

SECTION 45 PROCEEDINGS
TRADE-MARK: MAESTRO LORENZO
REGISTRATION NO.: 280,076

On February 4, 1994, on the Registrar's own initiative, a Section 45 notice was sent to Jacobs Suchard Ltd., the registered owner of the above-referenced trade-mark registration at the time. On August 10, 1994, the registrant's change of name to "Kraft Jacobs Suchard SA" was recorded on the register.

Prior to this, on October 11, 1991, a Section 45 notice had been issued to the then registrant at the request of a third party. In that proceeding, the registrant furnished the affidavit of Florence Michel, the Trade-Mark Manager of Jacobs Suchard Ltd. of Switzerland. A decision was rendered in the matter by a Member of the Trade-marks Opposition Board. In his decision, Myer Herzig was prepared to infer that the trade-mark was in use on or shortly prior to October 11, 1989. However, given the weakness of the evidence and the registrant's admission that it had ceased use of the trade-mark since 1989, he decided that a second and separate Section 45 notice ought to be issued to the registered owner concurrent with his decision.

The trade-mark MAESTRO LORENZO is registered for use in association with the following wares: "Coffee".

In response to the Registrar's notice, the law firm of Baker McLachlen submitted the affidavit of Harold C. Baker, who identifies his firm as the agent on behalf of the owner of the registration.

Prior to January 1, 1996, Section 45 of the Trade-marks Act required the registered owner to demonstrate use of its trade-mark at any time during the two years preceding the date of the notice. However, Section 45, as amended by the World Trade Organization Agreement Implementation Act now requires the registrant to demonstrate use at any time during the **three year period** preceding the date of the notice for each of the registered wares and/or services. The Trade-marks Opposition Board applies Section 45 as amended to all Section 45 cases whether they were commenced before or after January 1, 1996. Consequently, the relevant period in this case is between February 4, 1991 and February 4, 1994. If the registrant cannot show use within this period, it is required to show the date of last use and provide the reason for the absence of use since such date.

In my respectful opinion, it is clear from the decision rendered in Registrar of Trade-marks v. Harris Knitting Mills, 4 C.P.R.(3d) 188, that while an affidavit filed in response to a Section 45 notice may

be sworn by a third party, the evidence must be furnished by the registered owner. I have serious doubts here whether the Baker affidavit can be considered evidence furnished by the registered owner. Furthermore, as Mr. Baker has not been identified as an officer of the registrant having personal knowledge of the affairs of the registrant, his submissions concerning the reason for the absence of use of the trade-mark consist of inadmissible hearsay evidence. Furthermore, even if such evidence had been acceptable evidence, I would not have been satisfied that it established special circumstances that excuse the absence of use of the trade-mark.

Mr. Baker describes his affidavit as supplementary to that of Florence Michel's, the affidavit filed in the previous proceeding. In that proceeding, the Registrar was prepared to infer that the trade-mark MAESTRO LORENZO might have been used in Canada in October of **1989**. As there is no evidence that the trade-mark may have been used since that date, it would seem that at the date of the present notice, the trade-mark had not been in use for a period exceeding four years.

In paragraph 12, Mr. Baker asserts that ongoing changes of ownership of this registration establish special circumstances that excuse the absence of use. In my view, changes in title of a trade-mark are not in and of themselves sufficient to excuse an absence of use. In this case, I note from the registration page that Jacobs Suchard Ltd. (the owner on February 4, 1994, the date of the notice) became the owner of the trade-mark on November 25, 1991. One wonders why the trade-mark could not be used between November 25, 1991 and February 4, 1994 by such entity.

In paragraph 14 of his affidavit, Mr. Baker refers to paragraph 8 of Florence Michel's affidavit filed in the previous proceeding wherein it is stated that her company was negotiating with a large multinational food company to recommence sale of the trade-mark. However, no evidence concerning any negotiations between Jacobs Suchard Ltd., the owner since November 25, 1991 and a multinational company has been furnished and no details concerning any resumption of use have been provided. What seems clear in this case is that the trade-mark has not been in use since October 1989, was still not in use on February 4, 1994 (the date of the notice) and use had not resumed on November 4, 1994 (the date of the Baker affidavit).

In conclusion, I find that the evidence furnished does not satisfy the requirements of Section 45 of the Act. The Baker affidavit does not appear to be evidence furnished by the registered owner. Furthermore, even considering the affidavit as admissible, it does not show any use of the trade-mark during the relevant period and does not show that the absence of use has been due to special circumstances that excuse the absence of use.

Disposition:

Trade-Mark Registration No. 280,076 will accordingly be expunged from the register in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 1st DAY OF April, 1996.

D. Savard
Senior Hearing Officer
Section 45 Division