

SECTION 45 PROCEEDINGS
TRADE-MARK: GIORGIO BRUTINI
REGISTRATION NO.: TMA278,377

[1] At the request of Smart & Biggar (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) on March 6, 2007 to Harbor Footwear Group Ltd., the registered owner of the above-referenced trade-mark (the “registrant”).

[2] The trade-mark GIORGIO BRUTINI is registered for use in association with the following wares:

- (1) Men's footwear, namely shoes, boots and other men's accessories, namely handbags.
- (2) Men's footwear, namely shoes and boots.

[3] Section 45 of the Act requires the registrant to show whether the trade-mark has been used in Canada in association with each of the wares and/or 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 is any time between March 6, 2004 and March 6, 2007.

[4] “Use” in association with wares is set out in sections 4(1) and 4(3) 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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, section 4(1) applies.

[5] In response to the Registrar's notice, the registrant furnished the affidavit of Dennis S. Lazar, sworn on September 28, 2007, together with Exhibits "A" and "B". Mr. Lazar states that he is the president of the registrant and that he has held that position since 1995. Both parties filed written submissions; an oral hearing was not requested.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares/services specified in the registration during the relevant period.

[7] At the outset of the decision, it is noted that the registrant did not make any reference to the wares specified in the registration as "other men's accessories, namely handbags" in its evidence. In particular, Mr. Lazar did not show or describe the use of the trade-mark in association with handbags nor did he advance any special circumstances to excuse the non-use of these wares if that was the case. Consequently, the wares registered as "other men's accessories, namely handbags" ought to be deleted from the registration.

[8] With respect to the manner in which the trade-mark is associated with the remaining wares specified in the registration as "men's footwear, namely shoes and boots", Mr. Lazar states in paragraph 4 of his affidavit that the subject trade-mark "is used by displaying the trade mark on the Goods [previously defined as "men's footwear, namely

shoes and boots”] and/or the packaging for the Goods”. In support, sample labels representative of those used in Canada during the relevant period are attached as Exhibit “A”. I note that the subject trade-mark is shown in a prominent manner on the labels followed by the indicia ®.

[9] The requesting party contended that it is unclear whether the labels were applied to “shoes” or “boots” and that the sample labels are “inconsistent” with the affiant’s statement that the trade-mark was used on the packaging of the wares. In return, the registrant submitted that there is no ambiguity in Mr. Lazar’s statements regarding the use of the labels in association with both types of footwear during the relevant period as the affiant has previously defined in paragraph 3 of his affidavit that the term “Goods” refers to the wares registered as “men’s footwear, namely shoes and boots”, to which I agree. I also find it reasonable to accept the rectangular fabric labels produced as Exhibit “A” as representative of those applied to the footwear rather than the packaging. As for Mr. Lazar’s statement that the subject trade-mark appeared on the footwear “and/or” its packaging, I do not find the use of “and/or” in this case to be inconsistent. It simply means that the trade-mark was not always used on the footwear *and* on the packaging. In any event, usage of the trade-mark in either manner is deemed to be used within the meaning of section 4(1) of the Act.

[10] On a separate note, the requesting party questioned the lack of photographic evidence showing the footwear with the label bearing the trade-mark GIORGIO BRUTINI sewn therein. There is no one particular type of evidence that must be provided in these proceedings. While it might have been helpful for the registrant to produce a photograph of the footwear in question with the label attached, I am satisfied that in this case, the affiant has sufficiently set out facts accompanied by supporting exhibits that would allow me to conclude that the subject trade-mark was associated with men’s shoes and men’s boots during the relevant period.

[11] With respect to the normal course of trade and the sales of these wares, Mr. Lazar explains in paragraph 6 of his affidavit that the sale of men’s shoes and boots bearing the

subject trade-mark to retail stores and distributors in Canada during the relevant period amounted to approximately \$191,300, representing nearly 12,600 pairs of footwear. In support, sample purchase orders and corresponding invoices dated within the relevant period are attached as Exhibit “B”. Even though the subject trade-mark does not appear as part of the item descriptions in these documents, the affiant attests that “all the stock/style numbers in the purchase orders and invoices are for [men’s footwear, namely shoes and boots] bearing the trade-mark GIORGIO BRUTINI”. Mentions of “GIORGIO BRUTINI” as the name of the label and the instruction “STAMP SOCK, SHOES, COLOR BOXES GIORGIO BRUTINI” can be seen on numerous purchase orders. Furthermore, it is noted that the invoices bear the registrant’s name, as well as Canadian billing and shipping addresses; indicative of sales to Canadian entities during the relevant period.

[12] The requesting party submitted that there is no evidence as to the volume of sales of each distinct ware and that the representative purchase orders and invoices fail to distinguish between “shoes” and “boots”, thus “there is no clear and reliable evidence to determine which of the registered wares, if any, were actually sold in Canada”.

[13] In the present case, there is clear evidence showing sales of both types of footwear in the normal course of trade by the registrant in Canada; in addition to the affiant’s statements that men’s shoes and boots were sold during the relevant period, numerous purchase orders and invoices are produced with Canadian billing and shipping addresses issued during the relevant period with descriptions such as “STAMP [...] SHOES [...] GIORGIO BRUTINI” and item descriptions such as “black boots”. When Mr. Lazar’s statements are read in conjunction with the supporting documents, I am satisfied that men’s shoes and men’s boots bearing the subject trade-mark were sold in the normal course of trade in Canada within the relevant period.

[10] In view of the foregoing, I am satisfied that there was use of the subject trade-mark within the meaning of sections 45 and 4(1) of the Act on “men’s footwear, namely shoes, boots” and “men's footwear, namely shoes and boots”. Accordingly, and pursuant

to the authority delegated to me under section 63(3) of the Act, registration TMA278,377 for the trade-mark GIORGIO BRUTINI will be amended to delete "... and other men's accessories, namely handbags" in compliance with the provisions of section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT MONTREAL, QUEBEC THIS 26TH DAY OF MARCH 2010.

P. Fung
Hearing Officer
Trade-marks Opposition Board