



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

Citation: 2016 TMOB 94
Date of Decision: 2016-06-15

IN THE MATTER OF A SECTION 45 PROCEEDING

Fetherstonhaugh & Co.

Requesting Party

and

Benisti Import-Export Inc.

Registered Owner

TMA309,311 for POINT ZERO

Registration

[1] At the request of Fetherstonhaugh & Co. (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 January 15, 2014 to Benisti Import-Export Inc. (the Owner), the registered owner of registration No. TMA309,311 for the trade-mark POINT ZERO (the Mark).

[2] The Mark is registered in association with the following goods:

(1) Tissus, couve-lits; nappes de tables; vêtements pour hommes, femmes et enfants, notamment: manteaux, vestes, gilets, pantalons, sous-vêtements, chemises, blouses, shorts, jeans, chapeaux, casquettes, mouchoirs, écharpes, jump suits, robes, salopettes, T-shirts, pull-over, chandails, maillots de corps, maillots de bain, peignoirs de bain, chaussures, notamment: bottes, souliers, sandales et pantoufles.

(2) Watches, basket balls, wallets, belts, sunglasses, eyeglasses, ties, colognes perfumes, gels, deodorants, eau de toilette, jewellery, key chains, back packs, travelling bags, garment bags, hand bags, school bags, beach bags, purses, umbrella's, gloves and mittens.

[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 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 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 15, 2011 and January 15, 2014.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act as follows:

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 the purpose and scope of section 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 [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar’s notice, the Owner filed the affidavit of Mario Morelato, Vice-President of the Owner, sworn on August 15, 2014 in Montreal. Both parties filed written representations; a hearing was not requested.

The Owner’s Evidence

[7] In his affidavit, Mr. Morelato attests that the Owner “operates a business of manufacturing, importing, distributing, wholesale and retail sale of men’s and women’s clothing”. He explains that POINT ZERO goods were sold through authorized licensees, through wholesale distribution and through the Owner’s own retail stores in Canada.

[8] With respect to some of the registered goods, Mr. Morelato states that the Owner discontinued use of the Mark, conceding that the Mark was not used during the relevant period in association with the following:

From goods (1), (with the good as registered appearing first, followed by the translation in English provided by Mr. Morelatto): couve-lits/bed sheets, nappes de tables/tablecloths, mouchoirs/handkerchiefs, salopettes/overalls, maillots de corps/body suits, maillots de bain/bath robes, and pantoufles/slippers.

From goods (2): basket balls, wallets, eyeglasses, colognes, perfumes, gels, deodorants, eau de toilette, garment bags, beach bags, umbrellas, and mittens.

[9] As the Owner furnished no evidence of special circumstances excusing non-use of the Mark in association with such goods, the registration will be amended accordingly.

[10] For each of the remaining goods, Mr. Morelatto supports his assertion of use with clear evidence of use of the Mark in the form of photographs and invoices at Exhibits A through X attached to his affidavit. In each case, the photographs show the particular good with the Mark displayed on the good itself or on a tag affixed to the good. The “corresponding” invoices in each exhibit show sales in Canada during the relevant period by either the Owner directly or by an authorized licensee.

[11] For example, Exhibit A consists of several photographs of three types of coats and jackets, each accompanied by an invoice from the relevant period showing a sale of that particular item. I note, for example, the style number for the “3 in 1 jacket” appearing on the October 16, 2013 invoice corresponds with the style number appearing on the tag affixed to the jacket depicted in the last photograph of the exhibit. The photographs show that the Mark was displayed on the goods directly as well as on tags attached to the goods.

[12] Similar evidence appears in the subsequent exhibits for the following registered goods (again, where applicable, the good as registered appears first, followed by the translation in English provided by Mr. Morelatto): gilets/vests (Exhibit B); sous-vêtements/underwear (Exhibit C); chemises/shirts (Exhibit D); blouses (Exhibit E); chapeaux/hats, casquettes/caps, écharpes/scarves and gloves (Exhibit F); pants (Exhibit G), jeans (Exhibit H), robes/dresses (Exhibit I); T-shirts (Exhibit J); peignoirs de bain/swimsuits (Exhibit K); souliers/shoes, bottes/boots and sandales/sandals (Exhibit L); belts (Exhibit M); sunglasses (Exhibit N); ties (Exhibit O); jewellery and keychains (Exhibit P); backpacks, travelling bags, handbags, school bags, and purses (Exhibit Q); chandails/sweaters (Exhibit R); shorts (Exhibit S);

pantalons/children's pants (Exhibit T); watches (Exhibit U); tissu/fabric (Exhibit V); pull-over/pullovers (Exhibit W); and jump suits (Exhibit X).

Analysis

[13] In his affidavit, Mr. Morelatto makes no attestations regarding sales volumes for particular goods, nor does he attest to aggregate sales of POINT ZERO goods generally. Furthermore, for some of the goods, the Owner furnished only one invoice as evidence of transfers in the normal course of trade during the relevant period.

[14] However, it is well established that evidence of a single sale may be sufficient to establish use of a trade-mark in the normal course of trade, so long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration of the trade-mark [see *Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18, 90 CPR (4th) 277 and *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. In this case, I note that the invoices are often for large quantities of goods and charges for GST and QST appear on the invoices. Indeed, in its written representations, the Requesting Party does not generally take issue with the evidence in this respect.

[15] The Requesting Party does note that one of the invoices at Exhibit P with respect to jewellery is an invoice showing sales *to* the Owner rather than *from* the Owner.

[16] However, at Exhibit P, Mr. Morelatto provides a second invoice dated within the relevant period, showing the sale of a "bracelet large" at a Point Zero retail store in Montreal. The Mark appears at the top of the invoice and the accompanying photographs show various jewellery items with attached tags that display the Mark. In my view, this evidence is sufficient to demonstrate use of the Mark in association with such goods. Indeed, ultimately, the Requesting Party does not submit that "jewellery" should be deleted from the registration.

[17] Instead, the Requesting Party's brief representations focused on the registered goods bottes/boots and sandales/sandals. The Requesting Party asserts that no direct evidence "through photographs, invoices or otherwise that there were sales ... during the relevant period ... in

association with [the Mark]” was provided for boots and sandals. Given the structure of the affidavit, the Requesting Party further submits that the exhibited photographs are not representative of the goods missing from the exhibits [citing in support, *Etigson v KPM Industries Ltd* (2001), 15 CPR (4th) 411 (TMOB)]. Accordingly, in addition to the goods for which the Owner concedes non-use, the Requesting Party submits that “bottes” and “sandales” should also be deleted from the registration.

[18] However, in reviewing the evidence at Exhibit L, I agree with the Owner that the evidence does show transfers of boots and sandals displaying the Mark in the normal course of trade during the relevant period in Canada. In this respect, I note that Mr. Morelatto specifically attests that Exhibit L consists of the following:

Photographs of shoes, boots and sandals bearing the POINT ZERO trademark, and corresponding invoices indicating the sale of such shoes, boots and sandals by the Owner in 2011 and 2013, as wholesale, and in 2012 through one of its retail stores.

[19] Indeed, Exhibit L includes two invoices showing bulk sales of “SHOES & BOOTS” to a Montreal company. The corresponding photographs display a variety of footwear, including different styles of men’s and women’s running shoes, casual shoes and boots. Although the Mark is not clearly visible on all of the depicted footwear, I note that the second photograph shows three styles of footwear displaying the Mark; at a minimum, I accept that one of these styles could be described as a boot.

[20] Similarly, as submitted by the Owner, two of the Exhibit L invoices refer specifically to sales of either “sandals” or “flip flops” (which I accept to be a type of sandal). The corresponding photographs depict two styles of sandals, both of which display the Mark.

[21] As the same exhibit shows distinct evidence of use of the Mark in association with the registered goods souliers/shoes, I am satisfied that Exhibit L shows evidence of use with respect to each of souliers/shoes, bottes/boots and sandales/sandals.

[22] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the remaining registered goods within the meaning of sections 4 and 45 of the Act.

Disposition

[23] In view of all of the foregoing, 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 from the statement of goods:

(1) ... couve-lits; nappes de tables; ... mouchoirs, ... salopettes, ... maillots de corps, maillots de bain, ... et pantoufles.

(2) ... basket balls, wallets, ... eyeglasses, ... colognes perfumes, gels, deodorants, eau de toilette, ... garment bags, ... beach bags, ... umbrella's, ... and mittens.

[24] The amended statement of goods will be as follows:

(1) Tissus, vêtements pour hommes, femmes et enfants, notamment: manteaux, vestes, gilets, pantalons, sous-vêtements, chemises, blouses, shorts, jeans, chapeaux, casquettes, écharpes, jump suits, robes, T-shirts, pull-over, chandails, peignoirs de bain, chaussures, notamment: bottes, souliers, sandales.

(2) Watches, belts, sunglasses, ties, jewellery, key chains, back packs, travelling bags, hand bags, school bags, purses, gloves.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No Hearing Held

AGENTS OF RECORD

Sumbulian & Sumbulian

For the Registered Owner

Fetherstonhaugh & Co.

For the Requesting Party