



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 106
Date of Decision: 2016-06-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Mincov Law Corporation

Requesting Party

and

G C jewellers

Registered Owner

**TMA630,155 for Two 'P' on mirror
image one of the P is up side down**

Registration

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA630,155 for the design trade-mark shown below (the Mark), owned by G C jewellers (the Owner):



[2] The Mark is registered in association with the goods “jewellery”.

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

The Proceeding

[4] On November 10, 2014, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to the Owner. The notice was sent at the request of Mincov Law Corporation (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between November 10, 2011 and November 10, 2014 (the Relevant Period), in association with the registered goods. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[6] The relevant definition of “use” is set out in section 4(1) of the Act as follows:

4(1) A trade-mark 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] It is well established that the purpose and scope of section 45 of the Act are to provide a simple, summary and expeditious procedure for removing “deadwood” from the register. The criteria for establishing use are not demanding and an overabundance of evidence is unnecessary. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the goods or services specified in the registration at any time during the relevant period [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use of the trade-mark [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 53 CPR (2d) 62 (FCA)]. Furthermore, any ambiguity in the evidence should be interpreted against the owner, as it bears the full burden of proof [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428].

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Ping Szeto, sworn on December 18, 2014.

[9] Both parties filed written representations; a hearing was not held.

Owner's Evidence

[10] Mr. Szeto's affidavit, the header of which reads "AFFIDAVIT OF Ping Szeto (G C Jewellers)", contains three paragraphs. Mr. Szeto asserts the following:

- He is the owner of and operates a retail store named G C Jewellers located at 267 Lakeshore Rd E, Oakville, Ontario.
- He is the rightful owner of the registration for the Mark used for "our" jewellery products since 2001.
- He is attaching images of the products "with marking".

[11] The affidavit is accompanied by a single page, which has not been endorsed or otherwise identified as an exhibit. On this page, nine photographs are printed against a backdrop consisting of the words "G C Jewellers 2014" printed repeatedly across the page.

[12] The photographs are of varying quality and some details are too small to see distinctly. In one photograph, it is not even clear what object is depicted. Nevertheless, I am able to identify various types of jewellery, including a ring, a necklace, a pendant, a pair of earrings and a bracelet.

Requesting Party's Written Representations

[13] The Requesting Party's main representations may be summarized as follows:

- The evidence does not show whether the Mark appears on the goods.
- The evidence does not describe the Owner's normal course of trade.
- The evidence is undated and therefore may not pertain to the Relevant Period.
- The evidence does not show transfers of the goods.

Owner's Written Representations

[14] As its written representations, the Owner filed a two-paragraph letter signed by Mr. Szeto, stating that he is providing “more detail and clear photos” to satisfy the Registrar’s request.

[15] The “clear photos” consist of nine photographs: six correspond to the photographs accompanying Mr. Szeto’s affidavit; two show a newspaper article about the Owner and one shows an award certificate for Mr. Szeto’s jewellery design. As for the details contained in the letter, these are that Mr. Szeto: (i) has to stamp the Mark and a quality mark on each piece of finished jewellery by virtue of the “Canadian precious metal act”; (ii) has been “running G C Jewellers for many years”, and (iii) is using the Mark “almost every day”.

[16] Unfortunately, there is no provision in the Act for the filing of reply evidence once the Requesting Party’s written representations have been submitted, nor for requesting leave to file additional evidence in a section 45 proceeding [see *Oyen Wiggs Green & Mutula LLP v Hung Gay Enterprises Ltd*, 2014 TMOB 107, 125 CPR (4th) 238]. Therefore, if the Owner wished for the photographs attached to the written representations to be considered in the subject proceeding, the Owner should have furnished them through Mr. Szeto’s affidavit. Similarly, the assertions regarding the *Precious Metals Marking Act* in the Owner’s written representations do not form part of the evidence in this proceeding. Indeed, pursuant to section 45 of the Act, evidence must be filed in the form of an affidavit or a statutory declaration.

[17] Accordingly, I am disregarding the factual statements that would constitute new evidence in the Owner’s written representations, as well as the accompanying photographs. Although they have been placed on file, they will not be considered as evidence in this proceeding.

Analysis

[18] Before addressing the points raised by the Requesting Party, I will make preliminary remarks with respect to the evidence.

[19] First, I note that Mr. Szeto's assertion that he is the "rightful owner" of the registration for the Mark appears inconsistent with the registration particulars of record, which show the name of the registered owner as "G C jewellers".

[20] However, based on a fair reading of the affidavit as a whole, I infer that Mr. Szeto and "G C Jewellers" are one and the same. More particularly, I conclude that G C Jewellers is merely the name under which Mr. Szeto does business. Noting that the Requesting Party made no submissions in this respect, for the purposes of the present proceeding, I accept that any demonstrated use of the Mark by Mr. Szeto in the course of operating G C Jewellers constitutes use by the Owner.

[21] Also, as I indicated before, the page of photographs accompanying Mr. Szeto's affidavit has not been endorsed or otherwise identified as an exhibit. This is technically a deficiency in the form of the affidavit. However, the absence of an endorsement on an exhibit will not necessarily be fatal if, as here, no objection was raised by the other party [see *Maximilian Fur Co, Inc v Maximillian for Men's Apparel Ltd* (1983), 82 CPR (2d) 146 (TMOB) at para 9]. Indeed, the Registrar has at times accepted exhibit evidence that is not properly endorsed by a notary or commissioner for taking oaths, if the evidence is clearly identified and explained in the body of the affidavit [see *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)].

[22] In the present case, Mr. Szeto states in his affidavit that the Mark is used for "jewellery product" and that he is attaching images of "our products". As the accompanying page includes images of jewellery products, I find that the evidence attached to the affidavit has been properly identified and explained in the affidavit. I therefore find that the page accompanying Mr. Szeto's affidavit is admissible as evidence for the purpose of this proceeding.

[23] I now revert in turn to the points raised by the Requesting Party, as set out above.

Does the evidence show the Mark?

[24] The Requesting Party submits that the exhibited photographs "make it impossible to figure out if any of the shown goods bear trademark marking on them". I partly agree with the Requesting Party.

[25] Indeed, the size and quality of the photographs makes it difficult to discern most of the detail. I certainly do not see the Mark on each of the jewellery pieces shown by the photographs. Upon close examination of the photographs, I can make out the Mark in the centre of the back of the pendant.

Does the evidence describe the normal course of trade?

[26] The Requesting Party submits that the Owner has not provided information regarding its normal course of trade. The Requesting Party further submits that the Registrar cannot make assumptions about, or be expected to know, the nature of the Owner's business. However, in the present case, the affidavit of Mr. Szeto clearly states that he operates a retail store located in Oakville, Ontario.

Does the evidence pertain to the Relevant Period?

[27] The Requesting Party submits that the evidence is ambiguous because it does not specifically refer to the Relevant Period. On this point, I agree with the Requesting Party.

[28] In his affidavit, Mr. Szeto merely states that the Mark was "used" for jewellery products "since 2001 till now". It is not clear whether that use was continuous or whether any of it occurred during the Relevant Period. As I indicated before, this ambiguity in the evidence should be interpreted against the Owner.

[29] Furthermore, although the Owner states in its written representations that the Mark is "used" almost every day, as discussed before, I cannot consider this statement in reaching my decision. That said, even if this statement were contained in Mr. Szeto's affidavit, it would not have assisted the Owner's case. Indeed, I would not have inferred from the assertion that the Mark is *currently* in daily use that the Mark was in use, daily or otherwise, during the Relevant Period.

[30] With respect to the exhibit page, as noted by the Requesting Party, the photographs on that page are undated. Moreover, Mr. Szeto does not state when the photographs were taken or whether they are representative of how the Mark was displayed during the Relevant Period. The backdrop to the photographs does contain the notation "G C Jewellers 2014"; however, it is

unclear whether this date represents the date the photographs were taken or the date the exhibit page was compiled and printed. Noting that the affidavit was sworn in December 2014, it is not clear whether “2014” refers to a time within the Relevant Period, which ended on November 10, 2014. Again, I must interpret these ambiguities against the Owner.

[31] In the end, I find that the evidence is too ambiguous to permit me to conclude that the Mark was displayed on jewellery during the Relevant Period. In the event that I am wrong in so concluding, a further discussion of the evidence is warranted since the display of the Mark in itself is insufficient to show use within the meaning of section 4(1) of the Act. Indeed, as mentioned above, it is also necessary for the Owner to provide at least some evidence of transfers in the normal course of trade.

Does the evidence show transfers of the goods?

[32] The Requesting Party submits that the evidence does not show transfers of the goods in the normal course of trade. In particular, the Requesting Party notes that Mr. Szeto does not provide any sales figures in his affidavit, nor any invoices, receipts or order forms showing sales of the jewellery goods.

[33] I agree with the Requesting Party that Mr. Szeto’s affidavit does not provide any evidence of goods being transferred in the normal course of trade.

[34] As noted above, section 45 requires a registered owner, not merely to state, but to *show* use of the trade-mark in association with the goods for which it has been registered. That is, an affidavit in response to a section 45 notice must “show use by describing facts from which the Registrar or the Court can form an opinion or can logically infer use within the meaning of section 4” [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401 at para 18].

[35] Although invoices are not mandatory, it is necessary to provide at least some evidence to allow the Registrar to conclude that transfers in the normal course of trade actually occurred in Canada. By way of example, in the absence of invoices, such evidence can include statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79, CarswellNat 2439; and

Gowling Lafleur Henderson LLP v Wertex Hosiery Incorporated, 2014 TMOB 193, CarswellNat 4624]. In the present case, there is no evidence showing any actual sales of jewellery bearing the Mark - depicted in the exhibited photographs or otherwise - during the Relevant Period or at any other time.

Disposition

[36] In view of all of the foregoing, I find that the Owner's evidence does not show use of the Mark in Canada in association with the registered goods within the meaning of sections 4 and 45 of the Act. Further, the Owner has provided no evidence of special circumstances excusing the absence of such use.

[37] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No Hearing Held

AGENT(S) OF RECORD

No Agent Appointed

For the Registered Owner

Mincov Law Corporation

For the Requesting Party