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

Citation: 2011 TMOB 76
Date of Decision: 2011-05-10

IN THE MATTER OF A SECTION 45 PROCEEDING requested by Kate Henderson against registration No. TMA510,960 for the trade-mark PLANET GROOVE in the name of Jiries Arbid, doing business as Planet Groove

[1] At the request of Kate Henderson (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 August 18, 2008, to Jiries Arbid, doing business as Planet Groove, the registered owner (the Registrant) of registration No. TMA510,960 for the trade-mark PLANET GROOVE (the Mark).

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

[a] Wares: *Baseball caps, labels, tags, T-shirts, sweaters, stickers, jackets, pre-recorded compact discs and cassettes, records, albums*.

[b] Services: *Music entertainment industry namely live musical performance*.

[3] Section 45 of the *Trade-marks 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/or

services 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. In this case, the relevant period for showing use is any time between August 18, 2005 and August 18, 2008. What qualifies as use of the trade-mark is defined in s. 4 of the Act, which states:

> **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.
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> (2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.
>
> (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.

In this case, subsections 4(1) and 4(2) apply.

[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. While mere assertions of use are not sufficient to demonstrate use in the context of a s.45 proceeding (*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 C.P.R. (2d) 194, aff'd (1980), 53 C.P.R. (2d) 63 (F.C.A.)), the threshold for establishing use in these proceedings is quite low (*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)), and evidentiary overkill is not required (*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)). However, 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 or services specified in the registration during the relevant period.

[5] In response to the Registrar's notice, the Registrant furnished the affidavit of Jiries Arbid, the registered owner of the Mark, sworn November 13, 2008, together with a number of exhibits. Neither party filed written submissions; an oral hearing was not held.

[6] As a preliminary matter, I note that the exhibits that were furnished with Mr. Arbid's affidavit were unnotarized. However, given that each item in evidence corresponded without any ambiguity to a clear description in the affidavit, the fact that no submissions were received by the Requesting Party, and keeping in mind the intent and purpose of s.45, I find this deficiency to be a mere technicality and I am prepared to accept the evidence [see *Dashte Morghab Co. v. Rex Inc*. (2005), 52 C.P.R. (4th) 71 (T.M.O.B.), *Smith, Lyons, Torrance, Stevenson & Mayer v. Pharmaglobe Laboratories Ltd*. (1996), 75 C.P.R. (3d) 85 (T.M.O.B.), and *Baume & Mercier S.A. v. Brown Carrying on Business As Circle Import* (1985), 4 C.P.R. (3d) 96 (F.C.T.D.)].

[7] The evidence is summarized as follows:

- Pre-recorded compact discs, dated 2005, 2006, 2007, and 2008, clearly marked with the Mark;
- A baseball cap, labels and tags, a sweater, a jacket, and a t-shirt, all clearly marked with the Mark;
- Event posters advertising live musical performances in Toronto, dated June 10, 2006, May 4, 2007, and October 12, 2008 respectively; and,
- Sales revenue statements for 2005, 2006, 2007, and 2008 of PLANET GROOVE wares sold in Canada.

[8] A trade mark is deemed to be used in association with wares if, in the normal course of trade, at the time of the transfer of the wares, it is marked on the wares or is otherwise associated with the wares. The word "trade" contemplates some payment or exchange for the wares supplied or at least that the transfer of the wares was part of a deal (*Gowling v. Royal Bank of Canada* (1995), 63 C.P.R. (3d) at 322 (F.C.T.D.)). However, as stated in *Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 21 C.P.R. (3d) at 483 (F.C.T.D.), there is no particular type of evidence that must be filed in response to a s.45 notice.

[9] The evidence in respect of wares, as summarized above, consists of an assortment of wares all clearly marked with the Mark, and sales revenue statements. I note that the sales

revenue statements contain a clear breakdown of sales in Canada, during the relevant period, for the following wares: *compact discs, baseball caps, sweaters, t-shirts, and jackets*. As the sales revenues for these wares are substantial, I am prepared to infer that such sales were in the normal course of trade (see *Cast Iron Soil Pipe Institute v. Concourse International Trading Inc*. (1988), 19 C.P.R. (3d) 393 (T.M.O.B.)). In view of the sales records provided in concert with the evidence showing how the Mark was associated with the wares at the time of transfer, I am satisfied that the Registrant has shown use of the Mark in association with "*compact discs, baseball caps, sweaters, t-shirts, and jackets*" in the manner prescribed by s.4(1) of the Act.

[10] I note however, that no evidence of a transfer in the normal course of trade has been provided for the wares described as "*labels, tags, stickers, pre-recorded cassettes, records, and albums*". Furthermore, there is no information to suggest that the use that has been shown should be considered representative of all of the wares. Consequently, I find that the Registrant has failed to demonstrate use of the Mark in association with "*labels, tags, stickers, pre-recorded cassettes, records, and albums*" in the manner prescribed by s.4(1) of the Act.

[11] With respect to the evidence pertaining to use of the Mark with the registered services, I note that two of the event posters clearly advertise live musical performances in Canada during the relevant period, with the Mark clearly appearing on the posters. As such, I am satisfied that the Mark has been shown in association with "*live musical performances*", in advertising materials, during the relevant period. Furthermore, as the posters contain specific information regarding the live musical performances, such as performance locations, featured artists, contact information for the purchase of tickets, etc., I am satisfied that the Registrant offered such services in Canada during the relevant period [see *Wenward (Canada) Ltd. v. Dynaturf Co.* (1976), 28 C.P.R. (2d) (R.T.M.), and *Smith Lyons v. Vertrag Investments, Ltd.* (2000), 7 C.P.R. (4th) 557 (T.M.O.B.)]. Consequently, I find that the Registrant has shown use of the Mark in association with the registered services in accordance with s.4(2) of the Act.

[12] In view of the above, I conclude that use has been shown of the Mark for the wares described as "*compact discs, baseball caps, sweaters, t-shirts, and jackets*" and for the services described as "*music entertainment industry namely live musical performance*"; use has not been

shown for the remaining wares in the registration and there is no evidence of any special circumstances excusing the absence of use. Pursuant to the authority delegated to me under s.63(3) of the Act, the registration will be amended to delete the following wares: "*labels, tags, stickers, pre-recorded cassettes, records, and albums*", in compliance with the provisions of s.45 of the Act.

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Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office