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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 39

Date of Decision: 2017-04-21

IN THE MATTER OF A SECTION 45 PROCEEDING

M. Capewell & Associates Inc.	**Requesting Party**
and	
OceanWorks International Inc.	**Registered Owner**
TMA345,259 for NEWTSUIT	**Registration**

[1] This decision pertains to summary expungement proceeding with respect to registration No. TMA345,259 for the trade-mark NEWTSUIT (the Mark), owned by OceanWorks International, Inc. (the Owner).

[2] The Mark is registered for use in association with: underwater diving equipment, namely an underwater diving suit (the Goods). For the reasons that follow, I conclude that the registration ought to be expunged.

THE PROCEEDING

[3] On October 6, 2014, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to the Owner. The notice was sent at the request of M. Capewell & Associates Inc. (the Requesting Party).

[4] The section 45 notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between October 6, 2011 and October 6, 2014 (the Relevant

Period), in association with the Goods. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[5] The relevant definition of "use" in association with goods is set out in section 4(1) of the Act as follows:

> 4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[6] 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 removing "deadwood" from the Register. The criteria for establishing use are not demanding and an overabundance of evidence is unnecessary. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the goods or services specified in the registration at any time during the relevant period [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use of the trade-mark [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 53 CPR (2d) 62 (FCA)].

[7] In response to the Registrar's notice, the Owner filed the affidavit of Laura MacDonald, sworn on August 5, 2015.

[8] Neither party filed written representations nor a hearing requested. In view of this , I will comment on the content of Ms. MacDonald's affidavit as I am describing each of her statements.

MACDONALD EVIDENCE

[9] Ms. MacDonald identifies herself as a law student employed by the Owner's agent firm. Each allegation of fact in her affidavit is preceded by the following statement: "According to information in my firm's files".

[10] Even in the context of a section 45 proceeding, this type of evidence is weak and, generally, should be given little weight. In any event, as it will appear from my decision, even if I were to give some weight to this hearsay evidence, it would still not establish the requisite use of the Mark for the reasons detailed hereinafter.

[11] As Exhibit A, Ms. MacDonald attaches a 2015 brochure of the Owner that her firm received in 2015. She alleges that, in such brochure, the Mark is associated with an atmospheric diving suit or system ("ADS"). She adds that: "(a) the [Owner] NEWTSUIT ADS is manufactured in Canada; (b) an ADS is a highly sophisticated piece of diving equipment that has an indefinite lifespan (i.e. to the extent possible, it will be repaired rather than replaced)". I note that the brochure is dated after the Relevant Period. Moreover, a brochure *per se* on which appears a trade-mark does not constitute use of that mark within the meaning of section 4(1) of the Act.

[12] As Exhibit B, Ms. MacDonald attaches a photograph of the Owner's ADS. She adds that this particular suit shown in the photograph was refurbished and upgraded by the Owner at its Canadian facilities for the Italian Navy in 2014 and the cost of such work was in excess of $1.5 million, a portion of which was paid at the commencement of work.

[13] First, even I were to give any weight to these statements, there is no evidence of a transfer or a sale of the Goods. These facts may establish that services in the nature of refurbishing and upgrading ADS were performed by the Owner in 2014, but it certainly does not establish use of the Mark in association with the Goods during the Relevant Period or otherwise. Moreover, Ms. MacDonald does not state exactly when in 2014 such work was performed. Therefore, it is unclear if the work was performed during the Relevant Period.

[14] As Exhibit C, Ms. MacDonald attaches a bundle of press releases allegedly issued by the Owner during the period of April 2013 to July 2015 regarding such work. Ms. MacDonald does not state that she has personal knowledge that such press releases were issued. In any event, all of the press releases make reference to ADS in association with the trade-mark HARDSUIT rather than the Mark. As such, these press releases are not relevant.

[15] As Exhibit D, Ms. MacDonald attaches a photograph of another one of the Owner's ADS. She states that this particular one was refurbished by the Owner at its Canadian facilities for a Russian client between 2013 and 2014. Again, as explained above, I do not consider the work of refurbishing the Goods to be use of the Mark as defined in section 4(1) of the Act.

[16] As Exhibit E, Ms. MacDonald attaches a bundle of printouts from the Owner's website. First, I was unable to find any reference to the Mark on any of them. Rather, there are references to the trade-mark HARDSUIT, which is not the Mark. Second, the printouts are dated July 31, 2015 and thus after the Relevant Period. Finally, in any event, even if the Mark appeared on the printouts, in the absence of evidence of transfer or sale of goods, website printouts are generally insufficient to establish use of a trade-mark in association with goods.

[17] Finally, Ms. MacDonald attaches, as Exhibit F to her affidavit, another bundle of press releases allegedly issued by the Owner during the Relevant Period. Again, press releases *per se* do not constitute evidence of use of a trade-mark in association with goods within the meaning of section 4(1) of the Act. In any event, there is no reference to the Mark in them, but rather to the trade-mark HARDSUIT, which is not the Mark.

[18] As noted above, there is no evidence that there was any transfer of or sales of the Goods in association with the Mark during the Relevant Period. As such, the Owner has failed to demonstrate use of the Mark in association with the Goods within the meaning of sections 4 and 45 of the Act.

[19] Furthermore, there is no evidence of "special circumstances" within the meaning of section 45 of the Act, which would justify such non-use of the Mark during the Relevant Period. Given the absence of representations from the Owner, I do not intend to do a detailed analysis of the evidence described above to determine whether the Owner has established the existence of special circumstances within the meaning of section 45(3) of the Act.

[20] Suffice to say at this stage that I have no affidavit from a duly authorized individual from within the Owner that contains the following:

- facts that could be considered as special circumstances excusing non-use of the Mark;

- facts that would lead to a conclusion that the Owner has a serious intention to shortly resume use of the Mark.

DISPOSITION

[21] In view of all of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the Goods within the meaning of sections 4 and 45 of the Act. Further, the Owner has provided no evidence of special circumstances excusing the absence of such use.

[22] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration TMA345,259 will be expunged.

Jean Carrière, Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE: No Hearing Held

AGENTS OF RECORD

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.	FOR THE REGISTERED OWNER
M. Capewell & Associates Inc.	FOR THE REQUESTING PARTY

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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 39

Date of Decision: 2017-05-17

IN THE MATTER OF A SECTION 45 PROCEEDING

M. Capewell & Associates Inc.	**Requesting Party**
and	
OceanWorks International Inc.	**Registered Owner**
TMA345,259 for NEWTSUIT	**Registration**

[1] It has been brought to my attention that the trade-mark covered by registration TMA345,259 has been incorrectly identified as NEWSUIT instead of NEWTSUIT in my decision dated April 21, 2017. Furthermore, I inverted the name of the agents of record such that it should have read:

AGENTS OF RECORD

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.	FOR THE REGISTERED OWNER
M. Capewell & Associates Inc.	FOR THE REQUESTING PARTY

[2] The first and last pages as well as paragraph 11 of the aforesaid decision have been corrected accordingly.

Jean Carrière, Member
Trade-marks Opposition Board
Canadian Intellectual Property Office