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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 35

Date of Decision: 2020-04-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Finlayson & Singlehurst	**Requesting Party**
And	
Lubecki Technical Holdings Inc.	**Registered Owner**
TMA715,765 for TURBOSKIN	**Registration**

INTRODUCTION

[1] At the request of Finlayson & Singlehurst (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on July 4, 2018, to Lubecki Technical Holdings Inc. (the Owner), the registered owner of Registration No. 715,765 for trademark TURBOSKIN (the Mark).

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

Adult toys, namely synthetic skin.

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

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with the goods 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 July 4, 2015 to July 4, 2018.

[5] 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.

[6] 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)].

[7] On October 2, 2018, in response to the Registrar's notice, the Owner furnished the affidavit of Maria Lubecki, sworn October 1, 2018. Both parties filed written representations. An oral hearing was not requested.

[8] As a preliminary matter, I note that on April 8, 2019, the Owner filed a second affidavit of Maria Lubecki, sworn April 4, 2019, as its written representations. Pursuant to sections 45(1) and (2) of the Act, I can only consider evidence submitted in the form of an affidavit or statutory declaration filed within three months of the date of the Registrar's notice, plus any extensions granted under section 47. Because the Owner's deadline for filing evidence expired on October 4, 2018, this affidavit cannot be considered as evidence. However, I note that the document was filed within the Owner's prescribed time for filing written representations; as such, I will consider this document only to the extent that this document comprises the written representations of the registered owner.

THE OWNER'S EVIDENCE

[9] Ms. Lubecki's affidavit is brief. After stating that she is the Administrator of the Owner, a Quebec company, and that an entity called DeeVa is a "registered division" of the Owner, she attests as follows:

> **THAT,** TURBOSKIN, a registered trade mark of Lubecki Technical Holdings, is used in Canada on-going ;
>
> **THAT,** the attached sample is packaging used in the sale of the product sold under the trade mark of TURBOSKIN.

[10] Empty packaging for a product was sent along with the affidavit; however, I note that this item does not appear to have been commissioned or notarized. The packaging depicts a product identified as a "girth sleeve" which "[a]dds extra girth to one's manhood"; I note that the packaging shows a condom-like product and displays the Mark. The packaging also displays the company name DeeVa, and lists two addresses for the company, one of which is the same as the Quebec address provided by Ms. Lubecki for the Owner. The Owner's name does not appear on the packaging.

ANALYSIS

[11] The Requesting Party submits that the packaging should be disregarded as evidence as it has not been properly identified as exhibits or commissioned or notarized, citing *Beiersdorf AG v Future International Diversified Inc* (2002), 23 CPR (4th) 555 (TMOB). However, it has been established that technical deficiencies in evidence should not stop a party from successfully responding to a section 45 notice where the evidence provided could be sufficient to show use [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. For example, the Registrar has accepted exhibited evidence that was not properly endorsed where the exhibited evidence was clearly identified and explained in the body of the affidavit [see, for example, *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)]. In this case, the packaging is referenced in Ms. Lubecki's affidavit; as such, I am not prepared to disregard it. Further, I have no doubt that the product depicted on the packaging can be considered "Adult toys, namely synthetic skin".

[12] However, the Owner's evidence is not sufficient to satisfy the requirements of sections 4 and 45 of the act for several reasons. In particular, Ms. Lubecki merely states that the Mark is "used in Canada on-going"; neither she nor the attached packaging makes any reference to the relevant period. While she states that the Mark is used in Canada and was sold in association with the attached packaging, there is no specific reference to any sales in Canada during the relevant period. As stated above, the section 45 notice required the Owner to show use of the Mark in association with the registered goods in the normal course of trade during the period of July 4, 2015, to July 4, 2018. In the absence of such use, I cannot conclude that the Owner has met its evidentiary burden pursuant to sections 4 and 45 of the Act.

[13] I would further note that while Ms. Lubecki attests that DeeVa is a "registered division" of the Owner, it is not clear what this means, such as whether DeeVa is a separate legal entity. If separate, it is not clear whether any use of the Mark by DeeVa would have enured to the benefit of the Owner pursuant to section 50 of the Act. Had the Owner provided evidence of actual transfers and sales, some light may have been shed on the nature of this relationship and/or rendered the issue moot. In this respect, I note that the Owner filed documentation as an exhibit to the second affidavit of Ms. Lubecki which provides further information about the relationship between the Owner and DeeVa; however, as discussed above, I cannot consider these materials.

[14] As such, I find that the Owner's evidence does not establish use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act. Further, the Owner has provided no special circumstances that would excuse non-use of the Mark in association with the registered goods.

[15] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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 No Hearing Held

AGENTS OF RECORD

No agent appointed	For the Registered Owner
Finlayson & Singlehurst	For the Requesting Party