

TRADUCTION/TRANSLATION

SECTION 45 PROCEEDINGS
TRADE-MARKS: NEWLOOK
REGISTRATION NOS.: 318,999 and 433,436

At the request of Multi-Vision Publishing Inc., the Registrar forwarded Section notices to Look Magazine Enterprises SA [now CECE Suisse SA], the registered owner of the above-referenced trade-mark registrations. The notice that issued against Registration No. 318,999 covering the wares “imprimés, journaux et périodiques” is dated April 3, 2003. The notice that issued against Registration No. 433,436 covering the wares “magazines périodiques” is dated April 17, 2003.

Section 45 of the Trade-marks 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/or services listed on 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 use since that date.

In response to the notice the affidavit of Michel Birnbaum together with exhibits has been furnished in each case (for the most part the affidavits are identical). The registrant alone filed a written argument. Both parties were represented at the oral hearing.

At the hearing the requesting party indicated that there was no question that the trade-mark was in use during the relevant period. However, the requesting party questioned the affiant's knowledge with respect to the use of the trade-mark by the registrant or accruing to the registrant "Look Magazine Enterprises SA". Further, it argued that the use shown was not by and did not accrue to Look Magazine Enterprises SA.

Concerning the registered owner "Look Magazine Enterprises SA" Mr. Birnbaum has indicated in paragraph 5 of his affidavit that in December of 2001 it changed its name to CECE Suisse SA. Exhibit MB-1 was submitted to support Mr. Birnbaum's statement that a change of name had occurred. At the hearing, counsel for the requesting party argued that it was unclear whether the document furnished as Exhibit MB-1 showed a change of name or a transfer. He also argued that as the change occurred after the relevant three-year period, the registered owner for the present proceeding is still Look Magazine Enterprises SA.

Having considered the document furnished as Exhibit MB-1 I conclude that it does confirm that a change of name from Look Magazine Enterprises SA to CECE Suisse SA, and not a transfer, occurred in December of 2001. The change was recorded on the trade-mark registration page on December 2, 2005. Consequently, the registered owner remains the same entity but is now known as CECE Suisse SA.

Considering the use of the trade-mark what the evidence shows is that the registered owner has licensed another company the right to use and to sub-license the use of the trade-mark.

Exhibit MB-2 to the affidavit shows that Construction Etudes Commerce Electronique (CECE) is a licensee and Exhibit MB-3 shows 1633, SA is a sub-licensee.

In paragraph 11 of the affidavit, it is indicated that the registered owner controls the character and quality of the wares associated with the trade-mark used by the sub-licensee 1633, SA. Such statement made by Mr. Birnbaum concerning the licensed use and control is sufficient for the purposes of Section 45 proceedings to satisfy the requirements of s-s. 50(1) of the Trade-marks Act (see *Fitzsimmons, MacFarlane v. Caitlin Financial Corp. N.V.*, 79 C.P.R. (3d) 154, *Sim & McBurney v. Lesage Inc.*, 67 C.P.R. (3d) 571 and *Federated Department Stores, Inc. v. John Forsyth Co.*, 10 C.P.R. (4th) 571). Accordingly, I conclude that if the evidence shows use by 1633, SA such use would accrue to the registered owner pursuant to s. 50(1) of the Act.

Having considered the evidence I am satisfied that the use of the trade-mark as shown by the evidence is by 1633, SA. Mr. Birnbaum has clearly indicated that during the relevant period “1633, SA” has affixed the trade-mark NEWLOOK on the wares which wares were then sold in the normal course of trade and he has provided examples of such sales. The requesting party however argues that none of the publications submitted in evidence refer to “1633, SA”, that rather the reference therein is to “NEWLOOK, 13 rue du Cherche-Midi, 75006 Paris”. However, in the block of text appearing at the bottom of the first page of each publication it is clearly indicated the following: “NEWLOOK ... est une publication éditée par 1633, SA ... 13, rue du Cherche-Midi ...”. Therefore the name of the sub-licensee does appear in the publication.

Further, I accept that the reference to “NEWLOOK, 13 rue du Cherche-Midi, 75006 Paris” is a

reference to “1633, SA” considering that the address is that of the sub-licensee.

The requesting party has also questioned the capacity of Mr. Birnbaum to provide the evidence showing use accruing to the registered owner. However, as Mr. Birnbaum is “President Directeur Général” of 1633, SA and as he has attested that he has personal knowledge of the facts stated in his affidavit having reviewed the records of 1633, SA and CECE Suisse SA (the registered owner) this satisfies me that Mr. Birnbaum is competent to give evidence on behalf of the registered owner.

Having concluded that the use shown by the evidence is use accruing to the registered owner pursuant to s-s. 50(1) of the Act, I conclude that the trade-mark registrations ought to be maintained.

Registration Nos. 318,999 and 433,436 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 17TH DAY OF MARCH 2006.

D. Savard
Senior Hearing Officer
Section 45 Division