



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

Citation: 2013 TMOB 125
Date of Decision: 2013-07-19

**IN THE MATTER OF SECTION 45 PROCEEDINGS
requested by LF USA Inc. against registration
Nos. TMA490,416 and TMA674,537 for the trade-marks
ROSETTI & Design and ROSETTI & Design in the name
of Landau Sacamoto Inc.**

[1] At the request of LF USA Inc. (the Requesting Party), the Registrar of Trade-marks issued notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on December 23, 2010 to Landau Sacamoto Handbags Inc./Les Sacs a Main Landau Sacamoto Inc. (the Registrant), the registered owner at that time of registration No. TMA490,416 for the trade-mark ROSETTI & Design and registration No. TMA674,537 for the trade-mark ROSETTI & Design, shown below (the Marks):

TMA490,416 (the Stylized Logo)

TMA674,537 (the Rose Design)

[2] Subsequent to the issuance of the notices, the Registrar recorded a change of the Registrant's name to Landau Sacamoto Inc. This change is not at issue in this proceeding.

[3] With respect to registration No. TMA490,416, the Stylized Logo is registered for use in association with the following wares: ladies purses, change purses, clutch purses, handbags, wallets and belts.

[4] With respect to registration No. TMA674,537, the Rose Design is registered for use in association with the following wares:

(1) Men's, women's, ladies', teens', boys', girls' and children's goods made of leather and/or imitation or synthetic leather, namely, handbags, purses, clutch bags, wallets, change and coin purses and belts.

(2) Men's, women's, ladies', teens', boys', girls' and children's goods made of leather and/or imitation or synthetic leather, namely, luggage.

(3) Men's, women's, ladies', teens', boys', girls' and children's goods made of leather and/or imitation or synthetic leather, namely, tote bags, backpacks, daypacks, waistpacks, fanny packs, school bags, knapsacks, rucksacks, handbags with shoulder straps worn over the shoulder, sportsman's hunting bags, golf bags, all purpose sports bags, athletic bags, tool bags, duffel bags, sling bags for carrying infants, diaper bags, hand held carrying bags used for shopping, clutch purses, pocket books, billfolds, passport cases, document cases, ticket pouches, credit card cases, cosmetic bags, cosmetic cases, vanity cases, key cases, key fobs, computer carrying cases, palm pilot cases, book covers, checkbook covers, attaché cases, briefcases, business card cases, travel bags, hand held travel bags, satchels, suitcases, valises, trunks, leather straps for use to carry handbags and purses, suitcases, overnight bags, travel garment bags, garment bags for home storage of garments and luggage tags.

(4) Eyewear, namely, eyeglasses, sunglasses, frames for eyeglasses and sunglasses and goggles.

[5] 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 and 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 such use since that date. In this case, the relevant period for showing use is between December 23, 2007 and December 23, 2010.

[6] The relevant definition of "use" in association with wares 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.

[7] In response to the Registrar's notices, the Registrant furnished the statutory declarations of Mr. Dimitrios Tsatsoulis, one of the owners of the Registrant. I note that the evidence furnished in response to each notice is substantively identical.

[8] The Requesting Party submits that any use of the Marks by the Registrant does not enure to the benefit of the Registrant, as "there was a contractually binding distributor agreement" in place between the Registrant and the Requesting Party prior to and throughout the relevant period. However, evidence of a distributorship between the parties is not before me. In any event, section 45 proceedings are not intended to provide an alternative to the usual *inter partes* attack on a registration [*United Grain Growers v Lang Michener*, (2001), 12 CPR (4th) 89 (FCA)]. As noted by the Federal Court of Appeal in *Ridout & Maybee LLP v Omega*, (2005), 43 CPR (4th) 18 (FCA), the validity of the registration is not in dispute in section 45 proceedings. Issues of ownership are more properly dealt with by way of application to the Federal Court pursuant to section 57 of the Act. As such, the nature of the Registrant's relationship with the Requesting Party, if any, is beyond the scope of this proceeding.

Evidence Submitted by the Registrant

[9] In his declarations, Mr. Tsatsoulis attests that the Registrant operates a business enterprise specializing in the manufacture and distribution of leather and/or imitation leather goods, handbags, luggage, and accessories. Specifically, Mr. Tsatsoulis asserts that, during the relevant period, the Registrant used the Marks in association with "purses, change purses, clutch purses, handbags, knapsacks, wallets, luggage, duffel bags and computer cases".

[10] In support, Mr. Tsatsoulis provides the following exhibits:

- Exhibit 4 consists of multiple copies of two sample paper tags, one bearing the Stylized Logo and one bearing the Rose Design, which Mr. Tsatsoulis attests were "over the three (3) year period immediately preceding the Section 45 Notice...affixed to the purses,

change purses, clutch purses, handbags, knapsacks, wallets, luggage, duffel bags and computer cases manufactured and/or distributed in Canada by [the] Registrant”.

- Exhibits 5, 6 and 7 consist of copies of excerpts from the Registrant’s catalogues from Spring 2008 to Fall 2010. The catalogues include images of various purses, wallets and bags, some of which display either the Stylized Logo or the ROSETTI portion of the Rose Design directly on the items by way of a metal label or an embossment.
- Exhibit 8 consists of pictures of luggage, duffel bags and computer cases, some of which clearly display the ROSETTI portion of the Rose Design on attached metal labels.
- Exhibits 9, 10 and 11 consist of pictures of sample handbags and wallets displaying the Rose Design paper tags found at Exhibit 4.
- Exhibits 12, 13 and 14 consist of hundreds of copies of “randomly selected invoices” for 2008, 2009 and 2010, respectively, “demonstrating the distribution in Canada, by [the] Registrant, of wares bearing the Trade-Mark”. In its written representations, the Registrant correlates a variety of the goods identified in the invoices with the wares appearing in the exhibited catalogues by way of their model numbers.

[11] The Requesting Party submits that some of the evidence did not show display of the Marks as registered, in particular the display of the word ROSETTI in block letters on some of the bags depicted in Exhibits 5, 6 and 7. However, it is not necessary to consider whether display of ROSETTI in block letters by itself constitutes display of the Stylized Logo or of the Rose Design. The evidence as a whole must be considered [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)], and I am satisfied that Mr. Tsatsoulis’ statements with regard to the Exhibit 4 paper tags being affixed to the Registrant’s wares during the relevant period, in combination with the representative invoices showing sales by the Registrant, is sufficient with respect to both Marks in this case.

[12] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Marks in association with purses, change purses, clutch purses, handbags, knapsacks, wallets, luggage, duffel bags and computer cases within the meaning of sections 4 and 45 of the Act.

With respect to the remaining wares, the Registrant provided no evidence of special circumstances excusing non-use of the Marks; the registrations will be amended accordingly.

Disposition for TMA490,416 (the Stylized Logo)

[13] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in accordance with section 45 of the Act, registration No. TMA490,416 will be amended to delete “belts” from the statement of wares.

[14] The amended statement of wares for registration No. TMA490,416 will be: “ladies purses, change purses, clutch purses, handbags, wallets”.

Disposition for TMA674,537 (Rose Design)

[15] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in accordance with section 45 of the Act, registration No. TMA674,537 will be amended to delete “belts” from wares (1), all of wares (4), and the following from wares (3):

...tote bags, backpacks, daypacks, waistpacks, fanny packs, school bags, ... rucksacks, ..., sportsman's hunting bags, golf bags, all purpose sports bags, athletic bags, tool bags, ..., sling bags for carrying infants, diaper bags, hand held carrying bags used for shopping, ..., pocket books, billfolds, passport cases, document cases, ticket pouches, credit card cases, cosmetic bags, cosmetic cases, vanity cases, key cases, key fobs, ..., palm pilot cases, book covers, checkbook covers, attaché cases, briefcases, business card cases, travel bags, hand held travel bags, satchels, suitcases, valises, trunks, leather straps for use to carry handbags and purses, suitcases, overnight bags, travel garment bags, garment bags for home storage of garments and luggage tags.

[16] The amended statement of wares for registration No. TMA674,537 will be as follows:

(1) Men’s, women’s, ladies’, teens’, boys’, girls’ and children's goods made of leather and/or imitation or synthetic leather, namely, handbags, purses, clutch bags, wallets, change and coin purses.

(2) Men’s, women’s, ladies’, teens’, boys’, girls’ and children's goods made of leather and/or imitation or synthetic leather, namely, luggage.

(3) Men’s, women’s, ladies’, teens’, boys’, girls’ and children’s goods made of leather and/or imitation or synthetic leather, namely, knapsacks, handbags with shoulder straps

worn over the shoulder, duffel bags, clutch purses, computer carrying cases.

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