



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 207

**Date of Decision:** 2023-12-07

**[UNREVISED ENGLISH**

**CERTIFIED TRANSLATION]**

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

**Requesting Party:** Fasken Martineau DuMoulin, LLP

**Registered Owner:** Cédric Songhao Shen

**Registration:** TMA1,013,967 for YUL

### **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. TMA1,013,967 for the mark YUL (the Mark).

[2] The Mark is registered for use in association with the following goods:

(1) Stationery; office stationery

(2) Business bags; key bags; backpacks; backpacks, book bags, sports bags, fanny packs, wallets and handbags; handbags; shoulder bags; wheeled bags; knapsacks; camping bags; beach bags; evening bags; sports bags; school bags; suitcases; wheeled suitcases.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete all the goods except “wheeled suitcases”.

### **THE FILE**

[4] On July 11, 2022, at the request of Fasken Martineau DuMoulin, LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act. The notice was sent to the registered owner of the Mark—Songhao Shen at the time, now Cédric Songhao Shen (the Owner)—following the recording of a name change on the register.

[5] The notice required the Owner to provide evidence showing, with respect to all the goods specified in the registration, whether the Mark had been used in Canada at any time during the three-year period preceding the date on 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 demonstrating use is July 11, 2019 to July 11, 2022.

[6] The relevant definition of “use” 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] 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] In response to the Registrar’s notice, the Owner furnished an affidavit in his own name, sworn on December 15, 2022, to which were attached exhibits 1 to 6.

[9] Only the Requesting Party submitted written representations. The parties did not request a hearing.

## **EVIDENCE SUMMARY**

[10] Mr. Shen explained that he operates an individual business in the [TRANSLATION] “field of importing and selling suitcases and luggage accessories”. This business also operates under the names COMMERCE X-BAG, XBAG TRADING, and X-BAG.

[11] Mr. Shen attests that he sold suitcases and wheeled suitcases bearing the Mark in Canada during the relevant period and that he sells these goods online via the Amazon Canada platform through his “Seller Central – X-Bag” account.

[12] In support, Mr. Shen provides printouts of his Seller Central – X-Bag account that refer to [TRANSLATION] “a few orders from customers who purchased suitcases and wheeled suitcases bearing the Mark YUL during the Relevant Period” [para 15, Exhibit 4]. The printouts contain details of orders placed during the relevant period by consumers in Canada for “hardside spinner luggage.” The printouts also contain a small image of each wheeled suitcase sold.

[13] Mr. Shen also attached to his affidavit images of “suitcases and wheeled suitcases” and states that these images are representative of the goods sold in Canada under the Mark during the relevant period [para 12, Exhibit 3]. The goods shown in these images are of the same type as those shown in the order details in Exhibit 4, hardside spinner luggage.

## **REASONS**

### ***Preliminary Remarks***

[14] In his affidavit, Mr. Chen states that the only registered goods sold under the Mark are “suitcases” and “wheeled suitcases” and that he has [TRANSLATION] “not yet started selling” the other goods [paras 7–8]. However, Mr. Shen adds that he received [TRANSLATION] “samples of backpacks and shoulder bags” bearing the Mark from his manufacturer. He explains that these samples were provided to him to verify their quality prior to the manufacture of larger quantities and that such bags will be sold on his Seller Central – X-Bag account [TRANSLATION] “as soon as possible” [paras 17–18].

[15] In the absence of any submissions from the Owner and since the receipt of these samples does not constitute a transfer by the Owner in Canada within the meaning of section 4(1) of the Act, I find that the evidence does not demonstrate use of the mark in association with any bag.

[16] In light of the foregoing and since there is no evidence of special circumstances justifying non-use of the Mark, the registered bags, wallets, and stationery products will be deleted.

### ***Suitcases and wheeled suitcases***

[17] The Requesting Party denies that the evidence demonstrates use of the Mark. In its representations, the Requesting Party raises a number of deficiencies in the evidence by reviewing it, exhibit by exhibit. However, in the context of the section 45 proceeding, it is important to consider the evidence as a whole. In this respect, I consider the Requesting Party's approach consisting of dissecting and considering each piece of evidence in isolation inappropriate [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209, 2005 CanLII 78281 (TMOB)].

[18] The Requesting Party also submits that any use of the Mark would not confer rights on the Owner as it would be a use in bad faith. In this regard, the Requesting Party is asking me to infer that the Owner has [TRANSLATION] "adopted a mark identical to that of Aéroports de Montréal to knowingly market its suitcases so as to benefit from the goodwill of a third party" [Requesting Party's written representations at para 40]. In support, the Requesting Party refers to the content of certain webpages that are not in evidence and therefore cannot be considered.

[19] In any event, section 45 proceedings are not intended to determine substantive rights in respect of a trademark, 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 p 294]. It is therefore not the Registrar's responsibility in section 45 proceedings to determine whether the use of a mark is in good or bad faith.

[20] 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; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [*Diamant*, above, at para 9].

[21] Considering the evidence as a whole, including the images of the wheeled suitcases bearing the Mark shown in Exhibit 3 and the sales of wheeled suitcases detailed in the printouts in Exhibit 4, I find that the Owner has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with “wheeled suitcases.”

[22] The same is not true for “suitcases.” It is well established that use of a mark in association with a specific good cannot serve to maintain multiple goods in a registration. Therefore, having distinguished “suitcases” and “wheeled suitcases” in the statement, the Owner was required to provide evidence in respect of the two goods separately [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[23] While “wheeled suitcases” may be characterized as a particular type of “suitcase,” where use in association with a particular good could support two goods in a registration, the more specific good will be maintained over the more generalized [*Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD), paras 14–16]. Thus, to maintain his registration for the broader good, the Owner had to demonstrate use in association with “suitcases” other than by referring to the more specific registered goods, “wheeled suitcases.”

[24] The evidence does not show any good that distinguishes itself as a “suitcase” other than the previously cited wheeled suitcases. Therefore, I find that the Owner has not met his burden of demonstrating use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with “suitcases.” Since there is no evidence of special

circumstances justifying non-use of the Mark, these goods will be deleted from the registration.

### **DECISION**

[25] 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:

(1) Stationery; office stationery

(2) Business bags; key bags; backpacks; backpacks, book bags, sports bags, fanny packs, wallets and handbags; handbags; shoulder bags; wheeled bags; knapsacks; camping bags; beach bags; evening bags; sports bags; school bags; suitcases; wheeled suitcases; ...

[26] The Mark will now be registered in association with the following goods (2):  
“wheeled suitcases.”

Eve Heafey  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

Certified translation  
Daniel Lépine

The English is WCAG compliant.

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** Fasken Martineau DuMoulin, LLP

**For the Registered Owner:** Therrien Couture Joli-Coeur LLP