

SECTION 45 PROCEEDINGS  
TRADE-MARK: INDIAN  
REGISTRATION NO: TMA 493,119

At the request of Indian Motorcycle International, LLC., (the “requesting party”) the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on February 1, 2005 to 680187 Ontario doing business as Empire Tobacco Company, the registered owner of the above referenced trade-mark (the “registrant”).

The trade-mark INDIAN is registered for use in association with:

Tobacco products namely cigarettes, fine cut tobacco, snuff, cigars, cigarillos, chewing tobacco, pipe tobacco, and related accessories namely tobacco pouches, cigarette cases, cigarette papers, cigar cutters, cigar cases, cigar humidors, cigarette and cigar lighters, smoking pipes, pipe racks, pipe humidors and other related products namely candy cigars and candy cigarettes.

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. Section 45 requires the proof of use be established by way of an affidavit or statutory declaration. In this case the relevant period for showing use is any time between February 1, 2002 and February 1, 2005.

In response to the Registrar’s notice, the registrant furnished a document signed by Clayton Warmuth. The covering letter accompanying this document identifies it as an affidavit; the requesting party filed written submissions in which it is submitted, *inter alia*, that this document should fail on technical grounds, as it is neither an affidavit nor a

statutory declaration. The registrant did not file written submissions; neither party requested an oral hearing.

As set out above, section 45 clearly requires that the proof of use be established by way of an affidavit or statutory declaration. Accordingly the evidence submitted must be in a form that is sworn or declared before a commissioner for taking oaths.

In the present case, the document provided by the registrant contains the signature of Mr. Warmuth, undated, and the stamp and signature of a commissioner for taking oaths in Ontario with a handwritten date. There is no jurat – no statement that Mr. Warmuth’s statements are made under oath and sworn to before the commissioner. This similar to the situation in *Performance Apparel Corp.v. Uvex Toko Canada Ltd.*, 25 C.P.R. (4<sup>th</sup>) 284, in which Hearing Officer Savard stated that:

“Section 45(1) of the *Trade-marks Act* requires the registered owner to furnish “an affidavit or a statutory declaration showing...whether the trade-mark was in use [emphasis added]. As an affidavit or a statutory declaration must be sworn/declared and commissioned, I conclude that the Wilson document is not a proper affidavit. Further as properly argued by the requesting party, this is not a technical requirement that can be waived by the Hearing Officer as without the swearing/declaring and commissioning, an affidavit or a statutory declaration does not exist. The registrant could have requested a retroactive extension of time pursuant to s.47(2) of the trade-marks Act to try and correct the situation. However, it did not do so.

Consequently, I conclude that the Wilson document is inadmissible in this proceeding. As the registrant has not complied with the requirement of s.45, the evidence not being in the form of an affidavit or statutory declaration, then I conclude that this amounts to a failure to furnish evidence. Accordingly it follows that the trade-mark registration ought to be expunged.”

In *Fawcett v. Linda Lingerie Inc.*, (1984), 2 C.P.R. (3d) 198, Opposition Board Member, David Martin stated at p. 201:

“As for the purported affidavit of Mr. Van den Bosch, I agree with the submissions by the applicant's agent at the oral hearing to the effect that the document signed by Mr. Van den Bosch is not an affidavit at all. Mr. Van den Bosch does not swear or declare to the truth of the contents of his document nor is there any jurat.”

In *Premier Vision Inc. v. Fuzzi S.P.A.*, 31 C.P.R. (3d) 251, G.W. Partington, Chairman of the Trade-marks Opposition Board (as he then was), stated at p. 252:

“By way of its correspondence of April 6, 1989, as well as in its written argument and at the oral hearing, the opponent maintained its objection to the Fuzzi affidavit not having been properly sworn before the notary public whose seal appears on the affidavit. Despite being alerted to the objection raised by the opponent to the admissibility of the Fuzzi affidavit, the applicant elected to proceed on the basis that the Fuzzi affidavit is a properly sworn affidavit. While I am of the view that the board has the jurisdiction to overlook technical deficiencies in the jurat of an affidavit, I consider that the failure to include "sworn before me" in the jurat is more than a technical deficiency which can be overlooked and rather goes to the basis of the document being an affidavit. Thus, while in para.1 Ms Fuzzi does state that she was first duly sworn and it is indicated at the end of the document that Ms Fuzzi signed the document in the presence of a notary, it is certainly not clear from the document that Ms Fuzzi swore to the contents of the document before the notary whose seal and signature appears at the end of the document. Accordingly, I have concluded that the document identified as the affidavit of Anna Maria Fuzzi is not admissible as evidence in this opposition.”

On the basis of the foregoing it is clear that an affidavit or statutory declaration without a jurat to indicate that it has been taken under oath, is not considered admissible as evidence. Accordingly, I must conclude that no evidence has been filed by the registrant pursuant to the section 45 notice which issued on February 1, 2005.

Having decided that the Warmuth document fails on technical grounds to be considered proper evidence as required by section 45 (1), there is no need to assess the sufficiency of the statements therein with respect to whether or not use within the meaning of section 4(1) and 45 has been established. I would comment, however, that there are other issues with the document, in that it does not clearly identify Mr. Warmuth and his relationship with the registered owner, there is ambiguity as the document is written on Empire Tobacco Company, Ltd., letterhead, whereas the registered owner is identified as a numbered Ontario company doing business as Empire Tobacco Company, and no information regarding corporate relationships, names or licensing agreements has been provided therein.

In view of all of the foregoing, it is my conclusion that trade-mark No: TMA No.493,119 for INDIAN ought to be expunged from the Register, for failure to show use pursuant to Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC, THIS 20<sup>TH</sup> DAY OF DECEMBER 2006.

P. Heidi Sprung  
Member, Trade-marks Opposition Board