



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

Citation: 2012 TMOB 241
Date of Decision: 2012-12-12

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Kirby Eades Gale Baker against registration
No. TMA669,411 for the trade-mark TOKAIDO &
Design in the name of Helen Bremner**

[1] On June 17, 2010, at the request of Kirby Eades Gale Baker, the Registrar forwarded a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Helen Bremner the registered owner (the Registrant) of registration No. TMA669,411 for the trade-mark TOKAIDO & Design (reproduced below) (the Mark):



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

- (1) Martial arts uniforms; t-shirts; belts for use in martial arts; footwear for use in martial arts.
- (2) Boxing gloves; striking pads for use in martial arts competitions and training; accessories, namely hand, groin, chest and head protectors for use in martial arts competitions and training; bags adapted to carry sporting articles; parts and fittings for all the aforesaid goods.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show, with respect to each of the wares or services specified in the registration, whether the trade-mark was in use in Canada at any time during 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. In this case, the relevant period for showing use is any time between June 17, 2007 and June 17, 2010 (the Relevant Period).

[4] The relevant definition of “use” in the instant case 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 Registrar’s notice, the Registrant filed her own affidavit, together with Exhibits 1 to 3, sworn January 10, 2011. Neither party filed written representations or requested an oral hearing.

[6] 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 threshold test is quite low [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270].

[7] Ms. Bremner states that she is the owner of record of the Mark, which is registered in association with “martial arts uniforms and equipment”. As she collectively refers to these wares as the “Tokaido Products” throughout her affidavit, I will do the same, unless indicated otherwise.

[8] Ms. Bremner states that in 2006, she personally entered into a License Agreement with Kwong Wing & Co. (China) Ltd. (Kwong Wing), a member of the Kwong Wing Group, whereby she granted Kwong Wing the right to manufacture and sell the Tokaido Products in Canada. She states that such License Agreement has always been in full force.

[9] More particularly, Ms. Bremner states that during the Relevant Period, the Tokaido Products bearing the Mark have been manufactured and shipped to Canada by Kwong Wing in

accordance with the License Agreement, which provides among other terms and conditions that Kwong Wing is granted 1) the sole right to put the Mark on the Tokaido Products; 2) the right to sell the Tokaido Products in various countries, including Canada; and 3) the exclusive distributorship of Tokaido Products in various countries, including Canada. She further states that by virtue of such License Agreement, she personally has direct control over the character or quality of the Tokaido Products manufactured and sold under the Mark in Canada.

[10] Ms. Bremner then turns to the sale under license of the Tokaido Products in Canada. She provides sales figures for each of the years 2007, 2008, 2009 and 2010, the total of which exceeds \$81,000 US. In support of her assertions of use, she attaches the following exhibits:

- Exhibit 1 consists of a sampling of photographs of some of the Tokaido Products bearing the Mark, namely gloves, striking pads and a martial art uniform (jacket). Ms. Bremner states that depending on the material of the Tokaido Products, a label depicting the Mark is either sewed on the fabric or printed on the product;
- Exhibit 2 consists of web pages extracted from the website *www.kw2.com.hk*, operated by the Kwong Wing Group, featuring some of the Tokaido Products, including martial arts uniforms, boxing gloves, carrying bags, karate mitts, belts for use in martial arts, head protectors, chest protectors and shoes for use in martial arts. Ms. Bremner states that these images typically represent some of the Tokaido Products as sold under license in Canada by Kwong Wing during the Relevant Period. Upon review of these images, I note that some of the Tokaido Products display a variant of the Mark as registered. For instance, the word TOKAIDO and the Chinese characters are sometimes inverted. On other images, the word TOKAIDO is displayed beneath the Chinese characters. In my view, such deviations from the Mark as registered are inconsequential; the dominant features have been preserved such that the Mark as used maintains its identity and remains recognizable as the registered Mark *per se* [see *Registrar of Trade-marks v Compagnie Internationale pour l'Informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltee v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]; and

- Exhibit 3 consists of a sampling of invoices for the years 2007 to 2010 issued by the licensee Kwong Wing showing sales of Tokaido Products in Canada. Ms. Bremner states that each invoice is accompanied by a packing list (except for the second invoice dated June 20, 2008), a *pro forma* invoice and a bill of lading. Ms. Bremner further states that the Tokaido Products sold and shipped to Canada are indicated as “labelled TOKAIDO” on the *pro forma* invoices. The invoices and packing lists include the abbreviation “TOK” (“Item No.”). Ms. Bremner states that such abbreviation refers to TOKAIDO and it means that the designated products are Tokaido Products bearing the Mark. For ease of reference, Ms. Bremner provides a list of the Tokaido Products identified in the invoices, packing lists and *pro forma* invoices attached as Exhibit 3 and further confirms that all of the following items refer to Tokaido Products marked with the Mark: woven karate set (jacket and trousers), karate mitts, shin and instep guard, chest protector, fist guard, and woven belts.

[11] Ms. Bremner concludes her affidavit stating that the Mark constitutes an important asset for herself and her licensee Kwong Wing, and that there is no intention to abandon such trademark.

[12] In view of the foregoing, and except for the registered wares “t-shirts” discussed below, I am satisfied that the Registrant has evidenced use of the Mark within the meaning of sections 4 and 45 of the Act in association with all of the registered wares in Canada during the Relevant Period. Indeed, the demonstrated use of the Mark by the licensee Kwong Wing inures to the benefit of the Registrant pursuant to section 50(1) of the Act.

[13] However, the Registrant has not furnished any evidence with respect to the registered wares “t-shirts”. Ms. Bremner does not attest that she or Kwong Wing sold any t-shirts in Canada in association with the Mark during the Relevant Period. There are no facts which would permit me to conclude that during the Relevant Period, the Mark was also in use in association with such wares, and there is no evidence of special circumstances that would excuse the absence of such use. To the contrary, Ms. Bremner’s explicit statements of use with respect to the wares falling under each of the other categories of wares listed in the registration, together with the

accompanying specimens of use and photographs of the wares, lead me to conclude that the Registrant has not used the Mark in Canada during the Relevant Period in association with the category of wares listed in the registration as “t-shirts”.

[14] Disposition

[15] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended in compliance with the provisions of section 45 of the Act to delete the wares “t-shirts”.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office