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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 84

Date of Decision: 2021-04-30

IN THE MATTER OF SECTION 45 PROCEEDINGS

Fasken Martineau Dumoulin LLP

Requesting Party

and

SGM - Société Générale de Marques SA

Registered Owner

TMA670,718 for GUY ELLIA

Registrations

**TMA600,611 for GE GUY ELLIA (&
DESSIN)**

[1] At the request of Fasken Martineau Dumoulin LLP (the Requesting Party), the Registrar of Trademarks issued notices under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on August 8, 2017 to Établissements Jean Guerin (Guerin), the registered owner at that time of registrations No. TMA670,718 for the trademark “GUY ELLIA” (the Word Mark) and No. TMA600,611 for the trademark “GE GUY ELLIA (& DESSIN)” (the Design Mark), reproduced below:



[2] The Design Mark consists of the stylized letters “GE”, underlined, above the words GUY ELLIA in a similar font.

[3] The Word Mark and the Design Mark (collectively the Marks) are registered for use in association with various goods, including watches (“*montres*”) and a number of other related and unrelated goods. The full lists of goods for each of the Word Mark and the Design Mark are set out in Schedules A and B hereto, respectively.

[4] The notices required the registered owner of the Marks to furnish evidence showing that the Marks were in use in Canada, in association with each of the goods specified in the registrations, at any time between August 8, 2014 and August 8, 2017. If either of the Marks had not been so used, the registered owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of such use since that date.

[5] 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.

(3) A trademark 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.

[6] It is well established that 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)]. Although the threshold for establishing use in section 45 proceedings is quite 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 Canada (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] In each of the present proceedings, in response to the Registrar's notice, Guerin furnished a statutory declaration of Catherine Thall Dubé, solemnly declared on May 8, 2018, in Montreal.

[8] Subsequently, on January 15, 2019, the registrations were updated when the Registrar recorded an assignment of the Marks from Guerin, formerly known as Guy Ellia – Ancien Ets Jean Guerin, to SGM – Société Générale de Marques SA (the Owner), effective in 2003.

[9] Only the Requesting Party filed written representations and was represented at an oral hearing.

THE OWNER'S EVIDENCE

[10] In each of her declarations, Ms. Dubé identifies herself as an articling student and provides, as Exhibit CTD-1 to the declaration, the results of Internet searches she conducted on March 7, 2018. In each case, the attached search results consist of extracts from two websites—differing in each declaration—depicting what Ms. Dubé identifies as certain GUY ELLIA goods (in the case of the Word Mark) or certain GE GUY ELLIA (& DESSIN) goods (in the case of the Design Mark) of Guy Ellia Ancien Ets Jean Guerin. Ms. Dubé provides no additional information regarding the searches or their results.

[11] The goods depicted on the exhibited webpages are luxury wrist watches. The Word Mark is displayed on the back of some of them and in the text of the webpages. In the declaration for the Design Mark, a variation of the Design Mark wherein the stylized letters GE are smaller, not underlined, and precede the words GUY ELLIA is displayed in the text of one of the webpages. Also in this declaration, a couple of the depicted watch faces display a design based on the stylized letters GE, and the stylized letters GE are also faintly displayed on the mechanism showing through the back of one of the wristwatches.

[12] Ms. Dubé's declaration does not include any assertion that the Owner ever used the Marks in Canada in the normal course of trade. Moreover, on their face, the webpages do not appear to be from the Owner or its predecessor in title but rather from third-party websites. The currency and/or URL displayed suggest that at least three of the four websites are European. Furthermore, the watches depicted on at least three of the four websites appear to be second-hand goods.

ANALYSIS

[13] At the outset, I note that Ms. Dubé does not indicate by whom she is employed or whether she has personal knowledge that the Marks were used in Canada during the relevant period. Presumably, Ms. Dubé is articling with the Owner's agent. In any event, there is no indication that she was at any time personally involved in the Owner's activities or had access to its business records. Although she may have personal knowledge of the existence and location of the webpages she printed for her affidavit, she would not appear to be in a position to confirm the accuracy of the webpages' contents.

[14] Hearsay issues aside, I agree with the Requesting Party that the evidence does not show use of the Marks in Canada during the relevant period. At best, the evidence indicates that certain watches bearing the Word Mark were offered for sale on third-party websites approximately six months after the end of the relevant period. With respect to the Design Mark, there is an issue as to whether any of the depicted variations of the mark, displayed on the watches themselves or on the webpages, constitute display of the Design Mark as registered. In any event, none of the furnished webpages demonstrates an actual sale or other transfer of such goods, by the Owner or otherwise. I would also note that there is no explanation of the Owner's normal course of trade or any indication of how any sales through the depicted third-party websites might relate to the Owner's trade.

[15] In sum, I am not satisfied that the Owner has demonstrated use of the Marks in association with any of the registered goods within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence before me of special circumstances excusing the absence of such use.

DISPOSITION

[16] 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 section 45 of the Act, the registrations will be expunged.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

GUY ELLIA—TMA670,718

Goods :

- (1) *Préparations pour blanchir et autres substances pour lessiver, nommément: savons, poudres pour blanchir, liquides détersifs pour blanchir, assouplisseurs de tissus, eaux de javel, détergents, détachants; préparations pour nettoyer, polir, dégraisser et abraser, nommément: savons, cires, liquides détersifs, savons pour laver la vaisselle; savons, nommément: savon pour le corps, le visage et les cheveux; parfumerie, huiles essentielles pour usage personnel, cosmétiques, nommément: laques pour les cheveux, laits démaquillants, crèmes de toilette, crèmes nettoyantes, crèmes de jour, fonds de teint ombres à paupières, fards, mascaras, vernis à ongles, rouges à lèvres; lotions pour les cheveux; dentifrices.*
- (2) *Métaux précieux et leurs alliages; objets d'art en métaux précieux et leurs alliages, nommément: des toiles, des tableaux, boîtes et coffrets, porte-clefs; ustensiles de ménage et de cuisine, nommément: passoires, râpes, spatules, tamis, racloirs de casseroles, rouleaux à pâtisserie, fourchettes, cuillères à soupe, cuillères à thé, couteaux à beurre, couteaux à steak, couteaux à pain; vaisselle, vases, flacons, figurines, statuettes, poudriers, pulvérisateurs de parfum, vaporisateurs à parfum, boîtes, bonbonnières, bougeoirs, chandeliers en métaux précieux et leurs alliages; joaillerie, pierres précieuses; horlogerie et instruments chronométriques, nommément: montres, montres chronographes, chronomètres, chronomètres à arrêt, mouvements d'horlogerie, balanciers, barillets, pendules, montres-bracelets, réveils-matin, horloges, horloges de contrôle (horloges mères), horloges atomiques, horloges électriques, cadrans solaires; écrins pour l'horlogerie; boîtiers de montre; bracelets de montres, chaînes de montre, ressorts de montre.*
- (3) *Cuir et imitations du cuir, objets d'art en cuir et en imitation de cuir, nommément: canapés, chaises longues, coussins, divans, fauteuils, sofas; étuis pour les clefs, porte-documents, serviettes, portefeuilles, porte monnaie, sacs à main, cartables et serviettes d'écoliers, sacs à dos, sacs à provisions, sacs d'alpinistes, sacs de campeurs, sacs de plage, sacs de voyage, sacs-housses de vêtements pour le voyage, trousse de voyage (maroquinerie); bracelets montres en cuir, peaux d'animaux; malles et valises; parapluies, parasols et cannes; fouets et sellerie.*

[TRADEMARKS JOURNAL TRANSLATION:]

- (1) Preparations for bleaching and other substances for laundry, namely soaps, bleach powders, liquid detergents for bleaching, fabric softeners, javel waters, detergents, spot removers; preparations for cleaning, polishing, removing grease and scouring, namely soaps, waxes, liquid detergents, dishwashing soaps; soaps, namely soap for the body, face and hair; perfumery, essential oils for personal use, cosmetics, namely hairspray, make-up remover

milk, toilet creams, cleansing creams, day creams, make-up foundations, eyeshadow, blushes, mascaras, nail polish, lipstick; hair lotions; dentifrices.

- (2) Precious metals and their alloys; art objects made of precious metals and their alloys, namely canvases, pictures, boxes and chests, key holders; kitchen and household utensils, namely colanders, graters, spatulas, sifters, pot scrapers, pastry rollers, forks, soup spoons, teaspoons, butter knives, steak knives, bread knives; dinnerware, vases, flasks, figurines, statues, compacts, perfume atomizers, spray bottles for perfume, boxes, candy dishes, votive candle holders, candleholders made of precious metals and their alloys; jewellery, precious stones; clocks and timepieces, namely: watches, chronograph watches, stop watches, timepiece movements, balance wheels, barrels, mantel clocks, wristwatches, alarm clocks, clocks, master clocks, atomic clocks, electric clocks, sundials; clock cases; watch cases; watch bands, watch chains, watch springs.
- (3) Leather and imitation leather, art objects made of leather and made of imitation leather, namely loveseats, loungers, cushions, couches, armchairs, sofas; key cases, document holders, portfolios, wallets, change holders, hand bags, satchels and school bags, backpacks, shopping bags, climbing bags, camping bags, beach bags, travel bags, garment bags, travel kits (leatherware); leather watchbands, animal skins; travel trunks and suitcases; umbrellas, parasols and walking sticks; whips and saddlery.

SCHEDULE B

GE GUY ELLIA (& Dessin)—TMA600,611

Goods:

- (1) *Préparations pour blanchir et autres substances pour lessiver, nommément: savons, poudres pour blanchir, liquides détersifs pour blanchir, assouplisseurs de tissus, eaux de javel, détergents, détachants; préparations pour nettoyer, polir, dégraisser et abraser, nommément: savons, cires, liquides détersifs, savons pour laver la vaisselle; savons, nommément: savon pour le corps, le visage et les cheveux; parfumerie; huiles essentielles pour usage personnel, cosmétiques, nommément: laques pour les cheveux, laits démaquillants, crèmes de toilette, crèmes nettoyantes, crèmes de jour, fonds de teint, ombres à paupières, fards, mascaras, vernis à ongles, rouges à lèvres; lotions pour les cheveux; dentifrices..*
- (2) *Métaux précieux et leurs alliages; objets d'art en métaux précieux et leurs alliages, nommément: des toiles, des tableaux, boîtes et coffrets, porte-clefs; objets d'art en cuir et en imitation de cuir, nommément: canapés, chaises longues, coussins, divans, fauteuils, sofas; ustensiles de ménage et de cuisine, nommément: passoires, râpes, spatules, tamis, raclours de casseroles, rouleaux à pâtisserie, fourchettes, cuillères à soupe, cuillères à thé, couteaux à beurre, couteaux à steak, couteaux à pain; vaisselle, vases, flacons, figurines, statuettes, poudriers, pulvérisateurs de parfum, vaporisateurs à parfum, boîtes, bonbonnières, bougeoirs, chandeliers en métaux précieux et leurs alliages; joaillerie, pierres précieuses; horlogerie et instruments chronométriques, nommément: montres, montres chronographes, chronomètres, chronomètres à arrêt, mouvements d'horlogerie, balanciers, barillets, pendules, montres-bracelets, réveils-matin, horloges, horloges de contrôle (horloges mères), horloges atomiques, horloges électriques, cadrans solaires; écrins pour l'horlogerie; boîtiers de montre; bracelets de montres, chaînes de montre, ressorts de montre.*
- (3) *Cuir et imitations du cuir; étuis pour les clefs, porte-documents, serviettes, portefeuilles, porte monnaie, sacs à main, cartables et serviettes d'écoliers, sacs à dos, sacs à provisions, sacs d'alpinistes, sacs de campeurs, sacs de plage, sacs de voyage, sacs-housses de vêtements pour le voyages, trousse de voyage (maroquinerie) ; bracelets montres en cuir, peaux d'animaux; malles et valises; parapluies, parasols et cannes; fouets et sellerie.*

[TRADEMARKS JOURNAL TRANSLATION:]

- (1) Bleaching preparations and other substances for laundry use, namely soaps, bleaching powders, liquid detergent for bleaching, fabric softeners, liquid bleach, detergents, spot removers; preparations for cleaning, polishing, removing grease and scouring, namely soaps, waxes, detergent liquids, soaps for washing dinnerware; soaps, namely soap for the body, face and hair; perfumery; essential oils for personal use; cosmetics, namely hairspray, make-up remover milk, toilet creams, cleansing creams, day creams, make-up foundations, eyeshadow, blush, mascara, nail polish, lipstick; hair lotions; dentifrices.

- (2) Precious metals and their alloys; art objects made of precious metals and their alloys, namely canvases, pictures, boxes and chests, key holders; art objects made of leather and imitation leather, namely chesterfields, loungers, cushions, divans, armchairs, sofas; household and kitchen utensils namely colanders, graters, spatulas, sifters, pan scrapers, rolling pins, forks, soup spoons, teaspoons, butter knives, steak knives, bread knives; dinnerware, vases, flasks, figurines, statues, compacts, perfume atomizers, perfume sprayers, boxes, candy dishes, votive candle holders, candleholders made of precious metals and their alloys; jewellery, precious stones; clocks and timepieces, namely watches, chronograph watches, chronometers, stop watches, watch movements, balances, barrels, wall clocks, wristwatches, alarm clocks, clocks, master clocks (main clocks), atomic clocks, electric clocks, sundials; cases for horology; watch cases; watch bands, watch chains, watch springs.
- (3) Leather and imitation leather; keyholders, briefcases, portfolios, wallets, coin holders, hand bags, satchels and student briefcases, backpacks, shopping bags, hiking bags, camping bags, beach bags, travel bags, garment bags for travel, travel kits (leathercraft); watchbands made of leather, animal skins; travel trunks and suitcases; umbrellas, parasols and walking sticks; whips and saddlery.

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

HEARING DATE 2020-12-14

APPEARANCES

No one appearing For the Registered Owner

Michael Shortt For the Requesting Party

AGENTS OF RECORD

ROBIC For the Registered Owner

Fasken Martineau Dumoulin LLP For the Requesting Party