SECTION 45 PROCEEDINGS
TRADE-MARK: JUJO GOLFTECHS
REGISTRATION NO: TMA 586,154

At the request of M. Capewell & Associates Inc. (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") on March 23, 2007 to Joseph Clifford Berezanski, the registered owner of the above-referenced trade-mark.

The trade-mark JUJO GOLFTECHS is registered in association with the following wares and services:

> ***Wares***: Golf bags, golf hats and caps, golf shoes, spikes, divot tools, tees, umbrellas, retrievers, spike wrenches, wrist (and other) golf stroke counters, greens markers, golf gloves, rain suits, putter fingers, swing weights, club covers.
> ***Services***: Golf club manufacturing, repair and sales and golf accessories sales.

Pursuant to the provisions of s. 45 of the Act, the registered owner must show, with respect to each of the wares and/or 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 on which it was last used and the reason for the absence of use since that date. In this case, the relevant period for showing use is any time between March 23, 2004 and March 23, 2007.

In response to the Registrar's notice, the statutory declaration of Joseph Clifford Berezanski, the registered owner of the subject mark, was furnished. Both parties filed a written argument; however, an oral hearing was not conducted.

Mr. Berezanski's statutory declaration consists of a brief written statement together with a table of contents detailing associated attached exhibits 1 through 10. Mr. Berezanski's written statement is reproduced below:

The contents here-in provided accurately portray the activities of JUJO GOLFTECHS during the years 2004, 2005, 2006 and will comply with Section 45 Proceedings as requested Mar. 23, 2007.

Please note JUJO GOLFTECHS is a sole proprietorship business whose main activity is in the repair and manufacture of golf clubs, components of which are imported and assembled. The trade mark is <u>not</u> labelled on assembled golf clubs nor is it attached as a label on any wares which are also imported wholesale and retailed with original manufactured labels.

The table of contents details a list of exhibits consisting of various business documents, newspaper and telephone directory advertisements, customer billing samples and invoices. The exhibits and their contents can be summarized as follows:

- Exhibits 1, 2, and 3, consist of business license fee receipts, income tax documents and bank statements respectively. However, these documents do not appear to constitute evidence of use of the trade-mark in accordance with the Act. Rather, at most, these documents establish that a business operating under the trade-name of JuJo Golftechs existed at some point during the relevant period.
- Exhibits 4, 7 and 9 consist of telephone directory advertisements for the following years 2004/2005, 2005/2006, and 2006/2007. I note that the trade-mark appears prominently in all such advertisements in connection with golf club and golf accessory related sales and service.
- Exhibits 5, 8, 10 include invoices issued to the registrant from newspapers, presumably for the placement of ads. I note however, that only Exhibit 5 includes sample advertisements, such being in the form of approved advertising proofs, wherein the trade-mark is clearly featured in connection with golf club and golf accessory related sales and service.
- Exhibit 6 includes a number of "customer billing samples" or invoices for various golf-related wares and services during the relevant period. I note the trade-mark appears prominently at the top of such invoices together with the words "CUSTOM GOLF CLUB FITTING MANUFACTURE & REPAIRS", an address, telephone and facsimile number, appearing immediately beneath.

The requesting party has argued that Mr. Berezanski acknowledges in his affidavit "that there is no use of the Mark in relation to any wares listed on the registration."

For the purposes of the present case, it is important to reproduce the relevant definition of "use" in association with wares, as set out in subsection 4(1) of the *Trade-marks 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.

"Use" of the Mark in association with wares, accordingly, can only be concluded if the conditions described in ss. 4(1) have been satisfied.

In deciding the matter, I note that it is true that Mr. Berezanski has set out in his declaration that "the trade mark is not labelled on assembled golf clubs nor is it attached as a label on any wares which are also imported wholesale and retailed with original manufactured labels." Furthermore, I note there is no evidence that the Mark was marked on packages in which the wares were distributed.

With respect to whether there is evidence of "any other manner" in which the Mark was associated with the wares at the time of transfer, the evidence is also lacking. In this regard, as is generally the case, the advertisements cannot be considered evidence of use of the mark in association with wares, as they do not demonstrate that the mark was associated with the wares at their time of transfer.

Furthermore, the invoices or customer billing samples (Exhibit 6) do not appear to provide such requisite notice of association in respect of wares. As previously indicated, the trade-mark appears prominently at the top of such invoices together with the words "CUSTOM GOLF CLUB FITTING MANUFACTURE & REPAIRS", an address, telephone and facsimile number, appearing immediately beneath. Such use would either appear to be in the context of (a) identifying the registrant or its business and not the wares per se; this has been held not to be use in connection with wares or services [see *Tint King of*

California v. Canada (Registrar of Trade-marks (2006), 56 C.P.R. (4th) 223 (F.C.)]; or (b) display in the performance or advertising of services, since a description of the registrant's services is listed immediately beneath the subject mark on the invoice. In any event, there is no evidence that the invoices accompanied the wares at their time of transfer. Consequently, the wares will be deleted from the registration.

In turning to the matter of the services, "use" in association with services is defined by subsection 4(2) of the Act as follows:

> 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.

The relevant exhibits for discussion with respect to services, in my view, are exhibits 4, 7 and 9 (telephone directory advertisements), and exhibit 5 (newspaper advertisements). All of the aforementioned advertisements clearly feature the trade-mark in connection with services that I consider to encompass each of the registered services. Furthermore, it is clear that the advertisements were in circulation during the relevant time period.

Not only am I satisfied that the aforementioned advertisements show that the registrant was prepared to offer such services [see *Tint King of California Inc. v. Canada (Registrar of Trade-marks)* (2006), 56 C.P.R. (4th) 223 (F.C.) and *Bedwell Management Systems Inc. v. Mayflower Transit, Inc.* 2 C.P.R. (4th) 543 (T.M.O.B.) regarding telephone directory advertisements], but the invoices at exhibit 6 provide support for the conclusion that the registered services were actually performed in Canada during the relevant period. Consequently, I am satisfied that the evidence shows use of the subject mark during the relevant period in association with the registered services in the manner required by the Act.

In view of the above, I have concluded that use has been shown of the subject trade-mark in respect of each of the registered services; use has not been shown in respect of the registered wares and there is no evidence of any special circumstances excusing the absence of use. Having been delegated authority by the Registrar of Trade-marks by

virtue of s. 63(3) of the Act, registration No. TMA 586,154 will be amended in compliance with the provisions of s. 45(5) of the Act to delete the wares:

> "Golf bags, golf hats and caps, golf shoes, spikes, divot tools, tees, umbrellas, retrievers, spike wrenches, wrist (and other) golf stroke counters, greens markers, golf gloves, rain suits, putter fingers, swing weights, club covers.",

for failure to show use pursuant to Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC, THIS 4th DAY OF MARCH 2009.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board