



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 069

**Date of Decision:** 2023-04-18

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

**Requesting Party:** Finlayson & Singlehurst

**Registered Owner:** Alcon Inc.

**Registration:** TMA412,177 for FRESH LOOK

### **INTRODUCTION**

[1] This is a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA412,177 for the trademark FRESH LOOK (the Mark) registered for use in association with “disposable contact lenses” (the Goods).

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

## **THE PROCEEDING**

[3] At the request of Finlayson & Singlehurst (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 9, 2021 to the registered owner of the Mark, Alcon Inc. (the Owner).

[4] The notice required the Owner to show whether the Mark was used in Canada in association with the Goods 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 November 9, 2018 to November 9, 2021 (the Relevant Period). In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[5] The relevant definition of use in the present case is set out in section 4(1) of the Act as follows:

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.

[6] 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; the 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 [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[7] In response to the Registrar's notice, the Owner furnished the Affidavit of Vanessa Johari-Hansen, sworn on June 2, 2022, together with Exhibits A to D.

[8] Both parties submitted written representations. No hearing was held.

## **THE EVIDENCE**

[9] Ms. Johari-Hansen is the Director of Marketing, Vision Care, of Alcon Canada Inc. (Alcon Canada), a wholly owned subsidiary of the Owner.

[10] Ms. Johari-Hansen states that the Owner acquired the Mark from Novartis AG via a *nunc pro tunc* assignment effective April 8, 2019, which assignment was recorded against the registration on September 27, 2019. The Registrar has a discretion to review the state of the register [*True Software Scandinavia AB v Ontech Technologies Inc*, 2018 TMOB 40] and I have done so to confirm that a change of title in favour of the Owner was recorded on September 27, 2019.

[11] Ms. Johari-Hansen goes on to state that the Owner distributes its products in Canada through Alcon Canada. She also states that Alcon Canada is licensed by the Owner to use the Mark in Canada in association with the Goods and that the Owner maintains care and control over the nature and quality of the Goods in association with which the Mark is used in Canada.

[12] Ms. Johari-Hansen states that the Owner sold the Goods in Canada in association with the Mark during the Relevant Period through various online Canadian retailers such as Clearly and through Canadian distributors such as Essilor Luxottica Canada, Inc. In support, she provides the following:

- (a) Exhibit A – a printout from the Clearly website at *clearly.ca* showing packaging for the Goods, which packaging displays FRESHLOOK (*i.e.* as one word). Ms. Johari-Hansen states that the printout is representative of the manner in which the Goods displaying the Mark were available in the product catalogue available on *clearly.ca* in Canada during the Relevant Period.
- (b) Exhibit B – an image of packaging for the Goods, labelled “FreshLook One Day Color Contact Lenses”. Ms. Johari-Hansen says the image is representative of the packaging used for the Goods sold in Canada during the Relevant Period.
- (c) Exhibit C – a copy of an invoice dated September 16, 2020 from Alcon Canada to Essilor Luxottica Canada, Inc., Clearly Division, with an address in Vancouver, B.C.

The invoice lists several entries for FRESHLOOK 1D (which I infer is a reference to FRESHLOOK One Day) for a total value in excess of \$12,000.

- (d) Exhibit D – a 2020 Alcon Parameter Guide distributed by Alcon Canada to Canadian eye care practitioners for use in prescribing contact lenses to their patients. The Guide lists FreshLook One-Day contact lenses under the heading “Beauty Lenses”.

### **ANALYSIS AND REASONS FOR DECISION**

[13] The Requesting Party submits that the evidence does not show use of the Mark as registered (*i.e.* FRESH LOOK as two words); rather, the evidence shows use of FRESHLOOK as one word.

[14] The Requesting Party also submits that the Owner is barred from arguing that evidence of use of FRESHLOOK constitutes use of the Mark and points to facts not in the evidence in this proceeding, namely that the Owner owns registration No. TMA927,940 for FRESHLOOK (as one word). These submissions will be disregarded [*Ridout & Maybee LLP v Encore Marketing International Inc* (2009), 72 CPR (4th) 204 (TMOB)] - I must decide this matter on the evidence before me in this proceeding.

[15] The question for me to determine is whether the Mark remained recognizable, in spite of the differences between the form in which it was registered (two words) and the form in which it was used (one word) [*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 Mark 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 Mark is a question of fact to be determined on a case-by-case basis.

[16] Comparing FRESH LOOK and FRESHLOOK, the overall impression created by FRESH LOOK is not lost, nor has FRESH LOOK lost its identity by virtue of the absence of a space between the two words. The Mark remains recognizable and the

dominant feature of the Mark, namely the words FRESH and LOOK in combination is still present (the space between the two words is not a dominant feature of the Mark). The dominant feature having been preserved, I conclude that the display of the FRESHLOOK constitutes a display of the Mark.

[17] I am also satisfied that the Goods were sold in Canada during the Relevant Period in packages which displayed the Mark.

[18] Ms. Johari-Hansen states that Alcon Canada was licensed by the Owner to use the Mark, subject to the Owner's care and control as to the nature and quality of the goods sold in association with the Mark. Based on her evidence, I am satisfied that a license was in place and that the requisite control was exercised [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102]. Accordingly, I am satisfied that the evidenced use of the Mark by Alcon Canada enures to the Owner's benefit pursuant to section 50 of the Act.

[19] Further, the evidence shows that the Mark was displayed on the packaging in which the Goods were sold in Canada (Exhibit B).

[20] Finally, the evidence shows that there was a sale of the goods in Canada during the Relevant Period, namely on September 16, 2020 (subsequent to the recordal of the assignment) from Alcon Canada to Essilor Luxottica Canada, Inc., Clearly Division.

[21] Evidence of a single sale can be sufficient to establish use for the purposes of section 45 so long as it follows the pattern of a genuine commercial transaction and is not seen as deliberately manufactured or contrived to protect the registration [*Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. Based on the evidence as a whole, I am satisfied that the evidence of a single sale follows the pattern of a genuine commercial transaction.

[22] Accordingly, I am satisfied that the Mark was used in Canada by the Owner in association with the Goods during the Relevant Period within the meaning of sections 4(1) and 45 of the Act.

**DISPOSITION**

[23] 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.

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Robert A. MacDonald  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** Finlayson & Singlehurst

**For the Registered Owner:** Miller IP Law