

**In the matter of Section 45 proceedings against Registration
No. TMA201,169 for the trade-mark HUIT & Design**

[1] On February 14, 2007, at the request of Sim & McBurney, the Registrar forwarded the notice prescribed by s. 45 of the *Trade-marks Act* R.S.C 1985, c- T-13 (the Act) to Huit Diffusion, société anonyme (the Owner) with respect to Registration No. TMA201,169 for the trade-mark HUIT & Design (the Mark). The Mark, which is illustrated below, is registered in association with “lingerie and corset articles for men, women and children; underwear; brassieres, pants, vests in natural and synthetic fabrics; shirts, short-sleeved shirts, blouses; stockings, tights, panties and socks; swimsuits and bathing costumes for men, women and children.”



[2] Pursuant to the provisions of s. 45 of the Act, the registered owner must show, with respect to each of the wares and/or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three-year period immediately preceding the date of the notice and, if not, the date on which it was last used and the reason for the absence of use since that date. The relevant period in this case is anytime between February 14, 2004 and February 14, 2007. What qualifies as use of a trade-mark is defined in s. 4 of the Act.

[3] In response to the Registrar’s notice, the Owner filed the affidavit of Bruno Roberty, together with Exhibits BR-1 through BR-3. Only the requesting party filed written representations. Both parties were represented at the oral hearing.

[4] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing deadwood from the register. Mere assertions of use are insufficient to demonstrate use [see *Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1979), 45 C.P.R. (2d) 194 (F.C.T.D.); aff’d 53 C.P.R. (2d) 62 (F.C.A.)].

A recipient of a notice pursuant to s. 45 of the Act must put forward evidence showing how it has used the trade-mark so that the Registrar may assess if the facts qualify as use of the trade-mark pursuant to s. 4 of the Act. However, it has also been held that evidentiary overkill is not required when use can be shown in a simple, straightforward fashion [see *Union Electric Supply Co. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)]. It is well established that ambiguities in the evidence are to be interpreted against the registered owner's interests [see *Aerosol Fillers Inc.*, *supra*].

[5] Mr. Roberty has been the Director General of the Owner since September 1, 2000. He states that the Owner's principal activities are the conception, manufacturing, sale and distribution of women's clothing including, but not limited to, lingerie and bathing suits. At paragraph 2 of his affidavit, Mr. Roberty states that he is aware of the commercialisation in Canada of the wares identified in the registration for the Mark or "*toute autre version actualisée de la Marque substantiellement similaire*" (any other updated version of the substantially similar Mark). At this time, I should remark that in his affidavit, Mr. Roberty collectively refers to the wares identified in the registration as "*les Marchandises*".

[6] Mr. Roberty deposes at paragraphs 3 and 4:

3. *Je souscris le présent affidavit afin de démontrer qu'entre le 14 février 2004 et le 14 février 2007 (ci-après désignée comme « la Période pertinente »), dans le cours normal des affaires, Huit Diffusion employait la Marque au Canada en liaison avec les Marchandises.*
4. *À titre illustratif de la manière dont la Marque est apposée sur, ou de toute autre manière liée à, certaines des produits constituant les Marchandises vendus par Huit Diffusion au Canada dans le cours normal des affaires durant la Période pertinente, je produis en liasse comme élément BR-1 [...] un échantillonnage d'étiquettes.*
(My underline)

[7] Paragraph 3 constitutes a mere statement of use reproducing the provisions of s. 45 of the Act.

[8] Considering the statement at paragraph 4 of the affidavit in its entirety, I conclude that the hangtags are filed as representative specimens showing use of the Mark during the relevant period, but only in association with certain of the registered wares. In my view, the verb *vendus* supports my interpretation since the verb agrees with *certaines produits*. If Mr. Roberty meant to refer to *les Marchandises*, the verb would have had to read *vendues*. If my interpretation is incorrect, then the statement is ambiguous and I am entitled to interpret it against the interests of the Owner.

[9] Each of the six hangtags filed as Exhibit BR-1 displays the following trade-mark:



[10] The requesting party argues that the trade-mark shown above considerably differs from the Mark. It submits that the “most notable differences” are: the shape of the numeric character, the lettering of the word “huit” and the backdrop and borders. Relying on the principles enunciated in *Registrar of Trade-Marks v. Compagnie Internationale pour l’Informatique CII Honeywell Bull S.A.* (1985), 4 C.P.R. (3d) 523 (F.C.A.) and *Promafil Canada Ltée v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A), I consider that the differences between the trade-mark as registered and as shown on the hang tags consist of minor variations. As I am of the view that the Mark remains recognizable and has not lost its identity, I conclude that the differences are so unimportant as not to mislead or deceive the public in any way. Thus, I am satisfied that the use of the trade-mark shown above constitutes use of the Mark within the meaning of s. 4(1) of the Act.

[11] Mr. Roberty deposes at paragraph 5:

5. *Je produis en liasse comme élément BR-2 [...] un échantillonnage de factures, sur lesquelles la Marque est démontrée, à titre illustratif de la vente au Canada des produits constituant les Marchandises, en liaison avec la Marque, par Huit Diffusion au courant de la Période*

pertinente. Pour chacune des années 2004 à 2007, dans le même élément BR-2, je joins un tableau récapitulatif de ces factures indiquant, entre autres, une description des produits visés et les catalogues, dont il est question au paragraphe suivant, dans lesquels lesdits produits sont annoncés.

- [12] Some invoices issued in 2006 and the invoices issued in 2007 show the word “huit” in a stylized script, whereas the trade-mark illustrated below is displayed at the top left corner of the invoices issued in 2004, 2005 and of some invoices issued in 2006.



- [13] Since the numeric character is the dominant element of the Mark, I consider it to be an essential element. Thus, I totally agree with the requesting party that the trade-mark consisting solely of the stylized word “huit” considerably differs from the Mark. However, I consider once again that the differences between the trade-mark as registered and as shown above consist of minor variations. Nonetheless, since there is no evidence that the invoices displaying the Mark accompanied the wares when shipped to the clients in Canada, I agree with the requesting party that they do not show use in accordance with s. 4(1) of the Act [see *Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000), 8 C.P.R. (4th) 471 (F.C.T.D.)]. That being said, I agree with the Owner’s submissions that the invoices can be relied upon to corroborate Mr. Roberty’s allegations with respect to the sales of wares bearing the Mark. Further, while I recognize that invoices issued in 2004 and 2007 are not all dated within the relevant period, these invoices evidence continuity of sales, which is consistent with Mr. Roberty’s statements as to the use of the Mark.

- [14] Mr. Roberty deposes at paragraph 6:

À titre illustratif de la manière dont Huit Diffusion a fait la promotion et la publicité au Canada de certains des produits constituant les Marchandises vendus sous la Marque au Canada durant la Période pertinente, je produis en liasse comme élément BR-3 [...] un

échantillonnage de catalogues, pour les années 2004 à 2007, visant différentes collections d'articles de lingerie, de maillots de bains, d'articles de plage et d'articles vestimentaires commercialisés au Canada par Huit Diffusion au courant de la Période pertinente. Ces catalogues, sur lesquels apparaît la Marque, sont pour ma compagnie des outils de vente distribués non seulement à ses représentants français, mais également à ses agents ou importateurs à l'étranger, dont au Canada. Pour les années 2004 à 2006, lesdits catalogues ont aussi été distribués à plusieurs clients canadiens de Huit Diffusion, [...].
(My underline)

[15] Considering the statement at paragraph 6 of the affidavit in its entirety, I once again conclude that the catalogues are filed as representative catalogues used during the relevant period for the promotion and advertisement of certain of the registered wares. The trade-mark consisting of the stylized word “huit” is mostly and prominently displayed in the catalogues. I recognize that the Mark, as shown at paragraph 9 or paragraph 12 of my decision, is displayed on what appears to be the back cover of catalogues. Still, the appearance of the Mark in catalogues does not in itself constitute use in association with wares [see *Clairol International Corp. v. Thomas Supply & Equipment Co. Ltd* (1968), 55 C.P.R. 176 (Ex. Ct.)]. Further, considering the circumstances of this case, I am not satisfied that the evidence allows me to conclude, or for that matter to infer, that this is a case where the inclusion of the Mark in the catalogues creates an association between the Mark and the wares when ownership is transferred. First, Mr. Roberty clearly states that the catalogues were intended for promotion and advertisement. Second, apart from the fact that the Mark is not displayed in closed proximity to the wares illustrated in the catalogues, Mr. Roberty does not state that the catalogues could be used to order the wares illustrated therein. Third, he does not state that the catalogues accompanied the wares at the time of transfer of the property in or possession of the wares.

[16] In the end, I agree with the requesting party that the only exhibits to the Roberty affidavit showing use of the Mark by the Owner during the relevant period, within the meaning of s. 4(1) of the Act, are the hangtags. As I accept the hangtags as representative specimens

of use of the Mark, the next issue becomes whether such use has been shown in association with the registered wares.

[17] At the oral hearing, counsel for the Owner did not make any submissions with respect to the wares “lingerie and corset articles for men and children”, “corset articles for women”, “pants, vests in natural and synthetic fabrics”, “shirts, short-sleeved shirts”, “stockings, tights, panties and socks” and “swimsuits and bathing costumes for men and children”. However, counsel for the Owner argued that the Roberty affidavit was sufficient to evidence use of the Mark in association with the registered wares “lingerie for women”, “underwear”, “brassieres”, “blouses” and “swimsuits and bathing costumes for women”. Indeed, counsel for the Owner devoted an important part of his submissions to review the summary reports accompanying the invoices to demonstrate the nexus between the aforementioned wares and those listed on the invoices and/or shown in the catalogues. I would remark that I consider it most unfortunate that it had been left to counsel to make the correlation, when Mr. Roberty, intentionally or not, did not explicitly state at paragraph 4 of his affidavit which of the registered wares bearing the Mark shown by Exhibit BR-1 were sold in Canada during the relevant period.

[18] While it would have been preferable that Mr. Roberty explicitly stated which of the registered wares bearing the Mark were sold in Canada during the relevant period, I am satisfied that Exhibit BR-1 together with the invoices of 2006 permit me to arrive at the conclusion of use of the Mark in association with “lingerie for women”, “underwear” and “brassieres” during the relevant period.

[19] Insofar as “blouses” are concerned, counsel for the Owner directed my attention on the *chemise* illustrated in the first catalogue of 2007 and listed under C710 both in the catalogue and on invoice No. 106447 dated January 31, 2007. Counsel for the Owner recognized that the English translation of the word *chemise* shown in the catalogue is “shirt”. However, counsel argued that since there are no buttons in front of the *chemise*, it is a blouse rather than a shirt. In support of his contention, counsel relied on the dictionary definition for “blouse”. Given counsel’s submissions, I conclude that the

evidence relied upon did not purport to show use of the Mark in association with the registered wares “shirts”. Again, I consider it most unfortunate, if not inappropriate, that counsel for the Owner be left to argue that the *chemise* shown in the catalogue is in fact a blouse. Surely it would have been a fairly simple matter for Mr. Roberty to state in his affidavit that the *chemise* is a blouse, if in fact that is what he considered it to be. Nonetheless, I agree that the *chemise* shown in the 2007 catalogue could be commonly called a “blouse”. Thus, I am satisfied that Exhibit BR-1 together with invoice No. 106447 permit me to arrive at the conclusion of use of the Mark in association with “blouses”.

[20] With respect to the wares “swimsuits and bathing costumes for women”, counsel for the Owner directed my attention on two types of bathing suits illustrated in the first catalogue of 2007 and listed respectively under R10 and R501 both in the catalogue and on invoice No. 106446 dated January 31, 2007. The product illustrated as R10, which in my view is basically a one-piece bathing suit, is identified as *nageur armatures* (underwired swimsuit). The product illustrated as R501, which in my view is basically a two-piece bathing suit, is identified as *triangle coulissé* (sliding triangle), I would remark that the *Oxford Canadian Dictionary* defines “bathing costume” as: “esp. Brit. a bathing suit.” While it seems that in Canada a bathing costume may be more commonly called a bathing suit, I note that the Registrar does not have the authority to redefine or amend the wares for which use has been shown in these proceedings. Although s. 45(4) of the Act gives the Registrar the power to amend, this section must be read in conjunction with s. 45(3) which provides that the registration can be amended if it appears that the Mark is not in use with the specified wares [see *Carter-Wallace Inc. v. Wampole Canada Inc.* (2000), 8 C.P.R. (4th) 30 (F.C.T.D.)]. Thus, I am satisfied that Exhibit BR-1 together with invoice No. 106446 permit me to arrive at the conclusion of use of the Mark in association with “swimsuits and bathing costumes for women”.

[21] In view of the above, I am satisfied that the Roberty affidavit, when considered in its entirety, is sufficient to show use of the Mark during the relevant period in association with “lingerie for women”, “underwear”, “brassieres”, “blouses” and “swimsuits and

bathing costumes for women” in the manner required by the Act. However, I am not satisfied that the Roberty affidavit evidences use of the Mark in association with “lingerie and corset articles for men and children”, “corset articles for women”, “pants, vests in natural and synthetic fabrics”, “shirts, short-sleeved shirts”, “stockings, tights, panties and socks” and “swimsuits and bathing costumes for men and children”, nor does it put forward special circumstances to justify non-use of the Mark. Therefore, these wares will be deleted from the registration.

[22] In view of the above, and pursuant to the authority delegated to me under s. 63(3) of the Act, I find that Registration No. TMA201,169 should only be maintained in respect of “lingerie for women; underwear; brassieres; blouses; swimsuits and bathing costumes for women”.

[23] Registration No. TMA201,169 will be amended in compliance with the provisions of s. 45(5) of the Act.

DATED AT MONTREAL, QUEBEC, THIS 27th DAY OF NOVEMBER 2009.

Céline Tremblay
Member
Trade-marks Opposition Board