



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 109

Date of Decision: 2023-06-28

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Hermes International

Registered Owner: Nasri International Inc.

Registration: TMA885,641 for MOSAIIC COLLECTION

INTRODUCTION

[1] This decision involves a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA885,641 for the trademark MOSAIIC COLLECTION (the Mark).

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

(1) Fashion clothing, namely pants, slacks, jeans, shorts, bermuda shorts, knickers, pedal pushers, tops namely tank and halter tops; jackets, blazers, shirt jackets, shirts, t-shirts, polo shirts, blouses, camisoles, vests, ponchos, sweaters, cardigans, turtlenecks, jumpers, culottes, sweat shirts, sweat pants, overalls, bodysuits, tights, body warmers, leg warmers, leggings, skirts, dresses, robes, shrugs, boleros, house coats, underwear tops and bottoms, lingerie, bathrobes, pyjamas, sleep shirts, night shirts, night gowns, bed jackets, clothing caps, gloves, mitts, hats, tuques, scarves, bonnets, head bands, socks, slippers, belts, swimsuits, swimwear, bathing-shorts, beach robes, beach jackets, beach cover-ups, cabana shorts and tops, beach hats, beach blankets, sundresses, rompers, receiving blankets, sleepers, bath blankets, suits and wind resistant jackets.

(2) Coats, raincoats, capes, shawls, parkas, bomber jackets, ski suits, ski pants, snow suits, snow jackets, snow vests, leather jackets, duffle coats, trench coats, suspenders, ties, neck warmers, belt buckles, shoes, boots, sandals, beach blankets, handbags, purses, clutch purses, wallets, coin purses, valises, luggage, travel garment bags, travel bags, luggage tags, cosmetic cases, perfume, cologne, cosmetics namely facial powder, lip powder, eyeliner, eyelash thickener, eyelash brushes, cosmetic brushes, cosmetic pads, lipstick and facial cream; key rings, jewellery namely rings, bracelets, necklaces, ornamental pins, cufflinks and watches; eyeglasses, dishes, cutlery and candles.

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

PROCEEDING

[4] At the request of Hermes International (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 1, 2021, to Nasri International Inc. (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods 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 1, 2018 to November 1, 2021.

[6] The relevant definition of “use” in the present case 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] Where the owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Nathalie Nasri, dated January 26, 2022, together with Exhibits 1 to 3.

[9] Neither party submitted written representations; however, both parties were represented at a hearing.

EVIDENCE

Preliminary remark regarding the trademark in evidence

[10] Before proceeding with summarizing the Owner's evidence, I note that while the Mark is registered as a word mark, three logos (the Logos), reproduced below, appear in the exhibits to Ms. Nasri's affidavit.



[11] The issue of whether the Logos in evidence constitute an acceptable variation of the Mark as registered will be addressed further below.

Overview of the evidence

[12] In her affidavit, Ms. Nasri identifies herself as the General Manager of the Owner, a family business operating since 1993 as manufacturer and distributor of fashion clothing and accessories for women, men and children.

[13] According to Ms. Nasri the business in which the Owner is involved is seasonal. In this respect, she states:

[F]or example, during 2017, [the Owner] would distribute to its customers and potential customers documents depicting wares that would be shipped to the customers for retail sales during the Spring of 2018 in association with the [Mark] [para 11].

[14] Ms. Nasri also states that the Owner's "clothing and accessories" have been continuously sold and distributed across Canada and in the United States. In particular,

she states that during the relevant period the Owner sold its goods to its retail customer, 168662 Canada Inc. (Liliane). She further states that each and every “garment or accessories” sold by the Owner during the relevant period had attached thereto a label or a hangtag displaying the Mark [paras 1 and 13-14].

[15] In support, the following exhibits are attached to Ms. Nasri’s affidavit:

- Exhibit 1: consists of 51 printouts of promotional material. I note that the printouts show eight different beachwear collections covering the seasons from the spring/summer 2018 to the spring/summer 2021. Each collection contain sketches and photographs of three to four different models of swim garments, such as swim-tops (underwire bras, crop-tops and “tankinis”), bottoms and full-body swim garments. For example, the “Amalfi Coast” collection, for the spring/summer 2020, shows four red floral swim garments, namely two swim-tops, one swim bottom and one full-body swim garment. A total of 33 swim garments identified under 33 different styles numbers are regrouped within the eight collections. The Logo 1 is displayed on the top of the first page of each collection. The photographs show hangtags displaying the Logo 2 and garment tags displaying the Logo 3. Ms. Nasri states that the hangtags are representative of those attached to the goods sold during the relevant period [para 16].
- Exhibit 2: consists of one photograph of a red floral full-body swim garment with a hangtag attached thereto which displays the Logo 2. Ms. Nasri states that this product is representative of those sold by the Owner [para 17].
- Exhibit 3: consists of six invoices issued by the Owner to Liliane in Canada and dated during the relevant period. Ms. Nasri confirms that the style numbers shown in the invoices relate to the Owner’s “beachwear” products sold during the relevant period [para 18]. I note that the left column of two invoices list four out of the 33 style numbers referenced through the promotional material.

ANALYSIS AND REASONS FOR DECISION

[16] At the hearing, the Owner claimed use of the Mark only in association with “swimwear” and “swimsuits” (the Claimed goods). With respect to use of the Mark in association with the remaining goods specified in the registration, the Owner conceded that the evidence is silent. As there are no special circumstances excusing the absence of use of the Mark with these remaining goods, the registration will be amended accordingly.

[17] The Requesting Party raised several issues which can be summarized as follows:

- Part of the evidence predates the relevant period;
- The trademarks in evidence are not the Mark as registered;
- The Owner’s normal course of trade is unclear;
- The evidence does not demonstrate use of the Mark with respect to *each* of the Claimed goods.

The evidence predating the relevant period

[18] The Requesting Party submits that part of the evidence is irrelevant and should be disregarded. In particular, it submits that the evidence related to the spring/summer 2018 season precedes the relevant period.

[19] I agree with the Requesting Party that the first seven pages of the promotional material, corresponding to the spring/summer 2018 collection, predates the relevant period. Therefore, I will not consider the contents of these pages in my decision.

The variation of the Mark

[20] The Requesting Party submits that the trademarks in evidence are a substantial deviation from the Mark as registered. In particular, it submits that the Mark as registered is written with two “I” letters, while the trademarks in evidence are written with one letter “I” with diaeresis.

[21] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the dominant features of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc*, 1992 CanLII 12831, 44 CPR (3d) 59 (FCA); *Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc*, 2016 FCA 265]. This is a question of fact to be determined on a case-by-case basis.

[22] In the present case, comparing the registered word mark to the Logos in evidence, I find that the Mark did not lose its identity and remains recognizable. In my view, the omission of one “l” and the addition of a diaresis over the remaining “l” does not change the identity of the Mark; the dominant feature of the Mark, namely, the word “MOSAIC”, can be easily read in each of the Logos and is therefore preserved. Consequently, I find that the trademarks in evidence constitute a minor deviation of the Mark as registered. Thus, I consider the Logos shown throughout the evidence to constitute display of the Mark as registered for the purpose of this proceeding.

The Owner’s normal course of trade

[23] The Requesting Party submits that the Owner’s normal course of trade is unclear. In particular, it submits that the Owner neither explains “when” the sales are made nor “what” the goods are. On the latter point, it submits that Ms. Nasri refers to “garment”, “clothing” and “accessories” without naming the goods as they are specified in the registration. It further submits that the invoices and the promotional material refer to “beachwear”, which is not specified in the registration.

[24] It has been held that there is no particular type of evidence that must be provided to show the normal course of trade in a section 45 proceeding and the evidence need not be perfect [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD) at 486]. Further, it is well established that reasonable inferences

can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64].

[25] In the present case, while I agree that Ms. Nasri did not expressly describe the Owner's normal course of trade, she did refer to the kind of business in which it is involved. She also provided an example of how the Owner promotes its goods and how long the estimated shipping time can be once the orders have been completed. Further, in view of the documentary evidence, I can infer that the Owner's normal course of trade consists of selling seasonal swim garments to its Canadian retailers for further sales to end-consumers several months later.

[26] As for the Requesting Party's submission that correlation of the evidence to the Claimed goods is unclear, from the evidence as a whole, I find that every and each product in evidence clearly correlates with swim garments. The issue of whether the swim garments correlate with the Claimed goods will be addressed below.

The swim garments sold under the Mark

[27] The Requesting Party submits that the invoices show that only three swim-tops were sold during the relevant period and that swim-tops do not correlate with "swimsuits". According to the Requesting Party, a swimsuit consists of a set of top *and* bottom swim garments. As the evidence is silent with respect to swim bottoms, it submits that the Owner has therefore failed to demonstrate use of the Mark in association with swimsuits. Further, although the Requesting Party appeared to concede at the hearing that swim-tops correlate with "swimwear", it submitted that the evidence of sales was unclear as one swim-top model, namely the underwire bra was identified as "sample" in the promotional material [Exhibit 1, page 27].

[28] The Owner simply submits in response that the evidence sufficiently demonstrates use of the Mark in association with swimsuits. It further submits that as "swimwear" includes "swimsuits" and any swim-related garments, the Claimed goods may both be maintained.

[29] First, I need not decide whether or not “swim-tops” constitute “swimsuits”, as I do not agree with the Requesting Party that only swim-tops were sold during the relevant period. From a fair review of the evidence, I note that the full-body red floral swim garment, shown in the photograph [Exhibit 2], corresponds to the “Amalfi Coast” model from the Spring/summer 2020 collection in the promotional material. This garment’s style number is LBL1237AC [Exhibit 1, page 34], which is listed in the invoice dated September 14, 2021 [Exhibit 3, page 6]. Second, contrary to the Requesting Party’s submissions, bottom garments [Exhibit 1, page 34], style number LBL1236BAC, were also sold under the same invoice.

[30] The question remains whether the evidenced sales of swim garments under the Mark supports the conclusion that use has been shown with both of the Claimed goods.

[31] As the Owner chose to list the Claimed goods separately in the registration, the implication is that one good is somewhat different from the other and, therefore, use must be shown with respect to *each* Claimed good [*John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA); see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[32] Based on common sense, I agree with Owner that “swimwear” includes “swimsuits”. In my view, swim-related garments other than swimsuits, such as swim dresses, swim skirts and swim trunks, reasonably correspond to “swimwear”. Similarly, the components of a two-piece swimsuit, such as bras or tankinis and bottoms also correspond to swimwear. To that extent, I find that “swimwear” is a more generalized and broader good than “swimsuits”.

[33] In the present case, the evidence shows that the Mark was associated with full-body swimsuits [Exhibit 1, page 34 and Exhibit 2] and with swimwear, namely underwire bras, tankinis [Exhibit 1, pages 27 and 34] and bottoms [Exhibit 1, page 34]. All these goods, including the underwire bras, were the subject of commercial transactions as the invoices show that 38 full-body swimsuits, 156 underwire bras, 66 tankinis and 66 bottoms were sold within the Owner’s normal course of trade in Canada during the relevant period [Exhibit 3, pages 3 and 6].

[34] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with “swimsuits” and “swimwear” within the meaning of sections 4(1) and 45 of the Act.

DISPOSITION

[1] Accordingly, 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 goods:

(1) Fashion clothing, namely pants, slacks, jeans, shorts, bermuda shorts, knickers, pedal pushers, tops namely tank and halter tops; jackets, blazers, shirt jackets, shirts, t-shirts, polo shirts, blouses, camisoles, vests, ponchos, sweaters, cardigans, turtlenecks, jumpers, culottes, sweat shirts, sweat pants, overalls, bodysuits, tights, body warmers, leg warmers, leggings, skirts, dresses, robes, shrugs, boleros, house coats, underwear tops and bottoms, lingerie, bathrobes, pyjamas, sleep shirts, night shirts, night gowns, bed jackets, clothing caps, gloves, mitts, hats, tuques, scarves, bonnets, head bands, socks, slippers, belts, ..., bathing-shorts, beach robes, beach jackets, beach cover-ups, cabana shorts and tops, beach hats, beach blankets, sundresses, rompers, receiving blankets, sleepers, bath blankets, suits and wind resistant jackets.

(2) Coats, raincoats, capes, shawls, parkas, bomber jackets, ski suits, ski pants, snow suits, snow jackets, snow vests, leather jackets, duffle coats, trench coats, suspenders, ties, neck warmers, belt buckles, shoes, boots, sandals, beach blankets, handbags, purses, clutch purses, wallets, coin purses, valises, luggage, travel garment bags, travel bags, luggage tags, cosmetic cases, perfume, cologne, cosmetics namely facial powder, lip powder, eyeliner, eyelash thickener, eyelash brushes, cosmetic brushes, cosmetic pads, lipstick and facial cream; key rings, jewellery namely rings, bracelets, necklaces, ornamental pins, cufflinks and watches; eyeglasses, dishes, cutlery and candles

[2] The amended statement of goods will read as follow:

(1) Swimsuits, swimwear.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-05-25

APPEARANCES

For the Requesting Party: Catherine Daigle

For the Registered Owner: Harold W. Ashenmil

AGENTS OF RECORD

For the Requesting Party: NORTON ROSE FULBRIGHT CANADA

LLP/S.E.N.C.R.L.,S.R.L.

For the Registered Owner: Harold W. Ashenmil