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**IN THE MATTER OF A SECTION 45 PROCEEDING  
Respecting Registration No. 296.716 for the trade-mark "CAPTAIN CANADA"**

At the request of Messrs Barrigar & Oyen, the Registrar forwarded a Section 45 notice on November 5, 1990 to Apache Communications International Corporation Limited, the registered owner of the above-referenced trade-mark at the time (hereafter, "the trade-mark"). The trade-mark was registered on November 2, 1984 for use in association with the following wares: "comic books and magazines".

On August 31, 1990 Apache Communications International Corporation Limited amalgamated with other companies to form "GWS Holdings Inc.". "GWS Holdings Inc." was registered as the new owner of the trade-mark on January 17, 1992. Although it is not relevant to the present proceedings, the trade-mark was subsequently assigned by "GWS Holdings Inc." to the current registrant, "The Sunday Herald L td." by a nunc pro tunc assignment of the trade-mark dated July 14, 1991 confirming an earlier assignment of June 6, 1991. "The Sunday Herald Ltd." was recorded on the register as the new owner of the trade-mark on December 18, 1992.

The registrant submitted the affidavit and related exhibits of Mr. Scott Stirling identified as "Director of Apache Communications International Corporation Limited, now called GWS Holdings Inc. (my company)". Exhibits "B" and "0" were missing from the file when the proceedings advanced to the decision stage, hence, they were re-submitted by the agents for the registrant, Messrs. Gowling, Strathy & Henderson on March 21, 1994.

The registrant bears the burden of demonstrating use of its trade-mark in association with the wares mentioned in the registration, in the normal course of trade, and during the two years immediately preceding the date of the notice. "Use" is defined by Section 4(1) of the Trade-marks 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 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."

Paragraph 4 of the affidavit contains a general statement of use of the trade-mark in association with the registered wares, i.e. "comic books and magazines". However, there is nothing in the evidence that shows any use at any time in association with "magazines".

When speaking of the registrant's wares, for the most part, Mr. Stirling refers to a



"publication" or "work" entitled "Atlantis" (paragraphs 5, 6, 7, 8 and 9 of the affidavit). Exhibits "C" and "Cl" also refer to "Atlantis" and "Legend of Atlantis". Mr. Stirling states that the said ATLANTIS work is a collector's edition and that part 2 of the said work is a "CAPTAIN CANADA" book.

Mr. Stirling mentions a "book" entitled "CAPTAIN NEWFOUNDLAND" (also a special collector's edition). He states that it was offered to the general public in the same manner as ATLANTIS was offered, as described in paragraphs 7 and 8 of the affidavit, i.e. as prize giveaways, by a company called "The Newfoundland Broadcasting Co. Ltd.". He refers to a copy of this book being submitted as Exhibit "D". However, Exhibit "D" does not refer to such work.

Concerning both "works", the use as "prize giveaways" is not a use pursuant to Section 4(1) of the Trade-marks Act since there were no transfer of the wares in the normal course of trade. In this regard, I rely on the case Joseph E. Seagram & Sons Ltd. v. Corby Distilleries Ltd., 42 C.P.R. (2d) 264 and C8M Kabushiki Kaisha v. Lin Trading Co. Ltd., 5 C.P.R. (3d) 27. Furthermore, any use by a company other than the registrant or its licensee is not use that accrues to the registrant.

Exhibit "8" which contains a photocopy of certain parts of the "Atlantis" work, contains specific references to the trade-mark CAPTAIN CANADA. The first page of Exhibit "8" reads at the top: "Welcome to the exciting worlds of Captain Atlantis, Captain Canada and Mademoiselle OM is this special collector's edition of ATLANTIS (underlining is mine)". The second page of Exhibit "8" is marked "Part 11: CAPTAIN CANADA". As mentioned earlier, Mr. Stirling explains at paragraph 5 that "Part 2 of the said work (the "Atlantic" work) is a CAPTAIN CANADA book".

However, even if the "ATLANTIS" work contains a comic book entitled CAPTAIN CANADA, I cannot conclude on the basis of this evidence that for the purposes of Section 4(1) of the Act, notice of the association between the trade-mark and the registrant's wares is given to the person to whom the property or possession is being transferred. The trade-mark is represented in Exhibit "8" on page 1 of said Exhibit and on a page entitled "Part II: CAPTAIN CANADA" but the Registrar has not been informed whether any of these pages of Exhibit "8" is visible to the ordinary purchaser at the time of purchase of the wares. Furthermore, the packaging of the "Atlantis" work may very well prevent access to these pages at the time of purchase. I am left in doubt as to whether notice of the association between the trade-mark and the registrant's wares is given at the time of transfer; consequently, this doubt must be resolved against the

registrant.

Furthermore, there is no clear evidence of any sales of the registrant's wares having occurred during the two years immediately preceding the date of the notice. At paragraph 6 of the affidavit Mr. Stirling states that his company sent by consignment a selection of the "Atlantis" work to a number of customers including to a specialty comic book store in January 1990. Mr. Stirling states: "I visited said store in early June and noted that certain such ATLANTIS works were available for sale at the time". The affidavit was sworn on June 27, 1991: therefore, I assume Mr. Stirling's reference to early June is early June 1991 which is subsequent to the notice date (November 5, 1990). He then states that he was advised by the Manager thereof that the said work was available for sale immediately prior to November 5, 1990: however, this statement constitutes hearsay evidence which is inadmissible.

Consequently, in view of the evidence filed, I conclude that the registrant has failed to show use of its trade-mark in association with the registered wares pursuant to Section 4(1) and 45 of the Trade-marks Act. Accordingly, its trade-mark registration ought to be expunged from the register.

Registration No. 296.716 will be expunged in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 30<sup>TH</sup> DAY OF

A rectangular box containing the word "August" written in a cursive, handwritten style.

D. Savard  
Senior Hearing Officer

1994.