



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

Citation: 2014 TMOB 190
Date of Decision: 2014-09-05

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Smart & Biggar against registration
No. TMA518,881 for the trade-mark GENESIS in the
name of Ocean Ceramics Ltd.**

[1] At the request of Smart & Biggar (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on October 29, 2012 to Ocean Ceramics Ltd. (the Registrant), the registered owner of registration No. TMA518,881 for the trade-mark GENESIS (the Mark).

[2] The notice required the Registrant to furnish evidence showing that the Mark was in use in Canada, in association with each of the wares and services specified in the registration, at any time between October 29, 2009 and October 29, 2012. If the Mark had not been so used, the Registrant was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[3] The Mark is registered for use in association with the wares “dental crowns” and the services “creating dental crowns for others”.

[4] The relevant definitions of use with respect to wares and services are set out in sections 4(1) and 4(2) of the Act as follows:

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.

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of James Neuber, Vice-President of the Registrant, sworn on January 23, 2013. Both parties filed written representations; only the Registrant was represented at an oral hearing.

The Registrant’s Evidence

[7] In his affidavit, Mr. Neuber attests that the Registrant is a company that manufactures “ceramic crowns, veneers, inlays and onlays for anterior and posterior teeth” in response to prescription requests from its customers. He explains that the Registrant’s customers are dentists throughout British Columbia, Alberta, Saskatchewan and Quebec, numbering “in excess of 150”. He asserts that since 1999 and throughout the relevant period, the Registrant has used the Mark in Canada in association with the wares and services as registered. In this respect, he attests that between 2008 and 2012, the Registrant provided an average of 22 dental crowns per year in association with the Mark, with the total value of all such dental crowns and associated manufacturing services being in excess of \$40,000.

[8] With respect to its normal course of trade, Mr. Neuber attests that the Registrant provides prescription forms to its dentist customers. He explains that dentists place orders for dental crowns by checking the box marked GENESIS on the form and submitting the completed prescription form along with an impression of the patient’s tooth to the Registrant via courier. A representative copy of the form is attached at Exhibit B to Mr. Neuber’s affidavit; he confirms that the form was used during the relevant period.

[9] After receiving the order form, the Registrant's technicians prepare and fabricate the crown in the Registrant's laboratory, according to the specifications provided on the form. Mr. Neuber attests that the completed crown is then delivered to the dentist customer together with an invoice for the crown and its manufacture.

[10] Ten such invoices from the relevant period to various customers located in Canada are provided at Exhibit C to the affidavit. The Mark appears in the description column of each invoice, along with a brief description of the subject tooth, such as "Genesis® Veneer/Crown Anterior".

[11] Given the nature of the wares, it is reasonable that the Mark would not appear on the wares themselves. Notwithstanding the Requesting Party's submissions, it is well-established that invoices bearing the trade-mark can be evidence of use, falling within the words "or it is in any other manner so associated with the wares that notice of association is then given to the person to whom the property or possession is transferred" as set out in section 4(1) of the Act [see *Gordon A MacEachern Ltd v National Rubber Co Ltd* (1963), 41 CPR 149 (Ex Ct); *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD)]. In this case, I agree with the Registrant that the invoices constitute use of the Mark in association with "dental crowns". As described above, the Mark appears in the body of the invoices and Mr. Neuman confirms that the invoices accompanied the wares when the crowns were shipped to the Registrant's dentist customers, *i.e.*, at the time of transfer in possession of the wares.

[12] Furthermore, given the ancillary nature of the services to the wares, the appearance of the Mark on the order forms and invoices constitutes display of the Mark in the advertisement and performance of the services as registered.

[13] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark in association with "dental crowns" and "creating dental crowns for others" within the meaning of sections 4 and 45 of the Act.

Disposition

[14] Accordingly, 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 maintained.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office