



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 104

Date of Decision: 2023-06-19

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: FeraDyne Outdoors, LLC

Registered Owner: Bass Pro Intellectual Property, L.L.C.

Registration: TMA948,038 for AE Logo

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. TMA948,038 for the trademark AE Logo (the Mark), owned by Bass Pro Intellectual Property, L.L.C. (the Owner) and shown below:



[2] For the reasons that follow, I conclude that the registration ought to be amended to delete “arrow points” and “reel seats”.

THE PROCEEDING

[3] At the request of FeraDyne Outdoors, LLC (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on July 5, 2021.

[4] The notice required the Owner to show whether the Mark had 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 5, 2018, to July 5, 2021.

[5] The Mark is registered for use in association with “Bow fishing reels, archery bows, arrows, arrow points, bow fishing line, reel seats.”

[6] The relevant definition of use in the present case is set out in section 4 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.

[7] It is well accepted that 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)]. However, 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.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Marsha Green, Paralegal for the Intellectual Property department of Bass Pro L.L.C. (Bass Pro),

sworn on February 7, 2022. Only the Owner submitted written representations; both parties were represented at an oral hearing.

THE EVIDENCE

[9] Ms. Green states that Bass Pro and the Owner are both direct or indirect subsidiaries of Great Outdoors Group, LLC, and that the Owner has licensed to Bass Pro the right to use trademarks including the Mark. She states that pursuant to this licence, the Owner has always and continues to exercise control over the character and quality of the registered goods.

[10] As Exhibits B through E, Ms. Green attaches “an image showing how the Trademark is displayed on such good or an example of how the Trademark is used in association with such good on the www.basspro.com website as it is displayed to Canadian customers and via which it was purchased in the relevant period”. She correlates the images in Exhibits B, C, D, and E with the goods “bow fishing reels”, “archery bows”, “arrows, including arrow points”, and “bow fishing line”, respectively. She confirms that these images are reflective of how the Mark was used throughout the relevant period. She also includes a table showing sales figures in Canada during the relevant period for “bow fishing reels”, “archery bows”, “arrows, including arrow points”, and “bow fishing line” goods. While only one or two sales are detailed for each good, Ms. Green attests that “despite the relatively low dollar value”, the sales “were genuine commercial transactions in the ordinary course of trade to purchasers in Canada”.

REASONS FOR DECISION

Preliminary Issue: Hearsay

[11] The Requesting Party submits that Ms. Green’s evidence, especially her statements regarding the licence between Bass Pro and the Owner, are hearsay. In particular, the Requesting Party submits that by stating that “[the Owner] and Bass Pro are both direct or indirect subsidiaries of Great Outdoors Group, LLC”, Ms. Green is either unsure about the relationship between the Owner and Bass Pro, or is deliberately seeking to obscure the nature of their relationship, and that a negative inference must

be drawn about the reliability of her evidence. Given that Ms. Green does not state that she was personally responsible for controlling the character or quality of the registered goods used by Bass Pro, the Requesting Party submits that her statements ought to be considered hearsay.

[12] I find these submissions to be without merit. Ms. Green clearly states the following at paragraph 2 of her affidavit:

I am responsible for all matters relating to the intellectual property, including trademarks, of Bass Pro and related entities, including [the Owner], as well as the day-to-day use of those trademarks by these entities through my work with team members on legal issues related to proprietary product packaging and compliance. As a result, I have direct knowledge of the subject matter of this affidavit. As part of my normal responsibilities, I have access to business records of Bass Pro and [the Owner]. I make this affidavit on the basis of these business records, as well as my personal knowledge and other records which I have prepared and maintained in the course of performing my responsibilities. [emphasis added]

[13] Given that Ms. Green has clearly stated that she has direct knowledge of the subject material of the affidavit and access to the business records of both Bass Pro and the Owner, her evidence, including that relating to the terms of the licence between the two entities, is not hearsay.

Licensed use

[14] The Requesting Party submits that the Owner's evidence does not establish that use of the Mark by Bass Pro would enure to the Owner pursuant to section 50 of the Act. In this respect, it is well established that there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the licence agreement that provides for the requisite control [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84]. The Requesting Party submits that Ms. Green's sworn statement that the Owner exercises the requisite control is insufficient to demonstrate control because, as was the case in the Registrar's decision on appeal in the *Empresa Cubana* case, Ms. Green's statements regarding the licence between Bass Pro and the Owner are hearsay.

[15] However, I note that the evidence that was determined to be hearsay in the Registrar's *Empresa Cubana* decision came from an individual who was not affiliated with either the licensor or licensee, and who did not state the basis for his knowledge of the licencing agreement described in his affidavit. By contrast, Ms. Green is affiliated with both the Owner and Bass Pro and has clearly stated the basis for her knowledge of the facts set out in her affidavit. Given that her statements are not hearsay, as discussed above, I find that her clear sworn statement that the Owner exercises control over the character and quality of the goods sold by Bass Pro is sufficient to establish that such use enured to the Owner within the meaning of section 50 of the Act. In this respect, I do not consider it relevant that Ms. Green may not have personally exercised such control, as suggested by the Requesting Party.

Normal course of trade

[16] The Requesting Party submits that the Owner's evidence does not establish that the sales described in the Green affidavit were in the normal course of trade. In this respect, the Requesting Party notes that in *Quarry Corp v Bacardi & Co* (1999), 86 CPR (3d) 127 (FCA), the Federal Court of Appeal held that a single sale "divorced from all context" [para 2] is inadequate to show a transfer in the normal course of trade. In the Requesting Party's submission, Ms. Green merely states, but does not show, that the transfers were in the normal course of trade [citing *Wallace v Geoservices* (1988), 19 CPR (3d) 561 (TMOB), and *Sim & McBurney v Majdell Manufacturing Co* (1986), 11 CPR (3d) 306 (FCTD)].

[17] The *Geoservices* and *Majdell* cases cited by the Requesting Party hold that it is incumbent on an owner to set out sufficient facts to allow the Registrar to conclude that any evidenced sales were in the normal course of trade. In my view, the Green affidavit sets out sufficient facts to enable me to draw such a conclusion. I note that sworn statements of fact in an affidavit are not to be considered "bald allegations", as suggested by the Requesting Party, but are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25]. In this respect, Ms. Green has attested that Bass Pro's normal course of trade includes selling its goods in Canada

through its website, and that the Canadian transactions set out in her affidavit are sales through that website. As such, although the volume of sales is low, the sales are not “divorced from all context”. Given that Ms. Green clearly sets out the Owner’s licensee’s normal course of trade and attests that the listed sales were purchased through the *basspro.com* website and “were genuine commercial transactions in the ordinary course of trade to purchasers in Canada”, I accept that these transactions followed the pattern described by Ms. Green and were in the normal course of trade, and were purchases in Canada, within the meaning of sections 4(1) and 45 of the Act.

[18] Given that Exhibits B, C, and E show that the Mark was displayed directly on the goods “bow fishing reels”, “archery bows”, and “bow fishing line”, respectively, and given that Ms. Green has confirmed that the Mark was displayed in this manner throughout the relevant period, I am satisfied that the Owner has demonstrated use of the Mark in association with the goods “bow fishing reels”, “archery bows”, and “bow fishing line” within the meaning of sections 4(1) and 45 of the Act.

Arrows and arrow points

[19] Ms. Green lists two Canadian sales of “Arrows, including arrow points” in her affidavit and, as Exhibit D, attaches a screenshot from the *basspro.com* website showing what appears to be an arrow, with the Mark shown in the “product details” information section underneath. I concur with the Owner that the display of the Mark in this manner on the web page from which the goods are purchased would be sufficient to establish the necessary notice of association between the Mark and those goods [see *McMillan LLP v Neogen Corp*, 2013 TMOB 187 at para 14; *M Capewell & Associates Inc v Bollinger Industries, Inc*, 2022 TMOB 222 at para 22].

[20] The Owner submits that this evidence is sufficient to show use of the Mark in association with both “arrows” and “arrow points”. I concur with the Owner that nothing in the Act requires a trademark to be used in association with a “stand-alone” product; use within the meaning of the Act may be established where a Mark is used in association with a component of a complete product [see *Gowling, Strathy & Henderson*

v Tundra Knitwear Ltd (2001), 13 CPR (4th) 559 (TMOB) at para 7; *Gowling WLG (Canada) LLP v Pelican International Inc*, 2016 TMOB 144 at paras 16-18]

[21] However, to the extent that arrow points were sold during the relevant period, the Owner acknowledges it was only as components of the arrows depicted in evidence. Generally, use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration; having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [per *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA); for similar conclusions regarding components or ingredients, see *Ziaja Ltd v Jamieson Laboratories Ltd* (2005), 50 CPR (4th) 237 (TMOB) at para 10; *McMillan LLP v Orange Brand Services Ltd*, 2016 TMOB 111 at paras 72-73; *Fetherstonhaugh & Co v Les Montres Marciano Inc*, 2020 TMOB 70 at para 14]. For the Owner to maintain its registration for the goods “arrow points”, it had to show transfer and sales of such goods otherwise than as components of “arrows”.

[22] In view of the above, I am satisfied that the Owner has demonstrated use of the Mark in association with the goods “arrows” within the meaning of sections 4(1) and 45 of the Act. However, I am not satisfied that the Owner has demonstrated use of the Mark in association with the goods “arrow points” within the meaning of sections 4(1) and 45 of the Act. In the absence of special circumstances excusing such non-use, the registration will be amended accordingly.

Reel seats

[23] As noted by the Requesting Party, Ms. Green’s affidavit does not specifically refer to the goods “reel seats” other than in recitations of the registered goods at paragraph 9 of her affidavit and in a copy of the trademark registration attached as Exhibit A. While Ms. Green makes the general statement that Bass Pro has used the Mark in Canada in association with “the Goods”, there is no specific reference to “reel seats” in the table of Bass Pro’s Canadian sales during the relevant period or otherwise in the affidavit.

[24] The Owner refers to the Exhibit C screenshot from the *basspro.com* website showing a product identified by Ms. Green as an “archery bow”. As noted by the Owner, the picture appears to show the archery bow attached to a “bow fishing reel” product, similar to the one depicted in Exhibit B. Although the Exhibit C image is cut off and does not show how the reel is attached to the bow, the Owner asks me to infer that the reel is connected to the bow by a “reel seat” and that this product was sold during the relevant period as a component of the archery bow product. In this respect, I refer to my comments above regarding component goods; in any event, I am not prepared to infer, in the absence of any evidence regarding “reel seats” from the Owner, that a “reel seat” would be sold as part of this product.

[25] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with the goods “reel seats” within the meaning of sections 4(1) and 45 of the Act. In the absence of special circumstances excusing such non-use, the registration will be amended accordingly.

DISPOSITION

[26] In view of all of the foregoing, 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 “arrow points” and “reel seats”.

[27] The amended registration will be as follows:

Bow fishing reels, archery bows, arrows, bow fishing line

G.M. Melchin
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-05-31

APPEARANCES

For the Requesting Party: Scott MacKendrick

For the Registered Owner: John Cotter

AGENTS OF RECORD

For the Requesting Party: Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

For the Registered Owner: Osler, Hoskin & Harcourt LLP