



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 104

Date of Decision: 2021-05-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar

Requesting Party

and

J-Tech Digital, Inc.

Registered Owner

TMA903,244 for J-TECH DIGITAL

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA903,244 for the trademark J-TECH DIGITAL (the Mark), currently owned by J-Tech Digital, Inc. (the Owner).

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

THE PROCEEDING

[3] At the request of Smart & Biggar (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on December 27, 2018, to Lan Yao (the Registrant), the owner at the time of the Mark.

[4] The notice required the Registrant to show whether the Mark had been used in Canada in association with each of the goods and 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 it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is December 27, 2015, to December 27, 2018.

[5] The Mark is registered for use in association with the following goods and services:

GOODS

(1) Audio and video HDMI products namely audio amplifiers, audio and video cables, connectors and converters, audio video switchers, audio and video splitters, audio speakers and receivers, audio and video decoders.

(2) Consumer electronic products namely home theater systems, audio amplifiers, audio speakers, audio receivers, electrical audio and speaker cables and connectors, audio decoders, video decoders, speakers, power conversion devices, power converters and power inverters; Electronic switchers for audio and video signals; high definition multimedia interface apparatus and component cables sold as a unit; high-definition multimedia interface cables; matrix switchers for audio and video signals; signal splitters for electronic apparatus.

(3) USB accessories namely USB cables and adapters for personal computers, SATA accessories namely cables and enclosures for PC hard drivers, WIFI network products namely WIFI internet routers, WIFI repeaters, and WIFI USB adapters.

SERVICES

(1) Servicing, installation and consultant services in the field of audio and video HDMI products, consumer electronic products and USB accessories.

[6] On March 22, 2019, the Registrant advised the Registrar that the Mark had been assigned from the Registrant to the Owner, effective March 1, 2019. On January 13, 2020, the Registrar updated the registration to record this assignment.

[7] On November 19, 2019, the Owner requested discontinuance of this proceeding, stating that this proceeding had been initiated at the Owner's request. However, on December 5, 2019, the Requesting Party wrote to the Registrar noting that the proceeding had been initiated at *its* request, not the Owner's, and indicating that it did not consent to discontinuance. In response, on January 2, 2020, the Registrar wrote to the parties confirming that pursuant to section IX of the Registrar's practice notice, *Practice in section 45 proceedings*, a section 45 proceeding will only be discontinued on consent of the parties. The Registrar further confirmed that Smart & Biggar

remained the requesting party in this proceeding, and in the absence of its consent, the proceeding would continue and a decision would issue in due course.

[8] The relevant definitions of use in the present case are set out in section 4 of the Act as follows:

4(1) A trademark 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.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[9] It is well established that bare statements that a trademark is in 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 these proceedings is 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 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 and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[10] In response to the Registrar's notice, the Registrant furnished the statutory declaration of Lan Yao, declared on March 22, 2019. Only the Requesting Party submitted written representations. No oral hearing was held.

THE EVIDENCE

[11] The statutory declaration is brief, consisting of the following substantive paragraphs:

1. I applied for [the Mark] on behalf of J-Tech Digital, Inc. on 28 May 2012, and [the Mark] was registered on 11 May 2015.
2. [The Mark] has been continuously used since registration in all three classes of goods: audio and video HDMI products, consumer electronic products, and USB accessories. A copy of amazon.ca website showing sale of these goods is attached to this declaration.

[12] Attached to the declaration, but not marked as exhibits or notarized, are screenshots from *www.amazon.ca*. The upper left hand corner of the screenshots reads “J-Tech Digital”. The screenshots show a range of electronics equipment. The Mark appears in the product descriptions for the products, and in some cases, is shown as appearing on the products themselves.

REASONS FOR DECISION

[13] The Requesting Party submits that the attached screenshots are inadmissible as they are not marked as exhibits or notarized. 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 or declaration [see, for example, *Borden & Elliot c Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)]. In this case, I am not prepared to consider the screenshots to be inadmissible simply because they are not marked as exhibits or notarized, given that they are clearly identified in the body of the Registrant’s statutory declaration.

[14] Nevertheless, I concur with the Requesting Party that the evidence does not establish use of the Mark within the meaning of the Act for a number of reasons. Firstly, there is no indication that any of the goods shown on the screenshots were sold during the relevant period. It is not enough that such goods were merely offered for sale; some evidence of transfer in the normal course of trade is necessary. While the Registrant describes the screenshots as “showing sale of these goods”, the screenshots merely show that the goods were available for sale, not that they were actually sold.

[15] Secondly, there is no indication that the screenshots are dated during the relevant period. Indeed, certain listings read “Get it by Thu, Mar 14”; I note that March 14 fell on a Thursday in 2019 but not during the relevant period. As such, there is no evidence that the goods shown in the screenshots were even available for sale during the relevant period. The Registrant’s statement that the Mark “has been continuously used since registration” in association with the registered goods does not clarify whether such goods were sold through *www.amazon.ca* or otherwise during the relevant period.

[16] Thirdly, there is no indication that the goods shown in the screenshots were sold or offered for sale *by the Registrant*. As noted above, the notice required the Registrant to show that it had used the Mark in association with the registered goods and services during the relevant period. Neither the statutory declaration nor the screenshots themselves confirm who was offering the goods for sale. However, the appearance of the Owner's name at the top of the screenshots suggests that the goods might be offered for sale by the Owner, rather than the Registrant, which would be consistent with the assignment of the Mark to the Owner on March 1, 2019. As the Registrant owned the Mark for the entirety of the relevant period, any use of the Mark by the Owner would not enure to the Registrant unless, pursuant to a licence, the Registrant had control over the character and quality of the associated goods and services. While the statutory declaration states that the Registrant applied for the Mark on behalf of the Owner in 2012, there is no further indication in evidence of any relationship or licence between the Registrant or the Owner. Accordingly, there is no indication that any use of the Mark in association with goods sold through *amazon.ca* would enure to the Registrant.

[17] Finally, there is no mention of the registered services in the statutory declaration or screenshots, and no evidence of special circumstances excusing non-use of the Mark in association with any of the goods or services.

DISPOSITION

[18] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods or services within the meaning of sections 4 and 45 of the Act. Accordingly, 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.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Brunet & Co.

For the Registered Owner

Smart & Biggar LLP

For the Requesting Party