



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 6

Date of Decision: 2025-01-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Borden Ladner Gervais LLP

Registered Owner: JAWHP, LLC

Registration: TMA1,044,162 for JOE JOSEPH ABBOUD & 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. TMA1,044,162 for the design trademark depicted below (the Mark):



[2] The Mark, owned by JAWHP, LLC (the Owner), is registered in association with the following goods and services (the Goods and Services):

CL 9 (1) Eyewear, namely, optical eyeglass frames for vision correction and sunglasses; eyewear accessories, namely, eyewear cases, straps, neck cords which restrain eyewear from movement on a wearer

CL 35 (1) Retail store services in the fields of clothing and accessories, namely, gloves, belts, umbrellas, sunglasses, wallets, bracelets, watches and cufflinks; online retail store services in the fields of clothing and accessories, namely, gloves, belts, umbrellas, sunglasses, wallets, bracelets, watches and cufflinks

[3] For the reasons set out below, I conclude that the registration ought to be “eyewear, namely, optical eyeglass frames for vision correction” and “eyewear accessories, namely, eyewear cases” and amended to delete all remaining goods and services.

PROCEEDING

[4] At the request of Borden Ladner Gervais LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act to the Owner on June 19, 2023.

[5] The notice required the Owner to show whether the Mark was used in Canada with each of the Goods and Services at any time within the three-year period immediately preceding the date of the section 45 notice. If not, the Owner had to provide the last date of use and the reason for the absence of use since that date. In this case, the relevant period for showing use is June 19, 2020 to June 19, 2023 (the Relevant Period).

[6] The definition of "use" for a trademark in association with goods and services 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.

...

(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] 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 a registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68] 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]. That said, mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)], and sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] Where an owner has not shown "use", a registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[9] In response to the Registrar's notice, on February 16, 2024, the Owner filed the affidavits of Jeffery Jones (the Jones Affidavit), identified as the vice president for the JOSEPH ABBOUD brand for the Owner and Jillian Marro (the Marro Affidavit), vice president at Altair Eyewear, Inc. (Altair), exclusive licensee of the JOSEPH ABBOUD brand in association with eyewear.

[10] Both parties filed written representations and attended an oral hearing that was held in conjunction with hearings for related registrations

TMA1,066,389 for the trademark JOE JOSEPH ABBOUD & Design and TMA1,044,194 for the trademark JOE JUST ONE EARTH JOSEPH ABBOUD & Design, decisions for which will be issued under separate cover.

EVIDENCE

The Jones Affidavit

[11] The Jones Affidavit contains, *inter alia*, the following statements, information and exhibits:

- The Owner is the owner of the JOSEPH ABBOUD brand which includes trademarks comprised of, or which include, JOSEPH ABBOUD and/or JOE, including the Mark (the JA Marks) [para 2].
- All business activities related to the JOSEPH ABBOUD brand are controlled and managed by the Owner. All goods sold in association with the JA Marks are manufactured, sold, and provided by the Registrant's network of authorized licensees [para 3].
- Although the specific terms of the license agreements with the authorized licensees are confidential, all of the licenses for the JA Marks have terms providing the Owner has control over the character and quality of the goods manufactured, sold and provided by the licensees in association with the JA Marks including:
 - the requirement to provide the Owner with a representative sample of goods before showing or distributing any goods in association with the JA Marks and that all goods sold in association with the JA Marks are at least "materially equal in quality" to the samples approved by the Owner; and

- the Owner may terminate a license, upon notice, in the event a licensee of the JA Marks manufactures, distributes, sells and/or provides goods that do not meet with the Owners approval in the event the breach of the license is not cured with in a reasonable time [para 4].
- The Owner's licensee, Altair, sold "eyewear, namely, optical eyeglasses frames for vision correction" and "eyewear accessories, eyewear cases" associated with the Mark (the Altair JA Eyewear) to retailers in Canada during the Relevant Period [para 5].

The Marro Affidavit

[12] The Marro Affidavit contains, *inter alia*, the following statements, information and exhibits:

- Altair has been an exclusive licensee of the JOSEPH ABBOUD brand including the Mark for use in association with eyewear, including, optical frames, sunglasses, readers and accessories related to eyewear since 2003 [para 2].
- Pursuant to the terms of a license agreement between Altair and the Owner, Altair has the exclusive rights to manufacture, distribute, advertise and sell eyewear and accessories related to eyewear in association with the JA Marks to certain categories of retailers in Canada and elsewhere [para 3].
- During the Relevant Period, Altair sold the Altair JA Eyewear to retailers in Canada. These retailers in Canada then sold the Altair JA Eyewear to end consumers in Canada, both in stores and online [para 4].

- Attached as Exhibit A are photographs showing examples of the Altair JA Eyewear representative of those sold to retailers in Canada during the Relevant Period [para 5].
- Attached as Exhibit B is a photograph showing examples of the Altair JA Eyewear on display in a store in Canada during the Relevant Period. The Mark was displayed on each of the Altair JA Eyewear products sold to retailers in Canada during the Relevant Period in a manner identical or similar to the samples depicted in Exhibits A and B [para 5].
- Attached as Exhibit C are representative invoices relating to sales of Altair JA Eyewear to stores in Canada during the Relevant Period [para 6]. These invoices show sales from Marchon Canada (located in Quebec), which is a company with common ownership and control as Altair, to Fyi doctors stores in Canada. The Altair JA Eyewear products are received by the purchaser within a week of being shipped [para 7].
- The Altair JA Eyewear listed in the invoices in Exhibit C are comprised a package that included both eyewear frames and cases in a manner identical or similar to the representative examples shown in Exhibits A and B [para 8].

ANALYSIS

Goods for Which Use is Asserted

[13] The Owner relies on the Marro Affidavit to demonstrate use of the Mark in association with eyewear through its licensee Altair. I am satisfied based on the sworn statements in the Jones Affidavit that the Owner maintained the requisite control over the character and quality of the Altair JA Eyewear during the Relevant Period such that use of the Mark by Altair is deemed use by the Owner pursuant to section 50 of the Act.

[14] With respect to use of the Mark during the Relevant Period, as summarized above, the Marro Affidavit confirms that Altair sold the Altair JA Eyewear in association with the Mark in Canada during the Relevant Period to retailers, who in turn sold the Altair JA Eyewear to end consumers in Canada, both in stores and online [para 4]. The exhibits to the Marro Affidavit include images of eyeglass frames with lenses depicting the Mark as well as eyeglass cases branded with the Mark and invoices for sales of the Altair JA Eyewear to retailers in Canada during the Relevant Period [paras 5 to 7, Exhibits A to C]. The Marro Affidavit contains the statement that the Altair JA Eyewear listed on the invoices in Exhibit C “comprised a package that included both an eyewear frame and eyewear case” both displaying the Mark [para 8].

[15] While the Requesting Party has argued that the Mark is not depicted on the eyeglass frames *per se* and is rather depicted on the lenses in the frames, I find that this argument has little merit given that the Mark is clearly very closely associated with the frames and, in my view, falls within the “in any 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” provision of section 4(1) of the Act.

[16] Overall, I am satisfied that the evidence establishes use of the Mark in association with the Altair JA Eyewear and, as such, the registration for the Mark will be maintained in respect of “eyewear, namely, optical eyeglass frames for vision correction” and “eyewear accessories, namely, eyewear cases” and amended to delete the remaining goods.

No Evidence of Use for Remaining Goods and All Services

[17] As the Owner’s evidence only asserts use of the Mark in association with “eyewear, namely, optical eyeglasses frames for vision correction” and “eyewear accessories, namely, eyewear cases”, and the Owner has not

asserted that there were any special circumstances to excuse the lack of use with the remaining goods and all services will be deleted from the registration for the Mark.

DISPOSITION

[18] 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 in respect of "eyewear, namely, optical eyeglass frames for vision correction" and "eyewear accessories, namely, eyewear cases" and amended to delete all remaining goods and services.

Leigh Walters
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-10-17

APPEARANCES

For the Requesting Party: Jeff Gordon and David Schnittker

For the Registered Owner: Kevin Graham

AGENTS OF RECORD

For the Requesting Party: Borden Ladner Gervais LLP

For the Registered Owner: Stikeman Elliott S.E.N.C.R.L., SRL/LLP