

Publisher's Note

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Canadian Trade-Marks Act Annotated

This comprehensive reference work sets out the original purpose and application of the Act, administrative policies, case law and secondary sources.

This release features updates to Procedural Summary PS3 – Summary of Procedure for Appeals Pursuant to Section 56 of the *Trade-Marks Act*. This release also features updates to Procedural Summary PS5 – Trade-Mark Summary Cancellation Proceedings.

Highlights

• **Summary of Procedure for Appeals Pursuant to Section 56 of the *Trade-Marks Act* — Case law — Hearing** — Shortly before the opponent was due to file its memorandum of fact and law, the applicant abandoned all of the trade-mark applications with the exception of those pertaining to BLACK Design, MY BLACKCARD and MY BLACKCARD REWARDS. Justice Fothergill concluded that the appeals arising from the seven abandoned trade-mark applications were moot, and the Court should not exercise its discretion to decide them. The general rule is that the withdrawal of a trade-mark application renders the corresponding appeal moot. Any anticipated future proceedings, including those that may arise from BCL's and Amex's competing

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trade-mark applications, would be decided according to their facts and on their own merits, perhaps with new evidence and with different material dates. Amex was not seeking declaratory relief from this Court or any direction that would purport to bind the Registrar of Trademarks in relation to the recently filed applications. The concrete dispute between the parties regarding the seven abandoned trade-mark applications had disappeared, and the issues raised by the corresponding appeals had become academic. Concern for judicial economy and an awareness of the Court's proper function, specifically in relation to the independent role of the Registrar of Trademarks, militated strongly against the Court exercising its discretion to hear the appeals that have been rendered moot by the withdrawal of the underlying applications: *American Express Marketing & Development Corp. v. Black Card LLC*, 2018 CarswellNat 1410, 2018 CarswellNat 1677, 2018 FC 362, 2018 CF 362 (F.C.).

• **Trade-Mark Summary Cancellation Proceedings — Summary of Procedure — Evidence — Case Law — Affidavit** — The sworn statement was accompanied by three invoices but they were not designated as attachments to the statement by the notary who administered the oath, and were not otherwise marked as exhibits or identified in the statement. However, the affiant mentioned two invoices in the covering letter of the statement. The first two invoices concurred with the statement that they were remitted to the Owner by a Thai company during the relevant period. Although section 45 provides for a summary procedure, and the evidential burden is not heavy, it nonetheless remains that a mere assertion of use is, in itself, insufficient to establish the use of a trade-mark under the terms of section 45 of the Act. One must instead prove the use of the mark, by describing enough facts for the Registrar to be able to arrive at a conclusion whether the mark was used in Canada during the relevant period and in accordance with section 4 of the Act. In particular, it is incumbent on the registered owner to prove how the mark was marked on these goods specified in the registration or their packages - or otherwise associated with these goods - at the time of their sale or delivery in the normal course of trade. Concerning the invoices provided concurrently with the statement, but without being mentioned therein, it is well established that technical deficiencies should not prevent an owner from responding to a notice provided for in section 45 when the evidence adduced could suffice to establish use. In particular, the Register may occasionally admit attachments in evidence that do not bear the inscription of the

Commissioner for Oaths or the notary, when they are clearly identified and explained in the body of the statement. However, the sworn statement made no mention of attachments and offered no explanation regarding the invoices provided at the same time. The covering letter could not be considered evidence. Although the procedure stipulated in section 45 is simple and expeditious, the provisions of this section require evidence in the form of an affidavit or a statutory declaration. The fact that the invoices were not mentioned in the sworn statement or identified as attachments thereto was more than a mere technical deficiency. The invoices were not admissible as evidence: *Guixens Food Group, Inc. c. Kim Long Distributions Inc.*, 2018 CarswellNat 2080, 2018 CarswellNat 2081, 2018 TMOB 41, 2018 COMC 41 (T.M.O.B.).