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

Citation: 2016 TMOB 31
Date of Decision: 2016-02-24

IN THE MATTER OF A SECTION 45 PROCEEDING

Norton Rose Fulbright Canada LLP	**Requesting Party**
and	
Wubbies World International Incorporated	**Registered Owner**
TMA569,495 for WUB-A-DUB	**Registration**

[1] At the request of Norton Rose Fulbright Canada LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on September 18, 2013 to Wubbies World International Incorporated (the Owner), the registered owner of registration No. TMA569,495 for the trade-mark WUB-A-DUB (the Mark).

[2] The Mark is registered for use in association with "plush toys".

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the goods specified in the registration, at any time between September 18, 2010 and September 18, 2013. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of use with respect to goods is set out in section 4(1) of the Act as follows:

> 4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in a section 45 proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], 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 goods specified in the registration during the relevant period.

Owner's Evidence

[6] In response to the Registrar's notice, the Owner furnished the statutory declaration of John Martin Mokrenko (the Mokrenko Declaration), dated December 17, 2013. The Requesting Party filed written representations. The Owner made a request for an extension of time to file substantive written representations. The request was denied as the Registrar no longer grants requests to extend the administrative deadline for filing written representations. Although the Owner requested an oral hearing, the scheduled hearing was cancelled as both parties later indicated that they no longer wished to attend.

[7] Mr. Mokrenko's short statutory declaration states as follows:

> I, John Martin Mokrenko, of the Town of Halton Hills, in the Province of Ontario, DO SOLEMNLY DECLARE THAT:
>
> 1. I am the person named in, and who subscribed, the attached (or annexed) Application No. 1597726 dated the 17th day of December, 2013 by and between Wubbies World International Inc to Canadian Intellectual Property Office.

2. To the best of my knowledge and belief, the matters and facts in it are true.

3. Where matters specifically stated in it are made upon information and belief, I believe them to be true.

AND I make this declaration conscientiously believing it to be true and knowing that it is of the same force and effect as if made under oath.

[8] I note that the Mokrenko Declaration does not provide any assertions of use of the Mark in Canada. In fact, it does not mention the Mark at all.

[9] The Mokrenko Declaration was accompanied by four documents that have not been identified as exhibits and are not accompanied by jurats.

[10] The four documents attached to the Mokrenko Declaration are as follows:

- A letter signed by Mr. Mokrenko with the subject line "Re: Application No 1597726". In the letter, Mr. Mokrenko makes several statements about application No. 1,597,726 for the trade-mark WUBBANUB applied for by Trebco Specialty Products, Inc. (Trebco). Mr. Mokorenko states that he believes the mark WUBBANUB would cause confusion with the Mark, and that Trebco is aware of such confusion. The letter does not provide any information regarding use of the Mark in Canada.

- A page with what appears to be four labels consisting of the Mark with a trade-mark symbol, the phrase "recommended for 3 years and up", the Owner's contact information, and a trade-mark and copyright notice dated 2000, which I note is not within the relevant period (the WUB-A-DUB Labels).

- An undated drawing of a cartoon village with various cartoon characters (the First Drawing) and a castle. The castle is identified as "WUB-A-DUB'S CASTLE" on the drawing.

- A drawing of seven round furry cartoon characters with the handwritten date, "8/9/13" (the Second Drawing). The Mark appears at the top and bottom of the drawing.

Is the evidence admissible?

[11] The Requesting Party's main submission is that the Mokrenko Declaration and the attached documents are inadmissible. The Requesting Party further submits that even if the documents filed by the Owner were held to be admissible, they are insufficient to demonstrate use of the Mark.

Admissibility of the Mokrenko Declaration

[12] The Requesting Party submits that the Mokrenko Declaration is inadmissible because it is impossible to determine whether Mr. Mokrenko has the authority to respond on behalf of the Owner as there is no indication in the Mokrenko Declaration of the status of Mr. Mokrenko within the Owner or of how he is related to the Owner.

[13] In the Owner's written representations, however, it is clearly indicated below the signature block that John Martin Mokrenko is the "President & CEO" of the Owner. As such, I am satisfied that by virtue of his position, Mr. Mokrenko has the authority to respond on behalf of the Owner and that the Mokrenko Declaration is admissible as evidence.

Documents Not Served Upon the Requesting Party

[14] With respect to the documents attached to the Mokrenko Declaration, the Requesting Party submits that the WUB-A-DUB Labels, the First Drawing, and the Second Drawing are inadmissible because they were never served upon the Requesting Party.

[15] In this respect, the Requesting Party submits that the Owner contravened section I of the practice notice, *Practice in Section 45 Proceedings* by failing to serve the three documents on the Requesting Party. It notes that the Requesting Party would have remained under the impression that the only documents relied upon by the Owner was the Mokrenko Declaration and the attached letter regarding application No. 1,597,726. As such, the Requesting Party submits that it would have been deprived of the opportunity to comment on the three other attached documents had it not obtained a copy of the evidence from the Registrar.

[16] The practice notice, *Practice in Section 45 Proceedings*, states the following:

> After the Registrar has forwarded a notice to the registered owner of the trademark under s. 45(1) of the Act ("Section 45 Notice"), a party corresponding with the Registrar must:
>
> 1. send a copy of all correspondence to the other party in the section 45 proceeding; and
> 2. confirm in all correspondence addressed to the Registrar that a complete copy has also been sent to the other party in the section 45 proceeding.

[17] However, there are no legislative or regulatory provisions requiring the Owner to serve or send a copy of the evidence it has filed with the Registrar to the attention of the Requesting Party. Thus, the attached documents cannot be deemed inadmissible on the basis that the Owner failed to send a copy of its evidence to the Requesting Party. Section 45 of the Act simply requires the registered owner to furnish its evidence within the prescribed time frame, and stipulates that the Registrar shall not receive any evidence other than the affidavit or statutory declaration filed by or on behalf of the registered owner.

[18] In this case, Mr. Mokenkro filed his evidence with the Registrar in compliance with the Act within the prescribed deadline.

Admissibility of the Attached Documents

[19] The Requesting Party further notes that the WUB-A-DUB Labels, the First Drawing, and the Second Drawing were neither properly notarized, nor described or referred to in the Mokrenko Declaration. As such, citing *MBM & Co v Belize Bicycle Canada Reg'd*, 2010 TMOB 141, CarswellNat 3503 and *Phillips, Friedman, Kotler v Acme Bedding & Felt Co*, 1999 CarswellNat 3494 (TMOB), the Requesting Party submits that the attached documents must be considered inadmissible or disregarded accordingly.

[20] In this respect, it has been established that technical deficiencies in evidence should not stop a party from successfully responding to a section 45 notice where the evidence provided could be sufficient to show use [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. On occasion, the Registrar has accepted evidence that is not properly notarized if it is properly identified and explained in the declaration [see *Borden & Eilliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)].

[21] In this case, all four documents attached to the Mokrenko Declaration, including the letter regarding application No. 1,597,726, are not notarized. Although I note that the Mokrenko Declaration does make reference to an attached "Application No. 1597726", it is clear that none of the attached documents constitutes a trade-mark application. Since Mr. Mokrenko provides no further explanation or a description of the "Application No. 1597726" in his declaration, I cannot resolve this ambiguity in the Owner's favour [see *Plough, supra*]. As such, it is more than a mere

technical deficiency that none of the attached documents is notarized. Furthermore, the Mokrenko Declaration does not explain or even identify any of the attached documents. Accordingly, I find all four documents attached to the Mokrenko Declaration to be inadmissible in this case.

Did the Owner use the Mark in association with the goods during the relevant period?

[22] I agree with the Requesting Party that the Mokrenko Declaration itself does nothing to explain the Owner's use of the Mark during the relevant period or otherwise. The declaration simply attests to the truth of "Application No. 1597726". In fact, as mentioned above, the Mokrenko Declaration itself makes no mention of the Mark at all.

[23] Given that the Mokrenko Declaration provides no assertion of use and no admissible evidence demonstrating use of the Mark, I am not satisfied that the Owner has demonstrated use of the Mark as set out in sections 4 and 45 of the Act.

[24] In any event, even if I were to consider the four attached documents as forming part of the Mokrenko Declaration and thus, as admissible evidence, I would still not be satisfied that the Owner has demonstrated use of the Mark. In this respect, the attached documents contain no allegations regarding use of the Mark by the Owner, no description of the Owner's normal course of trade, no explanation of how the Mark was marked on or otherwise associated with "plush toys", and no indication that there was any transfer of property or possession of "plush toys" in Canada during the relevant period.

[25] As noted above, the first document is a letter regarding application No. 1,597,726. Although it mentions the Mark, the content of the letter pertains only to matters of confusion and bad faith, which are beyond the scope of a section 45 proceeding. The letter provides no particulars relevant to whether the Mark was used during the relevant period within the meaning of section 4 of the Act.

[26] With respect to display of the Mark, although the Mark appears in the WUB-A-DUB Labels and in the Second Drawing, I agree with the Requesting Party that there is no indication

that these were actually marked on or otherwise associated with "plush toys" in Canada during the relevant period.

[27] Moreover, as the Requesting Party notes, the copyright notice on the WUB-A-DUB Labels refers to the year 2000, which significantly predates the relevant period. Since the Owner provided no evidence to clarify when or how the labels were used, I cannot resolve this ambiguity in the Owner's favour [see *Plough*, *supra*]. Indeed, it is not clear that the labels were for plush toys rather than some other product.

[28] Finally, none of the attached documents provides any evidence of a transfer of the goods, in Canada or elsewhere. Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], evidence of at least one transfer in the normal course of trade in Canada during the relevant period is necessary. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements. In this case, however, there is no evidence whatsoever which would allow me to conclude that WUB-A-DUB plush toys were ever actually sold in Canada, or elsewhere.

[29] In light of the foregoing, I find that even if I were to admit the attached documents into evidence, they would not have been sufficient to demonstrate use of the Mark during the relevant period as required by sections 4 and 45 of the Act. Furthermore, there is no evidence of special circumstances excusing non-use of the Mark before me.

Disposition

[30] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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Andrea Flewelling
Acting Chairperson
Trade-marks Opposition Board
Canadian Intellectual Property Office

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

No Hearing Held

AGENTS OF RECORD

No Agent Appointed	For the Registered Owner
Norton Rose Fulbright Canada LLP	For the Requesting Party