



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 65

Date of Decision: 2024-03-28

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Smart & Biggar LP

Registered Owner: Gemsparkle Ltd.

Registration: TMA964,886 for SR & 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. TMA964,886 for the trademark SR & Design, reproduced below (the Mark), currently owned by Gemsparkle Ltd. (the Owner).



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

Goods

(1) Jewellery; Diamond Jewellery, Pendants; and Earrings.

Services

(1) Wholesale and retail store services specializing in the sale of jewellery.

(the Goods and Services)

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

PROCEEDING

[4] At the request of Smart & Biggar LP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on April 17, 2023, to Praash Jewels Inc. (Praash).

[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 from April 17, 2020 to April 17, 2023.

[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.

[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] On July 5, 2023, a change in name from Praash to the Owner was recorded by the Registrar. The date of the change is shown on the register as November 1, 2022.

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Kamlesh Tukrel, sworn on July 10, 2023, together with Exhibits A to J.

[10] Neither party filed written representations and no oral hearing was held.

EVIDENCE AND ANALYSIS

[11] In her affidavit, Ms. Tukrel states that she was the sole officer, director and shareholder of Praash. Ms. Tukrel explains that her husband was the sole officer, director and shareholder of the Owner from its incorporation in 1992 until his passing away in October 2019. She then became the Owner's sole officer, director and shareholder. Ms. Tukrel states that, on November 1, 2022, the Owner and Praash entered into an amalgamation, and continued business under the Owner's name [paras 2 to 5].

[12] Ms. Tukrel asserts that from the beginning of the relevant period until the amalgamation date, Praash operated the business of the wholesale and retail sale of jewellery. In particular, she states that individuals and wholesale purchasers were invited to view displays of the Goods and to purchase them at the Praash's location in Toronto [Paras 8 and 15].

[13] With respect to the use of the Mark, Ms. Turkel states that it has been used in association with the Goods and Services in Canada during the relevant period. In particular, she states that the Mark was displayed on the Goods themselves or on their packages. In this respect, she states that in some instances, where possible given the nature of the Goods, the Mark was engraved directly on the Goods. Otherwise, she states that the Mark was displayed on jewellery holders and boxes used to show the Goods. She also states that the Mark was "used or displayed in the performance or advertising of all of the Services" [Paras 12 to 14 and 16 to 17].

[14] In support of her statements of use of the Mark, Ms. Tukrel provides eight photographs showing different kinds of jewellery [Exhibits D2, D3, E2, F2, F3, G2, H2 and I2]. Ms. Tukrel asserts that the products shown in these photographs are representative of how the Goods appeared when they were sold at the Praash's location during the first part of the relevant period [para 25]. The photographs show diamond earrings, pendants and bracelets, as well as an emerald and diamond ring and a pearl necklace with a diamond pendant. All the photographs show the Mark displayed on holders and boxes on which each product is shown. In addition, one photograph shows the inside rim of the emerald and diamond ring on which the Mark is engraved.

[15] As Exhibits D1, E1, F1, G1, H1 and I1, Ms. Tukrel provides six invoices dated from January 4, 2021 to October 28, 2022. The invoices are issued by Praash to retail and wholesale customers in Canada. Ms. Tukrel identifies three invoices as being issued to wholesalers and she attests that they are in the business of selling jewellery to the public. Ms. Tukrel correlates all the products listed in the invoices with each of those appearing in the exhibited photographs [paras 19 to 24]. For example, she correlates the diamond earrings in the invoice number 5328 [Exhibit F1] with those shown in one of the photographs [Exhibit F2]. The Mark does not appear on the invoices.

Use of the Mark in association with the Goods and Services

[16] 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, the registered owner must establish a *prima facie* case of use of the trademark in association with *each* of the goods and services specified in the registration [*John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA); see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[17] With respect to the Goods, the representative photographs show each of the Goods displayed on jewellery holders and boxes that bear the Mark, thus showing the manner in which the Mark was associated with each of the Goods. Furthermore, in view of Ms. Tukrel's attested correlations, the invoices clearly demonstrate transfers of the photographed Goods to Canadian customers during the relevant period.

[18] With respect to the Services, Ms. Tukrel relies on the exhibited photographs and invoices as evidence of use of the Mark in association with the Services.

[19] Regarding the retail store services, it has been held that the display of a retailer's trademark on hangers, labels and the like is often considered sufficient to demonstrate use in association with retail store services [see, for example, *Smart & Biggar v Swede Can Group* (2003), 23 CPR (4th) 117 (TMOB) at para 15; *Anderson Instrument Company v 3402983 Canada Inc*, 2015 TMOB 98 at para 18; and *Smart & Biggar LLP v Kings Landing Limited*, 2021 TMOB 76 at para 29]. Absent representations from the Requesting Party, I consider it appropriate to apply this approach to the present case given that jewellery holders and boxes bearing the Mark were used to show the Goods in the performance of retail sale services at Praash's location during the first part of the relevant period. I therefore accept that display of the Mark on jewellery holders and boxes at Praash's location is sufficient to demonstrate use of the Mark in association with retail sale services.

[20] As for the wholesale services, I see no reason to depart from the same approach based on the referenced cases above. Thus, I accept that display of the Mark on jewellery holders and boxes used in the performance of wholesale services at Praash's location during the first part of the relevant period is sufficient to demonstrate use of the Mark in association with wholesale services.

[21] I therefore conclude that the use of the Mark in the manner shown in the exhibited photographs on display at Praash's location amounts to use of the Mark in association with the Services.

[22] In view of all the above, I am satisfied that the Owner has demonstrated use of the Mark in association with the Goods and Services within the meaning of sections 4 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.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Smart & Biggar LP

For the Registered Owner: Corey Bergstein (Bergsteins)