



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

Citation: 2015 TMOB 108
Date of Decision: 2015-06-10

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Guess? IP Holder L.P. against registration
No. TMA600,451 for the trade-mark SPORT
MARCIANO design in the name of Les Montres
Marciano Inc.**

[1] At the request of Guess? IP Holder L.P. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on October 7, 2013 to Les Montres Marciano Inc. (the Owner), the registered owner of registration No. TMA600,451 for the trade-mark SPORT MARCIANO design as reproduced below:

S P O R T
MARCIANO (the Mark)

[2] The Mark is registered for use in association with watches (the Goods).

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the goods specified in the registration, at any time between October 7, 2010 and October 7, 2013 (the Relevant Period). If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of use with respect to goods is set out in section 4(1) of the Act:

4(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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc*, (1980) 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], 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 goods and/or services specified in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FCTD)].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Moshe Dayan, an officer and director of the Owner, sworn on December 4, 2013. Both parties filed written representations; an oral hearing was not requested.

The Owner's Evidence

[7] Mr. Dayan states that the Owner is in the business primarily of selling and distributing, at wholesale, watches and accessories thereto. He asserts that during the Relevant Period the Owner sold watches in Canada, in the ordinary course of its business, in association with the Mark. To prove such statement he filed as Exhibit 1 to his affidavit randomly selected invoices issued during the Relevant Period evidencing sales of watches in Canada in association with the Mark.

[8] Mr. Dayan affirms that each and every watch listed in Exhibit 1 "... had the [Mark] marked on the watches at the time of transfer of the property in, and the possession of, the watches in favour of the purchasers indicated." To confirm such statement, he filed as Exhibit 2 to his affidavit, photographs of watches showing the Mark as used on the watches sold and delivered in Canada by the Owner during the Relevant Period.

[9] Finally Mr. Dayan states that such use of the Mark has been accompanied at all times by the use of the Owner's trade names 'Montres Marciano' and 'Marciano Watches' and 'Marciano

& Co.’ as confirmed by a print-out of the Registraire des Entreprises Quebec attached as Exhibit 3 to his affidavit.

Analysis of the Evidence

[10] I now have to determine if such evidence establishes use of the Mark by the Owner during the Relevant Period in association with each of the Goods within the meaning of section 4(1) of the Act.

[11] There would be no issue on the matter if the evidence had shown use of the Mark as registered, as the allegations contained in Mr. Dayan’s affidavit support a conclusion of use in Canada of a trade-mark in association with the Goods during the Relevant Period. However, the question is whether the trade-mark that is being used can be considered use of the registered mark? That is the sole issue to be decided.

[12] In order to understand both parties’ contentions the following illustration will show the Mark and the trade-mark used:

S P O R T
M A R C I A N O



The Mark

the trade-mark used

[13] The Owner argues that the Mark consists of the dominant word MARCIANO with a stylized form of the word ‘sport’. Therefore:

- The average Canadian consumer who had previously purchased or been exposed to watches bearing the [Mark] as registered is likely to have focused upon the dominant portion of the Mark, namely MARCIANO, and to having viewed the stylized word ‘sport’ in smaller print, if in fact this was ever taken into consideration, as the particular style of a MARCIANO brand watch;

- The notional average Canadian seeing the Mark is very unlikely to mentally include the stylized word ‘sport’ as being part of the identification of the make or source or brand name of the watch. If any attention was paid to the stylized word ‘sport’ it would be only to differentiate or distinguish this particular style of MARCIANO watch, but it would always be a MARCIANO watch;
- The notional average Canadian who is exposed to, or has purchased, or is purchasing, one of the watches bearing the trade-mark used, who has been previously been exposed to watches bearing the Mark, is most likely not to perceive any difference;
- By ceasing to use the stylized ‘sport’ feature of the Mark, the Owner has been acting in response to fashion and the trend of simplified and abbreviated brand identifications.

[14] I take note that the Owner, in its written representations, asserts that the Mark contains two separated elements. The element ‘MARCIANO’ is large, in bold font, and is on a different line than the element ‘sport’. The element ‘sport’ is much smaller in size and in a much more stylized form than the dominant MARCIANO element, and is not before or after or alongside MARCIANO but rather above on a different line. Finally the Owner stresses the fact that there are differences in the lettering and in the sizing between MARCIANO and ‘sport’.

[15] Citing *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA*, (1985) 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltd c Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), the Owner argues that there is no reason to suggest that the trade-mark it used would cause any confusion in the mind of the unaware purchaser. The mark as used maintains its ‘recognizability’ because the dominant feature of the Mark, namely MARCIANO, has been preserved.

[16] The Requesting Party, not surprisingly, takes the position that the Owner has not showed any use at all of the Mark during the Relevant Period. It argues that the trade-mark used presents a substantially different impression from the Mark. Although both marks feature the word ‘Marciano’, it cannot be concluded that the mark used constitutes use of the Mark. It relies on *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) to support its contention that the changes made to the Mark are significant and not just minor.

[17] The Requesting Party goes on to state that the dominant features of the Mark have not been preserved. The word ‘sport’ and the positioning of the word ‘sport’, with its extra-wide spacing, on top of the word MARCIANO, are important features of the mark. In the trade-mark used, such features have not been preserved. Those changes are more than minor and create a very different mark, one which presents a substantially different visual impression from the Mark.

[18] I agree with the Requesting Party that the changes described above cannot be considered minor in nature and therefore, there is no evidence of use of the Mark in association with the Goods in Canada during the Relevant Period. I reach this conclusion for the reasons described below.

[19] As mentioned in *Promafil Canada Ltée*, I must consider the overall impression and the visual effect of the Mark and the trade-mark used. The Mark has the following features:

- It is composed of two words namely, ‘sport’ and ‘MARCIANO’;
- The word ‘sport’ is written with extra-wide spacing on top of the word ‘MARCIANO’ such that both words are written over a similar length;
- The font used for the words ‘sport’ and ‘MARCIANO’ appears to be the same;

[20] Comparing the trade-mark used to the Mark, I note that:

- The word ‘sport’, which is a feature of the Mark, has been omitted;
- There is no superposition of words as in the Mark;
- The font of the trade-mark used is entirely different than the one used for the Mark.

[21] Each case dealing with deviation of registered trade-marks has its own set of facts and it is difficult to refer to those cases without avoiding the argument that they are distinguishable. However, there is some similarities between the present case and the following decisions:

- *Vanity Fair Inc v Manufacturier de bas de Nylon Doris Ltée*, 1999 CarswellNat 3393 (TMSHO) where the registered mark was NUDE SECRET and the trade-mark used was

SECRET. The Registrar held that use of SECRET did not constitute use of the trade-mark NUDE SECRET;

- *Arvic Search Services Inc v Gainers Inc* (1992), 47 CPR (3d) 100 (TMOB) where use of the trade-mark CAPITAL was not considered to be use of the registered trade-mark CAPITAL BRAND;
- *Gowling, Strathy & Henderson v Market Services Pty Ltd* (1994), 57 CPR (3d) 126 (TMHO) where the use of the trade-mark MINTEL was not considered to be use of the registered trade-mark MINTEL PUBLICATIONS.

[22] In all of these cases, despite the fact that the missing element was either descriptive or highly suggestive of the character or quality of the goods or services, nevertheless it was nevertheless ruled that the trade-mark used was not the mark as registered.

[23] In all, I do not consider the deviations described above to be minor as contemplated in *Nightingale Interlock Ltd*.

[24] I note that Mr. Dayan has not provided any evidence that would lead to a conclusion that there were special circumstances justifying non-use of the Mark during the Relevant Period within the meaning of section 45(3) of the Act.

[25] As stated above, the Owner argued in its written representations that the deletion of the word 'sport' is merely a response to fashion and the trend of simplified and abbreviated brand identifications. There is no evidence to that effect in the record and in any event such Owner's decision was a business decision not beyond its control [see *(Registrar of Trade Marks) v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)].

Disposition

[26] Pursuant to the authority delegated to me under section 63(3) of the Act, registration TMA600,451 will be expunged in compliance with the provisions of section 45 of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office