



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

Citation: 2016 TMOB 160
Date of Decision: 2016-09-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Smuglers LLP

Requesting Party

and

Richard Cook

Registered Owner

TMA783,659 for ICE SKIN

Registration

[1] At the request of Smuglers LLP, Inc. (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 June 25, 2014 to Ice Skin Inc., the registered owner at that time of registration No. TMA783,659 for the trade-mark ICE SKIN (the Mark). Subsequent to the issuance of the notice, the Registrar recorded a change in title of the registration to Richard Cook (the Owner).

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

Clothing, namely undergarments that wick moisture away from the body.

[3] 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 goods 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 such use since that date. In this case, the relevant period for showing use is between June 25, 2011 and June 25, 2014.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act:

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.

[5] In response to the Registrar’s notice, the Owner furnished his own affidavit, sworn on January 26, 2015 in Vancouver, British Columbia. Both parties filed written representations; an oral hearing was not requested.

The Owner’s Evidence

[6] In his affidavit, Mr. Cook attests that he is the President of Ice Skin Inc. (ISI), which he identifies as a small corporation that he operates from his home in Toronto, Ontario. He attests that the only business of ISI is the production and sale of the registered goods, being undergarments that wick moisture away from the body. Mr. Cook asserts that, during the relevant period, ISI sold its clothing goods to customers, primarily being amateur hockey teams, in Canada in association with the Mark. In this respect, Mr. Cook attests that the Mark was displayed on tags attached to the undergarments as well as on the packaging in which the undergarments were sold. He further attests that customers were invoiced at the time of delivery.

[7] In support, Mr. Cook provides the following exhibits attached to his affidavit:

- Exhibit A is three photographs of what Mr. Cook attests are samples of packaging of the registered goods, namely “extra-small youth sized long sleeved t-shirts (which are undergarments) which ... wick moisture away from the body”. He confirms that the depicted packaging is representative of the packaging used by ISI during the relevant period.

The word ICESKIN appears underneath the stylized letters “iS” on an insert visible through the shirt’s clear plastic packaging. Mr. Cook explains that the “iS” logo is

another trade-mark ISI uses. The “iS” logo, without the word ICESKIN underneath it, is also visible on the undergarments themselves.

- Exhibit B is a photograph of a label, which Mr. Cook attests is attached to the shirts displayed in Exhibit A. The label displays “ICE SKIN” below the same stylized “iS” logo visible in Exhibit A. Mr. Cook confirms that the depicted label is representative of those attached to the registered goods sold during the relevant period.
- Exhibit C consists of photographs of eight handwritten invoices, all of which Mr. Cook attests were written by himself for sales of the registered goods to amateur sports teams in Ontario. Mr. Cook explains that, as a small business, ISI used blank handwritten invoices in lieu of pre-printed formal invoices. All the invoices are dated within the relevant period. ISI’s name does not appear on any of the invoices, but the Mark appears, also handwritten, in the top left corner of six of the invoices.

Analysis - Legal Status of the Owner

[8] As a preliminary matter, the Requesting Party questions the legal status of ISI, the registered owner during the relevant period.

[9] In this respect, in its written representations, the Requesting Party attaches a copy of a certificate of dissolution for Ice Skin Inc., issued by Industry Canada and dated November 12, 2011. As such, the Requesting Party asks the Registrar to take judicial notice of this dissolution as a matter of public record. In view of this apparent dissolution, the Requesting Party submits that, contrary to Mr. Cook’s claims, ISI could not have used the trade-mark continuously throughout the relevant period or, indeed, could not have acted in any of the ways alleged by Mr. Cook. The Requesting Party repeatedly submits that the statements in Mr. Cook’s affidavit regarding the activities of ISI are “false, as the Corporation dissolved on November 12, 2011”.

[10] In response to the Requesting Party’s attempt “to introduce its own evidence regarding the corporate status” of ISI, the Owner notes that no evidence from a requesting party is admissible in a proceeding under section 45 of the Act [citing *Berg Equipment Co v Merdith & Finlayson*, 1991 CarswellNat 335 (FCA)].

[11] I note that 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 2004 FC 448, 31 CPR (4th) 270]. Statements in an affidavit must be accorded substantial credibility [*Ogilvy Renault v Compania Roca-Radiadores SA*, 2008 CarswellNat 776 (TMOB)] and the evidence as a whole must be considered; focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Ltd* (2005), 47 CPR (4th) 209 (TMOB)]. Finally, section 45 proceedings are not intended to provide an alternative to the usual *inter partes* attack on a trade-mark envisaged by section 57 [*Meredith & Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)].

[12] In my view, taking judicial notice to the extent and for the purpose argued for by the Requesting Party would be contrary to these general principles. A registered owner would have to provide an overabundance of evidence in anticipation of questions beyond the narrow scope of the proceeding and would have its hands tied in the face of any judicial notice casually taken, considering that a registered owner is essentially barred from submitting reply evidence to such unanticipated notice.

[13] Similarly, a requesting party is barred from submitting its own evidence in a section 45 proceeding. As such, it should not be able to do with calls for judicial notice that which it is prohibited from doing by way of evidence or cross-examination. As a summary and expeditious procedure, a section 45 proceeding is an improper forum for this type of “evidence”. Indeed, I note that there may be other records pertaining to ISI’s corporate status during the relevant period that have not been brought before the Registrar.

[14] In any event, whether the activities of ISI as attested to by Mr. Cook after its apparent dissolution in November 2011 otherwise complied with provincial or federal regulations is beyond the scope of this proceeding [see *Lewis Thomson & Son Ltd v Rogers Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. The Federal Court has cautioned against letting technical requirements become “a trap for the unwary” where a trade-mark has been obviously in use by its rightful owner [per *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. Although

that case dealt with technical aspects of affidavits, in view of the evidentiary threshold in a section 45 proceeding [per *Uvex, supra*], I consider the general principle apt in this case [see also *Riches Mckenzie & Herbert LLP v Chaussures M & M Inc/M & M Footwear Inc*, 2013 TMOB 222, 117 CPR (4th) 234)].

[15] In this case, as further discussed below, the evidence shows that the Mark was clearly in use during the relevant period by ISI and/or by Mr. Cook personally. Although not determinative, I would also note that, as the evidence indicates that Mr. Cook was essentially the sole proprietor of ISI, whether the corporation was formally dissolved at some point is particularly moot.

Display of the Mark

[16] In its written representations, the Requesting Party submits that none of the photos in Exhibit A actually display the Mark as registered. In this respect, it argues that the trade-mark shown on the goods is a combination of the stylized “iS” logo together with the smaller “ICESKIN”, as one word and in capital letters.

[17] With respect to the appearance of ICESKIN as one word, I would first note that the Requesting Party incorrectly describes the Mark as “Ice Skin with only the I & S being capitalized”. In fact, the Mark is the word mark ICE SKIN.

[18] In any event, I consider the display of ICESKIN as one word rather than two on the exhibited packaging to be only a minor deviation from the Mark as registered [per *Canada (Registrar of Trade-marks) v Cie International pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA)].

[19] Furthermore, use of a word mark in combination with additional words or design features qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); 88766 *Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. The issue is a question of fact, dependent upon such factors as whether the word mark stands out from the additional material – for example, by the use of different lettering or sizing, or whether

the additional material would be perceived as purely descriptive matter or as a separate trade-mark or trade name [see *Nightingale, supra*]. Moreover, a registration for a word mark can be supported by use of that mark in any stylized form and in any colour [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)] and nothing prevents the display of multiple trade-marks on goods or their packaging [see *AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (FCTD)].

[20] In this case, I agree with the Owner that the differences in size, typeface, and font between ICESKIN and the “iS” logo – as well as the separate display of the “iS” logo – make it clear that the two elements are separate and the Mark itself is being used on the undergarment packaging.

[21] In any event, I accept that the display of ICE SKIN on the exhibited invoices constitutes display of the Mark in association with the registered goods.

[22] For its part, the Requesting Party argues that “ICE SKIN” written on the exhibited invoices refers to Ice Skin Inc., submitting that the text appears on “the part of the invoice normally reserved for the company name”. In response, the Owner submits that nothing in the evidence suggests that it refers to the corporate name “Ice Skin Inc.” rather than a trade-mark.

[23] I would first note that trade-mark and trade name usage are not necessarily mutually exclusive [see *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB) at paragraph 14].

[24] Furthermore, the Federal Court of Appeal has held that display of a trade-mark at the top of an invoice that accompanies goods at the time of transfer in the normal course of trade may, in some circumstances, constitute use of that trade-mark in association with the goods listed in the invoice [see *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321, CarswellNat 4836]. The major consideration remains “whether the trade-mark is being used as a trade-mark in describing the wares contained in the invoice and, as such, whether appropriate notice of such use is being given to the transferee of the wares” [per *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 144, 56 CPR (4th) 223 at para 32]. In this respect, it is important to consider the prominence of the trade-mark at the top of the invoice and whether

other trade-marks appear on the invoice, either in the body or otherwise [per *Hortilux, supra*, at para 12].

[25] In this case, Mr. Cook attests that customers are “invoiced at the time of delivery”. Furthermore, the Mark appears at the top of some of the exhibited invoices, with no other trade-marks appearing on any of the invoices. As attested by Mr. Cook, the only goods sold by ISI during the relevant period were the registered goods.

[26] Although the Requesting Party calls attention to the fact that the exhibited invoices do not have a product description beyond “pieces” and “sets” of products, the descriptions otherwise refer to various sizes of clothing, consistent with Mr. Cook’s statement that the only products sold by ISI were undergarments.

[27] Together with Mr. Cook’s statements, I accept that the exhibited invoices show transfers of ICE SKIN-branded undergarments as shown in the exhibited photographs. As such, I am satisfied that the Owner has demonstrated use of the Mark in Canada during the relevant period in association with the registered goods within the meaning of sections 4 and 45 of the Act.

Disposition

[28] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be maintained.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

Blake, Cassels & Graydon LLP

For the Registered Owner

Smuglers LLP

For the Requesting Party