



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

Citation: 2015 TMOB 12
Date of Decision: 2015-01-23

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Barrette Legal Inc. against registration
No. TMA604,304 for the trade-mark LEONARDO DA
VINCI in the name of Dallevigne S.P.A.**

[1] At the request of Barrette Legal Inc., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on December 7, 2012 to Cantine Leonardo da Vinci Soc. Coop. A.R.L., the registered owner at the time of registration No. TMA604,304 for the trade-mark LEONARDO DA VINCI (the Mark).

[2] The Mark is registered in association with the goods “wines”.

[3] The section 45 notice required the registered owner to furnish evidence showing that it had used the Mark in Canada in association with the goods specified in the registration within the time period between December 7, 2009 and December 7, 2012.

[4] The relevant definition of “use” 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] Subsequent to the issuance of the notice, the Registrar recorded a change in title of the registration to Dallevigne S.P.A. (the Owner). This change in title is not at issue in this proceeding.

[6] In response to the Registrar's notice, on July 3, 2013, the Owner furnished the "affidavit" of Sergio Dagnino. This document totals four pages, with each page having been stamped and signed by an Italian notary, Paolo Castellari. The first page is in English and comprises the substance of Mr. Dagnino's statements, followed by two pages of exhibited photos, with the last page being a lengthy notarized document transcribed in Italian by Mr. Castellari.

Admissibility of the Dagnino Document

[7] I would first note that the Act and the *Trade-marks Regulations* are silent as to the form of affidavits and statutory declarations to be filed in an opposition or section 45 proceeding before the Registrar. As the Registrar has noted before, while it may be desirable for evidence to conform to the *Federal Court Rules*, it is not an obligation [see *Tension 10 Inc v Tension Clothing Inc* (2004), 45 CPR (4th) 136 (TMOB)]. The Registrar generally accepts affidavits sworn to in foreign jurisdictions as long as they meet the requirements of that jurisdiction [see, for example, *Dubuc v Montana* (1991), 38 CPR (3d) 88 (TMOB) and *Bull, Housser & Tupper LLP v Sacha London, SL* (2013), 113 CPR (4th) 371 (TMOB)]. Furthermore, especially in the context of section 45 proceedings – which are intended to be summary and expeditious – the Registrar has frequently considered certain deficiencies in affidavits and statutory declarations to be mere technicalities [see, for example, *Brouillette, Kosie v Luxo Laboratories Ltd* (1997), 80 CPR (3d) 312 (TMOB) and *88766 Canada Inc v Tootsie Roll Industries Inc* (2006), 56 CPR (4th) 76 (TMOB)].

[8] For the reasons below, however, I agree with the Requesting Party that the Dagnino document should not be admissible as evidence in this proceeding.

[9] On each page of the Dagnino document, the notary's stamp and signature appears in the right hand margin. However, on the first page, I note that the jurat in English is incomplete. Although "Italy" and "2013" are indicated, spaces for the town, day and month are left blank and the notary's signature does not appear in the space provided. It is possible that the stamp and signature of the notary elsewhere on the page is adequate under Italian law. Further, it is possible that the last page of the document includes a completed jurat and other details sufficient for sworn declarations under Italian law. However, no translation of the Italian portion of the document was provided by the Owner.

[10] I agree with the Requesting Party that the Owner should have provided a translation of the Italian portion of the “affidavit” to allow the Registrar to determine whether the document meets the requirements of an affidavit. In this respect, even if I were to accept that an Italian notary signed and affixed his seal to the document, that in and of itself cannot lead to the assumption that Mr. Dagnino’s statements were sworn before the notary [see *88766 Canada Inc v 167407 Canada Inc* (2010), 89 (4th) 293 (TMOB)]. It could be that Mr. Castellari’s certification merely attests to the identity of Mr. Dagnino and not that he was sworn. Without a translation, we simply do not know the status of the document.

[11] I do not consider this to be a mere technicality that can be overlooked by the Registrar. Despite the Requesting Party raising the issue, the Owner chose not to furnish a translation of the Italian portion of the document, nor did it provide any representations in reply as to the admissibility of the “affidavit”.

[12] Had the Registrant provided a translation to indicate that Mr. Dagnino’s statements were sworn or would have been considered the equivalent of an affidavit or statutory declaration in Italy, then I may have considered the Dagnino document to be admissible in this proceeding. Absent a translation or representations from the Owner, at best I consider the Dagnino document the equivalent of a document furnished as evidence in a section 45 proceeding that has been stamped by a Canadian notary but which lacks a proper jurat [see, for example, *Cameron IP v Jones* (2013), 112 CPR (4th) 333 (TMOB)]. Consequently, I conclude that the Dagnino document is inadmissible in this proceeding.

Insufficiency of Evidence

[13] In any event, even if I were to accept the Dagnino document as proper evidence, I would not be satisfied that the Owner has demonstrated use of the Mark in accordance with sections 4 and 45 of the Act for the reasons below.

[14] Mr. Dagnino’s “affidavit” is brief, the substantive portion of which consists of the following two paragraphs and one exhibit:

1. I am the Managing Director of [the Owner]. I have access to the records of the Registrant and have consulted them to prepare this affidavit. I have personal knowledge

of the facts set out in this affidavit and am authorized by the Registrant to swear and submit this affidavit in support of this action.

2. Attached and marked Exhibit A are true reproductions of labels showing use of the above-referenced trade-mark.

[15] Exhibit A consists of three labels. The labels appear to be for different sizes of wine bottles. The trade-mark LEONARDO appears at the top of each label, with each label indicating that the vintage is 2010. The first label consists primarily of English and Italian text. The second and third labels include at least some English and French text. Next to the barcode on the second label is “ONTARIO AGENT: DIONYSUS (#555)” with a 416 area code phone number.

[16] Again, the last page of the “affidavit” appears to be the Italian notary’s certification page for which no translation was provided by the Owner.

[17] 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 a section 45 proceeding is quite 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 specified in the registration during the relevant period.

[18] In this case, I note that Mr. Dagnino does not even assert use of the Mark in Canada, nor within the relevant period. I am not prepared to make any inferences from the appearance of “Ontario Agent” on one of the exhibited labels and the appearance of “2010” on the labels as the vintage year of the wines. Even if I were to infer that these labels actually appeared on the Owner’s goods, Mr. Dagnino provides no details regarding the Owner’s normal course of trade. In the absence of invoices or any particulars regarding the Owner’s sale and distribution of its wines, I am unable to conclude that any transfers of the registered goods occurred in the normal course of trade in Canada during the relevant period or were otherwise in compliance with sections 4 and 45 of the Act.

[19] In any event, as noted by the Requesting Party, the trade-mark appearing on the labels is LEONARDO, rather than the Mark as registered.

[20] The test for deviation, as articulated in *Canada (Registrar of Trade-marks) v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) at 525, is as follows:

The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

[21] As the Court of Appeal noted, “That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used.” [at 525]

[22] In deciding this issue, one must look to see if the “dominant features” of the trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough so as to permit a finding of use of the trade-mark as registered is a question of fact to be determined on a case-by-case basis.

[23] Although the trade-mark appearing on the labels, LEONARDO, is the first part of the Mark as registered, the omission of the words DA VINCI is insufficient to constitute display of the Mark. LEONARDO is a single-word given name while the Mark is the well-recognized name of a famous historical figure. The omission of DA VINCI substantially alters this dominant feature of the Mark in appearance, phonetically and in the idea suggested, such that it has lost its identity and does not remain recognizable as the Mark.

[24] In view of all of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence of special circumstances excusing non-use of the Mark before me.

Disposition

[25] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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