



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 60

Date of Decision: 2019-06-25

IN THE MATTER OF SECTION 45 PROCEEDINGS

Sim & McBurney

Requesting Party

and

Gayle Gordon

Registered Owner

**TMA631,952 for LOVE-KNOT and
TMA599,853 for FORGET-ME-KNOT**

Registrations

[1] This is a decision involving summary expungement proceedings with respect to registration Nos. TMA631,952 and TMA599,853, for the marks LOVE-KNOT and FORGET-ME-KNOT (the Marks) respectively, owned by Gayle Gordon.

[2] Both of the Marks are registered in association with the goods: Gold and silver jewellery.

[3] For the reasons that follow, I conclude that the registrations ought to be maintained.

THE PROCEEDINGS

[4] On April 25, 2017, the Registrar of Trade-marks sent notices under section 45 of the *Trade-marks Act*, RSC 1985, c T-13, as it then was (the Act), to Gayle Gordon (the Owner). The notices were sent at the request of Sim & McBurney (the Requesting Party).

[5] The notices required the Owner to furnish evidence showing that it had used the Marks in Canada, at any time between April 25, 2014 and April 25, 2017, in association with each of the goods specified in the registrations. If the Marks had not been so used, the Owner was required to furnish evidence providing the date(s) when the Marks were last in use and the reasons for the absence of use since that date.

[6] The definitions of use with respect to goods are set out in sections 4(1) and 4(3) of the Act as follows:

4(1) A trademark 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.

...

4(3) A trade-mark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[7] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. As such, the evidentiary threshold that the registered owner must meet is quite low [see *Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the trademark was used in association with each of the goods specified in the registration [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270 and *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. 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)].

[8] In response to the Registrar's notices, the Owner furnished identical affidavits sworn by the Owner, herself, on July 19, 2017, together with Exhibits A to C.

[9] Only the Requesting Party filed written representations and appeared at an oral hearing, wherein representations were made with regard to both proceedings.

THE EVIDENCE

[10] In support of the registrations, Ms. Gordon filed as Exhibit A to her affidavit, what she describes are "true copies of invoices issued by me". There are eight invoices in total, all of which are dated during the relevant period. The words "ring", "chain", "bracelet", "pendant", and "pin(s)" appear in the product descriptions on the invoices to which she attests that all such jewellery was made from gold or silver. The invoices are indicated to be cash sales sold to individuals, wherein no shipping address or shipping charges are detailed.

[11] Ms. Gordon attests that each and every good referenced in the invoices with the phrase "Forget Me Knot" or "Forget-Me Knot" was shipped to the buyer with a hang tag as shown in front and rear views in Exhibit B. In Exhibit B, the first image shows "Forget-Me-Knot™" appearing in large lettering at the bottom of the hang tag, while the second image, or rear view perspective of the hang tag, shows "Love-Knots™" in large lettering at the top. The second image also includes the notice "'Forget-Me-Knot' is a Trademark of Gayle Gordon".

[12] Lastly, Ms. Gordon attaches as Exhibit C to her affidavit, what she attests is a true copy of a brochure distributed in small quantities during the relevant period to generate sales. She attests that any reference to rings sold in the invoices noted by the phrase "Forget-me Knot" or "Forget-me-Not" in the product description evidences a sale of such goods shown in this brochure beside the annotation FORGET-ME-KNOT.

ANALYSIS AND REASONS FOR DECISION

[13] The Requesting Party submits that although Ms. Gordon states that each and every good referenced in the Exhibit A invoices was shipped to the buyer with a hang tag as shown in Exhibit B, she does not state that the tag is affixed or somehow attached to the goods shipped to

the buyer, or otherwise displayed in a manner so associated with the goods that notice of the association is given to the purchaser at the time of transfer.

[14] The Requesting Party further submits that the display of a trade-mark on an invoice can only constitute use (in particular, provide notice of association of the trade-mark) within the meaning of section 4 if the invoice accompanied the goods at the time of transfer; however, the affidavit is silent as to what point in time the invoices were delivered in relation to the shipment of the invoiced goods. Furthermore, the Requesting Party submits that it has been established that use of advertisements and promotional materials is not in itself sufficient to constitute “use” of a trade-mark in association with goods under section 4(1) unless these materials are sufficiently associated with the goods and are given at the time of transfer of the property in or possession of the goods.

[15] In addition to the aforementioned, the Requesting Party makes submissions regarding deficiencies and ambiguities in the evidence should section 4(3) apply; however, I find it unnecessary to address such submissions, as I am satisfied that sales of the registered goods in association with the Marks took place in Canada.

[16] In this regard, while it is true that there is no clear evidence that the invoices accompanied the goods at their time of transfer, I accept Ms. Gordon’s sworn statement that the Exhibit B hang tags, which clearly bear both Marks, accompanied the goods when they were shipped to the buyer. Hang tags, by definition, are attached to the merchandise being sold, and there is no evidence before me to the contrary. Consequently, having regard to Ms. Gordon’s sworn statements in conjunction with the Exhibit B hang tags, I accept that notice of association of the Marks with the registered goods was given to consumers at the time of transfer. As such, I need not consider the brochures.

[17] On another note, the Requesting Party submits that the affidavit does not establish that sales were made to purchasers in Canada, nor does the affidavit state that the sales shown in the invoices were “in the normal course of trade”. The Requesting Party submits that the fact that the invoices do not show separate HST charges, show discounted prices, and no charges for items and/or no shipping costs suggests that these were not sales “in the normal course of trade”

from an individual operating in jewellery sales, but rather suggest that these were promotional or token sales.

[18] The Requesting Party submits that the affidavit provides no evidence as to what constitutes the Owner's normal course of trade, thus the Registrar has no standard against which it can determine if the alleged sales were in the normal course of trade; for example, the Owner does not indicate whether she is a retailer, wholesaler, designer, manufacturer or performed one or more of these functions. Furthermore, the Requesting Party submits that no information is provided in the affidavit as to the location of the buyers.

[19] However, I find it reasonable to infer from the evidence, that Ms. Gordon, an individual, is a small business owner located in Toronto, Canada. Furthermore, there is nothing in the evidence to suggest that Ms. Gordon is involved in the importing or exporting of her products; indeed, the evidence suggests that Ms. Gordon's goods are artisanal in nature and sold locally. The invoices indicate that the sales were cash sales, and Ms. Gordon attests that such sales were made from the Toronto, Ontario address which is indicated in the footer of the invoices. Furthermore, I see nothing in the evidence to suggest that such sales were token sales deliberately contrived to protect the registration of the Marks. Indeed, the evidence need not be perfect; a registered owner need only establish a *prima facie* case of use and the Registrar may draw reasonable inferences from the facts provided [see *Diamant Elinor Inc v 88766 Canada Inc*, 90 CPR (4th) 428; and *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64, 48 CPR (4th) 223].

[20] Having regard to the aforementioned, and well established principles in section 45 regarding the Owner's evidentiary threshold [*Uvex Toko Canada Ltd, supra*], I am satisfied that the Owner's evidence demonstrates use of the Marks during the relevant period in accordance with the criteria of section 4(1) of the Act.

DISPOSITION

[21] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, registration Nos. TMA631,952 and TMA599,853 will be maintained in compliance with the provisions of section 45 of the Act.

Kathryn Barnett
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 2019-02-21

APPEARANCES

N/A

FOR THE REGISTERED OWNER

Kenneth McKay

FOR THE REQUESTING PARTY

AGENT(S) OF RECORD

Ridout & Maybee LLP

FOR THE REGISTERED OWNER

Marks & Clerk

FOR THE REQUESTING PARTY