THE EVIDENCE OF USE REQUESTED IN A SECTION 45 PROCEEDING REVIEWED BY THE FEDERAL COURT

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Jagotec AG v. *Riches, Mckenzie & Herbert LLP*, 2006 FC 1468 (CanLII)

In an appeal to the decision made by the Opposition Board on behalf of the Registrar of Trade-marks to expunge Jagotec AG's registered trade-mark VISIBLE YOUTH in association with various skin care products from the register pursuant to section 45 of the *Trade-marks Act* ("the Act"), the Federal Court of Canada (the "FC") had to decide whether the Opposition Board Member erred in finding that the evidence of use of the mark during the relevant period was inadequate.

1. Factual background

The relevant period within which Jagotec AG was required to furnish evidence of use of its VISIBLE YOUTH trade-mark in accordance with section 45 of the Act was from October 1999 to October 2002. In this case, as Jacotec AG became the owner of the trade-mark by assignment in 2001, the evidence was mostly to be provided by its predecessor in title, SkyePharma PLC.

At the opposition stage, the evidence provided by Jagotec AG was found to be inadequate by the hearing officer. As the appeal was afterward filed and based on two new affidavits, the court's standard of review was therefore based on correctness.

The new evidence described the sales process of SkyePharma PLC's distributor, who was receiving the Canadian orders, which were directed to a

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Toronto warehouse for subsequent shipment. SkyePharma PLC was also the identity issuing the invoices and receiving payment from the Canadian customers. Both filed affidavits had exhibits which included invoices issued during the relevant period, as well as sales records and pictures of the VISIBLE YOUTH products.

2. Analysis and conclusions

As is it not necessary in a section 45 proceeding for a registrant to produce detailed and complete records of use, but rather a *prima facie* case of use needs to be furnished, the Court noted that proof of a single sale made during the relevant period, in this particular case between October 1992 and October 2002, would be enough.

The Court was in this case satisfied by the evidence filed in appeal, as the affidavits showed use of the trade-mark through sales of the wares in Canada, at least prior to the assignment in 2001, in that such wares were sold in containers or packaging bearing the terms VISIBLE YOUTH.

Therefore, even though the invoices and sales records produced as evidence by Jagotec AG did not by themselves prove use of the trade-mark, the Court found that they nevertheless substantiated the affiant's evidence that sales of the wares had occurred.

Finally, the fact that the terms VISIBLE YOUTH appeared placed one above the other on the wares packaging did not, as argued by the respondent, convinced the Court that the trade-mark was not in fact used as registered. On that matter, the Court was of the opinion that any casual observer would instantly associate the two words as being part of a global expression.

In light of the above, the Court therefore allowed the appeal with cost to Jagotec Ag.