

**SECTION 45 PROCEEDINGS**  
**TRADE-MARK: RAPHAËL & DESIGN**  
**REGISTRATION NO.: TMA 297,998**

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On April 23, 1999, at the request of Messrs. Borden & Elliot, the Registrar forwarded a Section 45 notice to Raphaël Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark RAPHAEËL & Design (shown below) is registered for use in association with the following wares: articles de maroquinerie, nommément: bagages à main, sacs à main, serviettes, porte-documents, valises, housses à vêtements, ceintures, porte-monnaie, portefeuilles et étuis.



**Raphaël**  
un nom, un style.

In response to the notice, the statutory declaration of Raphaël Wazana has been furnished. Each party filed a written argument. An oral hearing has not been requested in this case.

In his affidavit, Mr. Wazana states that he is “détenteur” of the trade-mark RAPHAEËL UN NOM, UN STYLE & (dessin), registration No. TMA 297,998; he states that he operates a business in Montreal dealing in fine leather goods and gifts. He submits that the trade-mark is actively used and is visible in the operation of his business; that it was used between April 23, 1996 and April 23, 1999 in the same form as is registered. He adds “À titre d’exemple, la marque de commerce & (dessin) est exploitée en relation avec des articles de maroquinerie, nommément bagages à main, sac à main, serviettes, porte-documents, valises, housses à vêtement, ceintures, porte-monnaie, portefeuilles, et etuis” and he attaches sample specimens of labels, business cards, plastic bags, cotton bags/packaging, promotional cards, and a price list and inventory.

In its written argument, the requesting party argues that as the exhibits are unsworn they should

be ignored by the Registrar. Further, it submits that although the affidavit states that the mark has been in use during the relevant period, it does not show such use. The requesting party adds that the attachments appear to relate to bags or packaging (all undated) and that one specimen (undated) bears the stamp “CONFIDENTIAL” and the words “Pricelist and Inventory”. Further, the requesting party submits that the evidence fails to show use of the trade-mark as registered and use by the registered owner, “Raphaël Inc.”

In their written arguments, the agents for the registrant submit that the evidence is sufficient to show use of the trade-mark as registered and to show use by the registered owner. They explain that Mr. Wazana is the sole proprietor and administrator of Raphaël Inc. As this last information has not been submitted by way of affidavit or solemn declaration it has been disregarded.

Pursuant to Section 45(1) of the Act, the registrant must show that the trade-mark was in use in association with each of the registered wares at any time during the three-year period preceding the date of the Section 45 notice namely between April 23, 1996 and April 23, 1999.

Use in association with the wares is defined in Section 4(1) of the Act which reads as follows:

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.

Thus, the registered owner must show:

- (1) transfers of the registered wares;
- (2) in the normal course of trade; and
- (3) that the mark was associated with the wares at the time of transfer so that notice of the association was then given to the purchaser.

Having considered the evidence and the arguments of the parties, I conclude that the evidence fails to show any use of the trade-mark as registered in association with any of the registered wares during the relevant period in the manner required by Section 4(1) of the Act.

In his declaration Mr. Wazana indicates that he operates a business in Montreal and that the trade-mark has been used and is visible in the operation of his business and that it was used between April 23, 1996 and April 23, 1999. As examples of the use of the trade-mark he provides labels, business cards, cotton and plastic bags and a document entitled price list and inventory. Although the exhibits are not clearly identified as exhibits and do not bear the signature of the commissioner for taking oaths, in my view this is a mere technicality. As they are clearly identified in paragraph 6 of the affidavit, I have no difficulty in identifying them, therefore, I find them to be admissible.

From Mr. Wazana's statements and from the exhibits furnished it can be concluded that during the relevant period the registrant operated a business dealing in leather goods. However, the trade-mark registration does not cover "services". The issue in this case is whether the evidence shows use of the trade-mark in association with each of the wares during the relevant period in the manner required by Section 4(1).

The business cards and promotional cards do not show use of the trade-mark in association with wares in the manner required by Section 4(1) of the Act in that they do not show the manner the trade-mark was associated with the wares at the time of transfer of the wares. Rather, the use of the trade-mark thereon would appear to be use of the trade-mark in association with the registrant's store or business and consists of use complying with Section 4(2) rather than Section 4(1) of the Act.

Concerning the other attachments, although some could be considered as showing use with wares, most of them do not bear the trade-mark as registered. In this regard, I note that the cotton bags and the labels bear the word RAPHAËL and the design feature of the registered mark but, they omit the words "UN NOM, UN STYLE" which in my view, form a dominant element of the trade-mark as registered. As I am of the view that as the omission of the words UN NOM, UN STYLE, constitutes of a substantial deviation, I conclude that the labels and cotton bags bear a mark that is substantially different from the trade-mark as registered. In arriving at this

conclusion, I had regard to the opposition decision *Nightingale Interlock Ltd v. Prodesign Ltd.*, 2 C.P.R.(3d) 535, particularly “principle 2” set out therein.

Concerning the document entitled “Price List and Inventory” which bears all of the words of the registered trade-mark but in a different arrangement, such document is undated and it does not refer to any ware. Further it bears the mention “CONFIDENTIAL”. Consequently, it would seem such document may not even be available to the registrant’s customers and, therefore would not provide the required association between the trade-mark and the wares in the manner required by Section 4(1) of the Act. Accordingly, it does not show use of the trade-mark in association with wares within the meaning of Section 4(1) of the Act.

The only other attachments that bear all of the words of the registered trade-mark but in a different arrangement, are the plastic bags. I have doubt whether such bags could be considered as showing use of the trade-mark in association with the wares. This is because such use is use in association with services. In particular, these bags would probably be used by the registrant to insert one or more items a customer would have purchased at its place of business and therefore the display of the trade-mark on such bags is use in association with services namely use of the trade-mark in the advertisement or performance of the registrant’s business. Consequently, the use probably would comply with Section 4(2) of the Act which reads: “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” but would not appear to be a use in association with wares in the manner complying with Section 4(1) of the Act.

In any event, the evidence clearly fails to show transfers of any of the registered wares associated with the registered trade-mark in the manner required by Section 4(1) during the relevant three-year period. The registrant has not indicated whether each of the wares had been sold during the relevant period and he has not provided invoices or any other documents bearing dates during the relevant period confirming that transfers of the registered wares had been made during that period. In the circumstances, I conclude that the evidence is clearly insufficient to permit me to conclude that the trade-mark as registered was in use in association with the registered wares

within the meaning of Section 4(1) and Section 45 of the Act and during the relevant period.

In view of the above, I conclude that the trade-mark registration ought to be expunged.

Registration No. TMA 297,998 will be expunged in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 20th DAY OF JUNE 2001.

D Savard  
Senior Hearing Officer  
Section 45