

RE: SECTION 45 PROCEEDINGS
Trade-mark: PARIS BLUES
Registration No. TMA 355,975
Registration Date: May 19, 1989

At the request of Sim & McBurney, the Registrar of Trade-marks issued a Section 45 notice on May 26, 1992 to Buttino Investments Inc./ Les Investissements Buttino Inc., the registered owner of the trade-mark PARIS BLUES, registration No. 355,975. The trade-mark PARIS BLUES was registered May 19, 1989 in association with:

"Men, women and children's clothing, namely: jackets, tops shirts, skirts, shorts, boleros, pants, slacks, purses and belts, both in denim and other fabrics."

and in association with services identified as:

"Wholesaling and retailing the following wares: men, women and children's clothing, namely: jackets, tops, shirts, skirts, shorts, boleros, pants, slacks, purses and belts, both in denim and other fabrics."

In response to the Section 45 notice, Buttino Investments Inc. filed the affidavit of Luigi Buttino, President of Buttino Investments Inc. and of Recital Jeans Inc., dated June 2, 1992.

Both parties filed written submissions with the Registrar of Trade-marks and an oral hearing was not requested by either party.

In paragraph 2 of his affidavit, Mr. Buttino states the following:

"2. Pursuant to an Agreement of Sale entered into on April 1, 1991, BUTTINO sold to RECITAL the registered trade mark, **PARIS BLUES**, as appears from a copy of an Agreement of Sale annexed hereto as **Annex 1**;"

Annex 1 is identified as: "MEMORANDUM OF AGREEMENT OF SALE, entered into at the City and District of Montreal, on this 1st day of April, 1991." However, the Agreement, which has been executed on behalf of Buttino Investments Inc. and of Recital Jeans Inc. by Luigi Buttino as President of both companies, does not indicate a date when the Agreement was executed.

The requesting party has argued that "the evidence of ownership in this matter was created subsequent to the date of the Section 45 Notice to fit the alleged evidence of use" and that the transfer of ownership "does not meet the test set out by the Court of Appeal in Marcus v. Quaker Oats". In Marcus, carrying on business as Marcus & Associates v. Quaker Oats Co. of Canada, 20 C.P.R. (3d) 46, Mahoney, J. commented as follows at page 49-50 with respect to an assignment in issue in that case which was alleged to have retroactive effect:

From the first paragraph of the comments of Mr. Justice Mahoney noted above, it would appear that the Federal Court of Appeal has affirmed the jurisdiction of the Registrar in a Section 45 proceeding to decide the effect of an assignment. As a result, I consider that the matter of the assignment of the registered trade-mark PARIS BLUES can be reviewed in the present proceeding.

In the present case, I am mindful of the fact that, as in the Marcus case, the assignment in the present instance involve parties which appear to be related. Further, it does not appear that the registrant sought to record the assignment with the Trade-marks Office prior to the date of the Section 45 Notice even though the Agreement of Sale of the trade-mark is dated as of April 1, 1991, more than one year prior to the date of the Notice. Nevertheless, having regard to paragraph 2 of the Buttino affidavit, as well as to the Agreement, I have concluded that the agreement confirms an assignment of rights in the registered trade-mark PARIS BLUES which took place April 1, 1991. In this regard, I would note that the Buttino affidavit is dated one week subsequent to the date of the Section 45 Notice and there is nothing to point to the agreement having been prepared subsequent to the issuance of the Section 45 Notice in order to respond to it.

Having accepted that there was an assignment of rights by the original registrant to Recital Jeans Inc. on April 1, 1991, consideration must now be given to the Buttino affidavit with respect to use of the trade-mark PARIS BLUES by Recital Jeans Inc. In this regard, Mr. Buttino states the following in his affidavit:

"4. Pursuant to the Agreement of Sale, **Annex 1**, RECITAL uses and shall continue to use the trade mark **PARIS BLUES** throughout Canada, the whole as is more fully supported by the following documentation:

- (i) a series of invoices for the month of May 1992, emanating from RECITAL, addressed to its customers and indicating style numbers which correspond to garments bearing the trade mark, **PARIS BLUES**, as appears from copies of said invoices annexed hereto as **Annex 2**;
- (ii) ticket labels bearing the trade mark **PARIS BLUES** and indicating style numbers which correspond to the numbers indicated on the invoices mentioned in the previous subparagraph, as appears from said ticket labels annexed hereto as **Annex 3**;
- (iii) a sample of a label bearing the trade mark **PARIS BLUES**, attached to the various garments sold by RECITAL, as appears from said sample annexed hereto as **Annex 4**;"

Mr. Buttino has annexed 36 invoices to his affidavit relating to sales by Recital Jeans Inc. to various customers for the month of May, 1992, up to and including the date of the Section 45 notice. Further, Annexes 3 and 4 confirm the manner of use by Recital of the registered trade-mark and relate the wares associated with the labels to the items identified in the invoices. However, the invoices only confirm sales of jackets, shorts, t-shirts, jeans and pants. No evidence has been furnished by the current owner of use of the trade-mark PARIS BLUES in association with tops, skirts, boleros, slacks, purses and belts, or in association with the services presently covered in the registration.

Having regard to the above, and in the absence of an appeal from this decision pursuant to the provisions of Section 56 of the Trade-marks Act, registration No. 355,975 will be amended to cover the following wares:

"Clothing, namely: jackets, shorts, t-shirts and pants".

DATED AT HULL, QUEBEC THIS 22nd DAY OF February, 1994.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.