

**Date: 20080926**

**Docket: T-456-08**

**Citation: 2008 FC 1071**

**Ottawa, Ontario, September 26, 2008**

**PRESENT: The Honourable Mr. Justice Martineau**

**BETWEEN:**

**PROMOTIONS C.D. INC.,  
sometimes doing business as  
LES PROMOTIONS G.B.  
[successor of LES PROMOTIONS G.B. INC.]**

**Appellant**

**and**

**SIM & MCBURNEY**

**Respondent**

**REASONS FOR ORDER AND ORDER**

[1] This is an appeal from a decision of the Registrar of Trade-marks (the Registrar) dated January 22, 2008, ordering the expunging of registration number LMC 440,974 for the PETER PAN trade-mark, pursuant to subsection 45(4) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (Act).

[2] The appellant, Promotions C.D. Inc., is a legal person duly incorporated under the laws of the province of Quebec, having its place of business at 550 St-Jean, Longueuil, Quebec, J4H 2Y4. For a number of years, this corporation has operated a wholesale sales business of various products, including clothing, namely pantyhose, under the trade-mark in question.

[3] On March 24, 1995, the trade-mark in question was registered under number LMC 440,974 in the register of trade-marks for use in connection with the following wares: "clothing, namely pantyhose".

[4] At that time, the registered owner of the trade-mark was Les Promotions G.B. Inc. (GB), a company duly incorporated under the laws of Quebec, having its place of business at 194 Laurier, Saint-Thomas-D'Aquin, Saint-Hyacinthe, Quebec, J0H 2A0.

[5] During the month of November 2004, GB was wound up while on November 2, 2004, GB [TRANSLATION] "distributed, ceded and remitted" to the appellant [TRANSLATION] "all of its assets (and liabilities)". However, no amendment to this effect was made in the register of trade-marks. (Since then, at the same time as these proceedings were undertaken, the appellant applied to have the register amended to substitute its name and address.)

[6] At the respondent's request, on August 23, 2007, the Registrar sent to GB's former address a notice under subsection 45(1) of the Act. The registered owner of the trade-mark therefore had to show the Registrar that the trade-mark in question had been used in Canada during the relevant

period of three years, specifically, from August 23, 2004, to August 23, 2007 (the relevant period), in connection with [TRANSLATION] "clothing, namely pantyhose". However, on January 22, 2008, the Registrar ruled that because of the failure to furnish the required evidence of use, registration number LMC 440,974 was to be expunged from the register pursuant to subsection 45(4) of the Act.

[7] In this appeal brought under section 56 of the Act, the appellant submits that in spite of continuous use of the trade-mark in question by the appellant and its predecessor, GB, during the relevant period, evidence of use required by the Registrar's notice under section 45 of the Act could not have been submitted to the Registrar because the appellant did not have timely knowledge of the notice in question. Therefore, no evidence of use was submitted at that time to the Registrar and this resulted in a different decision.

[8] Considering the additional evidence submitted by the appellant and its determinative nature, the matter must be heard *de novo* on the basis of the standard of correctness (*Austin Nichols & Co., Inc. v. Cinnabon Inc.*, [1998] F.C.J. No. 1352 (QL), at paragraph 13, [1998] 4 F.C. 569; *Molson Breweries v. John Labatt Ltd.*, 5 C.P.R. (4th) 180, [2000] F.C.J. No. 159 (QL); *United Grain Growers Ltd. v. Lang Michener*, [2001] 3 F.C. 102, [2001] 3 F.C. 102 (QL)).

(Notwithstanding the Supreme Court decision in *Dunsmuir v. New Brunswick*, 2008 SCC 9, which did not specifically deal with a situation such as the one in this case, the standard of review remains that of correctness).

[9] The test to be met for a proceeding under section 45 of the Act is not severe. In fact, evidence of one single sale may be sufficient (*Cordon Bleu International Ltd. v. Renaud Cointreau & Cie* (2000), 10 C.P.R. (4th) 367, [2000] F.C.J. No. 1416 (QL)). No specific form of evidence is required in a proceeding under section 45 of the Act. That being said, it is not sufficient to simply allege that the trade-mark is used, but rather it is necessary to describe the use made of this trade-mark (*Renaud Cointreau & Cie v. Cordon Bleu International Ltd.*, [2000] F.C.J. No. 882 (QL), at paragraph 36, 193 F.T.R. 182). On this point, a photocopy may be acceptable (*Mantha & Associates v. Le Cravatte di Pancaldi S.r.L.*, [1998] F.C.J. No. 1636 (QL), at paragraphs 18-20, 84 C.P.R. (3d) 455). In this case, evidence of a label may be acceptable if the facts described in the affidavit or the statutory declaration show use (*Renaud Cointreau & Co. v. Cordon Bleu International Ltd.*, [2000] F.C.J. No. 882 (QL), at paragraphs 17 and 35, 193 F.T.R. 182). Finally, the fact that there was a change of owner of the registered trade-mark within the relevant period allows the Court to consider at the same time evidence of use by the registered owner, in this case GB, and by the present owner, that is, the appellant (*Sim & McBurney v. Buttino Investments Inc.*, [1996] F.C.J. No. 208 (QL), 66 C.P.R. (3d) 77).

[10] In ruling on the issue *de novo* and after having considered all the additional evidence submitted, the Court finds that this appeal must be allowed. The content of the statutory declarations given by Jacques Collette and by Normand Berthiaume on April 17, 2008, is determinative. The respondent did not cross-examine Mr. Collette or Mr. Berthiaume. In this case, I have no reason to doubt the truthfulness of the allegations made by both deponents, as they are conclusive as far as the use and the trade-mark in question during the relevant period are concerned.

[11] Mr. Berthiaume is a consultant for the appellant and a former president of GB. He submitted colour photocopies of the pantyhose packaging with the products in question sold in September and October 2004 in Canada by GB in connection with the trade-mark in question. The documentary evidence attached to the declaration shows that the pantyhose in this packaging was actually sold on the Canadian market at one time or another in September and October 2004.

[12] Mr. Collette is the vice-president of the appellant. He held this position throughout the relevant period from August 23, 2004 to August 23, 2007. He submitted colour photocopies of the pantyhose packaging with the products in question sold in Canada by the appellant in connection with the trade-mark in question, as well as invoices from the appellant showing sales of pantyhose under the trade-mark in question. The documentary evidence attached to the declaration shows that this packaging was sold on the Canadian market, more specifically, at one time or another in 2005, 2006 and 2007. In fact, at least 300,000 pairs of pantyhose (like those in Exhibit JC-4) were sold by the appellant to retailers in 2006.

[13] Accordingly, I am satisfied on the basis of the evidence submitted in this case that the use of the trade-mark in question is in connection with the wares subject to registration during the relevant period (first by GB, then by the appellant).

[14] In conclusion, the appeal is allowed. The decision of the Registrar of Trade-marks dated January 22, 2008, expunging registration number LMC 440,974 in connection with the PETER

PAN trade-mark pursuant to subsection 45(4) of the Act is set aside and the Registrar must make the appropriate annotations in the register of trade-marks. Without costs.

**ORDER**

**THE COURT ORDERS** that the appeal is allowed. The decision of the Registrar of Trade-marks dated January 22, 2008, expunging registration number LMC 440,947 in connection with the PETER PAN trade-mark pursuant to subsection 45(4) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, is set aside and the Registrar must make the appropriate annotations in the register of trade-marks. Without costs.

“Luc Martineau”

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Judge

Certified true translation  
Susan Deichert, Reviser

**FEDERAL COURT**

**SOLICITORS OF RECORD**

**DOCKET:** T-456-08

**STYLE OF CAUSE:** PROMOTIONS C.D. INC. v. SIM & MCBURNEY

**PLACE OF HEARING:** Montréal, Quebec

**DATE OF HEARING:** September 15, 2008

**REASONS FOR ORDER  
AND ORDER:** MARTINEAU J.

**DATED:** September 26, 2008

**APPEARANCES:**

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FOR THE RESPONDENT

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