



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

Citation: 2018 TMOB 31

Date of Decision: 2018-03-29

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF A SECTION 45 PROCEEDING

Charm Jewelry Limited

Requesting Party

and

Robert Forget

Registered Owner

TMA823,809 for ROMANCE

Registration

[1] On January 5, 2016 at the request of Charm Jewelry Limited (the Requesting Party), the Registrar sent the notice stipulated in section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Robert Forget (hereinafter called the Owner), holder of registration No. TMA823,809 for the ROMANCE trade-mark (the Mark).

[2] The Mark is registered in association with the following goods: “bijoux en or, en argent, en metal (*sic*), cristal ou toutes autres matières, en collier, bracelet, bague, boucle d’oreille, chevilière (*sic*), broche” [jewellery in gold, silver, metal, crystal or other materials, in necklaces, bracelets, rings, earrings, anklets, brooches] (the Goods).

[3] This notice enjoined the Owner to provide an affidavit or a statutory declaration that its Mark was used in Canada at any time between January 5, 2013 and January 5, 2016, in association with the goods specified in the registration, and, in the negative, the date when the Mark was used for the last time and the reason for its failure to use it since that date.

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

(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 mere allegations of use are not enough to establish use in the context of the procedure contemplated in section 45 [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 63 (FCA)]. The evidential threshold required is low [*Lang, Michener, Lawrence & Shaw v Woods Canada Ltd* (1996), 71 CPR (3d) 477 (FCTD)]. It is unnecessary to adduce overabundant evidence [*Union Electric Supply Co v Canada (Registrar of Trade-marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nonetheless, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the goods specified by the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co et al.* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar’s notice, the Owner filed his own affidavit, sworn on April 4, 2016 in Québec City.

[7] Neither of the parties filed written representations or requested a hearing.

PRELIMINARY REMARKS

[8] In response to the Registrar’s notice, the Owner first filed a letter dated January 9, 2016 (received on January 19, 2016), to which were attached a business card, two small cards bearing the Mark, and three designs representing the Mark.

[9] In a decision rendered on February 24, 2016, the Registrar informed the Owner that his letter and the attachments could not be accepted as evidence in response to the Registrar's notice because, under the provisions of section 45 of the Act, the evidence must be adduced in the form of an affidavit or a statutory declaration.

[10] Subsequently, on April 5, 2016, the Owner filed with the Registrar a document entitled [TRANSLATION]"DETAILED AFFIDAVIT", which essentially reproduced the contents of the letter dated January 9, 2016. We find stapled to the affidavit the three designs that were attached to the letter of January 9, 2016.

[11] I note that the designs attached to the affidavit are not marked as attachments thereto, nor do they bear a designation entered by the notary to this effect.

[12] However, the Registrar is not bound to follow rigorously the Rules of Practice of the Federal Court in this regard. Especially in the context of section 45 expungement proceedings—which are intended to be summary and expeditious—the Registrar frequently considers certain irregularities as mere technical details [see, for example, *Maximilian Fur Co v Maximillian for Men's Apparel Ltd* (1983), 82 CPR (2d) 146 (TMOB); and *88766 Canada Inc v Tootsie Roll Industries Inc* (2006), 56 CPR (4th) 76 (TMOB)]. It is well established that such technical deficiencies should not prevent an owner from responding to a notice provided for in section 45 when the evidence adduced could suffice to establish use [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 (FCTD)]. In particular, attachments that do not bear the inscription of the Commissioner for Oaths or the notary, but which nonetheless are clearly identified and explained in the body of the affidavit, may be received as evidence in this context [see, for example, *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)].

[13] In the case at bar, I find that the three designs are identified adequately in the affidavit. Although there are two designs of the Mark in logo form—while Mr. Forget mentions only one, as described below—the two designs of the logo resemble each other, and all three designs are physically associated with the affidavit by means of a staple. In the circumstances, I am prepared to conclude that the three designs are part of the evidence in the case at bar.

[14] In any case, the Requesting Party raised no objection in this regard and the affidavit, including the designs, was placed on the record.

[15] However, I note that the attachments to the affidavit include only the three designs that were attached to the letter of January 9, 2016, and not the three cards. As the Registrar indicated in his decision of February 24, 2016, the attachments to the letter of January 9, 2016 cannot be accepted as evidence, since they are not filed in the form of an affidavit or a statutory declaration. Consequently, in the context of my analysis, I consider only the contents of the affidavit sworn on April 4, 2016 and the attached drawings. I will not consider the cards that accompany the letter of January 9, 2016.

THE EVIDENCE

[16] I reproduce below the relevant paragraphs of Mr. Forget's affidavit [TRANSLATION]:

1. I am Robert Forget, owner of 7265409 Canada Inc., and I confirm the use of the name Romance in the jewellery field since June 1, 2010.
2. I am a producer and wholesale importer for jewellery stores, and I sell (*sic*) in the field of jewellery, .925, silver, gold, fashion jewellery and Lotus watches. Our sales are mainly in Quebec and Ontario.
3. The Romance collection is used mainly in silver .925, gold and fashion jewellery, in rings, earrings, necklaces and bracelets.
4. Attached is a copy of the logo, the displays and an earring card.

[17] Effectively, attached to the affidavit we find two designs of the Mark in logo form and a diagram of a display. The display contains several watches and a sign bearing the logo and the mention “.925”.

[18] However, as mentioned above, no earring card is attached to the affidavit. Although such a card was attached to the letter filed on January 19, 2016, on the grounds set out previously, I can only consider the contents of the affidavit sworn on April 4, 2016.

ANALYSIS

[19] In his affidavit, Mr. Forget affirms that the Mark [TRANSLATION] “has been used” since June 1, 2010, in relation to some of the jewellery specified in the registration.

[20] Although section 45 provides for a summary procedure, and the evidential burden is not heavy, it nonetheless remains that a mere assertion of use is, in itself, insufficient to establish the use of a trade-mark under the terms of section 45 of the Act. One must instead *prove* the use of the mark, by describing enough facts for the Registrar to be able to arrive at a conclusion whether the mark was used in Canada during the relevant period and in accordance with section 4 of the Act [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401]. In particular, it is incumbent on the registered owner to prove—regarding each of the goods specified in the registration—how the mark was marked on these goods or their packages, or otherwise associated with these goods, at the time of their sale or delivery in the normal course of trade.

[21] In the case at bar, the few vague facts provided by Mr. Forget are insufficient to substantiate his assertion of use.

[22] First of all, Mr. Forget does not specify if “the use” of the Mark since June 1, 2010 was continuous, or at least in such a manner as to include uses of the Mark between January 5, 2013 and January 5, 2016.

[23] Moreover, although Mr. Forget indicates that the jewellery is sold [TRANSLATION] “mainly” in Quebec and Ontario, he does not confirm that in fact the Goods were sold in these provinces, in association with the Mark and during the relevant period. Nor is it indicated that the Goods were sold in association with the Mark elsewhere in Canada during the relevant period.

[24] Likewise, concerning the Goods, Mr. Forget simply affirms that the Mark [TRANSLATION] “is mainly used” in the field of gold and silver jewellery, rings, earrings, necklaces and bracelets. He does not specify which of this jewellery was sold in association with the Mark during the relevant period. Moreover, his affidavit does not refer in any way to the other goods that appear in the registration, namely [TRANSLATION] “anklets” and brooches, and jewellery in metal, crystal and [TRANSLATION] “other materials”. If by [TRANSLATION] “fashion jewellery” Mr. Forget means such jewellery, he does not explain this in his affidavit.

[25] In any case, Mr. Forget does not provide any evidence of sales or transfers of Goods in Canada during the relevant period.

[26] Although it is not mandatory to produce invoices to respond satisfactorily to the notice stipulated in section 45 [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], it remains necessary to provide at least certain evidence that would allow the Registrar to conclude that the goods specified in the registration were transferred in association with the Mark in Canada in the normal course of trade during the relevant period. For example, in the absence of invoices, such evidence may take the form of sales reports or equivalent factual details [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 (CanLII), CarswellNat 4624].

[27] However, in the case at bar, Mr. Forget's affidavit does not contain any evidence proving that the Goods were transferred in the normal course of trade. Mr. Forget does not provide any sales figures or any document showing any transaction whatsoever.

[28] Moreover, Mr. Forget does not describe or prove the manner in which the Mark was presented on, or in association with, each of the Goods at the time of their sale or transfer during the relevant period.

[29] In particular, the designs of a logo accompanying Mr. Forget's affidavit do not show how this logo was marked on or otherwise associated with the goods. Although one of the designs represents the Mark shown on a display, nothing indicates when and where this display was exhibited. Moreover, nothing indicates what jewellery was presented in this display. It is also curious that Mr. Forget chose to provide a diagram in support of his assertions of use of the Mark, instead of a photograph showing an actual display, as it would have been at the points of sale during the relevant period.

[30] I will add in passing that if the above-mentioned earring card had been attached to the affidavit and designated as representative of the cards attached to the earrings sold in Canada during the relevant period, this card could have indicated the manner in which the Mark was associated with one of the Goods at the time of its transfer. However, as I mentioned above, I can

consider as evidence only the affidavit, to which the card is not attached. In all cases, no evidence proves a transfer of earrings in the normal course of trade.

[31] In the absence of additional details and supporting documents, I cannot conclude that the Mark as registered was marked on the Goods or their packages or was otherwise associated with the Goods, such that a notice of this association would have been given to the buyers at the time of the transfer of the property in or possession of the Goods. It is thus impossible to determine the extent to which the Mark was used, within the meaning of section 4 of the Act, with each of the goods specified in the registration.

[32] On the whole, Mr. Forget's statements amount to mere allegations of use, instead of statements of fact establishing the use of the Mark. As such, Mr. Forget's statements are insufficient to establish the use of the Mark within the meaning of sections 4 and 45 of the Act.

DECISION

[33] In view of all of the above, I am not convinced that the Owner proved the use of the Mark in association with the goods covered by the registration within the meaning of sections 4 and 45 of the Act. Moreover, I do not have any evidence of special circumstances justifying failure to use.

[34] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, the registration will be expunged.

Oksana Osadchuk
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Arnold Bennett

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

No Hearing Held

AGENT(S) OF RECORD

No Agent Appointed

FOR THE REGISTERED OWNER

Stewart McKelvey

FOR THE REQUESTING PARTY