



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2024 TMOB 51

**Date of Decision:** 2024-03-25

## IN THE MATTER OF A SECTION 45 PROCEEDING

**Requesting Party:** BCF S.E.N.C.R.L./BCF LLP

**Registered Owner:** Kazar Group Spółka z ograniczona odpowiedzialnoscia

**Registration:** TMA1,021,184 for KAZAR

### 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. 1,021,184 for the trademark KAZAR (the Mark), owned by Kazar Group Spółka z ograniczona odpowiedzialnoscia (the Owner).

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

(1) Shoe wax, shoe cream, shoe polish, leather polishes, leather preserving polishes, perfumery, essential oils for personal use, cosmetics; goods made of paper or cardboard namely labels, boxes, bags; printed matter and publications in the field of fashion, jewelry, cosmetics: posters, souvenir albums, pamphlets, maps, postcards, catalogues, photographs, paper stationery, writing implements, wrapping paper, greeting cards; goods made of leather and imitation leather namely, leashes, backpacks, book bags, sports bags, trunks, chests, suitcases and travel bags, purses and wallets, pouches, vanity cases, attaché cases, briefcases, small clutch purses, cosmetic cases and bags, cases

for manicure sets, garment bags, umbrellas and parasols; clothing namely casual clothing, business clothing, children's clothing, sports clothing, socks, tights, footwear namely children's, women's and men's shoes, insoles for shoes and boots, headwear namely, headbands, neckerchief, headscarves, headdresses, hats, caps, berets and cap visors

(2) Polishing preparations for shoes and leather, shoe polish, preservatives for leather (polishes), shoe wax, perfumery, essential oils for personal use, cosmetics; Calendars, catalogues, magazines, note books, mats for beer glasses, writing cases (stationery), boxes of cardboard or paper, bags [envelopes, pouches] of paper or plastic for packaging, flyers, patterns for making clothes; Hand bags, briefcases, wallets, leather thongs, attache cases, rucksacks, leather leashes, luggage, leather vanity cases, not fitted.

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

### **PROCEEDING**

[4] At the request of BCF S.E.N.C.R.L./BCF LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on May 11, 2022, to the Owner.

[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 May 11, 2019, to May 11, 2022.

[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] 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 38] 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 the goods.

[8] 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.

[9] In response to the Registrar’s notice, the Owner furnished an affidavit of Grzegorz Filipek, the Owner’s Vice President, sworn on December 9, 2022, to which were attached Exhibits A through D.2.

[10] Both parties submitted written representations; no oral hearing was requested.

### **EVIDENCE**

[11] Mr. Filipek states that the Owner offers “shoes, bags, various accessories, perfumes” [para 6]. The Owner commercialises its products via sales points in Poland and Hungary [para 7] as well as online via its website [para 8].

[12] Mr. Filipek indicates that the Owner sells to customers in Canada via its website. He explains that to make such a purchase, Canadian customers must first open a “Customer Account” with the Owner. Once an account has been opened, Canadian customers can shop online after having logged in [paras 11-12]. Purchases made online are then “delivered via DHL courier company” [para 13].

[13] Mr. Filipek specifically states that “[t]he Mark is on virtually each of the Kazar Group goods [...], as well as being prominently featured on invoices for the sale of Goods to consumers” [Para 14]. In this regard, Mr. Filipek attaches an invoice dated February 28, 2022, with an English translation, for the sale of a pair of men’s shoes to Canada [Exhibits B.1 and B.2], as well as DHL delivery receipts for same [para 16, Exhibits C.1 and C.2]. Mr. Filipek specifically states that the shoes identified in such invoice “have the Mark, KAZAR, imprinted on the insoles of the shoes” [para 15].

[14] With regard to other goods, Mr. Filipek indicates that the Owner’s website, “accessible to Canadians as well as others shows [...] goods bearing the Mark in the catalogue” and provides specific links to such website [para 17]. He further indicates

how to navigate the website to see the Mark on the products when not immediately visible on the website and invites the Registrar to do so [para 18]. However, no copies or printouts of the Owner's website, current or as it appeared during the relevant period, are included in the affidavit.

[15] Mr. Filipek references various third-party websites where the Owner promotes its brand and goods, including Facebook, Instagram and YouTube [paras 19-22]. No copies or printouts of such websites, current or as they appeared during the relevant period, are included in the affidavit.

[16] Mr. Filipek indicates that "the development of the KAZAR brand and the use of the KAZAR Mark in Canada [...] during much of the relevant period was stopped because of COVID restrictions" [para 23]. He nevertheless specifies that the Owner resumed activity in Canada in 2022 and is "offering shoes and bags on the www.amazon.com platform for Canadian customers" and provides links accordingly [para 24]. Again, no printouts of such links are provided.

[17] Lastly, Mr. Filipek attaches an invoice with English translation for a sale of women's shoes, which he indicates "have the Mark imprinted on the insoles" [paras 25-26, Exhibits D.1 and D.2]. This invoice is dated July 14, 2022, which I note is after the relevant period.

### **ANALYSIS AND REASONS**

[18] As a preliminary evidentiary matter, I note that section 45(2) of the Act states that the Registrar "shall not receive any evidence other than the affidavit or statutory declaration". As such, I cannot visit or consider any of the webpages to which Mr. Filipek provides links in his affidavit. To be considered as evidence, the Owner would have needed to furnish relevant excerpts or printouts of said webpages [see *Lutron Electronics Co, Inc v Limbic Media Corporation*, 2024 TMOB 32; *Smart & Biggar LLP v MMG Management Consulting Inc*, 2021 TMOB 190; *Relativity Media LLC v Dandrade Designs Inc*, 2016 TMOB 109]. Moreover, even if I could visit these webpages, they would be of little assistance absent evidence that they are representative of the relevant period.

[19] With regard to transfers in the normal course of trade during the relevant period, I note that the only evidence of sales is a single invoice showing the sale of one pair of men's shoes. Mr. Filipek provides no other invoices, sales figures, or evidence of sales of any other goods, nor does he clearly state that such sales occurred during the relevant period. His evidence in this regard is limited to statements that such goods *are offered* via the Owner's website "accessible to Canadians" and that "[n]ow Kazar Group is additionally offering shoes and bags on the www.amazon.com platform for Canadian customers" [my emphasis]. However, a mere assertion that goods were made available for purchase to Canadians is insufficient to demonstrate transfer of property in the normal course of trade [see *Relativity Media*, above; *Riches, McKenzie & Herbert LLP v Cleaner's Supply Inc*, 2012 TMOB 211; and *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)]. Moreover, it is at best unclear to what extent, if any, such evidence pertains to the relevant period.

[20] Regarding the third party websites where the Owner asserts it promotes the registered goods and the Mark, I note that display of a trademark in advertising is not in itself sufficient to establish use of a trademark in association with goods. For the display of a mark in advertisements and promotional material to be sufficiently associated with a good to constitute use, such material would have to be given at the time of transfer of the property in or possession of that good [*Nissan Canada Inc v BMW Canada Inc*, 2007 FCA 255 at para 25]. No evidence of such association was provided in the present case.

[21] With regard to evidence of one sale of a pair of women's shoes, as noted above, this evidence is dated after the relevant period. As such, the only goods shown to have been sold in Canada during the relevant period are men's shoes.

[22] In this regard, Mr. Filipek provides one invoice evidencing a single sale during the relevant period. He states that the men's shoes subject of the invoice "have the Mark, KAZAR, imprinted on the insoles of the shoes", but he does not provide a photograph or other representative image of the goods. As such, the only evidence as

to display of the Mark on men's shoes during the relevant period is Mr. Filipek's statement to this effect.

[23] However, it is well established that in response to a section 45 notice, the Owner must not merely state, but *show* use of the Mark [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA) and *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401 at para 18].

[24] In the present case, without further evidence detailing how the Mark was displayed on the insoles of the shoes, it is not possible to determine whether such display constitutes use within the meaning of sections 4(1) and 45 of the Act. For example, it is not clear from the affiant's statement whether the Mark *per se* was displayed, either alone or with additional matter, such that it cannot be determined from this evidence if the Mark was used as registered [see *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)].

[25] Indeed, this requirement that the Owner show rather than state use of the Mark is illustrated, in the present case, by the invoice provided by the Owner. Mr. Filipek states that the "Mark is [...] prominently featured on invoices for the sale of Goods to consumers". However, the invoice does not display the Mark *per se*. Rather, the only display of KAZAR on the invoice is in the indication "Seller: Kazar Group Sp. z. o. o". Similarly, the DHL delivery information displays KAZAR as "Consignor/Exporter KAZAR GROUP SP.Z.O.O.". On both the invoice and the delivery information, these mentions are followed by the Owner's address, and are depicted in the same basic font rather than in a manner that would distinguish them. Moreover, the description of the goods does not contain the Mark on either document. These facts show use of a trade name rather than use as a trademark [per *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440; see also *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD); *Virgin Enterprises Limited v Virgin Water Inc*, 2023 TMOB 175].

[26] In view of the above, I am not satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act during the relevant period in association with any goods specified in the registration, including men's shoes.

[27] It must therefore be determined whether, pursuant to section 45(3) of the Act, there existed special circumstances that excuse the absence of use of the Mark. The general rule is that absence of use will be penalized by expungement unless special circumstances excusing non-use are established [per *Smart & Biggar v Scott Paper Ltd*, 2008 FCA 129, *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA) and *John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD) at para 29].

[28] In the present case, Mr. Filipek has stated only that "use of the KAZAR Mark in Canada [...] during much of the relevant period was stopped because of COVID restrictions". However, it has recently been stated that "it is not sufficient for an owner to refer to the pandemic generally without providing sufficient details regarding its impact on the owner's operations" [*Pelton Crane Inc v KaVo Dental Technologies, LLC*, 2023 TMOB 123 at para 20; see also *The Wonderful Company LLC and Fresh Trading Limited*, 2023 TMOB 8].

[29] In the present case, I consider the Owner's statement regarding the COVID-19 pandemic to constitute just such an insufficient general reference. As such, I am not satisfied that the Owner has established special circumstances excusing non-use of the Mark in association with any of the goods specified in the registration.

**DISPOSITION**

[30] 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 expunged.

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Emilie Dubreuil  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office



## Appearances and Agents of Record

**HEARING DATE:** No hearing held

### **AGENTS OF RECORD**

**For the Requesting Party:** BCF S.E.N.C.R.L./BCF LLP

**For the Registered Owner:** Perry + Currier