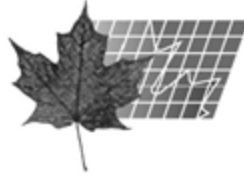


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 150

Date of Decision: 2021-01-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Borden Ladner Gervais LLP

Requesting Party

and

Jolene Ali

Registered Owner

TMA683,054 for Sweet Momma

Registration

INTRODUCTION AND PROCEDURAL HISTORY

[1] At the request of Borden Ladner Gervais LLP (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 January 25, 2018, to Jolene Ali (the Owner), the registered owner of registration No. TMA683,054 for the trademark Sweet Momma (the Mark). The Mark is registered for use in association with the goods and services listed in Schedule A.

[2] The notice required the Owner to show whether the Mark has been used in Canada in association with the registered goods and services 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 January 25, 2015, to January 25, 2018.

[3] The notice was sent to the last correspondence address of record provided by the Owner. On April 13, 2018, the Owner sent a letter to the Registrar advising that the notice was not received because the Owner had moved. The Owner asked that “a second copy” of the notice be sent to the Owner’s new address and to the address of the “operating owner” of the company Sweet Momma Spa. The Owner also confirmed that she was the registered owner of the Mark and asserted use and licensing of the Mark. However, such assertions were not made in the form of an affidavit or statutory declaration.

[4] On May 8, 2018, the Registrar informed the Owner that a formal request to change her address of record would be required to update the registration. This notification was issued by the Registrar’s Assignment and Renewal Section (the Assignment Section). Although the Owner’s letter contained assertions of use relating to the section 45 proceeding, the file was unfortunately not subsequently forwarded to the Trademarks Opposition Board (the Opposition Board) to address the statements in the registered owner’s letter relating to the section 45 proceeding.

[5] On June 12, 2018, the Registrar received a formal request (dated May 16, 2018) to update the Owner’s correspondence address of record. The Assignment Section performed this update on June 28, 2018, and the file was subsequently forwarded to the Opposition Board for action.

[6] On July 4, 2018, the Registrar received from the Owner a request (also dated April 13, 2018) to record an assignment of the registration from the Owner to the company Sweet Momma St. Albert Inc. Enclosed with this letter was an assignment document dated September 1, 2013. The file was returned to the Assignment Section to process this request, prior to the issuance of further correspondence regarding the section 45 proceeding.

[7] On August 9, 2018, the Assignment Section informed the Owner that the requested assignment of the registration could not be recorded, because the document submitted in support did not evidence the transfer. More particularly, the document submitted purported to be an assignment of the Mark from an entity other than the Owner to an unnamed assignee. Consequently, the registered owner of record remained unchanged.

[8] Subsequently, upon review of the file by the Opposition Board, it was apparent that the Owner's letter of April 13, 2018 contained an attempt to respond to the section 45 notice. However, as the Owner's response was not in the form of an affidavit or statutory declaration, it could not be made of record as evidence in response to the section 45 notice.

[9] On August 16, 2018, in accordance with the normal practice of the Opposition Board, the Owner was given an opportunity to request an extension of time to furnish her evidence in proper form.

[10] On August 29, 2018, a hearing officer at the Opposition Board returned a telephone call from Mr. Jim Gibbon, on behalf of the Owner. Mr. Gibbon requested an explanation for the delay in the processing of this file and for a perceived discrepancy between the letter from the Opposition Board of August 16, 2018, and information he indicates the Owner had received from the Registrar's staff in two prior conversations. The hearing officer informed Mr. Gibbon that the delay in issuing the letter of August 16, 2018 was due to transit of the file between the Assignment Section, the Records Office (file room), and the Opposition Board, and that the section 45 proceeding was otherwise following the normal course. With respect to the Owner's prior conversations with the Registrar's staff, Mr. Gibbon was invited to provide details of the interactions so that any miscommunications might be addressed.

[11] On August 30 and 31, 2018, the Owner filed two letters with the Registrar. In the August 30 letter (dated August 27, 2018), the Owner requested a retroactive extension of time to file a proper response to the section 45 notice on the basis that she had not received the section 45 notice "from CIPO". In addition, the Owner stated that, in two telephone conversations with an "officer" of the Canadian Intellectual Property Office (CIPO), she was informed that her submission in response to the section 45 notice was "both adequate and received on time" and that her "evidence was processed and sent forward for review".

[12] In her letter of August 31, 2018, the registered owner reiterated her request for a copy of the section 45 notice, and requested that her deadline for responding to the notice run from the date of receipt of that copy.

[13] Enclosed with this letter were two statutory declarations dated August 30, 2018. The first of these declarations (the Ali Declaration) concerns use of the Mark. The second (the Gibbon Declaration) relates to Mr. Gibbon's telephone conversation and information that he indicates was received regarding actions taken on the Owner's file.

[14] On October 4, 2018, the Registrar provided written clarification regarding several misunderstandings that were evident from the content of the letters and the Gibbon Declaration, discussed in further detail below, and granted a retroactive extension of time to January 5, 2019, for the Owner to file further evidence.

[15] No further evidence was filed by the Owner after the retroactive extension was granted. Accordingly, the only evidence in this proceeding is the Ali Declaration and the Gibbon Declaration.

[16] Only the Requesting Party submitted written representations. No oral hearing was held.

EVIDENCE

[17] The Gibbon Declaration makes no mention of whether the Owner used the Mark during the relevant period or otherwise, or of any reasons for non-use, but instead relates to conversations between Mr. Gibbon and a hearing officer at the Opposition Board. I note that Mr. Gibbon states that he was informed that the Owner's April 13, 2018, letter "was received on time to have been considered enough evidence, before the due date, to have the application closed without the need of a tribunal." I further note that in the Registrar's correspondence dated October 4, 2018, the Registrar addressed this misunderstanding, advising that while the April 13 letter was received before the Owner's initial deadline to file evidence, that letter was not in the form of an affidavit or statutory declaration, and therefore could not be accepted as evidence in this proceeding. The Registrar further advised that no information on the sufficiency of the evidence is communicated to the parties until all stages of the proceeding have been completed and the Registrar issues a final decision in writing under section 45(4) of the Act, and that if the Owner was led to understand that such information was being provided at an earlier stage, then there had been a misunderstanding. As noted above, in that same correspondence, the Registrar

granted a retroactive extension of time for the Owner to file further evidence; however, no such evidence was filed.

[18] The content of the Ali Declaration is reproduced below:

Since the filing of this application for registration of the trademark, the applicant, by itself and/or through a licensee, has commenced the use in Canada of the trademark claimed in the said application in association with [...] All the goods and/or services specified in the application.

[19] No exhibits were attached to either statutory declaration.

ANALYSIS

[20] The relevant definitions of use are 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.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[21] In its written representations, the Requesting Party submits that the Ali Declaration contains only a bare assertion of use; that the declarations contain no evidence of transfer of the registered goods or performance or advertising of the registered services; that they do not demonstrate how the Mark is displayed in association with any of the goods or services; and that they make no reference to the relevant period.

[22] I concur with the Requesting Party that the Owner's statutory declarations are insufficient to establish use of the Mark in association with any of the registered goods and services. The Gibbon Declaration makes no reference to use of the Mark during the relevant period or otherwise. The Ali Declaration consists only of a bare statement that the Mark has been in use, with no factual evidence to corroborate the declarant's assertion and without any mention of the relevant period. Such statements 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)]. It is not

enough to merely state that a trademark has been in use; an owner's evidence must provide factual evidence demonstrating use of the Mark in association with each of the goods and services listed in the registration. In other words, the Owner must provide evidence *showing* how the Mark was displayed in association with a transfer in the normal course of trade of each of the registered goods, and in the performance or advertising of each of the registered services, in Canada during the relevant period.

[23] Accordingly, I am not satisfied that the Owner has shown use of the Mark in association with the registered goods or services within the meaning of the Act. Furthermore, there is no evidence of special circumstances which would excuse non-use of the Mark.

DISPOSITION

[24] In view of all of the above, 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

SCHEDULE A

GOODS

Abdominal belts, Baby backpacks, Baby bath tubs, Baby books, Baby bottles, Baby bunting, Baby carriages, Baby carriers worn on the body, Baby clothes, Baby food, Baby formula, Baby hair conditioner, Baby lotion, Baby multiple activity toys, Baby oil, Baby powder, Baby rattles, Baby shampoo, Bags (Diaper), Bags (Overnight), Bandannas, Bands (Hair), Bands (Head), Bands (Neck), Bands (Sweat), Bands (Wrist), Bassinets, Bath beads, Bath crystals, Bath foam, Bath gel, Bath oil, Bath pearls, Bath powder, Bath salts (Medicated), Bath salts [non-medicated], Bath salts for medical purposes, Bath toys, Bath toys (Inflatable), Bathing additives, Bathtubs (Baby), Bears (Stuffed toy), Bears (Teddy), Beauty masks, Bed blankets, Bed canopies, Bed coverings, Bibs (Cloth), Blush, Blusher, Body cream, Body mask creams, Body mask lotions, Body mask powders, Body masks, Body oil, Body powder, Body scrubs, Booklets, Bookmarks, , Books (Baby), Books (Children's activity), Books (Cook), Books (Educational), Books (Exercise), Booties, Bras, Breast pads, Breast pumps, Breast shields, Calcium supplements, Cards (Announcement), Cards (Occasion), Carriers worn on the body (Infant), Chains (Jewelry), Chairs (Birthing), Children's books, Cloth bibs, Cloth diapers, Cloth diapers (Infant), Cream (Body), Cream (Eye), Cream (Face), Cream (Hand), Cream (Skin cleansing), Cream (Skin), Crib mobiles, Exercise books, Facial cleansers, Facial creams, Facial masks, Facial scrubs, Food for infants namely baby food, Food supplements (Dietary) namely vitamins, Gel (Shower), Ginger, Ginger ale, Granola-based snack bars, Hand lotion, Hats, Head bands, Herbal food beverages, Identification bracelets, Incontinence garments, Infant toys, Infant walkers, Infantwear, Lozenges (Non-medicated), Magazines, Mobiles (Crib), Nausea treatment pharmaceutical preparations, Neck bands, Neckerchiefs, Necklaces, Nutritional drink mix for use as a meal replacement, Nutritionally complete food substitutes namely food bars drink mixes and meal replacements, Pacifiers for babies, Pads (Breast), Powder (Baby), Pregnancy test kits for home use, Sarongs, Scarves, Shampoo (Baby), Shampoo-conditioners, Skin masks, Skin whitening creams, Soaks (Muscle), Soaps for hands, face and body (Liquid), Sun screen preparations, Talcum powder, Tea, Tops (Tank), Tops namely shirts, Underwear, Vitamin and mineral supplements.

SERVICES

Acupuncture, Child care, Chiropractic services, Clinics (Medical), Consultation (Food nutrition), Cosmetician services, Developing educational manuals, Diet planning and supervision (Weight reduction), Development and dissemination of educational materials, consultation of food and nutrition, Health spas, Medical counselling, Medical equipment (Rental of), Nutrition consultation (Food), Nutrition counselling, Physical education services, Physical fitness consultation, Physical fitness instruction, Physical therapy, Physician services, Retail outlets featuring maternity products, Spas (Health), Television production.

**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

Borden Ladner Gervais LLP

For the Requesting Party