



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 89

Date of Decision: 2024-05-07

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: 88766 Canada inc.

Registered Owner: Incontro S.P.A.

Registration: TMA967,218 for TRANSIT

OVERVIEW

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA967,218 for the trademark TRANSIT (the Trademark), owned by Incontro S.P.A. (the Owner).

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

Casual clothing; waterproof clothing; casual clothing of imitations of leather; casual clothing of leather; dresses; suits; jumper dresses; bath robes; bandanas (neckerchiefs); bibs, not of paper; caps (headwear); berets; underwear; boas (necklets); braces for clothing (suspenders); stockings; socks; breeches for wear; bathing trunks; shirts; coats; hoods (clothing); belts (clothing); tights; layettes (clothing); bathing suits; beach clothes; neckties; headbands (clothing); pocket squares; scarves; jackets (clothing); skirts; overalls; gloves (clothing); ready-made casual clothing; casual paper clothing; knitwear (clothing); jerseys (clothing); leggings (leg warmers); hosiery; sports jerseys; sweaters; muffs (clothing); pelerines; mantillas; vests; trousers; parkas; pelisses; furs (clothing); pajamas; collar protectors;

shawls; sashes for wear; overcoats; outer clothing; petticoats; shirt fronts; fur stoles; pockets for clothing; tee-shirts; turbans; combinations (clothing); uniforms; veils (clothing); dressing gowns; motorists' clothing; cyclists' clothing; sports singlets; fishing vests; clothing for gymnastics; headwear; headgear for wear; hats; visors (headwear); cap peaks

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

RECORD

[4] On December 28, 2022, at the request of 88766 Canada inc. (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T 13 (the Act) to the Owner.

[5] The notice required the Owner to show whether the Trademark 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 the Trademark was last in use and the reason for the absence of such use since that date. The relevant period for showing use is therefore between December 28, 2019 and December 28, 2022.

[6] The relevant definition of "use" 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] However, where the Owner has not shown use as described above, 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 submitted the affidavit of Andrea Cozza, legal representative of the Owner, sworn on July 21, 2023, together with Exhibits A to C.

[9] Only the Owner filed written representations. Both parties were represented at a hearing.

EVIDENCE

[10] Mr. Cozza states the Owner licenses the manufacturing and sale of the registered goods, to which he refers collectively as the "TRANSIT Goods", to its licensee Tam & Company SPA (Tam). Mr. Cozza attests that since 2018, the Owner has had "full and direct control of the character and quality of the goods that are produced and sold by TAM under the TRANSIT Trademark" [para 5].

[11] Mr. Cozza states that Tam sells the TRANSIT Goods that it manufactures to Canadian stores, which in turn sell the goods to Canadian consumers. He also states that Tam provides Canadian stores with "lookbooks" and "modellario guides" (also identified collectively as "catalogues" in his affidavit) to promote and showcase the TRANSIT Goods. Mr. Cozza provides representative catalogues which he attests were sent to Canadian stores during the relevant period [Exhibit A].

[12] Mr. Cozza asserts that the Trademark was used during the relevant period in Canada in association with the TRANSIT Goods with the exception of "Bibs, not of paper, stockings, layettes, casual paper clothing, sports jerseys, motorists' clothing, cyclist's clothing, fishing vests, clothing for gymnastics; underwear" [para 8] (the Conceded Goods).

[13] As for direct evidence of sales, Mr. Cozza provides representative invoices issued during the relevant period by TAM to Canadian stores located

in Toronto and Montreal [Exhibits B1 to B4]. I note that the Exhibit B invoices reference various clothing and apparel items. Some of the product descriptions, namely "jacket", "trousers", "shirt", "skirt", "overcoat", "parka", "t-shirt", "dress", "hat", "coat", "scarf", "overall", and "gloves", plainly correspond to goods listed in the registration. Other product descriptions are not specified as such in the registration, namely "jumper", "tank", "trench", "cardigan", "waistcoat", "mask", "sweatshirt" and "slip".

[14] According to Mr. Cozza, invoiced product descriptions employ general terms which can refer to more than one specific product. He explains that the specific product sold can be identified by referring to its product code, also shown in the invoices. He further explains that it is possible to cross-reference the codes with products depicted in the Owner's catalogues.

[15] At paragraph 13 of his affidavit, Mr. Cozza cross-references certain invoiced items with products shown in exhibited catalogues; he correlates those items with the following registered goods: "dresses", "jumper dresses", "shirts", "coats", "overalls", "gloves (clothing)", "sweaters", "trousers", "parkas", "overcoats", "outer clothing", "headwear", "Casual clothing", "casual clothing of leather", "hoods (clothing)", "scarves", "jackets (clothing)", "skirts", "knitwear (clothing)", "ready-made casual clothing", "furs (clothing)", and "tee-shirts".

[16] In addition to the above, at paragraphs 19 to 21 of his affidavit, Mr. Cozza identifies belts, leggings, and jerseys in the Exhibit A catalogues which he attests are representative of those "sold under the TRANSIT Trademark during the Relevant Period". Mr. Cozza does not, however, identify any belts, leggings or jerseys in the exhibited invoices, or otherwise evidence transfers of such goods.

[17] Similarly, at paragraphs 15 to 18 of his affidavit, Mr. Cozza identifies other products shown in the Exhibit A catalogues which he correlates to goods specified in the registration. Mr. Cozza provides neither a statement regarding sales nor a correlation between those catalogue products and any of the items listed in the invoices.

[18] As for display of the Trademark, Mr. Cozza attests that the goods referenced in the Exhibit B invoices all relate to "TRANSIT Goods under the TRANSIT Trademark only" [para 11], and that those goods bear the Trademark. In support, he provides images of labels and tags which he states are representative of those attached to all TRANSIT Goods sold in Canada during the relevant period [Exhibit C]; I note two images which are photographs showing tags attached to articles of clothing. The Trademark is displayed on all of the depicted labels and tags.

REASONS

[19] To begin, I will address Mr. Cozza's concession regarding the absence of use of the Trademark in association with the Conceded Goods. As there is no evidence of special circumstances excusing non-use of the Trademark, those goods will be deleted from the registration.

[20] With respect to the remaining goods, the Owner essentially submits that it is only required to establish a *prima facie* case of use, and directs attention to the purpose of summary expungement proceedings to clear deadwood from the register. At the hearing, the Owner argued that the evidence provides "pieces of the puzzle" that, when considered together, supply facts from which a conclusion of use may follow as a logical inference.

[21] I am satisfied that the evidence establishes, at a minimum, that:

- the Owner has, under licence, control of the character and quality of the goods manufactured and sold by Tam, such that any use of the Trademark by Tam enures to the benefit of the Owner pursuant to section 50 of the Act;
- Tam sold TRANSIT Goods in Canada during the relevant period; and
- the Trademark was displayed on labels and tags attached to the TRANSIT Goods sold.

[22] With respect to the last point, I note here that many of the Requesting Party's submissions at the hearing were related to the Owner's alleged failure to show the requisite notice of association between the Trademark and each of the goods specified in the registration. For example, the Requesting Party argued that the Owner failed to establish that invoices, which bear the Trademark, were provided to purchasers at the time of transfer. The Requesting Party also argued that the Owner failed to provide photographs showing labels and tags attached to each one of the subject goods.

[23] I disagree with the Requesting Party that evidence specifically showing the manner in which the Trademark was associated to each of the subject goods is required. The evidence before me includes photographs of labels and tags bearing the Trademark, which Mr. Cozza clearly states are representative of those attached to all TRANSIT Goods sold in Canada during the relevant period. Two of those photographs even show tags hanging from what appear to be jackets. I accept that similar labels and tags were attached to each of the goods sold during the relevant period, and I am satisfied that the requisite notice of association was given at the time of their transfer.

[24] As for which of the TRANSIT Goods were sold, the answer is less clear.

[25] I will begin by addressing the correlations made by Mr. Cozza at paragraph 13 of his affidavit. As indicated above, the invoices furnished by the Owner reference various clothing and apparel items. Mr. Cozza correlates certain invoiced items with particular registered goods and I accept those correlations at face value [per *Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25 for the well-established principle that an affiant's statements must be accorded substantial credibility in a section 45 proceeding].

[26] In light of the foregoing, and having regard to the representative evidence of display of the Trademark, I am satisfied that the Owner has demonstrated use of the Trademark within the meaning of sections 4 and 45 of the Act in association with the registered goods correlated by Mr. Cozza at paragraph 13 of his affidavit. Those registered goods will therefore be maintained.

[27] With respect to the remaining TRANSIT Goods, the Owner submits that the invoices are merely representative of some of the sales that have taken place and that, when viewed as a whole, the evidence is sufficient to infer that goods which are not explicitly referenced or identified in the invoices were also sold within the relevant period in Canada.

[28] The Owner's position in this regard is multifaceted and appears to be at least in part premised on its position that providing evidence pertaining to each of the asserted registered goods would have been evidentiary overkill. In this regard, the Owner submitted at the hearing that many of the goods specified in the registration are "obviously related" and can be divided into "subgroups" such that demonstrating use of the Trademark in association with some of the goods is sufficient to demonstrate use for all of the asserted goods. The Owner gave examples of alleged subgroups, such as a "tops" subgroup including e.g. shirts, vests and sweaters, but conceded that

subgroup classifications are less than obvious for other asserted goods such as “pajamas” and “collar protectors”.

[29] The Owner also submitted that, in view of the purpose of section 45 proceedings, one must not be “overly technical” when assessing the description of goods. In this respect, the Owner stressed that “general terms” are used to designate more than one product. By way of example, the Owner referenced Mr. Cozza’s statement that invoiced products described as “shorts” also correspond to “swim shorts [bathing trunks]” or “beach clothes” [at para 18 of the affidavit of Mr. Cozza]. Similarly, the Owner contended that certain goods can be combined to form other goods, directing my attention to a statement that jackets and trousers can be combined and sold as a “suit” [*id.* at para 17].

[30] It is well-established that an owner’s evidentiary burden is not a stringent one and that representative evidence can be sufficient for the purposes of section 45 proceedings. However, a registered owner must still establish a *prima facie* case of use of its trademark in association with *each* of the goods specified in a registration, and use evidenced with respect to one specific good cannot generally serve to maintain multiple goods [*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].

[31] Moreover, to the extent that the Owner seeks to rely on invoiced items which are not correlated by Mr. Cozza, I note that it is not the Registrar’s position to speculate as to the nature of the goods and it is an owner’s responsibility to show the connection between evidenced products and the goods listed in the registration [*Fraser Milner Casgrain LLP v Fabric Life Limited*, 2014 TMOB 135 at para 13; see *Vermillion Intellectual Property Corporation v Vermilion Energy Inc*, 2017 TMOB 24 at para 70 for the

principle that a trademark owner takes a risk when it leaves correlations between the evidence and the registered goods to the Registrar].

[32] In spite of the above, and based on my own review of the invoices, I am prepared to make one correlation between an invoiced product and a registered good, that is for a product described as a "HAT" in an Exhibit B1 invoice dated 01.09.2021. The product in question is identified by a code which differs from that of the "HAT" correlated to the registered goods "headwear" by Mr. Cozza at paragraph 13 of his affidavit. Given Mr. Cozza's statements about the significance of product codes, and also that this product plainly corresponds to a registered good, I accept that the HAT product referenced in the 01.09.2021 invoice is different from the one referenced by Mr. Cozza, and I accept the invoice in question as representative evidence of transfers of the registered goods "hats". Consequently, "hats" will also be maintained in the registration.

[33] I will finally address the correlations made by Mr. Cozza for which no evidence of transfers was provided. In this respect, I agree with the Owner that direct documentary evidence of transfers such as invoices is not required for each registered good. However, some evidentiary basis from which it is possible to logically infer transfers is necessary. By way of example, in the absence of invoices, such evidence can be in the form of documentation like sales reports, or through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[34] In light of the above, the correlations made by Mr. Cozza at paragraphs 15 to 21 of his affidavit between goods listed in the registration and those shown in catalogues, without further evidence to support a finding that those goods were also sold during the relevant period, do not assist the

Owner [see, for example, *Molson Cos v Halter* (1976), 28 CPR (2d) 158 (FCTD); and *Gowling, Strathy & Henderson v Royal Bank* (1995), 63 CPR (3d) 322 (FCTD)].

[35] Before concluding, I wish to point out that I consider Mr. Cozza's identification of certain catalogue products as representative of belts, leggings, and jerseys "sold" to be tantamount to bare assertions of use. As a result, without further particulars regarding such sales, I find that this evidence also falls short of what is required to establish use.

[36] In sum, I am not satisfied that the Owner has demonstrated use of the Trademark in association with any of the remaining goods within the meaning of sections 4 and 45 of the Act. In essence, the Owner is asking that I infer use of the Trademark in association with all of the asserted goods on the basis of use evidenced in association with only some of them. Such a conclusion would in this case be mere speculation [see *Diamant Elinor, supra*, at para 11 for the principle that the Registrar must "rely on an inference from proven facts rather than on speculation" to satisfy every element required by the Act].

[37] As there is no evidence of special circumstances before me which would excuse non-use of the Trademark, the registration will be amended accordingly.

DISPOSITION

[38] 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:

... waterproof clothing; casual clothing of imitations of leather; ... suits; ... bath robes; bandanas (neckerchiefs); bibs, not of paper; caps (headwear); berets; underwear; boas (necklets); braces for clothing (suspenders); stockings; socks; breeches for wear; bathing trunks; ... belts (clothing);

tights; layettes (clothing); bathing suits; beach clothes; neckties; headbands (clothing); pocket squares; ... casual paper clothing; ... jerseys (clothing); leggings (leg warmers); hosiery; sports jerseys; ... muffs (clothing); pelerines; mantillas; vests; ... pelisses; ... pajamas; collar protectors; shawls; sashes for wear; ... petticoats; shirt fronts; fur stoles; pockets for clothing; ... turbans; combinations (clothing); uniforms; veils (clothing); dressing gowns; motorists' clothing; cyclists' clothing; sports singlets; fishing vests; clothing for gymnastics; ... headgear for wear; ... visors (headwear); cap peaks

[39] The statement of goods will now read as follows:

Casual clothing; casual clothing of leather; dresses; jumper dresses; shirts; coats; hoods (clothing); scarves; jackets (clothing); skirts; overalls; gloves (clothing); ready-made casual clothing; knitwear (clothing); sweaters; trousers; parkas; furs (clothing); overcoats; outer clothing; tee-shirts; headwear; hats;

Eve Heafey
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-04-02

APPEARANCES

For the Requesting Party: Stéphanie Karam

For the Registered Owner: Victoria Carrington

AGENTS OF RECORD

For the Requesting Party: Robic Agence PI S.E.C. / Robic IP Agency LP

For the Registered Owner: Aventum IP Law LLP