



**LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS**

**Citation: 2013 TMOB 220
Date of Decision: 2013-12-13**

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Baker & McKenzie LLP against registration
No. TMA657,168 for the trade-mark BEFRESH in the
name of Fempro I Inc.**

[1] At the request of Baker & McKenzie LLP, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Fempro I Inc. (the Registrant), the registered owner of registration No. TMA657,168 for the trade-mark BEFRESH (the Mark).

[2] The Mark is registered for use in association with the following wares: feminine hygienic products, namely: panty liners, sanitary napkins, absorbent pads, and tampons.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and services specified in the registration at any time within the three year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is April 13, 2008 to April 13, 2011.

[4] Section 4 of the Act sets out the meaning of use. In this case, the following section applies:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Mr. Jean Fleury, Chief Executive Officer of the Registrant, sworn on July 12, 2011. Both parties filed written submissions; an oral hearing was not held.

[7] In his affidavit, Mr. Fleury makes the sworn statement that the Registrant used the Mark by way of licensees in the normal course of trade in association with "feminine hygienic products" during the relevant period. In support, he includes with his affidavit photographs of products, sample invoices and sales figures from the relevant period. As will be discussed further in the paragraphs that follow, this evidence features only "sanitary napkins" and "panty liners".

[8] Mr. Fleury explains that the Registrant specializes in the manufacture and sale of feminine hygienic products, namely sanitary napkins and panty liners. Mr. Fleury explains that the Registrant directly or indirectly controls the character or quality of the feminine hygienic products sold in association with the Mark by third party retailers. Specifically, he states that the Registrant manufactures private label feminine hygienic products in its Drummondville, Quebec

factory to be sold in Canada by various Canadian retailers (*e.g.* Jean Coutu). The packaging for these products features both the Mark and the “private trade-mark”, or store brand, of the retailer.

[9] As noted above, Mr. Fleury attaches to his affidavit photographs of packages of sanitary napkins and panty liners displaying the Mark, which he states are representative of the manner in which the Mark was used during the relevant period (Exhibit JF-2).

[10] Mr. Fleury also attaches two sample invoices dated October 15, 2009 and September 1, 2009 which he states show sales of sanitary napkins and panty liners to Le Groupe Jean Coutu Inc. during the relevant period (Exhibit JF-3). The invoices, which do not feature the Mark, display product codes corresponding with the product codes shown in the photographs attached as Exhibit JF-2. As a result, I am satisfied that the sample invoices evidence sales of sanitary napkins and panty liners that were sold in packaging displaying the Mark.

[11] While redacted to remove the exact sales figures, Mr. Fleury further makes the sworn statement that the invoices represent sales of at least \$40,000 of sanitary napkins and panty liners.

[12] In response to the Registrant’s evidence, the Requesting Party submits that:

- (a) the photographs do not satisfy the requirements of section 45 because they fail to describe the use of the Mark in association with each of the registered wares during the relevant period;
- (b) the invoices are insufficient to show use of the Mark as they do not reference the Mark; and
- (c) the Registrant does not provide evidence of use of the Mark in relation to either “absorbent pads” or “tampons”.

[13] With respect to the first two submissions, the jurisprudence is clear that, in section 45 proceedings, the evidence must be viewed as a whole rather than focusing on individual pieces [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 at 213 (TMOB)]. Furthermore, there is no one particular type of evidence that must be provided in a section 45 proceeding. The registered owner of a trade-mark is only required to provide some evidence that the trade-mark was being used in Canada in the normal course of trade during the relevant period [*Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)].

[14] In this case, I do not agree with the Requesting Party's submissions that the photographs and the invoices do not provide sufficient information about the manner of use of the Mark in association with the registered wares to support a finding of use during the relevant period. Rather, when the invoices are taken together with Mr. Fleury's sworn statements, it is clear that at the time of transfer, the Mark was displayed on the packaging for "panty liners" and "sanitary napkins" during the relevant period. In particular, I am satisfied that a correlation can be made between the descriptions appearing on the exhibited invoices and the descriptions on the exhibited photographs of the packaging.

[15] With respect to the Requesting Party's third and final submission that the Registrant has failed to discuss or provide any evidence of use of the Mark in association with "absorbent pads" and "tampons", I agree, for the reasons that follow.

[16] I note that the onus is on the Registrant to make the correlation between the wares shown to be in use and the registered wares [*Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 (TMOB) at 571]. Furthermore, it is well established that allegations in an affidavit should be precise and should not lead to more than one interpretation [*Aerosol Fillers Inc v Plough (Canada) Ltd* (1979), 45 CPR (2d) 194 (FCTD) at 198].

[17] I agree with the Requesting Party's submission that the evidence is silent with respect to the use of the Mark in relation to "absorbent pads" and "tampons". Nowhere in the evidence does the affiant make any specific reference to "absorbent pads" or "tampons". Rather, the evidence makes clear and specific reference to only "sanitary napkins" and "panty liners". Furthermore, I note that the Registrant's written representations are also silent on this issue with the exception of a general submission that "evidentiary overkill" is not required.

[18] As such, I am not satisfied that the Registrant has demonstrated use of the Mark in association with the wares "absorbent pads" and "tampons" within the meaning of sections 4 and 45 of the Act during the relevant period. Furthermore, the Registrant has not provided any special circumstances excusing non-use of the mark with respect to "absorbent pads" and "tampons".

Disposition

[19] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the wares “absorbent pads” and “tampons”.

[20] The amended statement of wares will read as follows: “Feminine hygienic products, namely: panty liners, sanitary napkins.”

Andrea P. Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office