

VAGUE AND IMPRECISE AFFIDAVIT HELD INSUFFICIENT TO ESTABLISH PROOF OF USE IN A SUMMARY EXPUNGEMENT PROCEDURE

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In *Smart & Biggar v. Jarawan*, 2006 FC 1254 (Federal Court, J. von Finckenstein), a decision rendered on October 19, 2006, the Federal Court of Canada allowed an appeal from a decision of a Trade-marks Opposition Board Member (the “Hearing Officer”) pursuant to an expungement procedure.

Further to a notice sent by the Registrar at the request of the Applicant (Smart & Biggar), the Respondents (the registrant Al-Rifai Roastery (Mahmasat) Inc. and its president Fares Jarawan) had to show that the trade-mark TMA 530,273 for AL-RIFAI ROASTERY (MAHMASAT) issued in respect of coffee and roasted or otherwise processed nuts was used, in compliance with the requirements found in s. 45 of the Trade-marks Act.

On the basis of the affidavit filed by the Respondents, the Hearing Officer held that the trade-mark in question “was in use in Canada in association with each of the registered wares by means of its display on their packaging and that the sales of these wares occurred during the material three year period (preceding the date of the notice) in the registrant’s normal course of trade.”

The Court had to decide whether the Hearing Officer’s findings were reasonable or not, given the proof of use that had been filed, namely the affidavit along with the related exhibits.

A statement in the affidavit indicated that the wares associated with the trade-mark in question were shipped to clients in boxes and bags, and that the trade-mark was visible on such packaging. The Respondents attached as an exhibit some photographs showing the trade-mark in question on boxes in a warehouse.

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The affidavit also contained statements regarding annual sales for the wares made during the relevant time period, and it referred to an exhibit comprised of invoices from a company called Wake-Cup Coffee Depot Inc. showing coffee sold to various retailers and displaying the trade-mark in question.

However, the Court was of the opinion that the affidavit and the photographs filed as an exhibit did not establish use, because they failed to reveal (a) whether the pictures were taken within the three year period or more recently, (b) whether they were taken in Canada or elsewhere and (c) whether the boxes actually contained the wares associated with the trade-mark in question or something else.

The Court found the invoices filed irrelevant, because they were not establishing that the wares sold bore the trade-mark in question, which is an essential requirement to show use within the meaning of the Trade-marks Act.

In support of this view that what amounts to bare unsubstantiated statements of use are not acceptable, the Court cited some excerpts of the decision in *Aerosol Fillers Inc. v. Plough (Canada) Ltd* (1979) 45 CPR (2d) 194. In that decision Cattnach J. stated that the affidavit, and more particularly so in cases of summary expungement procedures, should be precise and “should not be susceptible of more than one interpretation and if it is then the interpretation adverse to the interest of the party in whose the document was made should be adopted.”

Accordingly, the Court found that the Hearing Office’s conclusion was not reasonable and granted the appeal.

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