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TRANSLATION
THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 163

Date of Decision: 2017-11-30

[UNREVISED ENGLISH

CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

Field LLP

Requesting Party

and

8268533 Canada Inc.

Registered Owner

TMA617,293 for VEXY

Registration

INTRODUCTION

[1] This decision concerns a summary expungement proceeding instituted against registration no. TMA617,293, property of 8268533 Canada Inc (the Owner), for the VEXY trade-mark (the Mark) covering the following goods:

Clothing and accessories for men, women and children, namely raincoats, topcoats, overcoats, jackets, vests, sweaters, pants, suspenders, belts, shirts, shirt blouses, ties, bow ties, ascots, wool sweaters, slipcovers, cardigans, socks, tank tops, briefs, hats, peaked caps, gloves, mitts, cloaks, redingots, capes, waist-length jackets, dresses, skirts, blazers, gauchos, Bermuda shorts, shorts, full slips, overalls, body suits, bathrobes, pajamas, hose, nightgowns, negligees, gowns, slips, caps, scarves (the Goods).

[2] For the following reasons, I conclude that the registration must be maintained in part.

THE PROCEDURE

[3] On May 7, 2015, the Trade-marks Registrar sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c. T-13 (the Act) to the Owner of the Mark. The notice was issued at the request of Field LLP (the Requesting Party).

[4] Section 45 of the Act requires the Registrant to show that it has used its Mark in Canada in association with each of the Goods at any given time during the three years preceding the date of the notice or, if not, provide the date on which it was last used and the reason for its absence of use since this date. The relevant period is therefore from May 7, 2012 to May 7, 2015 (the Relevant Period).

[5] The procedure pursuant to section 45 is simple and expeditious, and serves to clear “deadwood” from the register. Accordingly, the threshold to establish use of the Mark, within the meaning of section 4 of the Act, during the Relevant Period is not very high [see *Uvex Toko Canada Ltd v. Performance Apparel Corp.*, (2004) 31 CPR (4th) 270 (FC)]. The issue is to establish a use of the Mark prima facie [see *1459243 Ontario Inc v Eva Gabor International, Ltd.*, 2011 FC 18].

[6] A simple assertion of use of the Mark in association with the Goods is not sufficient to establish its use within the meaning of section 4 of the Act. Finally, there is no need to file abundant evidence [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (4th) 62 (FCA)].

[7] In response to this notice from the Registrar, the Owner filed Mr. Antonio Raimondo’s affidavit and Exhibits P-1 to P-4 inclusive.

[8] The parties did not file written representations and there was no hearing.

THE EVIDENCE OF RECORD

[9] Mr. Raimondo is the President of the Owner, also known under the name DTOX since its founding, i.e. since August 2012. He is also the Secretary of Valino International Cover-up Inc,

also known under the business name Valino, which is a company related to the Owner, specializing in clothing production.

[10] Mr. Raimondo affirms that on August 14, 2012, the Owner acquired the Registered Mark in association with the Goods. He affirms that, since this acquisition, the Owner used the Mark continuously in Canada, between the month of August 2012 and the Month of May 2015, in association with: “*clothing including, among others the following: jackets, coats, shirts, sweaters, fashion tops, pants, skirts, blazars (sic), shorts, bermudas, hats and scarfs (sic) (hereinafter the “Products”)*”. For the purposes of my decision, I have translated this relevant excerpt as: “des vêtements, incluant, entre autres, des vestes, manteaux, chemises, chandails, camisoles, débardeurs, pantalons, jupes, blazers, shorts, bermudas, chapeaux et foulards (les Marchandises)”.

[11] I note that “*coats*” (“manteaux”) and “*sweaters*” (“chandails”) are not on the list of Goods/Products. However, I consider that I can associate these terms with “paletots” (“overcoats”) and “gilets de laine” (“wool sweaters”) respectively on the list of Goods/Products.

[12] Mr. Raimondo affirms that since the acquisition of the Mark, Valino has been a licensee of the Owner for the production and sale of the Goods/Products bearing the Mark, according to the Mark’s quality standards. Thus, Valino supervises the production, import and sale of the Goods/Products on the Owner’s account.

[13] Mr. Raimondo affirms that the Goods/Products bearing the Mark have been sold in many retail stores, including: Amnesia (Quebec), Marks & Venus (Alberta) and Sacrilege (New Brunswick). The Goods were also sold in the Owner’s stores operated under the D-TOX banner (Quebec and Ontario) during the Relevant Period.

[14] Mr. Raimondo filed as Exhibit P-1 specimens of labels that are representative of the way the Mark was used by the Owner in Canada in association with the Goods/Products during the Relevant Period.

[15] Mr. Raimondo filed as Exhibit P-2 photographs showing how the Mark was used during the Relevant Period in association with some of the Goods/Products, namely “*tank tops*” and

“*dresses*” (robes). For the purposes of my decision, I consider that the expression “*tank tops*” refers to “*débardeurs et camisoles*” contained on the list of Goods/Products.

[16] Mr. Raimondo also filed as Exhibit P-3 invoices issued in 2013, proving the sale of some of the Goods/Products in Canada in association with the Mark by Valino, on the Owner’s account, to Canadian retail stores. He explains that the reference “VX” under heading “numéro Produit” (Product number) appearing on the invoices filed represents the abbreviation of the Mark and he enumerates the codes appearing on the invoices filed and indicates the Goods/Products to which these codes correspond. Thus, the invoices filed concern the sale of: “*jackets/coats, shirts, dresses, fashion tops, sweaters, pants, skirts*”. For the purposes of my decision, I consider that “jackets/coats” refers to “*vestes*” (jackets) and “*paletots*” (overcoats) contained on the list of Goods/Products. Thus, this list of Goods/Products refers to the following goods/products: “*vestes, paletots, chemises, robes, camisoles, débardeurs, gilets de laine, pantalons, jupes*” (jackets, overcoats, shirts, dresses, tank tops, wool sweaters, pants, skirts).

[17] Mr. Raimondo also files as Exhibit P-4 invoices issued in 2014 and 2015 by the Owner for sales made directly to consumers, and the description of the Goods/Products sold. This description comes from the Owner’s archives. He explains that the abbreviation “VX” refers to the Mark. He affirms that these invoices prove the sale of the following Products/Goods by the Owner to consumers in Canada, namely: “*blouses, fashion tops (tube, tank crop (sic)), dress (sic) and coat (sic)*” (chemisiers, camisole, débardeur, robe et paletot).

[18] On the basis of this evidence, I must determine whether the Owner proved the use of the Mark in Canada in association with each of the Goods/Products during the Relevant Period.

ANALYSIS OF EVIDENCE

[19] Mr. Raimondo makes no mention whether the “*Products*” (Marchandises), are for men, women and/or children. However, the photographs filed as Exhibit P-2 only illustrate clothing for women. I therefore find that the Goods/Products only concern clothing and accessories for women.

[20] I find that Mr. Raimondo did not include the following clothing in his definition of the term “*Products*” (Marchandises) : “*dresses*” (robes) and “*blouses*” (chemisiers). However, he

refers to this clothing in paragraph 11 of his affidavit. Moreover, he filed one invoice, among those included as Exhibit P-4, illustrating the sale of these goods in association with the Mark during the Relevant Period.

[21] Despite the use of the defined term “*Products*” (Marchandises) throughout his affidavit, and specific references to some of the Goods/Products, Mr. Raimondo is silent regarding the use of the Mark in association with:

impermeables, pare-dessus, gilets, bretelles, ceintures, cravates, nœuds papillons, ascots, cardigans, chaussettes, caleçons, chapskas, gants, moufles, pèlerines, redingotes, capes, blousons, pantacourts, combinaisons, salopettes, justaucorps, peignoirs, pyjamas, bas, chemises de nuit, déshabillés, nuisettes, jupons et casquettes [raincoats, topcoats, sweaters, suspenders, belts, shifts, ties, bow ties, ascots, cardigans, socks, briefs, peaked caps, gloves, mitts, cloaks, redingots, capes, waist-length jackets, gauchos, full slips, overalls, body suits, bathrobes, pajamas, hose, nightgowns, negligees, gowns, slips and caps] (Goods Not Sold).

[22] I also note, despite Mr. Raimondo’s allegation that the Owner used the Mark in Canada during the Relevant Period in association with chapeaux, blazers, bermudas, shorts et foulards [hats, blazers, Bermuda shorts, shorts and scarves], there is no evidence of record of a transfer of ownership regarding these Goods/Products.

[23] Although a registered owner is not bound to provide invoices for each of the Goods/Products covered by the registration, it nonetheless must present sufficient evidence to allow the Registrar to conclude that transfers really took place in the normal course of trade in Canada regarding *each* of the Goods/Products covered by the registration [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. For example, in the absence of invoices, such evidence may include statements concerning sales volumes, the dollar value of sales or equivalent factual details [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79, CarswellNat 2439; and *Gowling Lafleur Henderson LLP v Wertex Hosiery Incorporated*, 2014 TMOB 193 (CanLII), CarswellNat 4624].

[24] Finally, Mr. Raimondo provides no explanation that could constitute special circumstances justifying the non-use of the Mark in Canada in association with clothing and accessories for men and children and in association with clothing and accessories for women,

namely the Goods Not Sold, as well as hats, blazers, Bermuda shorts, shorts and scarves, the whole according to the provisions of section 45(3) of the Act.

[25] However, I am satisfied that the evidence described above proves the use of the Mark in Canada by the Owner during the Relevant Period in association with clothing and accessories for women, namely paletots, vestes, pantalons, chemises, chemisiers, gilets de laine, débardeurs, camisoles, robes et jupes [overcoats, jackets, pants, shirts, shirt blouses, wool sweaters, tank tops, dresses and skirts].

[26] The registration thus will be amended accordingly.

DECISION

[27] In view of all the foregoing, in the exercise of the powers delegated to me under the provisions of section 63(3) of the Act and in accordance with the provisions of section 45 of the Act, registration no. TMA617,293 will be amended to delete the following items for the statement of goods:

Vêtements et accessoires pour hommes et enfants, (...) imperméables, pare-dessus, gilets, bretelles, ceintures, cravates, noeuds papillons, ascots, cardigans, chaussettes, caleçons, chapeaux, chapskas, gants, moufles, pèlerines, redingotes, capes, blousons, blazers, pantacourts, bermudas, shorts, combinaisons, salopettes, justaucorps, peignoirs, pyjamas, bas, chemises de nuit, déshabillés, nuisettes, jupons, casquettes, foulards. [Clothing and accessories for men and children, (...) raincoats, topcoats, jackets, suspenders, belts, ties, bow ties, ascots, cardigans, socks, briefs, hats, peaked caps, gloves, mitts, cloaks, redingots, capes, waist-length jackets, blazers, gauchos, Bermuda shorts, shorts, bathrobes, pajamas, hose, nightgowns, négligés, gowns, slippers, caps, scarves]

[28] The amended statement of goods will be worded as follows:

Vêtements et accessoires pour femmes nommément, paletots, vestes, pantalons, chemises, chemisiers, gilets de laine, débardeurs, camisoles, robes et jupes [Clothing and accessories for women, namely overcoats, jackets, pants, shirts, shirt blouses, wool sweaters, tank tops, dresses and skirts].

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Arnold Bennett

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No hearing held

AGENT(S) OF RECORD

Goudreau Gage Dubuc

FOR THE REGISTERED OWNER

Field LLP

FOR THE REQUESTING PARTY