



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 070

Date of Decision: 2023-04-18

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Finlayson & Singlehurst

Registered Owner: Alcon Inc.

Registration: TMA656,925 for FRESHLOOK DIMENSIONS

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. TMA656,925 for the trademark FRESHLOOK DIMENSIONS (the Mark) registered for use in association with “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 E.

[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 B – a printout from the Clearly website at *clearly.ca* showing packaging for the Goods. 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 C – an image of packaging for the Goods. Ms. Johari-Hansen says the image is representative of the packaging used for the Goods sold in Canada during the Relevant Period.

- (c) Exhibit D – a copy of an invoice dated November 6, 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 DIMENSION (Ms. Johari-Hansen states that the absence of the “S” on the word DIMENSION is a typographical error).
- (d) Exhibit E – 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 ® Dimensions” contact lenses under the heading “Beauty Lenses”.

[13] The packaging for the Goods as shown in Exhibits B and C shows the Mark as follows (Ms. Johari-Hansen notes that the CIBA VISION Design mark is also owned by the Owner):



ANALYSIS AND REASONS FOR DECISION

[14] The Requesting Party submits that the average Canadian consumer would perceive FRESHLOOK as being a trademark distinct from the word DIMENSIONS given that FRESHLOOK appears on a standalone basis emphasized by the more prominent font and the placement of the ® marking.

[15] The Owner submits that the components of the Mark, when taken together, form a unitary commercial impression and relies on *Stikeman, Elliott v Wm. Wrigley Jr. Co.* (2001), 14 CPR (4th) 393 in which the Registrar held as follows:

As clearly pointed out by the registrant, the trade-mark as registered is a word mark. No particular design or font size was registered. Consequently, in the case of a word mark, use of the trade-mark word or words in any stylized form and in any colour can be considered as use of the registered mark. Granted the word "ALPINE" is given much more prominence, nonetheless, the words WRIGLEY'S ALPINE are clearly reproduced on the packaging. Consequently the entire word mark is being used albeit in a stylized form. In my view, the public would perceive the present trade-mark as being used as well as the trade-mark ALPINE "per se".

[16] I agree with the Owner. As stated in the *Stikeman, Elliott* case, even though the word FRESHLOOK is more prominent on the packaging for the Goods, consumers would still perceive that FRESHLOOK DIMESNIONS was being used as the trademark given the close association between the two words [see also *Clark Wilson LLP v. 7299362 Canada Inc.*, 2022 TMOB 17]. The addition of the ® after the word FRESHLOOK on the packaging for the Goods is not likely to change the perception. Indeed, the ® could be seen by consumers as relating to the whole design, namely the word FRESHLOOK with the arc design above and the word DIMENSIONS below. In reaching this decision, I have kept in mind that Exhibit E lists “FreshLook ® Dimensions” – however, Exhibit E is a guide distributed to eye care practitioners (i.e. in the nature of promotional material) as opposed to packaging which would be seen by consumers at the time of transfer of the Goods.

[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 C).

[20] Finally, the evidence shows that there was a sale of the goods in Canada during the Relevant Period, namely on November 6, 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.

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