



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

**Citation: 2015 TMOB 223**  
**Date of Decision: 2015-12-11**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Borden Ladner Gervais LLP**

**Requesting Party**

**and**

**Garbo Group Inc.**

**Registered Owner**

**TMA438,539 for ELEMENTS**

**Registration**

[1] On September 4, 2013, at the request of Borden Ladner Gervais 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 Garbo Group Inc. (the Owner), the registered owner of the trade-mark ELEMENTS (the Mark).

[2] The Mark is registered in association with the following goods: “Jewellery, hair accessories, and sunglasses.”

[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 September 4, 2010 and September 4, 2013.

[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] In response to the section 45 notice, the Owner furnished the affidavit of Gary Grundman, President of the Owner, sworn on April 2, 2014 in Toronto, Ontario. Both parties filed written representations; an oral hearing was not requested.

### The Owner's Evidence

[6] In his brief affidavit, Mr. Grundman attests that, as President of the Owner, he has personal knowledge of the use of the Mark in Canada by the Owner and its licensee, iWear Inc. He explains that when an order is received by the Owner, it creates a "picking slip" and sends that slip to its warehouse for processing – which includes picking, packing and shipment to the customer. Based on the evidence described below, it would appear that such orders are for various types of jewellery only.

[7] However, Mr. Grundman attests that the Owner also licences the Mark to iWear Inc. He confirms that the Owner maintains care and control of the nature and quality of all goods sold in association with the Mark. As described below, the evidence indicates that iWear only sells sunglasses in association with the Mark.

[8] In support of his assertion of use with respect to all of the registered goods, Mr. Grundman attaches the following exhibits to his affidavit:

- Exhibit A consists of three picking slips and corresponding invoices regarding sales of goods from the Owner to The Bargain Shop, addressed in Ontario. While Mr. Grundman asserts that the invoices show sales of "earrings, necklaces, bracelets and assorted fashion/hair accessories bearing the ELEMENTS trade-mark", neither of the invoices dated within the relevant period reference "hair accessories". Rather, the items are described as "fashion bracelets", "fashion necklaces" and "fashion earrings". The invoice dated March 2010, prior to the relevant period, simply refers to "Asst Junior Fashion".

- Exhibit B consists of four iWear order forms and their corresponding invoices with respect to goods sold by iWear to a Canadian customer. Three of the order forms and their corresponding invoices are dated within the relevant period. The order forms are each handwritten, and have various descriptions of the goods, including: “Branded Adults”, “Non-Branded Adults”, “Adult Brand Name Sunglasses”, “Assorted branded SUNS” and “Assorted nonbranded SUNS”. For some of the descriptions, “Element” or “Elements” appears to have been added to the item description.

Mr. Grundman attests that all of the invoices show sales of sunglasses during the relevant period. The invoices have various descriptions of the goods, including: “Branded Kids”, “Non Branded Kids”, “Adult Brand Name S/G”, “Adult No Name S/G” and “Adult Brand Name”. However, the Mark does not appear on any of the invoices.

- Exhibit C consists of photographs of various goods that Mr. Grundman attests were sold in Canada during the relevant period. Although Mr. Grundman does not clearly identify the goods, the photographs appear to show the back and front of six packages of various types of jewellery and the back and front of a pair of sunglasses with an attached tag. The packages and tag display the Mark.

If any of the depicted jewellery is in the nature of a “hair accessory”, it is not clear from Mr. Grundman’s statements or the exhibits themselves.

[9] Lastly, Mr. Grundman attests that sales of goods in association with the Mark exceeded \$135,000 between 2010 and 2013. However, he does not provide a breakdown of this figure with respect to each of the registered goods.

#### Analysis - Jewellery

[10] With respect to the registered good “jewellery”, the Requesting Party submits that the invoices and picking slips at Exhibit A do not demonstrate use of the Mark during the relevant period because the Mark does not appear on the invoices.

[11] However, the evidence as a whole must be considered [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)] and the invoices must be considered together with Mr. Grundman’s attestations. In this case, Mr. Grundman states that

the Exhibit A invoices are representative of sales of “earrings, necklaces, bracelets ... bearing the ELEMENTS trade-mark sold in Canada” and shows examples of such goods at Exhibit C. Accordingly, I am satisfied that the goods appearing in the Exhibit C photographs correspond to the goods indicated as being sold in the Exhibit A invoices.

[12] In any event, the Requesting Party also submits that the Exhibit C photographs show “cheap adornments” that do not qualify as the registered goods “jewellery”. However, the Requesting Party provides no authority in support of its narrow definition of what constitutes “jewellery”, and I see no reason to consider the earrings, necklaces and bracelets depicted in Exhibit C as other than “jewellery”.

[13] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with “jewellery” during the relevant period within the meaning of sections 4 and 45 of the Act.

#### Analysis - Sunglasses

[14] With respect to “sunglasses”, the Requesting Party alleges various deficiencies with the Exhibit B invoices. For example, it notes that none of the invoices bear the Mark and that where the Mark appears on the order forms, it is handwritten, suggesting it does not form part of the original document. As well, it submits that the repeated reference to ‘non-branded’ or ‘no name’ products on the documents “renders it difficult to accept the goods in question were actually branded with the registered mark.” The Requesting Party further submits that the Exhibit C photographs display “samples” and not the goods as actually sold.

[15] Again, however, the evidence must be considered as a whole. Furthermore, 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)]. Although the goods are not clearly identified on the invoices themselves, Mr. Grundman attests that the invoices show sales of sunglasses bearing the Mark, and further provides *examples* of such sunglasses at Exhibit C.

[16] As such, I am satisfied that the sunglasses appearing in the Exhibit C photographs correspond to the goods referred to in the Exhibit B invoices. Again, the Mark is prominently displayed on the label attached to the sunglasses. Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with “sunglasses” during the relevant period within the meaning of sections 4 and 45 of the Act.

#### Analysis – Hair Accessories

[17] With respect to the registered goods “hair accessories”, however, I am not satisfied that the Owner has demonstrated use of the Mark. As mentioned above, in his affidavit, Mr. Grundman does not provide a breakdown of the \$135,000 in sales to show what portion, if any, was for “hair accessories”. While Mr. Grundman asserts that the Exhibit A invoices show sales of “assorted fashion/hair accessories”, as noted above, the invoices themselves only indicate “fashion bracelets”, “fashion necklaces” and “fashion earrings”; the invoices do not reference “hair accessories” or the like.

[18] Furthermore, if any of the goods shown in the Exhibit C photographs constitute “hair accessories”, this is not apparent from Mr. Grundman’s statements or the exhibits themselves. Mr. Grundman did not identify or attest that any of the photographs contained an image of a “hair accessory”. Although he asserts that the Mark was used in association with all of the registered goods, the exhibits are silent with respect to “hair accessories”.

[19] Nonetheless, the Owner submits that the registered owner of a trade-mark “is not required to provide evidence of use of every specific item within a general category of wares” in order to maintain its registration. The Owner states that, in this case, evidence of use of the Mark in association with “jewellery” can be sufficient as evidence of use in relation to “hair accessories” [citing *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FCTD)].

[20] First, given that there are only three registered goods, it is not clear why the Owner could not furnish evidence of at least one invoice from the relevant period referencing hair accessories or at least one photograph depicting a hair accessory with the Mark.

[21] In any event, 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.

[22] In the present case, sufficient facts have not been provided to permit me to conclude that the Mark was used in association with “hair accessories”. As previously stated, there is no evidence of sales of the aforementioned goods, nor are any such goods depicted in the evidence; thus, I have no basis to conclude that use of the Mark occurred or extended to “hair accessories” as well.

[23] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with “hair accessories” within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence of special circumstances excusing such non-use before me.

#### Disposition

[24] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended in compliance with the provisions of section 45 of the Act to delete “hair accessories”. The amended statement of goods will be as follows: “Jewellery and sunglasses.”

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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**

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No Hearing Held

AGENTS OF RECORD

Johnston Law

For the Registered Owner

Borden Ladner Gervais LLP

For the Requesting Party