



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 132

Date of Decision: 2020-11-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Sim & McBurney

Requesting Party

and

**Vogue Tyre & Rubber Company (An
Illinois Corporation)**

Registered Owner

TMDA52,581 for VOGUE

Registration

INTRODUCTION

[1] At the request of Sim & McBurney (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 June 8, 2017, to Vogue Tyre & Rubber Company (An Illinois Corporation) (the Owner), the registered owner of registration No. TMDA52,581 for the trademark VOGUE (the Mark).

[2] The Mark is registered for use in association with the goods “Automobile tires and tubes.”

[3] For the reasons that follow, I conclude that the registration ought to be maintained only with respect to automobile tires.

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with the registered goods 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 8, 2014, to June 8, 2017.

[5] The relevant definition of use in the present case is set out in section 4(1) 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)]. 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)]; however, 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) (*John Labatt*)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Pat Davy, Director of Operations of the Owner, sworn January 4, 2018. Only the Owner submitted written representations. Both parties were represented at an oral hearing.

THE OWNER'S EVIDENCE

[8] Throughout the affidavit, the affiant refers to the registered goods collectively. The affiant states that the goods were sold in Canada throughout the relevant period and beyond, and that the Mark appears on the side of each tire, as well as on price lists, application guides, and promotional materials distributed in Canada. As Exhibit A, the affiant attaches the cover of an

application guide dated August 2015, which “demonstrates the placement of the word VOGUE on automobile tires sold in Canada” by the Owner. The image shows a tire displaying the Mark. As Exhibit B, the affiant attaches a promotional offer for prepaid card rebates in association with the Owner’s tires. The advertisement shows a tire displaying the Mark. The affiant states that this promotional offer was distributed in Canada in October and November 2016.

[9] As Exhibit C, the affiant attaches copies of invoices dated within the relevant period, showing sales of items listed as “VG CBR VII GW”. The affiant states that “[t]he description VG that commences each item description on each invoice indicates that the items sold are VOGUE automobile tires”, and that these invoices demonstrate “actual sales of the Goods to addresses in Canada under the Trademark”. Two of the invoices include a “BILL TO” address for a company located in Victoria, B.C., and a “SHIP TO” address listed as “CARSON CUSTOM” located in Blaine, Washington, in the United States. The third invoice does not have “BILL TO” or “SHIP TO” headings, but includes an address for a business entity located in British Columbia, and an address for “PRO PACK” located in Blaine, Washington.

ANALYSIS

[10] At the outset, I note that there is nothing in the Owner’s evidence that refers specifically to the registered goods “tubes”. At the oral hearing, the Owner submitted that in the past, it was common for automobile tires to have tubes, and that a generous interpretation of the registered goods would be that the use of tires and tubes is intertwined. However, it is well-established that use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration; having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [per *John Labatt*]. As there is no evidence specific to tubes, and because the affiant has not described any special circumstances that would excuse non-use, the list of registered goods will be amended accordingly.

[11] The Requesting Party raises three issues with the Owner’s evidence: firstly, that the evidence does not establish that the Mark was displayed on the goods; secondly, that the Owner has not established its normal course of trade; and thirdly, that there is no evidence that the goods in question were transferred in Canada. Each issue will be addressed in turn.

Display of the Mark on the Goods

[12] The Requesting Party submits that the photographs attached as Exhibits A and B are artistic depictions of the tires as shown in promotional material, rather than photographs of the tires themselves, and therefore do not show how the Mark was displayed on the goods. However, in view of the affiant's sworn statement that the tire shown in the Exhibit A photograph, which is dated during the relevant period, is representative of the display of the Mark on tires sold in Canada, I am satisfied that any tires sold in Canada during the relevant period would have displayed the Mark in this manner.

Normal Course of Trade

[13] The Requesting Party submits that the Davy affidavit does not provide sufficient detail to establish that the three invoices reflect sales in the Owner's normal course of trade, noting that the affiant states only that "[t]he Goods have been, and continue to be, sold in Canada by [the Owner] in the normal course of trade, in particular during the [relevant] period". The Requesting Party submits that this statement does not specifically refer to goods bearing the Mark, and provides no further detail about the nature of the Owner's business, including whether the Owner is a manufacturer of tires. In this respect, the Requesting Party submits that the affiant's statement that the Owner "produces custom luxury automobile tires" is a "bald statement" and does not refer to Canada. The Requesting Party cites *Sim & McBurney v Madjell Manufacturing Co* (1988), 11 CPR (3d) 306 (FCTD) [*Madjell*], for the proposition that the Registrar cannot infer that a transaction was in the normal course of trade in the absence of a precise description of an owner's trade, and *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245 [*Guido Berlucchi*], for the proposition that it is not the function of the Registrar to set standards for the normal course of trade.

[14] In response to the Requesting Party's submissions on this issue, the Owner submits that the affiant has stated that the Owner produces custom luxury automobile tires and that the Owner sells tires in Canada in the normal course of trade. The Owner submits, and I agree, that evidence of a single sale can be sufficient to establish use for the purposes of section 45 expungement proceedings, so long as it follows the pattern of a genuine commercial transaction and is not seen

as deliberately manufactured or contrived to protect the registration [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at para 12].

[15] This case can be distinguished from *Madjell*, in which the owner did not state that sales were in the normal course of trade or provide any details about the nature of its business. With respect to *Guido Berlucchi*, also cited by the Requesting Party, I note that the Court in that case accepted that the owner had used its trademark in the normal course of trade despite having evidence of only a single transaction, given that good faith is presumed, that detailed sales figures are not required, and that the owner had attested that the sale was in the normal course of trade [*Guido Berlucchi* at paras 49-55]. Here, given that the affiant has described the nature of its business (albeit briefly), stated that the Owner sells tires in Canada in the normal course of trade, and provided evidence of three separate transactions involving a Canadian buyer, I am satisfied that these transactions would have been in the Owner's normal course of trade.

Transfer of the Goods in Canada

[16] The Requesting Party submits that the Owner's evidence does not establish that the goods in question were transferred in Canada, noting that each of the invoices, despite having a "BILL TO" address located in Canada, has a "SHIP TO" address located in Blaine, Washington. Accordingly, the Requesting Party submits that in the absence of evidence showing that the goods ever reached Canada, the Owner has not shown use within the meaning of section 4 of the Act.

[17] However, I agree with the Owner that it can be inferred that the invoices reflect sales of the goods in question in Canada. I reach this conclusion based on the following:

- The affiant has provided a sworn statement that the invoices demonstrate "actual sales of the Goods to addresses in Canada under the Trademark", and I am prepared to accept this statement at face value [following *Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25].
- The fact that the addresses in the invoices are listed as "CARSON CUSTOM" or "PRO PACK" in Blaine, Washington, which is a community located in close proximity to the British Columbia-United States border, is consistent with these shipments being the first step in a chain of distribution leading to delivery of the products to their purchasers in British Columbia, Canada.

- The fact that the Owner has distributed promotional material for its tires in Canada during the relevant period, while insufficient in itself to show use within the meaning of the Act, provides further support for the affiant's statements that the Owner sold tires in Canada in the normal course of trade during the relevant period and that the invoices reflect such sales.

[18] Given the above, I am satisfied that the invoices reflect actual transfers of the goods in question to customers in Canada, in the normal course of trade during the relevant period. In reaching this conclusion, I am mindful of the principles that evidence in a section 45 proceeding must be considered as a whole and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)], and that reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)].

[19] Accordingly, given that the Owner's evidence establishes that the Mark was displayed on its tires, and that such tires were sold to customers in Canada during the relevant period in the normal course of trade, I am satisfied that the Owner has shown use of the Mark in association with the registered goods "Automobile tires" within the meaning of the Act.

DISPOSITION

[20] 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 "and tubes" from the registered goods.

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

Automobile tires.

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 2020-10-26

APPEARANCES

Peter Cooke For the Registered Owner

Kenneth McKay For the Requesting Party

AGENTS OF RECORD

Borden Ladner Gervais LLP For the Registered Owner

Marks & Clerk For the Requesting Party