

SECTION 45 PROCEEDINGS  
TRADE-MARK: ROTOVAC & DESIGN  
REGISTRATION NO.: 455,561

On July 5, 2002 at the request of Sim & McBurney, the Registrar forwarded a Section 45 notice to Lucie P. Marceau faisant affaire sous le nom Les Systèmes Rotovac, the registered owner of the above-referenced trade-mark registration.

The trade-mark ROTOVAC & DESIGN (shown below) is registered in association with the following wares and services:

<u>Wares:</u>	Aspirateurs pour Sablage  [translation] Sandblasting vacuums
<u>Services:</u>	Installation et service de systèmes d'aspirateurs  [translation ] Installation and service of vacuum systems

The logo for ROTOVAC is a stylized, bold, and slightly irregular font. The letters are thick and have a hand-drawn or blocky appearance. The 'O's are particularly prominent, with a slight curve and a shadow effect. The overall style is reminiscent of a logo for a mechanical or industrial brand.

Section 45 of the Trade-marks Act requires the registered owner of a trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and/or services listed on 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 use since that date. The relevant period in this case is any time between July 5, 1999 to July 5, 2002.

In response to the notice, the registrant filed the statutory declaration of Lucie P. Marceau dated October 1, 2002. On May 1, 2003 additional evidence was filed, however by official letter dated June 11, 2003 it was returned to the owner. The owner was informed that the deadline for filing the evidence in this proceeding had expired and the owner had not requested nor been granted a retroactive extension of time under ss. 47(2) to file additional evidence. Neither party has submitted written arguments or requested an oral hearing.

In her statutory declaration of October 1, 2002 Ms. Marceau states that the registrant has used the trade-mark ROTOVAC & DESIGN since March 15, 1996 (the registration date) and still wishes to continue to use it in the future. Accompanying the statutory declaration is one invoice dated during the relevant period for the sale of the registered wares. The trade-mark ROTOVAC appears at the top left-hand corner of the invoice and in the body of the invoice.

With respect to the wares, the registrant had to show use of the trade-mark during the relevant period in a manner complying with Section 4(1) of the Trade-marks Act.

Section 4(1) of the Act reads 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.

Thus, for the wares to be maintained on the registration the owner had to show:

- (1) a transfer of the registered wares (during the relevant period);
- (2) in the normal course of trade;
- (3) and that at the time of transfer of the wares the trade-mark appeared on the wares or their packaging or was so associated with the wares that notice of the association between the trade-mark and the wares was given to the purchaser at that particular time;

Here, the registered owner has shown that a transfer of the wares (criterion (1) above) occurred during the relevant period. Further, it can be concluded that the transfer was made in the registrant's normal course of trade (criterion (2) above).

However, the Marceau declaration is silent with respect to the manner the trade-mark was associated with the wares at the time of their transfer (criterion (3) above). Ms. Marceau has not indicated nor shown that the trade-mark appears on the wares or their packaging. What the evidence shows is that the trade-mark appears in the body of the invoice that has been furnished. The issue therefore, is whether the invoice would have provided the required notice of association between the trade-mark and the wares to the customer at the time of transfer of property or possession of the wares. In the case *Riches McKenzie & Herbert v. Pepper King* (8 C.P.R. (4<sup>th</sup>) 471) the court stated:

“ while the display of a trade-mark on an invoice may be considered "use" of that mark, it is essential that the invoice be associated with the wares at the time of transfer of property or possession. Whether an invoice bearing a trade-mark

constitutes an association between the mark and the wares is a question of fact to be decided on the evidence adduced. In this case, there was no evidence that the invoices accompanied the goods at the time of transfer and the Registrar was not entitled to assume that they did.”

In the present case Ms. Marceau has not indicated that the invoice accompanied the wares and I find there is no evidence which would permit me to conclude that the invoice accompanied the wares at the time of transfer of the wares. The invoice identifies the purchaser of the wares as Groupe Financier Laplante (1997) Inc., having an address in Montreal, Quebec. However, the invoice also shows that the wares were delivered to Les Carosseries Jacques Généreux Inc. with an address at Notre-Dame-Des-Prairies, Quebec. Consequently, it cannot be determined whether the invoice was sent to Groupe Financier Laplante or whether it was sent with the wares to Les Carosseries Jacques Généreux. As I cannot conclude that the invoice accompanied the wares, I cannot conclude that the invoice provided the required notice of association between the trade-mark and the wares at the time of transfer of property or possession of the wares. Accordingly, as the evidence fails to show that the required notice of association was provided to the purchaser at the time of transfer of the wares I conclude that the use shown does not comply with the requirements of subsection 4(1) of the Act.

Concerning the services, use of a trade-mark with services is defined under ss. 4(2) of the Act which reads:

- 4(2). A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

Here although on the invoice there is an enumeration of “services”, the invoice only shows a sale of the wares. The Marceau declaration does not contain a statement to the effect that the trade-mark was in use in association with the services during the relevant period or at any other time and the evidence is completely silent as to whether the registered services were available to be performed or were performed during the relevant period. Accordingly, based on the evidence furnished, I cannot conclude that the trade-mark was in use in association with the services during the relevant period.

As I have concluded that the evidence is insufficient to permit me to conclude that the trade-mark was in use in association with the registered wares in the manner required by ss.4(1) of the Act and as the evidence completely fails to show use in association with the registered services, I conclude that the trade-mark registration ought to be expunged.

Registration No. 455,561 will be expunged in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 29TH DAY OF SEPTEMBER 2005.

D. Savard  
Senior Hearing Officer  
Section 45 Division