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

Citation: 2018 TMOB 94

Date of Decision: 2018-08-29

IN THE MATTER OF A SECTION 45 PROCEEDING

BBA Aviation, PLC

Requesting Party

and

BBA Remanufacturing Inc.

Registered Owner

TMA825,302 for BBA-REMAN

Registration

[1] At the request of BBA Aviation, PLC (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on July 21, 2015 to BBA Remanufacturing Inc. (the Owner), the registered owner of registration No. TMA825,302 for the trade-mark BBA-REMAN (the Mark).

[2] On August 5, 2016, at the Owner's request, the registration was amended to remove references to the "aerospace" industry from the services listed in the registration. Accordingly, the Mark is currently registered for use in association with the following services:

(1) Refurbishment, repair, restoration, remanufacture and servicing of automotive industry parts namely engine control modules, alternators, dashboards, anti-lock braking systems, distributors, throttle bodies, air mass meters, air conditioners, power steering systems, catalytic converters, ancillary controllers, fuel pumps and air bags.

(2) Installation of automotive industry parts namely engine control modules, alternators, dashboards, anti-lock braking systems, distributors, throttle bodies, air mass meters, air conditioners, power steering systems, catalytic converters, ancillary controllers, fuel pumps and air bags.

(3) Supply and distribution of parts to the automotive industry namely engine control modules, alternators, dashboards, anti-lock braking systems, distributors, throttle bodies, air mass meters, air conditioners, power steering systems, catalytic converters, ancillary controllers, fuel pumps, air bags, air suspension modulators, body control modules, idle control valves, signal acquisition modules, soft-top roof controllers, tiptronic gearbox actuators and security, locking, and electronic key modules.

(4) Supply and distribution of diagnostic tools for the automotive industry.

(5) Computer software programming and development.

[3] Section 45 of the Act requires the registered owner of the trade-mark to furnish an affidavit or statutory declaration showing whether the trade-mark has been used in Canada in association with each of the goods or services specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when the trade-mark was last used and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between July 21, 2012 and July 21, 2015.

[4] The definition of “use” in association with services is set out in section 4(2) of the Act as follows:

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.

[5] 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)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Canada (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 goods or services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of its chairman in Canada, Christopher Swan, sworn on October 23, 2015 in Taunton, Massachusetts. Only the Requesting Party filed written representations; a hearing was not held.

[7] I note that, on June 26, 2017, the Requesting Party informed the Registrar that it wished to withdraw from the present proceeding. By way of office letter dated July 12, 2017, the Registrar advised the parties that, pursuant to the practice notice *Practice in Section 45 Proceedings*, a section 45 proceeding will only be discontinued with the consent of both parties. Accordingly, notwithstanding the Requesting Party's desire to withdraw, the section 45 proceeding would continue, unless the Registrar received confirmation that the Owner consented to discontinuance. A reminder in this respect issued on May 25, 2018, and was re-sent on July 11, 2018. As of the date of this decision, the Registrar has received no further communication from the registered owner. Therefore, this decision is issued on the merits of the evidence of record.

THE OWNER'S EVIDENCE

[8] In his affidavit, Mr. Swan states that the Owner has been operating in Canada for four years and has been using the Mark in Canada "on a regular and ongoing basis" since June 2012. He states that the Mark "was last used in Canada in October 22nd 2015 and continues to be used". He further states that the Owner uses the Mark in association with "all of its services and associated products" at all times of "transfer" of the services in the regular course of business.

[9] More particularly, Mr. Swan states that the Mark is "used and marked" from "initial interaction with customers on the BBA Reman website, to Canadian bulletins and advertising materials, to delivery of the BBA Reman services, including invoices, packages and materials". He further states that a notice of association between the Mark and the services is given to all clients "from initial contact to delivery to invoice". He specifies that the Mark is used on all invoices and correspondence and that all "relevant BBA Reman property" displays the Mark.

[10] In this respect, Mr. Swan references two supporting exhibits, which he describes as follows:

- Exhibit 1 - letter to customer (letterhead); BBA Reman website - screen shot of Canadian contact; UPS invoice; recent sample of customer list.
- Exhibit 2 - recent invoices.

[11] The following documents are attached to the affidavit, behind a title page that repeats the description for Exhibit 1:

- Three pages from an invoice for “Transportation Charges”, sent by UPS Canada to the Owner at its Canadian address on October 14, 2015. The Mark is not displayed on these pages.
- An undated screen shot from *www.bba-reman.com* titled “HOW TO CONTACT BBA-REMAN”. The webpage displays the Owner’s U.S. and Canadian office addresses, as well as other contact particulars, including the e-mail address *ca-sales@bba-reman.com*. The page also appears to provide a link to a form that the reader is asked to include “with all repairs sent to BBA”.
- An undated screen shot from *stores.ebay.ca/bba-remaninc-canada*, showing a page titled “bba-remaninc-canada”. A banner in the centre of the page features the words “BBA Reman” next to a car graphic and the smaller text “Re-engineering the future”. A box that reads “BBA REMAN LIFETIME WARRANTY! ON EVERY PART” is also displayed. The page describes BBA as “the home of specialist automotive remanufacturing” and states, “Our ebay shop contains a small selection of our inventory”. A “New Arrivals!” section on the page lists a Volvo “Anti Lock Brake Module” and a Jetta “Instrument Cluster Repair Service”, while the adjacent “Ending Soon!” section provides a price in Canadian dollars for what appears to be the brake module.
- A screen shot from *www.ebay.ca/usr/bba-remaninc-ca*, indicating that bba-remaninc-ca has been an eBay member since May 26, 2009, and has 650 “Views” and six “Followers”. The heading “Following” appears at the bottom of the page with the

subheading “Members”, but no listed members are included in the screen capture. One positive feedback comment is included, dated October 1, 2015.

[12] The following documents are attached behind a title page that repeats the description for Exhibit 2:

- A letter dated October 29, 2014, from the Owner to a company in Toronto. The letterhead indicates that the Owner is “Specializing in Electronic Automotive Parts”; it also provides the Owner’s Canadian mailing address and the website address *www.bba-reman.com*. The body of the letter references a “Mercedes Bosch ECU” that was “sent in for repair on 10/14/2014”. However, the letter indicates that the part was unable to be repaired and would be returned or disposed of.
- Two invoices with respect to automotive parts dated October 9, 2015, from companies in the United States to the Owner’s Canadian office. One of the invoices refers to the Owner as “BBA Reman, Inc.--Canada”.
- Two invoices from the Owner dated October 19, 2015: one to an individual in Ontario for a “Nissan Hitachi ECU” and the other to a company in Quebec for a “Ford ECU”. The Owner’s corporate name, its Canadian mailing address, and the website address *www.bba-reman.ca* are all displayed next to a car graphic at the top of each invoice. Warranty information at the bottom of each invoice references “repair” performed by “BBA Reman Inc” as well as “[s]hipping, removal, diagnostic, coding, programming, software download, and/or mechanic charges”. However, the warranty’s only reference to specific repairable parts is an exclusion of “diagnostic tools and NAV/Audio”.

PRELIMINARY REMARKS

[13] I note at the outset that none of the documents attached to the Swan affidavit is endorsed by the notary public before whom the affidavit was sworn.

[14] However, it has been established that technical deficiencies in evidence should not stop a party from successfully responding to a section 45 notice where the evidence provided could be sufficient to show use [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. For

example, the Registrar has accepted exhibited evidence that was not properly endorsed where the exhibited evidence was clearly identified and explained in the body of the affidavit [see, for example, *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)].

[15] In the present case, the affiant could have identified the exhibits more clearly by assigning each document its own exhibit number and marking the individual exhibits, or at least attaching the exhibited documents in the order in which they are described. Nevertheless, I am able to readily identify the following exhibited documents from their descriptions: “BBA Reman website - screen shot of Canadian contact” (Exhibit 1); UPS invoice (Exhibit 1); and “recent invoices” (Exhibit 2).

[16] In addition, I am able to identify the document “letter to customer (letterhead)” of Exhibit 1, notwithstanding its placement behind the title page describing Exhibit 2.

[17] I therefore consider the lack of endorsement on these documents to be a mere technicality. I am accordingly prepared to accept these documents as forming part of the affidavit and thus being admissible as evidence in this case.

[18] Less clear is the correlation between the only remaining exhibited pages, namely the pair of screen shots from the Owner’s eBay site, and the only remaining exhibit description, being “recent sample of customer list”. Neither of the webpages depicted in the screen shots identifies anyone as a “customer”. Nor does either page display a list of companies or individuals that one might infer are customers. If the “Members” referenced in one of the screen shots are “customers”, then that is not stated by Mr. Swan. Indeed, omission of the actual list of members from the screen shot suggests that this is *not* the list that Mr. Swan intended to furnish as a “customer list”. Moreover, Mr. Swan’s exhibit descriptions make no reference to *eBay* screen shots; the only mention of a screen shot is the reference to a single screen shot of the “Canadian contact” from the *BBA Reman* website.

[19] The fact that the two eBay screen shots are neither referenced by the affiant nor identified as exhibits to the affidavit amounts to more than a mere technical deficiency [for a similar conclusion, see *Smart & Biggar v Terfloth Trade Marks Ltd*, 2014 TMOB 158, 2014 CarswellNat 4069]. Therefore, as concerns the eBay screen shots, I find that they have not been

presented as part of an affidavit or statutory declaration. They are thus inadmissible, and will not be considered as evidence in the present case.

ANALYSIS

[20] Section 45 proceedings are summary in nature and the evidentiary threshold to be met is quite low. Nevertheless, it is well established that a mere assertion that a trade-mark has been used in Canada is insufficient to meet the requirements of section 45 of the Act. A registered owner must not merely state, but actually *show* use of the trade-mark in association with each of the goods or services listed in registration, “by describing facts from which the Registrar or the Court can form an opinion or can logically infer use within the meaning of section 4” [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401 at paragraph 18].

[21] In particular, with respect to services, the evidence must show that the trade-mark was displayed in the performance or advertising of the registered services in Canada during the relevant period. In the case of advertising, the evidence must also show that the owner is offering and prepared to perform the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[22] In the present case, Mr. Swan’s statement that the Owner has been using the Mark in Canada “on a regular and ongoing basis” since June 2012 in association with “all of its services and associated products” amounts to a mere assertion of use. Although Mr. Swan indicates, in general terms, that the Mark is used on the Owner’s website, Canadian bulletins and advertising materials, invoices, packages, correspondence, other “materials” and all “relevant BBA Reman property”, the documentary evidence provided in support does not show the Mark displayed during the relevant period in the performance or advertising of any of the specific services listed in the registration.

[23] First, the invoices from UPS and the two U.S. companies are dated outside the relevant period. Moreover, they do not show the Mark displayed by or on behalf of the Owner in the advertising or performance of the Owner’s services. Rather, they show third-party suppliers referencing the Owner’s corporate or trade name as a means of identifying their customer. Such

references do not constitute use of the Mark by the Owner within the meaning of sections 4 and 45 of the Act.

[24] Second, although the remaining two invoices were issued by the Owner, they are again dated outside the relevant period. Furthermore, the invoices do not display the Mark as registered—thus the question would become whether inclusion of the element “BBA Reman” in the abbreviated corporate name or website address on the invoices constitutes an acceptable variation of the Mark. Moreover, that variation would need to be displayed in the advertising or performance of registered services, and yet there is no clear correlation between the services referenced in the invoices and the services set out in the registration.

[25] In this last respect, the Mark is registered in association with services that are restricted to specific products, being mostly parts and tools for the automotive industry. However, the furnished invoices do not reference services performed in relation to the specific products set out in the registration. For example, although each invoice appears to be for the supply of an automotive part—an “ECU”—Mr. Swan does not confirm whether this part corresponds to the “engine control modules” listed in the registration. Similarly, although the warranty information references certain services, it does not indicate whether such services are provided for all or only some of the products listed in the registration.

[26] Third, the screen shot from *www.bba-reman.com* does not reference any particular registered services. At most, it refers only generally to “repairs sent to BBA”. Accordingly, even if I were to accept the heading “HOW TO CONTACT BBA-REMAN”—or the website or e-mail address—as a display of the Mark, such display, by itself, would not be in the advertising or performance of the registered services, during the relevant period or otherwise.

[27] Fourth, although the letter from the Owner *is* dated during the relevant period, it does not demonstrate the advertisement or performance of a registered service available in Canada. Instead, it indicates that the Owner is *unable* to perform a requested repair service, with no reason or explanation provided. Moreover, again, the Mark as registered is not displayed.

[28] Finally, even if I were to consider the two eBay screen shots to be admissible as evidence in this case, I would not consider them sufficient to demonstrate use of the Mark in the advertisement or performance of the registered services in Canada during the relevant period.

[29] In this respect, the first eBay screen shot displays the Mark with only a minor variation—omission of the hyphen—and refers to aspects of the registered services, such as remanufacture of automotive industry parts and supply of anti-lock braking systems. However, since the screen shot is undated, it is not clear whether such services were performed or advertised during the relevant period. Indeed, the second eBay screen shot is dated October 1, 2015—if that is also the date of the first screen shot, then it is outside the relevant period. I note that, in his affidavit, Mr. Swan refers to use of the Mark from June 2012 to October 22, 2015, which includes dates both within and outside the relevant period. However, he does not specify whether the eBay screen shots are representative of how the Mark was displayed at any of the times *within* the relevant period. Indeed, he does not reference the eBay screen shots at all.

[30] Moreover, promotional material posted online must be “distributed to” or accessed by prospective customers in order to constitute advertising [*Cornerstone Securities Canada Inc v Canada (Registrar of Trade Marks)* (1994), 58 CPR (3d) 417 (FCTD); see also *Shift Law v Jefferies Group, Inc*, 2014 TMOB 277, 2014 CarswellNat 6223; and *Ridout & Maybee LLP v Residential Income Fund LP*, 2015 TMOB 185, 136 CPR (4th) 127]. In the present case, although the eBay screen shot noting the Owner’s membership since 2009 mentions 650 “views”, it does not specify whether any of those “views” were made by Canadians during the relevant period and, if so, whether those viewers would have seen the specific webpage in question, as it appears in the furnished screen shot. As well, there is no evidence that any Canadians actually availed themselves of any of the Owner’s services available through eBay, during the relevant period or otherwise. Nor is there any other information on how the Owner actually performed its services in Canada, from which inferences favourable to the Owner might have been drawn.

[31] In any event, for the reasons stated above, the eBay screen shots are not admissible as evidence in the present proceeding.

[32] In summary, the Swan affidavit amounts to a mere assertion of use of the Mark with the registered services in general, rather than statements of fact showing use of the Mark in association with each of the specific services listed in the registration. In the absence of further details or supporting evidence, I am not prepared to conclude that the Mark was used or displayed in the performance or advertising of any of the registered services in Canada during the relevant period.

DISPOSITION

[33] In view of all the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered 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.

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

Oksana Osadchuk
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

No agent appointed

FOR THE REGISTERED OWNER

Miltons IP/P.I.

FOR THE REQUESTING PARTY