



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

Citation: 2010 TMOB 47
Date of Decision: 2010-04-01

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by WRH Marketing AG against registration
No. TMA601,229 for the trade-mark MEMO STIK in the
name of Conros Corporation**

[1] On January 9, 2008, at the request of WRH Marketing AG (the Requesting Party), the Registrar forwarded a notice under s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Conros Corporation (the Registrant), the registered owner of the above-referenced trade-mark registered in association with “pads of adhesive-backed paper”.

[2] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or 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 use since that date. In this case, the relevant period for showing use is any time between January 9, 2008 and January 9, 2005 (the Relevant Period).

[3] “Use” in association with wares is set out in subsections 4(1) and 4(3) 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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[4] 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 threshold test 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:

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.

[5] In response to the Registrar's notice, the Registrant furnished the affidavit of Mr. Hothi Keshvala, an Officer of the Registrant, together with Exhibits A and B.

[6] Only the Registrant filed written submissions. However, both parties were represented at an oral hearing.

[7] Turning to the evidence introduced by the Keshvala affidavit, Mr. Keshvala states that the Registrant has been selling pads of adhesive-backed paper under the Mark since January 2004 and that the Registrant has used and is using the Mark in Canada in the normal course of trade.

[8] Mr. Keshvala provides the approximate sales of pads (unit sales and dollar value) of adhesive-backed paper under the Mark for the years 2005, 2006 and 2007. The approximate total unit sales for the three year period are 1,970 for a total dollar value of \$48,500.

[9] In support of the sales information, Mr. Keshvala attaches as Exhibit A to his affidavit, two invoices which he states evidence the sale of pads of adhesive-backed paper under the Mark. The invoices are issued by the Registrant. They establish the occurrence of sales of a few

hundred of units of “MEMO STIK – STICKY NOTES” to an entity named Hill S.E. & Associates located in the State of North Carolina, during the Relevant Period.

[10] “[I]n support of the association between the [Mark] and the wares”, Mr. Keshvala further attaches to his affidavit “*Exhibit B which comprises a laminated cardboard backing support to which the wares are attached for sale.*” The cardboard clearly displays the Mark. It also includes a trade-mark notice identifying the Registrant as the owner of the Mark.

[11] Mr. Keshvala concludes his affidavit by stating that “*the [Mark] is being used in Canada by the Registrant with and was being used with pads of adhesive-backed paper in the normal course of business and has been used in the normal course of business during the three years preceding the commencement of these proceedings*” and requesting that a decision to maintain the subject registration on the Register be rendered.

[12] The Requesting Party argues that the Keshvala affidavit does not evidence that the invoices accompany the shipment of wares to the American addressee. It further argues that there is no evidence that the packaging for the wares is affixed to the wares prior to their export from Canada. More particularly, the Requesting Party argues that Mr. Keshvala’s statement that the “[...] *laminated cardboard backing support to which the wares are attached for sale*” is ambiguous for it uses the present tense and can be interpreted as meaning that the cardboard is to be affixed by the client in the United States. I disagree with the Requesting Party’s arguments for the following reasons.

[13] As the Registrant’s evidence pertains to export of the wares, this is a situation where s. 4(3) of the Act applies. In order to demonstrate use under s. 4(3), the Registrant need only show that i) the trade-mark was marked in Canada, ii) on the wares or their packaging, iii) when the wares were exported from Canada. The export of a single item bearing the Mark is sufficient to meet the requirements of use pursuant to s. 4(3) of the Act provided that the export is in the nature of a commercial transaction. There is no requirement for the transaction to be in the normal course of trade [see *Brouillette Kosie. v. Molson Breweries, A Partnership*, 2002 CarswellNat 4408].

[14] In the present case, the wares have been exported to the United States by way of commercial transactions, which are corroborated by the invoices attached as Exhibit A to the Keshvala affidavit. Furthermore, addressing the Requesting Party's argument that the affidavit does not evidence that the invoices accompany the shipment of wares to the American addressee, I note that invoice No. 3200705233 indicates a shipment date that is identical to the invoice date and shows that the invoice was sent to the same entity to which the "MEMO STIK – STICKY NOTES" referred to therein were shipped. Applying the reasoning set out in *Sara Lee Corporation v. Naylor* 2006 CarswellNat 2150 (T.M.O.B.) and *Bereskin & Parr v. Star-Kist* (2004), 37 C.P.R. (4th) 188 (T.M.O.B.), I am prepared to infer that this invoice did accompany the shipment of wares. However, such finding would be relevant in the context of s. 4(1) of the Act in considering the notice of association given to the party who receives the wares, whereas the present situation pertains to s. 4(3). This brings me to address the Requesting Party's second argument pertaining to the marking of the wares.

[15] I am satisfied from my review of the evidence that the Mark was affixed to the packaging for the wares prior to their export from Canada. I find no ambiguity in Mr. Keshvala's statement "*[t]hat in support of the association between the [Mark] and the wares, I attach Exhibit B which comprises a laminated cardboard backing support to which the wares are attached for sale.*" The use of the present tense in this statement is to be read in the context of the affidavit as a whole, wherein other uses of the present tense is made, such as in the paragraph that precedes that statement where Mr. Keshvala states "*[t]hat in support of the sales information presented in paragraph 4, I attach Exhibit A which includes two invoices which evidence the sale of pads of adhesive-backed paper under the [Mark].*" Mr. Keshvala's affidavit describes how the Mark is used by the Registrant itself, that is on packaging consisting of a laminated cardboard, to which the wares are attached for sale.

[16] The Requesting Party's argument that Mr. Keshvala does not expressly state that the laminated cardboard is attached to the wares prior to their export from Canada and that it could be that the cardboard is to be affixed by the client in the United States is not supported by the evidence. There is no indication in Mr. Keshvala's affidavit that the wares exported from Canada are for resale in the United States. Furthermore, in such a hypothetical scenario, it

seems reasonable to me to infer that the pads of adhesive-backed paper and their packaging (laminated cardboard) would still be shipped together.

[17] Having regard to the foregoing, I am satisfied that the Keshvala affidavit is sufficient to show use of the Mark during the Relevant Period in association with the wares in the manner required by the Act.

[18] 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.

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