



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 211**

**Date of Decision: 2021-09-27**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**SMITHS IP**

**Requesting Party**

**and**

**N8ked Brands Inc.**

**Registered Owner**

**TMA933,359 for N8KED**

**Registration**

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA933,359 for the trademark N8KED (the Mark), currently owned by N8ked Brands Inc.

[2] All references are to the Act as amended June 17, 2019 (the Act), unless otherwise noted.

[3] The Mark is presently registered for use in association with the following: nutritional supplements for general health and well being (the Goods).

[4] For the reasons that follow, I conclude that the registration ought to be maintained.

THE PROCEEDINGS AND AMENDMENT TO THE REGISTRATION

[5] At the request of SMITHS IP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on April 24, 2019, to N8ked Brands Inc. (the Owner), the registered owner of the Mark.

[6] At the time of issuance of the notice, the registration was registered for: dietary supplements for general health and well being; nutritional supplements for general health and well being.

[7] The notice required the owner to show whether the trademark 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 April 24, 2016 to April 24, 2019 (the Relevant Period).

[8] 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.

[9] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[10] In the absence of use as defined above, pursuant to section 45(3) of the Act, a registration for a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[11] In response to the Registrar's notice, the Owner furnished an affidavit of David Whalen, sworn November 21, 2019, to which was attached Exhibits DW-1, DW-2 and DW-3.

[12] Only the Owner submitted written submissions and no oral hearing was held.

#### Amendment to the Registration

[13] By way of a letter to the Registrar dated November 22, 2019, the agents for the Owner requested that the registration be amended pursuant to Section 41(1)(c) of the Act to remove the following goods: dietary supplements for general health and well being.

[14] By way of a Notice dated December 4, 2019 the Registrar confirmed the amendment sought and deleted the following goods from the registration: dietary supplements for general health and well being.

#### THE EVIDENCE

[15] In his affidavit, Mr. Whalen states that he is the Director and Co-founder of the Owner, which formulates and sells the Goods in powdered form accompanied by instructions that the Goods are to be mixed by the consumer with a liquid before ingesting the Goods.

[16] In paragraph 11 of his affidavit, Mr. Whalen states that, "Calorie Plus Shake," "...is a nutritional supplement for general health and well being."

[17] Mr. Whalen affirms that the Owner sells the Goods to distributors including 1852884 Ontario Inc. operating as Nutrition Club (Nutrition Club). Mr. Whalen affirms that Nutrition Club sold the Goods in Canada during the Relevant Period.

[18] Mr. Whalen affirms that during the Relevant Period, the Goods have been continuously sold in the form described, in containers labeled with the Mark, in Canada.

[19] To substantiate this allegation Mr. Whalen has attached following exhibits:

- (a) Exhibit DW-1: a picture of a container bearing a label that shows the Mark in a design form. The label shows the phrases “Calorie Plus Shake” and “Supports Daily Protein and Calorie Intake” as well as a volume weight of 1100g.
- (b) Exhibit DW-2: a collection of invoices issued by Nutrition Club which show the Mark as N8ked in the body of the invoices.
- (c) Exhibit DW-3: an invoice representative of those issued by the Owner to Nutrition Club which shows the Mark as N8ked in the body of the invoice.

#### ANALYSIS AND REASONS FOR DECISION

[20] The evidence described above establishes that the Owner has used a mark in Canada in association with the Goods during Relevant Period within the meaning of section 4(1) of the Act as there has been evidence of transfer of property of the Goods in the normal course of trade. The only question is whether the mark as used can constitute use of the registered mark.

#### Deviation from the Mark as Registered

[21] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[22] The Mark is N8KED, with the letters N, K, E and D depicted in plain, upper case lettering and the numeral 8 shown in plain type.

[23] The label appearing on Exhibit DW-1 shows N8ked in fanciful form with the letter N in upper case, followed by the numeral 8, followed by the letters K, E and D in that order, in lower case as illustrated below:



[24] The strongest elements of the Mark are present on the label. The numeral 8, which is the dominant element in the Mark is clearly shown. The use of upper and lower case lettering within N8ked on the label does not detract from the identity of the Mark as registered. The Mark remains recognizable on the label in that the fanciful lettering does not detract from the identity of the Mark.

[25] Customers viewing the label would likely recognize the mark shown thereon as being the registered Mark given the dominance of the numeral 8 and the order of the letters N, k, e and d.

[26] Given the foregoing, the mark illustrated above constitutes a minor variation of the Mark.

Conclusion

[27] In view of the foregoing, I am satisfied that the Owner has shown use of the Mark in Canada in association with the Goods within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[28] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

---

Jean Carrière  
Member  
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**

Gowling WLG

For the Registered Owner

SMITHS IP

For the Requesting Party