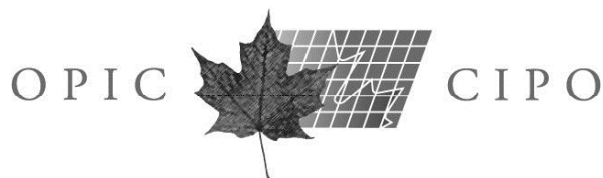


TRADUCTION/TRANSLATION



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

Citation: 2012 TMOB 10
Date of Decision: 2012-01-31

**IN THE MATTER OF A SECTION 45
PROCEEDING requested by Bereskin & Parr
LLP against registration No. TMA483,466 for the
trade-mark BODY PILLOW.**

[1] On December 8, 2008, at the request of Bereskin & Parr LLP (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), to Beco Industries Ltd., the registered owner of registration number TMA483,466 for the trade-mark BODY PILLOW (the Mark) registered for use in association with the following wares: "Bedding, namely pillows" (the Wares).

[2] Section 45 of the Act requires the registered owner of a trade-mark to show, in association with each of the wares specified in the registration, whether the trade-mark has been used in Canada at any time within the three year period immediately preceding the date of the notice. If not, the owner must show the date when trade-mark was last in use and the reason for the absence of such use since that date. The relevant period for showing use is any time between December 8, 2005 and December 8, 2008.

[3] "Use" in association with the Wares is set out in subsection 4(1) of the Act as follows:

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.

[4] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing "deadwood" from the register. The observations made by Mr. Justice Russell in *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270 (F.C.) perfectly illustrate this principle:

86. We know that the purpose of section 45 proceedings is to clean up the "deadwood" on the register. We know that the mere assertion by the owner that the trade-mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under section 45 and apply that provision.

[5] If it is true that the evidential burden applicable to the establishment of the trade-mark's use is such as to avoid evidential overkill, one must still provide the Registrar with sufficient evidence to conclude that the trade-mark was in fact used during the relevant period. The evidence must enable the Registrar to conclude that each of the wares or services specified in the registration have been used within the meaning of section 4 of the Act. Further, the evidential burden falls entirely on the registered owner [*88766 Inc. v. George Weston Ltd.* (1987), 15 C.P.R. (3rd) 260 (F.C.T.D.)], and any ambiguity in the evidence shall be interpreted against the aforementioned [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2nd) 62 (F.C.A.)].

[6] In response to the Registrar's notice, Beco Industries LP produced the affidavit of Luc Olivier, Chief Operating Officer, dated June 8, 2009 (the Affidavit). Documents have been attached to the Affidavit so as to indicate the trade-mark's use. Subsequently, the Requesting Party and Beco Industries LP submitted written arguments. Both parties also requested an oral hearing, which was held on June 21, 2011.

[7] A single invoice may be sufficient to establish trade-mark use [*Philip Morris Inc. c. Imperial Tobacco Ltd. et al.* (1987), 13 C.P.R. (3rd) 289 (F.C.)]. Beco Industries LP submitted multiple invoices and purchase orders relevant to the period in question. Nevertheless, the BODY PILLOW trade-mark is rarely found in the documents presented. In fact, as the Requesting Party indicates, one instead finds abbreviations that describe the product, such as: "ASST BODYCASE AST", "BPLW", "BOD PILLW".

[8] Jurisprudence indicates that a trade-mark is not used by the owner when it is altered using abbreviations or descriptive product elements [*Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3rd) 535 (T.M.O.B.)]. However, in this particular case, Beco Industries LP clearly established in paragraph 13 of the Affidavit and in document "B" that these acronyms refer to cushions sold during the period in question by the trade-mark owner and the owner's predecessors in title of the Mark. The Registrar accepts this assertion as evidence of record.

[9] The Requesting Party claims that the plastic packaging sample (supporting documentation "B") annexed to the Affidavit does not demonstrate use of the Mark. However, as Beco Industries LP indicates, the Mark is prominently displayed on the packaging sample that was used to package and market the cushions (supporting documentation "B"). The Mark was thus prominently displayed on the product's packaging during the transfer of ownership. Therefore, in light of the evidence provided, I find that the use of the Mark in association with the Wares has been demonstrated in accordance with section 4 of the Act.

[10] Nevertheless, a major specification needs to be made. Following an analysis of the elements presented, it has been determined that the evidence submitted by Beco Industries LP demonstrates its use of the Mark. However, as previously indicated, the registered owner as listed in the Trade-Marks Register is not Beco Industries LP, but rather Beco Industries Ltd. Mr. Olivier underlines the following facts from paragraphs 3 to 5 of the Affidavit as an explanation:

- Beco Industries Ltd. was the registered owner of the Mark in Canada for the Wares.

- December 5, 2005, (two years before the affiant took his position in the company), the Mark was assigned for the first time to a company that, to quote the affiant, carried on business under the name of Prince Apparel Limited Partnership.
- That same day, the Mark was assigned a second time; this time to Beco Industries LP.

[11] It must therefore be concluded that according to the Affidavit, Beco Industries Ltd. was the registered owner up until December 5, 2005, the date of the two assignments. Ultimately, through the cumulative effect of these assignments, Beco Industries LP became the new owner of the Mark.

[12] No document has been provided in the annex to support the aforementioned assignments. Further, in its written arguments, Beco Industries LP merely reiterated the summary nature of the proceedings under section 45 and did not provide other relevant elements that could enable the alleged facts to be clarified.

[13] The Act contains no provisions that render obligatory the registration of an assignment with the Registrar so as to accommodate ownership changes. The party that invokes this can provide evidence, such as a certified copy, an original deed of assignment or any other document deemed satisfactory, in order to support its own assignment assertions. While none of these steps are obligatory, they would have been helpful in the analysis of the present record.

[14] It is clearly established that in order to satisfy the Registrar, the affiant must provide sufficiently precise and detailed evidence of the assignment or provide supporting evidence that allow one to make the conclusion that there was indeed a transfer of the trade-mark. [*Gowling Lafleur Henderson LLP v. Midland Walwyn Capital Inc. / Capital Midland Walwyn Inc.* (2011) 90 C.P.R. (4d) 181 (T.M.O.B.)]. To this effect, Mr. Olivier provided, in paragraphs 4 and 5 of the Affidavit, declarations that were sufficiently clear and precise to allow one to make the conclusion that Beco Industries Ltd. assigned the Mark to Beco Industries LP.

[15] As such, I am satisfied that the evidence demonstrates use of the Mark in association with the Wares, within the meaning of paragraph 4 (1) of Section 45 of the Act.

Decision

[16] Consequently, pursuant to the authority delegated to me under subsection 63(3) of the Act, registration number TMA483,466 for the trade-mark BODY PILLOW will be maintained in compliance with the provisions of section 45 of the Act.

Darlene H. Carreau
Chairperson
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Jane Kuna