



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

Citation: 2019 TMOB 18

Date of Decision: 2019-02-28

IN THE MATTER OF A SECTION 45 PROCEEDING

October's Very Own IP Holdings

Requesting Party

and

Manuel Ros Fernandez

Registered Owner

**TMA765,346 for OC OCTOBER
DESIGN**

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA765,346 for the trade-mark OC OCTOBER DESIGN, shown below (the Mark), owned by Manuel Ros Fernandez.



(Colour is claimed as a feature of the trade-mark. The colour "red" is claimed as an essential feature of the trade-mark, with the letters "OC" and the word "october" appearing in red.)

[2] The Mark is currently registered in association with the following goods and services:

Goods:

(1) All types of clothing, for men, women and children, namely, shirts, T-shirts, trousers, shorts, skirts, pullovers, sweaters, cardigans, jackets, swimwear, coats, anoraks, belts, ties, wristbands, socks, underwear.

Services:

(1) Advertising services, namely preparing and placing advertisements for the benefit of third parties; business consultation services with respect to the working or management of commercial or industrial firms; business administration; office functions, namely preparing business reports, bookkeeping, computerised accounting services, business and account auditing services, cost price analysis, conducting market research studies, secretarial and clerical services, commercial information and directory services; export, import, sole and representation agencies; retail selling of clothing and retail selling of clothing by means of world-wide computer networks; franchising services provided to assist in the operation or management of commercial firm; all of the foregoing services offered in the clothing and footwear industry.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete the services in their entirety, but maintained in part with respect to the goods.

THE PROCEEDINGS

[4] On January 28, 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 Manuel Ros Fernandez (the Owner). The notice was sent at the request of October's Very Own IP Holdings (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that he had used the Mark in Canada, at any time between January 28, 2013, and January 28, 2016, in association with each of the goods and services 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] The relevant definitions of use in the present case are set out in sections 4(1) and 4(2) 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.

4(2) 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.

[7] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. As such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered goods and services.

[8] In response to the Registrar’s notice, Mr. Fernandez furnished his own affidavit, sworn January 5, 2017, together with Exhibits A and B.

[9] Only the Requesting Party filed written representations and attended an oral hearing in the matter.

THE EVIDENCE

[10] Mr. Fernandez attests that, in addition to being the Owner of the Mark, he is also the Managing Director of Eighteen October 2001 S.L.

[11] Mr. Fernandez states that he has full control over the character and quality of the goods sold by him through Eighteen October 2001 S.L. to Canadian purchasers, as well as the services associated with the Mark. He also states has full control over the manner of use of the Mark by Eighteen October 2001 S.L.

[12] Mr. Fernandez explains that he manufactures and sells a variety of clothing in Spain and that he also sells clothing to purchasers in Canada, such as Double J Fashion Group (2013) Inc.

He attests that he uses the Internet as a means of advertising his products and facilitating these sales.

[13] In support, Mr. Fernandez attaches the following exhibits to his affidavit:

- Exhibit A – copies of invoices issued during the relevant period, as well as invoices outside of the period to “show my continued interest in selling my clothing to Canada”. He states that these invoices accompany the goods sold to Double J Fashion Group in Canada. The Mark appears in the top left corner of the invoice, and both his own name as well as the company name Eighteen October 2001 S.L., appear at the bottom of the invoices. He attests that the reference to the exact goods shown on the invoices appears in Spanish and that the invoices reflect sales of the following goods:
 - i. Sleeveless blouses
 - ii. Short sleeve blouses
 - iii. Blouses-stamped
 - iv. Tops
 - v. Trousers (including long and cropped)
 - vi. Parkas
 - vii. T-shirts
 - viii. Polo shirts
 - ix. Jackets
 - x. Dresses
 - xi. Sweaters
 - xii. Accessories for clothing
 - xiii. Denims
 - xiv. Coats
 - xv. Cardigans
 - xvi. Vests
 - xvii. Coats
 - xviii. Handbags
 - xix. Bags for shopping
 - xx. Bags
 - xxi. Windbreakers
 - xxii. Capes
 - xxiii. Ponchos
 - xxiv. Jean-leggings (jeggings)
 - xxv. Down coats
 - xxvi. wallets
- Exhibit B - a translation of each of the goods appearing in each invoice made using Google translate. He states that he believes the translation is accurate.

[14] Lastly, Mr. Fernandez attests that he also provides services associated with the retail sale of these goods, including the provision of online information about the various goods and the operation of a website.

ANALYSIS AND REASONS FOR DECISION

[15] The Requesting Party submits that as the Mark is only displayed at the top of the invoice, with no use in the body of the invoice, this is not use in association with goods [citing *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440, 56 CPR (4th) 223 at para 32.] Further to this, the Requesting Party submits that the placement of the Mark directly adjacent to the address and contact information for the distributor is further support that the Mark is not being used in association with goods, but rather in relation to distribution services only [*Tint King, supra*].

[16] The Requesting Party submits that although it has been established that a trade-mark placed only at the top of an invoice can be considered use in association with the invoiced goods, this is only in exceptional circumstances such as where the name of the company appears separately from the trade-mark on the invoice, and the invoice is only in relation to a single good [citing *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321]. The Requesting Party submits that in the present case, the Mark is not separate from the company name, and that the invoices include a variety of different goods such that the Mark is not clearly associated with any of the goods. Instead, the Requesting Party submits, the display of the Mark on the invoices is use in association with services. The Requesting Party cites the following cases, which it submits have followed *Hortilux* in finding that the general rule of a trade-mark at the top of an invoice is not evidence of use in association with goods: *Smiths IP v Saks & Co*, 2015 TMOB 133; *Sim & McBurney v Nikita ehf*, 2015 TMOB 222; *Moffat & Co v Big Erics Inc*, 2015 TMOB 52; *MediPurpose Ptc Ltd v Bernis Co, Inc*, 2016 TMOB 197; and *McMillan LLP v April Cornell Holdings Ltd*, 2015 TMOB 111.

[17] In addition, the Requesting Party submits that there is no evidence of use of the Mark with any of the services. In this regard, the Requesting Party submits that there is only a bare assertion that retail sales are provided through a website to which there is no supportive evidence.

[18] The Requesting Party submits that accordingly, the Mark should be expunged in its entirety.

[19] The cases cited by the Requesting Party that have followed the decision in *Hortilux, supra*, regarding invoices and notice of association with goods are distinguishable. In *Smiths IP, supra*, trade-marks of third parties appeared in conjunction with product descriptions in all of the evidenced invoices. In *Sim & McBurney, supra*, the products listed on the invoices were identified with a secondary trade-mark, and the registered owner's trade-name and logo appeared more prominently at the very top of the invoices. In *Moffat & Co., supra*, the evidence demonstrated that the registered owner was a distributor who sold the goods of others, such that the invoices did not evidence sales of goods of one manufacturer. In *MediPurpose Ptc Ltd, supra*, another more prominent trade-mark appeared at the top of the invoices. In *April Cornell, supra*, it was ambiguous as to whether or not the invoices reflected the sale of goods from more than one manufacturer, and whether other trade-marks appeared in the body of the invoices.

[20] In the present case, no other trade-marks are evident on the invoices, and the Mark appears prominently at the top left hand side of the invoices, setting itself apart from the Owner's address and contact information as it appears in a different and substantially larger font. Additionally, the invoices appear to reflect sales of only one trader or manufacturer, as every good listed on the invoices includes the term "october" in conjunction with a product description. Contrary to the Requesting Party's submissions, *Hortilux, supra*, does not cite the requirement that invoices only be in relation to a single good, but rather, that it be clear that the goods of only one manufacturer are being sold. Lastly, the recipient of the goods in this case (in all instances), is Double J Fashion Group (2013) Inc., and is not an end consumer, but rather an intermediary, who would have familiarity with the Owner's business, and would therefore understand that OC October Design is distinguishing the source of the clothing referred to in the invoices from the clothing of others [per *Hortilux, supra*].

[21] Having regard to the aforementioned, and that Mr. Fernandez clearly attests that the invoices accompanied the goods at their time of transfer, I accept that the invoices provided the requisite notice of association between the Mark and the goods sold [see *Tint King, supra*; *Hortilux, supra*]. Having reviewed the items sold on the invoices together with Mr. Fernandez'

sworn statements, I accept that the invoices show sales of the following goods: “All types of clothing, for men, women and children, namely, shirts, T-shirts, trousers, shorts, skirts, pullovers, sweaters, cardigans, jackets, [...], coats, anoraks, [...], [...], [...], [...], [...]. Consequently, these goods will be maintained in the registration.

[22] However, I agree with the Requesting Party that there is no evidence of use of the Mark with any of the services. The invoices do not refer to any of the services, and there is no evidence that the Owner sells such goods at retail in Canada. Indeed, the Requesting Party correctly submits that there is only a bare assertion that “services associated with the retail sale of the goods” are provided through a website to which there is no supportive evidence.

DISPOSITION

[23] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the services in their entirety, but maintained in part with respect to the goods in compliance with the provisions of section 45 of the Act.

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

Goods:

- (1) All types of clothing, for men, women and children, namely, shirts, T-shirts, trousers, shorts, skirts, pullovers, sweaters, cardigans, jackets, coats, anoraks.

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 2018-10-23

APPEARANCES

No one appearing

FOR THE REGISTERED OWNER

Amy Thomas

FOR THE REQUESTING PARTY

AGENTS OF RECORD

Marks & Clerk

FOR THE REGISTERED OWNER

Moffat & Co.

FOR THE REQUESTING PARTY