



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 197

Date of Decision: 2023-11-28

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Tepee Sun LLC

Registered Owner: Lidl Stiftung & Co. KG

Registration: TMA935,717 for ULTIMATE SPEED (& Design)

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. TMA935,717 for the trademark ULTIMATE SPEED (& Design) (the Mark), reproduced below.



[2] The registration contains the following colour claim:

Colour claim: Colour is claimed as a feature of the trade-mark. The words 'ULTIMATE SPEED' are black with a white outline, the horizontal lines are red with a white outline, the background is red.

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

(1) Anticorrosive bands, namely duct tape. First aid boxes and bags (filled). Fuel cans of metal. Air and oil filters for engines; jacks; silencers for motors and engines; sparking plugs for internal combustion engines. Hammers, lifting jacks (hand-operated). Aerials for motor vehicles; tire pressure gauges; battery testers; battery preheaters; starter cables for motors and engines; internal and external thermometers (not for medical purposes), namely aquarium thermometers, domestic indoor and outdoor thermometers, pool thermometers, meat thermometers, automobile thermometers. Automobile lamps. Accessories and parts for cars, motorcycles, trikes and bicycles, namely windshield wipers, starters for motors and engines, motorcycle and bicycle helmets, motorcycle sidecars, bicycle bells, bicycle carriers, bicycle horns, bicycle locks, bicycle and motorvehicle [*sic*] mudguards, bicycle racks, bicycle stands; baskets for bicycles, bicycle pumps; brake pads, brake shoe sets, brake discs for vehicles; windshield wipers, vehicle seats; safety belts for vehicle seats; Child seats for vehicles; seat covers for vehicles; vehicle tires; snow chains; ski luggage racks; Roof racks; tricycles; vehicles covers (shaped). Insulating tape. Leatherware, namely motorcyclist protective clothing; trunks and travelling bags; umbrellas, sun umbrellas, parasols. Fuel cans of plastic. Tow ropes for automobiles; bands, not of metal, namely rubber bands, wrist bands, sweat bands. Gloves, namely bicycle gloves [*sic*], motorcycle gloves [*sic*], work gloves. Car mats, door mats, decorative mats, namely place mats, car mats.

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

PROCEEDING

[5] At the request of Tepee Sun LLC (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on January 10, 2022, to Lidl Stiftung & Co. KG. (the Owner), the registered owner of the Mark.

[6] 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 January 10, 2019 to January 10, 2022.

[7] The relevant definitions of “use” in the present case are 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.

4(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[8] Where the Owner does not show “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[9] In response to the Registrar’s notice, the Owner furnished the Affidavit of Camille Laliberté, sworn August 8, 2022.

[10] Only the Requesting Party submitted written representations and was represented at a hearing.

EVIDENCE AND ANALYSIS

[11] In her affidavit, Ms. Laliberté identifies herself as an articling student and gave 2000-630, René-Lévesque Boulevard Ouest, Montreal (Province of Quebec) H3B 1S6 as her address, which appears to be the address of the Owner’s trademark agents suggesting that she is employed at that firm. She asserts that she is “familiar with the general activities of [the Owner]”, a German hard-discount company that uses a minimalist concept to reduce costs and offer products at very low prices [para 1].

[12] Ms. Laliberté asserts that the Owner “offers for sale and sells goods such as those referred to in [the registration] under the [Mark]”. In support, she reproduces images that she describes as screen captures relating to the registered goods. The images show 11 products displaying the Mark on themselves along with their description. While the images appear to be taken from a website, Ms. Laliberté does not refer to any hypertext link and the domain address does not appear on the images themselves [paras 2 to 3].

[13] Lastly, Ms. Laliberté asserts that she has “no reason to believe” that the reproduced images are not illustrative of the way the Mark was associated with the registered goods during the relevant period [para 4].

Admissibility of the affidavit

[14] In its written representations, the Requesting Party submits that the Owner's evidence is inadmissible hearsay as Ms. Laliberté is merely an articling student of the Owner's agent. In this regard, it submits that the affiant does not have personal knowledge of the Owner's business, and therefore, of the facts stated in her affidavit. It also submits that the Owner has not established the necessity of submitting evidence by way of an affidavit of its agent's articling student.

[15] I agree that there is no indication in Ms. Laliberté's affidavit that she was at any time an employee of the Owner or that she was otherwise associated with it. There is also no indication that she was personally involved in the Owner's activities or had access to its business records. Therefore, I am unable to infer that Ms. Laliberté is knowledgeable of the Owner's activities and facts asserted in her affidavit. In this context, the evidence provided in her affidavit constitutes hearsay, which is *prima facie* inadmissible, unless it satisfies the criteria of necessity and reliability [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)].

[16] The Owner provided no reason as to why the evidence had to be introduced through an articling student, or why a person having direct knowledge of its activities and use of the Mark was unable to provide evidence. Consequently, the Owner has not established the necessity of submitting the affidavit of its agent's articling student. The Owner has also failed to provide the grounds for belief that the facts so stated are true. On this point, Ms. Laliberté simply states that she is *familiar* with the Owner's *general activities* [my emphasis]. I also note that she does not indicate where the reproduced images of products were taken. Without knowing the source of Ms. Laliberté's information, I cannot conclude that the evidence is reliable.

[17] All that being said, given the summary nature of section 45 proceedings, "concerns with respect to the hearsay nature of evidence can go to weight, rather than admissibility" [*Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18 at para 18]. Therefore, any concerns about the reliability of Ms. Laliberté's affidavit will be assessed in terms of weight rather than admissibility.

Use of the Mark in association with the registered goods

[18] The Requesting Party also makes alternative submissions with respect to the evidence. Noting that Ms. Laliberté makes no correlation between the registered goods and the 11 products shown in the images, it submits that the evidence fails to show the association between the Mark and each of the registered goods. The Requesting Party also submits that the evidence is silent as to any transfer of the goods in or from Canada. It further submits that the evidence is also silent as to any special circumstances excusing the non-use of the Mark in Canada during the relevant period.

[19] Although Ms. Laliberté states that the Owner sells goods such as those specified in the registration, she does not assert that the products shown in her affidavit were ever sold or otherwise transferred in or from Canada. More importantly, she neither provides invoices nor factual particulars from which such transfers might be inferred. In the absence of evidence of sales of the goods in Canada or exported from Canada, I do not need to consider the Requesting Party's submission related to the notice of association.

[20] Thus, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act. Further, the evidence is silent as to any reasons excusing the non-use of the Mark in Canada during the relevant period.

[21] Before closing, I will briefly address a submission added by the Requesting Party at the hearing regarding the Owner's behaviour.

[22] I note that a hearing was originally requested by both parties. The agent for the Owner indicated that representations would be made in French; the agent for the Requesting Party indicated that representations would be made in English and that simultaneous translation would be required. Initially scheduled on August 18, 2023, the hearing was postponed once on consent of the parties and set to November 15, 2023 at 10:00 a.m. with the presence of interpreters. On the morning of the hearing, the Owner sent an email to the hearing coordinator advising that it would not be attending. I further note that, at the hearing, the Requesting Party referred to two previous

section 45 proceedings in which the Owner also filed affidavits of articling students, and which led to the expungement of the registrations [*Barrette Legal Inc. v Lidl Stiftung & Co. KG*, 2022 TMOB 6; and *Vanguard IP LLP v Lidl Stiftung & Co. KG*, 2022 TMOB 189].

[23] The Requesting Party submits that the owner's behaviour with respect to the last minute cancellation of the hearing and the evidence itself was unacceptable and amounted to an abuse of process as the Requesting Party, the Trademarks Opposition Board, and the interpreters engaged unnecessary resources in this proceeding.

[24] However, the parameters of the present proceeding are narrow and a determination of whether the Owner's actions amount to an abuse of process is beyond the scope of section 45 proceedings [see *Essilor Group Canada Inc v Vermillion Networks Inc*, 2021 TMOB 184; and *Michelle Fleischhacker Room Service Interiors v Room Service Interiors Ltd.*, 2022 TMOB 74]. The sole issue to be determined in a section 45 proceeding is whether a trademark has been used within the meaning of the Act; as such, allegations that a party's actions may be abusive or vexatious are irrelevant [*Consorzio del Prosciutto di Parma v Maple Leaf Foods Inc*, 2010 TMOB 52 at para 20].

DISPOSITION

[25] In view of all the above, 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.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-11-15

APPEARANCES

For the Requesting Party: Steven Andrews

For the Registered Owner: No one appearing

AGENTS OF RECORD

For the Requesting Party: Andrews Robichaud

For the Registered Owner: ROBIC