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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 4**

**Date of Decision: 2020-01-22**

**IN THE MATTER OF SECTION 45 PROCEEDINGS**

**Antler Limited**

**Requesting Party**

**And**

**ATOM S.p.A.**

**Registered Owner**

**TMA563,446 for ATOM Design**

**Registrations**

**TMA563,447 for ATOM Design**

INTRODUCTION

[1] At the request of Antler Limited (the Requesting Party), the Registrar of Trademarks issued notices under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on October 11, 2017 to ATOM S.p.A. (the Owner), the registered owner of registration No. TMA563,446 for the trademark ATOM Design and registration No. TMA563,447 for the trademark ATOM Design (collectively the Marks), shown below, respectively.

atom

ATOM

[2] The Marks are both registered for use in association with the following goods:

Machines for the shoe industry, machine-tools for the shoe industry, for leather goods and for the processing of leather, animal skins and synthetic materials; leather and imitations of leather, and goods made of these materials not included in other classes namely handbags, wallets, brief-cases and belts; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, saddlery, namely saddles and harnesses; clothing, namely leather clothing for men and women, namely jackets, sport jackets, track leather suits; textile clothing for men and women, namely shirts and jackets.

[3] Section 45 of the Act requires the registered owner of the trademark to show whether the trademark has been used in Canada in association with each of the goods 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 trademark was last so used and the reason for the absence of such use since that date. In this case, the relevant period for showing use in both cases is between October 11, 2014 and October 11, 2017.

[4] The relevant definition of “use” with respect to 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.

[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 trademark in association with each of the goods 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 notices, in each case the Owner furnished an affidavit of Luisa Maria Gaia, the CFO of the Owner, sworn March 20, 2018, in Italy [the Gaia Affidavits].

Both parties filed written representations; a hearing was not requested. I note that the affidavits and representations in each case are substantively similar.

#### THE GAIA AFFIDAVITS

[7] The Gaia Affidavits can be summarized as follows:

- The Owner “produces and sells machines, accessories and spare parts for use in many manufacturing sectors, adapting to all industrial processes that include cutting non-metallic materials, including the footwear industry” [para 4].
- In Canada, the Owner sells its products through its distributor, Relco, Inc. Relco purchases ATOM Design-branded machines, machine tools, accessories and spare parts from the Owner or the Owner’s North American distributor, ATOM-MSC USA, and in turn sells these products to Canadian customers [para 5].
- The Owner has sold goods bearing the Marks in Canada since the 1980s. During the relevant period, sales of “machines, machine tools, accessories and spare parts for the shoe industry, for leather goods, and for the processing of leather, animal skins and synthetic materials bearing [the Marks]” amounted to over 4 million euros [para 6].
- Exhibit A to the Gaia Affidavits consist of approximately 40 “representative” invoices from the Owner, all dated during the relevant period, that Ms. Gaia attests pertain to sales of goods sold in Canada in association with the Marks. Ms. Gaia identifies specific goods referenced in the invoices, namely “oscillating knife cutting table”, “oildynamic cutting press”, and “oildynamic clicking press” as being machines and machine tools for use in many industries – including the shoe industry – for cutting rigid and semi-rigid materials, including leather, animal skins and synthetic materials [para 7]. I note that both Marks are displayed at the top of each invoice, and that the Owner’s full name appears separately at the bottom of each invoice.
- With respect to the invoices, Ms. Gaia explains that, in the case of “parts” sales, invoices are issued to Relco directly and, in the case of machine and machine tool sales, invoices

are issued to ATOM-MSA USA. In any event, goods are delivered to Relco in Canada for further sale to Canadian customers [para 7].

- Attached as Exhibit B to the Gaia Affidavits are two photographs of a “knife cutting table” machine bearing the ATOM Design mark (in capital letters). Ms. Gaia confirms that the manner of display demonstrates how the Marks were used on products delivered to customers in Canada during the relevant period.
- Attached as Exhibit C to the Gaia Affidavits are four photographs of “components of a machine wrapped in packaging” bearing the ATOM Design mark (in capital letters). Again, Ms. Gaia confirms that the manner of display demonstrates how the Marks were used on the packaging of products delivered to customers in Canada during the relevant period.

#### ANALYSIS

[8] In its brief written representations, the Requesting Party submits that, while the Gaia Affidavits speak to sales of “machines and machine tools and their accessories and spare parts”, they are silent with respect to the remaining registered goods. As such, the Requesting Party submits that, “at the very least”, the registrations should be amended accordingly to delete such remaining registered goods.

[9] In its written representations, the Owner submits that it has established use of the Marks “at least” in association with “machines for the shoe industry” and “machine-tools” and that the registrations should be maintained accordingly with respect to such goods.

[10] Indeed, having reviewed the exhibited invoices and photographs in conjunction with Ms. Gaia’s sworn statements, it is clear that the Owner has evidenced transfers of the registered goods “machines for the shoe industry” and “machine-tools...” in Canada during the relevant period and that such goods and/or their packaging displayed the ATOM Design mark (albeit in capital letters only).

[11] Nevertheless, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)

and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I find that the dominant feature of both Marks is the word “Atom”. As such, I consider the display of the ATOM Design mark in capital letters as shown in the exhibited product and packaging photographs to constitute use of the ATOM Design mark in lower-case letters as well, the dominant feature having been preserved.

[12] In any event, in applying the factors set out in *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321 at para 12 with respect to display of a trademark on invoices, I also accept the display of both Marks at the top of the exhibited invoices to constitute use of both Marks in association with the invoiced goods. In this respect, I note that the invoices are for sales to a distributor, the Owner’s full name appears separately from the displayed Marks, and no other trademarks (such as those of other manufacturers) appear on the invoices.

[13] In view of foregoing, I am satisfied that the Owner has established use of the Marks in association with the registered goods “Machines for the shoe industry, machine-tools for the shoe industry, for leather goods and for the processing of leather, animal skins and synthetic materials” within the meaning of sections 4 and 45 of the Act.

[14] With respect to the remaining goods, I agree with the Requesting Party that there is no evidence of use of the Marks in association with any goods other than “machines” and “machine-tools”. While the machines and machine-tools sold by the Owner may be used in the processing of leather goods, clothing, and the like, the evidence is otherwise silent with respect to those remaining registered goods as objects of trade in and of themselves.

[15] As such, I am not satisfied that the Owner has established use of the Mark in association with any of the remaining registered goods within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances before me, the registrations will be amended accordingly.

#### DISPOSITION FOR TMA563,446

[16] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, registration No. TMA563,446 will be amended to delete the following goods:

... leather and imitations of leather, and goods made of these materials not included in other classes namely handbags, wallets, brief-cases and belts; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, saddlery, namely saddles and harnesses; clothing, namely leather clothing for men and women, namely jackets, sport jackets, track leather suits; textile clothing for men and women, namely shirts and jackets.

[17] The amended statement of goods will be as follows:

Machines for the shoe industry, machine-tools for the shoe industry, for leather goods and for the processing of leather, animal skins and synthetic materials.

DISPOSITION FOR TMA563,447

[18] Similarly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, registration No. TMA563,447 will be amended to delete the following goods:

... leather and imitations of leather, and goods made of these materials not included in other classes namely handbags, wallets, brief-cases and belts; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, saddlery, namely saddles and harnesses; clothing, namely leather clothing for men and women, namely jackets, sport jackets, track leather suits; textile clothing for men and women, namely shirts and jackets.

[19] The amended statement of goods will be as follows:

Machines for the shoe industry, machine-tools for the shoe industry, for leather goods and for the processing of leather, animal skins and synthetic materials.

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Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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No Hearing Held

**AGENTS OF RECORD**

Marks & Clerk

For the Registered Owner

Moffat & Co.

For the Requesting Party