



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 071

Date of Decision: 2023-04-18

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Finlayson & Singlehurst

Registered Owner: Alcon Inc.

Registration: TMA927,940 for FRESHLOOK

INTRODUCTION

[1] This is a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA927,940 for the trademark FRESHLOOK (the Mark) registered for use in association with the following goods: “contact lenses; cases and containers for contact lenses”.

[2] For the reasons that follow, I conclude that the registration ought to be amended to delete the goods “cases and containers for contact lenses”.

THE PROCEEDING

[3] At the request of Finlayson & Singlehurst (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 9, 2021 to the registered owner of the Mark, Alcon Inc. (the Owner).

[4] The notice required the Owner to show whether the Mark was 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 November 9, 2018 to November 9, 2021 (the Relevant Period). In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[5] The relevant definition of use in the present case is set out in section 4(1) of the Act as follows:

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] 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. The evidence in a section 45 proceeding need not be perfect; the Owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[7] In response to the Registrar's notice, the Owner furnished the Affidavit of Vanessa Johari-Hansen, sworn on June 2, 2022, together with Exhibits A to F.

[8] Both parties submitted written representations. No hearing was held.

THE EVIDENCE

[9] Ms. Johari-Hansen is the Director of Marketing, Vision Care, of Alcon Canada Inc. (Alcon Canada), a wholly owned subsidiary of the Owner.

[10] Ms. Johari-Hansen states that the Owner acquired the Mark from Novartis AG via a *nunc pro tunc* assignment effective April 8, 2019, which assignment was recorded against the registration on September 27, 2019. The Registrar has a discretion to review the state of the register [*True Software Scandinavia AB v Ontech Technologies Inc*, 2018 TMOB 40] and I have done so to confirm that a change of title in favour of the Owner was recorded on September 27, 2019.

[11] Ms. Johari-Hansen goes on to state that the Owner distributes its products in Canada through Alcon Canada. She also states that Alcon Canada is licensed by the Owner to use the Mark in Canada in association with the goods specified in the registration and that the Owner maintains care and control over the nature and quality of the goods in association with which the Mark is used in Canada.

[12] Ms. Johari-Hansen states that the Owner sold contact lenses in Canada in association with the Mark during the Relevant Period through various online Canadian retailers such as Vision Pros and Clearly and through Canadian distributors such as Essilor Luxottica Canada, Inc. and Walmart Vision Centre. In support, she provides the following:

- (a) Exhibit B – a printout from the Vision Pros website at *visionpros.ca* showing packaging for color enhancing contact lenses which packaging displays the Mark above the word “colors”. Ms. Johari-Hansen says this is representative of the manner in which contact lenses displaying the Mark were available for sale in Canada during the Relevant Period on *visionpros.ca*.
- (b) Exhibit C – a printout from the Clearly website at *clearly.ca* showing packaging for contact lenses which packaging displays the Mark above the word “colors”. Ms. Johari-Hansen says that the printout is representative of the manner in which

contact lenses displaying the Mark were available in the product catalogue available on *clearly.ca* in Canada during the Relevant Period.

- (c) Exhibit D – an image of packaging for contact lenses which displays the Mark above the word “colors”. Ms. Johari-Hansen says the image is representative of the packaging used for the contact lenses sold in Canada during the Relevant Period.
- (d) Exhibit E – a portion of an invoice dated December 6, 2018 from Alcon Canada to Clearly. In the upper right hand corner of the invoice, there is a reference to “Alcon A Novartis Division”. The invoice has been redacted such that the only product visible is identified as FRESHLOOK COLORS. The sale appears to be for one unit at a net price of \$39.00. Also included in the exhibit is a portion of an invoice dated June 25, 2021 from Alcon Canada to Vision Pros. In the upper right hand corner of the invoice, there is a reference to “Alcon”. Again, the invoice has been redacted such that the only product visible is identified as FRESHLOOK COLORS. The sale appears to be for two units at a net price of \$80.00.
- (e) Exhibit F – a 2020 Alcon Parameter Guide distributed by Alcon Canada to Canadian eye care practitioners for use in prescribing contact lenses to their patients. The Guide lists FreshLook Colors contact lenses under the heading “Beauty Lenses”.

ANALYSIS AND REASONS FOR DECISION

[13] The Requesting Party submits that the Owner has submitted no evidence with respect to “cases and containers for contact lenses” and that those goods must be deleted from the registration. As the Owner, in its submissions, consents to the deletion of those goods, the registration will be amended accordingly.

[14] With respect to the remaining goods, namely contact lenses, the Requesting Party made no submissions. The Owner, on the other hand, submits that the evidence provides sufficient details as to the Owner’s normal course of trade and shows that the contact lenses were sold in Canada during the Relevant Period in packages which displayed the Mark. I agree with the Owner.

[15] Ms. Johari-Hansen states that Alcon Canada was licensed by the Owner to use the Mark, subject to the Owner's care and control as to the nature and quality of the goods sold in association with the Mark. Based on her evidence, I am satisfied that a license was in place and that the requisite control was exercised [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102]. Accordingly, I am satisfied that the evidenced use of the Mark by Alcon Canada enures to the Owner's benefit pursuant to section 50 of the Act (subject to the comment below concerning the invoice dated December 6, 2018).

[16] Further, the evidence shows that the Mark was displayed on the packaging in which the goods were sold in Canada (Exhibit D).

[17] Finally, the evidence shows that there was a sale of the goods in Canada during the Relevant Period. In this regard, I have relied on the invoice dated June 25, 2021 from Alcon Canada to Vision Pros; I have not relied on the invoice dated December 6, 2018 from Alcon Canada to Clearly. The latter invoice predates the assignment of the Mark to the Owner and, presumably, the license from the Owner to Alcon Canada. I have no evidence before me as to the relationship between Alcon Canada and the previous owner of the Mark.

[18] Evidence of a single sale can be sufficient to establish use for the purposes of section 45 so long as it follows the pattern of a genuine commercial transaction and is not seen as deliberately manufactured or contrived to protect the registration [*Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)].

[19] Based on the evidence as a whole, I am satisfied that the evidence of a single sale follows the pattern of a genuine commercial transaction.

[20] Accordingly, I am satisfied that the Mark was used in Canada by the Owner in association with the goods "contact lenses" during the Relevant Period within the meaning of sections 4(1) and 45 of the Act.

DISPOSITION

[21] 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 “cases and containers for contact lenses”.

[22] The amended statement of goods will read as follows: “contact lenses”.

Robert A. MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Finlayson & Singlehurst

For the Registered Owner: Miller IP Law