



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

Citation: 2011 TMOB 80
Date of Decision: 2011-06-20

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Kerr & Nadeau against registration No.
TMA519,433 for the trade-mark SANTÉ in the name of
Médias Transcontinental S.E.N.C.**

[1] At the request of Kerr & Nadeau (the Applicant), the Registrar issued a notice under s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, (the Act) on June 19, 2008, to Médias Transcontinental S.E.N.C. Inc. (the Registrant), the registered owner of registration No. TMA519,433 for the trade-mark SANTÉ (the Mark) registered for use in association with “Printed publications, namely: magazines”.

[2] Section 45 of the Act requires the registered owner of a trade-mark to show, with respect to each of the wares or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date. In this case, the relevant period covers June 19, 2005, to June 19, 2008.

[3] Use of a mark in association with wares is defined as follows at s. 4(1) of the Act:

(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.

[4] 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 “dead wood” from the register and as such, the applicable threshold is quite low. In *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270, Justice Russell expressed this as follows:

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.

[5] In response to the Registrar’s notice, the Registrant filed the affidavit of Lise Paul-Hus (the Affiant), the Registrant’s general manager of operations. Neither party filed written representations or requested a hearing.

[6] It is well established that 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.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.), at page 480], and evidentiary overkill is not required [*Union Electric Supply Co. Ltd. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], 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. In addition, the entire burden is with the registrant [*88766 Canada Inc. v. George Weston Ltd.* (1987), 15 C.P.R. (3d) 260 (F.C.T.D.)], and any ambiguities in the evidence must be interpreted against the registrant [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.*, above]

[7] The affiant has worked for the Registrant since September 2006. She states that she has personal knowledge of the facts presented in her statement and that she has access to the records, files and documents of the Registrant and of its subsidiaries and affiliated companies.

[8] Ms. Paul-Hus states that the Registrant is part of a corporate group consisting of various companies working in printing, publishing and magazine publishing. She also states that the

Mark was used continuously in association with magazines over the three years preceding her affidavit: in that respect, she appended to her affidavit excerpts from the magazine BEL ÂGE, which were published and distributed in Quebec in 2005, 2006, 2007 and 2008. I note that even though some of the magazine excerpts provided by the Registrant do not cover the relevant period, the majority of them are dated during that period. The relevant excerpts provided by the Registrant clearly show that the Mark identifies a regular section of the magazine and it does so on the cover page. I therefore consider this evidence to be sufficient proof of use of the Mark as recognized in *United Grain Growers Ltd. v. Lang Michener* (2001), 12 C.P.R. (4th) 89 (F.C.A.), where the Court accepted the presence of the mark in the table of contents of a magazine as acceptable proof of use of the mark in association with magazines.

[9] The Affiant continued her affidavit by stating that Publication Senior Inc. is licensed to use the Mark on the cover page of and inside the magazine BEL ÂGE, and that the Registrant has control of the quality of the magazine since its editor, Ms. Francine Tremblay, is also the senior vice-president of the Registrant's consumer publications department. It is Ms. Tremblay who approves the magazine before it is published, while the Affiant is part of the magazine's administrative team and is responsible for the magazine's operations.

[10] Lastly, Ms. Paul-Hus stated that in Quebec, the magazine BEL ÂGE is distributed by mail to subscribers and is also available at newsstands. She stated that in 2005, 2006, 2007 and 2008, the circulation figures were, respectively, approximately 147,016; 139,287; 137,569 and 136,479.

[11] Based on my reading of the evidence, it is my view that the Mark should be maintained on the Register. The Mark clearly appears on magazines, which were distributed and sold in Canada during the relevant period.

Disposition

[12] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, the registration shall be maintained under s. 45 of the Act.

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

Certified true translation
Johanna Kratz, Translator