TRADUCTION/TRANSLATION

PROCEEDING UNDER SECTION 45
TRADE-MARK: BÉBÉ CONFORT & DESSIN
REGISTRATION NO.: 323,935

On March 15, 2000, at the request of Messrs. McFadden Fincham, the Registrar issued the notice prescribed in section 45 of the *Trade-marks Act* to Produits Bébé Confort Inc., the registered owner of the above-mentioned registration.

The trade-mark BÉBÉ CONFORT & Dessin (reproduced below) is registered in association with the following wares:

(1) baskets or bags used to carry infants; baskets used to carry dolls;

(2) guardrails for cribs and children's beds; infants' and children's clothing, in particular night gowns and bibs; infants' and children's bedding, in particular flat and fitted sheets, pillowcases, bed skirts or valances, comforters and pads for high chairs;

(3) infants' and children's linens, in particular bath towels and wash mitts; sleeping bags;

(4) infants' and children's bedding, in particular blankets; growth charts for infants and children.

Section 45 of the *Trade-marks Act* requires the registered owner of the trade-mark to indicate

whether the trade-mark was used in Canada in association with each of the wares or services specified in the registration at any time in the three-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date. In this matter, the relevant period is any time between March 15, 1997, and March 15, 2000.

In response to the notice, an affidavit from Karen Abaziou (and supporting documents) was furnished. Each party produced a written argument and was represented at the hearing.

The applicant argued that the evidence provided was insufficient to show use in association with each of the wares specified in the registration.

Having considered the evidence and the arguments of the parties, I find that the evidence is sufficient for me to conclude that the trade-mark was used in association with the following wares: "baskets (or bags) used to carry infants; baskets used to carry dolls; infants' and children's clothing, namely bibs; infants' and children's bedding, namely flat and fitted sheets, pillowcases, bed skirts (or valances), comforters; infants' and children's linens, namely bath towels and wash mitts; infants' and children's bedding, namely blankets". The invoices show sales of each of these wares during the relevant period, and because Ms. Abaziou stated that all wares sold bear the trade-marks BÉBÉ CONFORT and BÉBÉ CONFORT & Dessin and produced sample labels representative of the type of labels affixed to the wares sold by the trade-mark holder during the relevant period, I agree that at the time the wares in question were transferred, notice of

association between the trade-mark and the wares as required by subsection 4(1) of the Act was given to the purchaser. Those wares will therefore be maintained.

With regard to the other wares specified in the registration, in particular "guardrails for cribs and children's beds, night gowns, pads for high chairs, sleeping bags, growth charts for infants and children", the evidence is in my view insufficient for me to conclude that there was use of the trade-mark in association with those wares during the relevant period. Ms. Abaziou stated that the trade-mark has been used in Canada continuously and without interruption since at least as early as November 1980 in association with each of the wares specified in the registration, but that statement alone is not enough for me to conclude that there were sales of each of the wares specified in the registration during the relevant period. Because Ms. Abaziou did not clearly state that those specific wares were the subject of business transactions during the relevant period and because the evidence does not show that there were sales of those wares during the relevant period, I find that those wares should be struck from the registration.

The trade-mark holder argued that those wares should be retained given that the case law indicates that the owner of a trade-mark is not required under section 45 to show use in association with each of the wares in a given category and that that principle was upheld by the Federal Court in *Saks & Co. v. RTM et al.*, 24 C.P.R. (3d) 49 (FCTD), where the judge wrote:

> The wares in the registration have been logically and properly categorized and, in such a case, there is no requirement, in order to maintain registration, when faced with an application under s. 44 [now section 45], that either direct evidence or documentary proof

> be furnished regarding every item in each category. I am therefore fully satisfied that registration should be maintained for the 14 categories where Canadian deliveries have been indicated regarding some of the items.

The trade-mark holder contended that following the decision in *Saks*, the Registrar made a number of decisions indicating that registration is maintained if (i) the owner of the trade-mark clearly claimed use of the trade-mark in association with the set of wares and/or services covered by the registration and (ii) the documentary evidence clearly shows use in association with some wares or services. The trade-mark holder made specific reference to the following decisions: *Mendelson, Rosentzveig & Schacter v. Giorgio Beverly Hills, Inc*., 56 C.P.R. (3d) 399, *Laboratoires Garnier & Cie v. Neutrogena Corp*., 64 C.P.R. (3d) 93 and *Sim & McBurney v. Hugo Boss AG*, 67 C.P.R. (3d) 558.

Given that an overabundance of evidence is not required in a proceeding based on section 45 (*Union Electric Supply Co. Ltd. v. Registrar of Trade Marks*, 63 C.P.R. (2d) 56), the principle stated in *Saks* is understandable. A trade-mark holder is therefore not required to furnish "either direct evidence or documentary proof" regarding every item in a given category. In my opinion, that assumes that the Registrar can infer from the evidence provided that there was use, in other words business transactions took place involving each of the wares, at some time during the three-year period immediately preceding the date of the notice. In contrast to *Saks*, there is nothing in the affidavit in this case that would allow me to make such inference. I therefore believe that the precedent applicable to this case is *John Labatt Ltd. v. Rainier Brewing Co*., 80 C.P.R. (2d) 228 (FCA).

Incidentally, the trade-mark holder stated that the evidence shows sales of various pads, such as "rocking chair pads and nursing pillows" that are similar to "pads for high chairs" and sales of various blankets or comforters similar to sleeping bags and argued that the wares "pads for high chairs" and "sleeping bags" should therefore be maintained. In my opinion, nursing pillows and rocking chair pads are not pads for high chairs. Moreover, because comforters and blankets are already covered by the registration, the trade-mark holder cannot use those same wares to maintain "sleeping bags" (see *Sharp Kabushiki Kaisha v. 88766 Canada Inc.*, 72 C.P.R. (3d) 195).

Since I am of the opinion that the evidence is insufficient to permit me to conclude that the trade-mark was used during the relevant period in association with the wares "guardrails for cribs and children's beds; night gowns; pads for high chairs; sleeping bags; growth charts for infants and children", I find that those wares should be struck from the registration.

Registration No. 323,935 will be amended accordingly, pursuant to subsection 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 15TH DAY OF JANUARY 2004.

D. Savard
Senior Hearing Officer
Section 45