



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

**Citation: 2014 TMOB 4**  
**Date of Decision: 2014-01-15**

**IN THE MATTER OF SECTION 45 PROCEEDINGS  
requested by Fraser Milner Casgrain LLP against  
registration Nos. TMDA48,747 and TMA435,036 for the  
trade-marks TRU-LOVE & Design and TRU-LOVE in  
the name of JPI Limited**

[1] At the request of Fraser Milner Casgrain LLP, the Registrar of Trade-marks issued notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on February 16, 2012 to JPI Limited (the Registrant) the registered owner of registration Nos. TMDA48,747 and TMA435,036 for the trade-marks TRU-LOVE & Design (the Design Mark) and TRU-LOVE (the Word Mark) (hereinafter referred to together as the Marks). The Design Mark is shown below:



[2] The Marks are registered for use in association with the wares “jewellery”.

[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. The relevant period for showing use in both cases is between February 16, 2009 and February 16, 2012.

[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.

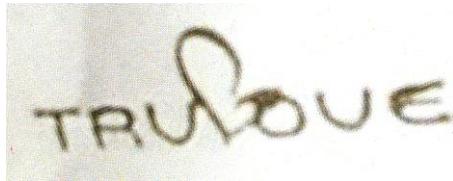
[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance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

[6] In response to the Registrar’s notices, the Registrant filed two essentially identical affidavits of Gus Xillas, the Managing Director for the Registrant, each sworn on May 14, 2012. Only the Requesting Party filed written representations and only the Registrant attended an oral hearing.

[7] In his affidavits, Mr. Xillas attests that the Registrant used the Marks in association with jewellery in Canada during the relevant period. In particular, Mr. Xillas explains that the Registrant produces two styles of rings that display a variation of the Marks; he describes the rings as Style No. J96509RD (Ring A), an 18-karat ring, and Style No. J64941RD (Ring B), a 14-karat ring.

[8] As evidence of sales in the normal course of trade during the relevant period, Mr. Xillas explains that the Registrant sold Ring A and Ring B to a retailer located in Canada, European Jewellery, which in turn sold the rings to consumers in Canada. In this respect, Mr. Xillas provides Exhibits C, D, E and F, which are copies of four invoices from the Registrant to European Jewellery, all dated within the relevant period. The invoices reference the aforementioned style numbers for both rings and I am satisfied that the invoices evidence sales of the wares in Canada during the relevant period.

[9] With respect to the manner in which the Marks were displayed, Mr. Xillas provides Exhibits A and B, which are representative photographs of Ring A and Ring B, respectively. The mark displayed on both rings is shown below (hereinafter referred to as the Modified Mark):



[10] In its written representations, the Requesting Party challenges the evidence as follows: first, that the mark as shown on the wares differs from the Marks as registered; and second, that the Registrant has not provided evidence demonstrating that the depictions of the rings correspond to the style numbers referenced on the invoices.

[11] With regards to the second issue, I am satisfied that Mr. Xillas provides sufficient details of the Registrant's normal course of trade and adequately explains the connection between the depictions of the wares with the evidence of sales in his affidavit. I agree with the Registrant that the evidence shows that it sold jewellery bearing the Modified Mark in Canada during the relevant period.

#### Deviation

[12] With regards to the issue of deviation, generally, the question to be asked is whether the trade-mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [see *Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see if the "dominant features" of the mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. As outlined in *Promafil*:

The law of trade marks does not require the maintaining of absolute identity of marks in order to avoid abandonment, nor does it look to miniscule differences to catch out a registered trade mark owner acting in good faith and in response to fashion and other trends. It demands only such identity as maintains recognizability and avoids confusion on the part of the unaware purchasers. [at 71]

[13] Furthermore, the use of a trade-mark in combination with additional words or features constitutes use of the registered mark if the public, as a matter of first impression, would perceive the trade-mark *per se* as being used [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[14] The test to be applied is set out in *Honeywell Bull, supra*, as follows:

The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin. [at 525]

[15] In summary, while a trade-mark as used may deviate from its registered counterpart, it must retain the dominant features thereof in order to qualify as use of the trade-mark as registered.

Does the Modified Mark displayed on the rings qualify as use of the Word Mark?

[16] Generally, use of a word mark can be supported by the use of a composite mark featuring the word mark and other elements [see *Nightingale, supra*]. As stated in *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393:

As clearly pointed out by the registrant, the trade-mark as registered is a word mark. No particular design or font size was registered. Consequently, in the case of a word mark, use of the trade-mark word or words in any stylized form and in any colour can be considered as use of the registered mark. [at 395]

[17] When specifically considering the embellishment of letters, in *FAAM SpA v Fabrica Italiana Accumulatori Motocarri Montecchio* (2011), 95 CPR (4th) 184 (TMOB) the Registrar concluded as follows:

The trade-mark as used however, differs solely in that the letters F and M have been slightly embellished. I am of the view that this deviation is minor; the dominant features of the mark have been retained to the extent that the deviation would not deceive or injure the public in any way and an unaware purchaser, in spite of the difference, would identify the goods as emanating from the same source. [at para 20]

[18] At the oral hearing, the Registrant submitted that the dominant element of the Modified Mark is the words TRU LOVE with the design elements being minor and consisting only of an embellishment of the letter “L” and a hyphen that may have been omitted or incorporated into the embellished letter. I agree with the Registrant that these constitute minor variations such that use of the Modified Mark qualifies as use of the Word Mark.

[19] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Word Mark within the meaning of sections 4(1) and 45 of the Act in association with “jewellery”.

Does the Modified Mark displayed on the rings qualify as use of the Design Mark?

[20] At the oral hearing, the Registrant submitted that the differences between the Design Mark and the Modified Mark are minor and consists of a difference in font, an embellishment of the letter “L” and a hyphen that may have been omitted or incorporated into the embellished letter. As with the Word Mark, the Registrant argued that the dominant portion of the Design Mark is the words TRU LOVE, which is retained in the Modified Mark. With a tip of the hat to *The Princess Bride*, the Registrant further noted that, when sounded, both marks are pronounced “true love”.

[21] In addition to the jurisprudence set out above, the Registrant cited the following cases where differences between marks as registered and used were considered acceptable: *Brouillette Kosie Prince v Dans un Jardin Inc*, (2008) CarswellNat 375 (TMOB) and *Alibi Roadhouse Inc v Grandma Lee’s International Holdings Ltd* (1997), 76 CPR (3d) 327 (FCTD). Noting the age of the Design Mark (registered in 1930), the Registrant argued that the Modified Mark represents a “natural evolution” of the design and, echoing *Promafil, supra*, submitted that the Registrant engaged in good faith sales of the wares and it would be unfair and unjust to expunge the Design Mark based on minor differences.

[22] In *Alibi Roadhouse, supra*, the Court stated the following when assessing the dominant portion and use of a mark containing several modifications:

The existence of the other design features or ornamentations may make the registered trade-mark more attractive but I do not find that they are dominant

features of the mark. I cannot see how these deviations would cause injury or deception to the public or that they affected the “commercial impression”. [at 340]

[23] Similarly, in the present case, I do not consider the font in the Design Mark to be the dominant feature. The font merely adds to the aesthetic appeal, or presumably did so when it was registered over 80 years ago. With respect to the dark background, while it is incumbent upon a trade-mark owner to ensure that its registration is accurate, given the age of the registration in this case, it is unclear to me whether the background was intended to be a feature of the Design Mark or whether it is the result of a poor quality image and limitations in image reproduction at the time. Although no evidence is before me as to how the Design Mark was used historically, presumably if it were etched on jewellery in a fashion similar to the Modified Mark, the background would not have otherwise appeared. In any event, given the analysis above, this consideration is moot; it is rare that backgrounds consisting of simple geometric shapes as in this case would constitute the dominant feature of a trade-mark. Indeed, the Requesting Party made no reference to jurisprudence that would indicate otherwise.

[24] As such, I do not agree with the Requesting Party’s mere assertion that the Modified Mark appearing on the rings differs “too significantly” from the Design Mark as registered. Rather, I am of the view that the Modified Mark retains the dominant portion of the Design Mark, being the words TRU LOVE. I agree with the Registrant that the embellishment of the letter “L” and the difference in font are relatively minor variations that are cosmetic in nature.

[25] Indeed, as the dominant feature of the Design Mark and the Modified Mark is the words TRU LOVE, I am satisfied that the Modified Mark as displayed on the rings at Exhibits A and B constitutes use of the Design Mark. In my view, the minor differences between the Design Mark as registered and the Modified Mark would not confuse or deceive an unaware purchaser.

[26] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Design Mark within the meaning of sections 4(1) and 45 of the Act in association with “jewellery”.

#### Disposition

[27] Accordingly, pursuant to the authority delegated to me under subsection 63(3) of the Act and in compliance with the provisions of section 45 of the Act, both registrations will be maintained.

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