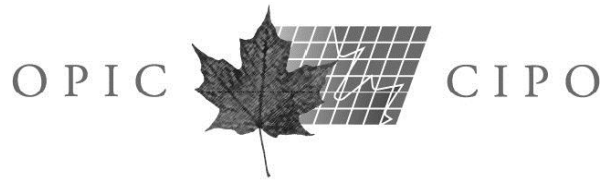


Translation



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

Reference: 2013 TMOB 73
Date of Decision: 18/04/2013

**IN THE MATTER OF THE SECTION 45
PROCEEDINGS, undertaken at the request of De
Grandpré Chait, regarding Registration No. TMA692,597
of the YEAR-IN-A-BOX trade-mark in the name of Mead
Products LLC.**

[1] On January 13, 2011, at the request of De Grandpré Chait (the Requesting Party), the registrar sent the notice stipulated in Section 45 of the *Trade-marks Act*, RSC (1985), c. T-13 (the Act), to MeadWestvaco Corporation (MeadWestvaco), then registered as the owner in Registration No. TMA692,597 of the trade-mark YEAR-IN-A-BOX (the Mark) registered in association with calendars.

[2] Mead Products LLC is currently registered as owner of the registration. However, the change of owner has no consequence in this case, since it stems from an assignment and mergers that occurred after the date of the notice under Section 45.

[3] In reply to the notice under Section 45, MeadWestvaco submitted an affidavit by Edith Forbes, trade-marks manager at MeadWestvaco.

[4] The two parties submitted written representations. However, the written representations of the Requesting Party were submitted after the deadline. Accordingly, they were not taken into consideration. Furthermore, a letter to this effect was sent to the Requesting Party on December 28, 2011.

[5] Both parties were represented at a hearing.

[6] According to Section 45 of the Act, the registered owner of a trademark must show, in regard to each of the wares or each of the services specified in the registration, whether the trade-mark was in use in Canada at any time during the three-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date.

[7] 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 clearing the register of “deadwood.” Mere claims of use are insufficient to show the use of the mark [see *Plough (Canada) Ltd v. Aerosol Fillers Inc.* (1980), 53 CPR (2d) 62 (CAF)]. Although the criterion for establishing use is not very demanding and an overabundance of evidence is not necessary, sufficient facts must be presented to enable the registrar to conclude that the trade-mark has been used in association with each ware or service mentioned in the registration during the Relevant Period [see *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 CPR (4th) 270 (CF)].

[8] In this case, the Relevant Period for establishing the use of the Mark in association with the calendars is from January 13, 2008 to January 13, 2011. The proof of use must establish that in the transfer of ownership or possession of the calendars, during normal business practice, the Mark was associated with the calendars to such an extent that a notice of association was then given to the person to whom the ownership or possession was transferred [see Section 4(1) of the Act].

[9] At the hearing, the Requesting Party conceded that the evidence presented by Ms. Forbes shows the use of the Mark in Canada in association with the calendars during the Relevant Period. However, the Requesting Party sustained that MeadWestvaco was unable to claim the benefit of this use. MeadWestvaco contested the claims of the Requesting Party.

[10] Before ruling on the Parties' representations, I will summarize the evidence presented by Ms. Forbes.

[11] Among others, Ms. Forbes states that during the Relevant Period:

- MeadWestvaco used the Mark in Canada in association with the calendars.
- The calendars associated with the Mark were manufactured in the United States by the "MWV Consumer & Office Products" division of MeadWestvaco, then sent to Hilroy, a division of MeadWestvaco Canada LP, which sold the calendars to Canadian retailers;
- MWV Consumer & Office Products, Hilroy and MeadWestvaco Canada LP were authorized to use the Mark pursuant to licences under the terms of which MeadWestvaco controlled the nature and quality of the calendars associated with the Mark; and
- over 33,000 calendars associated with the Mark have been sold in Canada by retailers, such as Calendar Club, Staples/Business Depot and Walmart.

[12] In support of her statements, Ms. Forbes submitted:

- Digital photos of a calendar on which the Mark appears; this calendar is representative of those sold in Canada during the Relevant Period; and
- Copies of invoices dated July 27, 2010 and August 6, 2010 showing sales in Canada of the calendars associated with the Mark. The name "Hilroy a division of MeadWestvaco Canada LP" appears in the upper left corner of these invoices.

[13] I consider that the elements of evidence provided by MeadWestvaco show the use of the Mark in association with calendars during the Relevant Period, which brings me back to the representations by the Requesting Party.

[14] The Requesting Party submits that the evidence is insufficient to establish that the use of the Mark by MWV Consumer & Office Products, Hilroy and MeadWestvaco Canada LP can be attributed to MeadWestvaco because it does not meet the requirements of Section 50 of the Act concerning the use of a mark under licence.

[15] According to Section 50(1) of the Act, the owner of a trade-mark must directly or indirectly control the characteristics or the quality of wares or services such that the use of the trade-mark by the licence holder is deemed to be a use by the owner.

[16] Contrary to the representations of the Requesting Party, MeadWestvaco is not required to indicate the conditions of the licence agreements or indicate the actual control it exercises over the characteristics and quality of the calendars. In fact, pursuant to a procedure under Section 45, it is possible to satisfy Section 50(1) of the Act by way of a declaration in which the owner or licence holder attests that the control required by Section 50(1) indeed exists [see *Mantha & Associés/Associates v. Central Transport Inc.* (1995), 64 CPR (3d) 354 (CAF); *Shapiro Cohen Andrews & Finlayson v. 1089751 Ontario Ltd.* (2003), 28 CPR (4th) 124 (TMOB)]. In the current case, Ms. Forbes clearly attests to the control by MeadWestvaco over the nature and quality of the calendars associated with the Mark.

[17] This being said, a reasonable reading of Ms. Forbes' affidavit leads me to conclude that the provisions of Section 50 of the Act are not applicable in this case for the following reasons:

[18] Ms. Forbes explicitly states that MWV Consumer & Office Products is a *division* of MeadWestvaco. MWV Consumer & Office Products is not therefore a separate entity. Accordingly, the use of the Mark by MWV Consumer & Office Products corresponds to a use by MeadWestvaco itself.

[19] Ms. Forbes also states explicitly that Hilroy is a division of MeadWestvaco Canada LP, which is probably related to MeadWestvaco. It seems clear to me that MeadWestvaco Canada LP, by way of its Hilroy division, was acting only as a distributor in Canada of the calendars bearing the MeadWestvaco Mark. However, the use of a trade-mark in Canada by a distributor constitutes a use by the holder of the trade-mark [see *Manhattan Industries Inc. v. Princeton Manufacturing Ltd.* (1971), 4 CPR (2d) 6 (CF 1st inst)].

[20] In final analysis, I am persuaded that the evidence provided by MeadWestvaco establishes its use of the Mark in association with the calendars within the meaning of Sections 4 and 45 of the Act.

[21] In exercising the authority delegated to me pursuant to Section 63(3) of the Act, I uphold maintenance of the registration TMA692,597 according to the provisions of Section 45 of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Alan Vickers, trad.