



Consumer and
Corporate Affairs Canada

Ottawa / Hull,
Canada
K1A 0C9

NOV 6 1985

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vous retenez Your file
27332-0861313

Norre reference Our file
413,437

Gentlemen:

Re: Section 44 Proceedings
Registration No.: 230,125
TRADE MARK: BRUT & Design

At the request of David A. Stein, acting on behalf of Eldon Industries of Canada, Inc., the Registrar of Trade Marks issued a Section 44 notice, dated September 10, 1984, to Faberge, Incorporated, the registered owner of the trade mark BRUT & Design, registration No. 230,125.

The subject trade mark was registered September 1, 1978, for use in association with jogging suits.

In response to the Section 44 notice the registrant submitted the affidavit of its President, Stanley Frederick, dated January 29, 1985.

A written submission dated May 2, 1985, was filed by the requesting party. The registrant responded thereto by written submission dated July 17, 1985.

Mr. Frederick describes the registrant as an international consumer products company principally engaged in the development, manufacture and distribution of fragrance, toiletry and cosmetic products. The affiant identifies BRUT as a principal trade mark of the registrant and asserts that the BRUT mark has been used in Canada continuously since as early as January, 13, 1965, up to the date of his affidavit.

Mr. Frederick explains that the BRUT trade mark is primarily used in connection with a line of men's toiletry products, but that the registrant through its subsidiary, Faberge of Canada Limited, repeatedly offers specially priced clothing items, such as jogging suits, through promotional inserts which are found inside BRUT products. Mr. Frederick further explains that the promotional insert consist of order forms which the customer must return to a specified address together with a cheque or money order and proof of purchase of a BRUT product. The affiant asserts that each jogging suit sold in the above-described manner clearly displays the BRUT trade mark. Mr. Frederick notes that the most recent jogging suit promotion in Canada commenced in March, 1984 and expired December 31, 1984, resulting in the sale of approximately 1000 jogging suits.

Accompanying the affidavit are Exhibits A through F:

- Exhibits A1 and A2 are identified as copies of the 1977 and 1981 Brut jogging suit coupons.
- Exhibit B is a promotional brochure entitled "Faberge Looks Great on You". The inside cover of the brochure describes the "Brut Track Set" offer and contains the illustration of a fragrance product bearing the BRUT & Design trade mark.
- Exhibits C1 and C2 are identified as product sleeves. The sleeves bear the BRUT & Design trade mark and the "Brut Tuck Set" offer.

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- Exhibit D is identified as a report from Marco Sales and Incentives Ltd, to Faberge Canada Limited relating to sales of BRUT jogging suits pursuant to the "Brut Looks Great on You" offer. The report covers the period extending from March 27, 1984 to October 31, 1984. Marco Sales and Incentive Ltd. is identified as the entity which handles the registrant's jogging suit promotion.

- Exhibit E is a photograph of a jogging suit which bears the word BRUT on the shirt pocket.

- Exhibit F consists of several pages of the April/May 1964 issue of a Magazine entitled "Images". One of the pages contains an advertisement promoting the "BRUT Track Set" as well as an illustration of a fragrance product which bears the Brut and Design trade mark.

The submission of the requesting party may be summarized as follows:

1. That the use of the word BRUT on jogging suits is for the purpose of promoting the sale of the registrant's line of toiletry products and an such does not constitute use as a trade mark.
2. That use of the BRUT & Design trade mark on promotional inserts and order forms printed on the product sleeves of the registrant's men's toiletry items does **not constitute** use of the trade mark with jogging suits. In support of its position **the requesting party** cites Syntex Inc. v. Apotex Inc. (1985) 1 C.P.R. (3d) 145.
3. That any use being made of the BRUT & Design trade mark with jogging suits is being made **by the third party manufacturer/distributor of the wares** and not by the **registrant** or its registered user. The **requesting party** speculates that no labels were appended to the registrant's affidavit **because** in all probability the labels contain the name of the manufacturer and **not that** of the **registrant**. Furthermore, **the requesting party notes that** the **order forms** and/or coupons are not sent to the **registrant** but to some third party who then delivers the **jogging suits** to **purchasers** by **return mail**.

On its behalf the registrant submits that the **trade mark** BRUT appears directly on the wares at the time of transfer of the property in or possession of the wares in the normal course of trade. Further, the **registrant argues** that the BRUT trade mark is not used **merely** to decorate the registrant's jogging suits but **so as** to distinguish the registrant's wares from the **wares** of **other** traders. In conclusion, the registrant submits **that** the appearance of the word BRUT on jogging suits and on order forms for jogging suits constitutes use of **the** trade mark **by the registrant and/or** its registered user within the meaning of **Section 4**.

With regard to the requesting party's first submission I do not agree that use of the word BRUT on jogging suits does not constitute use as a trade mark. A mark is used as a trade mark if the owner thereof uses it for the purpose of distinguishing his wares or services from those of others, or alternatively, if whatever the purpose for which the owner uses the mark, it does in fact distinguish his wares or services from those of others. If the use of a trade mark actually distinguishes the wares or services of the trade mark owner from those of other traders, it is not relevant that the owner uses the mark for some other or ancillary purpose.¹ In my opinion, the appearance of the word

¹ In this regard see Fox, Canadian Law of Trade Marks and Unfair Competition, 2nd Edition, at page 34.

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BRUT on jogging suits constitutes use of that word as a trade mark, whatever the intentions of the registrant, because such use does in fact distinguish the registrant's jogging suits from those of other traders.

It should be noted that use of the word BRUI by itself, does not constitute use of the trade mark as registered, namely BRUT & Design. Although the trade mark as used by the registrant on its jogging suits retains the word BRUT it omits totally all of the design features of the registered mark. Admittedly the word BRUT is an essential and predominant element of the subject trade mark; however, the design features are, in my opinion, highly distinctive components of the trade mark. Furthermore, it is the entire figure which is the subject of the registration and not just the word BRUT.

Secondly, I find that I must also disagree with the requesting party's Submission that use of the BRUT & Design trade mark on promotional inserts and order forms printed on the product sleeves of the registrant's men's toiletry items does not constitute use of that trade mark in association with jogging suits. In addition, I do not believe that the remarks of Mr. Justice Stone in Syntex Inc. v. Apotex Inc., as cited by the requesting party, in any way support the position enunciated by the requesting party. The question at issue in the Syntex case was whether the presence of the respondent's trade mark in the appellant's comparative chart constituted use of the respondent's trade mark in association with the appellant's wares. No issue arose as to whether the presence of the appellant's trade mark in the comparative chart amounted to use of that mark with the appellant's wares.

Section 4 of the Trade Marks Act recognizes that a trade mark is used in association with wares if at the time of the transfer of the property in or possession of such wares anyone of the following conditions is met:

the trade mark is marked on the wares themselves.

the trade mark is marked on the packages in which the wares are distributed.

the trade mark 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.

In my view, at the time a customer fills out the order form to purchase a jogging suit, there is, by virtue of the appearance of the BRUT & Design trade mark on the order form, notice of the association of that trade mark with the jogging suits. The customer is aware that he or she is purchasing a BRUT design jogging suit.

Finally, I do not agree with the requesting party that the use being made of the BRUT & Design trade mark is by some third party other than the registrant or its register user. The only entity referred to on the promotional materials and order forms is Faberge. The requesting party observes that the order forms are sent to a third party which then delivers the jogging suits to customers by return mail. In fact, the order forms are not mailed to any identified third party but are directed to "Brut Looks Good On You Offer" at a specified address.

Having reviewed the evidence and the written submissions of both parties I have concluded that the trade mark BRUT & Design was in use in Canada in the normal course of trade prior to and as of the date of the Section 44 notice in association with jogging suits. Therefore, the subject registration ought to be maintained.

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The decision in the preceding paragraph shall be acted upon **by** the Registrar if no appeal is taken therefrom within two months as provided under the provisions of Section 56 of the Trade Marks Act. If an appeal is taken, the Registrar shall act in accordance with the final decision pronounced in such appeal.

J.P. D'Aoust
Senior Hearing Officer
for REGISTRAR of TRADE
MARKS

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