



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

Citation: 2012 TMOB 230
Date of Decision: 2012-11-27

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by De Grandpré Chait LLP against registration
No. TMA574,771 for the trade-mark NAVY SEAL in the
name of S.W.I. Watches Inc./S.W.I. Montres Inc.**

[1] At the request of De Grandpré Chait LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 23, 2010, to S.W.I. Watches Inc./S.W.I. Montres Inc., the registered owner (the Registrant) of registration No. TMA574,771 for the trade-mark NAVY SEALS (the Mark).

[2] At the time the section 45 notice was issued, the Mark was registered for use in association with the following wares and services:

Wares

- (1) All men's, women's, boys', girls' and children's wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats.
- (2) Camping gear, camping equipment, namely sleeping bags, pocket knives, hunting knives, flashlights and tents.
- (3) Cologne, perfume and aftershave lotion.
- (4) Bottled water, vitamins and snack bars.

Services

- (1) Sale of all men's, women's, boys', girls' and children's wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters and T-shirts, together with all accessories, namely, belts, socks, ties, underclothing, caps and hats.
- (2) Sale of camping gear, camping equipment, sleeping bags, pocket knives, hunting knives, flashlights and tents.
- (3) Sale of cologne, perfume and aftershave products.
- (4) Sale of bottled water, vitamins and snack bars.

[3] Subsequent to the section 45 notice, the Registrant voluntarily amended its registration, pursuant to section 41(1)(c) to delete wares (3) and (4) and services (3) and (4) above. These amendments were officially recorded on the register on July 2, 2011. Thus, the trade-mark registration at issue is only registered with respect to wares (1) and (2) (the Wares) and services (1) and (2) above (the Services).

[4] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and services specified in the registration 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 use since that date. In this case, the relevant period for showing use is between November 23, 2007 and November 23, 2010 (the Relevant Period).

[5] The relevant definitions of "use" in the present case are set out in section 4 of the Act as follows:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression "clearing deadwood" has been often used to describe such proceedings [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d)

289 (FCTD)]. As such, the test that has to be met by a registrant under section 45 is not a heavy one; all the registrant has to do is establish a *prima facie* case of use [*Cinnabon, Inc v Yoo-Hoo of Florida Corp* (1998), 82 CPR (3d) 513 (FCA)].

[7] In response to the Registrar's notice, the Registrant furnished the affidavit of Mr. Ara Chenorhokian, the President of the Registrant. While both parties filed written submissions, an oral hearing was not requested.

[8] In his affidavit, Mr. Chenorhokian attests that the Registrant has used the Mark in Canada in association with each of the registered wares and services during the Relevant Period. In particular, Mr. Chenorhokian explains that at the time of transfer, the Mark appeared on labels either printed or embroidered on the Wares or on labels affixed to or engraved on such Wares. He attaches as Exhibit A-2, representative samples of a variety of the Wares bearing the Mark. I note that the Mark clearly appears on such Wares.

[9] Mr. Chenorhokian further explains that the Registrant has used the Mark on its website in the normal course of selling its Wares. In support, he attaches copies of pages appearing on the Registrant's website as Exhibit A-3. I note that the Mark clearly appears on the web pages, as well as on the various items of merchandise featured on such pages. Mr. Chenorhokian explains that the merchandise shown on these web pages are examples of the Registrant's wares set out in the registration at issue.

[10] Lastly, Mr. Chenorhokian attaches as Exhibits A-4(a) to A-4(l) a variety of invoices and supporting documents as evidence of sales of the Wares in Canada during the Relevant Period. The invoices and supporting documents are clearly described as representative in nature. I note that the invoices are all dated within the Relevant Period and show sales of a variety of the Wares by the Registrant in Canada. In fact, each product sold is described as a "Navy Seal" product within the product description column of all invoices. The supporting documents referred to by Mr. Chenorhokian are simply photographs of Wares which correspond to those listed on the invoices. As with all other depictions of the Wares in evidence, the Mark clearly appears on the Wares shown in the supporting documents.

[11] I note that in its written argument, the Requesting Party takes no issue with wares (1) and (2) (the Wares) and services (1) and (2) above (the Services), and has merely asked for the registration to be restricted to these Wares and Services. As previously mentioned, this has been done voluntarily on behalf of the Registrant.

[12] With respect to the Wares and Services as amended by the Registrant, I am satisfied that the Registrant has shown use of the Mark with such Wares and Services in Canada in the normal course of trade, during the Relevant Period, pursuant to sections 4 and 45 of the Act. In this regard, the evidence demonstrates that the Mark was associated with the Wares at the time of transfer and that the Mark was displayed in the performance or advertising of the Services. Furthermore, it is clear from the evidence that the Registrant made sales of the Wares in the normal course of trade, in Canada, during the Relevant Period.

Disposition

[13] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA574,771 will be maintained in compliance with the provisions of section 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

