



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2016 TMOB 47**  
**Date of Decision: 2016-03-29**  
**[UNREVISED ENGLISH**  
**CERTIFIED TRANSLATION]**

**IN THE MATTER OF A SECTION 45 SUMMARY EXPUNGEMENT PROCEEDING**

**Clark Wilson LLP**

**Requesting Party**

**and**

**Les Importations Enzo-M Ltée**

**Registered Owner**

**TMA360,782 for FRANCESCA**

**Registration**

The record

[1] On April 7, 2014 at the request of Clark Wilson LLP, the Registrar sent the notice stipulated in section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Les Importations Enzo-M Ltée (the Registered Owner), holder of registration No. TMA360,782 for the FRANCESCA trade-mark (the Mark).

[2] This notice enjoined the Registered Owner to prove that its Mark was used in Canada at any time between April 7, 2011 and April 7, 2014 (the relevant period), in association with the goods specified in the registration, namely "shoes" and, in the negative, the date when the Mark was used for the last time and the reason for its failure to use it since that date.

[3] In response to the Registrar's notice, the Registered Owner filed an affidavit submitted by its President, Vincenzo Masciotra, on November 3, 2014.

[4] Neither of the parties filed written representations. Only the Registered Owner was represented at a hearing.

### Analysis

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register; this is why the applicable test is not very stringent. As stated by Judge Russell in *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC), at p. 282:

We know that the purpose of s. 45 proceedings is to clean up the “deadwood” on the register. We know that the mere assertion by the owner that his trade-mark is in use is not sufficient and that the owner must “show” how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owner’s business and merchandising practices.

[6] In the present case, section 4 of the Act defines use in association with goods as follows:

- (1) A trade-mark 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 the case at bar, the evidence filed by the Registered Owner uncontestedly establishes the use of the Mark in association with the goods covered by the registration during the relevant period.

[8] Mr. Masciotra's detailed assertions and explanations concerning the use of the Mark in Canada during the relevant period in association with shoes particularly address the fact that the Registered Owner's customers are, inter alia, retail shoe stores located in different Canadian cities, such as Laval, Montreal or Ottawa, and are corroborated by several vouchers, including:

- Exhibit 1, which consists of colour photographs showing the Mark affixed inside shoes, on boxes containing shoes, and on signs placed beside shoes sold under the Mark;

- Exhibit 2, which consists of copies of purchase orders submitted between April 7, 2011 and April 7, 2014; and
- Exhibit 3, which consists of copies of delivery slips and invoices linked to the purchase orders of Exhibit 2.

[9] Without going into detail, it is appropriate to mention that Mr. Masciotra takes care to specify that the photographs in Exhibit 1 are representative of the manner in which the Mark was used during the relevant period. Also, the purchase orders and delivery slips for the shoes expressly refer to the Mark, and the invoices and delivery slips expressly refer to the purchase order numbers.

#### Disposal

[10] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Certified true translation  
Arnold Bennett

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** 2016-03-29

**APPEARANCES**

Johanne Muzzo

FOR THE REGISTERED OWNER

**AGENTS IN THE CASE**

Guy & Muzzo Inc.

FOR THE REGISTERED OWNER

Clark Wilson LLP

FOR THE REQUESTING PARTY