



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

Citation: 2013 TMOB 66
Date of Decision: 2013-04-11

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Pure Heart Inc. against registration
No. TMA562,824 for the trade-mark PURE HEART in
the name of Pure Heart Designs, LLC**

[1] At the request of Pure Heart Inc. (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 June 14, 2010 to Pure Heart Designs, LLC (the Registrant), the registered owner of registration No. TMA562,824 for the trade-mark PURE HEART (the Mark).

[2] The section 45 notice required the Registrant to furnish evidence showing that it had used the Mark in Canada in association with each of the wares specified in the registration within the time period between June 14, 2007 and June 14, 2010.

[3] The wares specified in the registration are:

(1) Jewelry made wholly or in part of precious metal; including rings, earrings, bracelets, necklaces, lapel pins and cuff links.

(2) Jewelry made wholly or in part of precious metal namely, rings, earrings, bracelets, necklaces, lapel pins and cuff links.

[4] The relevant definition of “use” with respect to 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] In response to the Registrar's notice, the Registrant furnished the declaration of Adai Akdemir, owner of the Registrant, sworn on March 10, 2011. Both parties filed written representations; an oral hearing was not requested.

[6] In his brief declaration, Mr. Akdemir acknowledges that the Registrant is required to establish use in association with each of the wares covered by the registration. Attached as Exhibit A to his declaration are 12 invoices, which he describes as a series of invoices evidencing sales by the Registrant to its Canadian client, Bijoux Marsan. The invoices are all dated within the Relevant Period and in each case the "Sold To" field of the invoice shows "Bijoux Marsan" and an individual's name along with an address in Montreal, Quebec.

[7] In his declaration, Mr. Akdemir explains that the items listed on the various invoices, namely "Cayla 24K Pure Heart", "Briana 24K Pure Heart" and "Gianna 24K Pure Heart", represent sales of necklaces bearing the Mark. I note that half of the invoices show the sale of only one necklace each, with no invoice exceeding four items.

[8] He also attaches as Exhibit B to his declaration what he describes as "a two-page handwritten listing which I prepared describing the specific goods covered by the invoices attached as Exhibit A hereto as sold to Bijoux Marsan". Also included, but not referenced in his declaration, are pictures of various jewellery items from what appears to be a catalogue. In its written representations, the Registrant explains that the style numbers next to the pictures correspond to the handwritten listings. However, I note that the pictures of the various jewellery items do not display the Mark. Furthermore, having already identified the items actually listed in the Exhibit A invoices as necklaces, it is unclear what the Exhibit B listings reference. If the Exhibit B listings are intended to indicate sales of other jewellery items to Bijoux Marsan during the Relevant Period, this is not clear from Mr. Akdemir's statement. In fact, based on Mr. Akdemir's description, it is reasonable to conclude that this exhibit was prepared merely in response to the section 45 notice issued in this case.

[9] In its written representations, the Requesting Party submits that the evidence does not show use in association with all of the wares as registered; furthermore, it submits that the invoices do not show use of the Mark as registered.

[10] Upon review of the declaration as a whole, however, a more fundamental issue with respect to the evidence is apparent. Although Mr. Akdemir states that the Exhibit A invoices show sales of jewelry to Bijoux Marsan, there is no indication that the sales occurred in Canada. In his declaration, the Registrant gives no details of his normal course of trade, such that it would be reasonable to infer that the sales occurred in Canada or that the jewelry was shipped to Canada by the Registrant.

[11] In this case, in the absence of clear statements, it is left to the invoices to speak for themselves regarding the Registrant's normal course of trade, and specifically regarding whether any transfer with respect to the jewelry occurred in Canada. However, there are several indications in the invoices that the sales did not, in fact, occur in the normal course of trade in Canada. The invoices show that the Registrant is located in New York and in each case show that the "Payment Method" was "Cash"; handwritten notes on each invoice stating "paid in cash" or "exchange damaged pieces" also indicate that the transactions were done in person. Nothing in the invoices suggests that the jewelry was shipped to Bijoux Marsan's Canadian address, or that the invoices accompanied such shipments.

[12] 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 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.

[13] As the Registrant has not established that any transfer in property or possession of the wares associated with the Mark occurred in Canada, I cannot conclude that the Registrant has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act. As stated in *Boutique Limitée Inc v Limco Investments, Inc* (1998), 84 CPR (3d) 164 (FCA) at paragraph 16:

“...a sale to a Canadian in the United States does not amount to use of a mark in the normal course of trade in Canada”.

[14] Furthermore, there is no evidence of special circumstances excusing non-use of the Mark before me.

Disposition

[15] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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