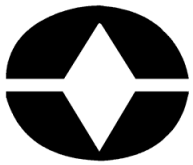
SECTION 45 PROCEEDINGS
TRADE-MARK: O & Design
REGISTRATION NO: TMA 175,229

At the request of Perley-Robertson, Hill & McDougall LLP (the "requesting party") the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on January 27, 2006 to OLIN CORPORATION, the registered owner of registration No. TMA 175,229 for the trade-mark O & Design (the "Mark") reproduced below:



The Mark is registered for use in association with: Snow skis.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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 January 27, 2003 and January 27, 2006.

"Use" in association with wares is set out in subsections 4(1) and 4(3) 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.

> (3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, ss. 4(1) applies.

In response to the Registrar's notice, the Registrant furnished the affidavit of Loretta Succi, an employee working for the firm of Riches, McKenzie & Herbert LLP, the trade mark agents of record for the Registrant. Only the requesting party filed a written argument. An oral hearing was not conducted.

In addition to Ms. Succi stipulating that she has been employed with Riches, McKenzie & Herbert LLP for more than seven years, the remaining paragraph of the affidavit is reproduced below:

> 3. THAT I have been informed by the United States trade mark counsel for the Registrant and I therefore state based on information and belief, that:
>
> a. the Registrant granted a license to use the Trade Mark to a licensee in the United States who in turn appointed a distributor in Canada to distribute snow skis in association with the Trade Mark;
> b. the Registrant had assumed that snow skis were being sold by the Canadian distributor in Canada in association with the Trade Mark;
> c. the Canadian distributor caused the issuance of the Section 45 Proceedings in this matter;
> d. the Registrant is now taking appropriate steps to appoint a new licensee for Canada for use of the Trade Mark; and
> e. special circumstances may have existed which excuse the non-use of the trade mark in Canada between January 27, 2003 and January 27, 2006.

The requesting party has argued, and I must say that I agree, that the affidavit of Loretta Succi constitutes hearsay, attesting to facts that are not within her personal knowledge. The affidavit is based upon information as proffered by the United States trade-mark counsel for the Registrant. Not only is Ms. Succi not an officer of the company (the Registrant), she has not indicated the grounds for belief that the facts so stated in the affidavit are true. Furthermore, in accordance with *Vapor Canada Ltd. v. MacDonald et al.* (1972), 6 C.P.R. (2d) 2004 (F.C.T.D.), she cannot be considered to have personal knowledge of matters told to her by counsel for the Registrant. Although hearsay

evidence may be admissible, wherein the tests of reliability and necessity have been met (see *Labatt Brewing Co. Ltd. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.), such is not the case in the present proceedings, as the Registrant has failed to address these exceptions to the hearsay rule.

The requesting party has argued that aside from the question of admissibility of the evidence, the affidavit has failed to "show" use of the subject mark during the relevant time period, has failed to specify the date when it was last so in use and has failed to advance reasons which excuse its lack of use, as required pursuant to section 45 of the Trade-marks Act.

It is clear that no evidence has been furnished (hearsay or otherwise), showing use of the subject mark pursuant to sections 4 and 45 of the Act. Furthermore, as I have concluded that the evidence furnished constitutes inadmissible hearsay, I need not decide whether there exists special circumstances that may excuse such non-use of the mark.

I would comment however, that the Registrant does not appear to have adequately addressed special circumstances to excuse non-use of the Mark during the relevant period. The applicable test regarding special circumstances has been outlined in *Canada (Registrar of Trade Marks) v. Harris Knitting Mills Ltd.* (1985), 87 C.P.R. (3d) 307 (F.C.A.). Such test involves the consideration of three criteria as follows: (i) the length of time during which the trade-mark has not been used; (ii) whether the reasons for which the owner did not use his mark were due to circumstances beyond his control; and (iii) whether there exists a serious intention to resume use of the mark shortly.

In the present case, the affidavit provides no evidence of use of the mark at any time, nor does it state when the mark was last in use. Moreover, the Registrant has failed to explain why such non-use was beyond its control, simply stating in the affidavit that "the Registrant had assumed that snow skis were being sold by the Canadian distributor in Canada in association with the Trade Mark." Lastly, with respect to demonstrating a serious intention to resume use of the mark, the affidavit does not detail any concrete

steps being taken to resume use of the mark nor does it provide a specific date of resumption.

Having regard to the foregoing, I conclude that the Registrant has failed to provide evidence of use of the Mark during the relevant period in association with snow skis. Registration No. TMA 175,229 will be expunged in compliance with the provisions of Section 45(5) of the Act.

DATED IN GATINEAU, QUEBEC THIS 22nd DAY OF APRIL 2008.

K. Barnett
Hearing Officer
Trade-marks Opposition Board