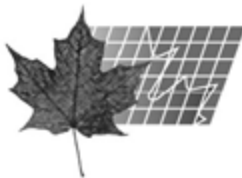


O P I C



C I P O

**LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS**

**Citation: 2022 TMOB 081**

**Date of Decision: 2022-04-26**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Smart & Biggar**

**Requesting Party**

**and**

**JTEKT Corporation**

**Registered Owner**

**TMA920,041 for JTEKT & DESIGN**

**Registration**

[1] At the request of Smart & Biggar (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 December 27, 2018, to JTEKT Corporation (the Owner), the registered owner of registration No. TMA920,041 for the trademark JTEKT & DESIGN (the Mark), shown below:

**JTEKT**

[2] The registration includes the following colour claim: Colour is claimed as a feature of the trade-mark. The bi-convex drawing in the middle of the alphabet E is red and the letters JTEKT are black.

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

Metalworking machines and tools, namely, lathes, rolling mills, tubing mills, mechanical presses, manual presses, hydraulic presses, oil hydraulic presses, pneumatic

drills, pneumatic hammers, grinders, sanders, electric drills, electric hammers, screwdrivers, nut runners, buffers, polishers, gear cutters, taps, thread chasers, drill bits, thread milling cutters, turning point tools, broaches, namely, a series of progressively taller chisel points mounted on a single piece of steel, milling cutters, reamers, cemented carbide tools, namely, cutting tools, anti-corrosive tools and anti-abrasive tools made of cemented carbide, diamond cutting tools, moulds and dies for metal-forming, forging moulds, press dies for metal forming; loading-unloading machines and apparatus, namely, cranes, conveyors, hoisting or winding gears, winches, windlasses, capstans (not for ships or boats), chain blocks, hoists, escalators, elevators, power jacks, unloading hoppers; non electric prime movers, not for land vehicles (other than 'water mills' and 'wind mills'), namely, internal combustion engines, steam engines, jet engines, rocket engines, turbines, compressed air engines, nuclear prime movers; pneumatic or hydraulic machines and instruments, namely, pumps, vacuum pumps, blowers, compressors; machine elements not for land vehicles, namely, shafts, axles or spindles (not for land vehicles), bearings (machine elements not for land vehicles), shaft couplings or connectors (machine elements not for land vehicles), universal joints, power transmissions and gearing for machines (not for land vehicles), pulleys, valves (machine elements not for land vehicles), shock absorbers (machine elements not for land vehicles), springs (machine elements not for land vehicles), brakes (machine elements not for land vehicles); driveshafts not for land vehicles; grease rings; waste compacting machines and apparatus, namely, grinding sludge compressor; waste crushing machines; starters for motors and engines; AC motors and DC motors (not including those for land vehicles but including 'parts' for any AC motors and DC motors); AC generators (alternators); DC generators; dynamo brushes; vehicles drive training simulators; sports training simulators; power distribution or control machines and apparatus, namely, electric switches, electric relays, circuit breakers, power controllers, current rectifiers, electric connectors, electric circuit closers, electric capacitors, electric resistors, local switches power distributing boxes, plugboards, fuses, lightning arresters, electric transformers, induction voltage regulators, electric reactors; electrical converters; phase modifiers; telecommunication machines and apparatus, namely, intercoms, telephone sets, teletypewriters, television receivers, television transmitters, radio receivers, radio transmitters, radio direction finders, public-access systems and instruments, compact disc players, juke boxes, tape recorders, electric phonographs, record players, video cameras, videodisc players, videotape records, antennas, cabinets, coils, magnetic tape erasers, magnetic tape cleaners, magnetic head erasers, magnetic head cleaners, loudspeakers, connectors, stands and racks, dials, electric capacitors, fuses, electric resistors, blank magnetic tapes for tape recorders, change-over switches, plugboards, pickups, blank video tapes, indicator lights, electrical phonomotors, headphones, electrical transformers, protectors, microphones, blank record disks, sprays for phonograph records; electronic machines, apparatus and their parts, namely, Geiger counters, high frequency welders, cyclotrons, industrial betatrons, magnetic object detectors, shield cases for magnetic disks, echo sounders, ultrasonic flaw detectors, ultrasonic sensors, auto door-lock systems, computers, electron microscopes, electronic desk calculators, word processors, electron tubes, semiconductor diodes, electronic circuits, computer programs for controlling machine tools and vehicles; heat exchangers (for chemical processing); industrial furnaces; machine elements for land vehicles, namely, shafts, axles or spindles,

bearings, shaft couplings or connectors, universal joints, power transmissions and gearing for machines, pulleys, suspension, damper pulleys, valves, shock absorbers, springs, brakes, differentials; grease rings; wheelchairs; AC motors or DC motors for land vehicles (not including 'their parts'); vessels, namely, boats and ships and parts and fittings therefor; railway rolling stock and their parts and fittings; automobiles and their parts and fittings, namely, cars, pumps, steering systems, driveshafts, clutches, hub units, hubs, wheels, camshafts; motorcycles, bicycles and their parts and fittings; seals, namely non-metal oil seals and non-metal grease seals.

[4] The notice required the Owner to show whether the Mark was 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 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 relevant definition of use 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.

[6] 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 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 specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] In the absence of use, pursuant to section 45(3) of the Act, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Yasunori Sasatani, sworn July 20, 2019 in Japan; and the affidavit of Cindy Noel, sworn July 29, 2019 in Toronto.

[9] Both parties submitted written representations. Only the Owner was represented at an oral hearing. The hearing was held jointly with respect to the summary cancellation proceeding for registration No. TMA825,081 for the trademark JTEKT. As the evidence and representations differ, a separate decision will be issued with respect to that proceeding.

#### THE EVIDENCE

##### **Sasatani Affidavit**

[10] Mr. Sasatani is the General Manager of the Owner's Intellectual Property Legal Division. In his affidavit, he states that the Owner is an engineering and manufacturing company that sells its "suite of carrier solutions" to motor carrier companies in Canada [para 7].

[11] In particular, Mr. Sasatani attests that, during the relevant period in Canada, the Owner "has sold" the following registered goods in association with the Mark: "machine elements for land vehicles namely bearings" and "machine elements not for land vehicles namely bearings (machine elements not for land vehicles)" [para 8].

[12] With respect to display of the Mark, Mr. Sasatani attests that, during the relevant period, the Mark appeared on the boxes of such bearings. In support, he provides a photograph showing a bearing box which he states is representative of how the Mark was displayed on the boxes of both categories of bearings sold [paras 9 and 10, Exhibit B].

[13] Mr. Sasatani also provides a screenshot from the Owner's website, *www.jtekt.co.jp*, displaying the Mark [para 11, Exhibit C].

##### **Noel Affidavit**

[14] Ms. Noel is an employee of the Owner's agent of record. In her affidavit, Ms. Noel does not directly address the issue of use of the Mark during the relevant period or otherwise. Rather,

she provides the results of various internet searches she conducted in July 2019, largely consisting of printouts from the Owner's website [paras 4 to 6, Exhibits B to T].

#### ANALYSIS AND REASONS FOR DECISION

[15] At the outset, I note that the exhibited webpages attached to Ms. Noel's affidavit are, for the most part, hearsay and not particularly probative. At best, the website printouts indicate that JTEKT-branded products were available for sale during the relevant period.

[16] As for the Sasatani affidavit, as noted by the Requesting Party in its written representations, the Owner does not provide any direct or documentary evidence of sales of any of the registered goods, including with respect to "bearings" [para 30].

[17] Although direct or documentary evidence is not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], some evidence of transfer in the normal course of trade in Canada is necessary [*John Labatt, supra*]. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[18] In the present case, I consider Mr. Sasatani's affidavit to fall short of including such sufficient particulars with respect to any of the registered goods. Although Mr. Sasatani states that the Owner "has sold" the registered goods "machine elements for land vehicles, namely, bearings" and "machine elements not for land vehicles, namely, bearings (machine elements not for land vehicles)" in Canada during the relevant period [para 8], he does not provide further particulars that would allow me to conclude that the Owner's bearings were in fact transferred in the normal course of trade or whether such transfer occurred in Canada. Indeed, absent further particulars, Mr. Sasatani's statement that the Owner "has sold" bearings could merely mean that such goods were *available* for sale in Canada. Ms. Noel's affidavit sheds no light on this issue.

[19] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence of special circumstances excusing non-use before me.

DISPOSITION

[20] Accordingly, 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 expunged.

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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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**HEARING DATE:** 2022-01-24

**APPEARANCES**

Marta Cheng

For the Registered Owner

No one appearing

For the Requesting Party

**AGENTS OF RECORD**

Riches, McKenzie & Herbert LLP

For the Registered Owner

Smart & Biggar LLP

For the Requesting Party