



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

Citation: 2012 TMOB 216
Date of Decision: 2012-11-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Kiss Play Inc. against registration
No. TMA239,841 for the trade-mark KISS & Design in
the name of Cosaco Inc.**

[1] On August 5, 2010, at the request of Kiss Play Inc. (the Requesting Party), the Registrar of Trade-marks forwarded a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Cosaco Inc. (the Registrant), the registered owner of registration No. TMA239,841 for the trade-mark KISS & Design (the Mark) shown hereafter:



[2] The Mark is registered in association with “ladies’, men’s and children’s sportswear namely, T-shirts, blouses, sweaters, pullovers, cardigans, pants, shirts, jackets and underwear”.

[3] Section 45 of the Act requires the registered owner of a trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares or services 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 use since that date.

[4] In this case, the relevant period for showing use of the Mark is any time between August 5, 2007 and August 5, 2010 (the Relevant Period). Further, the relevant definition of use is set out in section 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] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing deadwood from the register. The onus on a registered owner under section 45 is not a heavy one [see *Austin Nichols & Co v Cinnabon, Inc* (1998), 82 CPR (3d) 513 (FCA)]. However, speaking of the balance between evidentiary overkill and the obligation to show use to the extent that the Registrar is able to form an opinion on the “use” within the context of section 45, Mr. Justice Russel stated in *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC) (*Performance Apparel*) at para. 68 :

... We know that the purpose of s. 45 proceedings is to clean up the “dead wood” on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must “show” how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade mark owner’s business and merchandising practices.

[6] In response to the section 45 notice, the Registrant furnished the affidavit of Albert Saragossi, sworn November 1, 2010, and Exhibits “A” to “D” thereto. Mr. Saragossi is the President of the Registrant. Neither the Requesting Party, nor the Registrant filed written representations; an oral hearing was not held.

[7] Mr. Saragossi explains that the Registrant is a manufacturer, wholesaler and distributor of ladies’, men’s and children’s wearing apparel, including the wearing apparel specified in the registration for the Mark [para. 3 of the affidavit]. Mr. Saragossi attests that the Mark “has been used continuously in Canada in association with each one of the registered wares” during the Relevant Period in the normal course of trade [para. 5 of the affidavit]. In that regard, he explains

that the Mark is affixed to the clothing by means of hang tags and sewn-in labels. He further explains that the Registrant arranges for the manufacture of the registered wares and for the attachment of the hang tags displaying the Mark to the registered wares, which the Registrant then sells to retailers of wearing apparel throughout Canada [para. 7 of his affidavit]. The Registrant's retail customers include Giant Tiger Stores, Army & Navy stores, L'Aubainerie, Jean Bleu Inc. [para. 6 of the affidavit]. In support of his assertions, Mr. Saragossi files the following as exhibits to his affidavit:

- Exhibit "A": photographs and specimens of cardigans and shorts that he provides as "typical examples of wearing apparel that have been sold during the last three years in Canada in association with the [Mark]" [para. 7 of the affidavit]. It appears to me that the cardigan and shorts shown by the photographs correspond to the attached specimens. I note that the Mark is displayed on the inside label and on the hang tag of both items.
- Exhibit "B": a copy of a sales report "by style for the registered wares for the period of January 1, 2007 to August 24, 2010"; Mr. Saragossi states that each one of the style numbers referenced on the sales report represents an item of wearing apparel associated with the Mark and sold by the Registrant to its retail customers [para. 8 of the affidavit];
- Exhibit "C": a copy of a report with respect to representative invoice numbers and customers shown on the sales report filed as Exhibit "B" [para. 9 of the affidavit]; and
- Exhibit "D": copies of the actual representative invoices referenced in the report filed as Exhibit "C" [para. 10 of the affidavit].

[8] Mr. Saragossi explains that the particular invoices filed as Exhibit "D" to his affidavit relate to the sales of tops, t-shirts, cardigans, vests, skirts, tank tops, sweaters, shorts, dresses, blouses, pullovers, ponchos, polo shorts, dress shorts and Bermuda shorts in association with the Mark by means of a hang tag affixed thereto. He goes on to explain that "[t]he notation PRPK stands for pre-packaged followed by the number of individual items appearing inside the single package. For example, PRPK (18) represents 18 cardigans to that particular style and order number" [para. 11 of the affidavit].

[9] When considering the registered wares, it is apparent that the invoices filed as Exhibit “D” only relate to the sales of t-shirts, blouses, sweaters, pullovers and cardigans; they do not relate to the sales of pants, shirts, jackets and underwear. Still, evidentiary overkill is not required [see *Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD) and *Performance Apparel, supra*]. Besides the fact that the invoices have been expressly provided as representative invoices, Mr. Saragossi clearly and specifically states in his affidavit that the Mark has been used in association with each one of the registered wares during the Relevant Period. Further, the manner in which the Mark appears on the cardigan and shorts filed as Exhibit “A” is consistent with Mr. Saragossi’s written description of how the Mark was applied on the registered wares during the Relevant Period.

[10] That being said, while it is apparent that Mr. Saragossi’s affidavit provides representative evidence of use of the Mark in association with the registered wares, it remains that the Mark is registered in association with ladies’, men’s and children’s sportswear. For the reasons that follow, I find that Mr. Saragossi’s references to wearing apparel throughout his affidavit make the evidence somewhat ambiguous. It is well established that ambiguities in the evidence are to be interpreted against the registered owner’s interests [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1979), 45 CPR (2d) 194 (FCTD) aff’d at (1980), 53 CPR (2d) 62 (FCA)].

[11] For one thing, as I may reasonably conclude that the specimens filed as Exhibit “A” are ladies’ cardigan and shorts, I find that ambiguity resides in Mr. Saragossi not stating clearly and comprehensively that these specimens are typical examples of ladies’, men’s and children’s wearing apparel or sportswear sold in association with the Mark. In other words, I am not prepared to conclude that these are typical examples of men’s and children’s sportswear sold in association with the Mark during the Relevant Period; I am only prepared to conclude that these specimens are typical examples of ladies’ sportswear. Furthermore, while the sales report filed as Exhibit “B” identifies numerous style numbers, there is nothing in the evidence for me to conclude that any of them corresponds to wearing apparel for men and children. Likewise, there is nothing in the evidence for me to conclude that the style numbers and items described on the invoices filed as Exhibit “D” are wearing apparel for men and children.

Disposition

[12] Having regard to the evidence as a whole, I am satisfied that there was use of the Mark within the meaning of sections 45 and 4(1) of the Act in association with the wares: “ladies’ ... sportswear namely, T-shirts, blouses, sweaters, pullovers, cardigans, pants, shirts, jackets and underwear”. However, I am not prepared to conclude that use of the Mark in association with “...men’s and children’s sportswear ...” has been shown. Further, no special circumstances have been advanced to excuse non-use.

[13] Pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA239,841 will be amended to delete reference to men’s and children’s sportswear in compliance with the provisions of section 45 of the Act. Thus, the registered statement of wares will read “*ladies’ sportswear namely, T-shirts, blouses, sweaters, pullovers, cardigans, pants, shirts, jackets and underwear*”.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office