



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2024 TMOB 005

**Date of Decision:** 2024-01-10

## IN THE MATTER OF A SECTION 45 PROCEEDING

**Requesting Party:** Beaumont Stanley Inc.

**Registered Owner:** Magnolia Silver Jewelry Group Ltd.

**Registration:** TMA807,743 for MAGNOLIA SILVER JEWELRY & Design

### 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. TMA807,743 for the trademark MAGNOLIA SILVER JEWELRY & Design (the Mark), reproduced below.



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

- (1) Precious metals and their alloys and rings, earrings, necklaces, bracelets, jewels, their raw ore and imitations of jewels; key holders; jewel boxes; jewellery, precious stones; clocks, watches.

(The Goods)

- (1) Retail and wholesale services, retail store services, retail sale services including via global computer networks, all the foregoing relating to precious metals and their alloys and rings, earrings, necklaces, bracelets, jewels, their raw ore and imitations of jewels; key holders; jewel boxes; jewellery, precious stones; clocks, watches.

(The Services)

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

### **PROCEEDING**

[4] At the request of Beaumont Stanley Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on January 11, 2022, to Magnolia Silver Jewelry Group Ltd. (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 each of the Goods and Services 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 January 11, 2019 to January 11, 2022.

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

4(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[7] Where the Owner does not show “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 the affidavit of Tomer Reizberg, executed in Tel Aviv, Israel, on August 3, 2022, together with Exhibits A to C.

[9] Only the Requesting Party submitted written submissions and was represented at a hearing.

### **PRELIMINARY REMARKS**

#### ***The admissibility of the evidence***

[10] At the hearing, the Requesting Party expressed concerns regarding the Reizberg Affidavit and accompanying exhibits. In particular, it noted that the last page of the affidavit was not signed by the notary and that none of the exhibits were notarized. It also noted that most of the notary’s stamps were partially visible on the affidavit and exhibits, and that the stamps on one of the exhibits were black rather than red, like the others.

[11] It has been held that the Registrar generally accepts affidavits sworn in foreign jurisdictions as long as that jurisdiction’s requirements are met [see *Dubuc v Montana* (1991), 38 CPR (3d) 88 (TMOB)].

[12] In this case, all the pages of the affidavit and exhibits are joined to a cover page by a sealed ribbon, and the last page of the affidavit is signed by Mr. Reizberg with the jurat date attesting to the notary’s receipt of his oath. While I agree that the signature of the notary does not appear on that last page, it does appear on the cover page along with Mr. Reizberg’s identification and authentication of his signature. With respect to the notary’s stamps, although partially visible, all the pages are stamped. Furthermore, the fact that some stamps appear in a different color is inconsequential as Mr. Reizberg references and explains each exhibit in his affidavit. In my view, nothing indicates that

the Reizberg Affidavit does not meet the Israeli jurisdiction's requirements. I therefore see no reason to find the furnished evidence inadmissible.

***The trademark in evidence***

[13] Before proceeding with summarizing the evidence, I note that the documented evidence shows the trademark reproduced below.



[14] For ease of reference, I will refer to this trademark as the Mark in the overview of the Owner's evidence. The issue of whether use of the trademark reproduced above amounts to use of the Mark will be addressed further below.

**EVIDENCE**

[15] Mr. Reizberg is the Owner's CEO. He describes the Owner as an international retailer of a high-quality designer jewelry operating since 1996 [para 3].

[16] Mr. Reizberg states that the Owner had brick and mortar stores in Canada until the end of 2018. He also states that since the stores' closure, the Owner has continued to provide its services and to sell its goods "in various ways to Canadian consumers, including via its website *magnolia-jewellery.com*" (the Website). According to Mr. Reizberg, the Website has been "live and accessible" to customers around the world, including Canadian customers, during the relevant period. In particular, He explains that the Website's landing page displays a pop-up message inviting customers to select their shipping location among the "World Site", the "Israel Site" and the "Portugal Site". He asserts that Canadian customers can navigate through the Website once they have selected the World Site on the landing page [paras 4 to 9].

[17] With respect to the Goods, Mr. Reizberg states that during the relevant period and at all times since then, the Owner "was and continues to be ready to sell, ship and deliver the products shown on [the Website] to Canadian consumers in Canada" [paras 10 to 11].

[18] With respect to the Services, Mr. Reizberg states that the Owner's Mark has been used via its Website during the relevant period in association with "retail sale services including via global computer networks relating to [the Goods]" [paras 5 and 12].

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

- Exhibit A: consists of a representative printout showing the pop-up message appearing when accessing the Website. The Mark is displayed on the top of the printout.
- Exhibit B: consists of a representative printout of the Website's landing page. The printout shows several headings, which include "Outlet" and "Accessories", followed by other printouts showing the Outlet and Accessories webpages. The printouts show different types of jewellery, namely earrings, necklaces, bracelets, key holders and jewel boxes. The Mark is displayed on the top of each printout. However, none of the products shown on the printouts appear to display the Mark on themselves, and the Mark does not appear as part of their description.
- Exhibit C: consists of pages 16 to 19 of the Owner's "Terms of Use", which Mr. Reizberg states are representative and appear on the Website. On page 18, under the heading "SHIPPING", I read "[The Owner] currently ships to the United States, Canada (...).".

## **ANALYSIS**

[20] The Requesting Party submits that the trademark in evidence is a deviation of the Mark as registered. It also submits that the evidence does not support the conclusion that the Mark was used in association with the Goods and Services within the meaning of the Act, and that the Owner failed to provide evidence of special circumstances excusing the absence of use.

### ***The deviation of the Mark***

[21] In its written representations, the Requesting Party notes that “departing from the precise form of the trademark as registered is objectionable and dangerous practice”, and submits that nothing indicates that the Mark was ever used “in the registered form”. It also submits that the removal of the words “SILVER JEWELRY” may potentially mislead an unaware customer and jeopardizes the validity of the registration [paras 31-32]. From the Requesting Party’s submissions at the hearing, I understand that it argues that the display of the trademark in evidence does not constitute display of the Mark as registered.

[22] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*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 registered trademark 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 trademark as registered is a question of fact to be determined on a case-by-case basis.

[23] In the present case, comparing the Mark to the trademark in evidence, I first note that the words “SILVER JEWELRY” would be viewed as merely descriptive when associated with the Goods and Services. That being so, I find that the Mark did not lose its identity and remained recognizable. In my view, the dominant feature of the Mark is the word MAGNOLIA, which has been preserved with the same stylized form as in the registration. I therefore find the removal of the words “SILVER JEWELRY” to be minor. Thus, I find that the trademark in evidence is an acceptable deviation of the Mark. As the identity of the Mark has been preserved, such deviation would not, in my opinion, mislead an unaware purchaser.

[24] Consequently, I accept that any evidenced use of the trademark constitutes display of the Mark as registered for the purposes of this proceeding.

***Use of the Mark in association with the Goods and Services***

[25] 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 Goods and Services.

[26] The Requesting Party submits that the Owner has failed show use of the Mark in association with the Goods and Services in Canada during the relevant period. In particular, it submits that the evidence is ambiguous as the Owner does not provide printouts from the Wayback Machine Internet archive so as to clearly show that the Website existed during the relevant period.

[27] However, the fact that the printouts [Exhibits A and B] were not obtained from an Internet archive is not fatal to the Owner as Mr. Reizberg clearly states that they are representative of the way the pop-up message and the Mark appeared on the Website during the relevant period. In this respect, it is well established that an affiant’s statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25].

[28] It remains nonetheless that the main issue to be determined in this proceeding is whether sufficient facts have been provided to allow me to conclude that the Mark was used in association with the Goods and Services in Canada during the relevant period.

### The Goods

[29] From the evidence as a whole, I find that the evidence falls short of demonstrating use in association with the Goods within the meaning of section 4(1) and (3) the Act.

[30] To begin with, I note that Mr. Reizberg does not state that the Mark is associated with the Goods, and nothing in the evidence shows how it was displayed on them. Indeed, Mr. Reizberg does not state that the Mark was engraved, stamped or otherwise displayed directly on the products shown on the representative printouts of the Website. Nor does he state that the Mark was displayed on their packaging, if any, or that it was in any other manner so associated with the products. Moreover, as noted above, none of the products shown on the Website appear to display the Mark on themselves.

[31] Further, although Mr. Reizberg states that the Owner was ready to sell, ship and deliver the products in Canada, he does not state that they were ever sold or otherwise transferred in or from Canada during the relevant period. Mr. Reizberg neither provides invoices nor clear sworn statements regarding volumes of sales or any equivalent factual particulars from which transfer of the Goods in or from Canada might be inferred [see *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[32] Therefore, I am not satisfied that the Owner has demonstrated use of the Mark in association with the Goods within the meaning of sections 4(1), (3) and 45 of the Act. Moreover, the Owner has not put forward evidence of special circumstances excusing non-use of the Mark in association with the Goods.

### The Services

[33] As per my review above of the Reizberg Affidavit, the Owner does not claim use of the Mark in association with “retail and wholesale services, retail store services” and use in association with retail and wholesale services is not, in any event, supported by the evidence. As for the retail store services, Mr. Reizberg is clear that the Owner stopped brick and mortar stores operations in Canada before the relevant period. I am therefore not satisfied that the Owner has demonstrated use of the Mark in association



with any of these services within the meaning of section 4(2) of the Act. In addition, the Owner has not provided evidence of special circumstances excusing non-use of the Mark in association with “retail and wholesale services, retail store services” in Canada during the relevant period.

[34] With respect to the remaining service, that is “retail sale services including via global computer networks”, I also find that the evidence falls short of demonstrating use of the Mark within the meaning of the Act.

[35] I first note that Mr. Reizberg does not state that the Owner provided retail sale services in Canada or that any of the products offered for sale on the Website were shipped to Canadians during the relevant period. Although the Terms of Use [Exhibit C] establish that the Owner was able to ship products into Canada during such period, absent further evidence, this is insufficient on its own to conclude to the performance of this service.

[36] In the absence of actual performance, the evidence must show that the services were advertised in Canada during the relevant period. In this regard, it has been held that although webpages cannot be physically circulated in the same way as printed advertisements, they must still be “distributed to” or accessed by prospective customers in order to constitute advertising. A clear statement to this effect may be sufficient evidence of distribution or, in the alternative, some evidence from which it can reasonably be inferred that customers or prospective customers accessed the webpages may suffice [see, for example, *Shift Law v Jefferies Group, Inc*, 2014 TMOB 277; see also *Ridout & Maybee LLP v Residential Income Fund LP*, 2015 TMOB 185 at para 47]. However, the mere existence of archived or representative webpages is not sufficient to establish that such webpages were accessed by Canadians during the relevant period.

[37] In the present case, although Mr. Reizberg provides printouts of the Website displaying the Mark on their top and featuring products for sale, I find the evidence insufficient to conclude that Canadian customers did in fact access the Owner’s Website during the relevant period. First, Mr. Reizberg does not state that Canadian customers

visited the Owner's Website, nor does he provide the number of visits by Canadians during the relevant period. In addition, I find Mr. Reizberg's statement that the Website was "live and accessible" to Canadian customers during the relevant period to be insufficient on its own. Absent further evidence, I am unable to infer that the Website was ever accessed by Canadian prospective customers during the relevant period. In such a context, I cannot conclude that the Mark was ever advertised to Canadians in association with "retail sale services including via global computer networks" during the relevant period.

[38] I am therefore not satisfied that the Owner has demonstrated use of the Mark in association with "retail sale services including via global computer networks, all the foregoing relating to precious metals and their alloys and rings, earrings, necklaces, bracelets, jewels, their raw ore and imitations of jewels; key holders; jewel boxes; jewellery, precious stones; clocks, watches" within the meaning of sections 4(2) and 45 of the Act. Furthermore, the Owner has not put forward evidence of special circumstances excusing non-use of the Mark in association with this service.

**DISPOSITION**

[39] In view of all the above, 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 expunged.

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Maria Ledezma  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2023-11-28

## **APPEARANCES**

**For the Requesting Party:** Trisha A. Doré

**For the Registered Owner:** No one appearing

## **AGENTS OF RECORD**

**For the Requesting Party:** Richards Buell Sutton LLP

**For the Registered Owner:** Aventum IP Law LLP