

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 273

Date of Decision: 2021-12-03

IN THE MATTER OF SECTION 45 PROCEEDINGS

Gowling WLG (Canada) LLP

Requesting Party

and

Manu Sharma

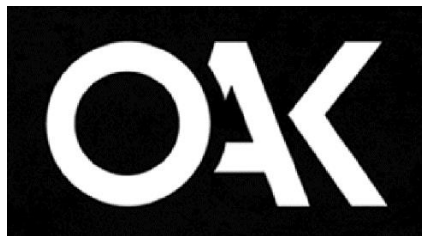
Registered Owner

**TMA827,844 for OAK and
TMA827,843 for OAK Design**

Registrations

INTRODUCTION

[1] This is a decision involving summary expungement proceedings with respect to registration No. TMA827,844 for the trademark OAK (the Word Mark) and registration No. TMA827,843 for the trademark OAK Design (Design Mark) reproduced below.



[2] The Word Mark and Design Mark are both registered for use in association with the following services:

Computer software design; software design for mobile phones, smartphones and tablet computers; updating of computer software; computer software verification; website design; graphic design; providing quality assurance in the field of computer software; computer database design services; consulting services in the fields of information technology, computer software design, website design, data management systems, social media software, software architecture, website architecture, network system architectures, software for mobile phones, smartphones and tablet computers, application architecture for mobile phones, smartphones and tablet computers, network protocols, computer software security, computer network security, internet security, privacy, encryption, firewall and anti-virus protection for the transmission of data and communications on a global computer network, software verification, graphic user interface (GUI) design, virtual and cloud computing environments accessible via global computer networks and organizational networks, computer data and software accessible via global computer networks and organizational networks.

[3] The proceedings were initiated on June 4, 2020, at the request of Gowling WLG (Canada) LLP (the Requesting Party), when the Registrar of Trademarks issued two notices pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to 8360022 Canada Inc., the owner of the registrations at the time. I note that assignments from 8360022 Canada Inc. to Manu Sharma (the Owner) were subsequently recorded by the Registrar on June 7, 2021 in respect of both registrations.

[4] In response to the Registrar's notices, the Owner submitted an affidavit in his own name, sworn on September 2, 2020 in Ottawa, Ontario (the Sharma Affidavit). The Owner subsequently filed additional affidavits, which will be discussed below.

[5] Both parties filed written representations and no oral hearing was held.

SUMMARY OF RELEVANT LAW

[6] A notice issued by the Registrar pursuant to section 45 of the Act requires the owner of the subject registration to show whether the trademark at issue was used in Canada in association with the goods and/or services listed 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.

[7] The relevant definition of use in this case is set out in section 4(2) of the Act as follows:

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.

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

[9] Pursuant to sections 45(1) and (2) of the Act, the Registrar can only consider evidence which is submitted in the form of an affidavit or statutory declaration, and filed within three months of the date of the Registrar's notice plus any extensions granted under section 47 of the Act.

[10] As section 45 proceedings are intended to be summary in nature – their purpose being to remove “deadwood” from the trademarks register – mere technical deficiencies in an owner's evidence should not be a bar to a successful response to a section 45 notice [*Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)], and it has been held that the “technical requirements” of section 45 should not become “a trap for the unwary” [*George Weston Ltd v Sterling & Affiliates* (1984), 3 CPR (3d) 527 (FCTD)].

[11] By way of example, the Registrar has held that exhibits to an affidavit need not be notarized if the exhibits are properly identified in the body of the affidavit [*Smith, Lyons,*

Torrance, Stevenson & Mayer v Pharmaglobe Laboratories Ltd (1996), 75 CPR (3d) 85 (TMOB)]. Similarly, the Registrar has found that the fact that a commissioner's name is not fully spelled out in an affidavit's jurat is a mere technicality that should not render that affidavit inadmissible in a section 45 proceeding [*Brouillette, Kosie v Luxo Laboratories Ltd* (1997), 80 CPR (3d) 312 (TMOB); *Dashte Morghab Co v Rex Inc* (2005), 52 CPR (4th) 71 (TMOB)].

EVIDENCE

[12] The body of the Sharma Affidavit is relatively brief and is reproduced in its entirety below:

I, Manu Sharma, of Ottawa, Ontario, MAKE OATH AND SAY THAT:

1. 8360022 Canada Inc was formally dissolved in May 2019 and Trademark Registration Number TMA827,844 and Trademark Registration Number TMA827,843 were assigned to me, Manu Sharma.
2. Both trademarks, "OAK" (Trademark Registration Number TMA827,844) and "OAK DESIGN" (Trademark Registration Number TMA827,843), have been active during the three year period immediately preceding June 4, 2020, and are in current commercial use with respect to the services specified in the trademark registrations.

[13] The Owner filed the Sharma Affidavit together with a cover letter signed by Mr. Sharma and dated September 2, 2020. The cover letter mentions the affidavit, as well as the following documents "enclosed also in support of the response":

1. Copy of Dissolution Certificate of 8360022 Canada Inc.
2. Copy of the Special Resolution of the Shareholders of 8360022 Canada Inc. assigning the two trademarks to Manu Sharma.
3. Copies of OAK proposals/quotes that establish that both trademarks have been active and in commercial use, with respect to the services specified in the registrations, during the three-year period immediately preceding the date of notices.

[14] These enclosures are not referenced in the body of the Sharma Affidavit. They are not notarized, and are not identified with cover pages or otherwise separated from each other.

[15] In its written representations, the Requesting Party argued that, pursuant to section 45(2) of the Act, the enclosures are inadmissible in this proceeding as they are not exhibits to the Sharma Affidavit.

[16] In response to the Requesting Party's written representations, the Owner filed its written representations along with two affidavits, both sworn by Mr. Sharma on January 15, 2021. The first affidavit contains the above-reproduced paragraphs from the Sharma Affidavit. Below each of those paragraphs, Mr. Sharma explains the contents and significance of exhibited materials, namely Exhibits A to G. The exhibits are not notarized. I note that some of the exhibited materials, though not all, correspond to the enclosures filed by the Owner on September 2, 2020. The second affidavit also contains new evidence, including further exhibits and explanations regarding the Owner's business.

[17] Subsequently, the Requesting Party wrote to the Registrar to object to the inclusion of the January 15, 2021 affidavits as evidence on the basis that these were filed without consent of the Requesting Party, without leave of the Registrar, and well past the deadline to submit evidence. In a letter dated February 26, 2021, the Registrar confirmed that "any new evidence contained within or attached to the registered owner's written representations cannot be considered by the Registrar".

ANALYSIS

[18] In the present case, there is no question that the Sharma Affidavit is admissible evidence. However, on their own, the statements made therein are insufficient to show use of the subject trademarks within the meaning of sections 4 and 45 of the Act. Indeed, without supporting evidence, Mr. Sharma's statement that the trademarks were "active" is, at most, a bare assertion of use of the sort found unacceptable by the Federal Court of Appeal in *Plough, supra*. It is therefore necessary to determine whether any of the other materials filed by the Owner constitute admissible evidence.

[19] To begin, I will address the enclosures furnished along with the Sharma Affidavit. These enclosures are neither explained nor referenced in the Sharma Affidavit, and while the cover

letter identifies the enclosures, this letter is neither sworn nor notarized. As a result, the enclosures are unsworn documents, which are not identified under oath. In my view, this constitutes more than a mere technical deficiency or minor irregularity of the type which has been disregarded by the Registrar in other cases, such as unnotarized exhibit cover pages or irregularities in the jurat. Accordingly, I agree with the Requesting Party that the enclosures are inadmissible as evidence in these proceedings.

[20] Next, I will address the two affidavits filed in response to the Requesting Party's written submissions. These affidavits were filed four months after the expiry of the Owner's deadline to file evidence, and no retroactive extension of time was requested by the Owner.

[21] With respect to the first January 15, 2021 affidavit, I accept that the primary purpose of that affidavit was to correct some of the identified technical deficiencies of the Sharma Affidavit. However, rather than merely doing so, the Owner also augmented its evidence by including additional details which were not present in the original Sharma Affidavit, such as the explanations of the exhibits and the additional exhibits not previously furnished as "enclosures". Similarly, the second January 15, 2021 affidavit contains new evidence which is not elsewhere referenced.

[22] Having regard to the relevant law set out above, and in particular the limitations set out in the Act with respect to improperly filed evidence, I find that these affidavits cannot be admitted as evidence in these proceedings.

[23] In view of the foregoing, I find that the admissible evidence in these proceedings is solely comprised of the original Sharma Affidavit. I am therefore 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 non-use of the Mark.

[24] Before concluding, I note that the Owner expressed concern about the impact of the proceeding on his ability to "generate and develop new business" and explained that the "loss of

the two trademarks would... threaten his livelihood”. However, I note that section 45 proceedings are limited in scope. The only matter to be resolved is whether, within the meaning of sections 4 and 45 of the Act, the evidence demonstrates use of the trademark with respect to each of the registered goods or services in question. It is well established that section 45 proceedings are not intended to provide an alternative to the usual *inter partes* attack on a trademark envisaged by section 57 of the Act [see *Meredith & Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)]. Similarly, whether a registration is maintained, amended or expunged, any disposition in a section 45 proceeding should not be construed as resolving any rights a person may or may not have in the trademark otherwise [*Modern Warehouse Imports Inc v Anthony C Sanginesi*, 2017 TMOB 18 at para 18].

DISPOSITION

[25] 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, both registrations will be expunged.

Eve Heafey
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

No agent appointed

For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party