



Consommation
et Corporations Canada

Consumer and
Corporate Affairs Canada

Ottawa / Hull, Canada
K1A0C9

DEC 241987

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5 Place Ville Marie
Suite 1203
Montreal, Quebec
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Votre référence Your file

14,213

Notre référence Our file

469,119

Gentlemen:

RE: SECTION 44 PROCEEDINGS
Registration No.: TMA 273,193
Trade Mark: SENA

At the request of Messrs. Sterling & Affiliates, the Registrar issued a Section 44 notice dated April 1, 1986 to Sena Marketing Inc. the registered owner of the above referenced trade mark registration.

The mark SENA was registered on October 29, 1987 for use in association with the following wares and services:

WARES: footwear namely shoes, slippers and sandals;
clothing namely jackets; jewelry.

SERVICES: operation of a retail clothing, footwear and
jewelry store.

In response to the Registrar's notice the registrant furnished the affidavit of its President, Mr. Chris Bannister, together with Exhibits A to H. Further to the filing of this evidence, the requesting party filed a written submission to which the registrant replied in like manner.

In its written submission the requesting party argued mainly as follows:

1. The invoices submitted as Exhibits E and F do not refer to wares bearing the trade mark SENA.
2. The exhibits relating to footwear and clothing must be seen as having been deliberately manufactured or contrived to maintain the registration in association with those wares.
3. The affidavit is silent regarding the wares "jewelry" or "the operation of a jewelry store".

In its written submission the registrant admits that the trade mark is not in use in association with "jewelry" but refutes all the other arguments.

On the first point, Section 4(1) does not require that the trade mark be inscribed on the invoices. It requires that at the time of the transfer of the property in or possession of the wares, notice of the association between the trade mark and the wares be given to the person to whom the property or possession is transferred. In his affidavit Mr. Bannister explains that notice of the association is given at the time of sale either by the trade mark being

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- 2 -

marked directly on footwear or being marked on labels and hang tags attached to footwear and clothing. The invoices attached as Exhibits E and F show that there were transfers of the property in or possession of footwear and clothing at the material time. Therefore I have no difficulty in concluding that the trade mark is in use in Canada in association with footwear namely shoes, slippers and sandals and with clothing namely jackets.

Regarding the second point, I find such objection not convincing and beyond the scope of Section 44 proceedings. Section 44 is not designed nor intended as a procedure for adjudicating disputes between competing interests. Should the requesting party be aware of facts which it cannot evidence before the Registrar then it should proceed under Section 57 of the Trade Marks Act.

As for the requesting party's third point, as mentioned earlier the registrant has admitted in its written submission to the non-use of the trade mark in association with jewelry.

Concerning the service "operation of a jewelry store" I must agree with the requesting party that use of the trade mark in association with such services has not been shown. There is no assertion of use in the affidavit with respect to those services. The photograph attached as Exhibit G to the affidavit shows that the registrant operates a retail clothing and footwear store and that the trade mark is displayed in the performance of such services. However there is nothing in the affidavit or in the exhibits to show use of the trade mark pursuant to Section 4(2) in association with the "operation of a jewelry store".

In the instant case, I am satisfied that sufficient facts have been established to show use of the mark in association with the wares "footwear namely shoes, slippers, sandals and clothing namely jackets" and in association with the services "operation of a retail clothing and footwear store". However, since the affidavit is silent on any use in association with "jewelry" or the "operation of a jewelry store" such wares and services ought to be deleted from the registration.

Therefore, by reason of the evidence filed I have concluded that the subject registration ought to be amended by deleting the word "jewelry" from the statement of wares and services so that the registration will read as follows:

wares: footwear namely shoes, slippers and sandals;
clothing namely jackets

services: operation of a retail clothing and footwear store.

Registration No. 273,193 will be amended accordingly in compliance with the requirements of, subsection 44(5) of the Trade Marks Act.

Yours truly,

J.P. D'Aoust
Senior Hearing Officer
for REGISTRAR OF TRADE MARKS

JPD:gmc-h

c.c.: Sterling & Affiliates (Your ref.: RWS/new)
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