



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

Citation: 2014 TMOB 145
Date of Decision: 2014-07-16

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Macrae & Co. against registration
No. TMA213,806 for the trade-mark PRESTIGE in the
name of 1373639 Alberta Ltd.**

[1] On March 29, 2012, the Registrar of Trade-marks (the Registrar) issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to 1373639 Alberta Ltd. (the Owner) at the request of Macrae & Co. (the Requesting Party). The notice required the Owner to furnish evidence showing that the trade-mark PRESTIGE (the Mark) was used in Canada in association with each of the wares listed in the registration, at any time between March 29, 2009 and March 29, 2012.

[2] The Mark is registered for use in association with the following wares: (1) mattresses and matching foundation; (2) bed pillows.

[3] The relevant definition of use is set out in section 4 of the Act as follows:

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.

[4] 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 an owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[5] In response to the notice, the Owner furnished the affidavit of Ms. Ketty-Ann Cournoyer, the Associate Vice President, Home Decor for Sears Canada Inc, sworn on October 22, 2012. Only the Owner filed written representations. An oral hearing was not held.

[6] In her affidavit, Ms. Cournoyer attests that Sears uses the Mark pursuant to a license agreement with the Owner, stating that the Owner “exercises direct or indirect control of the character or quality of the wares distributed and sold in Canada by Sears in association with [the Mark].” In particular, she attests that Sears distributed and sold bed pillows in association with the Mark in Canada during the relevant period in its retail stores.

[7] In support of her assertion, Ms. Cournoyer furnished two exhibits. Exhibit A consists of two photos of packaging for a “down pillow”. Ms. Cournoyer attests that this packaging is representative of the packaging in which Sears sold bed pillows during the relevant period. I note that the Mark is displayed prominently on the packaging.

[8] Exhibit B consists of 26 sales receipts from the relevant period. The receipts show sales of product #43145, which Ms. Cournoyer attests corresponds to the bed pillow shown in Exhibit A. She further attests that Sears sold more than 1600 PRESTIGE bed pillows in Canada in 2011 and a further 1250 from January to March 2012.

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

[10] With respect to wares (1), mattresses and matching foundation, Ms. Cournoyer’s affidavit is silent and the Owner made no representations regarding use of the Mark in association with such wares. As there is further no evidence of special circumstances excusing non-use, the registration will be amended to delete wares (1) accordingly.

Disposition

[11] In view of the foregoing and 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 the following wares: “mattresses and matching foundation”.

[12] The amended statement of wares will be as follows: “Bed pillows”.

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