

SECTION 45 PROCEEDINGS
TRADE-MARK: SR
REGISTRATION NO: TMA 353,486

On November 16, 2004, at the request of Riches, McKenzie & Herbert LLP (the “requesting party”), the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) to Semir Isin, the registered owner of registration No. TMA 353,486 for the trade-mark SR (the “Mark”). The Mark is registered for use in association with “Baq[g]ues, boucles d'oreilles, breloques, collier, bouton-épingles, bracelets, pendentif porte-pièce, pince à cravate, porte-clés, broches, chaines”.

[TRANSLATION] “Rings, earrings, charms, necklaces, pin buttons, bracelets, coin frame pendants, tie clips, key chains, brooches, chains”.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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 wares and/or services listed on 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 use since that date. In this case, the relevant period for showing use is any time between November 16, 2001 and November 16, 2004.

“Use” in association with wares is set out in subsections 4(1) and 4(3) of the *Trade-marks Act*:

- (1) A trade-mark is deemed to have been 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 use in Canada in association with those wares.

In this case only subsection 4(1) of the *Act* applies.

As a preliminary matter, it is worth mentioning that when the notice prescribed by Section 45 was sent to the registered owner on November 16, 2004, no response was received and the mark was automatically expunged. Following a determination that the notice had been sent to the incorrect address, the registration was reinstated pursuant to Rule 33(1)(a) of the *Trade-marks Regulations*. The registered owner was required to comply with the requirements of Section 45 of the *Act* set out in the initial notice; the requesting party queried this decision, and was advised that the Registrar's decision was final in this matter.

In response to the Registrar's notice, the registered owner furnished the affidavit of Mr Semir Isin, owner of the trade-mark, who subsequently requested and was granted a retroactive extension of time pursuant to subsection 47(2) of the *Act* to file a supplementary affidavit. Both the requesting party and the registered owner filed written arguments. Neither party requested an oral hearing.

In his initial affidavit, Mr Isin explains that he has been in business under his sole proprietorship since 1987 and trades under the following trading styles: Bijouterie Isin or Isin Jewellery. His business creates and manufactures jewellery according to the demand of his clients, some of whom require specific items to be made while others request items from his catalogue. His clients include jewellers, pharmacies, wholesalers and other businesses who subsequently sell the goods at the retail level or to tourist shops. He states that during the past three years he has manufactured and/or sold all of the wares listed in the registration.

In the initial affidavit, Mr Isin states that he is not in a position to furnish precise dates regarding use since it is difficult for him to say at what moment a certain good was manufactured because his business does not manufacture large quantities of goods and business is variable. In the supplementary affidavit, however, Mr Isin produces eight invoices showing sales of jewellery, four of which are dated during the relevant period and four of which are dated subsequent to the relevant period, all showing sales by Isin Jewellery to companies in Canada. Based on this evidence, I am prepared to conclude that there has been sale of jewellery by the registered owner during the relevant period in Canada.

I turn now to the issue of association of the Mark with the wares at the time of transfer. Mr Isin has stated that all the wares were stamped with the Mark along with the karats or sterling value; when the items are too small the Mark appears on the clasp. He also states that he uses moulds to manufacture the jewellery and that the Mark also appears on these moulds. In his supplementary affidavit, Mr Isin attaches a photocopy of two photographs of moulds used to manufacture the jewellery; the moulds appear to be placed beside the pieces of jewellery made from the corresponding moulds. He states that the moulds and pieces of jewellery feature the Mark. Perhaps due to the quality of the reproduction of the photographs, I am unable to locate the mark on either the moulds or the jewellery featured in this exhibit. Mr Isin also produces a sworn letter from its client Bijouterie Marsan that states that all jewellery it purchased in the past and up until the present time (letter dated December 29, 2005) from Mr Isin featured the Mark. A second letter from its client National Jewellery Boutique has also been provided which supports the claim made in the Bijouterie Marsan letter; however, the letter appears to be a certified copy with no jurat and as such I have accorded it little weight. An unsworn letter from Coulage Malek Casting Inc. has been provided stating that the moulds feature the Mark; however I have disregarded it since it constitutes hearsay.

The requesting party, in its written argument, submits that it is not clear that the pieces depicted in the photograph, or that the jewellery referred to in the invoices are those listed in the registration. The requesting party further suggests that while the Mark may be

imbedded in the moulds, it is immaterial since the registered owner has not obtained registration of the mark in association with moulds.

Based on the evidence before me, I am prepared to conclude that wares bearing the Mark were transferred in the normal course of trade. While the photographs do not show that the wares were stamped with the Mark (which may be due to the poor quality of the reproduction), I consider the affiant's sworn statement, together with the sworn statement of its client to the effect that the wares all bore the Mark, to be persuasive.

Turning now to the issue of whether use has been shown in association with all the wares listed in the registration during the relevant period, I note that the invoices only list sales of "assorted jewellery". In his first affidavit, Mr Isin states that he has manufactured and/or sold all of the wares listed in the registration; although he does not specify that all wares were *sold* during the relevant period, the sworn letter by Bijouterie Marsan states that the registered owner still uses its Mark today on an assortment of items, which he enumerates as [TRANSLATION] "earrings, necklaces, chains, key chains, bracelets, charms, brooches, tie clips, pin buttons, rings and coin frame pendants". I note these wares match those listed in the registration. It also states that all the jewellery that they have purchased in the past and up until now has always featured the Mark. While the evidence is not overwhelming in this case, considering that the evidence must be viewed as a whole rather than focusing on individual pieces (*Kvas Miller Everitt v. Compute (Bridgend) Limited* (2005), 47 C.P.R. (4th) 209 at 213 [TMOB]), I am prepared to infer that the wares referred to in the letters correspond to the jewellery listed on the invoices and that such wares were sold during the relevant period.

In view of all the foregoing, it is my conclusion that registration no. TMA 353,486 for the trade-mark SR ought to be maintained in compliance with the provisions of subsection 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 6TH DAY OF MARCH 2008.

C. Laine

Junior Section 45 Hearing Officer

Trade-marks Opposition Board