



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 124

Date of Decision: 2025-06-10

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Meyers Research, LLC

Registered Owner: PAGANI S.P.A.

Registration: TMA1,010,122 for ZONDA 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. TMA1,010,122 for the trademark ZONDA DESIGN (the Mark), shown below:

[2] The proceeding is restricted to the goods specified in the registration as: "electronic book readers", "electronic agendas", "books", "greeting cards", "drawing pads", "envelopes", "calendars", "paper boxes", "writing paper", "paper folders", "postcards", "hanging file folders", "paper stationery", "writing stationery", "books", "document covers", "paper sheets

for note taking”, “newspapers”, “writing slates”, “booklets”, “announcement cards”, “drawing books”, “address books”, “notebooks”, “diaries”, “loose-leaf binders”, “drawing paper”, “magazines”, “drawing boards”, “clip boards”, “pads [stationery], namely calendar pads, notepads, memo pads, writing pads”, “tablemats of paper”, “periodicals” (the Goods).

[3] For the reasons that follow, I conclude that the registration should be amended to delete all of the Goods at issue.

THE PROCEEDING

[4] At the request of Meyers Research, LLC (the Requesting Party), the Registrar of Trademarks issued a restricted notice under section 45 of the Act on June 25, 2024, to the registered owner of the Mark, PAGANI S.P.A. (the Owner).

[5] The restricted notice required the Owner to show whether the Mark was used in Canada in association with each of the Goods at any time within the three-year period immediately preceding the date of the notice. If the Mark was not so used, the Owner was required to provide the date when the Mark was last in use and the reason for the absence of use since that date. In this case, the relevant period for showing use is June 25, 2021 to June 25, 2024.

[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 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 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. Although the threshold for establishing “use” in section 45 proceedings is quite 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 Canada (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)]. Bare 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)].

[8] Where an owner has not shown “use”, a 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 Mr. Hannes Zanon, sworn on November 24, 2024, together with Exhibits A to C.

[10] Only the Requesting Party filed written representations. Additionally, the Requesting Party requested an oral hearing in the matter, conditional on the other party requesting a hearing; however, as the Owner did not make such a request, a hearing was not held.

THE EVIDENCE

[11] Mr. Zanon is the Special Prosecutor of the Owner, and has personal knowledge of the matters he attests to or has obtained such knowledge from

relevant documents maintained by the Owner in the normal course of business, to which he has access [para 1].

[12] Mr. Zanon describes the Owner as an Italian luxury car manufacturer, founded in 1992. He further provides that one of the Owner's most famous models is Zonda, which was the Owner's first model, introduced in 1999 [paras 2-4].

[13] Mr. Zanon states that the Mark has been used in Canada during the relevant period in association with the sale and advertisement of all of the registered goods, including the Goods at issue in this proceeding [para 9].

[14] With regard to such use, Mr. Zanon explains that the Mark appears in a variety of different ways in association with the Goods – either on the Goods themselves, their packaging, labels affixed to the Goods or by various other means such that notice of association between the Mark and the Goods is given to the consumer at the time the Goods are transferred to their possession [para 10]. In support, he attaches as Exhibits B and C, what he describes are a sampling of photographs and images of the Goods bearing the Mark and ZONDA cars as sold in Canada during the relevant period.

[15] The following Goods are enumerated in text at the top of the first page of the Exhibit B: Writing paper; paper stationery; writing stationery; paper sheets for note taking; notebooks; diaries; pads [stationery], namely calendar pads notepads memo pads, writing pads; books. The exhibit then includes the following two images:



[16] Exhibit C includes what appears to be images of pages from a book about the Owner's cars. The Mark appears near the right tail light of a car depicted on one of the book's pages.

[17] Mr. Zanon states that the images in Exhibits B and C are representative of how the Mark has appeared on the Goods during the relevant period. Lastly, he states that the Goods bearing the Mark are offered for sale and sold by the Owner's sales representatives in Canada and through the Owner's website.

ANALYSIS AND REASONS FOR DECISION

[18] The main submissions of the Requesting Party are as follows:

- "use" of the Mark has not been shown:
 - in the normal course of trade,
 - nor in association with each of the Goods.
- No special circumstances have been brought forth to excuse non-use of the Mark in association with the Goods in Canada during the relevant period.

[19] To begin with, the Requesting Party submits that as per section 4(1) of the Act, for there to be “use” of a trademark in association with goods, there must be a transfer of property or possession of the goods in the normal course of trade. However, in the present case, the Requesting Party submits that while Mr. Zanon states that the Mark has been used in Canada, he provides no supportive factual particulars such as invoices, sales reports or any other type of evidence showing that transfers of the Goods has occurred in the normal course of trade in Canada during the relevant period [see *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79 re: evidence of transfers].

[20] I agree. Aside from Mr. Zanon’s statements regarding sales and advertising of the Goods and that the Goods bearing the Mark are offered for sale and sold by the Owner’s sales representatives and through its website, there is no evidence of transfers in the normal course of trade of any of the Goods in Canada. Absent further evidence, such statements amount to bare assertions [*Plough, supra*].

[21] In any event and in addition, the Requesting Party submits that a review of the images in Exhibit B and C only permit the identification of two goods: a) a Booklet, and b) a Book. The Requesting Party submits that it appears that the Owner is claiming that the picture of the booklet depicted in Exhibit B amounts to use for all the Goods per the enumerated list of Goods on the first page of the exhibit. However, the Requesting Party submits, generally, evidence of use with respect to one specific good cannot serve to maintain multiple goods in a registration, and having chosen to specifically identify each of the Goods, the Owner was obligated to furnish evidence of use with respect to each good [*John Labatt, supra*; *A-COLD-WALL* v Les Placements Arden Inc/Arden Holdings Inc*, 2024 TMOB 82].

[22] Once again, I agree. To begin with, the Mark does not appear to be associated with any of the Goods at issue in the images in Exhibit C. Further, the items appearing in the images in Exhibit B have not been correlated with any specific Goods and it is unclear/ambiguous, absent further evidence, to which Good(s), if any, these images represent.

[23] Lastly, as the Requesting Party submits, the Owner's evidence does not establish any special circumstances excusing the absence of use of the Mark in connection with the Goods in Canada during the relevant period. Consequently, I agree with the Requesting Party that the registration should be amended accordingly to remove all of the Goods specified in the notice.

DISPOSITION

[24] Having regard to the aforementioned, 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 all of the Goods specified in the notice. That is, the registration will be amended to delete the following:

"electronic book readers", "electronic agendas", "books", "greeting cards", "drawing pads", "envelopes", "calendars", "paper boxes", "writing paper", "paper folders", "postcards", "hanging file folders", "paper stationery", "writing stationery", "document covers", "paper sheets for note taking", "newspapers", "writing slates", "booklets", "announcement cards", "drawing books", "address books", "notebooks", "diaries", "loose-leaf binders", "drawing paper", "magazines", "drawing boards", "clip boards", "pads [stationery], namely calendar pads, notepads, memo pads, writing pads", "tablemats of paper", "periodicals"

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

APPEARANCES AND AGENTS OF RECORD

HEARING DATE: No hearing held.

AGENTS OF RECORD

For the Requesting Party: Borden Ladner Gervais LLP

For the Registered Owner: MBM INTELLECTUAL PROPERTY AGENCY