

SECTION 45 PROCEEDINGS  
TRADE-MARK: JOHN SILVER  
REGISTRATION NO: TMA 160,349

At the request of Bereskin & Parr (the “requesting party”) the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on July 7, 2006 to Gallaher Sweden AB, the registered owner of the above-referenced trade-mark.

The trade-mark JOHN SILVER is registered in association with: “cigarettes”

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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 July 7, 2003 and July 7, 2006.

“Use” in association with wares is set out in subsections 4(1) and 4(3) of the *Trade-marks 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.

In this case, ss. 4(1) applies.

In response to the Registrar’s notice, the Registrant furnished the affidavit of Kristina Hassellund, the Finance Director of Gallaher Sweden AB (the Registrant). Both parties filed a written argument. An oral hearing was not conducted.

In paragraphs 3 to 6 of the affidavit, Ms. Hassellund describes the business of the Registrant's parent company, Gallaher Group plc, being that of a large producer of tobacco products.

It is explained that Gallaher Group plc owns a number of well-known cigarette product brands and that amongst its well-known brands are cigarettes offered for sale and sold under the trade-mark JOHN SILVER. Ms. Hassellund further explains that this trade-mark has been registered in numerous countries throughout the world including Canada, and has attached as Exhibit "A" to the affidavit, a list of such countries together with registration particulars. I note that such evidence does not constitute use within the meaning of the Act.

The last two paragraphs of the affidavit are reproduced as follows:

8. As has been noted, JOHN SILVER was registered in Canada on January 3, 1969 under no. 160,349. The trade-mark JOHN SILVER is still widely used, particularly in a number of these countries listed in Exhibit "A". By way of example, the trade-mark has been used on a continuous basis and to a very significant extent in Sweden commencing in 1947 and through to the present.
9. As a result of the foregoing, the trade-mark JOHN SILVER has achieved an important international reputation and good-will, which extends to Canada.

The requesting party's argument was brief, stating, "The affidavit of Kristina Hassellund does not provide any evidence of use of the JOHN SILVER mark as required under the *Trade-marks Act*, and that the registration should therefore be expunged."

After considering the evidence, I am in agreement with the requesting party's argument. Paragraph 8 (above) of the affidavit merely constitutes a bare allegation of use of the mark of the sort found unacceptable in *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (4<sup>th</sup>) 62 (F.C.A.). Furthermore, pursuant to section 45 of the Act, "use" must be shown to have occurred *in Canada*. In this regard, any discussion of "use" of the mark abroad is not relevant for the purposes of section 45.

In view of the above, I conclude that no evidence of use of the trade-mark JOHN SILVER has been provided in the manner required by the Act. Furthermore, as I find that there are no special circumstances that excuse such absence of use, I conclude that the trade-mark registration ought to be expunged.

Registration No. 160,349 will be expunged in compliance with the provisions of Section 45(5) of the Act.

DATED IN GATINEAU, QUEBEC THIS 27<sup>TH</sup> DAY OF MARCH 2008.

K. Barnett  
Junior Section 45 Hearing Officer  
Trade-marks Opposition Board