



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 095

Date of Decision: 2022-05-11

IN THE MATTER OF A SECTION 45 PROCEEDING

Finlayson & Singlehurst

Requesting Party

and

679503 B.C. Ltd.

Registered Owner

TMA603,258 for IN-LOOK

Registration

OPTICAL

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. TMA603,258 for the trademark IN-LOOK OPTICAL (the Mark).

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

Goods: Sunglasses, prescription glasses, contact lenses, parts and fittings thereof, and accessories thereof namely, lens cloths, glasses cases, contact lens cases, contact lens solutions, and glasses straps and chains.

Services: Optician services; retail sale of sunglasses, prescription glasses, contact lenses.

[3] For the reasons that follow, I conclude that the registration ought to be amended.

THE PROCEEDING

[4] At the request of Finlayson & Singlehurst (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on September 9, 2019 to the registered owner of the Mark, 679503 B.C. Ltd. (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods and services listed 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 September 9, 2016 to September 9, 2019 (the Relevant Period).

[6] The relevant definitions of use in this case 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.

[7] 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. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[8] In the absence of use, pursuant to section 45(3) of the Act, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[9] In response to the Registrar’s notice, the Owner furnished:

- The Affidavit of Michael Tam sworn on December 5, 2019 (the Tam Affidavit) to which were attached Exhibits A to S; and,

- The Affidavit of Allison Kehler sworn on December 6, 2019 (the Kehler Affidavit) to which was attached Exhibit A.

[10] Both parties submitted written representations and both parties attended an oral hearing.

THE EVIDENCE

The Tam Affidavit

[11] Michael Tam is the President of the Owner. He states that he has personal knowledge of the matters in his affidavit unless he has indicated that his statements are based on information and belief.

[12] Mr. Tam states that the Owner has operated, since at least 2003, a store in the Coquitlam Centre in Coquitlam, B.C. at which optician services were provided during the Relevant Period through its employee Jim Chisholm, who Mr. Tam states is a licensed optician. The optician services included the dispensing of eyeglasses and the fitting of contact lenses.

[13] In support, the following relevant exhibits are attached:

- Exhibit A is a printout from the website for the Coquitlam Mall showing the directory listing for the store and displaying the Mark. The “About Us” section reads as follows: “Eye Examination, Men’s Glasses, Women’s Glasses, Children Glasses, Teen’s Glasses, Fashion Frames, Contact Lenses, Sunglasses, Sports Glasses & Children’s Eye Care”.
- Exhibit B is a photograph of the store. Mr. Tam confirms that the signage shown in the photograph, which displays the Mark, has remained the same since at least the beginning of the Relevant Period.
- Exhibit E consists of two business cards which display the Mark, one for Mr. Tam and one for Jim Chisholm. Mr. Chisholm’s card identifies him as “Manager”, “Licensed Optician” and “Contact Lens Fitter”. Mr. Tam states that the business cards were distributed to customers of the store during the Relevant Period.

[14] Mr. Tam states that, in addition to providing optician services at the store, the Owner also provided retail sales of sunglasses, prescription glasses and contact lenses during the Relevant Period. Exhibits F to M are copies of invoices, each of which displays the Mark, for sales of prescription sunglasses, prescription glasses and contact lenses during the Relevant Period.

[15] In addition to the services offered, Mr. Tam states that the Owner has used the Mark in Canada during the Relevant Period on a number of goods including those listed in the registration. In support, he attaches the following exhibits:

- Exhibit N is a photograph of a lens cloth which displays the Mark.
- Exhibit P consists of photographs of a glasses case which displays the Mark.
- Exhibit R is a photograph of a bottle of lens cleaner which displays the Mark.

[16] Exhibits O, Q and S are copies of invoices, each of which displays the Mark, for sales of lens cloths, glasses cases and lens cleaner during the Relevant Period.

[17] Mr. Tam states that all of the invoices attached to his affidavit were printed from the computer accounting records maintained by the Owner. Mr. Tam states that a physical copy of the invoices would have been provided to the customer at the time of sale and that the layout and content of the physical copy would have been identical to the printout except for the date shown in the “date printed” line near the bottom of the invoice.

The Kehler Affidavit

[18] Allison Kehler is a legal secretary employed by Smiths IP, the Trademark Agent for the Owner at the time her affidavit was sworn.

[19] Attached to her affidavit is Exhibit A which she describes as consisting of copies of printouts from the “Find an Optician” section of the website of the College of Opticians of British Columbia located at *www.cobc.ca*. The printouts, each of which has a footer with a web address of *www.opticianry.ca*, show the Member Details pages for James Chisholm with a practice location identified as In-Look Optical in Coquitlam, B.C. He is identified as an eyeglass optician and a registered contact lens fitter.

ANALYSIS AND REASONS FOR DECISION

[20] The Requesting Party submits that the Tam Affidavit is misleading and should be approached with caution because Mr. Tam's assertion of use in respect of "a number of goods including those in the Registration" leads the reader to believe that the Owner has used the Mark in association with all of the goods listed in the registration.

[21] Evidence in a section 45 proceeding must be considered as a whole, and focusing on individual pieces of evidence or individual statements in isolation, as the Requesting Party has done, is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[22] In his affidavit, Mr. Tam provides more than the general assertion criticized by the Requesting Party. In fact, Mr. Tam specifically identifies the goods in evidence, namely the "lens cloth", "glasses case" and "lens cleaner", which display the Mark. As such, I do not view the Tam Affidavit as misleading.

[23] The Requesting Party also submits that the Kehler Affidavit must be ignored because Ms. Kehler was employed by the Trademark Agent for the Owner at the time she swore her affidavit, citing *Cross-Canada Auto Body (Windsor) Ltd v Hyundai Auto Canada*, 2006 FCA 133 which addresses the use of affidavit evidence from members or employees of law firms.

[24] In addition, the Requesting Party notes that, while Ms. Kehler describes Exhibit A as a printout from the website of the College of Opticians of British Columbia at www.cobc.ca, the printout itself shows an address at www.opticianry.ca, and no explanation is provided for the discrepancy.

[25] I do not need to deal with the issues raised by the Requesting Party. The Kehler Affidavit appears to have been submitted merely to corroborate the evidence given by Mr. Tam. As such, it is inconsequential and I have not relied on it in reaching my decision.

Sunglasses, prescription glasses, contact lenses, parts and fittings thereof

[26] At the oral hearing, the Owner conceded that no evidence was submitted with respect to use of the Mark in association with the goods “sunglasses, prescription glasses and contact lenses, parts and fittings thereof”. As there is no evidence of special circumstances excusing non-use of the Mark, those goods will be deleted from the registration.

Accessories thereof namely, lens cloths, glasses cases, contact lens cases, contact lens solutions, and glasses straps and chains

[27] The Tam Affidavit provides invoices for the sale of lens cloths, glasses cases and lens cleaner during the Relevant Period (Exhibits O, Q and S), along with photographs depicting those goods bearing the Mark (Exhibits N, P and R).

[28] The Owner submits that the sale of lens cloths, glasses cases and lens cleaner is sufficient to maintain the entire class of accessories in the registration, citing *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102 at para 79 in support of this proposition. I disagree.

[29] Unlike *Empresa Cubana*, which determined that the sale of cigars and cigarillos supported goods described as “manufactured tobacco for smoking or chewing”, here the Owner has listed specific accessories in the registration. Having done so, the Owner is obligated under section 45 to furnish evidence with respect to each of the specific accessories.

[30] The Tam Affidavit does not provide sufficient facts to conclude that there was use of the Mark in association with all the listed accessories. At best, the Tam Affidavit shows use of the Mark in association with lens cloths and glasses cases (lens cleaners not falling within the statement of goods listed in the registration). However, the Requesting Party submits that the evidence with respect to even those goods is deficient in a number of ways.

[31] First, the Requesting Party submits that there is no evidence as to the Owner’s normal course of trade.

[32] While Mr. Tam may not use the phrase “normal course of trade” in his affidavit, the nature of the Owner’s business, hence its normal course of trade, is described in the Tam Affidavit – the Owner runs a store in a mall that offers optician services and the retail sales of

sunglasses, prescription glasses and contact lenses, as well as lens cloths, glasses cases and lens cleaner.

[33] Accordingly, I am satisfied that there is evidence as to the Owner's normal course of trade.

[34] Secondly, the Requesting Party submits that we do not know if the Owner manufactured the goods in question, who put the Mark on the goods in question and whether control was exercised in the event that the goods were manufactured by a third party.

[35] As noted in *Banana Republic (ITM) Inc v Itochu Corporation*, 2021 TMOB 195, it is proper to presume that the registered owner is the source of the goods in question, unless the evidence indicates otherwise. There being no evidence to indicate otherwise, I have presumed that the Owner is the source of the lens cloths and glasses cases.

[36] Thirdly, the Requesting Party submits that the exhibited invoices are inadmissible hearsay because Mr. Tam did not issue the invoices himself and is not in a position to state that they would have been provided to the customer at the time of sale.

[37] The invoices are provided to prove sales of the goods in question during the Relevant Period. Given Mr. Tam's position and tenure with the Owner, it is reasonable to assume that he would have knowledge of the Owner's activities and I therefore accept his statements with respect to the invoices.

[38] Accordingly, based on Mr. Tam's evidence, I am satisfied that the Owner has demonstrated use of the Mark in Canada in association with lens cloths and glasses cases within the meaning of sections 4(1) and 45 of the Act. As there is no evidence of special circumstances excusing non-use, the remaining accessories, namely "contact lens cases, contact lens solutions, and glasses straps and chains", will be deleted from the registration.

[39] Given the phrasing of the statement of goods as registered (i.e. "sunglasses, prescription glasses, contact lenses, parts and fittings thereof, and accessories thereof namely..."), it is not possible to delete the goods "sunglasses, prescription glasses, contact lenses, parts and fittings thereof" as discussed above without rendering "accessories thereof namely" meaningless.

Accordingly, it is necessary to expand “accessories thereof namely” to read “accessories (for sunglasses, prescription glasses, contact lenses) namely ...” in order to properly limit the scope of the registration to the particular accessories as originally registered [see *StarragHeckert GmbH v World, LLC*, 2014 TMOB 179].

[40] This is not a case where the Registrar is restricting a registration despite use having been shown in association with the registered wares [see *Shapiro Cohen v Trapeze Software Inc* (2000), 8 CPR (4th) 409 (TMOB)]. Here, the amendment is necessary to neither unduly restrict nor unduly broaden the statement of goods in light of the evidence furnished.

Retail sale of sunglasses, prescription glasses, contact lenses

[41] The Tam Affidavit provides invoices, which display the Mark, issued during the Relevant Period for the sale of prescription sunglasses, prescription glasses and contact lenses (Exhibits F to M). The invoices, together with the store signage (Exhibit B), show that the Mark was displayed in the performance of the retail sale services during the Relevant Period.

[42] The Requesting Party made no submissions with respect to the retail sale of sunglasses, prescription glasses and contact lenses other than to argue that the invoices relied upon by the Owner are inadmissible hearsay. As noted above, given Mr. Tam’s position and tenure with the Owner, it is reasonable to assume that he would have knowledge of the Owner’s activities and I therefore accept his statements with respect to the invoices.

[43] Accordingly, based on Mr. Tam’s evidence, I am satisfied that the Owner has demonstrated use of the Mark in in Canada in association with the services “retail sale of sunglasses, prescription glasses, contact lenses” within the meaning of sections 4(2) and 45 of the Act.

Optician services

[44] Mr. Tam states that the Owner used the Mark in association with “optician services”, including the dispensing of eyeglasses and the fitting of contact lenses, which were offered at its store during the Relevant Period, through its employee Mr. Chisholm, a licensed optician. This is accompanied by supporting evidence namely the Owner’s mall listing (Exhibit A), the storefront signage (Exhibit B), the business cards (Exhibit E), and the invoices for the sale of prescription

sunglasses, prescription glasses and contact lenses (Exhibits F to M), all of which display the Mark.

[45] The Requesting Party submits that there is no evidence of a single transaction in relation to optician services.

[46] Section 4(2) of the Act requires proof that the Mark was displayed in the performance or advertising of the services and it is well established that, where the trademark owner is willing and able to perform its services in Canada, use of the trademark in the course of advertising those services meets the requirements of section 4(2) [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. Based on Mr. Tam's evidence, I am satisfied that the Mark was used in the advertising of optician services – see for example the mall listing (Exhibit A), the storefront signage (Exhibit B) and the business cards (Exhibit E).

[47] The Requesting Party also submits that we have no way of knowing that Mr. Chisholm was a licensed optician during the Relevant Period and directed my attention to the British Columbia *Health Professions Act* and the British Columbia *Opticians Regulations*.

[48] Compliance with statutes other than the Act is not a relevant consideration in proceedings under section 45 of the Act [see *Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD), *Renault v Comercializadora Eloro, SA*, 2012 TMOB 132]. Accordingly, even if the Owner was providing optician services without being licensed in the relevant jurisdiction, that does not preclude a finding of use in a section 45 proceeding [see *Essilor Group Canada Inc v Vermillion Networks Inc.*, 2021 TMOB 184 at para 68].

[49] In any event, Mr. Tam states that Mr. Chisholm was a licensed optician during the Relevant Period. Given Mr. Tam's position and tenure with the Owner, it is reasonable to assume that he would have knowledge of the Owner's activities and I therefore accept his statements with respect to the optician services offered by the Owner and with respect to the qualifications of those employed by the Owner.

[50] Accordingly, given Mr. Tam's evidence, I am satisfied that the Owner has established that the Mark was used, at a minimum, in the advertising of optician services during the Relevant Period and that the Owner was willing and able to perform those services, through its employee

Mr. Chisholm, which constitutes use of the Mark in Canada in association with “optician services” within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[51] 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 the following:

Goods: Sunglasses, prescription glasses, contact lenses, parts and fittings thereof, and ... contact lens cases, contact lens solutions, and glasses straps and chains.

[52] Accordingly, 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 read as follow:

Goods: accessories (for sunglasses, prescription glasses, contact lenses) namely, lens cloths, glasses cases

Services: Optician services; retail sale of sunglasses, prescription glasses, contact lenses.

Robert MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2022-02-15

APPEARANCES

Lawrence Chan For the Registered Owner

Daniel Drapeau For the Requesting Party

AGENTS OF RECORD

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Finlayson & Singlehurst For the Requesting Party