



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 152

Date of Decision: 2021-01-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Lavery, De Billy, LLP

Requesting Party

and

**Dimatt Investments Inc., Carrying on
Business as Genesis**

Registered Owner

TMA345,075 for GENESIS

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA345,075 for the trademark GENESIS (the Mark), owned by Dimatt Investments Inc., Carrying on Business as Genesis (the Owner).

[2] All references are to the Act as amended June 17, 2019, unless otherwise noted.

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

GOODS

- (1) Men's clothing, namely suits, coats, pants and sports jackets.
- (2) Men's clothing, namely ties and cummerbunds.
- (3) Men's clothing, namely shirts.
- (4) Men's clothing, namely leather and suede coats, jackets and pants; and puffs, scarves, robes, pyjamas, t-shirts, sweatshirts, track suits, bathing suits, shorts, underwear, and undershirts; cufflinks, key chains, and wallets.
- (5) Men's clothing, namely sweaters.
- (6) Men's clothing, namely socks; and pens.
- (7) Men's clothing, namely belts.
- (8) Jewellery, namely watches.

SERVICES

- (1) Operation of a retail store for the sale of men's clothing.

[4] For the reasons that follow, I conclude that the registration ought to be maintained with respect to the services and in part with respect to the goods.

THE PROCEEDINGS

[5] At the request of Lavery, De Billy, LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on November 13, 2018.

[6] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the goods and services specified in the registration 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 November 13, 2015 to November 13, 2018.

[7] The relevant definitions of use are set out in section 4 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.

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.

[8] 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 [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the mark was used 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*)].

[9] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[10] In response to the Registrar’s notice, the Owner furnished the affidavit of Gene Dimatteo, President of the Owner, sworn on February 12, 2019. Only the Requesting Party submitted written representations. No oral hearing was held.

THE EVIDENCE

[11] Mr. Dimatteo attests that he or the Owner have operated a retail store in Toronto from 1973 until December 2016. As of December 2016, the Ontario corporation GEN-RAM Inc. (GEN-RAM) took over the operation of the retail store. Mr. Dimatteo states that GEN-RAM was licenced during the Relevant Period to use the Mark in Canada “under the care and control” of the Owner.

[12] Mr. Dimatteo states that during the relevant period, the Owner and GEN-RAM, under licence, have offered for sale and sold to Canadian customers clothing, accessories and jewellery in association with the Mark, including the goods listed in the registration. Further, Mr. Dimatteo states that he has travelled to Italy on behalf of the Owner and GEN-RAM “to bring Canadian customers the latest men’s clothing, accessories and jewellery from ‘MADE IN ITALY’ quality and fashion” manufactured by a number of third parties. In addition, Mr. Dimatteo explains that

the Owner and GEN-RAM, under licence, also make and sell “Made To Measure” and “Custom Made” men’s clothing and accessories. Furthermore, he states that they provide in-house master tailoring and alterations as well as personal and private shopping services in association with the Mark, including during the relevant period.

[13] Mr. Dimatteo states that the Mark is prominently displayed on the goods sold at the retail store, and that it is also present at the time of sale of the goods on the invoices, copies of which are provided to customers at the time of purchase, as well as on shopping bags, boxes and garment bags given to customers.

[14] According to Mr. Dimatteo, the Owner and/or GEN-RAM have sold over \$2,300,000 worth of goods and services from January 2016 until October 2018. Apart from a monthly breakdown of total sales, however, the affidavit provides no further breakdown of the sales figures with respect to the particular goods.

[15] Mr. Dimatteo explains that the Owner and/or GEN-RAM have advertised and marketed the goods and services via the Canadian website *www.genesis-toronto.com* (the Website) during the relevant period, and that the website is an important tool for enabling customers to conduct research on the goods and services offered prior to making a store visit.

[16] The following relevant exhibits are attached to Mr. Dimatteo’s affidavit:

- Exhibit B: undated photographs showing the street front and rear entrance of a retail store displaying the Mark, as well as photographs of the interior of a clothing store.
 - Exhibit C: undated printouts from the Website displaying the Mark on the top of each page and showing men’s clothing and accessories. I note that while the Website itself displays the Mark, none of the goods shown on the Website appear to display the Mark.
 - Exhibit D: copies of several invoices dated during the relevant period displaying the Mark on the top of each invoice, in the middle of each page as a background or watermark. Most of the invoices also contain, at the bottom left of the page, a few lines of text which read, “Celebrating 43 years ... Thank you for shopping at Genesis”.
- Mr. Dimatteo states that the invoices are representative “for the sale of Goods and Services”, and he confirms that all the goods and services listed on the submitted invoices

were purchased and received by customers at the retail store in Toronto during the Relevant Period. I note that each of the products listed in the invoices is identified by a brief product description, often including a trademark or manufacturer; however, the only appearance of the Mark in these descriptions is “SILK PUFF [...] GENESIS made in Italy”. I note that in a few instances, for the goods “pant” and “formal cufflinks”, no trademark appears in the product description line.

- Exhibit E: photographs of clothing and accessories bearing stitched-on labels or hang tags displaying the word GENESIS, “Made in Italy GENESIS”, or “Made in Italy for GENESIS”, sometimes alongside third-party trademarks. Mr. Dimatteo does not describe the nature of the garments shown in the photographs, and it is not always clear what types of garments are being shown in the photographs. However, it appears that the garments with stitched-on labels displaying the Mark include jackets, ties, belts, pants, pens, wallets, shirts, and sweaters. It appears that the garments with attached hang tags include gloves, sweat shirts, robes, jewellery, underwear, and undershirts; I note that in the case of sweat shirts, robes, underwear, and undershirts, tags displaying other trademarks are visible in the photographs, while in the case of gloves and jewellery, I cannot determine from the photographs whether or not the goods display other trademarks. However, I note that gloves are not listed among the registered goods and that the jewellery does not appear to include watches, as specified in the registration. Mr. Dimatteo explains that the photographs in Exhibit E are representative samples of the Goods and that they are also representative of the manner in which they “have been offered for sale and sold” and of how the Mark has been displayed on the goods during the relevant period.
- Exhibit F: copies of photographs of advertising and promotional materials bearing the Mark, namely clothes hangers, sample labels, business cards, garment bags, and shopping bags. Mr. Dimatteo states that these photographs are representative of the advertising and promotional materials used by the Owner and/or GEN-RAM during the relevant period to advertise, promote and associate the Mark with the goods and services to the customer at the time of purchase.

ANALYSIS AND REASONS FOR DECISION

Licensed Use of the Mark

[17] The Requesting Party submits that any use of the Mark by the licensee GEN-RAM after December 2016 does not enure to the Owner's benefit because the Owner has not met the requirements set out in section 50(1) of the Act by demonstrating that it had direct or indirect control of the character or quality of the Goods and Services.

[18] As stated by the Federal Court, there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the licence agreement that provides for the requisite control [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84]. In this case, Mr. Dimatteo clearly asserts in paragraph 7 of his affidavit that GEN-RAM "was and continues to be during the Relevant Period, licensed to use the Registered Mark in Canada under the care and control" of the Owner. This is sufficient for the purposes of this proceeding. As such, I am satisfied that any evidenced use of the Mark by the licensee enures to the Owner's benefit.

Use in association with the Services

[19] With respect to the services, the Requesting Party submits that the Owner's evidence is insufficient to demonstrate use of the Mark in association with the services, noting that nowhere in the affidavit is the retail store referred to as GENESIS; that there is no indication that the Exhibit B photographs or Exhibit C screenshots are representative of how the store exterior or Website appeared during the relevant period; and that it is not clear whether the word GENESIS is used as a trade name or as a trademark on the Exhibit D invoices. With respect to the Owner's first submission, it is clear from the totality of the evidence, including the Exhibit B storefront photographs, the Exhibit C screenshots, and the Exhibit D invoices issued during the relevant period, that Genesis was the name of a retail clothing store operated by the Owner and its licensee during the relevant period.

[20] With respect to the invoices submitted as Exhibit D, the Requesting Party submits that the word GENESIS is used on the invoices solely as a trade name, as opposed to a trademark, citing, *inter alia*, *Good Earth Corporation v Good Earth Cafes Ltd*, 2013 TMOB 75. As noted by the Requesting Party, in deciding whether a trademark has been used as a trademark rather than a trade name, the context of use has to be considered, including such factors as whether the trademark stands apart from the corporate or trade name and other corporate identifier information to the extent that the public would perceive such use as a trademark and not merely as identification of a legal entity [see also *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB); *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD)].

[21] In the present case, as noted above, the word GENESIS appears firstly on the top left corner of the invoices in large cursive font, under which “dal 1973” is displayed in smaller stylized block letters, followed by the Owner’s address and contact information, all in smaller non-stylized block letters. Secondly, the word “Genesis” appears in the same cursive font, but larger in size, in the middle of each invoice page as a watermark or background in the middle of the invoice. Thirdly, most of the invoices contain a few lines of text at the bottom left of the page which read, “Celebrating 43 years ... Thank you for shopping at Genesis”. Due to the prominence of the Mark in each of these formulations, I find that the public would perceive such use as a trademark and not merely as identification of a legal entity. Given that the Mark is used to identify the retailer, and that other trademarks or manufacturers are listed in association with nearly all of the products listed in the invoices, I find that display of the Mark in this manner would be associated with the Owner’s retail store services, rather than in association with the goods [see *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321 at para 12; *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440 at para 35]. I note that the Mark is also displayed in the product descriptions of the product “SILK PUFFS” as an identifier for that particular product; display of the Mark in this manner will be discussed in the next section.

[22] Given that the Owner or its licensee has displayed the Mark on its invoices in Canada during the relevant period in the course of operating a retail clothing store, and given that Mr. Dimatteo has stated that such invoices are given to customers at the time of purchase of

goods at the retail store, I am satisfied that the Owner has demonstrated use of the Mark in association with performance of the registered services within the meaning of the Act.

Use in association with the Goods

[23] The Requesting Party submits that the Owner's evidence does not demonstrate use in association with any of the registered goods. In particular, the Requesting Party submits that the Owner's evidence does not show that the Owner has transferred the goods in the normal course of trade, and that the Owner has not established that the Mark was associated with the goods at the time of transfer.

Transfer of the Goods

[24] The Requesting Party notes that the invoices do not show sales of any goods identified by the Mark, with the exception of "puffs"; instead, the invoices show sales of goods displaying third-party trademarks. As such, the Requesting Party submits that there is therefore no evidence of transfer in the normal course of trade of items displaying the Mark, such as those shown in the Exhibit E photographs.

[25] Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], some evidence of transfer of *each* of the goods in the normal course of trade in Canada is necessary [see *John Labatt*]. Merely offering goods for sale is not sufficient [see, for example, *The Molson Companies Ltd v Halter* (1976), 28 CPR (2d) 158 at 177 (FCTD); and *Gowling, Strathy & Henderson v Royal Bank of Canada* (1995), 63 CPR (3d) 322 at 327 (FCTD)]. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements [see, e.g., *Davis LLP v Office of the Commissioner of Baseball*, 2015 TMOB 107 at para 9; *Barrette Legal Inc v Southbrook Farms Ltd*, 2015 TMOB 179 at para 13].

[26] In this case, I accept that the products listed in the Exhibit D invoices were sold in the normal course of trade in Canada during the relevant period. With respect to the products depicted in Exhibit E, while Mr. Dimatteo does not clearly indicate that these products correspond with any of the items listed in the Exhibit D invoices, he clearly states in his affidavit

that the items shown in Exhibit E are representative of products that “have been offered for sale *and sold*” [emphasis added] during the relevant period. This sworn statement is consistent with his description of the Owner and its licensee’s normal course of trade, and with the generalized sales figures showing substantial sales during the relevant period. I am therefore satisfied that the goods shown in Exhibit E were transferred in the normal course of trade in Canada during the relevant period [for a similar conclusion with respect to goods “offered for sale and sold”, see *Brownlee LLP v 555, 129 Ontario Ltd*, 2013 TMOB 23 at para 17].

Association of the Mark with the Goods

[27] Accordingly, the question to be determined is whether the Owner has established that the Mark was used within the meaning of the Act in association with the goods shown to have been transferred. In this respect, the Requesting Party submits that the display of the Mark on the invoices, hang tags, hangers, labels, and shopping bags does not amount to use of the Mark within the meaning of the Act.

[28] With respect to the invoices, the Mark is displayed on the top and bottom of the invoices and on a watermark; however, with the exception of “puffs”, each of the goods listed in the invoices is identified by a third-party trademark or no trademark. As discussed above, I agree with the Requesting Party that such appearances of the Mark are in association with retail store services, rather than in association with any of the registered goods. However, given that the Mark appears in the product description of the item “SILK PUFF” (which Mr. Dimatteo explains is a pocket square), that the invoices show that this item was transferred in Canada in the normal course of trade during the relevant period, and that Mr. Dimatteo has confirmed that the invoices accompany the products at the time of purchase in the retail store, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered good “puffs” within the meaning of the Act.

[29] Given that the remaining invoiced items have third-party trademarks, or no trademark, in their product descriptions rather than the Mark, I am not satisfied that the invoices establish that the Mark was used in association with any of the remaining goods.

[30] With respect to the photographs provided at Exhibit E and F, the Requesting Party submits, and I agree, that the presence of hang tags, price tags, or other signage in association with third-party goods at the time of sale is insufficient, on its own, to establish use of that trademark in association with such goods within the meaning of the Act [see *Moffat & Co v Big Erics Inc*, 2015 TMOB 52 (*Moffat*); *McMillan LLP v April Cornell Holdings*, 2015 TMOB 111; *Transport for London v Stiles Clothiers Inc*, 2018 TMOB 67]. Similarly, the act of placing goods bearing third-party marks into a shopping bag bearing a trademark at the time of purchase is insufficient, on its own, to establish use of that trademark in association with the third-party goods [see, for example, *6438423 Canada Inc v Consumers Nutrition Center Ltd*, 2009 CanLII 82134 (TMOB) at paras 12-14; and *Moffat* at para 17].

[31] In order for a trademark to be “marked on the goods themselves”, a trademark generally has to be displayed on the goods in a permanent fashion, typically by the manufacturer of the goods [see *Moffat* at para 29]. A relevant example would be a trademark displayed on a shirt’s stitched-in label [*Smiths IP v Saks & Co*, 2015 TMOB 133 at para 64 (*Saks*)]. In the present case, I consider the Mark as “marked on the goods themselves” for goods bearing an embossed, engraved, or stitched-on label displaying the Mark. While some of the items shown also display the marks of third parties in addition to such permanent labels displaying the Mark, there is nothing in the Act that precludes a trademark owner from using more than one trademark at the same time in association with the same goods [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD); *Sara Lee Corp v Kretschmar Inc*, 2005 CarswellNat 4474 (TMOB) at para 18; *Sharadha Terry Products Ltd v Dial Corp*, 2014 TMOB 285 at para 28]. As noted above, Exhibit E shows that the following products display the Mark in this manner: jackets, ties, belts, pants, pens, wallets, shirts, and sweaters. As I have concluded above that these photographed items were transferred in the normal course of trade in Canada during the relevant period, I am satisfied that the Owner has demonstrated use of the Mark in association with these goods within the meaning of the Act.

[32] Also shown in Exhibit E are other products with attached hang tags displaying the Mark; however, as noted above, among the products corresponding to goods listed in the registration, each photograph appears to show such products displaying third-party trademarks. Accordingly, as the Mark has not been permanently affixed to these goods, I am not satisfied that the Owner

has demonstrated use of the Mark on the goods themselves or in association in any other manner, within the meaning of the Act, following the reasoning in *Moffat* and *Saks*. In this respect, given that these products appear to display third-party trademarks, I am satisfied that the present case is distinguishable from *McDowell v Laverana GmbH & Co KG*, 2016 FC 1276, involving a fact pattern where it was ambiguous whether goods originated from a third party [for similar conclusions, see *Positec Group Ltd v Orange Works Kitchen & Home Corp*, 2017 TMOB 141 at paras 25-26; *TRANSPORT FOR LONDON v STILES CLOTHIERS INC*, 2018 TMOB 67 at para 31].

[33] Accordingly, in the absence of further evidence, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the goods other than jackets, ties, belts, pants, pens, wallets, shirts, sweaters, and puffs, as noted above. In the absence of special circumstances excusing non-use, the registration will be amended accordingly.

DISPOSITION

[34] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following goods: “suits, coats [...] and sports jackets”; “cummerbunds”; “leather and suede coats, [...] scarves, robes, pyjamas, t-shirts, sweatshirts, track suits, bathing suits, shorts, underwear, and undershirts; cufflinks, key chains”; “socks”; and “jewellery, namely watches” in compliance with the provisions of section 45 of the Act.

[35] The amended statement of goods and services will be as follows:

GOODS

- (1) Men’s clothing, namely pants.
- (2) Men’s clothing, namely ties.
- (3) Men’s clothing, namely shirts.
- (4) Men’s clothing, namely jackets and pants; and puffs; and wallets.
- (5) Men’s clothing, namely sweaters.
- (6) Pens.
- (7) Men’s clothing, namely belts.

SERVICES

(1) Operation of a retail store for the sale of men's clothing.

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 No Hearing Held

AGENTS OF RECORD

Riches, McKenzie & Herbert LLP

For the Registered Owner

Lavery, De Billy, LLP

For the Requesting Party