



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

Citation: 2018 TMOB 87

Date of Decision: 2018-07-31

IN THE MATTER OF A SECTION 45 PROCEEDING

McGregor Industries Inc.

Requesting Party

and

Giant Tiger Stores Limited

Registered Owner

**TMA645,352 for PROUD TO BE
CANADIAN & 11-Point Maple Leaf
Designs**

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA645,352 for the trade-mark PROUD TO BE CANADIAN & 11-Point Maple Leaf Designs (the Mark), shown below, owned by Giant Tiger Stores Limited.



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

Goods:

- (1) Posters, in-store signs and T-shirts.
- (2) Balloons and hats.

Services:

- (1) Advertisement and promotional services relating to the operation of a retail store; and sales, discounts and promotional programs relating to a retail store.

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

THE PROCEEDING

[4] On March 2, 2017, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Giant Tiger Stores Limited (the Owner). The notice was sent at the request of McGregor Industries Inc. (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between March 2, 2014 and March 2, 2017, in association with each of the goods and services 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 definitions of use are set out in sections 4(1) and 4(2) 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.

(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.

[7] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. While it is true that the threshold for establishing use in a section 45

proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD); *Austin Nichols & Co v Cinnabon, Inc* (1998), 82 CPR (3d) 513 (FCA)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982) 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the registered goods and services during the relevant period [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Jean-Marc Desjarlais, sworn April 20, 2017. The Requesting Party then filed its written representations on August 23, 2017. On August 29, 2017, a letter was issued by the Registrar inviting the Owner to file written representations or notify the Registrar that no written representations would be filed. On December 29, 2017, the deadline for doing so passed. An oral hearing was not requested.

[9] On January 18, 2018, however, the Owner requested a retroactive extension of time pursuant to section 47(2) of the Act in order to “complete and submit a proper affidavit”. For reasons detailed in a letter dated February 14, 2018, the Registrar refused the request. Consequently, the affidavit of Mr. Desjarlais, as furnished on April 20, 2017, is the only evidence filed and of record in the present proceeding.

THE EVIDENCE

[10] In his brief affidavit, Mr. Desjarlais states the following:

1. I am the Associate Vice-President, Leasing and Legal Services of Giant Tiger Stores Limited and as such have knowledge of the facts herein deposed.
2. The attached PROUD TO BE CANADIAN & 11-Point Maple Leaf Designs has been used consistently in the three-year period prior to March 2, 2017 in posters and in-store signs.

ANALYSIS AND REASONS FOR DECISION

[11] Although the Requesting Party has restricted its submissions to the goods “T-shirts, balloons and hats”, I find the submissions and reasoning provided by the Requesting Party for

the removal of these goods from the registration to be similarly applicable to the entirety of the registration.

[12] In particular, the Requesting Party submits, and I agree, that the Desjarlais affidavit fails to state, “let alone ‘show’ or ‘describe’ as required by Plough”, that the Mark was used in association with “T-shirts, balloons and hats” in Canada during the relevant period. Indeed, at most, Mr. Desjarlais makes a bare statement referring only to posters and in-store signs. Furthermore, the affidavit is completely silent with respect to the registered services.

[13] Consequently, the Owner has failed to demonstrate use of the mark in association with the registered goods and services within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence before me of special circumstances excusing the absence of such use.

DISPOSITION

[14] 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.

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**

HEARING DATE No hearing held.

AGENT(S) OF RECORD

MILTONS IP/P.I.

FOR THE REGISTERED OWNER

MACBETH & JOHNSON

FOR THE REQUESTING PARTY