



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

Citation: 2010 TMOB 135
Date of Decision: 2010-08-25

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Blake, Cassels & Graydon LLP against
registration No. TMA577,822 for the trade-mark
DIAMANTS EN FÊTE in the name of Corona Jewellery
Company Ltd.**

[1] At the request of Blake, Cassels & Graydon LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on August 20, 2008 to Corona Jewellery Company Ltd. (the Registrant), the registered owner of the above-referenced trade-mark registration. The trade-mark DIAMANTS EN FÊTE (the Mark) is registered for use in association with “jewellery” and “retail sale of jewellery” (the Registered Wares and Services).

[2] While not ultimately relevant to my decision, I note that according to the footnotes on the registration page, the Registrant was recorded by the Canadian Intellectual Property Office as the owner of the registration for the Mark on November 14, 2006 following an amalgamation of July 1, 2006 and subsequent change of name of July 12, 2006.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or services 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 any time between August 20, 2005 and August 20, 2008 (the Relevant Period).

[4] “Use” in association with wares is set out in s. 4 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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, s. 4(1) of the Act applies.

[5] “Use” in association with services is set out in s. 4(2) of the Act:

A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Diana Soare sworn October 23, 2008, together with Exhibits “A” and “B”. Ms. Soare states that she is the Marketing Manager of the Registrant. Only the Registrant filed written submissions and no oral hearing was requested.

[7] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing deadwood from the register and as such, the threshold test is quite low. As stated by Mr. Justice Russell in *Uvex Toko Canada Ltd. v.*

Performance Apparel Corp. (2004), 31 C.P.R. (4th) 270:

68. [...] We know that the purpose of s. 45 proceedings is to clean up the “dead wood” on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must “show” how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade mark owners business and merchandising practices.

[8] I will now turn to the evidence introduced by the Registrant.

[9] In her affidavit, Ms. Soare states that the Mark is a valuable trade-mark for the Registrant and it wishes to maintain it. Ms. Soare explains that the ordinary course of trade for the Registrant with respect to the Mark is the seasonal promotion and sale of its jewellery under the Mark. Ms. Soare states that the Registrant has continuously used the Mark since 1996 in association with the Registered Wares and Services. Ms. Soare specifies that the Mark has been used by the Registrant for approximately 12 years in the manner evidenced in her affidavit. Ms. Soare states that the Registrant was continuing to so use the Mark in association with the Registered Wares and Services at the date her affidavit was sworn.

[10] Ms. Soare attaches to her affidavit a brochure produced by the Registrant and dated April 2007 which bears the Mark (Exhibit A). Ms. Soare states that the brochure depicts some of the Registrant's jewellery products which the Registrant offers for sale under the Mark. Ms. Soare states that the sample brochure attached as Exhibit A is typical of brochures bearing the Mark produced by the Registrant and distributed in Canada in recent years, particularly, in 2005, 2006, 2007 and 2008 in order to promote the Registered Services. Ms. Soare also states that in each of the years 2005, 2006 and 2007, a minimum of 200, 000 of these brochures were produced and distributed in Canada by the Registrant. I find that the brochure attached as Exhibit A, along with the evidence which confirms that the Registered Services were offered in Canada during the Relevant Period, is sufficient to evidence use of the Mark in association with the Registered Services during the Relevant Period.

[11] Ms. Soare states that brochures like the one attached as Exhibit A were available at the Registrant's retail store locations and were thus associated with the Registered Wares at the time of sale to consumers. Ms. Soare states that in each of the years 2005, 2006 and 2007, the Registrant printed a modification of the first page of these brochures (i.e. catalogue codes and/or the Registrant's company logo removed) on hardboards which were then placed on counters at the Registrant's retail stores in order to associate the Mark with the Registered Wares at the time of purchase of such wares by consumers in Canada. Ms. Soare attaches a copy of one such "counter card" used for the April 2007 promotion and sale of the Registered Wares in Canada under the Mark. As mentioned above, for the purpose of establishing use of a trade-mark in association with wares pursuant to s. 4(1) of the Act, it must be shown that the mark is either marked on the wares or their packaging or "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”. The Registrant’s evidence establishing that the “counter cards” featuring the Mark are displayed in close proximity to the Wares at the time of purchase (i.e. as point of sale materials) satisfies this requirement [see *Loblaws Ltd. v. Richmond Breweries Ltd.* (1982), 73 C.P.R. (2d) 258 (T.M.O.B.) and *Loblaws Ltd. v. Richmond Breweries Ltd.* (1983), 78 C.P.R. (2d) 236 (T.M.O.B.)].

[12] In her affidavit, Ms. Soare states that in each of the years 2005, 2006 and 2007, the Registrant sold in excess of \$100,000 of jewellery in Canada under the Mark. Ms. Soare states that sales in 2008 continued at similar levels. Ms. Soare states that while the Mark does not appear on the Registrant’s invoices this is because the Mark is not associated directly with particular pieces of jewellery, but rather, it is used with seasonal promotions for the sale of jewellery as illustrated in the brochure Ms. Soare attaches as Exhibit A, and the related “counter card” she attaches as Exhibit B.

[13] To conclude my review of the evidence furnished, there is no question that Ms. Soare’s affidavit clearly evidences the sale of the Registered Wares and Services during the Relevant Period in Canada by the Registrant, the total sales of which were in excess \$100,000 for each of the years 2005, 2006, and 2007.

[14] Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office