



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

**Citation: 2014 TMOB 231**  
**Date of Decision: 2014-10-29**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by 1655453 Ontario Inc., dba Bizoux Bizoux  
against registration No. TMA503,518 for the trade-mark  
BISOU-BISOU in the name of Fashion Brands Holding  
Corporation**

[1] At the request of 1655453 Ontario Inc., dba Bizoux Bizoux (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 August 8, 2012 to Fashion Brands Holding Corporation (the Owner), the registered owner of registration No. TMA503,518 for the trade-mark BISOU-BISOU (the Mark).

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

- (1) Clothing, namely, jackets, pants, shirts, dresses, t-shirts, skirts, suits, hats, shoes, belts.
- (2) Women's sportswear, namely, pants, skirts; women's dresses.
- (3) Junior women's sportswear, namely, pants, skirts; women's dresses.
- (4) Girls' sportswear, namely, pants, skirts; girls' dresses.
- (5) Men's sportswear, namely, pants.
- (6) Young men's sportswear, namely, pants.
- (7) Boys' sportswear, namely, pants.
- (8) Women's, men's and children's footwear, namely, boots, shoes, sandals, slippers, infant footwear, athletic footwear, beach footwear, outdoor winter footwear, rain footwear, exercise footwear, fishing footwear, golf footwear, ski footwear, evening footwear, formal footwear, bridal footwear, protective footwear, safety footwear, orthopaedic footwear, footwear for medical personnel and novelty footwear
- (9) Fashion accessories, namely, belts; hats.

[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 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 between August 8, 2009 and August 8, 2012.

[4] The relevant definition of “use” is set out in section 4(1) 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although evidentiary overkill is not required [*Union Electric Supply Co v Canada (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. Further, use of a trade-mark cannot be established in relation to wares through the mere advertising or distribution of promotional materials [see, for example, *Gowling & Henderson v John Morton Ltd* (1992), 47 CPR (3d) 268 (TMOB)].

[6] In response to the Registrar’s notice, the Owner filed the affidavits of Marc Bohbot, sworn on February 18, 2013, and Lee Ewing, sworn on February 26, 2013. Only the Requesting Party filed written representations; an oral hearing was not held. As part of its written representations, the Requesting Party submitted what appears to be a sworn statement of its President, Martine Guay. To the extent Ms. Guay’s statement asserts facts not in evidence and attaches two exhibits, I have disregarded it.

[7] For the reasons set out below, the registration will be maintained with respect to “Clothing, namely ... pants” only.

The Owner's Evidence – Affidavit of Marc Bohbot

[8] In his affidavit, Mr. Bohbot identifies himself as the Chief Executive Officer of the Owner, a Nevada corporation that manages and administers the Mark in the United States and Canada. He further attests that he is also the owner and controlling principal of the related company Vintage Brand, which manufactures and distributes clothing, footwear and fashion accessories under license from the Owner.

[9] Mr. Bohbot asserts that the Mark is used in association with a variety of clothing, footwear and fashion accessories designed by the Owner and sold in Canada, including “jackets, pants, shirts, dresses, t-shirts, skirts, suits, swimwear, handbags, jewelry, hats, shoes, and belts”.

[10] More specifically, he attests that BISOU-BISOU clothing has been sold in Canada since at least as early as 1990 and that such clothing bore the Mark in the form of labels and hang tags affixed at the time of purchase. Attached as Exhibit A to Mr. Bohbot's affidavit is a copy of a representative label displaying the Mark.

[11] Mr. Bohbot attests that since 1992, the Owner and its predecessors have sold BISOU-BISOU clothing in Canada via the retail store WINNERS. Attached as Exhibit B to his affidavit are representative invoices dated June 11, 2012 for the sale of BISOU-BISOU jeans from the Owner's distributor and licensee, Vintage Brand, to WINNERS in Canada. The invoices total over \$85,000 in value.

[12] Accordingly, in view of Exhibits A and B, I am satisfied that the Owner has demonstrated use of the Mark in association with “Clothing, namely ... pants” within the meaning of sections 4 and 45 of the Act.

[13] However, the evidence of actual transfers within the relevant period is limited to pants and I do not consider such evidence to be representative with respect to any of the other registered wares. Although Mr. Bohbot asserts use of the Mark more broadly, the remainder of his affidavit amounts to evidence of advertising only.

[14] For example, Mr. Bohbot attaches, as Exhibit D to his affidavit, representative printouts from the website *www.jcpenney.com*, advertising BISOU-BISOU clothing. He explains that,

from 2003 to 2011, J.C. Penney Corporation, Inc. manufactured and sold BISOU-BISOU clothing in Canada, under license from the Owner. He confirms that under the terms of this license, the Owner maintained direct or indirect control over the character and quality of the BISOU-BISOU clothing manufactured and sold by J.C. Penney. However, he does not provide evidence of any transfers or sales in this respect. Such evidence is left to Mr. Ewing's affidavit, discussed below.

[15] Mr. Bohbot also attaches, at Exhibits C and E, printouts from the Owner's own website, *www.bisoubisou.com*, that Mr. Bohbot attests has been accessible to Canadians since 1997. He attests that, since 2003, the website has had "in excess of 7,000 visits from Canadian IP addresses". Exhibit C consists of printouts showing various BISOU-BISOU clothing items; Exhibit E consists of printouts showing various magazine articles that featured BISOU-BISOU clothing.

#### Owner's Evidence – Affidavit of Lee Ewing

[16] In his affidavit, Mr. Ewing identifies himself as a supply chain specialist at J.C. Penney Corporation, Inc. He confirms that until 2011, J.C. Penney was licensed by the Owner and its predecessors to manufacture and sell clothing, footwear and fashion accessories bearing the Mark in Canada.

[17] More specifically, he asserts that "J.C. Penney sold BISOU-BISOU clothing (including jackets, pants, shirts, dresses, t-shirts, skirts, suits, swimwear, handbags, hats, shoes and belts to Canadians via the J.C. Penney Website from 2003 to 2011."

[18] In support of this assertion, attached as Exhibit 2 to his affidavit are printouts from the J.C. Penney website showing a variety of BISOU-BISOU clothing items available for purchase. I note that the pages all bear a copyright notice date of 2012 and appear to have been printed on December 20, 2012.

[19] As evidence of sales, Mr. Ewing attaches, as Exhibit 3 to his affidavit, "a spreadsheet summarizing the catalog and online sales of BISOU-BISOU clothing sold to customers in Canada by J.C. Penney from 2003-2010". The spreadsheet consists of over 20 pages of line

items showing aggregate sales of various items over various time periods. While Mr. Ewing confirms that some of the line items show a code identifying them as a BISOU-BISOU item, he fails to identify the particular ware that each line represents. Further, no codes appear on the spreadsheet that would allow me to connect any of the sales data with any of the clothing items shown in the Exhibit 2 webpages or referred to in Mr. Bohbot's affidavit.

[20] This is compounded by the fact that most of the line item sales data are for time periods that are either partially or entirely before the relevant period. As such, it is not clear which of the registered wares, if any, were sold by J.C. Penney in association with the Mark during the relevant period. Such ambiguities must be resolved against the registered owner [per *Plough, supra*].

[21] Despite the affiants' assertions with respect to a variety of clothing, footwear and accessories, the only clear evidence of sales or transfers of BISOU-BISOU clothing during the relevant period are with respect to the sale of jeans to Winners in 2011. In view of the foregoing, I cannot conclude that the Owner has demonstrated use of the Mark in association with any of the remaining registered wares within the meaning of sections 4 and 45 of the Act.

[22] Furthermore, there is no evidence of special circumstances before me excusing non-use of the Mark.

#### Disposition

[23] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete all of the wares with the exception of "pants" in wares (1). The amended statement of wares will be as follows: "Clothing, namely, pants".

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