



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 17

Date of Decision: 2020-02-18

IN THE MATTER OF A SECTION 45 PROCEEDING

Sim & McBurney

Requesting Party

and

Trendium Pool Products Inc.

Registered Owner

TMA412,728 for VOGUE

Registration

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA412,728 for the trademark VOGUE (the Mark), owned by Trendium Pool Products Inc.

[2] The Mark is registered for use in association with the following goods:

- (1) Piscines hors-terre [above-ground pools].
- (2) Piscines creusées [in-ground pools].
- (3) Toiles intérieures pour piscines hors-terre and creusées [interior liners for above-ground and in-ground pools].
- (4) écumoirs [skimmers].

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

INTRODUCTION

[4] At the request of Sim & McBurney (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on June 30, 2017, to Trendium Pool Products Inc. (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the trademark 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 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 June 30, 2014 to June 30, 2017.

[6] The relevant definition of use for goods is set out in section 4 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.

[7] It is well established that bare statements that a trademark is in 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 in these proceedings is 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 trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Steven Cohen, sworn on September 29, 2017, in the state of New York. Neither party filed written representations. Both parties were represented at an oral hearing.

THE OWNER'S EVIDENCE

[9] Mr. Cohen states that since 2009, he has been the president of the Owner, a company based in LaSalle, Quebec (although Mr. Cohen describes himself as living in Locust Valley, New York). He explains that as president, he oversees all business activities of the Owner, including sales and marketing, and that all information in his affidavit is from his personal knowledge and from the Owner's business records, to which he has free and unrestricted access.

[10] Mr. Cohen explains that the Owner is a manufacturer of above-ground pools, which are sold in Canada, the United States, and elsewhere. He states that the Owner sells these pools to distributors and/or retailers, who then sell the pools to end users, and states that the Owner has sold above-ground pools in this manner in Canada during the relevant period. He explains that typically, a prospective purchaser of an above-ground pool will visit the showroom of a retailer to make the purchase, whereupon they are provided with informational pamphlets and given the opportunity to view sample pools in the showroom. The customer will then review the pamphlets and floor model pools in order to select a suitable pool, at which time they can enter into a sales contract with the retailer, who will then arrange for the pool to be delivered. As Exhibit A to his affidavit, Mr. Cohen attaches copies of informational pamphlets that were produced by the Owner and distributed to retailers in Canada during the relevant period. The pamphlets prominently display the Mark and depict a number of above-ground pools.

[11] As Exhibit B, Mr. Cohen attaches a number of invoices dated within the relevant period, showing shipments of above-ground pools by the Owner to its retailers and distributors. The Mark appears in the product descriptions on the invoices. Mr. Cohen states that the Owner sold hundreds of above-ground pools in Canada during the relevant period.

[12] Mr. Cohen states that the Mark is displayed on the wall support covers of many of its above-ground pools. As Exhibit C, he attaches photographs showing the Mark displayed on wall support covers of above-ground pools, and states that the Mark was displayed in this manner on pools in the Owner's distributors' showrooms during the relevant period.

[13] Finally, as Exhibit D, Mr. Cohen attaches a number of warranty documents and installation manuals displaying the Mark. He explains that these documents were provided to purchasers of the Owner's above-ground pools in Canada during the relevant period.

ANALYSIS

[14] At the hearing, the Owner conceded that it had not used the Mark in association with any of the registered goods other than above-ground pools. As no special circumstances were put forward to excuse absence of use, goods (2), (3), and (4) will be expunged from the registration. Accordingly, the sole issue to be determined is whether the Owner used the Mark in association with above-ground pools within the meaning of sections 4 and 45 of the Act.

[15] The Requesting Party submits that the Owner's evidence amounts to mere statements of use, rather than evidence showing use. In particular, he argues that Mr. Cohen lives in New York and has not explained the source of his knowledge of how the Owner's pools are sold in Canada, and that the Owner has not shown that the Mark was associated with the goods at the time of transfer of property or possession. As a result, the Requesting Party submits that the Mark should be expunged in its entirety.

[16] With respect to the first issue, I note that absent evidence to the contrary, an affiant's sworn statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25]. Further, as noted by the Federal Court in *Scott Paper Ltd v Georgia-Pacific Consumer Products LP*, 2010 FC 478, "an affiant's office may manifestly put him or her in a position to have personal knowledge of facts without necessarily being a direct witness to the event" [para 35]. Here, given the nature of Mr. Cohen's position, I accept that he would generally have knowledge of the Owner's activities, including the manner in which the Owner's products are normally sold by its distributors [for similar conclusions, see *Bereskin & Parr v Mövenpick-Holding* (2008), 73 CPR (4th) 28 (TMOB) at para 7; *Cascades Canada Inc v Wausau Paper Towel & Tissue LLC*, 2010 TMOB 176 at paras 29-30; *Blake, Cassels & Graydon LLP v Commercial Pro, Inc*, 2016 TMOB 46 at para 27]. Accordingly, I do not consider it to be relevant that Mr. Cohen lives in New York and swore his affidavit there, or that he did not explicitly state that he has observed sales of his company's product to members of the public.

[17] On the second point, the Requesting Party submits that the Exhibit A pamphlets constitute mere promotional material rather than use of the Mark in association with the registered goods; that the Exhibit C photograph of the wall support cover was taken after the relevant period and does not establish that the above-ground pools displayed the Mark during the relevant period; and that there is no indication that the Exhibit D invoices accompanied the goods at the time of transfer.

[18] In my view, however, the Owner's evidence is sufficient to establish use of the Mark in association with above-ground pools. Mr. Cohen clearly states in his affidavit that a prospective customer will typically review the Owner's informational pamphlets to select the specifications of the pool they wish to buy, and will then enter into a sales contract with the retailer to purchase the pool. It is well-established that notice of association between a trademark and goods can be established when customers place orders by way of a catalogue or brochure that displays the trademark in close association with those goods, and that notice of association continues when the goods are delivered [see, for example, *Swabey Ogilvy Renault v Mary Maxim Ltd* (2003), 28 CPR (4th) 543 (TMOB) at para 12; *Rosenstein v Elegance Rolf Offergelt GmbH* (2005), 47 CPR (4th) 196 (TMOB) at para 15; *Fraser Milner Casgrain LLP v LG Electronics Inc*, 2014 TMOB 232 at para 21; *Budget Blinds, LLC v Truth Hardware Corporation*, 2019 TMOB 116 at para 10]. As the Mark is prominently displayed in the brochures used by customers when entering into a contract to purchase the Owner's above-ground pools, I find that the Owner has established notice of association between the Mark and these goods at the time of transfer of property.

[19] In any event, the Mark appears on the wall support covers of the Owner's above-ground pools, shown in Exhibit C, and is prominently displayed on installation manuals and warranty documents shown in Exhibit D. Mr. Cohen is clear in his affidavit that Exhibits C and D are representative of how these materials appeared during the relevant period. With respect to Exhibit D, Mr. Cohen states that the manuals and warranty documents are provided to purchasers of the Owner's above-ground pools but, as noted by the Requesting Party, does not explicitly state that they accompanied the pools *at the time of transfer*. In my view, however, there is no reason to think that instruction manuals or warranty documents would be provided to pool buyers at any time other than the time of purchase (transfer of property) or delivery of the pools

(transfer of possession). I reach this conclusion bearing in mind that the Registrar may make reasonable inferences from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64].

[20] In sum, I find that purchasers would have had notice of association between the Mark and the above-ground pools based on the display of the Mark on brochures used for ordering the pools, on the wall support covers of those pools, and on the instruction manuals and warranty documents that accompanied those pools. Given that Mr. Cohen has stated that the Owner sold hundreds of above-ground pools in Canada during the relevant period, and has provided numerous invoices dated within the relevant period showing shipments of above-ground pools to distributors in Canada, I find that the Owner has shown sales of above-ground pools to customers in Canada in the normal course of trade during the relevant period.

DISPOSITION

[21] 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 goods (2), (3), and (4).

[22] The amended statement of goods will be as follows:

- (1) Piscines hors-terre.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2020-01-09

APPEARANCES

Jonathan Burkinshaw

For the Registered Owner

Kenneth McKay

For the Requesting Party

AGENTS OF RECORD

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

For the Registered Owner

Marks & Clerk

For the Requesting Party