



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

**Citation: 2014 TMOB 79  
Date of Decision: 2014-04-10**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by 1471706 Ontario Inc. against registration  
No. TMA717,956 for the trade-mark MOMO DESIGN in  
the name of Momo Design s.r.l.**

[1] At the request of 1471706 Ontario Inc. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 16, 2011 to Momo Design s.r.l. (the Registrant), the registered owner of registration No. TMA717,956 for the trade-mark MOMO DESIGN (the Mark).

[2] The Mark is registered for use in association with the following wares and services:

WARES: Body soaps, perfumery, cosmetics, namely eye-shadow, eye-liner, rouge, mascara, lipstick, lip liner, face powder, foundation cream, night and day cream, body cream; essential oils for personal use, deodorants for personal use, hair shampoos; paper, cardboard and goods made of these materials, namely, letterhead paper, business paper, art paper, packaging paper, gift paper, printed paper, absorbent paper, advertising display boards of paper or cardboard, advertising materials made of paper, boxes and cartons made of paper or cardboard, packaging cases and bags made of paper, envelopes, business cards made of paper, drying towels made of paper, table napkins and tablecloths made of paper; paper handkerchiefs; printed matters, namely, printed labels, printed luggage labels, printed invitations, printed greeting cards, printed advertising material, calendars, maps; books regarding sport; photographs; stationery, namely pens and pencils, pen-holders, pencil-holders, rubber erasers, notebooks, diaries, address books, binders, paper-knives, staplers and folders; adhesives for stationery and household purposes; office requisites (except furniture), namely, adhesive tape dispensers, desk sets, staple removers; indoor aquaria; seals, namely, seals for envelopes and packaging material, office seals and sealing stamps; smokers' articles, namely cigar lighters, wax

matches, matches; match, cigar and cigarette case and holders not of precious metal, ashtrays for smokers not of precious metal, cigar cutters; pipes and pipe cleaners, pocket machines for rolling cigarettes not of precious metal.

SERVICES: Industrial design; product and packaging design; trademark design and study; architectural design and study of outlet interiors and exhibition places; interior design; dress designing; engineering in the field of goods industrialization and prototype development.

[3] Section 45 of the 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 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.

[4] In this case, the relevant period for showing use is between November 16, 2008 and November 16, 2011.

[5] The relevant definitions of “use” are set out in sections 4(1) and 4(2) 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.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Roberto Mayer, Vice-President of the Registrant, sworn on June 8, 2012 in Italy. Both parties filed written representations; an oral hearing was not held.

#### Evidence of use

[7] In his affidavit, Mr. Mayer attests that, during the relevant period, the Registrant sold “diaries, binders, pencil cases/holders, cigar lighters, cigar cases and holders not of precious metal, notebooks and folders” in Canada in association with the Mark. He attests that such wares

were sold to various customers in Canada directly by the Registrant or through its Canadian distributor, Grand Prix Import of Montreal, Quebec.

[8] In support, Mr. Mayer attaches the following two exhibits to his affidavit:

- Exhibit A consists of photographs which Mr. Mayer attests are a representative sampling of the aforementioned products sold in Canada during the relevant period. The photographs are of cigar lighters, diaries, a cigar holder and case, a pencil case and a notebook. I note that some of the photographs are of poor quality, but I am prepared to accept, as attested to by Mr. Mayer, that the Mark is displayed directly on the products themselves.
- Exhibit B consists of a single three page invoice dated September 14, 2010, which Mr. Mayer attests is “representative of the type of invoices issued by [the Registrant] to its Canadian distributor [Grand Prix Import]” during the relevant period regarding sales of products bearing the Mark. Although the product descriptions are in Italian, handwritten above some of the “MOMODESIGN” items are English translations. In addition to several other products not forming part of the statement of wares, the invoices identify “pencil case”, “cigar case” and “work books/exercise books”.

[9] The invoice is the only supporting documentation regarding wares bearing the Mark sold in Canada, although Mr. Mayer does attest that the Registrant also sold “notebooks, binders, folders and diaries” in association with the Mark during the relevant period in Canada through its licensee, Cartiere Paolo Pigna S.p.A.

[10] Notably, Mr. Mayer makes no statements regarding volumes of sales or dollar value of sales in Canada during the relevant period with respect to any of the wares. The only evidence of transfers beyond Mr. Mayer’s mere assertion that the Registrant sold some of the wares in Canada during the relevant period is the single invoice at Exhibit B. While Mr. Mayer states that the invoice is “representative”, he provides no evidence of actual transfers in the normal course of trade with respect to diaries, binders, folders or cigar lighters.

[11] 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 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with *each* of the wares specified in the registration during the relevant period.

[12] Evidence of a single sale *may* be sufficient to establish use of a trade-mark in the normal course of trade, depending on the circumstances surrounding the transaction. As stated in *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at 293:

Evidence of a single sale, whether wholesale or retail, in the normal course of trade may well suffice so long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration of the trade mark.

[13] However, in *Guido Berlucci & C Srl v Brouillette Kosie* (2007), 56 CPR (4th) 401 (FC), the Federal Court stated the following at paragraph 20:

...if a registered owner chooses to produce evidence of a single sale, he is playing with fire in the sense that he must provide sufficient information about the context of the sale to avoid creating doubts in the mind of the Registrar or the Court that could be construed against him.

[14] Applied to this case, although Mr. Mayer repeatedly asserts that the identified wares were sold in Canada, either by the Registrant directly, through its distributor, or through its licensee, he provides no particulars to allow me to conclude that transfers of diaries, binders, folders or cigar lighters actually occurred in Canada during the relevant period in the normal course of trade. This is not to say that the Registrant was obligated to provide invoices showing sales of such wares – although given the small number of wares the Registrant alleges use for, it would not have been evidentiary overkill to do so. Rather, in the absence of invoices, the Registrant should have been prepared to furnish evidence regarding volumes of sales, dollar value of sales or equivalent factual particulars to allow the Registrar to conclude that transfers in the normal course of trade actually occurred in Canada with respect to *each* of these wares. In the absence

of particulars, Mr. Mayer's statements amount to mere assertions of use only, rather than statements of fact showing use, at least with respect to "diaries", "binders", "folders" and "cigar lighters".

[15] As it is, one is left in the dark regarding whether there is any basis to Mr. Mayer's assertion of use with respect to the wares for which no invoices were produced.

[16] Similarly, although he asserts that certain wares were also sold in Canada through the Registrant's licensee, Cartiere Paolo Pigna S.p.A., Mr. Mayer provides no particulars to indicate that such sales actually took place. The only documentary evidence he provides is a page from the licensee's catalogue, which in itself is insufficient to show actual transfers of wares bearing the Mark during the relevant period in Canada.

[17] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark only in association with "stationery, namely ... pencil-holders ... notebooks" and "cigar ... case and holders not of precious metal", within the meaning of sections 4 and 45 of the Act.

[18] With respect to the registered services, the Registrant furnishes no evidence of use nor does it provide evidence of special circumstances excusing non-use of the Mark. The registration will be amended accordingly.

#### Special Circumstances

[19] With respect to the remaining wares, the Registrant submits that there were special circumstances excusing non-use. Generally, a determination of whether there are special circumstances involves consideration of three criteria: the first is the length of time during which the trade-mark has not been in use, the second is whether the reasons for non-use were beyond the control of the registered owner, and the third is whether there exists a serious intention to shortly resume use [per *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)].

[20] The Federal Court of Appeal offered further clarification with respect to the interpretation of the second criterion, with the determination that this aspect *must* be satisfied in order for there to be a finding of special circumstances excusing non-use of a trade-mark [*Smart & Biggar v*

*Scott Paper Ltd* (2008), 65 CPR (4th) 303 (FCA)]. In other words, the other two factors are relevant but, considered by themselves in isolation, they cannot constitute special circumstances. Lastly, the intent to resume use must be substantiated by the evidence [see *Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD); *NTD Apparel Inc v Ryan* (2003), 27 CPR (4th) 73 (FCTD)].

#### Length of time of non-use

[21] Generally, where a date of last use is not provided or is inapplicable as in the present case, the Registrar considers the date of registration as the relevant date for purposes of assessing the length of non-use [see *Clark, Woods v Canaglobe International Inc* (1992), 47 CPR (3d) 122 (TMOB); *Oyen Wiggs Green & Mutala LLP v Rath* (2010), 82 CPR (4th) 77 (TMOB)]. In the present case, the Mark was registered on July 4, 2008 (based on a claim of foreign use and registration pursuant to section 16(2) of the Act), whereas the section 45 notice was issued on November 16, 2011, amounting to just over three years after the date of registration.

#### Reasons for non-use

[22] With respect to the question of whether the reasons for non-use were beyond the control of the Registrant, Mr. Mayer attests that since the registration of the Mark, the Registrant “has aggressively pursued its efforts to secure a distributor/licensee in Canada in order to sell the rest of the [registered wares] without any success. This has been due to an over-saturation in the Canadian market and, more recently, due to an economic downturn in Canada’s marketplace.”

[23] However, I note that poor or unfavourable market conditions are generally not considered special circumstances excusing non-use [see *Harris Knitting, supra*; *Rogers, Bereskin & Parr v Registrar of Trade-marks* (1987), 17 CPR (3d) 197 (FCTD); *Lander Co Canada Ltd v Alex E Macrae & Co* (1993), 46 CPR (3d) 417 (FCTD)]. Similarly, in cases where the registered owner had no intent to abandon their trade-mark in Canada, but lacked any orders from Canadian customers during the relevant period, this was not in itself sufficient to maintain the registration [see *Garrett v Langguth Cosmetic GMBH* (1991), 39 CPR (3d) 572 (TMOB)].

[24] In any event, in the absence of particulars regarding the Registrant's unsuccessful efforts to secure a distributor/licensee in Canada during the relevant period, I am unable to determine if the reasons cited by Mr. Mayer were within the Registrant's control or otherwise.

[25] Mr. Mayer does provide evidence of two "worldwide" license agreements that the Registrant entered into in June 2011. The first agreement is with an Italian company, Extraordinary Fragrance s.r.l. and covers a line of fragrances, deodorants and body lotions. The second agreement is with another Italian company, Delta s.r.l., and covers a line of writing instruments. In both cases, he attests that sales have commenced in either Italy or the United States, "with a Canadian launch expected shortly". Again, however, absent further particulars, this would actually indicate that the Registrant and/or its licensees made the voluntary decision to prioritize other markets before Canada.

#### Serious intention to resume use

[26] Similarly, with respect to the third criterion, one is left in the dark regarding how long the duration of non-use will persist. Mr. Mayer simply attests that the Registrant has "attempted to secure a distributor/licensee with respect to the remaining wares ... by contacting various distributors and licensees in both Canada and Italy as well as by continuously monitoring the viability of the Canadian marketplace."

[27] However, aside from "shortly" in relation to the two aforementioned license agreements, Mr. Mayer otherwise provides no particulars or indication as to when use of the Mark is likely to commence in Canada with respect to the remaining wares.

[28] In view of all of the foregoing, I am not satisfied that the Registrant has demonstrated special circumstances excusing non-use of the Mark during the relevant period.

#### Disposition

[29] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in accordance with section 45 of the Act, the registration will be amended to delete the services and all of the wares except "pencil-holders", "notebooks" and "cigar case and holders".

[30] The amended statement of wares will be as follows: “Stationery, namely pencil-holders, notebooks; cigar case and holders not of precious metal”.

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Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office