



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

Citation: 2014 TMOB 261
Date of Decision: 2014-11-26

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Bereskin & Parr LLP against registration
No. TMA434,436 for the trade-mark FERBY in the name
of Johann Froescheis Lyra-Bleistift-Fabrik GmbH & Co.**

[1] At the request of Bereskin & Parr LLP (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 May 2, 2013 to Johann Froescheis Lyra-Bleistift-Fabrik GmbH & Co. (the Owner), the registered owner of registration No. TMA434,436 for the trade-mark FERBY (the Mark).

[2] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the wares specified in the registration, at any time between May 2, 2010 and May 2, 2013. If the Mark had not been so used, the Owner 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 following wares:

Paper, namely writing paper, art paper and stationery as loose paper and in pad form; pasteboard; cardboard; printed matter, namely books, magazines, booklets, formulars, calendars, cards, posters, writing utensils, namely pencils and pens of any kind; pencil leads, cartridges, pen and pencil extender, wooden pen holders, artists' supplies, comprising drawing, painting and modelling products, namely crayons, coloured pencils and coloured pens of any kind; markers, wax painting chalks, painting sets for artists, water colour sets for artists, children and school pupils comprising water colours and drawing brushes modelling clay, compounds and materials for use by children and artists; crayons; office supplies comprising non-electrical office devices, namely rubber erasers, eraser pencils, pencil sharpeners and sharpening machines, rulers, angles, drawing tools,

squares, pen and ink drawing tools and tips, templates, cases for writing and drawing tools; teaching and instruction material (except apparatus) in the form of printed matter, namely books, magazines, booklets, formulars, calendars, cards, posters; educational games, drawing instruments for wall boards, playing cards; types; printing blocks.

[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] 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 Owner furnished the affidavit of Dr. Nicole Blum, CEO of the Owner, sworn on July 29, 2013. Both parties filed written representations and were represented at an oral hearing held on October 29, 2014.

[7] In Dr. Blum's affidavit, the evidence of use with respect to the Mark is limited to the wares "coloured pencils". At the oral hearing, the parties agreed that, at best, the evidence was limited to "artists' supplies, comprising drawing products, namely coloured pencils". Further, the parties agreed that there was no evidence of special circumstances excusing non-use with respect to the other wares.

[8] In her affidavit, Dr. Blum attests that the Owner manufactures and sells writing and drawing materials for school children, hobbyists and artists. She explains that the Owner was founded in Germany in 1806 and does business as Lyra, part of the FILA group of companies. She attests that in the ordinary course of trade, "Lyra's products are sold to a variety of retail

stores [...] in Canada through a distributor, Dixon Ticonderoga, Inc., which is a Canadian subsidiary of FILA”. To support her attestations, Dr. Blum attaches to her affidavit a Dixon price list, a photocopy of packaging for FERBY coloured pencils, and a number of invoices.

[9] I note that the Mark is displayed prominently on the packaging, along with the Owner’s trade name, Lyra. The packaging also displays “Since 1806” and identifies the country of origin as Germany.

[10] At the oral hearing, the Requesting Party conceded that the invoices show sales of FERBY coloured pencils to Canadian retailers by Dixon during the relevant period. However, the Requesting Party submits that Dr. Blum failed to make a clear statement in her affidavit that the Owner manufactured these coloured pencils and suggests that the manufacturer could have been another FILA company. Accordingly, the Requesting Party relies on *Plough, supra*, to argue that this “ambiguity” in the evidence should be resolved against the Owner.

[11] In response, the Owner submits that there are no inconsistencies in Dr. Blum’s sworn statements and that as a whole, the affidavit and the attached exhibits provide a clear picture showing that the Owner, as Lyra, manufactured the coloured pencils and sold them to Canadian customers through its distributor, Dixon.

[12] Indeed, it is well-established that the affidavit as a whole must be considered and it is not the proper approach to dissect the affidavit such that statements made are considered only out of context [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)]. In the present case, I am satisfied that, when read as a whole, the affidavit sufficiently explains the Owner’s ordinary course of trade and allows the Registrar to infer that the Owner was the manufacturer of the wares in question.

[13] While Dr. Blum states in her affidavit that “Lyra manufactures and sells writing and drawing material”, she does not make a precise statement that this includes the coloured pencils referenced in the exhibits. However, this inference can be readily drawn, as it is consistent with the details on the packaging and Dr. Blum’s statements. In light of the evidence as a whole, it strains credulity that a related FILA company – which, coincidentally, would also have been

established in Germany, in 1806, and would do business under the name “Lyra” – was the actual manufacturer of the coloured pencils in question, rather than the Owner.

[14] Finally, the Requesting Party’s remaining argument is that there needs to be a license in order for sales by the distributor, Dixon, to enure to the Owner’s benefit. However, it is well-established that a registered owner’s ordinary course of trade will often involve distributors and wholesalers and, if any part of the chain of distribution occurs in Canada, this is generally sufficient to demonstrate “use” enuring to the benefit of the owner [see *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD); *Lin Trading Co v CBM Kabushiki Kaisha* (1988), 21 CPR (3d) 417 (FCA)]. As such, the evidenced sales by Dixon of FERBY coloured pencils enures to the benefit of the Owner for purposes of this proceeding.

[15] In view of all the foregoing, I am satisfied that the Owner has demonstrated use of the Mark with respect to coloured pencils within the meaning of sections 4 and 45 of the Act.

Disposition

[16] 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 amended to delete all of the wares with the exception of “coloured pencils”. The amended statement of wares will read as follows:

Artists’ supplies, comprising drawing products, namely coloured pencils.

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