



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

Citation: 2017 TMOB 42
Date of Decision: 2017-03-24

IN THE MATTER OF A SECTION 45 PROCEEDING

**Norton Rose Fulbright Canada
LLP/S.E.N.C.R.L., s.r.l.**

Requesting Party

and

**Wubbies World International
Incorporated**

Registered Owner

TMA377,885 for WUBBIES

Registration

[1] At the request of Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., s.r.l. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on December 29, 2014, to Wubbies World International Incorporated (the Owner), the registered owner of registration No. TMA377,855 for the trade-mark WUBBIES (the Mark).

[2] The Mark is registered for use in association with the following goods: “Clothing namely, shorts, shirts, T-shirts, pants, pajamas, jackets, blouses and hats; footwear namely, running shoes and slippers; plush toys.”

[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 the trade-mark was last used and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between December 29, 2011 and December 29, 2014.

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

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 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 [*John Labatt Ltd v Rainer Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar’s notice, the Owner furnished the affidavits of John Martin Mokrenko and Carrie Anne Bennie, both sworn on July 28, 2015. Both parties filed written representations, but only the Owner was represented at an oral hearing, held jointly with respect to the summary cancellation proceeding for registration No. TMA535,841 (WITTLE WUBBIES). A separate decision will be issued with respect to that proceeding.

The Owner’s Evidence

[7] In his affidavit, Mr. Mokrenko attests that he has been President of the Owner since its inception in 1987. He states that the Owner has continuously sold plush toys and clothing that display the Mark since at least as early as 1990.

[8] With respect to the relevant period, he attests that the Owner sold WUBBIES plush toys and related clothing goods to “Sweet Molly’s”, a retailer located in Acton, Ontario. In support, attached to his affidavit are the following exhibits:

- Exhibit A consists of three purchase orders from Sweet Molly’s addressed to the Owner,

all dated within the relevant period. In addition to “Wittle Wubbies Plush Toys”, the purchase orders include the following items in various quantities: “Wubbies Large Plush Toys”, “Wubbies T-Shirts” and “Wubbies Hats”.

Although Mr. Mokrenko appears to attest that the purchase orders included “running shoes”, none of the items listed on the exhibited orders are for shoes or the like.

- Exhibit B consists of eight photographs of plush toys. Visible in some of the photographs are labels affixed to the plush toys that display the Mark.
- Exhibit C consists of six photographs. The first two photographs depict baseball caps that show the Mark on the front of the hat as well as on a label affixed to the hat. The next two photographs depict t-shirts, showing the Mark displayed on the front of the shirts as well as on labels affixed to the shirts. One of those photographs also shows a pair of shorts that displays the Mark on the pant leg. The last two photographs show WUBBIES plush toys as well as a cardboard shipping box bearing the Owner’s name.

[9] Mr. Mokrenko confirms that the plush toys and clothing items appearing in Exhibits B and C are representative of the goods sold pursuant to the Exhibit A purchase orders. He attests that the purchase orders were “duly fulfilled”, such that the Owner delivered the ordered goods “between May 20, 2012 and October 30, 2014” and was paid in full by Sweet Molly’s.

[10] Mr. Mokrenko also states that the Owner and Sweet Molly’s “are and have always been independent, arm’s length parties, having no shared ownership ties, and otherwise have no relationship to each other.”

[11] In her affidavit, Ms. Bennie identifies herself as the Owner of the Sweet Molly’s retail store, located in Acton, Ontario. She attests that Sweet Molly’s has purchased plush toys and certain clothing goods from the Owner “continuously” from at least as early as 2010, for subsequent sale to Sweet Molly’s customers. Attached to her affidavit are the aforementioned purchase orders (at Exhibit A) as well as the same aforementioned photographs of WUBBIES plush toys, hats, t-shirts and shorts (at Exhibit B). She confirms that the purchase orders were “duly fulfilled” by the Owner and that Sweet Molly’s paid the Owner in full.

Analysis

[12] In its written representations, the Requesting Party first submits that the affidavits are inadmissible. In this respect, it argues that the jurats in both affidavits are “incomplete in that the name of the alleged Commissioner for Oaths is not specified, his or her signature is illegible, and there is no seal or other indication disclosing the name and status of the person” before whom the affidavits were sworn. Similarly, the Requesting Party questions the admissibility of the supporting exhibits, “as they were not properly notarized”.

[13] In response, the Owner “vehemently disagrees”, suggesting that the Requesting Party’s written submissions “demonstrate the Requesting Party’s unfamiliarity and/or ignorance of the laws governing the commissioning of affidavits in Ontario”. The Owner goes so far as to provide a summary of the applicable law in Ontario and refers, in particular, to the *Commissioners for Taking Affidavits Act*, R.S.O. 1990, c. C.17 and the regulations thereof.

[14] I first note that it is well established that technical deficiencies in an affidavit should not be a bar to a successful response to a section 45 notice where there is sufficient evidence to conclude the trade-mark was in use [see, for example, *Baume & Mercier SA v Brown carrying on business as Circle Import* (1985), 4 CPR (3d) 96 (FCTD) and *Bereskin & Parr v 3056678 Canada Inc* (2004), 34 CPR (4th) 566 (TMOB)].

[15] In any event, suffice to say, I agree with the Owner that both affidavits appear to have been properly commissioned in accordance with applicable laws. As such, I see no reason to revisit the Registrar’s decision to make the subject affidavits of record in this proceeding.

[16] The Requesting Party also argues that the evidence fails to establish use of the Mark “in the normal course of trade”. It submits that the evidence “falls short of explaining what is the normal course of trade” of the Owner, noting in part the lack of detail regarding the Owner’s “sales process, distribution network etc.” It questions the lack of significant sales during the relevant period, further suggesting that it is “bizarre” that the Owner furnished “purchase orders instead of its own invoices for the alleged sales”.

[17] Lastly, the Requesting Party submits that Ms. Bennie’s affidavit “simply contains a bare statement that the goods were delivered and paid”, apparently suggesting that, if such actions did

in fact occur, they did not necessarily occur during the relevant period.

[18] On this point, while Ms. Bennie does not clearly specify the timing of delivery, as noted above, Mr. Mokrenko does confirm that delivery occurred during the relevant period for all of the ordered goods. Despite the alleged inconsistencies between the affidavits, in view of the evidence as a whole and the dates of the purchase orders in particular, I do not consider it a reasonable inference that the subject purchase orders were “duly fulfilled” at some point *after* the relevant period.

[19] Furthermore, it is well established that invoices are not necessary to successfully respond to a section 45 notice. For the purposes of section 45 of the Act, use can be demonstrated without providing invoices, and the Registrar should not view an affidavit without invoices as “presumptively useless” [per *Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD) at para 9].

[20] Indeed, evidentiary overkill is not required in a section 45 proceeding; the registered owner must simply establish a *prima facie* case of use of the trade-mark in association with each of the goods specified in the registration [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428].

[21] In this case, the fact that the Owner appears to have exclusively sold its WUBBIES goods to a single retail establishment during the relevant period does not vitiate the fact that the evidenced sales themselves appear to form a pattern of genuine commercial transactions in the normal course of trade.

[22] Here, the exhibits include photographs of the plush toys, t-shirts and hats bearing the Mark and both affiants confirm that such appearance is representative of the goods sold during the relevant period. For purposes of section 45 of the Act, this is sufficient.

[23] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with plush toys, t-shirts and hats within the meaning of sections 4 and 45 of the Act.

[24] With respect to the remaining clothing and footwear goods, I agree that the evidence is insufficient to establish a *prima facie* case of use of the Mark. Although Mr. Mokrenko attests

that the exhibited purchase orders were for the sale of “running shoes”, this is not reflected in the purchase orders themselves and none of the exhibited photographs show any type of shoe.

[25] As well, although one of the exhibited photographs depicts a pair of shorts displaying the Mark, such goods are not listed on any of the exhibited invoices and neither affiant clearly attests to sales and transfers of such goods during the relevant period.

[26] With respect to the remaining clothing and footwear goods listed in the registration, there is no evidence before me of use of the Mark during the relevant period or otherwise, nor is there evidence of special circumstances excusing such non-use. The registration will be amended accordingly.

Disposition

[27] In view of all of the foregoing, 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 the following from the statement of goods: “... shorts, shirts, ..., pants, pajamas, jackets, blouses ...; footwear namely, running shoes and slippers...”.

[28] The amended statement of goods will be as follows: “Clothing, namely, T-shirts and hats; plush toys”.

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: 2016-12-02

Appearances

David J. Schnurr For the Registered Owner

No one appearing For the Requesting Party

Agents of Record

David J. Schnurr (Miller Thomson LLP) For the Registered Owner

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., s.r.l. For the Requesting Party