



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

Citation: 2014 TMOB 255
Date of Decision: 2014-11-24

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Riches, McKenzie & Herbert LLP against
registration No. TMA719,081 for the trade-mark SEVEN
SISTERS in the name of Sena Marketing Inc.**

[1] At the request of Riches, McKenzie & Herbert 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 September 20, 2012 to Sena Marketing Inc. (the Owner), the registered owner of registration No. TMA719,081 for the trade-mark SEVEN SISTERS (the Mark).

[2] The section 45 notice required the Owner 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 September 20, 2009 and September 20, 2012.

[3] The mark is registered in association with the following wares: “footwear, namely: shoes, boots, sandals, slippers.”

[4] The relevant definition of “use” 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 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] However, in this case, the primary issue is whether the material furnished by the Owner is admissible as proper evidence in this proceeding.

Owner's Response to the Notice

[7] In response to the Registrar's notice, the Owner furnished a letter with attachments dated April 14, 2013. The letter is on the Owner's letterhead, and simply states the following:

To whom it may concern.
Please find enclosed documentation regarding our usage
Of the trade mark 'SEVEN SISTERS'.

[8] The letter is signed by Chris Bannester and also provides contact information. The attached documentation consists of the following:

- A two page invoice dated July 20, 2011 from Bruel International Limited in Dublin, Ireland to SENA. The invoice is in the amount of USD\$20,064 and the itemized descriptions list various models of shoes, all indicating "Seven Sisters" branding.
- Nine undated photographs of various types of shoes, all displaying the Mark on the insole.

[9] The attached documents all display the stamp and initials of Ann Desrosiers, "Commissionaire à L'Assermentation – Districts Judiciaires de Longueuil et Montreal". The stamp and initials appear on the front of the invoice pages and on the back of each photograph page. Nothing in the letter explains the significance of the attachments, but it would appear that the invoice is for the purchase of various shoes by the Owner from a manufacturer in 2011. The photographs are presumably representative of those shoes.

[10] On May 3, 2013, the Owner's response was made of record and the Requesting Party was invited to submit its written representations.

Requesting Party's Submissions

[11] In a letter dated July 3, 2013, the Requesting Party stated that "no written representations will be made". However it further stated the following:

...it is respectfully submitted that the alleged "evidence" that has been submitted to date is not in proper form because (i) the "evidence" is not an Affidavit or Statutory Declaration, and (ii) the "evidence" does not demonstrate use of the registered trade mark in Canada by the registered owner Sena Marketing Inc. at any time during the three year period immediately preceding the date of the Notice of September 20, 2012 with respect to each of the wares specified in the registration.

[12] In compliance with the Registrar's practice notice, *Practice in Section 45 Proceedings*, the Requesting Party's response indicated that the Owner had been sent a copy of its letter.

[13] By way of letter dated August 8, 2013, the Registrar informed the Owner that "no written representations from the requesting party have been received" and invited the Owner to submit its own written representations. On August 14, 2013, by way of letter to the parties, the Registrar clarified that its August 8 letter "should have indicated that the Registrar had received written representations from the requesting party", due to the statements the requesting party made in its response, including that "...the alleged "evidence" that has been submitted to date is not in the proper form...".

[14] Following the Requesting Party's submission regarding the admissibility of the Owner's response, and the Registrar's invitation to submit its own written representations, the Owner provided no further response. As such, the Owner had the opportunity to either submit proper evidence pursuant to section 47(2) of the Act or to make representations regarding the admissibility of its April 2013 response.

Analysis With Respect to Admissibility

[15] I would first note that the Act and the *Trade-marks Regulations* are silent as to the form of affidavits and statutory declarations to be filed in a section 45 proceeding before the Registrar.

As the Registrar has noted before, while it may be desirable for evidence to conform to the *Federal Court Rules*, it is not an obligation [see *Tension 10 Inc v Tension Clothing Inc* (2004), 45 CPR (4th) 136 (TMOB)]. Furthermore, especially in the context of section 45 proceedings – which are intended to be summary and expeditious – the Registrar has frequently considered certain deficiencies in affidavits and statutory declarations to be mere technicalities [see, for example, *88766 Canada Inc v Tootsie Roll Industries Inc* (2006), 56 CPR (4th) 76 (TMOB)].

[16] In this case, however, I agree with the Requesting Party and find that the deficiencies in the Owner’s “evidence” are well beyond mere technicalities. Notwithstanding the stamping of the attached documents by Ms. Desrosiers, the letter and attachments do not appear to be a sworn affidavit or statutory declaration. There is no jurat whatsoever and no statement by Ms. Desrosiers as to whether the statements in Mr. Bannester’s covering letter, such as they are, were sworn in her presence. The fact that the Ms. Desrosiers stamped and initialed the documentation attached to the letter does not in and of itself demonstrate that any statements in the letter would have been sworn or solemnly affirmed before her [see *88766 Canada Inc v 167407 Canada Inc* (2010), 89 CPR (4th) 293 (TMOB) for similar treatment of such deficiencies].

[17] In the absence of submissions from the Owner, it is clear that the response to the section 45 notice in this case is not, in fact, an affidavit or statutory declaration.

[18] In view of the foregoing, I find that the letter with attachments filed by the Owner are inadmissible as evidence in this proceeding and, consequently, that the Owner has failed to demonstrate that the Mark was used in association with the registered wares within the meaning of sections 4 and 45 of the Act.

Analysis With Respect to Use

[19] Even if I were to accept the Owner’s letter and attachments as proper evidence in this proceeding, I would consider it insufficient to demonstrate use of the Mark within the meaning of sections 4 and 45 of the Act.

[20] Again, I note that Mr. Bannester makes no substantive statements in his letter and provides no explanation as to the significance of the attached documentation. As such, the

attachments are left to speak for themselves. At best, the invoice shows a purchase of various SEVEN SISTERS branded shoes from an Irish manufacturer *by* the Owner. However, as there is no evidence of subsequent sales or transfers in Canada, the mere ordering and purchase of such shoes by the Owner does not constitute use of the Mark by the Owner within the meaning of sections 4 and 45 of the Act for purposes of this proceeding.

Disposition

[21] 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