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

**Citation: 2022 TMOB 091**

**Date of Decision: 2022-05-02**

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

**Hicks Intellectual Property Law**

**Requesting Party**

**and**

**Nam Yung Lighting Co., Ltd.**

**Registered Owner**

**TMA558,445 for EAGLEYE & Design**

**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. TMA558,445 for the trademark EAGLEYE & Design (the Mark), as illustrated below, currently owned by Nam Yung Lighting Co., Ltd. (the Owner):



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

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

Halogen headlights for automobiles; brake lamps for automobiles; lamps for directional signals of automobiles; room lights for automobiles; incandescent lamps; fluorescent lamps; discharge lamps; screw type fluorescent lamps; halogen headlights for motorcycles; infrared lamps; decoration lamps; socket type fluorescent lamps (the Goods).

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

#### THE PROCEEDINGS

[5] At the request of Hicks Intellectual Property Law (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 20, 2020, to the Owner.

[6] The notice required the Owner to show whether the trademark has been 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 July 20, 2017 to July 20, 2020 (the Relevant Period).

[7] 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.

[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. As such, the evidentiary threshold that the Owner must meet is quite low [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at 57]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the Mark was used in association with the Goods.

[9] In the absence of use as defined above, pursuant to section 45(3) of the Act, the registration of a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[10] In response to the Registrar's notice, the Owner furnished the affidavit of its General Manager, Seok Yong Jim, sworn on June 9, 2021, together with Exhibits A to F inclusive.

[11] The parties did not submit written representations and no oral hearing was held.

#### THE EVIDENCE AND ANALYSIS

[12] Mr. Jim attests that the Owner, located in Seoul, Korea, is one of the top manufacturers and worldwide suppliers of lighting products for use in the automotive industry including: halogen headlights for automobiles; brake lamps for automobiles; lamps for directional signals of automobiles; room lights for automobile; and halogen headlights for motorcycles (the Owner's lighting products).

[13] Mr. Jim affirms that the Owner's lighting products are sold to distributors, wholesalers and retailers in the automotive industry in Canada.

[14] I note that nowhere in his affidavit Mr. Jim makes reference to incandescent lamps; fluorescent lamps; discharge lamps; screw type fluorescent lamps; infrared lamps; decoration lamps; socket type fluorescent lamps. He does not provide any reasons that would explain the non-use of the Mark in Canada in association with these goods. Consequently, the registration will be amended accordingly.

#### **Use of the Mark in association with certain of the Goods**

[15] Mr. Jim affirms that the Owner's lighting products are sold in packaging which prominently displays the Mark as well as the Owner's name. To substantiate this affirmation, he attaches as Exhibits A to E inclusive, the following images:

Exhibit A: images of the product packaging for halogen headlights for automobiles with its product code and displaying the Mark;

Exhibit B: images of the product packaging for brake lamps for automobiles with its product code and displaying the Mark;

Exhibit C: images of the product packaging for lamps for directional signals for automobiles with its product code and displaying the Mark;

Exhibit D: images of the product packaging for room lights for automobiles with its product code and displaying the Mark;

Exhibit E: images of the product packaging for halogen headlights for motorcycles with its product code and displaying the Mark.

[16] Mr. Jim attests that the product images Exhibits A through E are representative examples of how the Mark was prominently displayed on the packaging of the Owner's lighting products during the Relevant Period in Canada.

[17] To support the allegation of sales of the Owner's lighting products in Canada to distributors, wholesalers and retailers in Canada during the Relevant Period, Mr. Jim attaches as Exhibit F to his affidavit, commercial invoices and corresponding packing lists within the Relevant Period detailing the sale of the Owner's lighting products to a customer in Canada. The product codes identified on the aforesaid documentation match the product codes mentioned in Mr. Jim's affidavit when describing the packaging Exhibits A to E, inclusive.

[18] Finally, Mr. Jim provides the total sales figures of the Owner's lighting products sold in Canada during the Relevant Period.

[19] Given the absence of written or verbal representations from the Requesting Party, and in view of the evidence described above, I am satisfied that the Owner has demonstrated use of the Mark in association with the Owner's lighting products.

#### DISPOSITION

[20] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following goods from the registration:

incandescent lamps; fluorescent lamps; discharge lamps; screw type fluorescent lamps; infrared lamps; decoration lamps; socket type fluorescent lamps

[21] The amended statement of goods will read as follows:

Halogen headlights for automobiles; brake lamps for automobiles; lamps for directional signals of automobiles; room lights for automobiles; halogen headlights for motorcycles.

The whole in compliance with the provisions of section 45 of the Act.

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Jean Carrière  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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No Hearing Held

**AGENTS OF RECORD**

Gowling WLG (Canada) LLP

For the Registered Owner

Hicks Intellectual Property Law

For the Requesting Party