



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

Citation: 2012 TMOB 36
Date of Decision: 2012-03-19

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by TRUMPF GmbH & Co. KG against
registration No. TMA471,990 for the trade-mark TRUE
LITE in the name of PRODUITS STANDARD INC./
STANDARD PRODUCTS INC.**

[1] At the request of TRUMPF GmbH & Co. KG (the Requesting Party), the Registrar of Trade-marks issued a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on October 28, 2009 to Standard Products Inc., the registered owner (the Registrant) in respect of registration No. TMA471,990 for the trade-mark TRUE LITE (the Mark).

[2] The Mark is registered for use in association “full spectrum fluorescent lamps”.

[3] 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 date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between October 28, 2006 and October 28, 2009 (the Relevant Period).

[4] The relevant definition of “use” in association with wares is set out in subsection 4(1) 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.

[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 and as such, the evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must “show” how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owners’ business and merchandising practices.

[6] In response to the Registrar’s notice, the Registrant filed the affidavit of Albert Ansky, Vice President-Finance of the Registrant, sworn on December 3, 2009. Only the Registrant filed written arguments; an oral hearing was not requested.

[7] In his affidavit, Mr. Ansky states that the Registrant used the Mark in association with the Wares. Attached as Exhibits 4 to 9 are photographs of the Wares and the packaging material in which they are shipped.

[8] In these photographs, the Mark is etched on each of the Wares and printed on the packaging material as either “TRUE LITE” or “TRUELITE”. The use of “TRUELITE” is a minor deviation from its registered form “TRUE LITE”, I am of the opinion that it would not confuse or deceive an unaware purchaser because the dominant features of the registered mark remain.

[9] Mr. Ansky provides in his affidavit that the Registrant sold these Wares etched with the Mark directly to Canadian customers during the Relevant Period in the normal course of trade. Attached as Exhibit 3 to his affidavit are fifteen representative invoices of sale. These invoices

are all dated within the Relevant Period. They are also all billed and shipped to Canadian addresses.

[10] Each of these invoices relates to sales of wares by the Registrant, including sales of full spectrum fluorescent lamps in association with the Mark. I note that the price for each item sold appears on the invoices preceded by a material description number composed of descriptive letters and numbers. Mr Ansky explains that where the description contains “FS” it refers to “full spectrum fluorescent lamps” while the other letters and numbers designate the size and type. He adds that this number is also etched on the Wares and printed on the packaging material as illustrated in the photographs attached as Exhibits 4 to 9. From this association and the aforementioned evidence, I am able to conclude that the Registrant sold the Wares associated with the Mark to Canadian customers during the Relevant Period in the normal course of trade pursuant to s. 4(1) and s. 45 of the Act.

[11] In view of all of the foregoing and 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.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office