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

Citation: 2017 TMOB 96

Date of Decision: 2017-08-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Portage World-Wide, Inc.	**Requesting Party**
and	
Croton Watch Co., Inc.	**Registered Owner**
TMA482,886 for MANHATTAN	**Registration**

[1] At the request of Portage World-Wide, 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 May 27, 2015 to Croton Watch Co. Inc., the registered owner as recorded at that time of registration No. TMA482,886 for the trade-mark MANHATTAN (the Mark).

[2] On September 23, 2016, the Registrar recorded a correction to the registered owner's name to Croton Watch Co., Inc. (the Owner). This change is discussed further below.

[3] The Mark is registered for use in association with the following goods: "Watches and clocks and parts and accessories therefor; pens and pencils."

[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 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 May 27, 2012 to May 27, 2015.

[5] The relevant definition of use with respect to goods 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.

[6] It is well established that 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)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods specified in the registration during the relevant period.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of David Mermelstein, President of the Owner, sworn on December 24, 2015 in the state of New York. Both parties filed written representations and were represented at an oral hearing.

THE OWNER'S EVIDENCE

[8] In his brief affidavit, Mr. Mermelstein attests that the Owner has been selling watches in Canada "for many years under the trade-mark MANHATTAN and those sales continue to present." He explains that in 2014, the Owner started selling its MANHATTAN line of watches in Canada through The Shopping Channel, at *www.theshoppingchannel.com*. He concludes his affidavit by confirming that it was made to provide documentary evidence of use of the Mark in association with watches "during the relevant time period in this proceeding and ongoing to date in the Canadian marketplace."

[9] In support, attached to his affidavit are the following exhibits:

- Exhibit A consists of two photographs of watches, that Mr. Mermelstein attests "are representative photos evidencing how the brand appears on product." The Mark appears on the face of the depicted watches.

- Exhibit B consists of three pages of "screenshots" from The Shopping Channel website that Mr. Mermelstein attests show MANHATTAN watches "currently for sale".

- Exhibit C consists of nine invoices showing sales from the Owner to The Shopping Channel in Ontario, all dated during the relevant period. Two of the invoices reference "Manhattan" watches; otherwise, Mr. Croton explains that any product codes starting with "CM" correlate to the Owner's MANHATTAN watches.

ANALYSIS

[10] In its representations, the Requesting Party first submits that the affidavit is inadmissible. In this respect, it argues that there is no proper jurat in the affidavit, noting that the "typical" statement beginning with "Sworn before me…" is missing. It asserts that such deficiencies have been held by the Registrar to be beyond mere technicalities and are fatal to the affidavit's admissibility [citing, in part, *Cameron IP v Jones*, 2013 TMOB 52, 112 CPR (4th) 333 (TMOB); *88766 Canada Inc v 167407 Canada Inc*, 2010 TMOB 167, 89 CPR (4th) 293; and *Premier Vision Inc v Fuzzi SPA* (1990), 31 CPR (3d) 251 (TMOB)].

[11] In response, the Owner notes that the *Trade-marks Act* and *Trade-marks Regulations* are silent as to the form of affidavits and statutory declarations to be filed in a section 45 proceeding, and that there is no requirement to conform to the particular format of evidence mandated by the *Federal Court Rules*. Moreover, the Owner correctly notes that the present case is distinguishable from those cited by the Requesting Party, in that Mr. Mermelstein's affidavit was sworn in a foreign jurisdiction, specifically the state of New York.

[12] As such, the Owner further submits that "it has long been the practice of the Registrar to accept, as *prima facie* acceptable, affidavits sworn before notaries outside of Canada" and that all that is required is that the Registrar be satisfied that the affiant is attesting to the truthfulness of the facts alleged in the affidavit filed.

[13] In any event, the Owner submits that it is well established that technical deficiencies in an affidavit should not be a bar to a successful response to a section 45 notice where there is sufficient evidence to conclude the trade-mark was in use [see, for example, *Baume & Mercier SA v Brown carrying on business as Circle Import* (1985), 4 CPR (3d) 96 (FCTD) and *Bereskin & Parr v 3056678 Canada Inc* (2004), 34 CPR (4th) 566 (TMOB)].

[14] In this case, I agree with the Owner that the affidavit contains indications of how, where and when it was sworn – the affidavit is dated December 24, 2015, and the Notary Public's stamp appears, indicating that the Notary is qualified in the County of Rockland in the State of New York. Furthermore, the preamble to the affidavit includes the statement that Mr. Mermelstein "in the City of Monsey in the State of New York hereby make oath and state as follows…".

[15] As such, I see no reason to revisit the Registrar's decision to make the subject affidavit of record in this proceeding.

[16] Otherwise, the Requesting Party questions much of the evidence based on the difference of a comma in the Owner's name as registered at the time of the notice versus the variations that appear in the evidence. However, as noted above, the Owner subsequently corrected the clerical error on the register, and I am satisfied that any evidence of use is that of the registered owner.

[17] With respect to use of the Mark in association with the registered goods "watches", the Owner furnished representative photographs of the watches it sold bearing the Mark as well as invoices demonstrating sales in Canada of such watches.

[18] Nonetheless, the Requesting Party notes in part that, in describing Exhibit A, Mr. Mermelstein "does not identify what the brand is, nor what the product is." The purpose of this observation is not apparent, since the exhibit clearly shows the brand (MANHATTAN) and the product (watches).

[19] Of more relevance is the Requesting Party's submission that Mr. Mermelstein "fails to disclose whether the attachments of Exhibit A are dated from within the Relevant Period or some other time". The Requesting Party goes a step too far, however, when it submits in its written representations that "Exhibit A is rendered irrelevant as it is undated".

[20] Although the Requesting Party submits that Mr. Mermelstein does not explicitly establish that the exhibited watches were sold during the relevant period, I note that the evidence must be considered as a whole and that focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)]. Furthermore, reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64, 48 CPR (4th) 223].

[21] As the Owner notes in its written representations:

> Contrary to the Requesting Party's approach, the evidence in a s. 45 proceeding must be read with the attitude of a mind willing to understand what is being said in the evidence, rather than for the purpose of searching out perceived problems or supposed "ambiguities".

[22] Indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at paragraph 2].

[23] In this case, I accept that the watches depicted at Exhibit A are representative of the watches sold in Canada during the relevant period, as reflected in the Exhibit C invoices. As such, I am satisfied that the evidence as a whole demonstrates use of the Mark in association with the registered goods "watches" within the meaning of sections 4 and 45 of the Act.

[24] With respect to the remaining registered goods, the affidavit is silent, the only evidence of transfers being with respect to "watches". As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with the remaining registered goods within the meaning of sections 4 and 45 of the Act. In the absence of special circumstances excusing non-use, the registration will be amended accordingly.

DISPOSITION

[25] 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 amended to

delete the following from the statement of goods: "…and clocks and parts and accessories therefor; pens and pencils".

[26] The amended statement of goods will be as follows: "Watches."

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

HEARING DATE 2017-08-02

APPEARANCES

James Green	For the Registered Owner
Jamie Bordman	For the Requesting Party

AGENTS OF RECORD

Gowling WLG (Canada) LLP	For the Registered Owner
Moffat & Co.	For the Requesting Party