



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

Citation: 2012 TMOB 23
Date of Decision: 2012-02-09

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Riches, McKenzie & Herbert LLP against
registration No. TMA641,128 for the trade-mark ZUKI in
the name of Zuki Balaila.**

[1] At the request of Riches, McKenzie & Herbert LLP (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 April 6, 2009 to Zuki Balaila, the registered owner (the Registrant) in respect of registration No. TMA641,128 for the trade-mark ZUKI (the Mark).

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

- (1) Fur garments, namely, men's, women's, ladies', teens', boys', girls' and children's fur coats, fur jackets, fur hats, fur stoles, fur capes, fur muffs, fur ear muffs, fur mufflers, fur purses and fur scarves and scarves trimmed with fur.
- (2) Men's, women's, ladies', teens', boys', girls' and children's wearing apparel made of leather and/or imitation or synthetic leather, namely, suits, jackets, slacks, pants, trousers, coats, overcoats, jackets, bomber jackets, shirts, vests, belts, collars, slippers, ties, hats, caps and skullcaps.
- (3) Men's, women's, ladies', teens', boys', girls' and children's goods made of leather and/or imitation or synthetic leather, namely, handbags, purses, tote bags, backpacks, daypacks, waistpacks, fanny packs, school bags, knapsacks, rucksacks, shoulder bags, sportsman's hunting bags, golf bags, all purpose sports bags, athletic bags, team bags, tool bags, duffel bags, sling bags for carrying infants, diaper bags, shopping bags, clutch bags, clutch purses, wallets, pocket books, billfolds, passport cases, document cases, ticket pouches, credit card cases, change & coin purses, cosmetic bags, cosmetic cases, vanity cases, key cases, key fobs, computer carrying cases, palm pilot cases, umbrellas,

parasols, walking sticks, key rings and key ring holders, book covers, checkbook covers, attache cases, briefcases, business card cases, travel bags, carry on travel bags, satchels, suitcases, valises, trunks, luggage, leather straps for use to carry handbags, purses, luggage, suitcases, overnight bags, travel garment bags, garment bags for home storage of garments, luggage tags, leashes, carrying bags and carrying packs for attachment to bicycles.

(4) Personal care products and toiletries, namely, fragrances, perfumes and eau de cologne, rouge, lipstick, lip gloss, mascara, eye make-up remover, eyeliner pencils, lipliner pencils, eyebrow pencils, sharpeners for eyeliner pencils, lip liner pencils and eyebrow pencils, automatic eyeliner pencils, automatic lip liner pencils, automatic eyebrow pencils, eye shadows, foundation, powder blush, cream blush, lipsticks, concealers, liquid eyeliners, natural and synthetic nail polish, nail polish remover, natural and synthetic brushes, make-up application brushes, make-up brush kits, manicures, make-up sponges, puffs, bath sponges, bath and shower liquid preparations, glycerine soaps, liquid soaps, hard milled soaps, toilet soaps, talcum powders, beard softeners, skin lotions and creams and oils, skin cleansers, skin care preparations, hair gels and hair care preparations.

(5) Men's, women's, ladies', teens', boys', girls' and children's clothing, namely, suits, jackets, pants, coats, shirts, sport shirts, casual shirts, T-shirts, knitted polo T-shirts, knitted shirts, sweaters, pullovers, cardigans, turtlenecks, dresses, skirts, bustiers, sweatsuits, sweatshirts, sweatpants, track suits, shorts, blouses, blousons, vests, robes, ties, bibs, wristbands, headbands, pyjamas, robes, kimonos, caftans, swimwear and bathing suits, thongs, cover-ups, sarongs and sun visors.

(6) Outerwear, namely, coats, raincoats, ponchos, jackets, ski jackets, mittens and gloves.

(7) Formal wear, namely, tuxedos, tails, morning pants and suits, vests, cummerbunds, shirts, ties and gowns.

(8) Exercise clothing, namely, tights, shorts, tops, body suits, athletic suits and leotards, sweatshirts, sweatpants, sweatsuits and tracksuits.

(9) Legwear, namely, hosiery, socks, knee-highs, leggings, tights, pantyhose, stockings and chausettes.

(10) Headwear, namely, hats, caps, sport caps, skullcaps, mufflers, scarves, ear muffs and bandanas.

(11) Underwear, namely, briefs, boxers, shorts, thongs, lingerie and intimate apparel for women.

(12) Footwear, namely, shoes, slippers, boots, sandals, running shoes, tennis shoes, walking shoes, sport shoes, deck shoes, sneakers and athletic shoes.

(13) Belts, buckles, suspenders, handkerchiefs, and pocket puffs.

(14) Watches, watch bands, watch chains and watch necklaces.

(15) Jewellery, namely, rings, earrings, brooches, bracelets, bangles, pins, necklaces, cufflinks, tie-pins, tie clips and cigarette cases.

(16) Eyewear, namely, eyeglasses, sunglasses, frames for eyeglasses and sunglasses and goggles.

(17) Furniture, namely, tables, chairs, kitchen tables, kitchen chairs, armoires, wardrobes, sofas, sofa beds, home entertainment center stands, television stands, television carts,

audio stands, audio carts, television & audio combination stands, pedestals, wall shelves, microwave oven carts, desks, computer tables, file cabinets, bookcases, VCR and/or DVD storage cabinets, beds, bed frames, headboards, dressers, night tables, lamps and sets combining some or all of the foregoing wares;

(18) Ready to assemble furniture, namely, home entertainment stands, television stands, television carts, audio stands, audio carts, television and audio combination stands, pedestals, wall shelves, tables, chairs, kitchen tables, kitchen chairs, microwave oven carts, desks, computer tables, file cabinets, bookcases, VCR and/or DVD storage cabinets, beds, bed frames, headboards, dressers, night tables, and sets combining some or all of the foregoing wares.

(19) Pillows, pillow covers, pillow shams, pillow protectors, pillow cases, quilts, eiderdowns, mattresses, mattress pads, mattress covers, foam mattress pads, cushions, throw cushions, throw rugs, throws, blankets, duvets, comforters, sheets and bedspreads, towels, bath towels, hand towels, washcloths, mats, blinds, curtains, shower curtains and drapes.

(20) Dinnerware, house wares, flatware, cookware, glassware, giftware, and table top items, namely, dinnerware made of porcelain, fine or bone china, pottery or stoneware, coffee mugs, cafe au lait cups, espresso cups, beverage glassware, wine glasses, martini glasses, serving plates and platters, vegetable bowls, salad bowls, butter dishes, cream and sugar sets, sugar bowls, gravy boats, salt and pepper shakers, egg cups, ice cream dishes, onion soup bowls, pitchers, hors d'oeuvre plates, butter warmers, butter cups, tea and coffee pots; eating utensils, namely, forks, knives, spoons, chopsticks, seafood forks, lobster tongs, cocktail forks, butter knives; kitchenware and cooking utensils, namely, cooking pots, stock pots, pans, skillets, roasting pans, crock pots, casserole dishes, woks, rice cookers, banking sheets, baking pans, muffin tins, pie plates and servers, quiche dishes, souffle dishes, waffle irons, fondue sets, fondue plates, fondue forks, burners and ignition fuel in liquid or solid form for fondue, ramekins, tureen, colanders, rolling pins, cake plates and servers, milk frothers, paper towel holders, utensil holders, spoon rests, trivets, tongs, peelers, rot~ cheese graters, rolling mincers, food slicers, graters, corers, zesters, pizza wheels, spaghetti measurers, cheese plates, grapefruit trimmers, lemon squeezers, pie servers, jar openers, ice cream scoops, kitchen knives, bottle openers, can openers, scissors, candy thermometers, oven thermometers, garlic presses, turners, spatulas, cooking spoons, cooking forks, ladles, spoon rests, skimmers, strainers, corkscrews, spaghetti servers, potato mashers, whisks, measuring cups, measuring spoons, spoons, spice racks, canister sets, cookie jars, bread boxes, cutlery trays, jam jars, coaster sets, cheese boards, cutting boards, carving boards, lazy Susans, condiment sets, magazine racks, cookbooks, cookbook holders, wine racks, kitchen clocks, napkin holders, knife blocks, banana holders, nut crackers with picks, salad sets, chip and dip sets, dish racks, fruit bowls, trolley cars, bed trays, organizers for kitchen drawers, tablecloths, table runners, placemats and napkins, kitchen towels, baskets, clocks, mirrors, floor and table lamps, CD racks, flower pots, flower vases, candles and candle holders, picture frames, Christmas ornaments and figurines.

(21) House wares, namely, crystal glasses, crystal bowls, crystal candlestick holders,

glassware, bowls, drinking glasses; kitchen utensils, namely, spoons made of wood or metal, graters, slicers, egg flippers, tablecloths and cookbooks.

[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 April 6, 2006 and April 6, 2009.

[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 [*Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 CPR (4th) 270 (FC)]. Although the threshold for establishing use in these proceedings is quite low [*Lang Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)], mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 CPR (2d) 194, aff’d (1980), 53 CPR (2d) 62 (FCA)]. Sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant, Zuki Balaila, filed his own affidavit sworn on October 6, 2009. Both parties filed written arguments; an oral hearing was not held.

[7] In his affidavit, Mr. Balaila states that during the relevant period, his licensee, Zuki Internationale Inc. (Zuki) made consistent use in Canada of the Mark in association with “fur garments”, “fur wares” and certain other wares referred to in his affidavit, described below. He explains that he is the majority shareholder and President of Zuki, a company which specializes in the design, manufacture and distribution of fur and leather wares. He further states that in his position as an Officer of Zuki, he controlled the quality and appearance of the wares bearing the Mark, and provides as Exhibit 7 to his affidavit a copy of the applicable license agreement between himself and Zuki. Accordingly, I am satisfied that the use shown below enures to the benefit of the Registrant pursuant to s. 50 of the Act.

[8] In his affidavit, Mr. Balaila states that the wares manufactured by Zuki are pictured in “look books” used by Zuki for the purpose of showing its products to potential customers in the day-to-day operations of its business or while in attendance at industry trade shows. Attached to his affidavit as Exhibits 8 and 10 are copies of Zuki’s look books for 2008 and 2007, respectively. Mr. Balaila explains that customers use the look book in conjunction with a price list to determine the prices of the various wares depicted. Provided as Exhibit 9 is Zuki’s price list for 2008.

[9] Although Mr. Balaila does not explicitly state what products displayed in the look books correspond with the wares as registered, I note that the look books predominantly show fur coats. However, I am also able to identify photographs of fur jackets, fur stoles, fur capes, fur and leather purses, leather handbags and fur blankets.

[10] Furthermore, in addition to the wares appearing in the look books, Mr. Balaila asserts use of the Mark in Canada with respect to the following wares, also designed, manufactured and distributed by Zuki: pillows, blankets, children’s coats, children’s headbands, ladies’/womens’ handbags, ladies’/womens’ stoles, ladies’/womens’ vests, children’s/boys’ vests and collars. In support, he provides at Exhibits 17 to 25 pictures of each of these products.

[11] With respect to the manner in which the Mark was displayed on the wares, Mr. Balaila states that each of the wares appearing in the look books and otherwise manufactured by Zuki

bear a tag or button displaying the Mark (samples of which are provided at Exhibits 13 and 15, respectively).

[12] I would note at this point that some of the evidence of use provided, such as linings (at Exhibit 14) and labels (also at Exhibit 15) relate to a design mark (TMA640,992 Zuki & Design), shown below:



[13] Though not determinative with respect to any of the individual wares, I have not accepted such evidence as evidence of use of the Mark. This trade-mark appears to be a highly stylized signature and I do not consider it recognizable as the word ZUKI on its own.

[14] Nevertheless, as proof of sales of wares bearing the Mark as registered, attached as Exhibits 26, 27 and 28 to Mr. Balaila's affidavit are dozens of "randomly selected" representative invoices showing sales from Zuki to various customers in Canada during the relevant period. As with the look books, I note that the sales are predominantly of fur coats and jackets, although I am also able to identify sales of handbags, blankets, headbands, vests, stoles and capes.

[15] Finally, Mr. Balaila states that Zuki expends approximately \$100,000CDN annually for the marketing of its wares. He also provides numerous exhibits in the form of various publications and website extracts (as Exhibits 30 to 40) referring to the fur wares distributed by Zuki to support his assertion that ZUKI is a "renowned" name in the fur industry.

[16] Although the Registrant indicates in its written representations that the Registrar should exercise its discretion to maintain the registration "in its present form", I note that despite the voluminous evidence furnished, it is primarily and overwhelmingly in relation to fur garments. In its own written representations, the Requesting Party submits that the Registrant has furnished

no evidence of use with respect to the majority of the registered wares and that the registration should be limited to “coats, pillows, blankets, headbands, hand bags, [leather] purses, stoles, vests and collars”.

[17] For the most part, I agree with the Requesting Party. In view of the evidence described above, I would accept that the Registrant has also demonstrated use of the Mark in association with fur jackets, fur capes and fur purses. Otherwise, Mr. Balaila makes no clear statements in his affidavit that the evidence provided should be considered representative of wares in a similar category [as per *Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)]. Furthermore, it is clear that there are wares listed in the registration (such as personal care products and furniture) that would not fall under any such representative category based on the evidence actually furnished.

[18] 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: fur coats, fur jackets, fur stoles, fur capes, fur purses, collars, leather handbags, leather purses, vests, headbands, pillows and blankets.

[19] As noted above, no evidence of use of the Mark in association with the remaining wares was provided and no evidence of special circumstances excusing such non-use was submitted.

[20] Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete the remaining wares in compliance with the provisions of s. 45 of the Act. The amended statement of wares will read as follows:

- (1) Fur garments, namely, men’s, women’s, ladies’, teens’, boys’, girls’ and children’s fur coats, fur jackets, fur stoles, fur capes and fur purses.
- (2) Men’s, women’s, ladies’, teens’, boys’, girls’ and children’s wearing apparel made of leather and/or imitation or synthetic leather, namely, collars.
- (3) Men’s, women’s, ladies’, teens’, boys’, girls’ and children’s goods made of leather and/or imitation or synthetic leather, namely, handbags and purses.
- (4) Men’s, women’s, ladies’, teens’, boys’, girls’ and children’s clothing, namely, vests and headbands.
- (5) Pillows, blankets.

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