



TRADE-MARK REGISTRATION “CURBED” THROUGH CANCELLATION PROCEEDINGS

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The Registrar of Trade-Marks having determined that there was insufficient evidence of use of a trade-mark in association with certain wares and services listed in the registration, she ordered that the trade-mark registration be amended. On appeal, the Federal Court of Canada partially reversed the decision of the Registrar as, on the basis of additional evidence, the Court found that, at least for certain wares and services, there was sufficient evidence of use of the trade-mark. [*Michael Curb v. Smart & Biggar*, 2009 FC 47, Harrington J, January 20, 2009].

The Facts

The Federal Court of Canada was seized of an appeal of a decision of the Registrar of trade-marks expunging certain wares from registration TMA 521,953 for the trade-mark CURB RECORDS. The Applicant, Mr. Michael Curb, a well-known record producer and head of the company Curb Records, is the owner of the trade-mark CURB RECORDS.

The registration originally covered a variety of wares and services relating to the entertainment field. The Respondent trade-mark and patent agency firm of Smart & Biggar asked the Registrar to issue a notice under Section 45 of the *Trade-Marks Act*: such notice required Mr. Curb to prove use in Canada of his trade-mark CURB RECORDS in association with each and every product and service listed in the registration at any time during the previous three years preceding the date of the notice.

After considering the evidence submitted in reply to the Section 45 notice, the Registrar found that there was insufficient evidence of use of the trade-mark CURB RECORDS in association with certain wares and services: consequently, the Registrar ordered those wares and services expunged from the registration.

Mr. Curb appealed this decision of the Registrar to the Federal Court.

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The Federal Court Judgement

Pursuant to section 56 of the *Trade-Marks Act*, on appeal to the Federal Court of a decision of the Registrar of trade-marks, the applicant is entitled to file new evidence, which Mr. Curb did. For this new evidence to be considered on appeal, it must be found that it would have materially affected the Registrar's findings if it had originally been presented to her in the first place. In this case, the Court ruled that the additional evidence would have influenced the Registrar's decision and on this basis, the Court was prepared to consider the case *de novo*, without any deference to the Registrar's findings or without having to identify an error committed by her in order to allow the appeal.

Justice Harrington then went on to reiterate that, pursuant to Section 45 of the *Trade-Marks Act*, the registered owner of a trade-mark must "show" use, not merely assert it. After considering the wares and services that had been struck from the registration by the Registrar, and in light of the new evidence before the Court, Justice Harrington found that except for two particular products, the new evidence was sufficient to overturn the Registrar's decision.

In particular, the Court found that access to a web site in order to listen to pre-recorded music and to view videos through a service listened to in Canada, from a computer situated in Canada, was sufficient evidence of use of the trade-mark CURB RECORDS in association with "entertainment services by pre-recorded music". Also, the new evidence had revealed that Mr. Curb's company, Curb Records, had produced a music video for one of the songs from a CD released in Canada. Since Curb Records had hired the company which filmed the video, and since it had ultimate control over the music video that was produced, this new evidence was sufficient to enable the Court to find use of the trade-mark CURB RECORDS in association with services of "production, publishing and distribution of audio and audio-visual recordings" in Canada.

Finally, the evidence adduced by Mr. Curb was deemed ambiguous in respect of "t-shirts and caps" as it failed to demonstrate that these products had been sold or distributed in Canada in association CURB RECORDS. The affidavit evidence submitted on appeal indicated that "t-shirts and caps" had been "sold and/or distributed in Canada and/or the United States". The Court stated that such ambiguity as to whether or not sales and distributions had actually taken place in Canada should be construed against the affiant and therefore, the Registrar's decision to strike these products from the registration was reasonable. On the basis of the evidence taken as a whole, the Court could not infer that "t-shirts and caps" would have been commercially available for distribution by sale or otherwise in Canada. Justice Harrington stated that neither the Registrar nor the Court would undertake an exercise of speculation, but rather that they needed to draw proper inference from proven the facts. It would had been relatively easy for Mr. Curb to prove such sales and/or distribution in Canada by showing, for example, customs broker records to show that the items was imported to Canada and

then re-exported, or if the products had been sold in Canada, there should be accounting records, namely services taxes records that could have been put forward. Absent this type of evidence, the Court could not conclude that the trade-mark CURB RECORDS had been used in association with “t-shirts and caps”.

For these reasons, the Court granted the appeal in part and ordered that “clothing, namely t-shirts and caps” be deleted from the wares specification for the trade-mark registration for CURB RECORDS.

Conclusion

This case serves as a reminder that Section 45 proceedings and the quality of the evidence put forward by a trade-mark owner should not be trivialised, as the Registrar and the Courts will not hesitate to delete wares and services based on the lack of evidence of use of the trade-mark in association with such wares and services. Ambiguous evidence will also be interpreted against the trade-mark owner. Trade-mark owners should therefore exercise great care and diligence when putting together the evidence in support of maintaining all or part of a trade-mark registration to avoid any small or extensive loss of trade-mark rights.



