

SECTION 45 PROCEEDINGS
TRADE-MARK: FOREVER YOUNG
REGISTRATION NO. TMA479,909

On February 15, 2006, at the request of Weir Foulds LLP, the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) to Pro-Health, Inc., the registered owner of registration No. TMA479,909 for the trade-mark FOREVER YOUNG (the “Mark”). The Mark is registered in association with “cosmetics, namely cellular moisturizing creams, lotions and gels.”

Section 45 requires the registered owner of a trade-mark to indicate whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice, in this case between February 15, 2003 and February 15, 2006. If the mark has not been used during that time period then the registered owner is required to indicate the date on which it was last used and the reason why it has not been used since that date.

What qualifies as use of a trade-mark is defined in s. 4 of the Act, which is reproduced below:

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.
- (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.
- (3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In response to the s. 45 notice, the registered owner filed the affidavit of Frank Newton. Neither party filed a written argument and an oral hearing was not requested.

Mr. Newton, the Vice President of Pro-Health, Inc., attests, “The trade-mark FOREVER YOUNG has been used in Canada by the registrant through its licensee Life Plus International since at least as early as December 1, 1993 in association with ‘cosmetics, namely cellular moisturizing creams, lotions and gels’.” He provides:

1. promotional pieces that are distributed in Canada to customers and which include photographs of the creams, lotions and gels displaying the Mark on their labels or containers;
2. Canadian annual sales figures for each of the years 2003, 2004 and 2005;
3. invoices dated 2005 and 2006 showing sales to Canadian customers of FOREVER YOUNG products (FOREVER YOUNG appears in the body of the invoices in the product description).

Based on the foregoing, I am prepared to accept that the FOREVER YOUNG mark was being used in Canada in association with each of the registered wares during the relevant time period. However, the registrant has not provided sufficient information for me to conclude that such use accrued to its benefit pursuant to s. 50. The relevant subsections of s. 50 are reproduced below:

(1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

(2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the wares or services is under the control of the owner.

The invoices and promotional pieces provided by the affiant all refer to Life Plus International; I see no reference to the registrant. Although Mr. Newton attests that Life Plus International is the registrant's licensee, this is not indicated in any way on the materials, and Mr. Newton has not attested that the registrant controls the character or quality of the FOREVER YOUNG wares sold by Life Plus International. Instead, he attests that Life Plus International "manufactures and sells the FOREVER YOUNG wares through a multi-level marketing business."

As stated by Senior Hearing Officer Savard in *Ridout & Maybee s.r.l. v. Omega SA* (2003), 33 C.P.R. (4th) 184 (T.M.O.B.):

...there is no requirement that a license be in writing (see *Quarry Corp. v. Bacardi & Co.* (1996), 72 C.P.R. (3d) 25 (Fed. T.D.) and (1999), 86 C.P.R. (3d) 127 (Fed. C.A.)). Concerning the control required, for purposes of Section 45, so long as the use is under license and there is a statement in the affidavit that the owner has direct or indirect control over the character and quality of the wares and/or the services, the Registrar will, in the absence of indications to the contrary, accept that the use is in compliance with Section 50 of the Act (see *Sara Lee Corp. v. Intellectual Property Holding Co.* (1997), 76 C.P.R. (3d) 71 (T.M. Bd.), *Fitzsimmons, MacFarlane v. Caitlin Financial Corp. N.V.* (1997), 79 C.P.R. (3d) 154 (T.M. Bd.) at a57, *Sim & McBurney v. LeSage Inc.* (1996), 67 C.P.R. (3d) 571 (T.M. Bd.) and the *Federated Department Stores Inc. v. John Forsyth Co.* (2000), 10 C.P.R. (4th) 571 (T.M. Bd.)).

The problem with the present case is that there is no statement from the affiant to the effect that the trade-mark owner had direct or indirect control over the character or quality of the wares sold by its licensee. Nor has public notice been given of the identity of the owner and the fact that the trade-mark is being used under licence. In other words, the registrant has not successfully invoked either s. 50(1) or (2).

Therefore, even though the burden on the registrant under s. 45 is not a heavy one [*Austin Nichols & Co. v. Cinnabon Inc.*, [1998] 4 F.C. 569 (F.C.A.)] and the Registrar does not require much information to reach a conclusion that s. 45 evidence complies with s. 50 of the Act, there is

insufficient evidence in the present case for me to reach such a conclusion. Overall, I find that the evidence presented does show use of the Mark but not use that accrues to the benefit of the Mark's registered owner.

I have noted that the registration indicates that the present owner only acquired the registration in 2004. The prior owner was Life Plus International. Life Plus International owned the registration from November 1, 1997 to October 7, 2004. Accordingly, evidence that Life Plus International was using the Mark as its owner during the relevant three-year period would also suffice to maintain the registration; in other words, evidence of use by Life Plus International in Canada between February 15, 2003 and October 7, 2004 would maintain the registration. However, even if I were to ignore the affiant's sworn contradictory statement that Life International Plus was using the Mark as a licensee during that time period, none of the invoices filed bear a date that falls within Life Plus International's ownership of the Mark.

For the reasons set out above, registration TMA479,909 will be expunged, in accordance with the provisions of s. 45(5) of the Act.

DATED AT GATINEAU, QUEBEC THIS 21st DAY OF NOVEMBER 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board