

SECTION 45 PROCEEDINGS
TRADE-MARK: QUICK
REGISTRATION NO: TMA 162,991

[1] At the request of Shimano Inc. (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) on May 16, 2007 to D.A.M. Neue Deutsche Angelgeräte Manufaktur Int. GmbH (the “registrant”), the registered owner of the above referenced trade-mark (the “Mark”). The Mark is registered in association with fishing reels.

[2] 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 specified in the registration at any time within the three year period immediately preceding the notice date and, if not, to provide the date when it was last in use and the reason for the absence of use since that date. Here, the relevant period for showing use is any time between May 16, 2004 and May 16, 2007.

[3] Use in association with wares is set out in subsection 4(1) of the Act as follows:

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.

Subsections 4(2) and 4(3) of the Act refer to use in association with services and the export of wares, respectively, and do not apply in the present proceedings.

[4] In response to the Registrar's notice, the registrant submitted the affidavit of Jesper Bach Soerensen, Managing Director of D.A.M. Neue Deutsche Angelgeräte Manufaktur Int. GmbH, sworn on November 5, 2007, together with Exhibits "1" and "2". Only the registrant filed written submissions; an oral hearing was not conducted.

[5] Mr. Soerensen states there is a licence agreement in place allowing DAM Fishing Tackle USA to use the Mark, and that the registrant controls the character and quality of the fishing reels sold by DAM Fishing Tackle USA. I am therefore satisfied that the registrant has the requisite control under section 50 of the Act such that any use of the Mark by DAM Fishing Tackle USA in association with fishing reels will enure to the registrant.

[6] Mr. Soerensen sets out the normal course of trade in paragraphs 4 and 5 of his affidavit; DAM Fishing Tackle USA sells QUICK fishing reels to KTL Canada Inc., a Canadian distributor in Mississauga, Ontario, for subsequent sale in Canada.

[7] With respect to the manner in which the Mark is associated with the wares in the registration, Exhibit 2 of the affidavit comprises colour photocopies of packaging bearing the Mark QUICK. Mr. Soerensen attests at paragraph 8 of his affidavit that this is packaging used when QUICK Finessa 940 FS fishing reels were shipped to KTL Canada Inc. during the relevant period. I note that packaging shows the word "QUICK" in close association with the words "Finessa 940 FS".

[8] It is not always the case that a mark used with additional material will be deemed different from the mark as registered. As per *Nightingale Interloc Ltd. V. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.), “use of a mark in combination with additional material will amount to use of the mark *per se* as a trade mark if the public, as a matter of first impression, would perceive the mark *per se* as being used as a trade mark.” In determining this, one might look to whether the mark stands out from the additional material (*Standard Coil Products (Canada) Ltd. v. Standard Radio Corp. et al.* (1971), 1 C.P.R. (2d) 155 (F.C.T.D.)). Here, the Mark “QUICK” is set out on a separate line, and uses a different font colour and style from the words “Finessa 940 FS”. In my view, it is clear that the Mark “QUICK” is used separately from this other material and that “Finessa 940 FS” would be perceived as a different trade-mark used in association with the specific model of fishing reel. In light of this, I am satisfied that the dominant features of the Mark have been preserved, and that the Mark as used maintains its identity and remains recognizable as the registered trade-mark (*Canada (Registrar of Trade-marks) v. Cie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 C.P.R. (3d) 523 at 525 (F.C.A.); *Promafil Canada Ltée v. Munsingwear Inc.*, 44 C.P.R. (3d) 59 (F.C.A.)). I further add that there is no prohibition against using two or more marks together (*Cie Internationale pour l'informatique CII Honeywell Bull, société anonyme v. Herridge, Tolmie and Registrar of Trade Marks* (1983) 4 C.P.R. (3d) 523 (F.C.T.D.), *rev'd* on other grounds in *CII Honeywell Bull, supra* (F.C.A.)).

[9] Mr. Soerensen provides a copy of an invoice from DAM Fishing Tackle USA to KTL Canada Inc., attached as Exhibit 1. The invoice indicates the sale of fishing reels, which Mr. Soerensen states in paragraph 8 of his affidavit bore the Mark at the time of transfer. The affiant

further explains all products on the invoice were sold to the Canadian distributor in the normal course of trade. The invoice reflects a purchasing cycle spanning March and April 2007, wherein the affiant states the products were ordered on March 12, 2007, shipped to KTL Canada Inc. on March 26, 2007, and received by KTL Canada Inc. in Mississauga, Ontario on April 2, 2007. I note that this is within the relevant period.

[10] In view of the foregoing, I am satisfied that there was use of the Mark within the meaning of section 45 and subsection 4(1) of the Act in association with “fishing reels”. Accordingly, and pursuant to the authority delegated to me under subsection 63(3) of the Act, the registration no: TMA 162,991 for the trade-mark QUICK will be maintained in compliance with the provisions of section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC, THIS 26th DAY OF NOVEMBER 2009.

C.R. Folz
Member, Trade-marks Opposition Board