



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

Citation: 2012 TMOB 139
Date of Decision: 2012-07-27

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Bereskin & Parr LLP against registration
No. TMA654,912 for the trade-mark PRAIRIE DAWN
natural bath & body products in the name of Ross
Goodine trading as Prairie Dawn Natural Bath & Body
Products**

[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 July 19, 2010 to Ross Goodine trading as Prairie Dawn Natural Bath & Body Products (the Registrant), the registered owner of registration No. TMA654,912 for the trade-mark PRAIRIE DAWN natural bath & body products (the Mark).

[2] The Mark is registered for use in association with the following wares: (1) lip balm; (2) personal essential oils, aromatherapy spritzers, massage oils; (3) insect repellent.

[3] Section 45 of the 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 specified in 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 such use since that date. In this case, the relevant period for showing use is between July 19, 2007 and July 19, 2010.

[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 the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Registrant filed his own affidavit, sworn on October 18, 2010. The Requesting Party filed written representations and both parties attended an oral hearing.

[7] In his affidavit, Mr. Goodine attests that he licensed his company, Prairie Dawn Natural Body Products Ltd. (the Company) to sell lip balm in association with the Mark during the Relevant Period. He attests that during all material times, he was the sole owner of the Company, directed all of its operations and had direct control over the quality and character of all the goods sold by the Company. However, he furnished no evidence of use with respect to wares (2) and wares (3), and provided no evidence of special circumstances to excuse the absence of use with respect to such wares. The registration will be amended accordingly.

[8] With respect to evidence of use of the Mark in association with “lip balm” during the Relevant Period, Mr. Goodine provides, as Exhibits A and B, pictures of the lip balm sold by the Company in boxes and in individual packages. I note that both packages display the words “Prairie Dawn” above the words “Natural Body Products”. Mr. Goodine attests that the Company’s total sales of such lip balm were \$78,357.94 in 2008, \$68,738.07 in 2009 and more than \$22,000 in 2010 up to July 19, 2010. Attached as Exhibit C are 15 invoices showing sales of various quantities of “lip balm” to various customers in Canada in 2010. Although the Mark does not appear in the description section of the invoices, Mr. Goodine attests that they are representative of sales of the lip balm shown in the Exhibit A and B photos.

[9] As the Requesting Party notes, the trade-mark actually used as shown in the exhibited photographs, “Prairie Dawn Natural Body Products”, differs from the Mark as registered.

However, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I consider the omission of “& bath” from the trade-mark as used to be a minor deviation from the Mark. In my view, the dominant feature in this case is the first portion, PRAIRIE DAWN. As such, the identity of the mark is preserved and the deviation would not, in my opinion, mislead an unaware purchaser.

[10] In view of the foregoing, I am satisfied that there was use of the Mark in association with “lip balm” during the Relevant Period within the meaning of sections 4 and 45 of the Act.

Disposition

[11] 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 wares (2) and wares (3).

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