

SECTION 45 PROCEEDINGS
TRADE-MARK: MOSQUITOS
REGISTRATION NO: TMA 379,320

On May 25, 2005, at the request of Vanessa Fhima (the “requesting party”), the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) to Mosquitos Commercial Et Style SAS, the registered owner of registration No. TMA 379,320 for the trade-mark MOSQUITOS (the “Mark”). The Mark is registered for use in association with “hand-bags, portfolios, document-cases, trunks, travelling-bags, saddles and harnesses for horse-back riding, all of leather and imitation leather, umbrellas; footwear, namely, shoes, boots, and slippers; clothing namely, trousers, lumber-jackets, jackets, skirts and pants; hosiery, stockings, blouses, coats, hats, gloves, ties and belts”.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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 this case, the relevant period for showing use is any time between May 25, 2002 and May 25, 2005.

“Use” in association with wares is set out in subsections 4(1) and 4(3) of the *Trade-marks Act*:

- (1) A trade-mark is deemed to have been 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 use in Canada in association with those wares.

In this case, only subsection 4(1) of the *Act* applies.

In response to the Registrar's notice, the registered owner furnished the affidavit of Patrick Engler, Managing Director of Mosquitos Commercial et Style SAS. The requesting party filed a written argument. Neither party requested an oral hearing.

As a preliminary matter, the requesting party submitted in its written argument that the affidavit is not a proper affidavit since the notary is not a person authorized to take oaths and attests only to the authenticity of the affiant's signature. I note that the affidavit was sworn in Paris, and that it clearly states that the notary is a "Notary Public or Commissioner for Oaths", which appears together with its seal. Based on this information, I am prepared to accept the affidavit as being properly sworn.

Mr Engler states that "prior to July 2005 my company manufactured shoes, boots, and slippers, to Canadian customers" and that "since July 2005, my company has contracted out the manufacturing of its goods". He further states that the registered owner sells such goods to its customers in Canada. He attaches as Exhibit "A" five invoices and accompanying shipping slips that show sales of ladies' boots and shoes to a Canadian customer during the relevant period. I note that the evidence is silent with respect to the remaining wares listed in the registration and as such those wares will be expunged from the registration.

There is no mention in the affidavit that the Mark appeared on the wares at the time of transfer. I note that the word MOSQUITOS appears in the top left-hand corner of the invoices along with the additional words "Commerical Style SAS" printed below it, with all this reading matter surrounded by a shaded box.

The use of a trade-mark on an invoice may or may not be considered use in association with wares described in the invoice. The major consideration is whether the trade-mark is being used as a trade-mark in describing the wares contained in the invoice and, as such, whether appropriate notice of such use is being given to the transferee of the wares. Whether use of a trade-mark on an invoice is use as a trade-mark in association with wares is most often decided on its position on the invoice. If a trade-mark is placed at the top of the invoice, with no use in the body of the invoice, the use will not generally be in association with the invoiced wares (see. *Moffat & Co. v. Conagra, Inc.* (1993), 52 C.P.R. (3d) 564 (T.M.O.B.); *Sterling & Affiliates v. A.C.B. Dejac SA* (1994), 58 C.P.R. (3d) 540 (T.M.O.B.). In the present case I consider that the Mark at the top of the invoices, in the context in which it appears, would be perceived by the consumer as part of the owner's trade-name and would more likely identify the corporate vendor than the wares.

Given the absence of evidence showing a clear association of the Mark with the wares I cannot conclude that use has been shown in this case.

In view of all the foregoing, it is my conclusion that registration no. TMA 379,320 for the trade-mark MOSQUITOS ought to be expunged in compliance with the provisions of subsection 45(5) of the *Act*.

DATED AT GATINEAU, QUEBEC, THIS 19th DAY OF MARCH 2008

C. Laine
Junior Section 45 Hearing Officer
Trade-marks Opposition Board