

SECTION 45 PROCEEDINGS
TRADE-MARK: NORTON
REGISTRATION NO.: TMDA 54550

On March 25, 1998 at the request of Messrs. Shapiro Cohen, the Registrar forwarded a Section 45 notice to Norton Villiers Limited, the registered owner of the above-referenced trade-mark registration.

The trade-mark NORTON is registered for use in association with the following wares:

Motor cycles, side cars, internal combustion engines and parts thereof, speed gears, brakes, clutches, parts and accessories of motor cycles, side cars, and stampings and casting for same.

In response to the notice, the declaration of David Arthur Bennett together with exhibits has been furnished. The requesting party alone filed a written argument. An oral hearing has not been requested in this case.

In his affidavit, Mr. Bennett states that he is Director and Company Secretary of Andover Norton International Limited and that his company has shipped "genuine Norton Motorcycle Parts" on at least three occasions during the three years preceding the date of the notice. As Items 1, 2 and 3 he provides certificates of shipment and relating invoices concerning such supplies of parts.

The requesting party's main arguments are that the evidence has not been furnished by the registered owner or a licensee on behalf of the registered owner; that, although Mr. Bennett has stated that genuine Norton Motorcycle Parts were supplied on at least three occasions during the relevant period, he has failed to indicate or show the manner the trade-mark was associated with the wares at the time of transfer "as required by Section 4(1) of the Trade-marks Act".

First, I agree with the requesting party that if Andover Norton International Limited is now the rightful owner of the trade-mark, the documents of transfer showing that Norton Villiers Limited assigned all of its rights in and to the trade-mark to Andover Norton International Limited should have been produced. Further, I agree with the requesting party that the evidence clearly fails to

show use of the trade-mark NORTON in the manner required by Section 4(1) of the Trade-marks Act.

Section 4(1) reads as follows:

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.

Mr. Bennett has failed to describe the normal course of trade with respect to the wares and the trade-mark. Further, concerning the shipments that were made on three occasions during the relevant three year period, although he has alleged that the goods delivered were "genuine Norton Motorcycle Parts", such an allegation does not constitute an assertion that the trade-mark NORTON was associated with the wares in the manner required by Section 4(1). We are not informed if the trade-mark appeared on the wares themselves or on their packaging, or was associated in any other manner with the wares so that the notice required by Section 4(1) was given to person to whom the property or possession was transferred.

I note that at the top of each invoice several trade-marks are listed namely: AP RACING & Design, NORTON & Design, MZ & Design and ROTAX. However, such marking at the top of the invoices does not constitute use of any of these trade-marks or of the trade-mark NORTON in the manner required by Section 4(1) of the Act as none of the trade-marks, including the trade-mark NORTON, is so associated with a particular item as to provide the required association between the trade-mark and any particular ware sold.

In view of the above, I conclude that the evidence fails to show use of the trade-mark in association with the registered wares in the manner complying with Section 4(1) of the Trade-marks Act and therefore the trade-mark registration ought to be expunged.

Registration No. TMDA 54550 will be expunged in compliance with the provisions of Section 45(5) of the Act.

DATED AT HULL, QUEBEC, THIS 17th DAY OF MAY 2001.



D Savard

Senior Hearing Officer
Section 45 Division