



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 015

Date of Decision: 2023-01-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Osler, Hoskin & Harcourt LLP

Registered Owner: Global Protection Corp.

Registration: TMA810,905 for LUX

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. TMA810,905 for the trademark LUX (the Mark).

[2] The Mark is registered for use in association with “Personal lubricants”.

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

PROCEEDING

[4] At the request of Osler, Hoskin & Harcourt LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on December 24, 2020, to Global Protection Corp. (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 the good 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 December 24, 2017 to December 24, 2020.

[6] The relevant definition of “use” in the present case 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.

[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 Arthur Kaynor, sworn in Massachusetts, on July 16, 2021, to which were attached Exhibits A to F.

[9] Neither party submitted written representations and no oral hearing was held.

EVIDENCE

[10] In his affidavit, Mr. Kaynor identifies himself as the Owner’s Director of Strategic Operations and Public Sector. He states that the Owner, an U.S.-located company, is a world leader in the manufacture and sale of sexual health products, including condoms and personal lubricants [at paras 1 and 5].

[11] Mr. Kaynor states that the Owner manufactures and sells a variety of condoms and personal lubricants under a number of different brand lines including the ONE brand. He further states that the Owner uses the Mark in association with a silicone based personal lubricant under the umbrella of the ONE brand line. In particular, he states that the Owner's lubricants are available in Canada in two formats: a 100ml bottle and a 3ml sachet [at paras 8 and 9].

[12] Mr. Kaynor also states that the Owner sells its personal lubricants directly to customers in Canada through its online store *www.onecondoms.com*, as well as to retailers and distributors in Canada, including Shoppers Drug Mark and Pamco Distributing Inc. He attests that the Owner sold in excess of US\$ 500,000 of its personal lubricant in Canada during the relevant period [at paras 10 and 16].

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

- Exhibit A consists of two images of a 100ml bottle and one image of a 3ml sachet of personal lubricants. Mr. Kaynor states that the images are representative examples of how the Mark was displayed on the products' packaging in Canada during the relevant period. I note that the bottle and sachet prominently display the Mark, and that the ® and TM symbols appear after the Mark on the bottle and sachet.
- Exhibit F consists of several copies of redacted invoices detailing sales of personal lubricants. Mr. Kaynor attests that the products detailed in the invoices were delivered to customers in Canada during the relevant period. I note that the invoices are issued by the Owner to addresses in Canada and that they are dated during the relevant period. Both formats of the products are identified with the Mark in the description field of the invoices.

REASONS FOR DECISION

[14] 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. As such, the evidentiary threshold that the registered owner must meet is

quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 38] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the mark was used in association with the registered goods.

[15] In the present case, the evidence includes images of personal lubricant in bottle and sachet formats bearing the Mark and Mr. Kaynor states they are representative examples of how the Mark was displayed on the products’ packaging in Canada during the relevant period. The evidence also includes invoices showing sales of these products in Canada during the relevant period. Given Mr. Kaynor’s statements and the documentary evidence, I find it reasonable to conclude that the bottle and sachet shown on the images correspond to the products invoiced and delivered to Canadian customers during the relevant period. Although Mr. Kaynor does not state that the invoices accompanied the products at the delivery, given his statement that the images are representative, I accept that the required notice of association was given to Canadian customers in a direct way at the time of transfer of possession, namely upon delivery of the goods.

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

DISPOSITION

[17] 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 maintained.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

No hearing held

AGENTS OF RECORD

For the Requesting Party: Osler, Hoskin & Harcourt LLP

For the Registered Owner: Gowling WLG (Canada) LLP