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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 169

Date of Decision: 2021-07-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Osler, Hoskin & Harcourt LLP

Requesting Party

and

Volkswagen Aktiengesellschaft

Registered Owner

TMA721,675 for HIGHLINE

Registration

INTRODUCTION

[1] At the request of Osler, Hoskin & Harcourt LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13, (the Act) on February 21, 2018 to Volkswagen Aktiengesellschaft (the Owner), the owner of registration No. TMA721,675 for the trademark HIGHLINE (the Mark).

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

(1) Vehicles and apparatus for locomotion by land, air or water, namely, automobiles, trucks, vans, lorries, trailers, buses, trains, locomotives, bicycles, motorcycles, snowmobiles, airplanes, boats and ship, hot air balloons and dirigibles and structural parts for all the aforesaid.

[3] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, in association with each of the registered goods, at any time within the three-year period immediately preceding the date of the notice, which in this case is between February 21, 2015, and February 21, 2018. If the Mark had not been used within the relevant period, 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.

[4] The relevant definition of “use” for goods is set out in section 4(1) 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.

[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 a section 45 proceeding 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 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 Lynne Piette, Director Marketing and Communication of Volkswagen Group Canada Inc., sworn on September 14, 2018.

[7] Neither party filed written representations and only the Owner attended an oral hearing.

[8] For the reasons that follow, I conclude that the registration ought to be maintained in part.

EVIDENCE AND ANALYSIS

[9] Ms. Piette defines Volkswagen Group Canada Inc. (the Licensee) as the exclusive licensee of the Mark and wholly owned subsidiary of the Owner. As such, Ms. Piette states that the Owner maintains and monitors the quality control of the registered goods offered and sold in Canada in association with the Mark.

[10] Ms. Piette states that the Mark is used in association with an upgrade package sold to clients when purchasing a vehicle. According to Ms. Piette, during the relevant period, this upgrade package was available on at least the following Volkswagen models: MY Atlas, Jetta, Golf, Golf Sportwagen, Passat, CC, Tiguan and Touareg.

[11] The Mark does not appear directly on the vehicles sold by the Licensee, but it appears on different documents, such as promotional and advertising materials, purchase and sales agreements and invoices, as stated by Ms. Piette. These documents are provided to consumers and purchasers, prior to and at the time of purchase of the registered goods or at the time of delivery, during the relevant period in Canada. As Exhibit B, the Owner files representative examples of how the Mark appears on different documents. In paragraph seven and eight of her affidavit, Ms. Piette describes the registered goods shown in Exhibit B as “in particular but not limited to automobiles, trucks and vans”.

[12] While it is not for the Registrar to speculate as to the nature of the registered goods [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13; *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 (TMOB) at para 12], reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)]. Although Ms. Piette mentions that the Mark has been used with “automobiles, trucks and vans”, the photographs in Exhibit B documents show only automobiles.

[13] In previous cases, different documents displaying a trademark were deemed sufficient to give notice of association between the trademark and the goods sold, such as an instruction sheet [see *Borden Ladner Gervais v Mueller International, Inc*, 2009 CanLII 82132 (TMOB) at para 11], a user manual [see *BCF LLP v THAT Corporation*, 2016 TMOB 190 at paras 31 to 33] and a

sales brochure, warranty form, and product manual [see *Billi R & D Pty Ltd v Culligan International Company*, 2020 TMOB 20 at para 14].

[14] In the present case, because the Mark appears on purchase and sales agreements that are given to purchasers at the time of delivery of the goods and on promotional and advertising materials provided to purchasers at the time of purchase, I accept that notice of association between the Mark and the registered goods was given to purchasers at the time of transfer of the registered goods, in accordance with the provisions of section 4(1) of the Act.

[15] In addition, Ms. Piette states that the Licensee sold at least 10 000 units of vehicles between June 2015 and July 2017 in Canada in association with the Mark. Moreover, as Exhibit C, the Owner filed representative sample invoices for vehicles sold in Canada during the relevant period.

[16] Based on the Exhibit B documents showing display of the Mark in association with automobiles and on the Exhibit C invoices showing transfers of automobiles in the normal course of trade in Canada during the relevant period, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with vehicles and apparatus for locomotion by land, namely, automobiles.

[17] As for the remaining goods listed in the registration, there is no evidence of no evidence of display of the Mark nor transfer of the remaining registered goods. Without evidence of use of the Mark in association with these goods, and as there are no special circumstances excusing non-use of the Mark in association with these goods, the registration will be amended accordingly.

DISPOSITION

[18] Based on the findings above, 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, the registration will be amended to delete the following goods shown ~~struck out~~ below:

(1) Vehicles and apparatus for locomotion by land, ~~air or water~~, namely, automobiles, ~~trucks, vans, lorries, trailers, buses, trains, locomotives, bicycles, motorcycles,~~

~~snowmobiles, airplanes, boats and ship, hot air balloons and dirigibles and structural parts for all the aforesaid.~~

[19] As such, the amended statement of goods in the registration will read as follows:

Vehicles and apparatus for locomotion by land, namely, automobiles.

Ann-Laure Brouillette
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-06-09

APPEARANCES

Kenneth McKay	For the Registered Owner
No one appearing	For the Requesting Party

AGENTS OF RECORD

All the trademark agents at Marks & Clerk Canada	For the Registered Owner
All the trademark agents at Osler, Hoskin & Harcourt LLP	For the Requesting Party