



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 119

Date of Decision: 2020-10-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Sim & McBurney

Requesting Party

and

**H.A. Kidd and Company
Limited/H.A. Kidd et Compagnie
Limitée**

Registered Owner

TMA174,361 for LA VOGUE

Registration

INTRODUCTION

[1] At the request of Sim & McBurney (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on June 12, 2017, to H.A. Kidd and Company Limited/H.A. Kidd et Compagnie Limitée (the Owner), the registered owner of registration No. TMA174,361 for the trademark LA VOGUE (the Mark).

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

- (1) Buttons.
- (2) Slide fasteners.

[3] For the reasons that follow, I conclude that the registration ought to be maintained only with respect to buttons.

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with the registered goods at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is June 12, 2014, to June 12, 2017.

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

4(1) A trademark 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.

[6] It is well established that bare statements that a trademark is in use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. The threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]; however, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with *each* of the goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) (*John Labatt*)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Douglas Earle, CEO of the Owner, sworn January 11, 2018. Only the Owner submitted written representations. Both parties were represented at an oral hearing.

THE OWNER'S EVIDENCE

[8] Mr. Earle states that the Owner is a vendor of sewing and knitting products, and that in the normal course of business, it sells its products to retail customers. He states that the Owner has an exclusive agreement with Wal-Mart Canada (Wal-Mart) to sell buttons branded with the Mark, and that during the relevant period, the Owner sold over 800,000 units of such buttons to Wal-Mart. He explains that such buttons are sold mounted on a cardboard card displaying the Mark, and attaches images of such cards in the body of his affidavit and on internet screenshots taken from the Wayback Machine internet archive, attached as Exhibit 5, showing Wal-Mart's website as it appeared during the relevant period. I note that the cards display the Mark above the attached buttons.

[9] As Exhibit 6, Mr. Earle attaches a number of invoices dated during the relevant period, showing sales of products identified as "Snap Bag o' Buttons" or "La Vogue... Btn" to various Wal-Mart stores in Canada. In several of the invoices, certain items are identified by the latter descriptor as well as by a product code corresponding to the code shown on the cards depicted in the body of the affidavit. Mr. Earle states that these invoices show sales of the buttons shown in evidence to Wal-Mart stores in Canada during the relevant period.

[10] In addition, Mr. Earle refers to an opposition proceeding between a former subsidiary of the Owner and The Condé Nast Publications Inc. (Nast), which was resolved by an agreement between the parties (the 1971 Agreement) stating that Nast recognized the former's right to future use and registration of the Mark without interference, attack, or objections from Nast or its subsidiaries. As Exhibit 1, he attaches a copy of this agreement. He further states that in 1988, Nast and other corporations merged to form Advance Magazine Publishers Inc. (Advance), and attaches a copy of the certificate of merger as Exhibit 2. He states that Advance is represented by the Requesting Party, who had requested a section 45 notice against the Mark in 1993, although that proceeding was discontinued in 1994 after the agent for the Owner forwarded a copy of the 1971 Agreement to the Requesting Party. He states that a reference number on the Requesting Party's correspondence for the current proceeding is the same as its client number for matters involving Advance. Finally, Mr. Earle states that the Owner's agent asked the Requesting Party

to discontinue the current proceeding, but it refused to do so. Accordingly, Mr. Earle states that the request to issue a section 45 notice in this case was in contravention of the 1971 Agreement.

ANALYSIS

[11] At the outset, I note that at the hearing, the Owner conceded that there was no evidence of use of the Mark in association with slide fasteners, and that its only argument for maintaining those goods was that this proceeding is an abuse of process due to alleged breaches of the 1971 Agreement. However, with respect to the Owner's submissions regarding the 1971 Agreement, it is well established that compliance with other legislation and the like is not the sort of issue that should be addressed in section 45 proceedings [see *Marks & Clerk v Sparkles Photo Ltd*, 2005 FC 1012 at para 43; *Meredith & Finlayson v Berg Equipment Investments Ltd* (1996), 72 CPR (3d) 387 (TMOB) at 393; *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. Further, section 45(1) provides that "any person" may request a section 45 notice, and that the Registrar may refuse to issue a section 45 notice if he or she "sees good reason to the contrary"; but once the notice is issued, allegations that a party's actions may be an abuse of process are irrelevant [*Consorzio del Prosciutto di Parma v Maple Leaf Foods Inc*, 2010 TMOB 52 at para 20].

[12] Accordingly, while I have considered the Owner's submissions that this tribunal is bound by the principles of natural justice and that it is the master of its own procedure, such that the Registrar may exercise discretion in certain situations, the fact remains that this tribunal is simply not the proper forum for seeking a remedy for any purported breach of a settlement agreement. The question of whether a party or its client are in violation of the settlement agreement is beyond the narrow scope of these proceedings; the sole issue to be determined is whether the Owner has used the Mark within the meaning of the Act.

[13] Given that the Owner has put forward no evidence of use of the Mark in association with slide fasteners, nor any evidence of special circumstances excusing non-use of the Mark in association with such goods, the registration will be amended to delete those goods.

[14] With respect to the registered goods "buttons", the Requesting Party submits that the Owner's evidence does not establish that such goods were sold in the normal course of trade

during the relevant period. In this respect, the Requesting Party notes that two of the invoices include “Snap Bag o’ Buttons” in the product description with no reference to the Mark, while the remaining invoices list only “La Vogue... Btn” in the product descriptions, which cannot be correlated with buttons. In response, the Owner submits, and I agree, that Mr. Earle has clearly indicated in his affidavit that products listed in the invoices correspond to the buttons shown in evidence, and that product codes listed in the invoices correspond to the product codes on the depicted packaging cards for such buttons.

[15] Accordingly, the Owner’s evidence clearly shows that the Mark was displayed on the packaging for buttons, and that such buttons were sold to Wal-Mart stores in Canada during the relevant period in the normal course of trade. Accordingly, I am satisfied that the Owner has shown use of the Mark in association with the registered goods “Buttons” within the meaning of the Act.

DISPOSITION

[16] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete goods (2) from the registered goods.

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

(1) Buttons.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2020-10-08

APPEARANCES

Gervas Wall For the Registered Owner

Kenneth McKay For the Requesting Party

AGENTS OF RECORD

Deeth Williams Wall LLP For the Registered Owner

Marks & Clerk For the Requesting Party