

**Section 45 clears register of deadwood
Canada - Macera & Jarzyna - Moffat & Co**

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A recent Federal Court of Canada decision in an appeal of a registrar's ruling appears to have restored the intention of Section 45 proceedings. These proceedings are intended to be summary in nature as a means to clear deadwood from the register and not as a proceeding for evidentiary overkill.

Over the years, the burden on a registered trademark owner has increased from requiring a simple declaration that a trademark was in use to a requirement for comprehensive evidentiary disclosure supporting commercial use of a trademark. In the case at hand, it was clear that the court considered the burden to have risen too high. The decision restores the situation where reasonable evidence ought to be sufficient rather than evidentiary overkill.

Background

In this case, Section 45 of the Trademarks Act required the owner of the trademark PIRANHA to submit evidence that it was using the trademark in respect of the goods listed in the registration, namely saw blades for power saws and circular saw blades. Evidence was filed by the trademark owner, the Black & Decker Corporation, by way of an affidavit. Included in the affidavit were copies of the goods displaying the trademark, sample Canadian price lists, sales figures, as well as printouts from various prominent retail websites displaying the goods as being available for sale in Canada. In addition, the affidavit included copies of invoices showing sales of circular saw blades during the relevant period. The registrar reviewed the evidence and was satisfied that use of the trademark had been established in respect of the circular saw blades. However, in the absence of invoices showing sales of the power saw blades, it was decided that there was no proof of sale of the subject goods and therefore no evidence of actual use of the mark with respect to power saw blades. It was ordered that the register be amended to remove power saw blades from the trademark registration.

Black & Decker appealed the registrar's decision and further evidence was filed including invoices for power saw blades during the relevant period. Ultimately the court was satisfied that the trademark was in use in respect of power saw blades and directed that the goods be reinstated in the PIRANHA trademark registration.

Comment

From a review of the decision, it appears that the court would have reinstated the deleted goods even without the additional evidence filed by the trademark owner. The court reviewed the purpose of Section 45 proceedings and reiterated that they were intended to be summary in nature and not a platform for evidentiary overkill. When evidence was filed by the registered owner, the court held that any ambiguities ought to be resolved in favour of the trademark owner.

The purpose of Section 45 is to clear the register of deadwood. In other words, it is a system to remove those marks from the register which are clearly not being used. The original affidavit ought to have been sufficient to maintain the trademark on the register. Invoices of sales are not required. Based on the evidence presented at the Section 45 hearing, it was reasonable to decide that the trademark was in use.

This decision will be welcomed by trademark owners which, up until now, ran the risk of losing trademark rights for failing to meet an unnecessary and comprehensive evidentiary burden.

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