



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2025 TMOB 122

**Date of Decision:** 2025-06-10

## IN THE MATTER OF A SECTION 45 PROCEEDING

**Requesting Party:** Wheel Pros, LLC

**Registered Owner:** KTM Components GmbH

**Registration:** TMA985,122 for WP 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. TMA985,122 for the trademark WP DESIGN (the Mark), owned by KTM Components GmbH (the Owner) and shown below:



[2] For the reasons that follow, I conclude that the registration ought to be maintained.

## **THE RECORD**

[3] At the request of Wheel Pros, LLC (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on May 30, 2024. The notice required the Owner to show whether the Mark had been used in Canada in association with 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 relevant period for showing use is May 30, 2021, to May 30, 2024.

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

(1) Shock absorbers for motor vehicles, namely motorised dual-axle or multi-axle vehicles; motorcycles accessories, namely springs, shock absorbers, suspension forks, chassis components, steering dampers, suspension struts for motorcycles, telescopic forks for motorcycles

[5] The relevant definition of “use” in the present case 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.

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Pirimeyer Christian and Steinbacher Fabian, the authorized officer and director, respectively, of the Owner, sworn on October 22, 2024. Both parties filed written representations; no hearing was held.

## **EVIDENCE**

[7] The affiants state that during the relevant period, the registered goods were imported to Canada and sold to distributors and sellers by the Owner’s licensed subsidiary, WP Suspension North America (WP Suspension), and that any use of the Mark by WP Suspension was pursuant to a licence by which the Owner controlled the

character and quality of goods sold in association with the Mark, such that the design of the registered goods as well as the use of the Mark were at the sole discretion of the Owner [paras 10-11]. The affiants explain that WP Suspension's normal course of trade in Canada during the relevant period involved direct sales to Canadian retailers who then sell such goods directly to Canadians. Exhibit B is a list of Canadian retailers who purchased and sold such goods during the relevant period.

[8] As Exhibit C, the affiants attach a set of invoices dated during the relevant period and showing sales to Canadian retailers; they also provide a chart identifying items listed on the invoices corresponding to the following: "shock absorbers for motor vehicles, namely, motorized dual-axle or multi-axle vehicles", and the seven listed types of "motorcycles accessories", including springs, shock absorbers, suspension forks, chassis components, steering dampers, suspension struts for motorcycles, and telescopic forks for motorcycles. As Exhibits D through K, the affiants attach photographs of each such product. In each case, the Mark appears directly on the product; the affiants confirm that these photographs are representative of how the Mark was associated with those products during the relevant period. Promotional materials and screenshots from the Owner's website are attached as Exhibits L through N.

## **ANALYSIS**

[9] The Requesting Party makes two submissions with respect to the Owner's evidence: first, that the Owner's evidence does not show that any use by WP Suspension would enure to the Owner, and second, that the Owner has not shown use in association with the goods "shock absorbers for... multi-axle vehicles". The Owner's written representations merely restate the facts set out in the affidavit and basic legal principles in section 45 proceedings, including the light burden, and do not specifically respond to any of the Requesting Party's submissions.

[10] With respect to the first issue, the Requesting Party submits that the Owner's evidence is insufficient to establish that the Owner exercised control over the character and quality of the registered goods such that use of the Mark by WP Suspension would enure to the Owner. In this respect, the Requesting Party submits that the jurisprudence

indicates that “[e]xamples of the manner by which the registered owner exercise its control over the character or quality of the goods or services should also be provided” [citing *Sara Lee Corp v Intellectual Property Holding Co* (1997), 76 CPR (3d) 71 (TMOB)], and that “merely stating that the owner had control is typically insufficient and there must be evidence of control” [citing *Gowling, Strathy & Henderson v Foodmaker Inc* (1996), 69 CPR (3d) 243 (TMOB)]. As the Owner has not indicated that WP Suspension is a mere distributor of the registered goods, the Requesting Party submits that the Owner’s evidence is insufficient to establish the requisite control as set out in section 50 of the Act.

[11] However, neither of the Trademarks Opposition Board cases cited by the Requesting Party stands for the propositions it puts forward. Specifically, the *Sara Lee Corp* case does not refer to examples of the manner by which the owner in that case exercised control over the character and quality of its goods; instead, the Registrar inferred from the existence of a licence providing that the owner was *entitled* to exercise such control that the owner actually did exercise such control [*Sara Lee Corp*, para 18]. Similarly, in the *Foodmaker* case, while the Registrar was satisfied, based on a licence agreement entered into evidence, that the owner had demonstrated control pursuant to section 50, the Registrar made no finding that a mere statement would be insufficient.

[12] In any event, both of these Trademark Opposition Board cases predate the guidance provided by the Federal Court in *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102, aff’d 2011 FCA 340, which provides that owners “can clearly swear to the fact that they exert the requisite control” to benefit from the deeming provision in section 50 [*Empresa Cubana*, para 84]. As the affiants in this proceeding have done just that, I am satisfied that any use of the Mark by WP Suspension would enure to the Owner for the purposes of section 50.

[13] As for the whether the Owner has shown use of the Mark in association with the goods “shock absorbers for... multi-axle vehicles”, I note that the Requesting Party’s submissions on this point refer to facts not in evidence concerning the functionality of the “XACT PRO 8950 SHOCK” product (cited by the Owner as an example of the

registered goods “Shock absorbers for motor vehicles, namely motorised dual-axle or multi-axle vehicles”), the channels of trade for two-wheeled and four-wheeled vehicles, and portions of the Owner’s website that were not included in its affidavit. However, section 45(2) of the Act is clear that the Registrar shall not receive any evidence other than the affidavit or statutory declaration prescribed by section 45(1). Accordingly, I cannot consider these facts.

[14] Nevertheless, I understand the Requesting Party’s position that the “XACT PRO 8950 SHOCK” product is intended for motorcycles (as shown in the Exhibit M promotional materials), its position that a “dual-axle vehicle” ought to be interpreted as referring to a four-wheeled vehicle, rather than a motorcycle, and its position that a “multi-axle vehicle” ought to be interpreted as referring to a larger vehicle than a motorcycle. Accordingly, the Requesting Party submits that the “XACT PRO 8950 SHOCK” product is a shock absorber for motorcycles, and not for “dual-axle or multi-axle vehicles”.

[15] However, it is well established that a statement of goods should be granted a generous interpretation as opposed to a restrictive one in a section 45 proceeding [see *ConAgra Foods, Inc v Fetherstonhaugh & Co* (2002), 23 CPR (4th) 49 (FCTD); and *Molson Canada v Kaiserdom-Privatbrauerei Bamberg Wörner KG* (2005), 43 CPR (4th) 313 (TMOB)], and one is not to be “astutely meticulous when dealing with [the] language used” [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17]. Moreover, section 45 proceedings are not intended to try contested issues of fact or to provide an alternative to the usual *inter partes* attack on a trade-mark envisaged by section 57 of the Act [*Meredith & Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)].

[16] In view of the above, the Owner’s evidence indicates that the “XACT PRO 8950 SHOCK” product is a shock absorber for motorized dual-axle or multi-axle vehicles, and shows it being used as a shock absorber for a motorcycle. There is nothing in evidence to suggest that a motorcycle could not be considered a dual-axle or multi-axle vehicle, and even if they are generally not considered as such, I am not satisfied that this is a

notorious or generally accepted fact, or one capable of immediate and accurate demonstration by resort to readily accessible sources of indisputable accuracy, such that I could take notice of it [see *Essilor International (cie générale d'optique) v Rampage Clothing Co* (2004), 36 CPR (4th) 371 at para 26]. Accordingly, this proceeding is not the forum to resolve the “debate” referenced in the Requesting Party’s written representations “as to whether a motorcycle can be described as having an axle similar to that of a four-wheel vehicle” [Requesting Party’s written representations, page 4], even if there were evidence before me that such a debate existed.

[17] Accordingly, I accept that the “XACT PRO 8950 SHOCK” product would amount to the registered goods “Shock absorbers for motor vehicles, namely motorised dual-axle or multi-axle vehicles”.

[18] As the Owner has shown transfers in the normal course of trade in Canada during the relevant period of each of the registered goods by its licensee, has shown how the Mark was associated with each such good during the relevant period, and has established that any use of the Mark by its licensee would enure to it pursuant to section 50 of the Act, I am satisfied that the Owner has shown use of the Mark in association with each of the registered goods within the meaning of sections 4 and 45 of the Act.

### **DISPOSITION**

[19] 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 maintained.

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G.M. Melchin  
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:** Paul D. Jones (Jones & Co.)

**For the Registered Owner:** Riches, McKenzie & Herbert LLP