



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

Citation: 2012 TMOB 66
Date of Decision: 2012-03-28

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Johnston Wassenaar LLP against
registration No. TMA613,422 for the trade-mark IRS
Instant Rock Star in the name of IRS Australia Pty Ltd.**

[1] On August 20, 2008 at the request of Johnston Wassenaar LLP (the Requesting Party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* RCS 1985, c T-13 (the Act) to IRS Australia Pty Ltd (the Registrant), the registered owner of registration No. TMA613,422 for the trade-mark IRS Instant Rock Star (the Mark).

[2] The Mark is registered for use in association with the following wares: Hair care preparations, hair treatments, lotions, shampoos, shampoo-conditioners, conditioners, styling creams, and waxes (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 listed on 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 use since that date. Thus, in this case, the relevant period in which use must be shown is between August 20, 2005 and August 20, 2008 (the Relevant Period).

[4] The relevant definition of “use” 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] In response to the section 45 notice, the Registrant furnished the affidavit of Margaret Ardoni, an Officer and Director of the Registrant. Only the Requesting Party filed written representations; an oral hearing was not held.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*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 et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co v Canada (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.

[7] In her affidavit, Ms. Ardoni states that the Registrant is an Australian company that sells a line of hair care preparations bearing the Mark. She explains that, until an unspecified point in the past, the Registrant's products were distributed in Canada by a Mr. Kurt Bruun. However, Mr. Bruun had a severe accident and terminated his business activities, which disrupted sales of the Registrant's products in Canada. Although not explicit in the affidavit, it would appear that this event occurred prior to the Relevant Period.

[8] Nonetheless, at paragraph 7 of the affidavit, Ms. Ardoni states that the "most recent sale and use of the Trademark in Canada was April 2008". In this respect, she attests that "an existing customer" requested, by email, a shipment of several products to him in British Columbia. Exhibit B consists of three emails between the customer and employees of the Registrant. Two of the emails are from March 2004, predating the Relevant Period. The third email is an inquiry from the customer regarding a further purchase dated April 2008. Exhibit C consists of two invoices which Ms. Ardoni identifies as "confirmation that the sale and shipment of this order occurred and is evidence of the last sales activity in Canada". I note, however, that the invoices are dated September 2006 and January 2007. Accordingly, they do not appear to be related to the Exhibit B emails.

[9] In any event, I note that the Mark as registered does not appear in the body of the invoices. Although the Registrant's "instant ROCKSTAR" logo appears at the top of the invoice, and notwithstanding the Requesting Party's submissions regarding deviation, such use is not generally considered to be in association with the invoiced wares [see *Tint King of California Inc v Canada (Registrar of Trade-marks)* (2006), 56 CPR (4th) 223 (FC)]. Furthermore, the description of the product in each invoice is "HARD ROCK 100ml RRP \$19.95". As the Requesting Party notes, the affiant does not explain the significance of HARD ROCK and does not clearly state which of the Wares, if any, were represented by these sales; nor does she assert that these sales were made in the normal course of trade.

[10] Accordingly, I cannot conclude that the Registrant has demonstrated use of the Mark during the Relevant Period in association with any of the Wares within the meaning of sections 4 and 45 of the Act.

Special Circumstances

[11] Given the finding above, I will now consider whether there were any special circumstances that excuse the absence of use pursuant to section 45(3) of the Act.

[12] Generally, a determination of whether there are special circumstances excusing non-use involves consideration of three criteria, as set out in *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA); the first is the length of time during which the mark has not been in use, the second is whether the reasons for non-use were beyond the control of the registered owner and the third is whether there exists a serious intention to shortly resume use. The decision in *Smart & Biggar v Scott Paper Ltd* (2008) 65 CPR (4th) 303 (FCA) offered further clarification with respect to the interpretation of the second criterion, with the determination that this aspect of the test *must* be satisfied in order for there to be a finding of special circumstances excusing non-use of a mark.

[13] In this case, Ms. Ardono asserts that the Registrant's inability to secure a reliable distributor in Canada constitutes special circumstances excusing non-use of the Mark.

[14] With respect to the first criterion of the *Harris* test, it is not clear from Ms. Ardon's affidavit when the Mark was last used in Canada in the normal course of trade. Evidence with respect to the Registrant's efforts to obtain a Canadian distributor date as far back as 2003, suggesting a period of non-use of at least six years. However, aside from the affiant's vague statement that the Registrant "had their products distributed in Canada" by Mr. Bruun prior to his accident, there is no evidence of use of the Mark in Canada within the meaning of section 4 at any time.

[15] With respect to the second criterion, attached as Exhibits E and F to the affidavit are copies of the Registrant's email correspondence from 2003 and 2004 with an export broker and Canadian distributors regarding potential business with such distributors. It would appear that nothing came of such activities and that the Registrant subsequently discontinued such efforts for some time.

[16] As for the Registrant's activities during the Relevant Period, Exhibits G and I of the affidavit relate to general marketing efforts of the Registrant, including attendance at a trade show in Hong Kong and the operation of social networking pages on the Internet. Neither of these efforts appears to be directed at the Canadian market, and any connections to it appear to be incidental. I note, for example, that the Registrant provides no evidence of sales presentations made in Canada or trade shows attended in Canada during the Relevant Period.

[17] The only other evidence presented regarding recent marketing efforts in Canada or targeted towards Canadians postdates the section 45 notice. Attached as Exhibit H are various documents relating to the Registrant's efforts to establish a presence in Canada with the assistance of a business development agency operated by the Australian government. Attached as Exhibit J are invoices for various samples of the Registrant's products shipped to Canadian retailers in late 2008 and early 2009.

[18] However, and also with respect to the third criterion of the *Harris* test, it is not clear whether the Registrant has made any progress in their efforts to resume use in Canada or whether it is likely to discontinue such efforts once again. Absent details regarding the manner of resumption of use of the Mark and, in particular, absent evidence of when sales of the Registrant's Wares are likely to resume in Canada, I cannot conclude that the Registrant has

provided sufficient evidence demonstrating a serious intention to shortly resume use of the Mark in Canada.

[19] In any event, given that the evidence reveals a lack of continuous effort on the part of the Registrant to acquire a Canadian distributor during the Relevant Period, I am not satisfied that the reasons for non-use were beyond the Registrant's control.

[20] Accordingly, I must conclude that the Registrant has not demonstrated special circumstances excusing non-use of the Mark during the Relevant Period within the meaning of section 45(3) of the Act.

Disposition

[21] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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