



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

**Citation: 2012 TMOB 140**  
**Date of Decision: 2012-07-30**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by O'Brien TM Services Inc. against  
registration No. TMA582,517 for the trade-mark  
GRUPPO MASTROTTO & Design in the name of  
Gruppo Mastrotto S.p.A.**

[1] At the request of O'Brien TM Services 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 23, 2009 to Conceria Mastrotto S.P.A., the registered owner at that time of registration No. TMA582,517 for the trade-mark GRUPPO MASTROTTO & Design (the Mark), shown below:



[2] The Mark is registered for use in association with the following wares: (1) Electric accumulators, accumulator boxes; (2) Leather and imitation leather sold in bulk, animal skins and hides, fur pelts.

[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 November 23, 2006 and November 23, 2009 (the Relevant Period).

[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] In response to the Registrar’s notice, Gruppo Mastrotto S.p.A. (the Registrant), the current owner of the Mark, filed the declaration of Bruno Mastrotto, Vice President of the Registrant, sworn on June 16, 2010 in Italy. I note that the change in title was due to a merger, recorded by the Registrar on March 23, 2010. Both parties filed written representations; an oral hearing was not held.

[6] In his affidavit, Mr. Mastrotto provides no evidence of use of the Mark in association with wares (1) and no evidence of special circumstances excusing non-use were submitted. The registration will be amended accordingly.

[7] With respect to the remaining wares (2), Mr. Mastrotto attests that the Mark has been used in Canada since at least as early as June 15, 1989 in association with “leather and imitation leather sold in bulk, animal skins and hides, fur pelts”. He attests that products bearing the Mark are “distributed in Canada directly from Italy by the Registrant”. In support of his assertion of use, Mr. Mastrotto provides, at Exhibit B, six invoices showing sales from the Registrant to Canadian customers during the Relevant Period. He also attaches, as Exhibit C, labels that appeared on such goods shipped to Canada during the Relevant Period.

[8] I note that a variation of the Mark appears on the Exhibit C labels, with an additional red design element appearing above the stylized “M” as depicted below:



[9] A similar variation appears in the top left corner on the black-and-white Exhibit B invoices. In its written representations, the Requesting Party describes the additional element as resembling “a walking ghost figure”, whereas the Registrant, in its written representations, describes the additional element as a mere background to the Mark and identifies the shape more particularly as the international pictogram for leather.

[10] In any event, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I consider the addition of this background element to be a minor deviation from the Mark. In my view, the dominant features in this case are the words GRUPPO MASTROTTO and the stylized “M” design. As such, the identity of the trade-mark is preserved and the deviation would not, in my opinion, mislead an unaware purchaser.

[11] As noted by the Requesting Party, the invoices do not clearly identify the wares. The invoices are mostly in Italian, with some words in English, and the goods listed on each invoice appear to be identified by a number code. Mr. Mastrotto provides no explanation as to meaning of these codes. As such, the Requesting Party submits that it is not possible to ascertain what goods are claimed to be sold in Canada and, consequently, that the registration should be expunged entirely.

[12] Nevertheless, while the affidavit could have been more explicit, the evidence as a whole must be considered [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB) at 213] and reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)]. In this case, upon review of the invoices in conjunction with Mr. Mastrotto’s statements in his affidavit,

I find it reasonable to infer that the invoices do show sales of “leather and imitation leather sold in bulk” in Canada during the Relevant Period. In this respect, I note that in the product description section, two of the invoices display disclaimers stating, in part, that “the material here described was not made using *leather* parts of animal species protected by the Washington Convention” [emphasis added]. Furthermore, quantities are displayed in measurements of “M2”, which appears to stand for “meters squared”; these quantities and corresponding unit prices displayed on the invoices allow for an inference that the goods were being sold in bulk.

[13] In view of the foregoing, I find there was use of the Mark in association with “leather and imitation leather sold in bulk” during the Relevant Period within the meaning of sections 4 and 45 of the Act.

[14] With respect to “animal skins and hides” and “fur pelts”, however, I agree that there are no indicators to allow for an inference that any of the invoices show sales of such goods. In its written submissions, the Registrant submits that it has provided adequate examples of use for the general category of “fabric made from animal skins and hides” and that, therefore, the registration should be maintained for all the wares (2), as they all fall under that general category. However, I consider Mr. Mastrotto’s affidavit and accompanying invoices ambiguous as to whether the Registrant sold “animal skins and hides” and “fur pelts” in Canada during the Relevant Period. 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 the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)], and 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.

[15] Accordingly, I cannot conclude that the Registrant has demonstrated use of the Mark in association with “animal skins and hides, fur pelts” within the meaning of sections 4 and 45 of the Act. Furthermore, the Registrant has provided no evidence of special circumstances excusing the absence of such use.

Disposition

[16] In view of the foregoing, 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 the following wares: “(1) Electric accumulators, accumulator boxes; (2) ... animal skins and hides, fur pelts”.

[17] The amended statement of wares will accordingly read as follows: “leather and imitation leather sold in bulk”.

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