



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

**Citation: 2016 TMOB 93**  
**Date of Decision: 2016-06-15**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Fetherstonhaugh & Co.** **Requesting Party**

**and**

**Benisti Import Export Inc.** **Registered Owner**

**TMA695,670 for Stylized letter P and an oval dot in a rectangle with the words POINT ZERO** **Registration**

[1] At the request of Fetherstonhaugh & Co. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on January 23, 2014 to Benisti Import Export Inc. (the Owner), the registered owner of registration No. TMA695,670 for the trade-mark “Stylized letter P and an oval dot in a rectangle with the words POINT ZERO” (the Mark), shown below:



[2] The Mark is registered in association with the following goods:

- (1) Men’s, women’s and children garments, namely: coats, jackets, suits, pants, t-shirts, shorts, jeans, hats, caps, undergarments, underwear, dresses, skirts, bathing suits, vests, blouses, scarves, jump suits, sweaters, sweatpants, sweatshirts, sleepwear, pyjamas, bathrobes and pullovers;
- (2) footwear, namely: boots, shoes, running shoes, sport shoes, sandals and slippers;

- (3) fashion accessories, namely: watches, wallets, belts, suspenders, ties, socks, handkerchiefs, hosiery, sunglasses, eyeglasses, jewellery, key chains, purses, umbrellas, gloves and mittens;
- (4) cosmetics and cleansing preparations, namely: colognes, perfumes, tanning gels, hair gels, deodorants and eau de toilette;
- (5) luggage and travel bags, namely: suitcases, backpacks, travelling bags, garment bags, handbags, school bags and beach bags;
- (6) sports equipment, namely: bicycles, scooters, skate boards, skis, ice skates, inline skates, basketballs, footballs and soccer balls;
- (7) camping equipment, namely: tents and sleeping bags;
- (8) household furniture and accessories, namely: tabletops, glasses, cups, forks, spoons, knives, utensils, pots, pans, bed sheets, blankets, covers, towels, curtains, horizontal blinds and vertical blinds.

[3] The Mark is also registered in association with the following services:

Café and restaurant services; loan financing and credit card services; real estate management services; retail apparel store services.

[4] 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 goods 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 January 23, 2011 and January 23, 2014.

[5] The relevant definitions of “use” are set out in section 4 of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

4(2) A trade-mark is deemed to be used in association with services it is used or displayed in the performance or advertising of those services.

[6] 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270].

[7] In response to the Registrar's notice, the Owner filed the affidavit of Mario Morelato, Vice-President of the Owner, sworn on August 25, 2014 in Montreal. Both parties filed written representations; a hearing was not requested.

### The Owner's Evidence

[8] In his affidavit, Mr. Morelato attests that the Owner "operates a business of manufacturing, importing, distributing, wholesale and retail sale of men's and women's clothing". He explains that POINT ZERO goods were sold through authorized licensees, through wholesale distribution and through the Owner's own retail stores in Canada.

[9] As a preliminary matter, with respect to some of the registered goods, Mr. Morelato states that the Owner discontinued use of the Mark, conceding that the Mark was not used during the relevant period in association with the following goods:

From goods (1): sleepwear, pyjamas and bathrobes;  
From goods (2): slippers;  
From goods (3): wallets and suspenders, handkerchiefs, hosiery, sunglasses, eyeglasses, jewellery, umbrellas and mittens;  
The entirety of goods (4), being: cosmetics and cleansing preparations, namely: colognes, perfumes, tanning gels, hair gels, deodorants and eau de toilette;  
From goods (5): beach bags;  
From goods (6): scooters, skate boards, skis, ice skates, inline skates, basketballs, footballs and soccer balls;  
The entirety of goods (7), being: camping equipment, namely: tents and sleeping bags;  
The entirety of goods (8), being: household furniture and accessories, namely: tabletops, glasses, cups, forks, spoons, knives, utensils, pots, pans, bed sheets, blankets, covers, towels, curtains, horizontal blinds and vertical blinds.

[10] Similarly, Mr. Morelato concedes non-use of the Mark in association with the following services: café and restaurant services and loan financing and credit card services.

[11] As the Owner furnished no evidence of special circumstances excusing non-use of the Mark, the registration will be amended to delete the foregoing goods and services accordingly.

[12] With the exceptions discussed below, for each of the remaining goods, Mr. Morelato supports his assertion of use with clear evidence of use of the Mark in the form of photographs

and invoices at Exhibits A through BB attached to his affidavit. In each case, the photographs show the particular good with the Mark displayed on the good itself. The “corresponding” invoices in each exhibit show sales in Canada during the relevant period by either the Owner directly or by an authorized licensee. In addition, Mr. Morelatto attests that, during the relevant period, it was the Owner’s practice to affix a “Content Label” bearing the Mark to all of the goods sold by it or its licensees. A sample of that label is depicted in a photograph attached as Exhibit CC to the affidavit. The Mark appears on the label.

[13] Illustrative of the Owner’s evidence, Exhibit A consists of several photographs of two types of coats and jackets, each accompanied by an invoice from the relevant period showing a sale of that particular item. I note, for example, the style number for the “mesh jacket” appearing on the August 15, 2013 invoice corresponds with the style number appearing on the tag affixed to the jacket depicted in the one of the exhibited photographs. The photographs show that the Mark was displayed on the goods directly as well as on tags attached to the goods.

[14] Similar evidence appears in the subsequent exhibits for the following registered goods: vests (Exhibit B); undergarments and underwear (Exhibit C); shirts (Exhibit D); blouses (Exhibit E); hats, caps, scarves and gloves (Exhibit F); pants (Exhibit G), jeans (Exhibit H), dresses (Exhibit I); t-shirts (Exhibit J); bathing suits (Exhibit K); shoes, running shoes, sport shoes, boots and sandals (Exhibit L); belts (Exhibit M); skirts (Exhibit N); ties (Exhibit O); keychains (Exhibit P); handbags (Exhibit Q); sweaters (Exhibit R); shorts (Exhibit S); children’s pants (Exhibit T); watches (Exhibit U); sweatpants (Exhibit V); pullovers (Exhibit W); jumpsuits (Exhibit X); bicycles (Exhibit Y); socks (Exhibit Z); suits (Exhibit AA); and sweatshirts (Exhibit BB).

[15] With respect to “retail apparel services”, Mr. Morelatto attests that the Owner displayed the Mark in the performance and advertising of such services in relation to the operation of the Owner’s POINT ZERO retail apparel stores in Canada. In support, attached to his affidavit are photographs of the interior of the Owner’s flagship retail store in Montreal (Exhibit DD) and copies of receipts issued at that store during the relevant period (Exhibit EE). I note that the Mark is displayed throughout the store and appears at the top of the exhibited receipts. Mr.

Morelatto confirms that the photographs demonstrate the manner in which the Mark was displayed during the relevant period.

#### Analysis - Services

[16] With respect to “retail apparel store services”, the evidenced display of the Mark in the operation of the Owner’s retail store during the relevant period is sufficient to maintain the registration in respect of such services.

[17] As noted above, the Owner concedes non-use of the Mark in association with “Café and restaurant services” and “loan financing and credit card services”. In addition, I agree with the Requesting Party that none of the evidence shows provision of “real estate management services” in association with the Mark or otherwise. For its part, the Owner makes no mention of such services in its written representations.

[18] As such, with respect to the registered services, I am satisfied that the Owner has demonstrated use of the Mark only in association with “retail apparel store services” within the meaning of sections 4(2) and 45 of the Act. The registration will be amended accordingly.

#### Analysis - Goods

[19] With respect to the registered goods, Mr. Morelatto makes no attestations regarding sales volumes for particular goods, nor does he attest to aggregate sales of POINT ZERO goods generally. Furthermore, for some of the goods, the Owner furnished only one invoice as evidence of transfers in the normal course of trade during the relevant period.

[20] However, it is well established that evidence of a single sale may be sufficient to establish use of a trade-mark in the normal course of trade, so long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration of the trade mark [see *Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18, 90 CPR (4th) 277 and *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. In this case, I note that the invoices are often for large quantities of goods and charges for GST and QST appear on the invoices. Indeed, in its written

representations, the Requesting Party does not generally take issue with the evidence in this respect.

[21] Nevertheless, I note that although Mr. Morelatto attests that Exhibit Q shows photographs of “a handbag and purse”, the photographs depict only one style of bag. Furthermore, the corresponding invoice shows only one item sold, which is identified as a “Handbag”. In contrast to, for example, Exhibit A – which also relates to two registered goods but includes photographs and invoices for two distinct products – Exhibit F shows evidence in relation to one product only.

[22] Given that use evidenced in association with one specific good cannot serve to maintain multiple goods within a statement of goods, the Owner is required to provide evidence of use for *each* of the registered goods [see *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA); *Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD); and *Fogler, Rubinoff LLP v Canada Safeway Ltd*, 2013 TMOB 227, CarswellNat 5446]. As such, for the Owner to maintain its registration for the goods “purses”, it had to show transfer and sales of such goods otherwise than by reference to “handbags”.

[23] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “purses” within the meaning of sections 4 and 45 of the Act.

[24] Otherwise, in its brief representations, the Requesting Party simply submits that Mr. Morelatto’s affidavit “does not provide any direct evidence through photographs, invoices or otherwise” that there was “provision” of any of the following goods during the relevant period in association with the Mark: bathing suits, running shoes, sandals, suitcases, backpacks, travelling bags, garment bags and school bags.

[25] With respect to “bathing suits”, the Requesting Party further submits that the Exhibit K photographs do not, in fact, show a bathing suit and that none of the other exhibits depicts a bathing suit.

[26] Given the structure of the affidavit, the Requesting Party submits that the exhibited photographs are not representative of the goods missing from the exhibits [citing in support,

*Etigson v KPM Industries Ltd* (2001), 15 CPR (4th) 411 (TMOB)]. Accordingly, in addition to the goods for which the Owner concedes non-use, the Requesting Party submits these goods should also be deleted from the registration.

[27] In reviewing the evidence as a whole, I agree with the Requesting Party that there is no evidence of use of the Mark in association with “suitcases, backpacks, travelling bags, garment bags and school bags”. None of the exhibits refer to these products and I note that the Owner makes no mention of these goods in its written representations. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark, the registration will be amended accordingly.

[28] On the other hand, in reviewing the evidence at Exhibit K, I agree with the Owner that the evidence *does* show transfers of “bathing suits” displaying the Mark in the normal course of trade during the relevant period in Canada. In this respect, I note that Mr. Morelatto specifically attests that Exhibit K consists of the following:

Photographs of a bathing suit bearing the POINT ZERO Logo Trademark, and corresponding invoice indicating its sale by the Owner in 2013.

[29] Indeed, Exhibit K includes an invoice showing the sale of 44 “Full Elastic Waist Swimshort” to a Quebec company in 2013. As noted by the Owner, the corresponding photographs display a pair of swim shorts, which is a type of “bathing suit”. In the second photograph, the Mark is clearly visible on the shorts.

[30] Similarly, with respect to “running shoes”, Exhibit L includes two invoices showing bulk sales of “SHOES & BOOTS” to a Montreal company. The corresponding photographs display a variety of footwear, including different styles of men’s and women’s running shoes, casual shoes and boots. Although the Mark is not clearly visible on all of the depicted footwear, I note that the second and third photographs show at least four styles of running shoes displaying the Mark.

[31] Exhibit L also includes an invoice that specifically refers to sales of “sandals”. As attested to by Mr. Morelatto, the “corresponding” photograph depicts a pair of sandals that displays the Mark.

[32] In contrast to the evidence furnished at Exhibit F with respect to both “handbags” and “purses”, I am satisfied that the invoices and photographs at Exhibit L are sufficient to demonstrate use of the Mark in association with each of the registered footwear goods as follows: “boots”, “shoes”, “running shoes”, “sport shoes” and “sandals”.

[33] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the remaining registered goods within the meaning of sections 4 and 45 of the Act.

### Disposition

[34] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete “café and restaurant services; loan financing and credit card services; real estate management services” from the statement of services and the following from the statement of goods:

- (1) ... sleepwear, pyjamas, bathrobes ...;
- (2) ... and slippers;
- (3) ... wallets, ... suspenders, ... handkerchiefs, hosiery, sunglasses, eyeglasses, jewellery, ... purses, umbrellas, ... and mittens;
- (4) cosmetics and cleansing preparations, namely: colognes, perfumes, tanning gels, hair gels, deodorants and eau de toilette;
- (5) ... suitcases, backpacks, travelling bags, garment bags, ... school bags and beach bags;
- (6) ... scooters, skate boards, skis, ice skates, inline skates, basketballs, footballs and soccer balls;
- (7) camping equipment, namely: tents and sleeping bags;
- (8) household furniture and accessories, namely: tabletops, glasses, cups, forks, spoons, knives, utensils, pots, pans, bed sheets, blankets, covers, towels, curtains, horizontal blinds and vertical blinds.

[35] The amended statement of goods and services will be as follows

### GOODS

- (1) Men’s, women’s and children garments, namely: coats, jackets, suits, pants, t-shirts, shorts, jeans, hats, caps, undergarments, underwear, dresses, skirts, bathing suits, vests, blouses, scarves, jump suits, sweaters, sweatpants, sweatshirts, and pullovers;
- (2) footwear, namely: boots, shoes, running shoes, sport shoes, sandals;
- (3) fashion accessories, namely: watches, belts, ties, socks, key chains, gloves;



- (4) luggage and travel bags, namely handbags;
- (5) sports equipment, namely: bicycles.

**SERVICES**

Retail apparel store services.

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

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** No Hearing Held

**AGENTS OF RECORD**

Sumbulian & Sumbulian

For the Registered Owner

Fetherstonhaugh & Co.

For the Requesting Party