



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

Citation: 2013 TMOB 207
Date of Decision: 2013-11-28

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Stikeman Elliott LLP against registration
No. TMA472,384 for the trade-mark TWO CHINESE
CHARACTERS: WU DYI Design in the name of Inventec
Besta Co., Ltd.**

[1] On August 19, 2011, at the request of Stikeman Elliott 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) to Inventec Besta Co., Ltd. (the Registrant), the registered owner of registration No. TMA472,384 for the trade-mark TWO CHINESE CHARACTERS: WU DYI Design (the Mark), shown below:



[2] The Mark is registered for use in association with the following wares:

Electronic dictionaries, electronic notebooks, electronic games, electronic game cassettes, electronic overhead projectors, electronic books, electronic organizers, namely agendas; electronic translators, namely translating dictionary; and electronic handheld graphic organizers; IC cards (integrated circuit cards), memory cards; calculators; data processing machines, word processors, computers, computer terminals, computer peripherals; computer accessory, namely diskettes, computer software and hardware, modem, mouse, printers, keyboard, monitor, scanner, digital audio tape, disk drivers, disks, CD-rom, image scanners, light pens, writing input recognition electronic board, computer software, printers, interface cards, cards, micro-processor chips; recording, transmitting and reproducing equipment for sound and image, namely cassette deck, video-recorder, turntable, amplifier, speaker, laser disk, compact disk, television, video-camera, radio, cassettes, remote control; telephone sets, pagers, facsimile machines; modems, mobile

telephones, cellular telephones, cordless telephones, telephone answering machines, image telephones, radio-frequency modulators; communication equipments, namely telephone, facsimile, telex, cellular phones, automatic teller machines.

[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 and services 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 August 19, 2008 and August 19, 2011.

[4] The relevant definition of “use” in association with wares is set out in section 4(1) of the 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 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 these proceedings 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 wares specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant furnished the declaration of Daniel Chuan-Chuien Deng, Owner of Modick Electronics, the principal Canadian distributor of the Registrant, sworn on March 15, 2012. Both parties filed written representations; an oral hearing was not held.

[7] In his affidavit, Mr. Deng states that the Registrant “has used the trade-mark in Canada for many years and more specifically during the relevant period in association with a wide variety of electronic products”. Mr. Deng explains that “in the normal course of trade of its business in

Canada, [the Registrant] sells its products bearing the mark through its distributor, Modick Electronics and has been doing so since 1996”. In support, Mr. Deng provides the following exhibits:

- Exhibit 1 consists of seven photographs of electronic devices as well as copies of 15 invoices from Modick to various Canadian customers dated within the relevant period. Mr. Deng states that the invoices evidence sales of “various electronic products bearing the ... trade-mark” and that the accompanying photographs depict the products listed on the invoices. I note that the Mark appears on the casing of the depicted products. Although Mr. Deng does not explicitly identify the nature or function of the devices, some of the photographs appear to identify them as computerized dictionaries and include depictions of various “Chinese-Canadian” and “Chinese-English” dictionaries, from which it can be inferred that the devices have a translation function.
- Exhibit 2 consists of a spreadsheet containing product codes which correspond to the product codes displayed on the exhibited invoices. Mr. Deng states that this spreadsheet provides a listing of “all the wares bearing the Mark sold by Modick Electronics in Canada between the years 2008 and 2011”. The spreadsheet identifies the products as “GPS” and “electronic dictionaries”. However, I note that the exhibited invoices only display product codes corresponding with codes for “electronic dictionaries” from the spreadsheet.
- Exhibit 3 consists of copies of five pages from the Registrant’s website, *www.bestacanada.com*. Mr. Deng explains that the website contains information on various electronic products sold by the Registrant through Modick in Canada and that “many of the identified products were sold during the relevant period and still are sold as of today”. These pages are dated after the relevant period and display various products identified as “learning devices”, “electronic dictionaries”, “computerized dictionaries”, “video camera” and “encyclopaedias”. However, while the Mark is displayed as part of a composite mark at the top left hand corner of the pages, with respect to the products themselves, the Mark only appears on the casings of what are identified as “learning devices”, “electronic dictionaries”, and “computerized dictionaries”.

- Lastly, Exhibit 4 consists of a spreadsheet which lists various publication titles and dates. Mr. Deng explains that this is a list of “all advertisements of the (electronic) products bearing the ... Mark that were published in major Chinese newspapers, magazines, weekly within the relevant period”.

[8] In its written representations, the Requesting Party submits that the Registration should only be maintained for the wares specifically listed as “electronic dictionaries”, since the Registrant does not provide sufficient evidence with respect to the remaining wares.

[9] In response, the Registrant submits that the evidence must be considered as a whole [citing *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)] and that demonstrating use with respect to each ware listed on the registration is not necessarily required when the declaration clearly states that the trade-mark is used on all of the wares and that adequate examples of use is shown [citing *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FCTD)] . Furthermore, the Registrant argues that it is an established principle that a statement of wares should be granted a generous interpretation as opposed to a restrictive one [citing *Molson Canada v Kaiserdom-privatbrauveral BamburgWorner KG* (2005), 43 CPR (4th) 313 (TMOB)].

[10] As such, the Registrant suggests that there are adequate examples of use to support the registration with respect to the following listed wares: electronic dictionaries, electronic notebooks, electronic games, electronic game cassettes, electronic overhead projectors, electronic books, electronic organizers, namely agendas; electronic translators, namely translating dictionary; and electronic handheld graphic organizers, calculators; data processing machines, word processors, computers, computer terminals, computer peripherals; computer accessory, namely diskettes, computer software and hardware, modem, mouse, printers, keyboard, monitor, light pens, writing input recognition electronic board, computer software”.

[11] However, even when the furnished evidence is viewed as a whole, I am satisfied that the Registrant has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act only in association with the wares listed as “electronic dictionaries” and “electronic translators, namely translating dictionary”.

[12] With respect to the remaining wares, I find that Mr. Deng does not provide any clear evidence of use, much less a clear assertion of use. At paragraph 2 of his declaration, Mr. Deng merely states that the Registrant has used the Mark in Canada in association “with a wide variety of electronic products”. However, this statement does not clearly identify any of the registered wares, nor does it address whether any such use of the Mark occurred *during the relevant period*. As such, it falls on the supporting exhibits to clarify.

[13] In this regard, although Mr. Deng states that Exhibit 1 contains invoices evidencing sales of “various electronic products”, I note that the products listed on the invoices and depicted on the accompanying photographs appear to be limited to electronic products in the nature of electronic dictionaries and translating dictionaries.

[14] As outlined above, the spreadsheet at Exhibit 2 lists “all the wares bearing the ... mark” that were sold by Modick for the Registrant in Canada during the relevant period. As submitted by the Requesting Party, although the spreadsheet refers to “GPS device”, the Registrant provides no substantive evidence to support use of the Mark in association with such a device. Indeed, the only product referenced on the spreadsheet with corresponding invoices at Exhibit 1 is identified as “electronic dictionaries”.

[15] As noted above, the Exhibit 3 web pages include depictions of various electronic products, but only the devices identified as “dictionaries” appear to bear the Mark. Even if I were to accept the composite mark appearing at the top of the page as display of the trade-mark as registered, these pages are dated after the relevant period and there is no indication that consumers could order any of the depicted devices through the website such that the Mark would have been associated with the devices at the time of sale.

[16] Notwithstanding the Registrant’s assertion in its written representations, and in view of Mr. Deng’s own statements and the supporting exhibits, it would appear that, during the relevant period, the Registrant’s use of the Mark was limited to the wares “electronic dictionaries” and “electronic translators, namely translating dictionary”. Accordingly, the registration will be maintained with respect to these wares only.

[17] As for the remaining wares, the evidence is insufficient to establish use of the Mark within the meaning of sections 4 and 45 of the Act and the Registrant has furnished no evidence of special circumstances justifying non-use with respect to these wares.

Disposition

[18] In view the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete the following from the statement of wares:

“...electronic notebooks, electronic games, electronic game cassettes, electronic overhead projectors, electronic books, electronic organizers, namely agendas; ... and electronic handheld graphic organizers; IC cards (integrated circuit cards), memory cards; calculators; data processing machines, word processors, computers, computer terminals, computer peripherals; computer accessory, namely diskettes, computer software and hardware, modem, mouse, printers, keyboard, monitor, scanner, digital audio tape, disk drivers, disks, CD-rom, image scanners, light pens, writing input recognition electronic board, computer software, printers, interface cards, cards, micro-processor chips; recording, transmitting and reproducing equipment for sound and image, namely cassette deck, video-recorder, turntable, amplifier, speaker, laser disk, compact disk, television, video-camera, radio, cassettes, remote control; telephone sets, pagers, facsimile machines; modems, mobile telephones, cellular telephones, cordless telephones, telephone answering machines, image telephones, radio-frequency modulators; communication equipments, namely telephone, facsimile, telex, cellular phones, automatic teller machines”.

[19] The amended statement of wares will be as follows: “Electronic dictionaries; electronic translators, namely translating dictionary”.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office