit B to various customers in Canada during the Relevant Period, including major coffee and tea retailers and mass merchandisers, as well as smaller retailers such as coffee bars and kitchen supply stores. Substantial sales figures based on the Registrant’s business records for Canadian

sales of non-electric tea and coffee presses and non-electric teapots by BODUM Inc. during 2006 and 2007 are provided in paragraph 10 of the affidavit. Attached as Exhibit C are copies of sample invoices demonstrating sales by BODUM Inc., under its former name BODUM USA, Inc., to such Canadian customers during the Relevant Period. The affiants state in paragraph 8 of their affidavit that these sales were made in the ordinary course of trade in Canada. The invoices reference sales of “BODUM COLUMBIA” products with the model numbers for non-electric tea and coffee presses, non-electric teapots, and sugar and creamer dispenser sets identified by the affiants (1303-16, 1308-16, 1315-16 and 1305-16). Based on the evidence as a whole, I am prepared to accept that “non-electric tea and coffee presses” and “non-electric teapots” are “non-electric coffee makers” and “non-electric tea makers”. Therefore, these invoices confirm that the Wares were sold during the Relevant Period in Canada.

[12] On the basis of this evidence, I conclude that the Registrant has discharged the onus of demonstrating use of the Mark in Canada during the Relevant Period in association with the Wares, within the meaning of s. 45, s. 4(1) and s. 50(1) of the Act.

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

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Ronnie Shore  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office