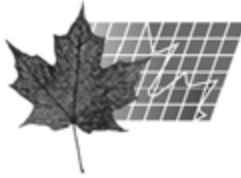


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 70

Date of Decision: 2020-05-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Fetherstonhaugh & Co.

Requesting Party

and

Les Montres Marciano Inc.

Registered Owner

**TMA747,407 for EVERY SECOND
COUNTS**

Registration

INTRODUCTION

[1] At the request of Fetherstonhaugh & Co. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on May 23, 2018, to Les Montres Marciano Inc. (the Owner), the registered owner of Registration No. 747,407 for the trademark EVERY SECOND COUNTS (the Mark).

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

Watches, parts for watches, watch movements, watch straps, watch bands, watch bracelets, watch batteries, watch chains; clocks; jewellery, namely chains, brooches, pins, lockets, rings, earrings, necklaces, pendants, pearls, bracelets, ankle bracelets, cuff-links and tie-clips; wallets, money clips, clothing accessories namely belts, belt buckles; t-shirts, shirts, blouses, caps, hats, sweaters, jackets, skirts and pants.

[3] For the reasons that follow, I conclude that the registration ought to be maintained with respect to “watches” only.

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with the goods 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 23, 2015, to May 23, 2018.

[5] The relevant definition of use for goods is set out in section 4 of the Act as follows:

4(1) A trademark 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 bare statements that a trademark is in 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 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 trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) (*John Labatt*)].

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Moshe Dayan, the President and Managing Director of the Owner, sworn August 16, 2018. Only the Owner submitted written representations. No oral hearing was held.

THE OWNER’S EVIDENCE

[8] Mr. Dayan states that the Owner has sold “watches with watch straps, watch hands and/or watch bracelets” in the normal course of trade continuously since 2009, including during the

relevant period, through its booths and kiosks in shopping malls and chain retail outlets. He states that many of these watches had the Mark displayed on the casing of the watch, on the packaging of the watches, or on cards included in the packaging of the watches.

[9] Mr. Dayan attaches photographs to his affidavit showing a watch in packaging displaying the Mark (Exhibit 1), a watch in a bag along with a business card displaying the Mark (Exhibit 3), and a watch with the Mark displayed on its back casing (Exhibits 4, 5, and 6), stating that these photographs are representative of how the Mark was displayed in the course of sales of the watches during the relevant period. He states that each of the watches depicted in the latter photographs had watch straps, watch bands, and/or watch bracelets attached to them at the time of transfer. In addition, he attaches copies of invoices dated during the relevant period (Exhibit 8) showing sales in Canada of “Ferenzi-Assorted-Premium-Watches”, and states that these watches displayed the Mark on their cases.

[10] Mr. Dayan states that during the relevant period, the Owner did not sell jewellery, wallets, or clothing accessories in association with the Mark.

ANALYSIS

[11] At the outset, in view of Mr. Dayan’s statement that the Owner did not sell jewellery, wallets, or clothing accessories in association with the Mark during the relevant period, I find that the Owner has not established use of the Mark in association with the registered goods “jewellery, namely chains, brooches, pins, locketts, rings, earrings, necklaces, pendants, pearls, bracelets, ankle bracelets, cuff-links and tie-clips; wallets, money clips, clothing accessories namely belts, belt buckles; t-shirts, shirts, blouses, caps, hats, sweaters, jackets, skirts and pants” within the meaning of section 4 and 45 of the Act. As there is no evidence of special circumstances before me which would excuse non-use of the Mark in association with these registered goods, the registration will be amended accordingly.

[12] Conversely, based on Mr. Dayan’s statement that watches were sold to customers in Canada in association with the Mark in the normal course of trade during the relevant period (as demonstrated by the Exhibit 8 invoices), and the corresponding photographs showing the Mark displayed on the packaging and casing of those watches, I accept that the Owner sold watches

bearing the Mark in Canada during the relevant period. Accordingly, I am satisfied that the Owner has established use of the Mark in association with the registered goods “watches” within the meaning of section 4 and 45 of the Act.

[13] As such, the question to be determined is whether the Owner has established use of the Mark within the meaning of the Act in association with the remaining goods, namely, “parts for watches, watch movements, watch straps, watch bands, watch bracelets, watch batteries, watch chains; clocks”. In this respect, the Owner submits that since the watches sold by the Owner in association with the Mark had watch movements, batteries, straps, bands or bracelets attached to them at the time of transfer, the Owner has satisfied the requirements of section 4(1) and 45 of the Act with respect to the component parts as well as the watches themselves despite the Mark not being printed on the components themselves. The Owner submits that purchasers are given notice of association between the Mark and these components by way of display of the Mark on the packaging in which these components are sold, or on cards included in such packaging, arguing that to find otherwise would be inconsistent with the language of section 4(1) which provides that use of a Mark will be established where a trademark is displayed on packaging or where notice is given “in any other manner”.

[14] However, to the extent the Owner sold watch movements, batteries, straps, bands, or bracelets during the relevant period, the evidence shows it was only as components of the watches depicted in evidence. Generally, use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration; having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [per *John Labatt*; for similar conclusions regarding components or ingredients, see *Ziaja Ltd v Jamieson Laboratories Ltd* (2005), 50 CPR (4th) 237 (TMOB) at para 10; *McMillan LLP v Orange Brand Services Ltd*, 2016 TMOB 111 at paras 72-73; *Vermillion Intellectual Property Corp v Vermillion Energy Inc*, 2017 TMOB 24 at para 69]. For the Owner to maintain its registration for the goods “parts for watches, watch movements, watch straps, watch bands, watch bracelets, watch batteries, watch chains”, it had to show transfer and sales of such goods otherwise than as components of “watches”.

[15] Finally, with respect to the registered goods “clocks”, again, evidence showing use in association with watches alone is not sufficient to establish use in association with this more general category of good [per *John Labatt*; see also *Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD) at paras 15-17].

[16] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods “parts for watches, watch movements, watch straps, watch bands, watch bracelets, watch batteries, watch chains; clocks”, within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances before me which would excuse non-use of the Mark in association with these goods, the registration will be amended accordingly.

DISPOSITION

[17] 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 the provisions of section 45 of the Act, the registration will be amended to delete the following registered goods:

parts for watches, watch movements, watch straps, watch bands, watch bracelets, watch batteries, watch chains; clocks; jewellery, namely chains, brooches, pins, locketts, rings, earrings, necklaces, pendants, pearls, bracelets, ankle bracelets, cuff-links and tie-clips; wallets, money clips, clothing accessories namely belts, belt buckles; t-shirts, shirts, blouses, caps, hats, sweaters, jackets, skirts and pants.

[18] The amended statement of goods will be as follows:

Watches.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENTS OF RECORD

Harold W. Ashenmil

For the Registered Owner

Smart & Biggar IP Agency Co.

For the Requesting Party