

**TRADUCTION/TRANSLATION**

**SECTION 45 PROCEEDING**

**TRADE-MARK: DANS UN JARDIN AND DESIGN**

**REGISTRATION NUMBER: TMA378925**

On July 21, 2004, at the request of Brouillette Kosie Prince, the Registrar sent a notice pursuant to section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Dans un Jardin Inc. (current owner), owner of the trade-mark contemplated by the above-mentioned registration.

The trade-mark DANS UN JARDIN and design (the Mark) as illustrated hereunder



is registered in association with the following services: operation of boutiques specializing in the sale of bath and perfume products (the Services).

Section 45 of the Act requires the registered owner of a trade-mark to establish the use of the Mark in Canada in association with each of the wares and/or each of the services specified in the registration, at any time during the three year period immediately preceding the date of the notice and, if not, to provide 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 from July 21, 2001, to July 21, 2004.

In response to the notice, the current owner provided the solemn declaration of Gilles Sansregret as well as exhibits A to M. The parties filed written arguments and were represented at the hearing.

In his declaration, Mr. Sansregret identifies himself as the president of the current owner of the Mark. From the allegations and the evidence files, there is no doubt that the trade-mark illustrated below:



(referred to for purposes of this matter as the modern mark)

had been used in Canada within the meaning of section 4 of the Act during the relevant period in association with the Services. Indeed, this is admitted by the applicant at paragraph 11 of its written arguments. This is the reason why it is useless for the purposes of this decision to review this overwhelming evidence. However, the objective of this proceeding is not to determine whether there was use of the modern mark but rather of the Mark. I would add that Mr. Sansregret also referred to the following mark in his affidavit (paragraph 13 of his affidavit and exhibit C):



(hereinafter referred to as the modified mark)

This matter raises the three following questions:

- (1) Does the use of the modern mark qualify as use of the Mark?

- (2) Can the use of the modified mark qualify as use of the Mark?
- (3) If question 2 is answered in the affirmative, can we find there was use of the modified mark within the meaning of subsection 4(2) of the Act?

It would not be necessary to answer questions 2 and 3 set out above if the first question is answered in the affirmative.

By way of introduction, the applicant points out that the purpose of the proceeding under section 45 of the Act is to eliminate “deadwood” from the register, i.e. any unused or obsolete trade-marks. There does not appear to be any disagreement between the parties on this point. However, the applicant contends that the use of the modern mark cannot qualify as use of the Mark within the meaning of section 4 of the Act because certain aspects of the Mark that it considers determinative are absent from the modern mark, i.e.:

- The words “boutiques” and “beauté”
- The expression “Parfumeur à Paris”

The applicant adds that these words and expressions were replaced by other words or expressions:

- “Parfumeries” and “les sens et les soins”

Also, the use of “parfumeries” instead of “boutique beauté” changes, in its opinion, the meaning of the worded part of the Mark. Finally, the applicant argues that leaving the Mark on the register would have the effect of confirming the monopoly of the current owner on the words “boutiques” and “beauté”, which were not the subject of a disclaimer when the Mark was registered.

For the current owner of the Mark, we find predominant aspects of this Mark in the modern mark, i.e.:

- The round form of the graphic
- The basket and the flowers
- The expression “Dans un jardin” in bold letters

It points out that we also find in the modern mark the word “Paris”, an element however qualified as secondary.

Finally, the use of the word “Parfumeries” instead of “Parfumeur” would not change the meaning of the Mark.

For the current owner, maintaining the Mark on the register does not at all affect third party rights to use the words “boutiques” and “beauté” because the registration of the Mark confers to the current owner the exclusive use of the Mark as a whole and not of its individual components.

It goes without saying that each case turns on its own facts when it is a matter of determining whether the modifications to a graphic mark have resulted in the loss of distinctiveness of the registered mark. I refer to the following passage of the often cited *Promafil Canada Ltée. v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59, where Mr. Justice MacGuigan of the Federal Court of Appeal states:

The law must take account of economic and technical realities. The law of trademarks does not require the maintaining of absolute identity of marks in order to avoid abandonment, nor does it look to miniscule differences to catch out a registered trademark owner acting in good faith and in response to fashion and other trends. It demands only such identity as maintains recognizability and avoids confusion on the part of unaware purchasers.

[Emphasis added.]

The current owner pointed out at the hearing that the Federal Court of Appeal in *Alibi Roadhouse Inc. v. Grandma Lee’s International Holdings Ltd.* (1997), 76 C.P.R. (3d) 327, had maintained the registration of the registered mark reproduced hereunder despite several modifications and I reproduce hereunder the mark used:



**ALIBI**

I note that this matter was not a proceeding under section 45 of the Act but rather an application to have the registered mark expunged. When the Court addressed the issue of whether the use of the second graphic appearing above could qualify as a use of the registered mark (first graphic), Mr. Justice Teitelbaum's found as follows:

“However one must also consider the argument that the two marks are only slightly different and therefore the registered trade-mark was actually “used” in 1986. In *Promafil Canada Ltée v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (Fed. C.A.), the court considered whether a registered trade-mark which was used in a modified form constituted use. The court held that if the same dominant features are used with minor differences which would not confuse or deceive an unaware purchaser, then the registered mark is still being used. The court was concerned with whether the “continuing commercial impression remain [ed] the same.

...

Turning to the registered trade-mark, I note that the designs of the old and new marks are different. The registered trade-mark is predominantly diamond-shaped with the words “Alibi” dominating the upper two-thirds of the design. The words “Bar & Grill” are located in an oval-shaped figure beneath the word “Alibi”. This design is different than the respondent's old mark mentioned above.

Despite these differences, I believe that the dominant element in both marks is the word “Alibi”. That word is clearly the dominant feature of the old mark since the only accompanying feature of that mark is the bold underline. In the registered mark, “Alibi” dominates the centre of the design. Furthermore, the words “Bar” and “Grill” have been disclaimed and they are an insignificant feature of the mark. The existence of the other design features or ornamentations may make the registered trade-mark

more attractive but I do not find that they are dominant features of the mark. I cannot see how these deviations would cause injury or deception to the public or that they affected the “commercial impression.”

[Emphasis added.]

In this case, the form of the mark is reproduced as well as the predominant words, i.e. “DANS UN JARDIN”. The word “Paris” still appears there and the word “Parfumeur” is replaced by “PARFUMERIES”. This modification is negligible. The expression “BOUTIQUES BEAUTÉ” had been replaced by “LES SENS ET LES SOINS” even though their position is different. I note that all of these words are written in letters that are much smaller than the size used for “DANS UN JARDIN”.

Without quantifying the degree of the modifications made to the registered mark ALIBI and graphic appearing above in relation to those described above regarding the Mark, I can reasonably determine that the modifications to the Mark appear to me to be less substantial than the ones made to the registered mark ALIBI and graphic. A picture is worth a thousand words. Further, I cannot reasonably find that the modifications to the Mark could mislead consumers regarding the origin of the Services. Finally, I agree with the submissions of the current owner described above regarding the effects of maintaining the Mark on the register in relation to third party use of the words “boutiques” and “beauté”.

Under the circumstances, I find that the use of the modern mark qualifies as a use of the Mark within the meaning of section 4 of the Act.

Given the affirmative answer to the first question the other two need not be decided.

The registration of the Mark should not be expunged or amended. Therefore the registration bearing number TMA378925 will be maintained in the register in accordance with the provisions of subsection 45(5) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, JANUARY 28, 2008.

Jean Carrière,

Member of the Trade-Marks Opposition Board