



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

Citation: 2012 TMOB 146
Date of Decision: 2012-08-09

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Smart & Biggar against registration
No. TMA623,750 for the trade-mark SOSEXÉ in the
name of Rick Worobec**

[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 July 15, 2010 to Rick Worobec (the Registrant), the registered owner of registration No. TMA623,750 for the trade-mark SOSEXÉ (the Mark).

[2] The Mark is registered for use in association with “Personal hygiene products namely; soaps; cosmetics namely perfumery, essential oils, hand lotions, body lotions, hair lotions; clothing namely under garments, swimwear; footwear namely shoes.”

[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 between July 15, 2007 and July 15, 2010.

[4] The relevant definition of “use” in association with wares is set out in section 4(1) of the Act:

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 section 45 proceedings [*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* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd 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 his own statutory declaration, sworn on September 10, 2010. Only the Requesting Party filed written representations and attended an oral hearing.

[7] In his affidavit, the Registrant makes no clear assertion of use with respect to any of the wares as registered. However, he identifies himself as the owner of "Flashy Fashions" and attaches as Exhibit A to his affidavit two photographs, which he attests depicts "items [that] have been distributed in Canada since as early as 2004". The photographs appear to be of shirts; however, the photographs are cropped so as to only show the tag appearing on the collar and the design logos on the front of the shirts. I note that only one of the shirts displays the Mark as registered. The other shirt displays the trade-mark OSOSEXE.

[8] He also attaches as Exhibit B two invoices in the name of Flashy Fashions Inc., which he attests are "in respect to the sale and distribution of the items set out in Exhibit A". I note, however, that the first invoice only identifies products by item number codes, which the Registrant fails to explain. Therefore, it is unclear which of the Exhibit A items are represented on the first invoice. The Exhibit B invoice is more detailed, identifying each of the 15 items either by an "SOS" code or an "OSO" code, presumably indicating either SOSEXE or OSOSEXE, respectively. However, the descriptions of each item on the invoice, as well as the

Exhibit A photographs themselves, would indicate that the items represented are shirts or t-shirts, rather than any of the clothing wares as registered, namely, “undergarments” or “swimwear”.

[9] I would further note that a handwritten note on the second invoice indicates that the invoice represents a consignment order, and that “all products remain property of Flashy Fashions Inc until paid for in full”. Citing *JAG Flocomponents NA v Archmetal Industries Corporation* (2010), 84 CPR (4th) 323, the Requesting Party submitted that a consignment order of this nature does not fall within the definition of use in section 4 of the Act. I would agree with the Requesting Party that it is unclear whether there was a subsequent transfer in property or possession and, absent clear statements from the Registrant, I would not be prepared to accept this single invoice as representative of sales in the normal course of trade.

[10] Accordingly, in view of the foregoing, I am not satisfied that there was use of the Mark in association with the Wares “clothing, namely under garments and swimwear” during the Relevant Period within the meaning of sections 4 and 45 of the Act.

[11] With respect to the remaining wares, notwithstanding the registration of the trade-mark in 2004, the Registrant explicitly states that such wares have not been distributed in Canada.

Special Circumstances Excusing Non-Use

[12] As such, I will now consider whether there were any special circumstances justifying non-use. Generally, a determination of whether there are special circumstances that excuse non-use involves consideration of three criteria, as set out in *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA); the first is the length of time during which the trademark has not been in use, the second is whether the reasons for non-use were beyond the control of the registered owner and the third is whether there exists a serious intention to shortly resume use. The decision in *Scott Paper Ltd v Smart & Biggar* (2008), 65 CPR (4th) 303 (FCA) offered further clarification with respect to the interpretation of the second criterion, with the determination that this aspect of the test *must* be satisfied in order for there to be a finding of special circumstances excusing non-use of a mark. In other words, the other two factors are relevant but, considered by themselves, in isolation, cannot constitute special circumstances. Further, the intent to resume use must be substantiated by the evidence [*Arrowhead Spring*

Water Ltd v Arrowhead Water Corp (1993), 47 CPR (3d) 217 (FCTD); *NTD Apparel Inc v Ryan* (2003), 27 CPR (4th) 73 (FCTD)].

[13] In the present case, I note that the Registrant provides no last date of use of the Mark with respect to any of the wares. He simply states that, with respect to the wares as registered other than “clothing”, he has not had time to produce them due to “business matters” that required his attention outside of Canada. He goes on to indicate that his intention is to produce and distribute such wares within “the next six months to a year”.

[14] Without further details regarding the nature of the Registrant’s other “business matters”, I would agree with the Requesting Party that the Registrant’s prioritization of other business interests should be construed as a voluntary decision of the Registrant within his control. Similarly, absent further particulars, I do not find that his statement regarding his intention to resume use is substantiated by the evidence before me.

[15] Accordingly, I cannot conclude that the Registrant has demonstrated special circumstances to excuse non-use of the Mark during the Relevant Period.

Disposition

[16] 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 expunged.

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