



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 137

**Date of Decision:** 2023-08-04

**[UNREVISED ENGLISH CERTIFIED TRANSLATION]**

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

**Requesting Party:** Drake Marks Associates

**Registered owner:** Services Optométriques (Opt) Inc.

**Registration:** TMA971,368 for VISION AVENUE

## **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. TMA971,368 for the trademark VISION AVENUE (the Mark).

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

[TRANSLATION]

### **Goods**

CI 3 (1) Eyeglass lens cleaning solutions.

CI 5 (2) Contact lens cleaning solutions, eyedrops, eye washes.

CI 9 (3) Eyeglasses, ophthalmic eyeglasses, eyeglass lenses, sunglasses, reading glasses, frames for eyeglasses, for sunglasses, and for pince-nez, protective eyeglasses, ski goggles, sports glasses, diving goggles, swimming goggles, polarizing eyeglasses, eyeglass lenses, sunglass lenses, anti-glare eyeglass lenses, contact lenses, cases and containers for contact lenses, cases for eyeglasses, for sunglasses, and for pince-nez; chains and cords for eyeglasses, for sunglasses, and for pince-nez, pince-nez, boxes for contact lenses; soft sleeves for eyeglasses; eyeglass repair kits and accessories, namely screwdrivers, magnifying glasses, screws, nose pads, and ear pads; smart glasses.

CI 21 (4) Cleaning wipes for eyeglasses, sunglasses, and pince-nez.

### **Services**

CI 35 (1) Retail and online sale of eyeglass lens cleaning solutions, contact lens cleaning solutions, eyedrops, eye washes, eyeglasses, ophthalmic eyeglasses, eyeglass lenses, sunglasses, reading glasses, frames for eyeglasses, for sunglasses, and for pince-nez, protective eyeglasses, ski goggles, sports glasses, diving goggles, swimming goggles, polarizing eyeglasses, eyeglass lenses, sunglass lenses, anti-glare eyeglass lenses, contact lenses, cases and containers for contact lenses, cases for eyeglasses, for sunglasses, and for pince-nez, chains and cords for eyeglasses, for sunglasses, and for pince-nez, pince-nez, boxes for contact lenses, soft sleeves for eyeglasses, smart glasses, cleaning wipes for eyeglasses, sunglasses, and pince-nez, eyeglass repair kits and accessories, namely screwdrivers, magnifying glasses, screws, nose pads, and ear pads.

CI 44 (2) Optometry services, optician services.

CI 45 (3) Personal fashion consulting services.

[3] For the following reasons, I find that the registration should be amended to remove all goods other than [TRANSLATION] “eyeglasses” and all services other than [TRANSLATION] “retail and online sale ... of eyeglasses”.

### **THE PROCEEDING**

[4] At the request of Drake Marks Associates (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on October 8, 2021, to Services Optométriques (Opt) Inc. (the Owner), the registered owner of the Mark.

[5] The notice required that the Owner 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 the Mark 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 October 8, 2018, to October 8, 2021.

[6] The relevant definitions of “use” 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] In the absence of use as defined above, a trademark registration is liable to be expunged, unless the absence of use is due to special circumstances.

[8] 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. A registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. The burden of proof is not very high; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant Elinor Inc v. 88766 Canada Inc.*, 2010 FC 1184 at para 9].

[9] In response to the Registrar’s notice, the Owner furnished an affidavit of Johann Lumbroso, sworn on January 4, 2022, to which were attached exhibits JL-1 to JL-5.

[10] Both parties submitted written representations. Only the Owner was represented at the oral hearing.

## **THE EVIDENCE**

[11] In his affidavit, Mr. Lumbroso identifies himself as manager of the Mark for the Owner since 2015.

[12] At paragraph 4 of this affidavit, Mr. Lumbroso states that the Mark has been in use in Canada by Vision Avenue Eyewear Inc. (VAEI) since May 19, 2017, under the terms of a licence by which the Owner directly or indirectly controls the characteristics or quality of the goods and services, and the use, advertising or display of the Mark in Canada.

[13] At paragraph 6 of his affidavit, Mr. Lumbroso describes VAEI's activities as the creation of frames for eyeglasses and sunglasses. cases for eyeglasses and other eyeglass accessories, and the retail and online sale of eyeglass frames and eyeglass accessories through optometric clinics and its website at *www.avenueeyewear.ca*. Mr. Lumbroso states that, at the date of his affidavit, [TRANSLATION] "since the creation of the Mark, 150 partner clinics have participated in the distribution of Vision Avenue models in Canada, with a choice of over 60 different eyeglass styles".

[14] Mr. Lumbroso then presents evidence of use of the Mark in Canada during the relevant period, collectively designating the goods and services identified in the registration under "Goods" and "Services". My subsequent use of the designations "Goods" and "Services" therefore reflects the use of those terms by Mr. Lumbroso in his affidavit.

[15] In short, Mr. Lumbroso's asserts the following concerning the use of the Mark by VAEI in Canada:

- VAEI has used the Mark in association with the Goods and Services since May 19, 2017 [para 8].
- The VAEI goods are sold through a network of optometric clinics [para 9].
- The Mark is displayed on one temple of each pair of eyeglasses and on the left lens [para 14].

- VAEI attends events at which the Goods are presented and available for sale to the public [page 16].
- The Goods and Services associated with the Mark are promoted on the VAEI website [para 18].

[16] In support of his assertions, Mr. Lumbroso attached the following exhibits to his affidavit:

- Exhibit JL-1: Copies of four invoices, with redacted sale prices, sent by VAEI to optometric clinics. These invoices are dated October 16, 2018, December 14, 2018, August 4, 2020, and August 24, 2020. Mr. Lumbroso confirms that the items described in those invoices are eyeglasses [para 10].
- Exhibit JL-2: Photographs of optometric clinics where the Goods are sold, displaying the Mark, namely: photographs of promotional tools used inside the clinics, taken on October 9, 2018; photographs of the interiors of three clinics, taken respectively on November 1, 2018, September 1, 2019, and October 7, 2019; and photographs of the front of a clinic, taken respectively on August 21, 2019, and February 26, 2020. Mr. Lumbroso states that these photographs are representative of the Services provided through optometric clinics [paras 12–13].
- Exhibit JL-3: Photographs showing the Mark displayed on eyeglasses. Mr. Lumbroso states that these photographs taken on November 5, 2018, July 7, 2019, and November 19, 2019, are representative of the Goods as sold at the optometric clinics and to consumers during the relevant period [paras 14–15].
- Exhibit JL-4: Photographs taken at four tradeshows held in Canada in October and November 2018 and 2019, attended by VAEI [para 17].
- Exhibit JL-5: Screenshots of the VAEI website from December 2018, July 2019 and August 2019. Mr. Lumbroso asserts that these screenshots are representative of the presentation of the website accessible during the relevant period [paras 19–20].

## **THE PARTIES' REPRESENTATIONS**

[17] The following is an overview of the parties' representations, which I will come back to in the analysis below as needed.

[18] The Requesting Party submits that the evidence does not show use of the Mark in Canada during the relevant period in association with the goods and services identified in the registration. In support of its position, the Requesting Party argues that there are significant deficiencies in Mr. Lumbroso's assertions and the documentary evidence.

[19] In particular, the Requesting Party submits that [TRANSLATION] "eyeglasses" are the only good specifically mentioned in Mr. Lumbroso's affidavit. However, it submits that there is insufficient evidence to find that there has been a transfer of ownership or possession of eyeglasses in association with the Mark during the relevant period. With respect to the services identified in the registration, in addition to Mr. Lumbroso's mere assertions of use of the Mark being insufficient, the Requesting Party essentially submits that the documentary evidence is not relevant.

[20] The Owner disputes the Requesting Party's position concerning the value of the evidence. In its written representations, the Owner responds to the Requesting Party's representations concerning the alleged deficiencies in Mr. Lumbroso's assertions and the documentary evidence. However, a reasonable reading of the Owner's written representations leads me to find that the Owner implicitly acknowledges that its evidence does not establish use of the Mark in association with each of the goods and services covered by the registration.

[21] Indeed, the Owner concludes its written representations by submitting that the evidence sufficiently demonstrates the facts to allow the Registrar to conclude that the Mark has been used [TRANSLATION] "at least for the 'eyeglasses' goods and the 'retail and online sale of eyeglasses' services" [para 30 of the written representations].

[22] At the start of the hearing, I referred the Owner to its written representations, indicating that it seemed to be acknowledging that its evidence is limited to the goods

and services specified at paragraph 30 of its written representations. I therefore invited the Owner to indicate any other goods or services for which it felt that it had presented sufficient facts to enable me to conclude that the Mark was used during the relevant period.

[23] In response to my invitation, the Owner did not submit that the evidence showed use of the Mark in association with goods and services other than those specified at paragraph 30 of its written representations. The Owner simply reiterated its written representations that the evidence shows sufficient facts to conclude that the Mark was at least used during the relevant period in association with [TRANSLATION] the “eyeglasses” goods and the “retail and online sale of ... eyeglasses” services.

### **ANALYSIS AND REASONS**

[24] I first note that the Requesting party does not dispute that Mr. Lumbroso’s explicit assertion concerning the Owner’s control over the use of the Mark by VAEI meets the requirements of section 50(1) of the Act. Regardless, Mr. Lumbroso’s assertion is sufficient evidence to accept that the use of the Mark by VAEI during the relevant period was for the benefit of the Owner [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102, at para 84, affirmed by 2011 FCA 340].

[25] It is well established that evidence in a proceeding under section 45 of the Act must be analyzed as a whole and that focusing on individual elements of the evidence in isolation is not the appropriate approach [*Dundee Corp v GAM Ltd*, 2014 TMOB 152, at para 21; *Reckitt Benckiser (Canada) Inc v Tritap Food Broker*, 2013 TMOB 65, at para 27]. Moreover, reasonable inferences can be drawn from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64]

[26] Since the Owner acknowledged the limitations of its evidence, there is no need to discuss here all of the Requesting Party’s representations concerning the deficiencies in the evidence.

[27] That said, I would now like to address the Requesting Party’s representations that the [TRANSLATION] “mere assertions” by Mr. Lumbroso concerning the dates of the

photographs of optometric clinics and eyeglasses, produced respectively as exhibits JL-2 and JL-3, must be ignored given the lack of corroborating evidence of the dates indicated by Mr. Lumbroso or the lack of explanations of how he determined the dates.

[28] I do not agree with the Requesting Party's position. As indicated previously, Mr. Lumbroso has been manager of the Mark for the Owner since 2015. In addition, Mr. Lumbroso clearly stated at paragraph 2 of his affidavit that he has personal knowledge of the facts indicated in his affidavit or that he has personally seen them in the Owner's records to which he has access by virtue of his duties and responsibilities. I therefore see no reason to question Mr. Lumbroso's sworn statements concerning the dates of the photographs produced in support of his affidavit.

***Evidence for the goods***

[29] Based on my review of the evidence, and as acknowledged by the Owner, I find that Mr. Lumbroso's allegations concerning the use of the Mark in association with goods other than [TRANSLATION] "eyeglasses" are mere assertions of use of the type found to be unacceptable in *Plough (Canada) Ltd. v Aerosol Fillers Inc.* (1980), 53 CPR (2d) 62 (FCA).

[30] Moreover, Mr. Lumbroso's affidavit mentions no special circumstances excusing the non-use of the Mark in Canada.

[31] It must therefore be determined whether the evidence provided by Mr. Lumbroso establishes use of the Mark in association with the [TRANSLATION] "eyeglasses" goods, as submitted by the Owner.

[32] I am of the view that the evidence considered as a whole allows me to determine this issue in favour of the Owner.

[33] Indeed, it is clear from Mr. Lumbroso's assertions that the items described in the invoices submitted as Exhibit JL-1 are references to various styles of eyeglasses associated with the Mark. Furthermore, the photographs submitted as Exhibit JL-3 and



taken during the relevant period show the Mark displayed on eyeglasses. I am therefore satisfied that the evidence shows the transfer of ownership of eyeglasses during the relevant period and that the Mark was displayed on the eyeglasses at the time of the transfer.

[34] Finally, I find that the evidence only shows use of the Mark in Canada, within the meaning of sections 4(1) and 45 of the Act, in association with the [TRANSLATION] “eyeglasses” goods.

[35] Absent evidence showing circumstances to excuse non-use of the Mark in association with each of the other registered goods, the registration shall be amended to remove all goods other than [TRANSLATION] “eyeglasses”.

### ***Evidence for the services***

[36] In my view, the evidence presented by Mr. Lumbroso is not sufficient to demonstrate use of the Mark in association with each of the registered services.

[37] First, the mere assertions by Mr. Lumbroso concerning the use of the Mark in association with the Services are insufficient to prove use of the Mark in Canada. Moreover, I find that the presentation of the evidence by means of collective references to the Services creates ambiguities in the facts presented in evidence. In a section 45 proceeding, any ambiguity in the evidence must be interpreted against the owner of the mark [*Diamant Elinor, supra*, at para 14].

[38] In light of Mr. Lumbroso’s affidavit as a whole and given the written and oral representations from the Owner, I accept at most that the facts presented in evidence are relevant to the registered services of [TRANSLATION] “retail and online sale of ... eyeglasses”. In my view, inferring that the evidence is relevant to other registered services would go against the principle that the registrar must be able to draw inferences from proven facts rather than speculation [*Diamant Elinor, supra*, at para 11].

[39] It must therefore be determined whether the evidence provided by Mr. Lumbroso establishes use of the Mark in association with the [TRANSLATION] “retail and online sale of ... eyeglasses” services, as submitted by the Owner.

[40] I am of the view that the evidence considered as a whole allows me to determine this issue in favour of the Owner.

[41] With respect to the retail sale of eyeglasses, I accept that the photographs produced as Exhibit JL-2 showing the Mark inside optometric clinics, for example on signs or near eyeglass displays, constitute sufficient documentary evidence to support Mr. Lumbroso’s assertions concerning the use of the Mark during the relevant period. I also accept that this is the case for the photographs produced as Exhibit JL-2 showing the Mark on the front of a clinic, for example on the window above an advertisement for eyeglasses starting at \$159.

[42] As for the services of online sales of eyeglasses, I recognize the lack of evidence that Canadians visited the VAEI website at *www.avenueeyewear.ca* during the relevant period. However, in light of Mr. Lumbroso’s assertions confirming that the website was accessible during the relevant period and the nature of a “.ca” website, I find it reasonable to infer that at least some Canadians accessed the website during the relevant period [for similar conclusions, see *Andrews Robichaud v Entechnevision Inc.*, 2017 TMOB 109, at para 31].

[43] The issue is therefore whether the four screenshots from the website, produced as Exhibit JL-5, constitute sufficient documentary evidence to support Mr. Lumbroso’s assertions concerning the use of the Mark in association with the services of online sales of eyeglasses during the relevant period. Based on my review of the screenshots, I am of the view that this is the case.

[44] Indeed, I note the presence of the Mark on each of the four screenshots that Mr. Lumbroso asserts to be representative of the presentation of the website during the relevant period. In addition, the first and fourth screenshots show eyeglass models with sale prices. Finally, according to the information in the third screenshot, registered

customers can log on to the website using their email addresses, which allows me to reasonably infer that it is a transactional website.

[45] Finally, I am of the view that the Owner's evidence, as a whole, only shows use of the Mark in Canada, within the meaning of sections 4(2) and 45 of the Act, in association with the [TRANSLATION] "retail and online sales of ... eyeglasses" services.

[46] Absent evidence showing circumstances to excuse non-use of the Mark in association with each of the other registered services, including the retail and online sale of goods other than [TRANSLATION] "eyeglasses", the registration shall be amended to remove all services other than [TRANSLATION] "retail and online sale of ... eyeglasses".

## **DECISION**

[47] In view of all of the foregoing, 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 shall be amended to remove the following goods and services:

[TRANSLATION]

### **Goods**

CI 3 (1) Eyeglass lens cleaning solutions.

CI 5 (2) Contact lens cleaning solutions, eyedrops, eye washes.

CI 9 (3) ... ophthalmic eyeglasses, eyeglass lenses, sunglasses, reading glasses, frames for eyeglasses, for sunglasses, and for pince-nez, protective eyeglasses, ski goggles, sports glasses, diving goggles, swimming goggles, polarizing eyeglasses, eyeglass lenses, sunglass lenses, anti-glare eyeglass lenses, contact lenses, cases and containers for contact lenses, cases for eyeglasses, for sunglasses, and for pince-nez; chains and cords for eyeglasses, for sunglasses, and for pince-nez, pince-nez, boxes for contact lenses; soft sleeves for eyeglasses; eyeglass repair kits and accessories, namely screwdrivers, magnifying glasses, screws, nose pads, and ear pads; smart glasses.

CI 21 (4) Cleaning wipes for eyeglasses, sunglasses, and pince-nez.

### **Services**

CI 35 (1) ... eyeglass lens cleaning solutions, contact lens cleaning solutions, eyedrops, eye washes, ... ophthalmic eyeglasses, eyeglass lenses, sunglasses, reading glasses, frames for eyeglasses, for sunglasses, and for pince-nez, protective eyeglasses, ski goggles, sports glasses, diving goggles, swimming goggles, polarizing eyeglasses, eyeglass lenses , sunglass lenses, anti-glare eyeglass lenses, contact lenses, cases and containers for contact lenses, cases for eyeglasses, for sunglasses, and for pince-nez, chains and cords for eyeglasses, for sunglasses, and for pince-nez, pince-nez, boxes for contact lenses, soft sleeves for eyeglasses, smart glasses, cleaning wipes for eyeglasses, sunglasses, and pince-nez, eyeglass repair kits and accessories, namely screwdrivers, magnifying glasses, screws, nose pads, and ear pads.

CI 44 (2) Optometry services, optician services.

CI 45 (3) Personal fashion consulting services.

[48] The amended statement in the registration shall read as follows:

[TRANSLATION]

**Goods**

CI 9 (3) Eyeglasses.

**Services**

CI 35 (1) Retail and online sale of eyeglasses.

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Céline Tremblay  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

Certified translation  
Gerald Woodard

The English is WCAG compliant

# Appearances and Agents of Record

**HEARING DATE:** 2023-04-11

## **APPEARANCES**

**For the Requesting Party:** No appearance

**For the Registered Owner:** Audrey Campeau-Brassard

## **AGENTS OF RECORD**

**For the Requesting Party:** DRAKE MARKS ASSOCIATES

**For the Registered Owner:** Brouillette Legal Inc.