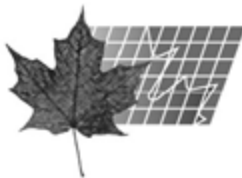


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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2017 TMOB 178**

**Date of Decision: 2017-12-19**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Infinity Cycle Works Ltd.**

**Requesting Party**

**and**

**Shandong Linglong Tyre Co., Ltd.**

**Registered Owner**

**TMA791,419 for INFINITY WITH  
DESIGN**

**Registration**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA791,419 for the trade-mark INFINITY WITH DESIGN, shown below (the Mark), owned by Shandong Linglong Tyre Co., Ltd.:

***Infinity***

[2] The Mark is currently registered in association with the following goods:

Inner tubes for pneumatic vehicle tires; Treads for retreading tires; Tires for vehicle wheels; Solid tires for vehicle wheels; Casings for pneumatic tires; Tire liners; Tire retreading caps; Tire patches; Vehicle wheel tires; Tires for tractors; Automobile tires;

Spikes for tires, namely, spikes for increased traction of tires; Tire deflators; Tire pumps; Treads for vehicles, namely, treads for vehicle tires; Bicycle tires.

[3] For the reasons that follow, I conclude that the registration ought to be expunged.

#### THE PROCEEDINGS

[4] On July 16, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Shangdong Linglong Tyre Co., Ltd. (the Owner). The notice was sent at the request of Infinity Cycle Works Ltd.

[5] The notice required the registered owner to furnish evidence showing that it had used the Mark in Canada, at any time between July 16, 2012 and July 16, 2015, in association with each of the goods specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use 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.

[7] It has been 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”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary; the registered owner must simply establish a *prima facie* case of use of the trade-mark in association with each of the goods specified in the registration [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428]. However, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Yi Hao Zhang, sworn February 12, 2016, together with Exhibits A to C.

[9] Only the Requesting Party filed written representations. An oral hearing was not requested.

#### THE EVIDENCE

[10] Mr. Zhang is the Head of the Trade-marks department of the Owner.

[11] Mr. Zhang attests that the Owner is a large scale global manufacturer. He states that the Owner “has cooperated” for many years with Al Dobowi Fze, a dealer who distributes or sells tires directly in Canada. He attaches as Exhibit A to his affidavit, sales contracts, packing lists and invoices with respect to the sale and export of INFINITY brand tires from China to Vancouver, Canada. The sales contracts, packing lists and invoices all list “INFINITY BRAND TYRE(S)” under the product description, with product specifications such as tire size/dimension information. Mr. Zhang does not provide any further information with respect to identifying the specific types of tires referred to in these documents.

[12] In addition, Exhibit A also contains a press release dated April 2010, which Mr. Zhang explains shows the Owner “has cooperated with Al Dobowi Group in many countries, including Canada.”

[13] Mr. Zhang then states that the Owner “has also been cooperating with Tire Discounter Group”. He explains that the Tire Discounter Group, which carries INFINITY brand tires, has over 55 authorized retail tire stores and hundreds of other point of sale locations throughout Ontario. He attaches, as Exhibit B to his affidavit, undated printouts from the Tire Discounter Group’s website, and photographs of a sign and company vehicle, which show the INFINITY brand of tires as one of the available brands of tires for sale. The photograph of a sign is for the Tire Discounter Group’s September 2015 annual general meeting. It appears from the Tire Discounter Group’s website that they are in the business of selling passenger tires, tires for sports cars, and tires for light trucks and SUVs. Exhibit B also contains undated printouts from another dealer of the Owner in Canada, *KXWheels.com*, which shows the availability for sale of INFINITY brand tires.

[14] Lastly, Mr. Zhang attaches as Exhibit C to his affidavit undated photographs of INFINITY brand tires as well as undated printouts from the Owner’s website which describes the

various types of INFINITY brand tires offered by the Owner. Included on the website is Canadian contact information to obtain more information about the Owner's products.

[15] Mr. Zhang then simply concludes his affidavit by stating that the Mark has been used continuously in Canada, including during the relevant period.

#### ANALYSIS AND REASONS FOR DECISION

[16] The Requesting Party submits that the various sales contracts in evidence refer to "INFINITY BRAND TYRES" without specifying the goods. The Requesting Party submits that presumably they are for the sale of tires and not for other tire-related products, but what tires are covered by the contracts is not clear. I agree. Moreover I note that Mr. Zhang, when discussing Exhibit A, attests that these documents show the export of INFINITY brand tires, without further specification or explanation as to what goods are specifically listed on the sales contracts, packing lists, and invoices. As the evidence is silent with respect to goods other than tires, at the very least, the registered goods that include parts and/or fittings for tires, tire accessories, and bicycle tires, will be deleted from the registration.

[17] Noting that the Exhibit A contracts indicate that the purchaser is located in Dubai, the Requesting Party submits, the mere export of goods from China to Canada on instructions from a foreign purchaser would not be a sale in Canada by the Owner. The Requesting Party submits that the evidence shows a foreign sale, where Canada is only the port of destination for these goods, with no evidence of any subsequent sales or distribution provided. More importantly, the Requesting Party submits, there is no evidence that the goods were branded with the Mark as registered.

[18] The Requesting Party further points out that it appears from the press release provided under Exhibit A to the Zhang affidavit, that the Al Dobowi Group is the owner of INFINITY tires, and that the Owner is actually just a manufacturer or supplier.

[19] However, as noted by the Federal Court of Appeal in *Ridout & Maybee LLP v Omega*, 43 CPR (4th) 18 (FCA), the validity of a registration is not in dispute in section 45 proceedings. Any issues of ownership are more properly dealt with by way of application to the Federal Court pursuant to section 57 of the Act.

[20] Although the Requesting Party submits that there is no evidence of any subsequent sales or distribution provided, Mr. Zhang does make statements of fact regarding the normal course of trade of the goods and that the goods are available for sale through the Tire Discounter Group, an entity with 55 retail locations in Ontario. Furthermore, and more importantly, I note that the Owner is not required to show evidence of sales to end consumers, and it has been established that a sale to a wholesaler or distributor can be a sale in the normal course of trade [*Philip Morris Inc v Imperial Tobacco Ltd et al* (1987), 13 CPR (3d) 289 (FCTD)]; if any part of the chain takes place in Canada, it is considered to be use in Canada [*LIN Trading Co v CBM Kabushiki Kaisha* (1985), 21 CPR (3d) 417 (FCA)]. The sales contracts show that the goods were sold and imported into Canada, and I have no reason to doubt that these were not *bona fide* sales in the normal course of trade as described by Mr. Zhang.

[21] With respect to the Requesting Party's submission that there is no evidence that the goods were branded with the Mark, the evidence in this regard consists of the photographs of tires bearing the Mark in Exhibit C. The Requesting Party submits that these photographs are undated, and thus cannot demonstrate use of the Mark during the relevant period. Further to this, the Requesting Party points out that Mr. Zhang does not allege that the photographs show how the Mark appeared on the goods that were sold in Canada during the relevant period.

[22] In the context of a section 45 proceeding, the evidence as a whole must be considered, [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)], and exhibits should be read in conjunction with the information provided in the affidavit as a whole. In doing so, however, I agree with the Requesting Party that the evidence falls short of establishing that the Mark was associated with the goods during the relevant period. It would have been a simple matter for Mr. Zhang to have attested that the photographs were representative of the manner in which the Mark appeared on the goods sold in Canada during the relevant period. Further to this, even if I were to accept that the photographs pertain to the relevant period, Mr. Zhang has not specified which goods are represented in the evidence, and I am unable to ascertain which specific registered goods are listed in the sales contracts and invoices, or depicted in the photographs. As noted above, the Owner made no representations to shed light on the matter.

[23] Consequently, arriving at a conclusion of use with respect to specific goods during the relevant period would involve an exercise in speculation, and thus, I find that the Owner has not established a *prima facie* case of use of the Mark in association with any specific registered good.

DISPOSITION

[24] Having regard to the aforementioned, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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Kathryn Barnett  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

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

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No Hearing Held

**AGENTS OF RECORD**

Shapiro Cohen LLP

FOR THE REGISTERED OWNER

Perley-Robertson, Hill & McDougall LLP

FOR THE REQUESTING PARTY