

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 242

Date of Decision: 2022-12-01

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Clancy PC

Registered Owner: Russell William Doig Professional Optometric
Corporation

Registration: TMA981,584 for SEE SHARP, LOOK SHARP, LOVE YOUR
GLASSES

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. TMA981,584 for the trademark SEE SHARP, LOOK SHARP, LOVE YOUR GLASSES (the Mark).

[2] The statement of goods and services is reproduced below, together with the associated Nice classes (CI):

Goods

CI 9 (1) Eyewear, namely eyeglasses, sunglasses, lenses for eyeglasses and sunglasses and replacement parts therefore [*sic*]; cases, chains and cords for eyeglasses and sunglasses; eyeglass repair kits; eyeglass lens cleaning solutions; and safety glasses and goggles.

Services

CI 44 (1) Eyeglass fitting services; retail sale of eyeglasses, sunglasses, safety glasses and goggles, eyeglass repair kits, lens cleaning cloths and solutions, contact lens solutions, contact lens cases and contact lens plungers.

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

PROCEEDING

[4] At the request of Clancy PC (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on February 5, 2021, to Russell William Doig Professional Optometric Corporation (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods and services specified 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 February 5, 2018 to February 5, 2021.

[6] The relevant definitions of “use” in the present 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] Where the owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

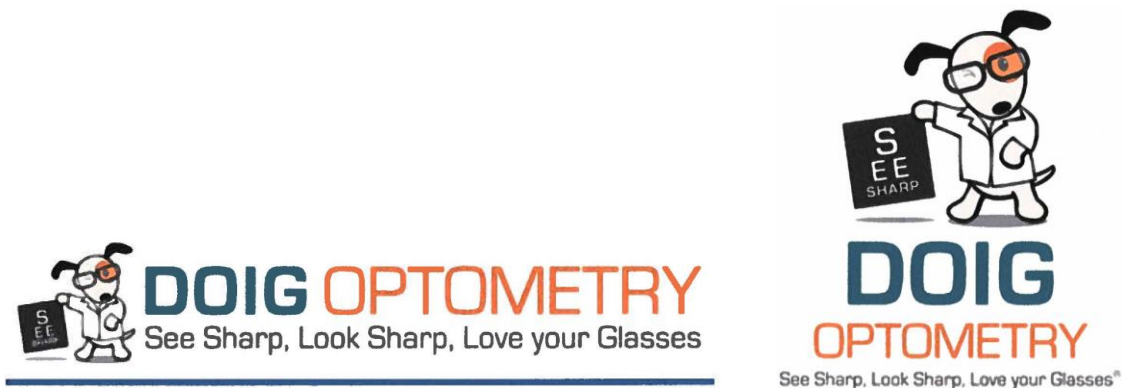
[8] In response to the Registrar’s notice, the Owner furnished an affidavit of Russel W. Doig, sworn on May 4, 2021, to which were attached Exhibits A to X.

[9] Both parties submitted written representations; only the Owner was represented at an oral hearing.

EVIDENCE

Preliminary remarks regarding the Owner’s evidence

[10] Before proceeding with summarizing the Owner’s evidence, I note that while the Mark is registered as a word mark, it appears as composite trademark in the exhibits to Mr. Doig’s affidavit. I reproduce below the two ways the Mark appears throughout the evidence:



[11] In some occurrences both composite trademarks are followed either by the Owner’s address and phone number or by the Owner’s website address and phone number, which appear underneath the logos, in different size and lettering. That being said, I note that the Mark also appears as a word mark.

[12] For ease of reference in the overview of the Owner’s evidence, I will refer hereafter to the first composite trademark as the “Logo 1”, and to the second composite trademark as the “Logo 2”. Otherwise, I will refer generally to the Mark in the overview of the Owner’s evidence and in my analysis below when referring to the word mark as registered. The issue of whether use of the Logo 1 or the Logo 2 constitutes use of the Mark as registered will be discussed further below in the analysis.

Overview of the Owner's evidence

[13] Mr. Doig identifies himself as the Director of the Owner since its incorporation in 2008. He states that the Owner is in the business of providing optometry services, eyewear fitting and repair services, as well as selling eyewear and related goods to its customers. Mr. Doig states that the Owner's customers are primarily located in Calgary, Alberta, and in other parts of Canada, including the Yukon Territories [at paras 1, 4, 7 and 8].

[14] In general, Mr. Doig attests to use of the Mark in association with the goods and services in the normal course of trade of the Owner during the relevant period in Canada. He correlates the goods listed in the statement of goods and services with the invoices submitted in support to his affidavit [at paras 20 to 43].

[15] With respect to "Eyewear, namely eyeglasses, sunglasses" and "safety glasses and goggles", Mr. Doig states that the Owner carries frames for those goods in its showroom, from whose inventory customers may choose frames for purchase. He adds that the customers can also bring their own frames for new lenses and for further services by the Owner [at paras 10 and 11]. With respect to "lenses for eyeglasses and sunglasses" Mr. Doig states that the Owner works with a manufacturing lab to make lenses according to the Owner's specifications and parameters. He explains that each time the Owner's employees work with customers their lenses and eyewear options are outlined in a form called "Patient Transfer of Care", which is used as a quotation of prices for the various lens options. According to Mr. Doig, once the customers make a final selection for purchase, the information contained in the Patient Transfer of Care form is transferred to the manufacturing lab work order. Once the manufacturing lab sends back the lenses edged and inserted into frames, the Owner verifies the lenses by reviewing different parameters involving both the specific prescription and the visual demands of the customers as assessed by the Owner. Mr. Doig also states that once the eyewear has been verified and approved by the Owner, it adjusts the eyewear for fit with its customers and includes the fitting fee in the total cost of the eyewear [at paras 12 to 16 and 36]. With respect to "eyeglass lens cleaning solutions" and "cases",

Mr. Doig states the Owner not only provides them for free to its customers when they purchase eyewear but also has sold them upon request [at para 17].

[16] Regarding all the goods, Mr. Doig states that all purchases are placed into shopping bags displaying the Mark before being handed to customers. [at para 37].

[17] With respect to the use of the Mark in association with the registered services, Mr. Doig states that in addition to the sale of the registered goods, the Owner sells contact lens accessories and cleaning cloths. He also states that customers who have eyewear damaged or broken can bring it to the Owner for repair [at paras 17 to 19].

[18] In support, the following relevant exhibits are attached to Mr. Doig's affidavit:

- Several redacted invoices, dated during the relevant period, showing sales of goods and services. Mr. Doig's correlation with the registered goods and services is as follows: eyeglasses and lenses [Exhibit C]; sunglasses and lenses [Exhibit D]; replacement parts for eyeglasses [Exhibit E]; cases, chains and cords for eyeglasses and sunglasses [Exhibit F]; eyeglass repair kits [Exhibit G]; eyeglass lens cleaning cloths and solutions [Exhibit H]; eyeglass fitting services [Exhibit I]; safety glasses and goggles [Exhibit J]; and contact lens solutions, cases, and plungers [Exhibit K]. Mr. Doig states that all the invoices are representative. The Logo 1 appears on the top of each invoice followed by the Owner's address and phone number. I first note that none of the goods listed in the body of the invoices are identified with the Mark. All the frames for eyeglasses and sunglasses and safety glasses as well as the goggles are clearly identified with third-party's trademarks. The lenses appear to be identified either with third-parties' trademarks or with no trademark. The remaining goods are not identified with any trademark. I also note that while the eyeglasses are always identified as "frames", the sunglasses are often detailed as "sunglass frames". I further note that the lenses are detailed separately from the frames. Finally, I note that the phrase, "Thank you for visiting our new

location!” appears at the bottom of all the invoices after the payment information;

- Photographs showing the exterior and interior of the Owner’s store location [Exhibit L]. Mr. Doig states that the Owner has been operating in this store location since 2016 and that the signage and in-store display shown in the photographs were installed at that time. The Logo 1 is displayed outside near the entrance door and the Logo 2 is displayed on the in-store walls and on the computer’s screens. The Logo 2 is also displayed on the showcases, in close proximity to the eyeglasses and sunglasses frames;
- Four photographs of eyeglass lens cleaning cloths and solutions, and eyeglass cases [Exhibit N]. Mr. Doig states that these photographs are representative. He also states that the Owner has been using the same branding on these goods since as early as 2016. The photographs show two eyeglass lens cleaning solutions, two different eyeglass cases and two eyeglass lens cleaning cloths along with a pair of eyeglasses. The Logo 1 is displayed followed by the Owner’s website address and phone number on the lens cleaning solution. The Logo 2 and the Mark are displayed on the lens cleaning cloths and cases, respectively;
- One original sample of the Owner’s letterhead and two redacted copies of what Mr. Doig identifies as “Patient Referral letters”, dated during the relevant period and printed on letterhead paper [Exhibit P]. Although Mr. Doig does not explain what the Patient Referral letters are for, he states that the letterhead is representative. I note that the words “Quality Eyewear”, “Fashion Frames”, “Sunglasses” and “Safety Glasses” are listed in the body of the documents. The Logo 1 is displayed on the top of the sample and Patient Referral Letters;
- Three redacted copies of what Mr. Doig identifies as “Patient Transfer of Care forms” dated during the relevant period [Exhibit Q]. Mr. Doig states that once completed, this document is attached to the customer’s clinical record. The Mark appears on the bottom of the forms beneath the words

“Doig Optometry”. The words “Progressive Lenses” and “Lens Design” appear in the forms;

- A photograph of one shopping bag [Exhibit R]. Mr. Doig states that this is “a representative product bag displaying the Mark, the Mark is shown in a similar manner on all of the product bags in which all purchased goods...are placed before the same are handed to customers including during the Relevant Period”. I note that even though the photograph is slightly blurred, I can distinguish that the Logo 2 is displayed on the bag followed by the Owner’s website address and phone number;
- Five printouts taken from the Internet Archive system WayBack Machine corresponding to the January 28, 2019 version of the Owner's website <https://doigoptometry.com> [Exhibit V]. The Mark appears as a word mark preceded by “Doig Optometry” on the top of the first webpage, which includes a “Second Pair Sale” promotion announcing 50% off for the second set of lenses and 30% off for the second set of frames. I also note that eyeglasses, sunglasses, contact lenses and safety glasses are listed under the heading “Optometry Services Calgary” on the second page. The Owner’s retail store address in Calgary, phone number and working hours appear on the last page.

ANALYSIS AND REASONS FOR DECISION

[19] In its written representations, the Requesting Party made numerous submissions with respect to the Doig affidavit and accompanying exhibits. In general, it qualifies the evidence as deficient and ambiguous. For example, the Requesting Party submits that all the photographs must be disregarded as they were taken after the relevant period. Another deficiency alleged by the Requesting Party is that the advertised services in the exhibits are not identified in the Doig affidavit. However, in the context of section 45 proceedings, it is the evidence as a whole that must be considered and focusing on individual pieces of evidence is not the correct approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)]. Thus, the affidavit should be analyzed as a whole and the exhibits thereto reviewed in conjunction with the

information provided in the affidavit. Otherwise, the Requesting Party's core arguments are related to the following questions: (i) whether the evidence constitutes inadmissible hearsay; (ii) whether the evidence is invalid as it shows a composite trademark; (iii) whether the normal course of trade is described; and (iv) whether the evidence shows use of the Mark in association with *each* of the goods and services specified in the registration.

The hearsay evidence

[20] The Requesting Party submits that the printouts taken from the Wayback Machine [Exhibit V] constitute inadmissible hearsay as they emanate from a third-party website. In support, the Requesting Party relies on *Bereskin & Parr v Mövenpick-Holding* (2008), 69 CPR (4th) 243 (TMOB), and submits that the Doig affidavit does not establish the necessity of submitting such hearsay evidence. In response, the Owner submits that since *ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056, aff'd 2005 FCA 96, the evidence of archived websites has been found to be generally reliable.

[21] I first note that in the *Mövenpick-Holding* case, the Registrar distinguished the *ITV* case and decided that the Wayback Machine evidence was inadmissible as the registered owner had not met the tests of reliability and necessity. That being said, I also note that the case relied on by the Requesting Party predates *Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18, where the Federal Court held at paragraph 18 that considering the summary nature of section 45 proceedings, "concerns with respect to the hearsay nature of evidence can go to weight, rather than admissibility". Accordingly, I disagree with the Requesting Party's contention that the Wayback Machine printouts must be disregarded.

The composite trademark in the evidence

[22] The Requesting Party submits that the evidence shows composite trademarks, where the Mark is "dwarfed" by the words "DOIG OPTOMETRY". Qualifying those words as the "overwhelmingly dominant portion" of the composite trademarks, it submits that the differences between the composite trademarks and the Mark are such that an unaware purchaser cannot infer that they identify goods or services having the same

origin. Regardless of the design features, the Requesting Party considers that the words added to the Mark substantially alter its dominant feature visually, phonetically and in the idea suggested. It therefore submits that all the evidence is invalid and that the registration should be expunged on this basis alone. Finally, it submits that the Mark operates as a mere descriptor of what one can expect when dealing with the Owner.

[23] In response, the Owner submits that its use of the composite trademark constitutes use of the Mark *per se* as there are no words surrounding the Mark which alter the way it is read or its meaning. It also submits that the dominant feature of the Mark as registered has been preserved. The Owner further submits that where a trademark is used in proximity to the owner's trade name or "house mark" such use can be considered as use of two separate trademarks.

[24] Generally, use of a trademark in combination with additional words or design features qualifies as use of that trademark when the public, as a matter of first impression, would perceive the mark *per se* as being used. This is a question of fact which is dependent on whether the mark stands out from the additional material, for example, by the use of different lettering or sizing, or whether the additional material would be perceived as clearly descriptive or as a separate trademark or tradename [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[25] Applying the test set forth above to the present case, I do not consider the addition of the words "DOIG OPTOMETRY" to substantially alter the dominant features of the Mark. Although the word mark appears beneath the words "DOIG OPTOMETRY", it is displayed all in one line in a different style, font and size. Furthermore, the words and design surrounding the Mark do not alter the way it is read or its meaning. Thus, when the Mark is considered with the additional words and design, I find that the public, as a matter of first impression, would perceived the Mark *per se* as being used. I also find that an unaware purchaser can easily infer that the composite marks and the Mark identify goods or services having the same origin. In this respect, I agree with the Owner that, as a matter of first impression, the public would perceive the Mark and

“DOIG OPTOMETRY” as forming two separate trademarks. In this respect, I note that there is nothing in the Act that precludes a trademark owner from using more than one trademark at the same time in association with the same goods or services [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)]. Therefore, I accept that use of the composite trademarks throughout the evidence amounts to use of the Mark for the purpose of this proceeding.

[26] Finally, with respect to the Requesting Party’s argument that the Mark operates as a mere descriptor of what one can expect when dealing with the Owner, it is well established that section 45 proceedings are not intended to determine substantive rights such as ownership, distinctiveness, descriptiveness or abandonment of a registered trademark [see *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66; *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at 294].

The normal course of trade of the Owner

[27] The Requesting Party submits that the Owner has not described its normal course of trade. In particular, the Requesting Party points out that, excepted for the lenses, the Owner failed to explain the distribution chain from the manufacturer to the end-consumers. The Requesting Party further submits that the evidence is silent as to the requisite control over the character and quality of the goods sold by the Owner.

[28] On its face, the evidence as a whole shows that the Owner’s normal course of trade consists of providing optometry and related services, as well as retail sale of eyewear and accessories to its customers in Calgary. Although the Requesting Party suggests that section 50 of the Act applies by questioning whether the Owner had control over the character or quality of the goods, there is no licensing issue in this case. Indeed, the Owner is not claiming the benefit of the use of the Mark by any third party. Therefore, the relevant question is whether the Owner itself has demonstrated use of the Mark within the meaning of the Act.

The use of the Mark in association with each of the registered goods

[29] The Requesting Party points out that, excepted for cases and lens cleaning solutions, there is no image of any good displaying the Mark. It also points out that third parties' trademarks appear in the body of the invoices rather than the Mark. Further, the Requesting Party points out that the Doig affidavit fails to mention that the invoices were remitted to the purchasers at the time of transfer. Relying on *Boutiques Progolff Inc. c. Canada (Registraire des marques de commerce)*, (1989) 27 CIPR 3 at paras 11-13 [*Progolff*], it submits that the evidence does not demonstrate use of the Mark.

[30] The Owner, on the other hand, submits that the evidence as a whole shows use of the Mark in association with each of the goods covered by the registration. In particular, it states:

The [Mark] is presented to consumers by the Owner at every step of the customer's experience with the Owner, from experiencing advertising of the Owner, to seeing the branded business premises and material where goods (...) are purchased and received, to walking home with branded goods in a branded shopping bag [Owner's written representations, para 10.1].

[31] With respect to the invoices, I first note that not all the goods listed in the registration are included in the invoices. Further, contrary to the Requesting Party's submission, not all the goods listed on the invoices are identified with third-parties' trademarks. More particularly, as noted above, "Eyewear, namely eyeglasses, sunglasses" and "safety glasses and goggles", are identified with third-parties' trademarks on the invoices, "lenses for eyeglasses and sunglasses" are mostly identified with third-parties' trademarks, and "cases", "cords", "lens cleaner solutions" and "eyeglass repair kits" are not identified with any trademark.

[32] In any event, as none of the goods listed in the invoices are identified with the Mark in the description field, the fact that the invoices were not remitted to the purchasers at the time of transfer is not relevant to consider. That being said, I accept such invoices as evidence of transfer of the goods identified therein within the normal course of trade of the Owner.

[33] Finally, as noted by the Requesting Party, the evidence includes photographs of some goods only. Therefore, for the goods sold for which there is no photograph displaying the Mark on the goods themselves or on their packages, the question is whether notice of association was given “in any other manner” to customers at the time of transfer of the goods. In this respect, I note that while it is true that the display of a trademark on signage or in-store displays in close proximity to goods at the time of transfer of possession of those goods may satisfy the requirements of section 4(1) of the Act, each case must be considered on its own merits and the context is important [see *McMillan LLP v April Cornell Holdings Ltd*, 2015 TMOB 111 at para 24]. The issue of the association of the Mark with the goods will be analyzed in turn below.

“Eyewear, namely eyeglasses, sunglasses, lenses for eyeglasses and sunglasses; and safety glasses and goggles”

[34] While the Owner acknowledges that the frames are made by third parties, it considers that “[f]rames without lenses are not eyeglasses or sunglasses or safety glasses or safety goggles” and that the lenses ordered by the Owner from the manufacturing lab are “a required element of the ultimate eyewear”. In this respect, the Owner submits that “[b]ecause it isn’t reasonable to expect the Owner to affix the [Mark] to the lenses of the eyewear” it has displayed the Mark during the purchasing process and in materials used for the eyewear and lenses selection. The Owner submits that the Mark is also displayed on the eyewear cases and on shopping bags handed to its customers upon purchase of the goods. [Owner’s written representations, paras 10.1 and 10.2.1].

[35] With respect to the materials used during the purchasing process, namely the Patient Transfer of Care forms and the Patient Referral letters, I find that they are not of assistance to the Owner. In my view, the fact that the words “Quality Eyewear”, “Fashion Frames”, “Sunglasses” and “Safety Glasses” are listed in the body of the Patient Referral Letters does not show how the Mark is associated in any other manner with the goods themselves. The same applies to the Patient Transfer of Care forms where the lenses’ features or characteristics appear. Therefore, although the Patient Transfer of Care forms and the Patient Referral letters display the Mark and are used

during the purchasing process, they do not qualify as use of the Mark in association with eyewear, namely eyeglasses, sunglasses, lenses for eyeglasses and sunglasses; and safety glasses and goggles [see *Burroughs Wellcom Inc. v Kirby, Shapiro, Eades & Cohen* (1983), 73 CPR. (2d) 13 (FCTD); and *Progolf* at paras 12 and 13].

[36] With respect to the in-store display of the Mark, while I agree that the lenses are a required element of the ultimate eyewear sold by the Owner, none of the photographs show the Mark in close proximity to lenses. Rather, the Mark is displayed near eyeglasses and sunglasses frames which are identified with third-party's trademarks in the invoices. To the extent that the lenses are to be inserted into the frames off-site, I cannot conclude that the Mark on in-store displays is associated with complete "eyewear, namely eyeglasses and sunglasses". As for "safety glasses and goggles", the evidence does not show the Mark displayed in close proximity either to them or to their lenses. Thus, per *April Cornell, supra*, I find that the in-store display is associated with the Owner's activities rather than with these goods.

[37] With respect to the customer bags, it has been held that the act of placing goods bearing third-party marks into a shopping bag bearing a trademark at the time of purchase is insufficient, on its own, to establish use of that trademark in association with the third-party goods [see, for example, *6438423 Canada Inc v Consumers Nutrition Center Ltd*, 2009 CanLII 82134 (TMOB) at paras 12-14; and *Moffat & Co v Big Erics Inc*, 2015 TMOB 52 at para 17]. As safety glasses, eyeglasses and sunglasses frames, which include lenses inserted into them, as well as the goggles are all identified with third-party trademarks in the invoices, the display of the Mark on shopping bags is not enough on its own to establish use of the Mark in association with such goods.

[38] Finally, with respect to the cases to hold eyeglasses, sunglasses, safety glasses and goggles, I note that they are among the registered goods and, therefore, the display of the Mark on them at the time of transfer amounts to use in association with cases. Accepting that the branded cases also constitute display of the Mark in association with the eyewear they hold would be tantamount to accepting the same use to maintain two different and distinct goods. In this respect, it has been established that use in

association with one specific good cannot generally serve to maintain multiple goods within the statement of goods, as the Owner is required to provide evidence of use for *each* of the registered goods [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Similar to my finding above that display of the Mark on shopping bags is insufficient to establish use in association with third-party-branded eyewear, I am not satisfied that display of the Mark on cases constitutes use in association with such eyewear.

[39] Therefore, I agree with the Requesting Party that this case is similar to *Progold* as the Owner neither provided photographs of the goods displaying the Mark nor established that the Mark was “in any other manner” associated with any of them. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark in association with “Eyewear, namely eyeglasses, sunglasses, lenses for eyeglasses and sunglasses; and safety glasses and goggles”, the registration will be amended accordingly.

“Cases and lens cleaning solutions”

[40] It is well established that that an affiant’s statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25]. Furthermore, representative evidence can be furnished in section 45 proceedings, and reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64].

[41] In the present case, the evidence includes photographs of “cases” and “lens cleaning solutions” [Exhibit N]. Mr. Doig clearly attests that these photographs are representative of the way the Mark was displayed on the goods [Doig affidavit, para 33]. The evidence also includes invoices related to these products sold in the normal course of trade of the Owner during the relevant period [Exhibit F, page 24 and Exhibit H, page 27].

[42] Given the representative photographs submitted in support to the Doig affidavit, I can conclude that notice of association was given at the delivery of cases and lens

cleaning solutions. As for the evidence of transfer to the Owner's customers, given that cases and lens cleaning solutions are not identified with any trademark in the description field of the invoices, I accept that such invoices demonstrate sales of the products shown in the photographs during the relevant period.

[43] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with "cases (for eyeglasses and sunglasses)" and "lens cleaning solutions" within the meaning of the Act.

"Replacement parts; chains and cords for eyeglasses and sunglasses; eyeglass repair kits"

[44] To begin with, the evidence does not show transfer for all these goods as only "replacement parts", "cords for eyeglasses" and "repair kits" are listed in the invoices [Exhibits E, pages 19, 21 and 31; Exhibit G, page 25; and Exhibit F, pages 22 and 23].

[45] Regarding the "cords for sunglasses", the Owner submitted at the hearing, and I agree, that cords for eyeglasses fit any kind of eyewear and can therefore be used for sunglasses. Similarly, in my view, replacement parts for eyewear, such as nose pads for eyeglasses also fit sunglasses.

[46] Regarding the "chains" (for eyeglasses and sunglasses), the Owner submitted at the hearing that cords and chains are essentially the same product as they are in the same class. However, it is clear from *John Labatt, supra*, that where the registrant chooses to specify differences between goods of the same class, the implication in the absence of proof to the contrary is that one good is somewhat different from the other and, therefore, that use must be shown for each of them. Given that there is neither evidence of notice of association nor evidence of transfer for "chains for eyeglasses and sunglasses", I am not satisfied that the Owner has demonstrated use of the Mark within the meaning of the Act. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark in association with "chains for eyeglasses and sunglasses", the registration will be amended accordingly.

[47] Regarding replacement parts for lenses, the Owner submitted at the hearing that a replacement for a lens is another lens. While I agree with the underlying principle of its submission, the evidence only show sales of lenses along with frames. As no lens appears to be sold separately, as a replacement part, I am not satisfied that the Owner has demonstrated use of the Mark in association with them within the meaning of the Act. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark in association with lenses as replacement parts, the registration will be amended accordingly.

[48] I will now address the issue of the display of the Mark “in any other manner” in association with “replacement parts (for eyeglasses and sunglasses)”, “cords (for eyeglasses and sunglasses)” and “eyeglass repair kits”. Taking in consideration the evidence provided, I find that use of the Mark “in any other manner” is shown in association with them as Mr. Doig attests that these goods were included in shopping bags upon purchase during the relevant period and as none of these goods are identified with third-party trademarks in the invoices.

[49] Therefore, I am satisfied that the Owner has demonstrated use of the Mark in association with “replacement parts”, “cords for eyeglasses and sunglasses”; and “eyeglass repair kits” within the meaning of the Act.

The use of the Mark in association with each of the registered services

[50] The Requesting Party submits that the Owner failed to show use of the Mark in association with *each* registered service. In particular, it submits that the invoices are not of assistance to the Owner as the Doig Affidavit fails to mention that they were remitted to the purchaser at the time the services were performed. It further submits that the service identified as “Repairs – Solder” in one of the invoices [Exhibit I, page 32] is a “repair service” and not a “fitting service”.

[51] Contrary to the Requesting Party’s submission, a registered owner need not provide an invoice during the performance of its services to establish use of a trademark in association with them. The Owner’s burden is to show that the Mark was displayed in the performance or advertising of its services and, in the absence of actual performance

of the services, that the Owner was willing and able to perform them in Canada during the relevant period [section 4(2) and *Wenward (Canada) Ltd v Dynaturf Co (1976)*, 28 CPR (2d) 20 (TMOB)].

[52] In the present case, Mr. Doig includes photographs showing the Mark displayed outside and inside the retail store and he states they are representative. Further, he also includes the Owner's website screenshots, the Patient Referral letters and Patient Transfer of Care forms, all of them dated during the relevant period, and all displaying the Mark and listing the Owner's goods. Therefore, I find that the Owner has sufficiently demonstrated the advertisement of its retail sale services during the relevant period. Furthermore, the phrase "Thank you for visiting our new location!" appearing at the bottom of the invoices clearly indicates that sales were made in the store, and therefore that retail sales were provided by the Owner during the relevant period. Accordingly, I am satisfied that sufficient evidence has been shown with respect to the retail sale services related to the list of goods reproduced below with their respective invoice.

Eyeglasses (Exhibit C), sunglasses (Exhibit D), safety glasses and goggles (Exhibit J, pages 34 and 35), eyeglass repair kits (Exhibit G), lens cleaning cloths and solutions (Exhibit H, pages 27 and 29), contact lens solutions, and contact lens plungers (Exhibit K, pages 38 and 40).

[53] In contrast, I find the evidence to be insufficient to demonstrate use of the Mark with respect to retail sale of contact lens cases as there is no sale of such cases within the evidence. As for their advertising, only contact lenses are listed in one of the Owner's website printouts under the heading "Optometry Services Calgary". Without further particulars from Mr. Doig, I am not prepared to conclude that the optometry services related to contact lenses would encompass the retail sale of their cases. Therefore, I am not satisfied that the Owner has demonstrated use of the Mark in association with retail sale of contact lens cases within the meaning of sections 4(2) and 45 of the Act. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark in association with this service, the registration will be amended accordingly.

[54] Finally, regarding the “Eyeglass fitting services”, it has been established that services should be given a liberal interpretation and each case should be decided on its own facts [see *Heenan Blaikie LLP v Sports Authority Michigan Inc*, 2011 FC 273; and *Kraft Ltd v Registrar of Trade-marks*, 1984 CanLII 5398 (FC), [1984] 2 FC 874, 1 CPR (3d) 457 at paras 8-9]. Applying these principles to the present case and given the extent of the Owner’s activities, I find it reasonable to consider the “repair services”, included in one of the invoices, as equivalent to “fitting services”. In any event, another invoice includes a “frame adjustment” [Exhibit I, page 31], which I also find equates to “fitting services”. Although Mr. Doig states that this service is included in the total cost of the eyewear [Doig affidavit, paras 16], I note that the eyewear fitting service was also sold separately by the Owner. Accordingly, I find that the Owner has demonstrated that the “Eyeglass fitting services” were provided in Canada during the relevant period.

[55] For all the reasons above, I am satisfied that the Owner has demonstrated use of the Mark in association with “Replacement parts (for eyewear, namely eyeglasses and sunglasses); cases and cords for eyeglasses and sunglasses; eyeglass repair kits; eyeglass lens cleaning solutions” within the meaning of sections 4(1) and 45 of the Act. I am also satisfied that the Owner has demonstrated use of the Mark in association with “Eyeglass fitting services; retail sale of eyeglasses, sunglasses, safety glasses and goggles, eyeglass repair kits, lens cleaning cloths and solutions, contact lens solutions and contact lens plungers” within the meaning of sections 4(2) and 45 of the Act. In contrast, I find the evidence to be insufficient to demonstrate use of the Mark with respect to the following goods: “Eyewear, namely eyeglasses, sunglasses, lenses for eyeglasses and sunglasses and replacement parts for lenses; chains for eyeglasses and sunglasses”, and with respect to the following service: “retail sale of contact lens cases”.

DISPOSITION

[56] 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 delete the following goods and services from the statement of goods and services:

Goods

Eyewear, namely eyeglasses, sunglasses, lenses for eyeglasses and sunglasses ...; chains... and safety glasses and goggles.

Services

(Retail sale of) contact lens cases.

[57] Consequently, the amended statement of goods and services will read as follows:

Goods

CI 9 (1) Replacement parts (for eyewear, namely eyeglasses and sunglasses); cases and cords for eyeglasses and sunglasses; eyeglass repair kits; eyeglass lens cleaning solutions.

Services

CI 44 (1) Eyeglass fitting services; retail sale of eyeglasses, sunglasses, safety glasses and goggles, eyeglass repair kits, lens cleaning cloths and solutions, contact lens solutions, and contact lens plungers.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2022-10-12

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Lisa Hutchinson

AGENTS OF RECORD

For the Requesting Party: Drapeaulex Inc.

For the Registered Owner: 20/20 Law Group