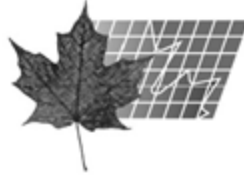


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 122

Date of Decision: 2021-06-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar

Requesting Party

and

NarinderSingh Narry Suriya-Amrit

Registered Owner

TMA686,929 for NARRY'S

Registration

INTRODUCTION

[1] At the request of Smart & Biggar (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 December 12, 2017, to NarinderSingh Narry Suriya-Amrit (the Owner), the owner of registration No. TMA686,929 for the trademark NARRY'S (the Mark).

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

Goods

(1) Clothing, namely pants (except sport pants and underpants), suits, neckties, frocks, dresses, vests, shirts, jackets and overcoats.

Services

(1) Real estate services, namely leasing of real estate, real estate agencies, real estate appraisal, real estate brokerage, real estate development, real estate escrow services, real estate investment, real estate listing, real estate management, real estate syndication, real estate time sharing, vacation real estate time-sharing, real estate trustee services.

[3] The notice required the Owner to furnish evidence showing that he had used the Mark 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, which in this case is between December 12, 2014, and December 12, 2017. If the Mark had not been used within the relevant period, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[4] The relevant definition of “use” for goods and services 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.

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.

[5] 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 a section 45 proceeding 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 and services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Owner furnished his own affidavit, sworn on July 11, 2018.

[7] Only the Requesting Party filed written representations and attended an oral hearing.

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

EVIDENCE AND ANALYSIS

[9] The affidavit is brief and consists of six paragraphs and three exhibits. The Owner states that he is the Founder and Chief Executive Officer of Narry Bespoke Tailors and that he is “responsible for matters relating to the trademark NARRY”. He states that he “currently operates three tailor shops in Thailand under the tradename Narry Bespoke Tailors”.

[10] The Owner states that he “has used the trademark NARRY, or sometimes in the form NARRY’S” in Canada since at least 2007 in association with the registered goods. The Owner refers to multiple photographs of different pieces of clothing filed as Exhibit A. Even though he did not correlate the Exhibit A photographs to any of the registered goods, I note that some of the registered goods appear bearing the Mark, namely, dresses, shirts and pants.

[11] As Exhibit B, the Owner filed different documents and described those documents as “several invoices for Goods sold to Canadian customers bearing the trademark”. He added that these invoices “are representative of such Goods sold during the period December 12 2014, to December 12 2017, to Canadians”. I note that Exhibit B consists of 17 documents, including purchase orders, credit cards receipts, emails and waybills.

[12] The purchase orders are from “Narry’s” followed by a word in a foreign language and the currency appears to be Thai Baht. Although the purchase orders are mostly incomplete, there is some information concerning the customers, including Canadian addresses. However, even when Canadian addresses are used, the customers also indicate their hotel name and room number, implying they resided at a hotel at the time of the purchases. The credit card receipts are all in Thai Baht, implying that the transaction was completed in Thailand. Moreover, in the affidavit, the Owner states that goods were sold to Canadian customers, but did not state if they were sold *in Canada*.

[13] The four air waybills are from “NARRY.COM TAILOR” and are issued to Canadian addresses. The first waybill is dated August 2, 2015, and the description of goods is “S ~~ENEV~~ ENVELOPES”. The other three are dated before the relevant period.

[14] Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], some evidence of transfer in the normal course of trade in Canada is necessary [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. In this case, the Owner does not state in the affidavit that the registered goods were sold in Canada. Instead, it appears that some goods may have been sold to Canadians outside of Canada. While the waybill from the relevant period shows that a product identified as “S ~~ENEV~~ ENVELOPES” was sent to a Canadian address, there is no indication that this item corresponds to any of the registered goods. Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods within the meaning of sections 4 or 45 of the Act.

[15] Finally, the affidavit is silent with respect to the registered services. Furthermore, there are no special circumstances excusing non-use of the Mark in association with the registered goods or services.

DISPOSITION

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

Ann-Laure Brouillette
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-05-20

APPEARANCES

No one appearing

For the Registered Owner

Mark G. Biernacki

For the Requesting Party

AGENTS OF RECORD

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

For the Registered Owner

Smart & Biggar LLP

For the Requesting Party