



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

Citation: 2011 TMOB 168
Date of Decision: 2011-09-29

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Borden Ladner Gervais against registration
No. TMA606,484 for the trade-mark MOMO DESIGN in
the name of Momo Design s.r.l.**

[1] At the request of Borden Ladner Gervais (the Requesting Party), the Registrar of Trade-marks issued a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on January 20, 2009 to Coalision, Inc., the registered owner (the Registrant) in respect of registration No. TMA606,484 for the trade-mark MOMO DESIGN (the Mark).

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

(1) Goods made of leather and imitations of leather, namely, suitcases, travel bags, handbags, rucksacks, trunks, purses, wallets, briefcases, vanity cases sold empty, key-rings made of leather. (2) Apparatus for reproducing sounds, namely, loud-speakers; apparatus for recording sounds, namely, tape recorders, cassette recorders and CD-ROM recorders; video cameras; telephones; radios; cameras; pocket and table calculating machines; measuring instruments, namely, tape measures and scales; barometers; marine compasses; echo-sounders for boats and ships; electric irons; electric switches; computers, computer printers and parts and fittings for these goods; fire alarms; theft-alarms not for vehicles; fire extinguishers; luminous signals of emergency exits; eye-glasses, sun glasses; frames and lenses for glasses; spectacles; cases and chains for glasses; clothing, namely, pants, dresses, suits, overalls, jackets, overcoats, skirts, shirts, t-shirts, blouses, wristbands, hairbands, scarves, ties, belts, gloves, socks, stockings, pajamas, nightgowns, nightshirts, underwear, swimsuits; clothing for use by motor car drivers, motorcyclists and cyclists, namely, racing suits, balaclavas, socks, jackets, pile jackets, jackets with rib and elbow protectors, shirts, sweatshirts, vests, pants, pants with

knee protectors, gloves; tennis suits, tennis shirts, fencing overalls, ski overalls, ski pants, ski jackets, ski gloves, fencing gloves, balaclavas for skiers, boat oilskin jackets, boat oilskin trousers, boat anoraks, horse-riding pants; footwear, namely, shoes, boots, racing boots, racing shoes, ski boots, horse riding boots, boat shoes; hats and caps; games and playthings, namely, table games, video games; snowboards. (3) Gymnastic equipment, namely, balls, stationery exercise bicycles, weight stacks, lateral bars, press bars, leg curl bars, leg extension bars, tricep bars, pectoral decks, rowing machines, dumbbells, ankle weights, skipping-ropes, chest expanders, twist bars, handgrips, barbells, climbers, steps, body building shots, body training shots, tapis-roulants for gymnastics, exercise benches, exercise bars; all of the foregoing not for use with vehicles.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares 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 between January 20, 2006 and January 20, 2009 (the Relevant Period).

[4] The relevant definition of “use” in association with wares is set out in subsection 4(1) of the *Trade-marks Act*:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[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 and as such, the evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the 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 owners' business and merchandising practices.

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Roberto Mayer, manager of the Registrant, sworn on October 9, 2009. Both parties filed written arguments; an oral hearing was not requested.

[7] In his affidavit, Mr. Mayer states that the Registrant used the Mark in Canada in association with the following wares, which he defines as "MOMO DESIGN Products":

Goods made of leather and imitations of leather, namely, travel bags, briefcases, wallets, belts, rucksacks, key-rings made of leather; sunglasses; spectacles; clothing, namely, jackets, T-shirts, gloves, hats and caps (the MOMO DESIGN Products).

[8] With respect to the MOMO DESIGN Products, Mr. Mayer states that, during the Relevant Period, the Registrant sold them in Canada directly or through its Canadian distributor, Grand Prix Import. Attached as Exhibit D to his affidavit are eight representative invoices from Grand Prix Import to various Canadian customers, all dated within the Relevant Period. I note that the Mark appears in the list of wares on some of the invoices and that Mr. Mayer otherwise highlights the listings in each invoice that correspond with MOMO DESIGN Products. In particular, I am able to determine that the invoices show sales of travel bags, belts, jackets, gloves and caps, in addition to other goods not relevant to this proceeding.

[9] In addition to the representative invoices, attached as Exhibit A are pages from two of the Registrant's MOMO DESIGN catalogues and, as Exhibit B, a MOMO DESIGN advertisement. These display MOMO DESIGN Products for which there are invoices (jackets and belts) as well as those that are not included in the representative invoices, namely, sunglasses (in Exhibit A) and leather goods, namely briefcases, wallets, and key-rings (in Exhibit B). Mr. Mayer states clearly that these two exhibits show MOMO DESIGN Products that were sold during the Relevant Period in Canada; Mr. Mayer also attaches as Exhibit C sample hang tags which prominently display the Mark and which Mr. Mayer identifies as having been attached to all of the MOMO DESIGN Products when sold in Canada during the Relevant Period.

[10] Although the Requesting Party concedes in its written submissions that the Exhibit D invoices establish sales of some of the registered wares, it submits that the evidence does not demonstrate use with all of the registered wares and further notes that the invoices do not reflect sales of all of the MOMO DESIGN Products.

[11] Although the Registrant has not provided sample invoices for each of the MOMO DESIGN Products, I would observe that direct documentary evidence is not always required to demonstrate use in association with each ware in a section 45 proceeding [*Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.)]. In particular, the case law is clear that the absence of invoices is not fatal in a section 45 proceeding [*Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988) 21 C.P.R. (3d) 483 (F.C.T.D.); *Gowling Lafleur Henderson LLP v. Neutrogena Corp.* (2009) 74 C.P.R. (4th) 153 (T.M.O.B.)]. In the present case, although it would have been preferable if the Registrant had provided sales figures or sample invoices for each of the MOMO DESIGN Products, there is more than a mere bald assertion of use with respect to those wares (sunglasses and some of the leather goods) for which there are no invoices. The Registrant has provided hang tags showing how the Mark was displayed in association with the MOMO DESIGN Products and has made clear statements that each was sold with the hang tags in Canada during the Relevant Period. The catalogue and advertisement pages, while not in themselves evidence of use within the meaning of s. 4(1) of the Act, do lend some support to Mr. Mayer's statements regarding the sale of those particular MOMO DESIGN Products during the Relevant Period. Accordingly, considering the evidence as a whole, I find it reasonable to conclude that there was use of the Mark within the meaning of s. 45 of the Act in association with all of the MOMO DESIGN Products.

[12] In addition to the MOMO DESIGN Products discussed above, Mr. Mayer also asserts use of the Mark through licensees with respect to the wares "apparatus for reproducing sounds, namely loudspeakers" and "peripheral units to play computer videogames". I note, however, that the wares "peripheral units to play computer videogames" do not appear in the registration. Although the wares "games and playthings, namely ... videogames" do appear in the registration, in the absence of further submissions on this point, I would not consider the

evidence of sales of peripheral units provided by the Registrant to constitute evidence of sales of videogames; nor was this argument put forward by the Registrant in their written submissions.

[13] Turning to the evidence with respect to “loudspeakers”, Mr. Mayer states that its licensee, Polk Audio, Inc., sold loudspeakers bearing the Mark in Canada during the Relevant Period. As evidence of sales, Mr. Mayer provides as Exhibit F2 a representative invoice dated within the Relevant Period from Polk Audio, Inc., to a company in Alberta. The pictures of the loudspeakers provided as Exhibit F1 are generally of poor quality, and it is difficult to make out all the markings that appear on the wares. However, on some of the pictures, the word MOMO (alone) is prominently displayed on the loudspeakers. Neither party made submissions with regards to this variation of the Mark appearing on the wares. However, noting that the word MOMO is the dominant and first portion of the Mark, I conclude that this is a minor variation that would not mislead an unaware purchaser [see *Unilever Canada Ltd. v. G.H. Wood & Wyant Inc.* (1997), 75 CPR (3d) 533 (TMOB)]. As Mr. Mayer provides the requisite statement of care and control over the manner of use of the Mark, I am satisfied that the use shown enures to the benefit of the Registrant pursuant to s. 50 of the Act.

[14] As noted above, no assertion of use was made for the remaining wares and no evidence of special circumstances excusing such non-use was submitted.

[15] Given all of the foregoing, I am satisfied that the Registrant has evidenced use of the Mark in association with the following wares within the meaning of s. 45 and s. 4(1) of the Act during the Relevant Period: Goods made of leather and imitations of leather, namely, travel bags, briefcases, wallets, belts, rucksacks, key-rings made of leather; sunglasses; spectacles; clothing, namely, jackets, T-shirts, gloves, hats and caps; apparatus for reproducing sounds, namely loudspeakers.

[16] Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registrations will be amended to delete the following from the statement of wares in compliance with the provisions of s. 45 of the Act:

Goods made of leather and imitations of leather, namely, suitcases, ..., handbags, ..., trunks, purses, ..., vanity cases sold empty, ... (2) ... apparatus for recording sounds, namely, tape recorders, cassette recorders and CD-ROM recorders; video cameras; telephones; radios; cameras; pocket and table calculating machines; measuring instruments, namely, tape measures and scales; barometers; marine compasses; echo-sounders for boats and ships; electric irons; electric switches; computers, computer printers and parts and fittings for these goods; fire alarms; theft-alarms not for vehicles; fire extinguishers; luminous signals of emergency exits; eye-glasses, ...; frames and lenses for glasses; ...; cases and chains for glasses; clothing, namely, pants, dresses, suits, overalls, ..., overcoats, skirts, shirts, ..., blouses, wristbands, hairbands, scarves, ties, belts, ... socks, stockings, pajamas, nightgowns, nightshirts, underwear, swimsuits; clothing for use by motor car drivers, motorcyclists and cyclists, namely, racing suits, balaclavas, socks, jackets, pile jackets, jackets with rib and elbow protectors, shirts, sweatshirts, vests, pants, pants with knee protectors, gloves; tennis suits, tennis shirts, fencing overalls, ski overalls, ski pants, ski jackets, ski gloves, fencing gloves, balaclavas for skiers, boat oilskin jackets, boat oilskin trousers, boat anoraks, horse-riding pants; footwear, namely, shoes, boots, racing boots, racing shoes, ski boots, horse riding boots, boat shoes; ...; games and playthings, namely, table games, video games; snowboards. (3) Gymnastic equipment, namely, balls, stationery exercise bicycles, weight stacks, lateral bars, press bars, leg curl bars, leg extension bars, tricep bars, pectoral decks, rowing machines, dumbbells, ankle weights, skipping-ropes, chest expanders, twist bars, handgrips, barbells, climbers, steps, body building shots, body training shots, tapis-roulants for gymnastics, exercise benches, exercise bars; all of the foregoing not for use with vehicles.

[17] The amended statement of wares will read as follows: Goods made of leather and imitations of leather, namely, travel bags, briefcases, wallets, belts, rucksacks, key-rings made of leather; sunglasses; spectacles; clothing, namely, jackets, T-shirts, gloves, hats and caps; apparatus for reproducing sounds, namely loudspeakers.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office