



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

**Citation: 2015 TMOB 5**  
**Date of Decision: 2015-01-15**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Method Law against registration  
No. TMA139,323 for the trade-mark JOSEF in the name  
of Boutique Jacob Inc.**

[1] On February 27, 2013, at the request of Method Law (the Requesting Party), a notice was issued under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Boutique Jacob Inc., the registered owner of registration No. TMA139,323 for the trade-mark JOSEF (the Mark).

[2] The Mark was registered on February 26, 1965 for use in association with the following goods:

- (1) Ladies' and misses' and children's dresses, coats, suits, blouses, slacks, skirts, shorts, gowns, bathing suits, beach coats, and robes.

[3] The registration was amended on November 16, 2010 and again on June 6, 2012 under the provisions of Section 41 of the Act, extending the statement of goods and services to include additional clothing items and accessories, as well as the retail sale of the aforementioned goods (i.e. goods (2), (3), and (4), and services (1) in the registration). However, as these goods and services had not been on the register for a period of at least three years prior to the section 45 notice, they are not subject to the current proceedings [see Section II.1.2 of the practice notice entitled *Practice in Section 45 Proceedings* and section 41(2) of the Act]. Consequently, the only goods at issue are those which are listed in the preceding paragraph (sometimes hereafter referred to as the relevant goods).

[4] The section 45 notice required the registered owner to provide evidence showing that it had used the Mark in Canada, at any time between February 27, 2010 to February 27, 2013 (the relevant period), in association with each of the relevant goods specified in the registration. If the Mark had not been so used, the registered owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

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

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.

[6] The threshold for establishing use in a section 45 proceeding is quite low [*Cinnabon, Inc v Yoo-Hoo of Florida Corp* (1998), 82 CPR (3d) 513 (FCA)], however, sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the registered goods during the relevant period. A bare statement of use is not sufficient, and ambiguities in the evidence are to be interpreted against the interests of the registered owner [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (4th) 62 (FCA)].

[7] In response to the Registrar's notice, the registered owner provided the solemn declaration of Joseph Basmaji, together with Exhibits A through N.

[8] Both parties filed written representations; however, only the Requesting Party attended an oral hearing.

[9] For the reasons that follow, I conclude that the registration ought to be amended.

### The Evidence

[10] In his declaration, Mr. Basmaji explains that he is the President of the current registered owner, Boutique Jacob Inc. (referred to hereafter as Jacob or the registered owner). He states that he was also the President of Basco IP L.P. (Basco), predecessor in title to Jacob, as well as

President of another company called Boutique Jacob Inc. (Boutique Jacob) that was using the Mark under license from Basco, during part of the relevant period.

[11] Mr. Basmaji attests that between May 1, 2008 and October 28, 2011, the Mark was owned by Basco, and used under license by Boutique Jacob in association with all of the goods sold and services performed under the Mark. He attaches, as Exhibit B, copies of relevant licensing documents. He further states that the license specifically includes control and quality standards provisions that he has generally enforced, on behalf of Basco, for all use of the Mark by Boutique Jacob during the relevant period.

[12] Mr. Basmaji then explains that by the end of 2010, Boutique Jacob, as a result of financial problems, underwent a massive corporate and business reorganization which also impacted Basco. As a result, Mr. Basmaji attests, on October 28, 2011, the Mark was transferred to Jacob, its current owner. He states that Jacob has been using the Mark, as owner, since October 2011. He attaches as Exhibit C, copies of the relevant assignment documents, which he indicates were ultimately recorded on the trade-mark register on May 15, 2012.

[13] Mr. Basmaji states that during the relevant period, Basco, through its licensee Boutique Jacob, or Jacob since October 2011 as owner, have used the Mark in Canada in association with the goods listed in the registration. In support of his statement of use of the Mark, he provides the following exhibit evidence summarized below. I will only refer to those exhibits that are relevant for the purposes of the present proceeding dealing with the relevant goods.

- Photographs of: product labels; women's clothing, accessories and jewelry; and shopping bags, garment bags, wrapping paper and boxes, all indicated to be representative examples of how the Mark was used by Boutique Jacob or Jacob during the relevant period in association with all of the registered goods (Exhibits D, F, and H);
- Copies of price ticket/hang tag specification forms used during the relevant period. The tags clearly bear the Mark, and are stated to show how the Mark was attached to all registered goods sold under the Mark by Boutique Jacob and Jacob during the relevant period (Exhibit E);

- Copies of cash register receipts and return receipts showing the sale of dresses, sweaters and skirts under the Mark during the relevant period (Exhibit G). Mr. Basmaji explains that as cash register receipts are given to customers at the time of sale, electronic copies are only kept for a short period of time by Boutique Jacob's head office. Further, the only reason why Boutique Jacob has a few copies of cash register receipts as per Exhibit G, is that when an item is returned (as in the present case), copies of the original cash register receipts and return receipts are kept by Boutique Jacob's head office for a longer period of time;
- Copies of webpages from the *jacob.ca* website dated July 2010, stated to show use of the Mark in association with "t-shirts, camisoles, coats, shorts, shirts, scarves, pants, jackets, robes, dresses, gowns, sweaters and jewelry" (Exhibit I);
- Copies of representative purchase orders placed to suppliers during the relevant period for products with the Mark. Mr. Basmaji states that based upon his knowledge regarding the article numbers and product descriptions on the representative purchase orders, the products produced under the Mark were "camisoles, t-shirts, dresses, jewelry, blouses, belts, sweaters, scarves, skirts, pants, leggings, dresses, bags and purses, jackets, and blazers" (Exhibit J);
- A table outlining annual sales made by Boutique Jacob and Jacob during the relevant period, for the registered goods sold, all bearing the Mark (Exhibit K). The sales totals are not broken down per item, but rather are expressed in total sales volumes; and
- A list of retail store locations operated by Boutique Jacob under the JOSEF trade-mark during the relevant period in Canada, including each store's respective opening and closing date (Exhibit L). Mr. Basmaji states that between 2005 and until 2011, all of the registered goods sold under the Mark were sold in these JOSEF stores.

## Summary of the Submissions and Analysis

[14] In its written representations, the Requesting Party submits that despite Mr. Basmaji's attestations, the only evidence of use insofar as the relevant goods are concerned is with respect to ladies' blouses, pants (which I accept constitutes the registered good "slacks"), and skirts.

[15] In particular, with respect to the photographs of the product labels (Exhibit D), and the price ticket/hang tag specification forms (Exhibit E), the Requesting Party submits that these documents show dates that are prior to the relevant period, and therefore irrelevant. The registered owner, on the other hand, submits that the dates appearing on these documents are immaterial, as Mr. Basmaji clearly states in his affidavit that the labels and price ticket/hang tag specifications are "representative examples" of those used during the relevant period. I agree.

[16] As for Exhibits F and I, the Requesting Party submits that these exhibits show only a limited number of goods. In particular, insofar as the relevant goods are concerned, the Requesting Party submits that Exhibit F only shows ladies' clothing, namely, coats, shirts (which I accept in this case constitutes the registered good "blouses"), skirts, slacks, dresses, and suits. Notably absent from these exhibits, the Requesting Party submits are "bathing suits, beach coats, robes; or any form of misses' and children's clothing."

[17] The registered owner submits that in addition to those relevant goods identified by the Requesting Party, Exhibits F and I also show pictures of "gowns". In this regard, the registered owner refers to the definition of the word "gown" as defined in the *Merriam-Webster* online dictionary as a "long, formal dress that a woman wears especially during a special event", or just "a woman's dress". I agree that these exhibits show photographs of gowns, and while the webpages are not sufficient to provide evidence of notice of association of the Mark with the goods at the time of transfer, the webpages are nonetheless corroborative of other exhibits.

[18] With respect to Exhibit J, the Requesting Party submits in its written representations that as with other exhibits, many of the relevant goods are notably absent including, once again, "bathing suits, beach coats, robes; or any form of misses' and children's clothing." Further to this, the Requesting Party notes that the purchase orders dated in 2012 refer to "Ligne prod.: Jacob", whereas those dated in 2010 refer to "Ligne prod.: Josef", a discrepancy the registered

owner has not explained. The Requesting Party submits that given this discrepancy, that the last JOSEF store closed on March 9, 2011 (as per Exhibit L), and that there is no description as to how the goods associated with the Mark were sold or provided after this date, the only conclusion is that no sales were made of JOSEF goods after 2010. Thus, the Requesting Party submits, the only evidence of transfers of the relevant goods is in the purchase orders for “Ligne prod.: Josef”, which is limited to “ladies’ blouses, skirts, and slacks”.

[19] At the oral hearing, the Requesting Party provided additional submissions regarding the 2010 purchase orders attached under Exhibit J, submitting that these purchase orders should actually also be disregarded. Accordingly, the Requesting Party submits there is no evidence of sales of any of the relevant goods and, as such, all of the relevant goods should be deleted from the registration.

[20] Specifically, the Requesting Party submits that there are additional unexplained differences/discrepancies between the 2010 and 2012 purchase orders. In particular, unlike the 2012 purchase orders, the 2010 purchase orders identify a corporate vendor instead of an individual buyer, the word “specimen” does not appear, and there are no corresponding photographs of the invoiced goods bearing the Mark. Having regard to such unexplained discrepancies, the Requesting Party submits that the 2010 purchase orders do not reflect actual sales as it appears that there was no acceptance by the buyer.

[21] I disagree with the Requesting Party’s submissions. I find the Requesting Party has been overly technical in dissecting the purchase orders, and find any alleged discrepancies (*e.g.* “fournisseur” vs “vendor”) to be merely semantic in nature. Furthermore, while it is true that Mr. Basmaji has not explicitly described how the goods associated with the Mark were sold or provided after the date when the last JOSEF store closed, the evidence demonstrates that commercial activity concerning goods bearing the Mark continued at least into 2012. In any event, Mr. Basmaji clearly states that the purchase orders are representative examples, and section 45 only requires that use be shown “at any time” during the relevant period [see *Osler, Hoskin & Harcourt v United States Tobacco Co et al* (1997), 77 CPR (3d) 475 at para 20 (FCTD); and *Carter-Wallace Inc v Wampole Canada Inc* (2000), 8 CPR (4th) 30 (FCTD)].

[22] All this being said, however, I disagree with the registered owner's submission that the evidence is sufficient to maintain all of the relevant goods in the subject registration.

[23] The registered owner submits that it has provided representative examples of use of the Mark within a defined category of goods. It relies on *Saks & Co v Canada (Registrar of Trademarks)* (1989), 24 CPR (3d), 49 (FCTD), for the principle that there is no requirement, in order to maintain a registration, that either direct evidence or documentary proof be furnished regarding every item in every category. Further to this, the registered owner submits it is sufficient that Mr. Basmaji has provided a general statement of sales made during the relevant period in association with each of the relevant goods, together with examples of use (but not all examples of use) [citing *Mendelson, Rosentzveign & Shacter v Giorgio Beverly Hills, Inc* (1994), 56 CPR (3d) 399 (TMOB)].

[24] I do not consider *Saks, supra*, to be applicable in the present case. In *Saks*, there were 28 distinct categories of goods and services; furnishing evidence for all of which would have placed an unreasonable burden on the registered owner. In the present case, the list of relevant goods is relatively small and concerns only one general category of goods, such that I do not find it unreasonable to expect the registered owner to furnish some evidence with respect to each of the goods. The situation in *Mendelson, supra*, is also distinguishable in terms of the sufficiency of evidence required, as it was a case which dealt with a much lengthier statement of goods. While the registered owner is not required to engage in evidentiary overkill in order to demonstrate use of its trade mark for the purposes of section 45, there must be *some* evidence upon which the Registrar can conclude that the trade mark has been used in association with each relevant good during the three-year period preceding the date of the notice.

[25] In viewing the evidence in its entirety, I accept that representative use of the Mark has been shown in association with "ladies' dresses, coats, suits, blouses, slacks, skirts, shorts, and gowns." These are the only relevant goods that appear in any of the exhibits whatsoever. However, despite Mr. Basmaji's statement that the Mark has been used in association with all of the relevant goods listed in the registration during the relevant period in Canada, I see nothing in the evidence that permits me to conclude or leads me to draw the logical inference that such use extended to "bathing suits, beach coats, and robes" or any form of "misses' and children's"

clothing. Furthermore, I do not find in the present case that it would have placed an unreasonable burden on the registered owner to have shown use with respect to each of the relevant goods.

Disposition

[26] Having regard to 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 goods listed at (1) in the registration will be maintained solely in respect of “*Ladies' dresses, coats, suits, blouses, slacks, skirts, shorts, gowns.*”

[27] However, as previously stated, as the goods listed at (2), (3), and (4), and the services listed at (1) are not subject to this proceeding, they will continue to remain on the register in their entirety.

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