



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

**Citation: 2014 TMOB 241**  
**Date of Decision: 2014-11-06**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Bereskin & Parr against registration  
No. TMA207,925 for the trade-mark CARMEN in the  
name of Kalena Importing Co. Ltd. dba Kalena's Shoes**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA207,925 for the trade-mark CARMEN owned by Kalena Importing Co. Ltd. dba Kalena's Shoes.

[2] The subject trade-mark is registered for use in association with "Ladies' and men's footwear, namely shoes" (the Wares).

[3] For the reasons that follow, I conclude that the registration ought to be maintained in its entirety.

The Proceeding

[4] On February 1, 2013, at the request of Bereskin & Parr (the Requesting Party), the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Kalena Importing Co. Ltd. (the Registrant), the name recorded as the owner of the registration on the trade-mark register at that time.

[5] The notice required the Registrant to provide evidence showing that it had used the trade-mark CARMEN (the Mark) in Canada, at any time between February 1, 2010 and February 1, 2013 (the relevant period), in association with each of the Wares specified in the registration. If the trade-mark had not been so used, the Registrant was required to furnish evidence providing the date when the trade-mark was last in use and the reasons for the absence of use since that date.

[6] Subsequent to the issuance of the section 45 notice, the Registrant filed with the Registrar, a request for a change of name to include the trade name/trading style under which it does business. On April 6, 2013, the amendment was recorded on the Register; as such, the registered owner of the subject registration is now identified as Kalena Importing Co. Ltd. dba Kalena's Shoes.

[7] In this case, the use of the Mark in association with the registered wares is governed by section 4(1) of the Act, which reads:

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.

[8] 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 clearing the register of "deadwood". Mere claims of use are insufficient to show the use of the trade-mark [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the test that has to be met by a registrant is not a heavy one, sufficient facts must be provided to enable the Registrar to conclude that the trade-mark has been used in association with each of the wares listed in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[9] In response to the Registrar's notice, the Registrant provided the affidavit of Veralena Casellato, sworn August 29, 2013, together with Exhibits A through J.

[10] Both parties filed written submissions; however, an oral hearing was not conducted.

[11] Following the submission of the Requesting Party's written submissions, the Registrant on two occasions, requested an extension of time based on section 47(2) of the Act to file a supplemental affidavit of Ms. Casellato. However, both such requests were denied; consequently, the supplemental affidavit of Ms. Casellato is not of record and will not be considered as evidence in this proceeding.

### The Evidence

[12] In the affidavit of record, Ms. Casellato attests that she is the Registrant's head buyer and explains that she has worked in a variety of positions of increasing responsibility with the Registrant over the past 28 years. She further attests that the Registrant is a family business that was originally established by her father over 40 years ago.

[13] Ms. Casellato then explains the background of the Mark, chosen by her father Carmen D'Onofrio early in the Registrant's history, as the trade-mark for a line of fine Italian-made men's and ladies' shoes.

[14] With respect to the Registrant's normal course of business or supply chain, and what Ms. Casellato explains is the norm in the Canadian retail shoe trade, the Registrant buys the Wares directly from manufacturers in Italy, who affix the Mark to the Wares according to the Registrant's specifications. Ms. Casellato explains that representatives of the Registrant travel to Italy to place orders with these suppliers in person, to ensure that the Wares meet the Registrant's high standards of quality.

[15] To provide context for the Registrant's channels of trade in Canada for the Wares, Ms. Casellato begins by stating that sales "have ebbed and flowed over the years." At its peak, she attests, "CARMEN-branded shoes were sold in every retail location of The Bay across Canada and in many specialty footwear stores." She explains however, that as the market for premium Italian footwear has changed in recent years, the Wares have been sold exclusively, including during the relevant period, in the Registrant's two retail stores located at 1526 Commercial Drive, Vancouver, British Columbia and 929 Mt. Hwy, North Vancouver, British Columbia.

[16] In support of the above-noted assertions of sales of the Wares during the relevant period, Ms. Casellato provides the following:

- A sampling of receipts for sales of CARMEN-branded shoes in Canada for each year of the relevant period, from February 1<sup>st</sup> to the end of the following January (Exhibits A-C). I note that the receipts were issued in the name of Kalena's Shoes, whose address is indicated as 1526 Commercial Drive, Vancouver, BC.
- Sworn statements regarding sales by the Registrant of Wares associated with the Mark for each year of the relevant period. When such statements are combined, they amount to total sales during the relevant period in excess of 260 pairs of ladies' shoes and 400 pairs of men's shoes, representing revenues during the relevant period for the Registrant in excess of \$125,000.
- Ms. Casellato attests that until very recently, it was the Registrant's practice to indicate the manufacturer, style and item number of shoes sold on receipts, but not the Mark with which the shoes were associated. As such, the receipts in Exhibits A-C do not show the Mark. However, Ms. Casellato explains that the receipts show item numbers for each pair of shoes sold, and she lists 16 item numbers that can be found throughout these receipts to which she clearly states are all tied to CARMEN-branded shoes sold by the Registrant in Canada.
- Copies of sales reports (Exhibit E). Ms. Casellato explains that each sales report relates to a receipt reproduced in Exhibit A, B, or C showing a sale of CARMEN-branded shoes, including the date of the sale, the item number of the shoes sold, as well as identifying the trade-mark affixed to the shoes sold. She then compares the sales reports of Exhibit E to the item numbers shown on the sales receipts of Exhibits A-C to demonstrate the number of CARMEN-branded shoes sold during each year of the relevant period, as per the sales receipts. She concludes by indicating that these sales do not represent all sales of CARMEN-branded shoes during this time period, and that over 700 pairs of CARMEN-branded shoes were sold by the Registrant in Canada in that period.

[17] With respect to the manner in which the Mark was associated with the Wares at the time of transfer, Ms. Casellato explains that the Mark is visible on the Wares themselves in the usual manner in which trade-marks are used in the shoe trade; that is, placed on the insole of the shoes. This way, explains Ms. Casellato, the trade-mark is visible while customers are browsing and selecting shoes for purchase, but is concealed while the shoes are actually worn.

[18] In addition, Ms. Casellato attests, the Mark is also visible on the boxes in which the Wares are sold by the Registrant, including those sold during the relevant period.

[19] In support of the above-noted attestations regarding the manner in which the Mark is and was associated with the Wares at the time of transfer, Ms. Casellato provides the following:

- Photographs of ladies' and men's shoes wherein the Mark is clearly visible on the insoles of the shoes, as well as a photograph of the shoe boxes in which the Wares are sold (Exhibits F, G, and J). While Ms. Casellato admits that the photographs were taken after the relevant period at the Registrant's Vancouver retail location, she clearly states that the photographs are representative of the Registrant's use of the Mark in association with shoes sold in Canada, including during the relevant period. Further to this, she also states that the Registrant sold "other pairs of CARMEN-branded shoes in these particular styles" as shown in the photographs during the relevant period at the Vancouver retail location. In support, she cross references one such sale from Exhibit C, as relating to the sale of a specific item number, which she states is the style of CARMEN-branded shoes that is shown in Exhibit G.

#### Analysis and Discussion of the Parties' Submissions

[20] The Requesting Party submits that the evidence is incomplete and ambiguous, to the extent that the evidence does not support use of the Mark in Canada with the Wares by the Registrant, and thus should be expunged. More particularly, the Requesting Party submits:

- There is no clear evidence showing use of the Mark in association with the Wares during the relevant period; and
- There is no evidence that use of the Mark accrued to the Registrant.

[21] With respect to the question of use of the Mark during the relevant period, the Requesting Party's submissions focus on the fact that the photographs of the shoes and shoe boxes (Exhibits F-J) were taken after the relevant period.

[22] Further to this, the Requesting Party submits that there is no evidence that the shoes shown in the photograph in Exhibit F were sold in Canada during the relevant period. In this regard, the Requesting Party contends ambiguity exists in Ms. Casellato's statement that "other pairs of CARMEN branded shoes in these particular styles were sold" during the relevant period at the Vancouver retail location. According to the Requesting Party, this statement means that the shoes shown in this exhibit were not sold at this location, only other shoes were.

[23] The evidence surrounding the shoe boxes, the Requesting Party submits, is also ambiguous. In this regard, the Requesting Party submits that not only was the photograph of the shoe boxes also taken after the relevant period, but there is no evidence that shoes bearing the CARMEN trade-mark were sold in these boxes during the relevant period.

[24] The Requesting Party further points to the only other additional visible information on the shoe boxes - the number "105". The Requesting Party submits that this number does not correspond to any of the item numbers listed by Ms. Casellato as being associated with CARMEN brand footwear. Furthermore, the Requesting Party submits that there is no way of knowing what type of footwear was sold in these boxes or whether the footwear therein displays the Mark in the manner shown in Exhibits F and G (and did so during the relevant period).

[25] However, although the photographs in Exhibits F, G, and J were taken after the relevant period, in all instances Ms. Casellato provides clear sworn statements that this evidence is *representative* of the Registrant's use of the Mark in association with the Wares sold during the relevant period. I note that these exhibits are entirely consistent with Ms. Casellato's sworn descriptions of how the Mark is and was affixed to the Wares and associated packaging (i.e. shoe boxes) during the relevant period. Further to this, Ms. Casellato clearly identifies which items on the sales receipts and sales reports that specifically pertain to sales of the Wares during the relevant period. Moreover, not only is the men's shoe depicted in Exhibit G representative of the Registrant's use of the Mark on these Wares during the relevant period, Ms. Casellato provides a

clear attestation that links a particular sales receipt in Exhibit C to the very style of shoe shown in the Exhibit G photograph.

[26] In considering the exhibits in conjunction with Ms. Casellato's sworn statements, I find nothing ambiguous or inconsistent in the evidence. The Registrant has provided more than bald statements of use; the Registrant has clearly described and shown use attributable to the relevant period.

[27] With respect to the Requesting Party's submission that there is no evidence that use of the Mark accrued to the Registrant, the Requesting Party draws attention to the sales receipts (Exhibits A-C). Specifically, the Requesting Party points out that the receipts in these exhibits are in the name of "Kalena's Shoes", not the Registrant, and that nowhere in the affidavit does Ms. Casellato explain what relationship Kalena's Shoes bears to the Registrant.

[28] In addition, the Requesting Party submits that the only evidence that ties the above-noted sales receipts to products displaying the Mark are the sales reports (Exhibit E) which are also in the name of Kalena's Shoes. The Requesting Party submits that as these sales reports are in the name of Kalena's Shoes, not the Registrant, there is no evidence that these reports were created in the normal course of business, and it is not possible to assess the reliability of these reports.

[29] The Registrant submits that Ms. Casellato clearly states in her affidavit that the use therein is by the Registrant. Further to this, the Registrant submits that the registration clearly states that "Kalena Shoes" is a trade name of the Registrant (i.e. the Registrant does business as Kalena's Shoes). I note however, that as previously indicated, the change of name amendment to the registration to reflect the Registrant's trade name/trading style was requested and recorded on the register after the date of the section 45 notice.

[30] In any event, the Registrant submits that Ms. Casellato's consistently provides statements in her affidavit confirming use by the Registrant, and as such, there is no ambiguity as to who is selling the Wares labelled with the Mark. The Registrant further points out that all of the sales receipts in Exhibits A-C indicate an address of "1526 Commercial Drive", an address that Ms. Casellato clearly attests in her affidavit is one of the Registrant's retail store locations. I note that this address is the same address of record, to which the section 45 notice was sent.

[31] The Registrant further submits that as Kalena's Shoes is not a corporate name (e.g. with "Ltd." appended), nor an individual's name, it would not lead a consumer to believe that a separate legal entity is involved. Thus, the Registrant submits that to the extent that any person might infer that Kalena's Shoes is the entity selling the Wares, in reading the affidavit in conjunction with Ms. Casellato's sworn statements, it is immediately clear that Kalena's Shoes must be a trade name of the Registrant.

[32] I find the Registrant's above-noted submissions on this issue reasonable. In addition, the common address of the Registrant at the date of the section 45 notice and the address of the Registrant's retail shoe store support the inference that Kalena's Shoes is a merely a trade name of the Registrant, and not a distinct legal entity to whom use can be attributed.

[33] Having regard to the foregoing and bearing in mind the intent and purpose of section 45 as a simple and summary means to remove "deadwood" from the register, I accept that use has been shown of the Mark in association with the Wares in Canada during the relevant period, and that such use was by the Registrant.

#### Disposition

[34] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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Kathryn Barnett  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office