

SUMMARY CANCELLATION PROCEEDINGS: INTENTION TO RESUME USE OF TRADE-MARK MUST BE PRESENT DURING THE RELEVANT PERIOD

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Trade-marks Senior Hearing Officer, D. Savard, rendered a decision addressing issues of establishing both use and justifying non-use within the relevant time frame in a summary cancellation proceeding taken under Section 45 of the *Trade-marks Act*. It was held that a trade-mark owner's intention to resume use must exist during the relevant period (*Manufacturier de Bas de Nylon Doris Ltée vs. Canadian Sportfishing Productions*, (2002) 16 C.P.R. (4th) 410).

The Facts

At the request of Manufacturier de Bas de Nylon Doris Ltée, the Registrar of Trade-marks issued a notice under Section 45 of the *Trade-marks Act* on July 7th, 1999, to Canadian Sportfishing Productions (hereinafter "Owner"), the registered owner of the trade-mark SECRET STRATEGIES.

The mark SECRET STRATEGIES was registered in association with "hats and t-shirts, sew-on patches, decals, videos and educational services, namely the promotion and staging of live demonstrational shows and seminars relating to angling".

The Owner was the assignee of the trade-mark SECRET STRATEGIES by way of a confirmatory assignment effective November 30th, 1993. This assignment was officially recorded on the trade-mark register on February 2nd, 2000.

The Owner filed affidavit evidence with supporting exhibits, both parties filed written arguments but no oral hearing was conducted.

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The Registrar's Decision

(i) Use in association with videos

In the case at bar, the relevant period of use was between July 7th, 1994 and July 7th, 1999. Senior Hearing Officer D. Savard held that the Owner established, in its affidavit evidence that use, in Canada, of the trade-mark SECRET STRATEGIES, in association with videos, occurred in May 1999 when 3360 fishing advice and instructions video cassettes bearing the trade-mark SECRET STRATEGIES were placed on the shelves of 70 WAL-MART stores across Canada.

The Owner also indicated that another supply of video cassettes bearing the trade-mark SECRET STRATEGIES was delivered to WAL-MART stores in mid-December 1999 and that it had received another order from WAL-MART for delivery in May 2000. In support of these factual allegations, no invoices were provided, but the Owner submitted part of the series of the video cassettes bearing the trade-mark SECRET STRATEGIES as an exhibit.

It is worth noting that the Senior Hearing Officer decided that since no particular kind of evidence is required, the lack of invoices was not presumptive where clear statements of facts showing use are provided. These wares were therefore maintained on the register.

It was also held that while evidence outside the relevant period is not required, transactions after the notice date are admissible in so far as they prove continuity of use and serve to rebut any allegations of recent fabrication or token use.

(ii) use in association with the remaining wares

The Owner clearly stated that it did not sell or distribute hats, t-shirts, sew-on patches and decals during the relevant period. The Senior Hearing Officer therefore held that these wares were to be deleted from the register since no special circumstances excusing non-use were shown.

(iii) use in association with seminars

The Owner alleged in its affidavit that throughout the relevant period, he continued to hold seminars relating to angling, in association with the trade-

mark SECRET STRATEGIES three to four times a year during spring and summer at most of its corporate fishing trips it conducted for its corporate clients.

By taking into account the Owner's evidence as a whole, Senior Hearing Officer D. Savard inferred that the trade-mark was probably used or displayed in the advertisement or performance of these seminars. These services were therefore maintained on the register.

(iii) use in association with the promotion and staging of live demonstrational shows

The Owner clearly stated in its affidavit that the last event was staged on March 28th, 1996, shortly prior to the relevant period. The Senior Hearing Officer was therefore faced with the issue of whether there were special circumstances that may have excused the absence of use of the trade-mark SECRET STRATEGIES since that date.

Special circumstances justifying non-use

Based on the evidence before the Senior Hearing Officer, it was decided that the live shows were temporarily shelved until their format was revamped, until a more effective advertising campaign was developed and until a suitable sponsor was recruited since the main sponsor of the event abruptly ended with the last show in March 1996.

However, the Owner indicated that it had plans to continue with the live shows in the year 2000, that efforts to revamp the format of the show, develop an advertising campaign and recruit a suitable sponsor were underway. The Owner also stated that in the year 2000, it would be coming out with a book of fishing advice and instructions in association with the trade-mark SECRET STRATEGIES as well sell more video cassettes. Finally, with all these activities, the Owner stated that it planned to reintroduce a new supply of merchandise.

In considering this evidence of the Owner's intentions, the Senior Hearing Officer held that mere allegations as to its intentions to resume use of its trade-mark were insufficient. It was decided that no inferences could be drawn from these allegations when it was not established, by documentary evidence, that efforts to revive the use of the trade-mark SECRET STRATEGIES were taken prior to the date of the Notice, in this case, July 7th, 1999. In the absence of such evidence, it was held that the absence of use was not due to special circumstances excusing non-use. The services for the promotion

and staging of live demonstrational shows were therefore deleted from the register.

Conclusion

As we have seen, a lack of invoices as supporting documentary evidence of use of a trade-mark in association with wares is not detrimental when coupled with clear statements of facts showing use of a trade-mark. However, such clear statements must also be made when justifying non-use of a trade-mark as it must be shown that a trade-mark owner's intention to resume use of its trade-mark existed *during* the relevant period and not merely after receiving the Notice.

Moreover, providing documentary evidence in order to lend substance to assertions that efforts have been expended to resume use should also be a consideration when preparing such evidence in summary cancellation proceedings. Finally, evidence of use outside the relevant period should also be considered when faced with the possibility of allegations by the Requesting Party of recent fabrication or token use.

Not published in the *WIPR*

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