



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

Citation: 2017 TMOB 43
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

TMA535,841 for WITTLE 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. TMA535,841 for the trade-mark WITTLE WUBBIES (the Mark).

[2] The Mark is registered for use in association with the goods “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. TMA377,885 (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 in association with the Mark since at least as early as 2000.

[8] With respect to the relevant period, he explains that the Owner sold WITTLE WUBBIES plush toys 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. Mr. Mokrenko confirms that these orders were with respect to the sale of plush toys bearing the Mark. Indeed, all three orders include large quantities of "Wittle Wubbies Plush Toys".

- Exhibits B and C are photographs of plush toys in clear plastic bags. The labels on the back of the plush toys clearly display the Mark. Mr. Mokrenko confirms that the plush toys sold pursuant to the Exhibit A purchase orders were in the same form as depicted in these exhibits.

[9] Mr. Mokrenko attests that the purchase orders were “duly fulfilled”, such that the Owner delivered the goods “between May 20, 2012 and October 30, 2014” and was paid in full by Sweet Molly’s.

[10] He 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. Attached to her affidavit are the aforementioned purchase orders (Exhibit A) and photographs of WITTLE WUBBIES plush toys (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 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 is, 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, noting further that it is "bizarre" that the Owner furnished "purchase orders instead of its own invoices for the alleged sales especially when the purchase orders indicate that it is a requirement for the supplier to send two copies of invoices to Sweet Molly's".

[17] The Requesting Party also points out that the Owner did not furnish "any photos of the goods at point of sales".

[18] 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.

[19] 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. 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.

[20] 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].

[21] 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].

[22] In this case, the fact that the Owner appears to have exclusively sold its 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.

[23] Lastly, the exhibits include photographs of the goods 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.

[24] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with “plush toys” within the meaning of sections 4 and 45 of the Act.

Disposition

[25] 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 maintained.

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