



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

Citation: 2011 TMOB 73
Date of Decision: 2011-05-24

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by McCarthy Tetrault against registration
No. TMA590,907 for the trade-mark GET IN THE ZONE
in the name of AutoZone Parts, Inc.**

[1] At the request of McCarthy Tetrault (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 December 19, 2008, to AutoZone Parts, Inc., the registered owner (the Registrant) of registration No. TMA590,907 for the trade-mark GET IN THE ZONE (the Mark).

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

Retail auto parts store services.

[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 December 19,

2005 and December 19, 2008. What qualifies as use of the trade-mark in association with services is defined in s.4(2) of the Act, which states:

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.

[4] In response to the Registrar's notice, the Registrant furnished the affidavit of Jamey Traywick, a Director of E-Commerce with the Registrant, sworn June 16, 2009, together with exhibits. Only the Registrant filed written submissions; an oral hearing was not held.

[5] 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.

[6] In his affidavit, Mr. Traywick explains that the Registrant currently operates a substantial number of retail stores physically located in the United States, dealing in the retail sale of auto parts. He indicates that the Registrant also operates a website, *www.autozone.com*, which permits customers, including customers located in Canada, to look up parts information and then order and pay for auto parts via the telephone. The orders are then physically delivered to the Canadian customer in Canada. He then states "During the years 2006, 2007, and 2008 AutoZone Parts, Inc. made numerous sales of auto parts to Canadians, which were delivered to the Canadian customer at the customer's Canadian address."

[7] Mr. Traywick provides data regarding the number of unique Canadian visitors to the website, *www.autozone.com* for the years 2006, 2007, and 2008, as follows:

2006 - 211,467 unique Canadian visitors

2007 - 300,100 unique Canadian visitors

2008 - 431,350 unique Canadian visitors

[8] The remainder of the relevant evidence is summarized as follows:

- Spreadsheets containing listings of representative sales transactions of auto parts to Canadian customers during the relevant period (“sales records”);
- Printouts of pages from the Registrant’s website, *www.autozone.com*, clearly displaying the Mark, as the pages appeared at various points of time during the relevant period; and
- Printouts of representative advertising circulars published on the Registrant’s website, displaying the Mark, covering the periods August 24-September 20, 2006 and September 21-October 18, 2006 respectively.

[9] Mere advertising of a service in Canada is not sufficient to demonstrate use of a trade-mark in association with services within the meaning of s.4(2) of the Act; the registrant also needs to show that it was prepared to perform the services in Canada during the relevant period [*Porter v. Don the Beachcomber* (1966), 48 C.P.R. 280 (Ex. C.R.) and *Wenward (Canada) Ltd. v. Dynaturf Co.* (1976), 28 C.P.R. (2d) 20 (T.M.O.B.)]. However, a registrant need not have a brick and mortar operation in Canada in order to satisfy the requirements of use in association with services under s.4(2) of the Act. As long as the services “are performed without the Canadian customer having to leave Canada”, and the trade-mark is used in association with the services, that is sufficient to demonstrate “use” [*Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.), *Bedwell v. Mayflower* (1999), 2 C.P.R. (4th) 543, and *Société Nationale des Chemins de Fer Français SNCF v. Venice Simplon-Orient-Express, Inc.* (2000), 9 C.P.R. (4th) 443 (F.C.T.D.) aff’g 64 C.P.R. (3d) 87].

[10] With respect to “retail store services”, the display of a trade-mark on a website, advertising the registrant’s services, has been accepted to constitute “use” within the meaning of s.4(2) of the Act; the requirement being that evidence be furnished to demonstrate that delivery of products was made by the registrant in Canada during the relevant period [see *Law Office of*

Philip B Kerr v. Face Stockholm, Ltd. (2001), 16 C.P.R. (4th) 105 (T.M.O.B.), and *Grafton-Fraser Inc. v. Harvey Nichols and Co.* (2010), 89 C.P.R. (4th) 394].

[11] In the present case, in view of the evidence as a whole, I accept that the Registrant has used the Mark in accordance with s.4(2) of the Act. I do so, as I am of the view that the sales records clearly indicating sales to Canadians (such records including Canadian addresses of purchasers) are corroborative of the affiant's statement that "Canadian residents can and do use this website to look up parts information and then order auto parts from the registrant via telephone, which are then physically delivered to the Canadian customer in Canada."

Furthermore, I have also taken into account the substantial number of Canadian visitors to the Registrant's website, that it is clear from the evidence that many of the goods listed on the sales records are products available for sale on the Registrant's website, and that the printouts of the Registrant's website and advertising circulars clearly display the Mark. As such, I am satisfied that the subject trade-mark was shown in association with "*retail auto parts store services*" through its display on the Registrant's website, and that the Registrant offered and provided such services in Canada during the relevant period.

[12] In view of the above, I conclude that use has been shown of the Mark for the services described as "*retail auto parts store services*". Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

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