



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

Citation: 2017 TMOB 138

Date of Decision: 2017-10-04

IN THE MATTER OF A SECTION 45 PROCEEDING

Le Centre Vu Lebel & Desroches Inc.

Requesting Party

and

SunVu Sunglasses & Optics

Registered Owner

TMA603,685 for SUNVU & Design

Registration

INTRODUCTION

[1] At the request of Le Centre Vu Lebel & Desroches 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 October 2, 2015 to SunVu Sunglasses & Optics (the Owner), the registered owner of registration No. TMA603,685 for the trade-mark SUNVU & Design reproduced below (the Mark).



[2] The Mark is registered for use in association with the following goods: “Eye wear, namely, sunglasses, ski goggles, clip-on sunglasses, reading glasses, cases and cords” (the Goods).

[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 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 October 2, 2012 and October 2, 2015.

[4] The relevant definition of “use” in association with 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.

[5] 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. While mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1979), 45 CPR (2d) 194 (FCTD), aff’d (1980), 53 CPR (2d) 63 (FCA)], the threshold for establishing use in these proceedings is quite low [see *Lang, Michener, Lawrence & Shaw v Woods Canada Ltd* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [see *Union Electric Supply Co v Canada (Registrar of Trade-marks)* (1982), 63 CPR (2d) 56 (FCTD)].

[6] In response to the Registrar’s notice, the Owner furnished an affidavit of Robert Labine, sworn April 12, 2016, together with Exhibits A to H. Both parties filed written representations; an oral hearing was not requested.

THE OWNER’S EVIDENCE

[7] In his affidavit, Mr. Labine states that he has been a partner of the Owner since it was registered in Alberta in 1999.

[8] Mr. Labine states that the Owner is located in Calgary and that for over 15 years, it has been continuously selling the Goods. He further states that the Owner has sold each of Goods in Canada in association with the Mark during the relevant period.

[9] Mr. Labine states that in the normal course of its business operations, the Owner offers and sells to its customers product display racks for their use in-store to display the eye wear products sold by the Owner in association with the Mark. In addition to these retail customer sales, the Owner's eye wear products are also sold to business customers whereby those customers' own trade-marks/logos are displayed on the products for use as promotional items.

[10] In support, Mr. Labine attaches the following exhibits to his affidavit:

- Exhibit B: a copy of his business card displaying the Mark and identifying the Owner as a division of ShaRine Designs;
- Exhibit C: photographs of exemplary in-store display racks. Mr. Labine attests that these racks are used by vendors in Canada to display various styles of the Owner's sunglasses, each pair having attached to it a label displaying the Mark. Mr. Labine further attests that the same or similar product display racks, with the same or similar products displayed therein appeared in many stores in Alberta and British Columbia during the relevant period.
- Exhibit D: specimens of labels bearing the Mark. Mr. Labine attests that these labels are identical to those which were attached to each of the Goods at the time the Owner sold those products in Canada during the relevant period.
- Exhibit E: photographs of each of the Goods having attached to it a label bearing the Mark. Mr. Labine attests that each of these products was sold in this manner during the relevant period.
- Exhibit F: copies of exemplary invoices dated from the relevant period. Mr. Labine attests that the invoices accompanied the Goods sold by the Owner to customers in Alberta and British Columbia. He further correlates the invoiced items with each of the registered goods. I note that the invoices prominently display both the Mark and the Owner's name in the upper left-hand corner thereof, as well as the Owner's name at the

bottom left-hand side. The invoices further identify the Owner as a division of ShaRine Designs and indicate that payment is to be made to that entity.

- Exhibits G and H: copies of exemplary advertisements used by the Owner.

ANALYSIS

[11] As summarized by the Owner in its written representations, the Requesting Party submits that the evidence furnished by the Owner does not show use of the Mark by the Owner because, although the invoices identify the Owner, they indicate to the customer that payment is to be made to a different entity, namely ShaRine Designs (of which the Owner is identified to be a division). The Requesting Party admits that the Owner is identified as a division of ShaRine Designs but submits that the evidence provides no further explanation as to the relationship between the Owner and ShaRine Designs.

[12] I disagree with the Requesting Party's position.

[13] As stressed by the Owner in its written representations, the Owner is clearly identified by its name, via prominent display, on the invoices of Exhibit F as well as the labels attached to the Goods at the time of sale (Exhibits D and E), the business card of the affiant (Exhibit B) and on promotional/advertising materials for the Goods. The fact that the Owner is also identified as a division of ShaRine Designs and that the invoices indicate that payment is to be made to that entity is of no consequence in the present case. Not only has Mr. Labine provided clear statements that the Goods bearing the Mark were sold during the relevant period through direct sales by the Owner, but he has provided supporting exhibits showing that the Goods so identify the Owner at the time they were sold. As put forth in the Owner's written representations, the Owner is free to set what terms it wishes regarding the manner or party to whom customers should make payment, in which case the customer fulfills its payment obligations upon complying such terms.

[14] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with each of the registered Goods within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[15] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Annie Robitaille
Member
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

Cassan Maclean

FOR THE REGISTERED OWNER

Lavery De Billy S.E.N.C.R.L.

FOR THE REQUESTING PARTY