

SECTION 45 PROCEEDINGS
TRADE-MARK: FOREVER
REGISTRATION NO.: UCA 37597

On November 3, 2004 at the request of Dimock Stratton LLP, the Registrar forwarded the Notice prescribed under Section 45 of the Trade-Marks Act to Cadman Manufacturing Company Limited, the registered owner of the above-referenced trade-mark registration.

The trade-mark FOREVER is registered for use in association with the following wares:

“finger rings made of precious metals”.

Section 45 of the Trade-marks 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/or services listed on 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 use since that date. The relevant period in this case is any time between November 3, 2001 and November 3, 2004.

In response to the notice, the affidavit of G. Wesley Dickenson has been furnished. Each party filed a written argument and was represented at the oral hearing.

Mr. Dickenson is President of the registrant company. He states that the registrant at all material times throughout the relevant period applied the trade-mark on the wares by means of engraving

the trade-mark on the inside of rings as shown in a copy of a photograph of a typical sample of the wares produced as Exhibit A. He explains that the registrant then sells the wares so marked to its customers who then resell the wares to the general public. As Exhibit B, he provides examples of sales invoices for the wares and specifies that the item numbers which have been highlighted on the invoices reference the wares sold bearing the trade-mark. There is also a reference to the trade-mark on the bottom portion of the invoices.

As Exhibit C he provides a copy of the front cover of the December, 2003 issue of the Canadian Jeweller 2004 Buyers' Guide as well as an excerpt of the Guide which he states shows a reference to the trade-mark.

The requesting party's main argument is that the evidence fails to show use of the trade-mark as registered. It submits that if any use is shown it is of the trade-mark CMC FOREVER which does not constitute use of the trade-mark FOREVER per se, and therefore the trade-mark registration ought to be expunged. The requesting party submits that the affiant is clearly being overly liberal when he refers to the "Trade-mark"; that he defines the "Trade-mark" as "FOREVER" but when he shows use of the "Trade-mark" it is not the trade-mark FOREVER but rather the trade-mark CMC FOREVER. The requesting party states that this is misleading, at best, and that a negative inference should be drawn from the fact that the affiant has mischaracterized the use of the mark. It submits that the inference to be drawn is that the affiant understood that use of CMC FOREVER is not use of the trade-mark FOREVER.

The registrant, on the other hand, submits that the use shown in association with the wares is of the trade-mark FOREVER and it submits that the trade-mark registration ought to be maintained.

Having considered the evidence, I cannot agree with the requesting party that it is misleading or that adverse inferences should be made. In my view, the evidence shows that the trade-mark FOREVER was in use in association with the registered wares during the relevant period.

Mr. Dickenson has clearly described the registrant's normal course of trade with respect to the trade-mark and the wares and I am satisfied that the sales of the wares that occurred in Canada during the relevant period (as evidenced by the invoices), were sales made in the registrant's normal course of trade. Concerning the manner the trade-mark was associated with the wares at the time of sales, Mr. Dickenson has explained (in paragraph 5 of his affidavit) that the trade-mark was engraved on the inside of the wares (a typical sample has been provided as Exhibit A to his affidavit) at all material times throughout the relevant period. Accordingly, I accept that the registrant's finger rings made of precious metals that were sold during the relevant period bore the trade-mark in the manner shown by Exhibit A. I reproduce below the trade-mark as engraved on the inside of the wares as shown by Exhibit A:



As is apparent from the photograph, the letters CMC are also engraved on the inside of the ring.

The requesting party's argument is that such use is of the composite mark CMC FOREVER and not of the trade-mark FOREVER "per se". It submits that because of the angle at which the photograph of the ring was taken it cannot be ascertained how much space there is between the letters CMC and the word FOREVER. Further it relies on the fact that in the excerpt of the December 2003 issue of the Canadian Jeweller 2004 Buyers' Guide (Exhibit C to the affidavit) reference is made to the trade-mark CMC FOREVER not the trade-mark FOREVER.

I agree that in the Canadian Jewellers 2004 Buyers Guide reference is made to the trade-mark CMC FOREVER and not FOREVER. However, the ad is not the only evidence to be considered in this case. As pointed out by the registrant's agent, the invoices (at the bottom thereof) refer to the trade-mark FOREVER without the letters CMC. Further, on the inside of the rings, I am of the view that the use shown is of both trade-marks, that is CMC FOREVER and FOREVER (as indicated in *A. W. Allen Limited v. Warner-Lambert Canada Inc.*, 6 C.P.R. (3d) 270, there is nothing to prevent two registered trade-marks from being used at the same time). As the word

FOREVER appears sufficiently spaced away from the letters CMC, I find that it does stand out from the letters CMC and consequently I accept that the registrant's customers would probably perceive it as a trade-mark on its own. Further, it may be that some customers would perceive the letters CMC as an abbreviation of the registrant's name and the word FOREVER as the trade-mark for the wares. Therefore, this case is distinguishable from *Registrar of Trade-marks v. Compagnie Internationale pour l'Informatique CII Honeywell Bull S.A.*, 4 C.P.R. (3d) 523.

Consequently, as I have found that the word FOREVER as used on the inside of the rings remains recognizable as a trade-mark (see *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535 Principle 1 and *Promafil Canada Ltée v. Munsingwear Inc.*, 44 C.P.R. (3d) 59), I conclude that the evidence shows use of the trade-mark FOREVER in association with the registered wares.

In view of the above, Registration No. UCA 37597 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 28TH DAY OF JUNE 2007.

D. Savard
Senior Hearing Officer
Section 45 Division