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

Citation: 2018 TMOB 142

Date of Decision: 2018-11-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Gowling WLG (Canada) LLP

Requesting Party

and

Cafénoir S.p.A.

Registered Owner

TMA581,342 for CAFE' NOIR

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA581,342 for the trade-mark CAFE' NOIR (the Mark), owned by Cafénoir S.p.A.

[2] The Mark is currently registered for use in association with the following goods:

Belts, shoes, boots.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete "belts".

THE PROCEEDING

[4] On June 6, 2016, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Cafenoir International S.A. (the Owner), the registered owner at that time of registration No. TMA581,342. The notice was sent at the request of Gowling WLG (Canada) LLP (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between June 6, 2013 and June 6, 2016, in association with each of the goods specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] Subsequent to the issuance of the section 45 notice, an assignment of the subject registration to Cafénoir S.p.A. was filed with the Registrar. The change in title, recorded on the register on February 21, 2017, as the result of an assignment of the Mark on January 10, 2017, is not at issue in the present proceeding.

[7] The relevant definition of use is set out in section 4(1) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[8] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression “clearing deadwood” has often been used to describe such proceedings [*Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. While it is true that the threshold for establishing use in a section 45 proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD); *Austin Nichols & Co v Cinnabon, Inc* (1998), 82 CPR (3d) 513 (FCA)], 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 registered goods during the relevant period [*Uvex Toko Canada Ltd v*

Performance Apparel Corp, 2004 FC 448, 31 CPR (4th) 270; and *John Labatt Ltd v Rainer Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Mere statements of use are insufficient to prove use [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Marco Spagnolini, sworn December 14, 2016, together with Exhibits A to C.

[10] Only the Owner filed written representations. An oral hearing was not requested.

THE EVIDENCE

[11] Mr. Spagnolini attests that he was the sales director with the Owner from 2008 to 2015, and is currently a sales consultant with Caf noir S.p.A., the successor-in-title to the Owner.

[12] Mr. Spagnolini attests that during the relevant period, the Owner used the Mark in Canada in the normal course of trade with "shoes and boots". In this regard, he states that the Owner sold shoes and boots to various retailers, including, to Sorelle Brotto Inc. – SHU SHU', a shoe store retailer located in Windsor, Ontario, Canada.

[13] In support of such sales, Mr. Spagnolini provides as Exhibit A, a copies of an invoice and transport document, dated August 5, 2014 and August 6, 2014 respectively. He notes specific codes on the invoice and correlates those codes to shoes and boots shown in the Caf  Noir Fall/Winter 2014/1015 catalogue that he attaches under Exhibit B to his affidavit.

[14] Mr. Spagnolini attests that the shoes and boots evidenced as sold in Exhibit A and shown in Exhibit B, were shipped in boxes on which the Mark was clearly displayed. In support, he attaches as Exhibit C to his affidavit, photographs of boxes representative of the boxes in which the CAF  NOIR shoes and boots were delivered to Sorelle Brotto Inc.- SHU SHU' in August 2014.

ANALYSIS AND REASONS FOR DECISION

[15] At the outset, I note that while the affidavit of Mr. Spagnolini speaks to the Mark being used in association with "shoes and boots", the affidavit and evidence are silent with respect to "belts". Similarly, the Owner's written representations refer only to "shoes and boots". As no

special circumstances have been brought forth which would excuse the absence of use of the Mark with respect to belts, the goods “belts” will be deleted from the registration.

[16] However, I am satisfied that the Owner has established a *prima facie* case of use of the Mark with respect to “shoes” and “boots”. The evidence clearly demonstrates that the Owner sold such goods to a Canadian retailer during the relevant period, and that the packaging for the goods (i.e. – the boxes enclosing the shoes and boots) displayed the Mark.

[17] While the trade-mark as used on the packaging for the goods, namely, CAFÉNOIR, differs slightly from the Mark as registered, I consider the display of the Mark in one word with a lowercase “é” to be entirely minor deviations. As such, the identity of the Mark has been preserved and these minor differences would not mislead an unaware purchaser [see *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (9185), 4 CPR (3d) 523 (FCA)].

[18] Lastly, it is well established that evidence of a single sale may be sufficient to establish use of a trade-mark in the normal course of trade, as long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration of the trade-mark [*Philip Morris, supra*]. I see nothing in the evidence that leads me to believe that the sales in evidence lacked *bona fides*. Furthermore, I note that there is no minimum amount of commercial activity required in order to maintain the registration [*Vogue Brassiere Inc v Sim & McBurney* 2000 CanLII 14812 (FC), 5 CPR (4th) 537 at 549 (FCTD)].

DISPOSITION

[19] Having regard to the aforementioned, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the goods “belts” in compliance with the provisions of section 45 of the Act.

[20] The amended statement of goods will read as follows:

Shoes, boots.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No hearing held.

AGENTS OF RECORD

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,S.R.L. FOR THE REGISTERED OWNER

Gowling WLG (Canada) LLP FOR THE REQUESTING PARTY