

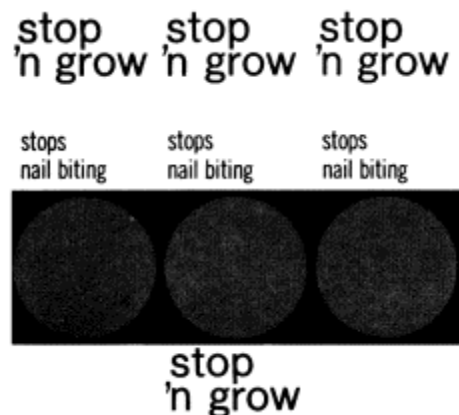
LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 90
Date of Decision: 2010-06-28

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Fasken Martineau DuMoulin LLP against
registration No. TMA162,143 for the trade-mark STOP'N
GROW & Design in the name of Mansfield Medical
Distributors Ltd.**

[1] At the request of Fasken Martineau DuMoulin 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 November 6, 2007 to Mansfield Medical Distributors Ltd. (the registrant), the registered owner of the above-referenced trade-mark registration.

[2] The trade-mark STOP'N GROW & Design shown below (the Mark) is registered for use in association with “nail biting deterrent preparations” (the registered wares).



[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 November 6, 2004 and November 6, 2007 (the relevant period).

[4] “Use” in association with wares is set out in s. 4(1) and (3) 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) applies.

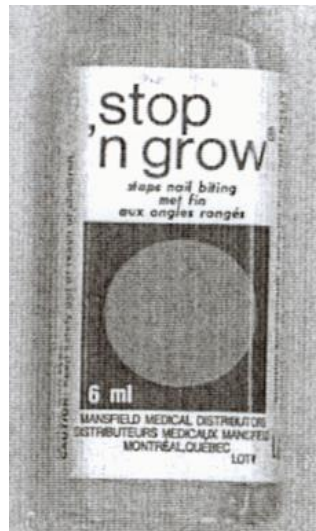
[5] In response to the Registrar’s notice, the registrant furnished the affidavit of Irwine Braude together with Exhibits “A” through “K”. Mr. Braude states that he is the President of the registrant. Both parties filed written submissions; an oral hearing was held where only the requesting party was represented.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of s. 45 proceedings [*Plough (Canada) Ltd v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required [*Union Electric Supply Co. Ltd. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares or services specified in the registration during the relevant period.

[7] With respect to the manner in which the Mark was associated with the registered wares, Mr. Braude explains that the Mark represents three panels which appear on the front and both sides of the liquid nail biting deterrent products packaged in 6ml square bottles. He further states the following in paragraph 7 of his affidavit:

Each product sold by Mansfield [the registrant] is marked with the registered trade-mark, the only difference being that the mark used on the product consists of only the front panel (not the side panels) and is therefore only visible from the front of the product, and the mark as used now also includes the wording “met fin aux ongles rongés” (the French equivalent of “stops nail biting”). With the mark only being visible from the front of the product, the side panelling of the product bottle is now used to provide the consumer with instructions for use and product warnings in both English and French.

[8] In support, a sample bottle of the registered wares is attached as Exhibit “B”. The following design appears on the front panel with instructions and warnings appearing on the side panels of the label in English and French:



[9] The requesting party expressed several concerns regarding the sample use provided even though it explained during the oral hearing that it did not take issue with the addition of the French expression “met fin aux ongles rongés” in the trade-mark as used. First, in its written arguments, the requesting party contended that Mr. Braude’s description of the Mark is “false and misleading as nothing in the registration substantiates that the registration is for a three-

dimensional mark or a two-dimensional mark applied to a three-dimensional object”. Second, it argued that the design as seen on the sample bottle contain “more than minor differences” with the Mark as registered. Specifically, “each of the rectangle, the three circles and the repetition of the wording are prominent features of the Trade-mark”. Third, during the oral hearing, the requesting party made references to several sections of the Act and the *Trade-marks Regulations* to reaffirm its position elaborated in its written arguments that “it is the entire mark that is the subject of the registration, not just one square on which is affixed one circle with the words ‘stop ’n grow’ appearing only once above the square”.

[10] In response, the registrant submitted in its written arguments that the modifications of the Mark are insignificant and that the “modern mark” retains all the dominant features in such a way that the impression left on the unaware purchaser is the same as that created by the Mark. In particular, the dominant features remain the words “stop ’n grow” written in bold lower case lettering on 2 lines, the words “stops nail biting” written in smaller lower case, and a solid red circle against a black background.

[11] On the topic of deviations of the trade-mark as registered, the Court made the following observations in *Promafil Canada Ltée. v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.):

Obviously, with every variation the owner of the trade mark is playing with fire. In the words of Maclean P., “the practice of departing from the precise form of a trade-mark as registered... is very dangerous to the registrant”. But cautious variations can be made without adverse consequences, if the same dominant features are maintained and the differences are so unimportant as not to mislead an unaware purchaser.

[...] 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 unaware purchasers.

[12] The test elaborated in *Registrar of Trade Marks v. Cie Internationale pour l’Informatique CII Honeywell Bull* (1985), 4 C.P.R. (3d) 523 (F.C.A.) is explained by the Federal Court of Canada in *Marks & Clerk v. Sparkles Photo Ltd.* (2005), 41 C.P.R. (4th) 236 at 247 as follows:

The test for whether an owner is using the trade-mark as registered is whether it is used in such a way that it does not lose its identity and remains recognizable, whether the differences are so unimportant that an unaware purchaser would be likely to infer that both identify goods having the same origin [...].

[13] The assessment as to which elements are the dominant features and whether the deviation is minor so as to permit a finding of use is a question of fact to be determined on a case-by-case basis. In the present case, I am of the opinion that when viewed as a whole, as a matter of first impression, the Mark remains recognizable and maintains its identity in the sample use provided. While I am mindful that it is the entire design that is the subject of the trade-mark registration, I agree with the registrant that the trade-mark as used has retained all of the dominant features of the Mark. In my view, an appreciation of the Mark reveals a combination of the following dominant features: the expressions “stop ‘n grow” and “stops nail biting”, the presence of a large circle inside a four-sided plane figure below these words, and the general positioning of these elements. Despite the fact that these elements are no longer shown repeatedly in the trade-mark as used, I am satisfied that these are unimportant changes and that all of the dominant features have been preserved in the design seen on the sample bottle. The “modern mark” appears to be a simplified version of the Mark; when viewed as a whole, the differences cannot be said to be so important that the Mark has lost its identity or that it is no longer recognizable. The impression created by the dominant features remains the same; the unaware purchaser would not be likely to infer that the goods have different origins based on these specific variations. Consequently, I am satisfied that that the Mark appeared on the registered ware’s packaging during the relevant period.

[14] In terms of the registrant’s normal course of trade and its sales, Mr. Braude explains that the registrant sells the nail biting deterrent preparation to several customers located in Canada, mostly pharmacies who in turn sell them to end-users. He adds that the customers are able to place their orders directly with the registrant’s in-field sales representatives, by phone or by fax, or through various wholesalers who purchase the product from the registrant. The affiant provides that the registrant has sold over six thousand units of the registered wares from November 2005 to October 2006, and over five thousand units from November 2006 to October 2007. In support, copies of product sales report for those periods are attached as Exhibits “D” and “E”. Furthermore, copies of sample invoices dated between August and October 2007 are

attached as Exhibits “F” to “K”, representative of the sales of the registered wares during the relevant period. I note that the registrant’s name and its Canadian contact information appear at the top of the sample invoices, followed by the Canadian billing and shipping addresses of the purchasers below. The notation “STOP ‘N GROW” can also be seen in the item descriptions of the invoices. Consequently, I am satisfied that the evidence shows the sales of the registered wares bearing the Mark by the registrant in the normal course of trade in Canada within the relevant period.

[15] In view of the foregoing, I am satisfied that there was use of the Mark within the meaning of s. 45 and 4(1) of the Act on “nail biting deterrent preparations” during the relevant period. Accordingly, and pursuant to the authority delegated to me under s. 63(3) of the Act, registration No. TMA162,143 for the trade-mark STOP’N GROW & Design will be maintained in compliance with the provisions of s. 45 of the Act.

P. Fung
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office