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

Citation: 2016 TMOB 1
Date of Decision: 2016-01-04

IN THE MATTER OF A SECTION 45 PROCEEDING

Ridout & Maybee LLP	**Requesting Party**
and	
673367 Ontario Ltd.	**Registered Owner**
TMA731,727 for i watch	**Registration**

[1] On February 14, 2014, at the request of Ridout & Maybe LLP (the Requesting Party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to 673367 Ontario Ltd. (the Owner), the registered owner of registration No. TMA731,727 for the trade-mark "i watch" (the Mark).

[2] The Mark is registered in association with the goods "Men's, ladies' and children's wristwatches, clocks and clip-on watches".

[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 goods 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 February 14, 2011 and February 14, 2014.

[4] The relevant definition of "use" in association with goods is set out in section 4(1) of the Act:

> 4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods 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 goods specified in the registration during the relevant period.

[6] In response to the section 45 notice, the Owner furnished the affidavit of David Weiss, President of the Owner, sworn June 5, 2014. Both parties filed written arguments, but only the Owner was represented at an oral hearing.

The Owner's Evidence

[7] In his affidavit, Mr. Weiss explains that the Owner sells watches in Canada through sales events that are open to the public, most often held in hotel meeting rooms over a two or three-day period. He attests that watches sold at these events include "i watch"-branded watches.

[8] Mr. Weiss states that, in July 2013, the Owner made a purchase from a manufacturer in China that included 800 "i watch"-branded watches. He states that the manufacturer acts as the Owner's agent and manufactures watches based upon the Owner's specifications. He confirms that "the character and quality of all i watch branded watches manufactured were strictly controlled" by the Owner and were manufactured exclusively for the Owner.

[9] In support, attached to his affidavit is an invoice from the Chinese manufacturer dated July 18, 2013 and its corresponding purchase order (at Exhibit C). The purchase order is for 800 "i watch" branded watches. Mr. Weiss also attaches to his affidavit shipping and customs documentation related to the purchase (at Exhibits D and E).

[10] With respect to sales events during the relevant period, Mr. Weiss provides evidence of eight such events. These events occurred between October 6, 2013 and January 13, 2014 in various locations in Ontario, Quebec and British Columbia.

[11] To promote these events, Mr. Weiss attests that the Owner distributed flyers by mail and at the door of the event. Samples of the flyer for each event are attached to his affidavit (at Exhibits F, I, L, O, R, T, W and Z). For example, the Exhibit F flyer advertises a sales event held in Ottawa from October 6 to 8, 2013. The flyer consists mostly of images and specifications for various wristwatches. One of the wristwatches bears the Mark on its face. The same wristwatch appears in each of the other exhibited flyers. Otherwise, I note that the flyers do not refer to "children's wristwatches", "clocks" or "clip-on watches".

[12] In support of his statement that the flyers were distributed by mail, Mr. Weiss attaches invoices from Canada Post corresponding to the delivery of the flyers during the relevant period (at Exhibits G, J, M, P, U, X and AA).

[13] Mr. Weiss also attaches to his affidavit photographs of a wristwatch and a gift box at Exhibit CC. The watch is identical to the "i watch"-branded wristwatch shown in the exhibited flyers. The Mark appears on the front and back of the watch face as well on the box. Mr. Weiss states that the exhibited gift box is the case in which the "i watch"-branded wristwatches were sold during the relevant period.

[14] Mr. Weiss attests that "i watch"-branded wristwatches identical to the one displayed in the exhibited flyers and photographs were sold at each event. He also states that a ladies' version of the watch was sold at each event, noting that aside from being slightly smaller, it was identical in appearance to the watch appearing in the exhibits.

[15] In support of his assertion of sales of "i watch"-branded wristwatches during the relevant period, Mr. Weiss provides copies of bank summaries dated between October 2013 and January

2014 (at Exhibits H, K, N, Q, S, V, Y and BB). He attests that these summaries reflect payments made using credit and debit cards at each sales event Mr. Weiss explains that due to the temporary nature of the events, the Owner did not print receipts or invoices displaying the particular brand of watch sold to each customer. However, he clearly states that the "i watch"-branded wristwatches shown in the exhibited flyers and photographs were sold at the sales events and that the charges included payment for such "i watch"-branded wristwatches. In this respect, he explains that, after the last event in January 2014, only five "i watch"-branded wristwatches remained in the Owner's inventory, the other 795 having been sold at the aforementioned sales events during the relevant period.

Analysis

[16] In its written representations, the Requesting Party notes that the exhibited watch and packaging do not indicate the source of the watches. However, it is not necessary for the goods themselves to indicate their source and the Requesting Party provides no authority in support of its suggestion that this is a requirement. In any event, Mr. Weiss attests to the source of the watches and to the Owner's normal course of trade; his attestations are sufficient in this case.

[17] The Requesting Party also submits that there is no evidence of a single sale of a wristwatch bearing the Mark in Canada. However, while Mr. Weiss only provides summaries of sales from each event, he specifically and clearly states that such sales included sales of "i watch"-branded watches.

[18] In this respect, I note that statements in an affidavit must be accorded substantial credibility in a section 45 proceeding [per *Ogilvy Renault v Compania Roca-Radiadores SA*, 2008 CarswellNat 776 (TMOB)]. Here, Mr. Weiss provides an explanation for the lack of individual invoices from the sales events.

[19] In any event, the absence of invoices is not fatal in a section 45 proceeding [*Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. In this case, Mr. Weiss' statements regarding sales of "i watch"-branded watches, in combination with the evidence showing the manner of display of the Mark on such goods are sufficient.

[20] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with "mens' and ladies' wristwatches" during the relevant period within the meaning of sections 4 and 45 of the Act.

[21] For the reasons below, however, I am not satisfied that the Owner has demonstrated use of the Mark in association with the remaining registered goods.

[22] First, I note that Mr. Weiss' affidavit and supporting exhibits are essentially silent with respect to "clocks", "clip-on watches" and "children's wristwatches".

[23] With respect to "children's wristwatches", at the oral hearing, the Owner asserted that "a watch is a watch, and children wear ladies' watches sometimes". However, having distinguished "children's wristwatches" from "men's wristwatches" and "ladies' wristwatches" in the statement of goods, the Owner is required to produce separate evidence with respect to "children's wristwatches" accordingly [per *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA); *Sharp Kabushiki v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD); *MAPA GmbH Gummi-und Plastikwerke v 2956-2691 Québec Inc*, 2012 TMOB 192, 2012 CarswellNat 4869]. This is not a case where the evidence is representative of a broader category of goods [per *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)]. Rather, the assertion by the Owner that "women's watches" are in fact used by children is insufficient to characterize the "mens' wristwatches" and "ladies' wristwatches" in evidence as being "children's wristwatches". In this respect, nothing in the evidence, including the exhibited flyers, indicate that the "i watch"-branded wristwatches are marketed as children's wristwatches.

[24] With respect to "clocks", at the oral hearing, the Owner stated that it is self-evident that a watch is also a clock. Again, however, having distinguished "clocks" from "wristwatches" in the statement of goods, the Owner is required to produce separate evidence with respect to "clocks" accordingly [per *John Labatt, supra; Sharp, supra* and *MAPA, supra*]. The assertion that "a watch is a clock" is insufficient to characterize the "mens' wristwatch" and "ladies' wristwatch" in evidence as being "clocks".

[25] The same reasoning applies for "clip-on watches". Indeed, nothing in the evidence indicates that the Owner sold "clip-on watches" in association with the Mark or otherwise.

[26] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with "clocks", "clip-on watches" and "children's wristwatches" during the relevant period within the meaning of sections 4 and 45 of the Act.

Disposition

[27] 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 "clocks", "clip-on watches" and "children's wristwatches".

[28] The amended statement of goods will be as follows: "Mens' and ladies' wristwatches."

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

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

Hearing Date: 2015-10-05

Appearances

Shane Hardy	For the Registered Owner
No one appearing	For the Requesting Party

Agents of Record

Cassels Brock & Blackwell LLP	For the Registered Owner
Low Murchison Radnoff LLP	For the Requesting Party