



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 201

Date of Decision: 2021-09-20

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF A SECTION 45 PROCEEDING

Nine West Holdings Inc.

Requesting Party

and

Aaron SARL

Registered owner

**TMA910,636 for AMERICAN
VINTAGE A.M. (drawing)**

Registration

INTRODUCTION

[1] This decision concerns a summary expungement proceeding with respect to registration No. TMA910,636 for the following AMERICAN VINTAGE A.M. trademark (drawing) (the Mark):

The logo features the words "American Vintage" in a highly decorative, cursive script. Below this, the letters "A.M" are written in a simple, sans-serif font.

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

[TRANSLATION]

Leather and imitation leather; bags namely handbags, shoulder bags, backpacks, sports bags, clutch purses; clothing namely coats, waist-length jackets, raincoats, parkas, costumes namely smoking jackets, suit and pant sets, jogging suits, jackets, blouses, pants, jeans, shorts, Bermuda shorts, dresses, skirts, petticoats, T-shirts, tank tops, sweaters, pullovers, shirts, vests, sweatshirts, warm-up pants, track jackets, swim suits, underwear, scarves, sashes, stoles, belts.

[3] For the following reasons, I find that the registration should be amended.

THE PROCEEDING

[4] On August 20, 2018, at the request of Nine West Holdings Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act), to Aaron SARL (the Owner).

[5] The notice required the Owner to provide evidence showing, with respect to all the goods specified in the registration, whether the Mark had been used in Canada at any time during the three-year period preceding the date on the notice and, if not, the date when the Mark 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 August 20, 2015 to August 20, 2018.

[6] The relevant definition of “use” in association with goods is 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.

[7] In response to the Registrar’s notice, the Owner submitted the statutory declaration of Michael Azoulay, declared on December 3, 2018.

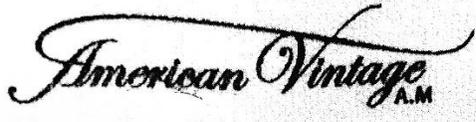
[8] Neither party filed written representations. Both parties were represented at the hearing.

ANALYSIS AND REASONS FOR DECISION

Display of the Mark as registered

[9] In his declaration, Mr. Azoulay states that, during the relevant period, the Mark was affixed to labels sewn inside the Owner's goods. In support, he attached as Exhibit B to his declaration [TRANSLATION] "copies of the various labels that are representative of all those used in Canada during the Relevant Period on the Goods bearing [the Mark] and sold in Canada as appears from the invoices produced".

[10] This exhibit contains photographs of bags and clothing, all bearing a label with the following mark:



[11] The Requesting Party submits that the evidence provided by the Owner does not display the Mark as it was registered, as the letters "A.M." have shifted to the right in the mark in Exhibit B.

[12] In determining whether the display of a trademark constitutes a display of the mark as registered, the question to be asked is whether the trademark has been used in such a way that it has retained its identity and has remained recognizable despite the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trademarks) v Cie International pour l'Informatique CIIHoneywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see if the "dominant features" of the trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 1992 CanLII 12831 (FCA), 44 CPR (3d) 59 (FCA)].

[13] In this case, I find that the dominant features of the Mark are the combination of words AMERICAN and VINTAGE interlaced in a stylized font.

[14] In my view, the mark displayed on the labels in Exhibit B is only a minor variation of the Mark as registered. In fact, the Mark remains recognizable, it has not lost its identity and the shift of the term “A.M.” slightly to the right is in no way likely to deceive or mislead the public, as the dominant features have been preserved. I therefore accept that the display of the Mark as shown in Exhibit B constitutes the display of the Mark as registered.

[15] In addition, in light of Mr. Azoulay’s assertion that the photographs of labels are representative of all the labels used during the relevant period, I accept that labels bearing the Mark were sewn inside goods sold by the Owner during the relevant period to order to give a notice of association within the meaning of section 4(1) of the Act.

[16] However, I note that Mr. Azoulay did not identify the goods in this exhibit and did not provide information that would allow me to conclude that these specific goods were sold in Canada during the relevant period. As a result, I find that Exhibit B was simply used to demonstrate how the Mark was affixed to the Owner’s goods.

Use of the Mark shown in association with certain Goods

[17] I note straightaway that Mr. Azoulay explains that the Mark was not used in association with the goods [TRANSLATION] “Leather and imitation leather”, “backpacks” and “costumes namely smoking jackets”. Since there is no evidence regarding them or special circumstances that would excuse non-use of the Mark, these goods will be deleted.

[18] That being said, Mr. Azoulay states that the Mark was used during the relevant period in Canada in the normal course of trade in association with all the remaining goods. He designates the goods in association with which he affirms use of the Mark with the term “the Goods”, a designation that I will use.

[19] However, it is well established that a mere allegation of use by the terms of the Act is not sufficient to establish use in a section 45 proceeding [*Diamant Elinor Inc. v. 88766 Canada Inc.*, 2010 FC 1184, at paras 8 and 9; and *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 CPR (2d) 62 (FCA)]. Mr. Azoulay's general allegation of use is therefore not sufficient in itself; the Owner is responsible for showing use by describing the facts that allow for an opinion to be formed or to logically infer use within the meaning of section 4 in association with each of the Goods [*Guido Berlucchi & C. S.r.l.'s v. Brouillette Kosie Prince*, 2007 FC 245 at para 18; *John Labatt Ltd. v. Rainier Brewing Co.*, (1984), 80 CPR (2d) 228 (FCA)].

[20] As evidence that the Goods were sold, Mr. Azoulay attached, as Exhibit A to his declaration, copies of invoices that he claims show the sale of each of the Goods. He states that [TRANSLATION] "each good designated in each of these invoices bore [the Mark] at the time of sale".

[21] The invoices attached to the declaration are dated during the relevant period and show the sale of several items by the Owner at PYA Importer LTD, with an address in Canada. In this regard, Mr. Azoulay indicates that between November 2015 and late August 2017, the Owner sold its Goods through a distributor, Société PYA Importer LTD. With respect to the Owner's normal course of trade, he also added that since September 2017, the Owner itself has manufactured and sold its Goods directly to the Canadian market.

[22] Mr. Azoulay stated that the items identified as [TRANSLATION] "tunics" on the invoices are actually "blouses", and similarly, the items identified as [TRANSLATION] "wrap" and "plaid" on the invoices are "stoles". He does not provide any additional correlation between the invoiced items and the Goods.

[23] Nevertheless, since they are clearly identified in the invoices filed in Exhibit A or very specifically correlated by Mr. Azoulay (regarding blouses and stoles), I accept the invoices presented in Exhibit A as evidence of the transfer of the following goods identified in the registration:

- coats (e.g., [TRANSLATION] “MID-LENGTH COAT ML”)
- jogging suits (e.g., “SWEAT SUIT”)
- jackets (e.g., [TRANSLATION] “SHORT SINGLE-BREASTED JACKET ML”)
- blouses (e.g., “ROUND COLLAR LONGSLEEVES STRIPED TUNIC”)
- pants (e.g., [TRANSLATION] “PANTS LARGE HIGH SIZE”)
- jeans (e.g., “SKINNY 5 POCKETS JEANS”)
- shorts (e.g., “HIGH WAIST OVERSIZED SHORTS”)
- Bermuda shorts (e.g., “TRAPEZE SEMI-LONG SHORTS”)
- dresses (e.g., [TRANSLATION] “STRAPPED DRESS ROUND NECK”)
- skirts (e.g., [TRANSLATION] “LONG SKIRT”)
- T-shirts (e.g., “TEE-SHIRT”)
- tank tops (e.g., [TRANSLATION] “TANK TOP ROUND NECK”)
- sweaters (e.g., “ROUND COLLAR LONGSLEEVES TRAPEZE SWEATER”)
- pullovers (e.g., [TRANSLATION] “ML PULLOVER BOATNECK”)
- shirts (e.g., [TRANSLATION] “ML SHIRT”)
- vests (e.g., [TRANSLATION] “VEST 7/8 SLEEVE”)
- sweatshirts (e.g., “SWEATSHIRT LS BOAT NECK”)
- scarves (e.g., “SCARF”)
- sashes (e.g., [TRANSLATION] “SASH”), and
- stoles (e.g., “PLAID”)

[24] In addition to the invoices in Exhibit A, Mr. Azoulay also referred to invoices that were not attached to his declaration. In particular, at paragraph 10 of his declaration, he provided the numbers of seven invoices and identified some items that presumably appear in them, along with their “codes”:

- Underwear (body): MALI9T and OPY49
- Suits (suit jacket): PAT97, JAG79 and IPI193
- Tracksuit jacket: TOU86

- Petticoat: AXI110
- Jogging suit: MISA90 (pullover) and MISA91 (jogging pants)
- Coat (Parka): CHIC401 and FUNY316
- Jogging (pants): CONY230
- Waterproof trenchcoat: STAR162
- Bag (leather): EDDIE and KENNY
- Leather belt: KEITH and WILSON
- Sports bag: BRITON
- Other bags: JAMIE and ETHAN

[25] Without a way of establishing that the invoices not adduced into evidence pertain to sales in Canada during the relevant period, I am not prepared to accept the mere reference to these invoices as evidence of use of the Mark.

[26] However, some correlations made by Mr. Azoulay between the codes and the Goods, along with his manner of referring to certain Goods, can be used to make for easier reading of the invoices attached to the declaration. For example, Mr. Azoulay's references to a [TRANSLATION] "Waterproof trenchcoat" and "Underwear (body)" suggest that the terms TRENCH and BODY on the invoices designate "raincoats" and "underwear," respectively. Similarly, Mr. Azoulay's references to a [TRANSLATION] "Jogging suit (pants)" and a "Legging (jogging pants)" clarifies the use of the terms JOGGING and LEGGING in the invoices as identifying "track pants".

[27] In light of the above, I accept the invoices presented in Exhibit A as evidence of transfer of the following goods identified in the registration:

- raincoats (e.g., "BLAZER COLLAR 7/8 SLEEVES DOULE-BREASTED LONG TRENCH")
- warm-up pants (e.g., "JOGGING" and "LEGGING"), and
- underwear (e.g., "BODY ML U NECK").

[28] I also find that certain invoices in Exhibit A refer to items designated by the codes identified by Mr. Azoulay in paragraph 10 of his declaration. I therefore accept that these invoices indicate sales of the following Goods:

- parkas (designated by the code CHIC401H16 and the description “LONG COAT LS BLAZER COLLAR”)
- petticoats (designated by the code H17AXI110 and the description [TRANSLATION] “PRINT SKIRT”), and
- track jackets (designated by the code H17TOU86 and the description “SWEAT ML HOOD”).

[29] In light of the foregoing, I find that the Owner demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act, in association with the following goods:

[TRANSLATION]

...clothing, namely coats, ...raincoats, parkas, ...jogging suits, jackets, blouses, pants, shorts, Bermuda shorts, dresses, skirts, petticoats, T-shirts, tank tops, sweaters, pullovers, shirts, vests, sweatshirts, warm-up pants, track jackets, ...underwear, scarves, sashes, stoles....

[30] However, for the following reasons, I find that the evidence did not demonstrate use of the Mark in association with the following goods:

[TRANSLATION]

...bags, i.e., handbags, shoulder bags, ...sport bags, clutch purses; ... waist-length jackets, ... suit and pant sets, ... bathing suits, ... belts (the Remaining Goods).

[31] In particular, the evidence provided does not allow me to correlate the Remaining Goods with the evidence. First, I do not see any clear link between them and any description in the invoices.

[32] Second, Mr. Azoulay did not provide correlation between the invoiced goods and the Remaining Goods. Moreover, except in the context of the declaration of goods covered by the registration and that of the identification of the codes associated with certain bags and belts in paragraph 10 of his declaration, Mr. Azoulay did not mention any of the Remaining Goods. As a result, I am not able to establish further correlations without speculating inappropriately as to the nature of the invoiced items [see *Fraser Milner Casgrain LLP v. Fabric Life Ltd.*, 2014 TMOB 135 at para 13 for the principle whereby the Registrar does not have to speculate on the nature of the wares sold].

[33] In addition, according to the Owner's representations at the hearing, certain invoiced items (such as the [TRANSLATION] "7/8 SLEEVE V-NECK PANTS SET", "ROUND COLLAR SLEEVELESS SHORT PANTS SUIT" or "U COLLAR 7/8 SLEEVES LARGE SWEATER") correspond to certain Remaining Goods. However, I am not prepared to accept these correlations simply on the basis of the Owner's representations. In that regard, I note that it would have been simple for Mr. Azoulay to provide such correlations as he had for the "blouses" and the "stoles".

[34] Lastly, I acknowledge that Mr. Azoulay provided sales figures for the sales regarding the [TRANSLATION] "Goods identified by [the Mark]". However, these are made up of annual sales figures, grouped by category (women, men, accessories). They are not broken down in a way that allows me to find that they include the sale of the Remaining Goods.

[35] As a result, I find that the Owner did not demonstrate use of the Mark in association with the Remaining Goods within the meaning of sections 4(1) and 45 of the Act. Since there is no evidence of special circumstances excusing the non-use of the Mark, the registration will be amended accordingly.

DISPOSITION

[36] 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 the following registered goods:

[TRANSLATION]

Leather and imitation leather; bags, namely handbags, shoulder bags, backpacks, sport bags, clutch purses; ... waist-length jackets, ... costumes namely smoking jackets, suit and pant sets, ... swim suits, ... belts.

[37] The amended statement will therefore read as follows:

[TRANSLATION]

clothing, namely coats, raincoats, parkas, jogging suits, jackets, blouses, pants, jeans, shorts, Bermuda shorts, dresses, skirts, petticoats, T-shirts, tank tops, sweaters, pullovers, shirts, vests, sweatshirts, warm-up pants, underwear, scarves, sashes, stoles.

Eve Heafey
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Tony Santin

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

HEARING DATE September 9, 2021

APPEARANCES

Chantal Desjardins

For the Registered Owner

R. Scott MacKendrick

For the Requesting Party

AGENTS OF RECORD

Lavery, De Billy, LLP

For the Registered Owner

Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L.

For the Requesting Party