

TRADUCTION/TRANSLATION

SECTION 45 PROCEEDING
TRADE-MARK: BOG
REGISTRATION NUMBER: LMC551772

On September 28, 2005, at the request of Smart & Biggar, the Registrar forwarded a notice pursuant to section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Mr. Idir Boussad carrying on business under the company name Collection Bagus Inc., owner of the trade-mark BOG (the Mark) referred to in the certificate of registration LMC551772 in association with the following:

jewellery made of gold, silver, pewter, leather, copper, namely bands, rings, earrings, bracelets, brooches, chains, necklaces, pendants. All of the said jewellery including precious, semi-precious and artificial stones; clothing, namely dresses, pants, shirts, skirts, wraparound skirts, beach wraps, vests, jackets, coats, T-shirts, sweaters, hose, underclothing, raincoats, culottes, shorts; accessories, namely belts, scarves, gloves, hats, toques, peak caps, shoes, boots, hand bags, backpacks, suitcases, mats, perfumes, toilet waters; eyeglasses, namely frames, lenses (the Wares).

Section 45 of the Act requires the registered owner of a trade-mark to show that it was in use in Canada in association with each of the wares and/or services specified in the registration at any time during the three year period immediately preceding the date of the notice and, if not, to furnish the date when it was last so in use and the reason for the absence of such use since that date. The relevant period in this case is between September 28, 2002, and September 28, 2005 (the relevant period).

In response to the notice, Mr. Idir Boussad furnished a statutory declaration together with Exhibits P-1 to P-6. The parties did not file written argument and did not request a hearing.

In his declaration, Mr. Boussad describes himself as a businessman [TRANSLATION] “carrying on business under the company name COLLECTION BAGUS INC.” He is the president and sole shareholder of Collection Bagus Inc. and submitted an excerpt from the Enterprise Register to support his statements. The excerpt confirms that this company was incorporated in December 1998. Last, he states, and this is corroborated by the excerpt from the Enterprise Register, that Collection Bagus Inc. has been operating a business under the corporate name ROUT’ART since July 13, 2005.

Both the description of the owner of the Mark in the register of trade-marks and the description in Mr. Boussad’s affidavit leaves us perplexed as to the identity of the owner of the Mark. The Registrar does not believe that he has jurisdiction, in a proceeding as summary as the one set out in section 45 of the Act, to invalidate a registration on the basis of an ambiguity in the register as to the identity of the owner of the Mark. For purposes of this case, I infer that it is Mr. Boussad personally who is the owner of the Mark and that the reference in the register of trade-marks to his company and to the description of the owner of the Mark is merely superfluous.

At paragraph 3 of his statutory declaration, he states that the Mark was in use by him and by his company during the three year period immediately preceding the date of his declaration (December 28, 2005) with respect to each and every one of the Wares. This statement in itself is not sufficient to establish use of the Mark under section 4 of the Act [see *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (4th) 62].

To support his submissions, he furnished photographs of the interior of one of the establishments operated by Collection Bagus Inc. showing some of the Wares to which labels are affixed bearing the Mark and the notation “Collection Bagus Inc.”. In some of the photographs, we can see various kinds of jewellery on display shelves as well as labels bearing the Mark.

He also submitted a purchase order, Exhibit P-4, dated November 2005, but this date is after the relevant period. He furnished copies of business cards on which the Mark does not appear and two copies of labels bearing the Mark that are in some of the submitted photographs. The last Exhibit, P-6, consists of confirmations of bundled orders dated May 14, 2001, and November 2005. These documents cannot be considered since they were issued outside of the relevant period. I will comment in more detail on the one from November 2005 a little later in my decision.

However, Collection Bagus Inc. is not the entity that owns the Mark. Thus, I may conclude, for purposes of this proceeding, that any use of the Mark, if there has been any, by Collection Bagus Inc. constitutes a use that accrues to Mr. Boussad by operation of section 50 of the Act.

As mentioned previously, Mr. Boussad describes himself as the president and sole shareholder of Collection Bagus Inc. In *Smart & Biggar v. Powers* (2001), 16 C.P.R. (4th) 276, Ms. Denise Savard wrote as follows:

As Mr. Powers has explained that he is President and sole shareholder of Flying Jewels Inc. and the only employee thereof, I conclude, based on the comments of the Court in *Lindy v. Canada (Registrar of Trade Marks)* [1999 CarswellNat 652 (Fed. C.A.)], decision of the Federal Court of Appeal dated April 22, 1999, Docket No. A-189-81, that an inference may be drawn from the facts stated in the

declaration to the effect that the company used the mark under oral licence from Mr. Powers or under an arrangement that was tantamount to an oral licence and that the mark remained under his direct control. Consequently, I am prepared to conclude that the sales made by A&P in 1996 and 1997 accompanied by the label attached as Exhibit A, show use of the trade-mark by Flying Jewels Inc. which use accrue to the registered owner pursuant to Section 50 of the Act.

Applying these principles to this case, I infer, based on the connection between Mr. Boussad and the company Collection Bagus Inc., that the company had an implied licence authorizing it to use the Mark in association with the Wares, subject to the standards of control and quality established by the owner of the Mark, in accordance with the provisions of section 50 of the Act. Thus, any use of the Mark by Collection Bagus Inc. is deemed to be a use of the Mark by its owner, Mr. Boussad.

However, is there evidence of use of the Mark in association with each of the Wares within the meaning of section 4(1) of the Act? At the outset, I note that neither the photographs nor the purchase orders, even if they were admissible in evidence, refer to the following Wares:

Vests, jackets, coats, T-shirts, hose, underclothing, raincoats, culottes, shorts; gloves, hats, peak caps, shoes, boots, suitcases, mats, perfumes, toilet waters; eyeglasses, frames and lenses.

I note that plastic and rubber sandals are visible in some of the photographs, but I do not consider these wares to be shoes in the usual sense. Subject to the following, the certificate of registration would, at the very least, have to be amended to exclude these wares.

The certificate of registration covers wares, not services. Accordingly, the owner must prove that there was at least one commercial transaction involving each of the Wares during the three year

period immediately preceding the notice under section 45 and that at the time of transfer of the property, the Mark was marked on a label or on the wares that were sold. The photos themselves do not constitute evidence of use of the Mark within the meaning of section 4(1) of the Act. There is no evidence of a commercial transaction during the relevant period showing that there was a transfer of the property in the wares bearing the Mark. As for the documentary evidence, not only does it not attest to any transfer of property in the wares from the owner of the Mark to a third party, but it is also inadmissible since it deals with events outside of the relevant period. The lack of relevant evidence is therefore fatal for the owner of the Mark.

It remains to be determined whether the owner furnished explanations that could constitute special circumstances within the meaning of section 45(3) of the Act to excuse the non-use of the Mark during the relevant period. Mr. Boussad stated the following in paragraph 5 of his affidavit:

[TRANSLATION]

5. Some of the wares, such as shoes, boots and sandals or eyeglasses, are more important in the displays depending on the seasons and the fashion, and, on this point, I am filing a purchase order for shoes for next season, all of which appears in the said purchase order filed as Exhibit P-4.

This allegation might excuse the absence of these wares in the photographs that were filed, but certainly not the lack of evidence of use of the Mark in association with these wares within the meaning of section 4 of the Act during the relevant period. I do not consider these explanations to be special circumstances excusing the non-use of the Mark. The owner of the Mark could very well also have filed evidence attesting to the transfer of the property in these wares during the relevant period.

Since the owner of the Mark has not discharged his burden of proof, I conclude that the registration of the Mark should be expunged.

The registration number TMA551772 will be expunged in accordance with subsection 45(5) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, JULY 18, 2008.

Jean Carrière,
Member of the Trade-Marks Opposition Board

Certified true translation
Mary Jo Egan