



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 216

**Date of Decision:** 2023-12-14

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

**Requesting Party:** MLT Aikins LLP

**Registered Owner:** Colt CZ Group SE

**Registration:** TMA842,696 for the trademark CZ SCORPION

### **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. TMA842,696 for the trademark CZ SCORPION (the Mark) owned by Colt CZ Group SE (the Owner).

[2] For the reasons that follow, the registration is maintained in part.

### **THE PROCEEDING**

[3] At the request of MLT Aikins LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner pursuant to section 45 of the Act on June 10, 2022.

[4] The notice required the Owner to show whether the Mark had been used 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 use since that date. In this case, the three-year period for showing use is June 10, 2019, to June 10, 2022 (the Relevant Period). In the absence of use, the registration is liable to be expunged, unless the non-use is attributable to special circumstances.

[5] The Mark is registered for use in association with the following goods (the Goods):

- (1) Hand firearms; components and spare parts for these firearms; accessories, namely cleaning implements for firearms, cleaning brushes for firearms, cleaning and preservation oil for firearms, hearing protectors, cleaning sets for firearms; transport cases for firearms, magazines, grips, dummy rounds of plastic, straps, sights, lasers, lamps, sniper scopes, optics, service instructions, all for use with firearms.
- (2) Hand firearms; accessories, namely magazines, straps, service instructions, all for use with firearms.

[6] The relevant definition of use is set out in section 4(1) of the Act:

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] 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. It is not necessary for the evidence filed in a section 45 proceeding to be perfect. Rather the Owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. The burden of proof is light. While bare assertions of use will not suffice, all that is required is for evidence to supply facts from which a conclusion of use of the trademark in association with each of the goods may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184; *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA) (*Plough*)]. Additionally, evidence must be considered as

a whole, and it is therefore not appropriate to focus on individual pieces of evidence in isolation [*Kvas Miller Everitt v Compute (Bridgend) Ltd* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[8] I note the Owner changed its name from Česká zbrojovka a.s effective September 1, 2022.

[9] In response to the Registrar's notice, the Owner submitted the affidavit of Mr. Jarmila Válková, who states he is an industrial legal protection specialist.

[10] Both parties submitted written representations and the Owner alone was represented at a hearing.

### **SUMMARY OF EVIDENCE**

[11] Relevant elements of Mr. Jarmila Válková's evidence include:

- a statement that the Mark has been used in Canada in association with hand firearms, namely submachine guns and components and spare parts for firearms since at least as early as January 2013, including after June 10, 2019 [para 5]
- a statement that the Owner affixes the Mark on Goods, as well as on packaging for the Goods [para 6]
- photographs of submachine guns, and their packaging, showing the Mark [Exhibit A]
- a statement that the Owner sells the Goods bearing the Mark to North Sylva Company, its exclusive Canadian distributor [para 7]
- a statement that Canadian sales of Goods bearing the Mark, from June 19, 2019, to April 13, 2020, amounted to approximately \$172,000 US [para 8]
- two invoices, with associated packing lists, dated August 23, 2019, and January 24, 2020, involving sales to North Sylva Company, with those invoices showing line items described as "CZ SCORPION EVO3 S1 CARBINE" [Exhibit B]

- two additional invoices which do not have accompanying packing lists, one dated February 25, 2020, to North Sylva Company and another dated June 26, 2020, to Wolverine Supplies, with line items for the “CZ SCORPION Evo3 S1” which is a smaller gun than the carbine models, and a “trigger mechanism for CZ Scorpion EVO3” [Exhibit B]
- information that “CZ SCORPION EVO3 S1 CARBINE” references on the invoices correlate to hand firearms, namely submachine guns [para 9 and Exhibit B] and that one of the invoices is for a CZ SCORPION trigger mechanism [para 9]
- dates that Goods were “invoiced and shipped to Canada” and line numbers associated with Goods bearing the Mark [para 9]
- promotional leaflets and catalogues showing the Mark applied to submachine guns and providing information about those guns [Exhibit C]

## **ANALYSIS AND REASONS FOR DECISION**

### ***Preliminary Matter - Are Submachine Guns a Type of Hand Firearms?***

[12] At paragraphs 13 and following, the Requesting Party argues a submachine gun is not a hand firearm because it is fired from the shoulder or hip. In support, it relies on a *Merriam-Webster Online Dictionary* entry that defines a submachine gun as “a portable automatic firearm that uses pistol-type ammunition and is fired from the shoulder or hip.” In addition, the Requesting Party submits:

The registration covers *hand firearms*. A firearm is defined in the on-line Merriam-Webster Dictionary as “a *firearm (such as a revolver or pistol) designed to be held and fired with one hand*”. <https://www.merriam-webster.com/dictionary/handgun> As stated above, the Affiant refers to *submachine guns* which are fired from the shoulder or hip, and not with a sole hand as noted in the dictionary definition of a hand firearm. The submachine guns are a different category of guns not included in the narrower description listed in the Registered Goods as hand firearms.

[13] It is settled law that a requesting party in a section 45 proceeding cannot file evidence [*Meredith & Finlayson v Canada (Registrar of Trade-Marks)* (1991), 40 CPR (3d) 409 (FCA)]. As such, I am not bound to consider the specific definitions provided by the Requesting Party in its written representations. Nonetheless, I am permitted to take

judicial notice of dictionary definitions [see *Aladdin Industries, Inc. v Canadian Thermos Products Ltd* (1969), 57 CPR 230 (Ex Ct), aff'd (1974), 6 CPR (2d) 1 (SCC); *Tradall SA v Devil's Martini Inc* 2011 TMOB 65, 92 CPR (4th) 408]. I believe an understanding of the meaning of the terms "submachine gun" and "firearm" is helpful to the determination of whether a submachine gun may be considered a hand firearm.

[14] I have checked the on-line *Merriam Webster Dictionary* and confirm that the definition provided by the Requesting Party was accurately conveyed. I have sought verification and better understanding of the suggested meaning by referencing the *Canadian Oxford Dictionary* (2 ed) and note "submachine gun" is defined as "a hand-held lightweight automatic or semi-automatic weapon designed to shoot small-calibre ammunition." Similar references to the guns being handheld, or lightweight and portable enough to be carried easily appear in other dictionary definitions provided by the Owner in its written representations [Owner's written representations, para 28]. In light of the common theme that these guns are hand-held and small, portable and lightweight I am able to conclude that the submachine guns are generally considered to be hand-held. I am not persuaded that merely because a gun may possibly be shot from the shoulder or hip it is not a hand-held gun.

[15] I have also considered the definition of "firearm" using the online *Merriam-Webster Dictionary* and find that the meaning differs from what was set out by the Requesting Party at paragraph 14 of its written representations. This dictionary defines firearm as "a weapon from which a shot is discharged by gunpowder- usually used of small arms" and not as "a firearm (such as a revolver or pistol) designed to be held and fired with one hand" as claimed by the Requesting Party. I note that the *Canadian Oxford Dictionary* (2 ed) defines firearm as "a portable gun of any sort, e.g., a pistol, rifle, etc." The meaning of "firearm" therefore appears to encompass any small portable gun.

[16] As argued by the Owner, both in its written representations and at the hearing, the promotional materials involving its submachine guns, and in particular the non-carbine model, identify that the guns can be shot "free hand" or from the shoulder. The

materials also reference a “pistol grip” and “gripping comfort” [Válková affidavit, Exhibit C].

[17] I need not be astutely meticulous when contemplating the language of a statement of goods [*Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17]. As the Owner argues at paragraph 25 of its written representations, a registration containing general wording will be maintained if the owner shows use of its trademark in association with goods falling within a general statement [*Graduate Management Admissions Council v Attachmate Corp*, 2015 TMOB 224 at para 17, citing *Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102]. I therefore agree with the Owner that its submachine guns fall within the scope of the more general statement “hand firearms”. If I am incorrect and not all of the Owner’s submachine guns constitute hand firearms, then I agree with the position taken by the Owner during the hearing that at least the smaller, lighter model meets the definition of hand firearm.

#### Prima Facie Case of Use

[18] At paragraph 10 of its written representations the Requesting Party is critical of Mr. Válková’s statements that the Mark has been used in Canada “in association with hand firearms, and components and spare parts for the firearms since at least as early as 2010”. The Requesting Party argues that “the statement falls well outside the Relevant Period” and is without evidentiary value. It argues that the evidence must show use through supporting exhibits, relying on *Plough*. I agree that mere assertions of use are not sufficient and to this end I have considered the statements of Mr. Válková in conjunction with the documentary evidence. As for the argument that the statement falls outside the Relevant Period, I consider this to be an unnecessarily narrow interpretation of Mr. Válková’s words. I presume he merely intended to convey that the Owner’s Goods have been sold in Canada for several years. As such, I do not agree that this portion of the evidence should be inadmissible or assigned low probative value. I will consider his statement, in conjunction with the other evidence, to determine whether the Owner has established a *prima facie* case of use, within the meaning of section 4 of the Act, during the Relevant Period.

### Use of the Mark in Association with Hand Firearms

[19] The Requesting Party argues at paragraph 25 of its written representations that considering the Válková affidavit and Exhibits as a whole, the Owner has not shown use of the Mark in association with the Goods during the Relevant Period. The Owner, at paragraphs 20 to 24 of its written representations argues to the contrary. The Owner notes that the Mark appears on the guns and their packaging [Válková affidavit, paras 6 and 7 and Exhibits A and C]. It points to several sales of its hand firearms in 2019 and 2020, evidenced through invoices and shipments within that timeframe [Owner's written representations para 24]. I agree that the invoices show a number of sales of CZ SCORPION submachine guns to the Owner's Canadian distributor and to Wolverine Supplies, during the Relevant Period and that those guns along with their packaging show the Mark.

### *Stocks, Magazines and Trigger Mechanisms*

[20] The Owner submits that the evidence also shows use of the Mark in association with components and spare parts comprising stocks, magazines and a trigger mechanism. It points to the appearance of these Goods on invoices [Owner's written representations para 31]. The Owner submits, and I agree that stocks, magazines and trigger mechanisms "components and spare parts for these firearms."

[21] I accept that sales of stocks, magazines and trigger mechanisms could support a claim to use in association with "components and spare parts for these firearms". I also agree there appear to have been sales of such products in Canada during the Relevant Period as evidenced by the line items on invoices. However, there is no evidence that the Mark appeared on these Goods or associated packaging or that the Mark was otherwise associated with the Goods at the time they were transferred to purchasers. In respect of the invoices, while stocks, magazines and trigger mechanisms appear as line items and are associated with the Mark, there is nothing in evidence that allows me to presume or infer that those invoices accompanied the Goods at the time they were transferred to purchasers. As such, I cannot conclude that the appearance of the Mark on invoices provides the requisite notice of association between the Mark and these Goods at the time of transfer [*Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8

CPR (4th) 471 (FCTD) para 18]. I would likely have concluded otherwise had Mr. Válková stated that the invoices showing the Mark accompanied the Goods, or if packing lists showed the Mark in association with stocks, magazines and trigger mechanisms.

[22] Display of a trademark on catalogues, and such, may be considered use for the purposes of section 4(1) of the Act when the evidence also shows that the trademark was brought to the attention of the consumer at the time the goods are transferred [see *Timothy's Coffee of the World Inc v Starbucks Corp* (1997), 79 CPR (3d) 147 (TMOB)]. However, the promotional leaflets and catalogs do not show the Mark in conjunction with stocks, magazines or trigger mechanisms *per se*. Even if they had, there is no indication the promotional leaflets and catalogs were associated with the Goods at the time those Goods were transferred. I am therefore not satisfied that the Owner has shown use of the Mark, within the meaning of sections 4(1) and 45 of the Act, in association with the registered Goods “Components and spare parts for these firearms” and “accessories namely magazines”. As there is no evidence of special circumstances excusing non-use, the registration will be amended accordingly.

*Accessories, Namely Cleaning Implements for Firearms*

[23] The Owner argues at paragraph 35 and following, that the promotional leaflets indicate that “the package” provided to customers along with the guns, includes a “cleaning kit” [Válková affidavit, Exhibit C]. It submits that since cleaning kits were sold during the Relevant Period, use of the Mark in association with “accessories, namely cleaning implements for firearms” has been shown.

[24] I note that none of the depictions of the Goods in evidence show what might be considered cleaning devices or materials. Even if I were to accept, based on a reference to cleaning kits in the Owner’s leaflets, that when its submachine guns were sold in Canada, “the Package” included a cleaning kit, there is nothing in evidence to allow me to conclude that at the time of transfer to purchasers there was notice of association between the cleaning kits and the Mark. Furthermore, I note that the packaging for the submachine guns does not indicate the presence of a cleaning kit. I



am therefore unable to conclude that there was use of the Mark in association with accessories, namely cleaning implements for firearms, cleaning brushes for firearms and cleaning and preservation oil for firearms.

### ***Remaining Goods***

[25] As there is no evidence or associated arguments relating to the remaining Goods and because there is no evidence of special circumstances that might excuse non-use for the Goods not sold during the Relevant Period, the registration will be amended to cover only hand firearms.

### **DISPOSITION**

[26] 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 as shown in strikeout below:

- (3) ~~Hand firearms; components and spare parts for these firearms; accessories, namely cleaning implements for firearms, cleaning brushes for firearms, cleaning and preservation oil for firearms, hearing protectors, cleaning sets for firearms; transport cases for firearms, magazines, grips, dummy rounds of plastic, straps, sights, lasers, lamps, sniper scopes, optics, service instructions, all for use with firearms.~~
- (4) ~~Hand firearms; accessories, namely magazines, straps, service instructions, all for use with firearms.~~

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Coleen Morrison  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



# Appearances and Agents of Record

**HEARING DATE:** 2023-09-18

## **APPEARANCES**

**For the Requesting Party:** No one appearing

**For the Registered Owner:** Scott MacKendrick

## **AGENTS OF RECORD**

**For the Requesting Party:** MLT Aikins LLP

**For the Registered Owner:** Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L.