



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

Citation: 2010 TMOB 57
Date of Decision: 2010-04-27

SECTION 45 PROCEEDINGS
TRADE-MARK: LA LAMPE BERBÈRE DESSIN
REGISTRATION NO.: TMA586,112

[1] At the request of Stikeman Elliott S.E.N.C.L., s.r.l. (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) on August 17, 2006 to Mogador Import Export Inc., the registered owner of the above-referenced trade-mark (the “registrant”).

Lalampe
Berbère

[2] The trade-mark LA LAMPE BERBÈRE DESSIN (shown above) is registered for use in association with the wares “Hand-made oil lamp of metal and glass imported from Morocco. Hand-made bottle of glass and metal that could be used as a lamp, made in Morocco (uses paraffin oil)”, as translated in the *Trade-marks Journal*.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or 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 any time between August 17, 2003 and August 17, 2006.

[4] “Use” in association with wares is set out in sections 4(1) and 4(3) 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.

[...]

(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, section 4(1) applies.

[5] In response to the Registrar’s notice, the registrant furnished the affidavit of Pierre Prud’homme, sworn on October 19, 2006, together with Exhibits “A-1” through “A-5”. Mr. Prud’homme states that he is an officer of 9034-1538 Québec Inc., doing business as “Mogador Import Export”. Both parties filed written submissions; an oral hearing was not requested.

[6] 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 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares/services specified in the registration during the relevant period.

[7] I note that the Canadian trade-marks database indicates “Mogador Import Export Inc.” as the registered owner of the subject trade-mark since its date of registration, namely July 29, 2003; there is no reference to a predecessor in title, a numbered company or to a trading style on the register. In terms of the evidence submitted, Mr. Prud’homme attests in paragraph 3 of his affidavit that 9034-1538 Québec Inc., doing business as “Mogador Import Export”, is the entity who owns, who uses and who registered the subject trade-mark registration on July 29, 2003. The entire affidavit pertains to the use and sales of oil lamps by 9034-1538 Québec Inc.; there is no indication of the latter’s relationship with Mogador Import Export Inc. or an explanation regarding the discrepancy in the two names. Under these circumstances, I am left to conclude that 9034-1538 Québec Inc. and Mogador Import Export Inc. are two separate legal entities; the nature of whose relationship is not explained in the evidence.

[8] Thus, in the absence of a distributorship relationship or indicia of the requisite control under section 50 of the Act, I am unable to infer that the use of the mark by 9034-1538 Québec Inc. enures to the benefit of the registrant, Mogador Import Export Inc. Since there is no other evidence of use provided besides that of 9034-1538 Québec Inc., I am not satisfied that the registrant has used the subject trade-mark in association with the wares specified in the registration during the relevant period in Canada.

[9] I would observe however that the evidence arguably shows use by 9034-1538 Québec Inc. during the relevant period. In this regard, Ms. Prud’homme produces printouts containing photos of a collection of elaborate oil lamps made with glass and alloy, with one particular line identified as La Lampe Berbère. He also provides evidence that the subject trade-mark was associated with the wares at the time of transfer by the insertion of instructional sheets and brochures bearing the trade-mark into packages in which the wares were distributed. In addition, the affiant attests to the fact that the wares were sold during the relevant period with a list of locations across Canada where such wares were made available attached in support.

[10] In any case, as I have concluded that the use shown does not enure to the benefit of the registrant, the trade-mark registration ought to be expunged. Accordingly, and pursuant to the authority delegated to me under section 63(3) of the Act, registration TMA586,112 for the trade-mark LA LAMPE BERBÈRE DESSIN will be expunged pursuant to section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT MONTREAL, QUEBEC THIS 27TH DAY OF APRIL 2010.

P. Fung
Hearing Officer
Trade-marks Opposition Board