



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

Citation: 2010 TMOB 146
Date of Decision: 2010-09-14

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by MacRae & Co. against registration
No. TMA600,185 for the trade-mark FOCUS in the name
of Gruner + Jahr AG & Co KG**

[1] At the request of MacRae & Co. (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on October 10, 2008 to Gruner + Jahr AG & Co KG (the Registrant), the registered owner of the above referenced trade-mark.

[2] The trade-mark FOCUS (the Mark) is registered for use in association with the following wares “printed publications, namely, magazines”.

[3] Section 45 of the Act 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 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 between October 10, 2005 and October 10, 2008 (the Relevant Period).

[4] “Use” in association with wares is set out in s. 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, s. 4(1) applies.

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and as such, the evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" 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 s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owners' business and merchandising practices.

[6] In response to the Registrar's notice, the Registrant furnished the affidavit of Rolf Heinz, sworn on April 2, 2009, together with Exhibits A through D. Both parties filed written submissions; an oral hearing was not requested.

[7] In his affidavit, Mr. Heinz states that he is the CEO of Gruner + Jahr/Mondadori (sometimes hereinafter referred to as G+J/M), a joint venture company of the Registrant and Mondadori, an Italian publishing company, and that he has held this position since 2005. He states that by virtue of his position, and through access to corporate records, he has knowledge of the facts stated therein, except where the information is stated to be based on information and belief.

[8] Mr. Heinz states that G+J/M is a licensed user of the Mark, and that as such it is entitled to publish and sell FOCUS magazines in Canada. He also states that the Registrant maintains direct or indirect control of the character or quality of the FOCUS magazines sold in Canada, pursuant to the licence. As an example of such control, he explains that as the CEO, he reports to G+J/M's board of control (Consiglio d'Amministrazione), which is composed of two members from the Registrant and two members from Mondadori.

[9] He describes the normal course of trade for the wares that are sold in Canada, stating that G+J/M publishes the Italian version of the FOCUS magazine and sells its export circulation to its Italian distributor, Press-Di Distribuzione Stampa (formerly Mondadori Editore), which then sells the magazines to a local Canadian distributor, Speedimpex Canada Inc. (Speedimpex). Speedimpex distributes the magazines to retailers in Canada for sale to individual purchasers.

[10] As Exhibit D, Mr. Heinz attaches sample invoices dated during the Relevant Period which show sales of FOCUS magazines from Press-Di Distribuzione Stampa (or Arnoldo Mondadori Editore) to Speedimpex Canada Inc. (with an address in Toronto, Ontario), with the first invoice in the Exhibit dated September 30, 2008 showing the sale of 110 copies of FOCUS magazine. Mr. Heinz states that approximately 1108 copies of the Italian version of the FOCUS magazine were sold in Canada in 2005, 1152 were sold in 2006, 1125 were sold in 2007, and 466 were sold between January and June 2008. Sample invoices showing sales of FOCUS magazines from Gruner + Jahr/Mondadori S.p.A. to Press-Di Distribuzione Stampa e Multimedia S.r.l (and one showing sales of the magazines to Mondadori Editore S.p.A.) are attached to the affidavit as Exhibit C. I note that "G+J/M" appears at the top of all the invoices above "Gruner + Jahr/Mondadori S.p.A."

[11] As for the manner in which the trade-mark was associated with the wares at the time of their transfer, Mr. Heinz states that the Mark appears prominently on the front cover of the magazines sold in Canada, as well as on the index page and beside each of the page numbers in the magazines. By way of example, a copy of the April 2008 issue of the Italian FOCUS magazine, as distributed in Canada, is attached as Exhibit A. Furthermore, copies of sample front cover pages and index pages from other issues of Italian FOCUS magazines distributed in Canada within the Relevant Period are attached as Exhibit B. I note that the Mark appears clearly

on the sample magazine and the excerpts, in the manner described by Mr. Heinz, and that “Gruner + Jahr/Mondadori Spa” appears below the Mark on each of the index pages. I am satisfied that the use shown constitutes use of the registered trade-mark.

[12] The requesting party submits that the evidence provided does not show use of the Mark by the Registrant, or accruing to the Registrant. It argues that the evidence fails to show any association of the Mark directly with the registered owner, and that missing information, such as the legal name of the licensed user Gruner + Jahr/Mondadori or evidence that it is a trading style of or the same legal entity as Gruner + Jahr/Mondadori S.p.A, and the lack of a copy of the licence agreement between the Registrant and G+J/M, render the affidavit insufficient to show use of the Mark in Canada.

[13] The Registrant in response argues that when the affidavit is considered as a whole, that the evidence furnished shows use of the Mark in Canada during the Relevant Period, and that such use accrues to the Registrant. It argues that Mr. Heinz clearly identified the licensed user of the Mark, Gruner + Jahr/Mondadori, as a company, and that this company, referenced as Gruner + Jahr/Mondadori Spa on page 5 of the sample magazine enclosed as Exhibit A, publishes the magazines. It submits that there can be no doubt that the licensed user Gruner + Jahr/Mondadori referred to by Mr. Heinz is the company referenced in this exhibit and in the invoices.

[14] I agree with the Registrant’s submissions, and find it reasonable to accept that the use shown in the evidence is licensed use by a proper licensee pursuant to s. 50 of the Act. In so finding, I have taken into consideration: (i) the purpose of s. 45 of the Act; (ii) that the burden that has to be met by the Registrant is not a heavy one [*Austin Nichols & Co. v. Cinnabon Inc.* (1998), 82 C.P.R. (3d) 513 (F.C.A.)]; (iii) that the filing of a copy of the licence agreement is not mandatory as long as the evidence establishes that the registrant has control over the character or quality of the wares bearing the Mark [see *Gowling, Strathy & Henderson v. Samsonite Corp.* (1996), 66 C.P.R. (3d) 560 (T.M.O.B.), where it was held that for s. 45 proceedings, this can be satisfied by the registrant/licensee clearly swearing to the fact that the control required by s. 50 exists, and *Mantha & Associés/Associates v. Central Transport Inc.* (1995), 64 C.P.R. (3d) 354, wherein the Federal Court of Appeal stated that assertions of facts are clearly adequate]; (iv) the affiant’s sworn statements regarding licensed use and control; (v) the reference to the invoices in

Exhibit C as being those of the licensee; and (vi) the abbreviations in the affidavit for the other company names (Press-Di Distribuzione Stampa and Mondadori Editore). In my view, the facts established, when viewing the evidence as a whole, permit a conclusion that Gruner + Jahr/Mondadori is merely an abbreviation or trading style of Gruner + Jahr/Mondadori S.p.A. Accordingly, I have no difficulty in finding that the provisions of s. 50(1) of the Act have been satisfied and that use of the Mark with magazines by Gruner + Jahr/Mondadori S.p.A. enured to the benefit of the Registrant.

[15] Having regard to the evidence as whole, namely, Mr. Heinz's sworn statements regarding the licence between the Registrant and G+J/M, the control exercised by the Registrant, the normal course of trade of the FOCUS magazine in Canada, the sample magazine and excerpts, and the representative sample invoices showing the chain of transactions in the normal course of trade during the Relevant Period, I find that the evidence clearly demonstrates that there was use of the Mark during the Relevant Period in association with "printed publications, namely, magazines" enuring to the benefit of the Registrant in the manner required by the Act. Accordingly, and pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

Ronnie Shore
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office