



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

**Citation: 2012 TMOB 68**  
**Date of Decision: 2012-04-11**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Himelfarb Proszanski LLP against  
registration No. TMA466,739 for the trade-mark  
LELLIKELLY in the name of Lelli Kelly S.p.A.**

[1] At the request of Himelfarb Proszanski LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 17, 2009 to Lelli Kelly S.p.A. (the Registrant), the registered owner of registration No. TMA466,739 for the trade-mark LELLIKELLY (the Mark).

[2] The Mark is registered for use in association with “shoes, boots, slippers and clothing, namely suits, skirts, overcoats, raincoats, mantles, sweaters, cardigans, vests, shirts, collars, cuffs, blouses, sport shirts, polo shirts, undershirts, pants, chemises, slips, petticoats, corsets, negligees, socks, neckties, tieneckerchiefs” (the Wares).

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares 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 between November 17, 2006 and November 17, 2009.

[4] The relevant definition of “use” in association with wares is set out in s. 4(1) of the Act:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[5] In response to the Registrar's notice, the Registrant filed the statutory declaration of Mr. Mario Attilieni, Sales Director of the Registrant, sworn on May 31, 2010. Neither party filed written representations; an oral hearing was not held.

[6] In his affidavit, Mr. Attilieni states that the Registrant is an Italian company that sells and promotes the Wares in Canada and other countries. He states that the Wares are sold mainly to clothing boutiques, independent shoe stores and other "high-grade" retailers in Canada. He further indicates that the Wares have been sold in association with the Mark continuously in Canada since 1997. Based on the information provided in the affidavit, the total value of sales of the Wares in Canada for the years 2007 to 2009 was approximately CDN\$300,000. However, I note that despite the assertion of use with respect to all of the Wares, the evidence appears to relate only to "shoes, boots, slippers" and not to the other "clothing" wares, as discussed below.

[7] As evidence of how the Mark was displayed on the Wares, attached as Exhibit CC-2 is a picture of a sample label which Mr. Attilieni identifies as representative of the labels stitched to the Wares sold in Canada. I note the label shows a minor but acceptable deviation of the Mark, displaying it as two words, with the word "Lelli" appearing above the word "Kelly".

[8] Similarly, attached as Exhibit CC-3 is a picture of a shoe sole, which Mr. Attilieni identifies as representative of the use of the Mark on shoes, boots and slippers distributed and sold in Canada. I note the Mark is printed on the sole in a manner similar to the exhibited label.

[9] Attached as Exhibit CC-4 to the affidavit are the Registrant's 2009 Fall/Winter and 2009 Spring/Summer "LelliKelly" product catalogues. A third publication by the Registrant, which appears to be a recipe collection targeted towards children, is also attached but does not appear to be relevant to this proceeding. I note that the product catalogues only display footwear products and no other clothing items are pictured or referenced. However, I further note that the Mark is

clearly displayed throughout the catalogues, including prominent display on the side and front of some of the shoes pictured in the catalogues.

[10] As proof of sales, attached as Exhibit CC-5 to the affidavit are representative invoices of sales to Canadian retailers and distributors dating back to 1997, including approximately 180 invoices from the Relevant Period. Products are invoiced with reference to style, color and size codes, without reference to the Mark or clearly indicating the specific type of Ware. However, the style codes appear to correspond with the codes that appear in the exhibited product catalogues. For example, on the invoice dated April 7, 2009, the line item for 36 units of “Pink Multi” is identified with Style code VF1343, which corresponds to a “LelliKelly” shoe depicted on page two of the 2009 Fall/Winter catalogue.

[11] Accordingly, in view of the foregoing, I am satisfied that there was use of the Mark in association with the Wares “shoes, boots, slippers” during the Relevant Period within the meaning of sections 4 and 45 of the Act.

[12] With respect to the remaining “clothing” Wares, it is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co v Canada (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 trade-mark in association with each of the wares specified in the registration during the relevant period. However, aside from the bare assertion of use, the affidavit is otherwise silent with respect to such “clothing” Wares. Furthermore, given the lack of detail in the exhibited invoices and the absence of listings for other clothing items in the corresponding catalogues, I cannot conclude that such invoices show sales of any of the remaining “clothing” Wares during the Relevant Period in Canada. Indeed, I note that none of the invoices dating back to 1997 appear to show any such sales.

[13] Accordingly, I cannot conclude that the Registrant has demonstrated use of the Mark in association with the Wares “clothing, namely suits, skirts, overcoats, raincoats, mantles,

sweaters, cardigans, vests, shirts, collars, cuffs, blouses, sport shirts, polo shirts, undershirts, pants, chemises, slips, petticoats, corsets, negligees, socks, neckties, tieneckerchiefs” during the Relevant Period within the meaning of sections 4 and 45 of the Act. Furthermore, the Registrant has provided no evidence of special circumstances excusing the absence of such use.

Disposition

[14] In view 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 Wares: clothing, namely suits, skirts, overcoats, raincoats, mantles, sweaters, cardigans, vests, shirts, collars, cuffs, blouses, sport shirts, polo shirts, undershirts, pants, chemises, slips, petticoats, corsets, negligees, socks, neckties, tieneckerchiefs.

[15] The amended statement of wares will read as follows: “shoes, boots, slippers”.

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Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office