



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

Citation: 2013 TMOB 140
Date of Decision: 2013-08-29

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Zenobia Bawa against registration
Nos. TMA692,931 and TMA703,479 for the trade-mark B
ZEN & DESIGN and B ZEN & DESIGN in the name of
1148 Company Inc.**

[1] At the request of Zenobia Bawa (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 April 28, 2011 to 1148 Company Inc. (the Registrant), the registered owner of registration No. TMA692,931 for the trade-mark B ZEN & DESIGN and registration No. TMA703,479 for the trade-mark B ZEN & DESIGN. The trade-marks are shown below:



(TMA692,931)



(TMA703,479)

[2] I note that the marks are virtually identical and that in the evidence furnished, no distinction is made between the two designs. Accordingly, they will be referred to collectively as the Mark in this decision.

[3] Regarding registration No. TMA692,931, the Mark is registered for use in association with the following wares:

(1) Men's, ladies, women's, children's and teens' wearing apparel, namely: shirts; dress shirts; sport shirts; knit shirts; t-shirts; over-shirts; blouses; halters; sweat shirts; turtleneck shirts; mock turtleneck shirts; polo shirts; tank tops; sweat tops; jerseys; camisoles; chemises; baseball shirts; pullover tops with pouch pockets; kangaroo tops; muscle tops; golf shirts; night shirts; cardigans; sleeveless sweaters; short sleeved sweaters; long sleeved sweaters; pullovers; warm-up tops; singlets; pants; trousers; slacks; jeans; sweat pants; warm-up pants; pantaloons; rompers; jodhpurs; jumpers; shorts; walking shorts; bermudas; boardwalk shorts; culottes; parkas; pea jackets; duffel coats; rain coats; trench coats; waist coats; overcoats; sweat jackets; jackets; suits; blazers; windbreakers; ponchos; rain suits; training suits; play-suits; coveralls; overalls; shortalls; jumpsuits; jogging suits; sweat suits; sun suits; warm-up suits; uniforms; dresses; skirts; kimonos; coats; housecoats; smocks and shop coats; pajamas; sleep wear; dressing gowns; robes; bathrobes; sleepers; underwear; boxer; tights; handkerchiefs; mittens; bibs; wristbands; diaper sets; bandanas; neckties; hats; caps; visors; tuques; berets; belts; suspenders; scarves; gloves; headbands; hosiery; socks; casual wear.

(2) Luggage and related items namely: all-purpose gear carrying bags; all-purpose sporting goods bags; athletic bags; attaché cases; backpacks; barrel bags; beach bags; billfolds; briefcases; card-holders; change holders; clutch bags; purses; cosmetic cases sold empty; drawstring bags; duffel bags; duffel tote bags; flight bags; garment bags; garment travel bags; gym bags; key cases; overnight bags; parasols; passport covers; purses; school bags; shoulder bags; sport bags; stadium tote bags; suit bags for travel; suitcases; toiletry bags sold empty; toiletry pouches; tote bags; travelling bags; travelling cases; umbrellas; vanity cases; wallets; wardrobe bags; watch straps.

(3) Watches; jewelry and cigarette cases.

[4] With respect to registration No. TMA703,479, the Mark is registered for use in association with the following wares:

(1) Men's, ladies, women's, children and teens' wearing apparel, namely: shirts; dress shirts; sport shirts; knit shirts; t-shirts; over-shirts; blouses; halters; sweat shirts; turtleneck shirts; mock turtleneck shirts; polo shirts; tank tops; sweat tops; jerseys; camisoles; chemises; baseball shirts; pullover tops with pouch pockets; kangaroo tops; muscle tops; golf shirts; night shirts; cardigans; sleeveless sweaters; short sleeved sweaters; long sleeved sweaters; pullovers; warm-up tops; singlets; pants; trousers; slacks; jeans; sweat pants; warm-up pants; pantaloons; rompers; jodhpurs; jumpers; shorts; walking shorts; bermudas; boardwalk shorts; culottes; parkas; pea jackets; bomber jackets; topcoats; duffel coats; rain coats; trench coats; waist coats; overcoats; sweat jackets; jackets; suits; blazers; tuxedos; windbreakers; ponchos; rain suits; training suits; play-suits; coveralls; overalls; shortalls; jumpsuits; jogging suits; sweat suits; sun suits; warm-up suits; uniforms; dresses; gowns; skirts; kimonos; coats; housecoats; smocks; shop coats; pajamas; sleep wear; dressing gowns; robes; bathrobes; sleepers; underwear; boxer shorts; briefs; active wear; ski wear; outer wear; fleece wear; athletic wear; swimsuits; swim wear; shoes; slippers; boots; sandals; running shoes; tennis shoes;

walking shoes; sport shoes; deck shoes; sneakers; specific purpose athletic shoes and general purpose sport shoes; tights; handkerchiefs; mittens; bibs; wristbands; diaper sets; bandanas; neckties; hats; caps; visors; tuques; berets; belts; suspenders; scarves; gloves; headbands; hosiery; socks; casual wear.

[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 of the Mark is between April 28, 2008 and April 28, 2011.

[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 filed statutory declarations of Charles David Lam, President of the Registrant, sworn on September 21, 2011. I note that the statutory declarations furnished in response to each notice are substantively identical. Neither party filed written representations and an oral hearing was not held.

[8] In his declarations, Mr. Lam states that during the relevant period the Mark was used by a related company and licensee of the Registrant, Bluedot Jeanswear Company Inc. In support, he provides a copy of the licence agreement, dated August 1, 2004, permitting Bluedot to use the Mark in association with manufacturing, distributing, promoting, advertising and selling B ZEN & DESIGN products. Furthermore, Mr. Lam states that B ZEN & DESIGN products were sold during the relevant period by Bluedot at its store in Montreal, Quebec. I note, however, that despite Mr. Lam’s broad assertions of use with respect to “clothing, footwear, headwear, leather bags and luggage, watches, jewellery, and cigarette cases”, the evidence appears to relate only to some of the registered wares, as described below.

[9] As evidence of the Mark displayed on the wares, Exhibits PD-3 and PD-4 consist of photocopies of labels and hang tags which Mr. Lam identifies as illustrative of those affixed to B ZEN & DESIGN products sold in Canada. Similarly, Exhibit PD-5 consists of pictures of the labels stitched to various items, primarily casual wear shirts and pants, as well as one bag and one belt. I note that some of the labels and hang tags display the Mark as registered, while others display a minor but acceptable deviation of the Mark, such that the stylized “B” element appears to the left of the “ZEN” element, rather than on top of it.

[10] As proof of sales, attached as Exhibits PD-6 and PD-7 to Mr. Lam’s declaration are 14 “example” invoices issued by Bluedot showing sales to Canadian customers dated within the relevant period. The invoices include descriptions such as “BZEN crew neck short sleeve top” and I note that all of the invoices display the Mark as registered at the top of the invoice with a check mark next to it, apparently to indicate the invoiced brand. I also note, however, that the invoices only show sales of the following items: pants, including jeans and shorts; various types of shirts, tops and sweaters; blazers; mini skirts; “worker jacket”; “woven hangbag”; and belts.

[11] With respect to the remaining wares, it is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares specified in the registration during the relevant period. By way of example, so long as an affidavit clearly states that a trade-mark is used in association with all of the wares as registered, at minimum, the registrant must provide evidence with respect to each category of wares registered [*Saks & Co v Canada (Registrar of Trademarks)* (1989), 24 CPR (3d) 49 (FCTD)].

[12] In this case, Mr. Lam makes no clear assertion of use with respect to each of the registered wares during the relevant period; instead, as noted above, he makes the ambiguous statement that the Mark “*is used* in association with clothing, footwear, headwear, leather bags

and luggage, watches, jewellery, and cigarette cases” (emphasis added). Furthermore, it is not clear that the invoices are representative of all of the registered wares, as they are only with respect to some of the clothing wares, primarily casual wear pants and shirts. Consequently, the evidence does not support an inference that the Registrant’s licensee used the Mark in association with all of the registered wares.

[13] In particular, I note the absence of clear evidence with respect to the entirety of wares (3) as set out in registration No. TMA692,931. Furthermore, with respect to the various “bags” as registered, given that the invoice simply states “woven hangbag” [*sic*] and the only exhibited photograph of a B ZEN bag appears to be that of a women’s hand or shoulder bag, the evidence does not support use of the Mark in association with all of the various luggage, bags and “related items” as set out in wares (2) of the same registration.

[14] Similarly, the evidence does not support the registration with respect to the various types of “jackets” and outerwear set out in wares (1) of both registrations.

[15] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the following wares only: various types of pants, shirts and tops (as set out below), blazers, skirts, jackets, shoulder bags and belts. However, given the ambiguities in the evidence and the lack of written representations that may have helped clarify such, I cannot conclude that the Registrant has demonstrated use of the Mark during the relevant period in association with the remaining wares, as set out below. Furthermore, no evidence of special circumstances excusing such non-use is before me.

Disposition with respect to registration No. TMA692,931

[16] Accordingly, 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 the following wares:

- (1) ... parkas; pea jackets; duffel coats; rain coats; trench coats; waist coats; overcoats; sweat jackets; ... suits; ...; windbreakers; ponchos; rain suits; training suits; play-suits; coveralls; overalls; shortalls; jumpsuits; jogging suits; sweat suits; sun suits; warm-up

suits; uniforms; dresses; ...; kimonos; coats; housecoats; smocks and shop coats; pajamas; sleep wear; dressing gowns; robes; bathrobes; sleepers; underwear; boxer; tights; handkerchiefs; mittens; bibs; wristbands; diaper sets; bandanas; neckties; hats; caps; visors; tuques; berets; ...; suspenders; scarves; gloves; headbands; hosiery; socks; ...

(2) ... all-purpose gear carrying bags; all-purpose sporting goods bags; athletic bags; attaché cases; backpacks; barrel bags; beach bags; billfolds; briefcases; card-holders; change holders; clutch bags; purses; cosmetic cases sold empty; drawstring bags; duffel bags; duffel tote bags; flight bags; garment bags; garment travel bags; gym bags; key cases; overnight bags; parasols; passport covers; purses; school bags; ...; sport bags; stadium tote bags; suit bags for travel; suitcases; toiletry bags sold empty; toiletry pouches; tote bags; travelling bags; travelling cases; umbrellas; vanity cases; wallets; wardrobe bags; watch straps.

(3) Watches; jewelry and cigarette cases.

[17] The amended statement of wares for registration No. TMA692,931 will read as follows:

(1) Men's, ladies, women's, children's and teens' wearing apparel, namely: shirts; dress shirts; sport shirts; knit shirts; t-shirts; over-shirts; blouses; halters; sweat shirts; turtleneck shirts; mock turtleneck shirts; polo shirts; tank tops; sweat tops; jerseys; camisoles; chemises; baseball shirts; pullover tops with pouch pockets; kangaroo tops; muscle tops; golf shirts; night shirts; cardigans; sleeveless sweaters; short sleeved sweaters; long sleeved sweaters; pullovers; warm-up tops; singlets; pants; trousers; slacks; jeans; sweat pants; warm-up pants; pantaloons; rompers; jodhpurs; jumpers; shorts; walking shorts; bermudas; boardwalk shorts; culottes; jackets; blazers; skirts; belts; casual wear.

(2) Luggage and related items namely: shoulder bags.

Disposition with respect to registration No. TMA703,479

[18] Accordingly, 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, registration No. TMA703,479 will be amended to delete the following wares:

(1) ... parkas; pea jackets; bomber jackets; topcoats; duffel coats; rain coats; trench coats; waist coats; overcoats; sweat jackets; ...; suits; ... tuxedos; windbreakers; ponchos; rain suits; training suits; play-suits; coveralls; overalls; shortalls; jumpsuits; jogging suits; sweat suits; sun suits; warm-up suits; uniforms; dresses; gowns; ...; kimonos; coats; housecoats; smocks; shop coats; pajamas; sleep wear; dressing gowns; robes; bathrobes; sleepers; underwear; boxer shorts; briefs; active wear; ski wear; ...; fleece wear; athletic wear; swimsuits; swim wear; shoes; slippers; boots; sandals; running shoes; tennis shoes;

walking shoes; sport shoes; deck shoes; sneakers; specific purpose athletic shoes and general purpose sport shoes; tights; handkerchiefs; mittens; bibs; wristbands; diaper sets; bandanas; neckties; hats; caps; visors; tuques; berets; ...; suspenders; scarves; gloves; headbands; hosiery; socks; ...

[19] The amended statement of wares for registration No. TMA703,479 will read as follows:

(1) Men's, ladies, women's, children and teens' wearing apparel, namely: shirts; dress shirts; sport shirts; knit shirts; t-shirts; over-shirts; blouses; halters; sweat shirts; turtleneck shirts; mock turtleneck shirts; polo shirts; tank tops; sweat tops; jerseys; camisoles; chemises; baseball shirts; pullover tops with pouch pockets; kangaroo tops; muscle tops; golf shirts; night shirts; cardigans; sleeveless sweaters; short sleeved sweaters; long sleeved sweaters; pullovers; warm-up tops; singlets; pants; trousers; slacks; jeans; sweat pants; warm-up pants; pantaloons; rompers; jodhpurs; jumpers; shorts; walking shorts; bermudas; boardwalk shorts; culottes; jackets; blazers; skirts; outer wear; belts; casual wear.

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