

**SECTION 45 PROCEEDINGS
TRADE-MARK: VALENTINO
REGISTRATION NO.: TMA 333,865**

On June 28, 1995, at the request of Messrs. Osler, Hoskin & Harcourt, the Registrar forwarded a Section 45 notice to Mario Valentino S.P.A., the registered owner of the above-referenced trade-mark registration.

The trade-mark VALENTINO is registered for use in association with the wares: (1) Leather or imitation leather accessories, such as bags, pocket books, wallets, purses, briefcases, articles of luggage, travel bags, key holders, belts.

In response to the Registrar's notice, the registrant furnished the affidavit of Vincenzo Valentino in the Italian language together with an English translation thereof. Each party filed a written argument and was represented at the oral hearing.

At the hearing, counsel for the requesting party submitted that the documents furnished by the registrant were inadmissible as the registrant had not submitted an affidavit by a translator attesting to the accuracy of the English translation of the foreign language document and it relied on Rule 302(1) of the Federal Court Rules, Consolidation, March 1993; (new Rule 1204 of Federal Court Rules 1998). Both parties made submissions on the matter and counsel for the registrant requested permission to file an affidavit by a person knowledgeable in both languages attesting to the accuracy of the translated document of record. The hearing was adjourned at both parties' suggestion. Once the affidavit in question was furnished, the requesting party informed the Registrar and the registrant that it was withdrawing its objection on the issue of the "admissibility" of the evidence. The oral hearing was reconvened on June 30, 1998, and again both parties were represented.

Concerning the evidence furnished, the requesting party argues that it is deficient in establishing use of the trade-mark VALENTINO in Canada in respect of the wares covered by the registration for several reasons:

It submits that it is unclear which trade-mark is being used by the registrant in that reference is made to two trade-marks, the trade-mark VALENTINO and MARIO VALENTINO and that some statements in the affidavit are clearly ambiguous as to whether the use mentioned is of VALENTINO or MARIO VALENTINO; concerning the invoices it states that they refer to the trade-mark MARIO VALENTINO and that nowhere on them is the trade-mark VALENTINO identified; concerning the photographs of the wares (Exhibit B), it submits there is no clear indication in the affidavit that these photographs are of the wares sold in Canada and further it submits that some of the wares bear the trade-mark MARIO VALENTINO or a trade-mark consisting of a V design.

It adds that even if the evidence was found sufficient, use has not been shown with each of the registered wares and further, it is unclear by whom the mark is being used.

Having reviewed the evidence, I agree that Mr. Valentino's affidavit is poorly drafted and I agree that it contains many shortcomings. Nevertheless, when the affidavit is read as a whole and when the evidence is considered in its entirety, I find it is sufficient, albeit barely, to permit me to conclude that the trade-mark VALENTINO was in use in Canada during the relevant period in association with the registered wares.

I agree that the fact that Mr. Valentino has provided evidence concerning two trade-marks namely VALENTINO and MARIO VALENTINO, rather than providing evidence of use only with respect to the trade-mark VALENTINO as required by the Section 45 notice, raises some concern. In particular, as argued by the requesting party, Mr. Valentino has chosen not to provide a breakdown by trade-mark and wares of the sales figures provided in paragraph 5 of his affidavit. Further, I agree that some of Mr. Valentino's statements are vague, keeping in mind that the affidavit refers to two trade-marks and considering that some of the wares referred to in the affidavit (namely footwear and clothing) are not wares covered by the present trade-mark registration..

However, I find the statements at paragraph 4 of his affidavit to be informative concerning use of the trade-mark VALENTINO. At paragraph 4, Mr. Valentino clearly

alleges that the trade-mark VALENTINO is used in respect of footwear (not covered by the registration) and leather and imitation leather accessories such as bags, pocket books, wallets, purses, brief cases, articles of luggage, travel bags, key holders and belts and he clearly states that “the trade-mark VALENTINO is used on the aforesaid goods, the relevant buckles and/or tags which are affixed to the VALENTINO products at the time of sale in Canada”.

With respect to this last statement, the requesting party submits that it is ambiguous and that it raises the question whether the trade-mark was affixed to the wares by the registrant or by some other entity in Canada. However, I tend to agree with counsel for the registrant that what Mr. Valentino is providing is a description of the manner the trade-mark VALENTINO is associated with the wares at the time of their sale in Canada, namely that the trade-mark appears on the wares themselves, on buckles and/or tags affixed to them. The photographs of the wares provided as Exhibit B appear to support such conclusion. The fact that some of the wares bear more than one trade-mark is not precluded by the Trade-marks Act.

The question, however, is whether the trade-mark VALENTINO was used in Canada in association with each of the wares mentioned in paragraph 4 of his affidavit during the relevant period.

In this regard, Mr. Valentino has stated in paragraph 3 of his affidavit that all of the wares covered by the trade-mark registration for VALENTINO have been in his company’s line of products for many years and have been sold within two years prior to the date of the notice. I agree with the requesting party that in that particular paragraph Mr. Valentino has not clearly specified that the products bore the trade-mark VALENTINO. However, I am of the view that such an inference can be made when the affidavit is read as a whole and when the evidence is considered in its entirety. For example, at paragraph 4 of his affidavit, where Mr. Valentino describes the business of the registrant, he clearly indicates that the trade-mark VALENTINO is used in association with the registered wares and footwear and he indicates the manner the trade-

mark VALENTINO appears in association with such wares when they are sold in Canada. Further the photographs of the wares (Exhibit B), clearly show the registered wares bearing the trade-mark VALENTINO either on tags, on buckles, and most often, in a repetitive pattern on the wares themselves. Concerning the copies of invoices from the years 1993-1995, Mr. Valentino has stated that “they show sales of VALENTINO products” to Canadian clients and that they show sales in Canada for each of the products covered by the present trade-mark registration. Although I agree that the reference to “VALENTINO products” is vague, I find that giving it a fair reading within the context of the affidavit as a whole and particularly taking into consideration the photographs of the wares bearing the trade-mark and the clear allegation of use of the trade-mark VALENTINO with such wares, I am prepared to accept that the invoices have been submitted to show sales of the wares associated with the trade-mark VALENTINO. In my view, to conclude otherwise would be to assume that Mr. Valentino was seeking to mislead the Registrar and I can see no basis for reaching such a conclusion.

Consequently, as Mr. Valentino has stated that all of the products covered by the present trade-mark registration have been sold within two years prior to the date of the notice, and as the invoices confirm sales of such wares within the relevant period, and as the photographs show the trade-mark VALENTINO associated with such wares, I conclude, but not without difficulty, that the evidence when considered in its entirety shows use of the trade-mark VALENTINO in association with the registered wares during the relevant period.

I would add concerning the invoices, that the requesting party commented on the fact that at the top of the invoices, the trade-mark MARIO VALENTINO together with a design appears and that at the bottom thereof the space marked “trade marks used” was left blank. It then submitted that the only inference that could be made is that the wares sold were wares associated with the trade-mark MARIO VALENTINO rather than VALENTINO.

In my view, the fact that the words MARIO VALENTINO appear at the top of the invoices beside the registrant's name, Mario Valentino SPA, is not conclusive that the wares sold bore such trade-mark. The use of MARIO VALENTINO at the top of the invoices may also be as a trade-name. Concerning the fact that the space "TRADE MARKS USED:" at the bottom of the invoices was left blank on all invoices, I find this to be irrelevant.

The requesting party has also argued that use had not been shown in association with each of the wares. However, having reviewed each invoice, I was satisfied that sales of each of the wares have been shown. The invoices show sales of "bags with handle (registered wares bags)," "wallets (registered wares wallets, pocket books)," "purses," "attache case (registered ware briefcases)," "overnight case, hand-bags or grip (registered wares articles of luggage and travel bags)," key holders and belts.

In view of the evidence furnished, I conclude that the trade-mark registration ought to be maintained.

Registration No. TMA 333,865 will be maintained in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 21st DAY OF September, 1998.

Denise Savard
Senior Hearing Officer
Section 45