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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 204

Date of Decision: 2021-09-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar LLP

Requesting Party

and

Wilson Sporting Goods Co.

Registered Owner

TMA203,653 for ADVANTAGE

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. TMA203,653 for the trademark ADVANTAGE (the Mark), currently owned by Wilson Sporting Goods Co. (the Owner).

[2] All references are to the Act as amended June 17, 2019 (the Act), unless otherwise noted.

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

Tennis rackets (the Goods).

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

THE PROCEEDINGS

[5] At the request of Smart & Biggar LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on March 3, 2020, to the Owner.

[6] The notice required the Owner to show whether the trademark has been used in Canada in association with 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 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 March 3, 2017 to March 3, 2020 (the Relevant Period).

[7] The relevant definition of use in the present case 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.

[8] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[9] In response to the Registrar’s notice, the Owner furnished the affidavit of Jason Collins, the Global Products Director of the Racquet Sports Division of the Owner, sworn on July 21, 2020, together with Exhibits A to F.

[10] Only the Owner submitted written representations and no oral hearing was held.

THE EVIDENCE

[11] Mr. Collins explains that the Owner is a company incorporated in the United States, specializing in the manufacturing of sports equipment, including tennis rackets. He states that the Mark has been used in Canada in association with the Goods as early as 1974 [paras 3 and 6].

[12] In support, Mr. Collins attaches the following relevant exhibits to his affidavit:

- Exhibit “B”: photos of a tennis racket and a label bearing the Mark [paras 7 and 8].
- Exhibit “D”: Three screenshots from Canadian Tire’s webpage taken from the internet archiving services Wayback Machine, dated April 25, 2017; May 26, 2017; and June 16, 2018, showing the Mark used in association with the Goods [para 10].

[13] Mr. Collins states that the Owner has sold the Goods in Canada, during the Relevant Period and that the Mark was displayed on the Goods themselves and on their labels [paras 7 and 8; Exhibit “B”].

[14] Mr. Collins declares that the Owner sold in excess of \$50,000 a year worth of tennis rackets bearing the Mark in 2018 and 2019, in Canada, to Canadian Tire [para 11]. He also adds that the Owner sells the Goods on other third-party retailers’ websites, including Walmart Canada and Amazon Canada [para 9].

ANALYSIS

[15] Given that the Requesting Party has submitted no written representations and based on the evidence described above, the only question left to determine is whether or not the evidence described above establishes that there has been use of the Mark in Canada during the Relevant Period in association with the Goods within the meaning of section 4(1) of the Act.

[16] Given that the Owner has sold the Goods in Canada during the Relevant Period [para 11], and has shown that the Mark appeared on the Goods themselves and the associated

label [paras 7 and 8; Exhibit “B”], I am satisfied that the Owner has shown use of the Mark in Canada within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[17] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Martin Béliveau
Chairperson
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

Smart & Biggar LLP

For the Registered Owner

Marks & Clerk

For the Requesting Party