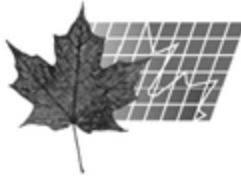


OPIC



CIPO

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

Citation: 2020 TMOB 12

Date of Decision: 2020-01-31

[UNREVISED ENGLISH

CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

W&L Giraffebaby Group Ltd.

Requesting Party

and

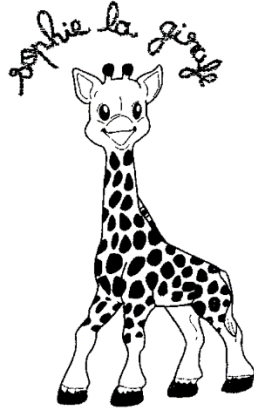
Sophie la Girafe S.A.S., une société anonyme

Registered Owner

**TMA691,735 for the trademark SOPHIE LA
GIRAFE (& Design)**

Registration

[1] At the request of W&L Giraffebaby Ltd. (the Requesting Party), the Registrar issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c. T-13 (the Act) on June 5, 2017, to Sophie la Girafe S.A.S., une société anonyme (SLG), the registered owner of registration No. TMA691,735 for the trademark SOPHIE LA GIRAFE (& Design) (the Mark), including a colour claim, as shown below:



[TRANSLATION]

Colour is claimed as a feature of the trademark. Salmon for the words SOPHIE LA GIRAFE and the insides of the ears and mouth of the giraffe. Yellow for the body and tail of the giraffe. Maroon for the spots on the body of the giraffe, its horns and its hooves. Black for the outline of the giraffe, the lines of the nose, the cheeks, the mouth, the chin, the insides of the ears, the tail, the feet and the outside of the eyes of the giraffe. White for the inside of the eyes of the giraffe.

[2] The Mark is registered in association with the goods and services listed below and the registration states that the Mark has been registered and used in France in association with the goods (1) and services, and that a statement of use of the Mark in Canada was filed on June 14, 2007, in association with the goods (2).

[TRANSLATION]

Goods

(1) Perfumery, body soap; cartoons on cassettes and compact disks; exposed film, video tapes, game software; cardboard portfolios and cardboard hat boxes; paper, namely drawing paper, writing paper, papier mâché, wallpaper; stationery, namely notebooks, colouring books, notepads, file folders, document files (stationery), envelopes, rulers, adhesive tape dispensers, pencil cases, pencil sharpeners, stamp pads, staplers and staples, pens, markers, chalk, pencils, erasers, letter openers, paper clips, pencil holders, desk pads, agendas; printed matter, namely newspapers, brochures, leaflets, magazines, catalogues; photographs, pictures, drawings, comic strips, albums, posters, books, magazines, cards, post cards, adhesives for stationery or household, namely paper glue; artist's supplies, namely easels, canvases, paint brushes; office requisites (except furniture), namely photograph holders, photograph frames, binder clips, pencil holders, pencil and pen stands, poster and display card holders, book weights, paper weights, bookends, pen cases, paper folders, mail baskets, letter openers, writing pads and inkstands; printers' type, printing plates; clothing, namely anoraks, blouses, boleros, shawls, sweaters, windbreakers, scarves, coats, tunics, raincoats, rain slickers, parkas, overcoats, waist-length jackets, vests, sports jackets, pants, suspenders, belts, shirts, pullovers, polo shirts, tank tops, socks, gloves, dresses, skirts, slippers, blouses, bibs, T-shirts, shorts, jeans, overalls, Bermuda shorts, nightshirts, pyjamas, bathrobes, tights,

rompers, infant sleepers, swim suits, scarves, underclothing; footwear, namely shoes, sandals, slippers, sports footwear, sneakers, moccasins and boots; headgear, namely hats, caps, balaclavas, berets, bonnets; games, namely playing cards, bowling sets; toys, namely stuffed animals, bath toys, dolls, scooters, balloons, balls, developmental toys and activities, namely rattles, cloth books, teething rings, toy rings, playing mats, mobiles, musical mobiles, swing sets, counting frames.

(2) Perfumery, developmental toys and activities, namely rattles, teething rings, toy rings.

Services

Advertising services for others, namely on-line advertising on a computer network, radio advertising, television advertising, broadcasting of advertisements, publication of advertising copy; broadcasting of radio and television programs; communication (transmission) by computer terminals, namely operation of a children's games Web site; recreational services and entertainment services, namely entertainment centres for children, namely interactive play areas; publication of books, magazines, comic strips and texts (other than advertising texts); production of films, animated cartoons, television programs and radio programs, editing of video tape, radio programs and television programs, rental of motion pictures and video tapes.

[3] Section 45 of the Act requires that the registered owner of a trademark indicate, for each of the goods or services specified in the registration, whether the trademark has been used in Canada at any time within the three-year period immediately preceding the date of the notice and, if not, that it indicate the date when it was last used and the reason for the absence of such use since that date. In this case, the relevant period is from June 5, 2014 to June 5, 2017 (Relevant Period).

[4] The relevant definitions of "use" are set out in section 4 of the Act and read as follows:

4(1) A trademark 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.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[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. 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) 63 (FCA)]. 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)], the registered owner must nonetheless establish a *prima facie* case of use of the mark [*1459243 Ontario Inc. v. Eva Gabor International, Ltd*, 2011 FC 18 (FCTD)]. In this respect, the registered owner must provide sufficient facts to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar's notice, SLG filed an affidavit by Stéphanie Arnaud, made on December 19, 2017, accompanied by Exhibits "A" to "K".

[7] Neither party produced written representations or asked that a hearing be held.

THE EVIDENCE OF RECORD

[8] In her affidavit, Ms. Arnaud collectively defines all the goods and services associated with the registration as the "Goods" and "Services". However, I note that Ms. Arnaud does not necessarily use these defined terms consistently throughout her affidavit. For the purpose of the review of evidence, I will limit myself to the wording used by Ms. Arnaud in her affidavit, at times using the defined terms "Goods" and "Services", and at other times the words "goods" and "services".

[9] Ms. Arnaud presents herself as the Assistant Director General of the corporation Vulli S.A.S. (Vulli). She states that she has been employed by Vulli since January 6, 2003, and has held the aforementioned position since January 2, 2017. From January 6, 2003 to January 2, 2017, she was the Director of Marketing and Communications with Vulli. Ms. Arnaud explains that, as Assistant Director General, she is responsible for managing operations related to the intellectual, artistic and legal properties of Vulli, SLG, and Deliso S.A.S. (Development Licensing Sophie la Girafe) (Deliso), and also provides Vulli's marketing and commercial direction. Ms. Arnaud further explains that SOFIVULLI S.A.S., a parent holding company, also holds 100% of SLG and 80% of Deliso; Vulli is fully owned by SLG. [paras 1 and 6]

[10] With respect to the normal course of business of SLG, Ms. Arnaud states that:

[TRANSLATION]

SLG is a French company with a very good reputation, operating in the field of goods and services for babies and children since 1989. Through its long-standing association with Vulli, SLG markets toys and goods for babies and children that have become must-haves worldwide, including the popular giraffe toy figure “Sophie la girafe”, more than 50 million of which have been sold worldwide since 1961. [para 9]

[11] Ms. Arnaud states that SLG granted Vulli a licence to use the Mark, allowing Vulli to enter into contracts for the distribution and resale of [translation] “goods from the ‘Sophie la girafe’ line”. She also states that SLG granted Deliso a licence to use the Mark, allowing Deliso to grant sub-licences for the use of the Mark to companies specializing in related fields. She states that the sub-licensees of Deliso include Alva Organics Cosmetics, Dorling Kindersley (DK), The Experiment, Janod/Juratoys and York Wallcoverings. [paras 7, 8 and 25]

[12] Ms. Arnaud states that [TRANSLATION] “since 2006, Vulli has manufactured and distributed [...] Goods that are part of the ‘Sophie la girafe’ line of goods in association with the [Mark] to exclusive Canadian distributors, who resell those Goods to the general public or to other retailers.” [para 11]

[13] Ms. Arnaud notes that [TRANSLATION] “most Goods sold in association with the [Mark] are goods in the ‘Sophie la girafe’ line”. [para 12] She states that:

[TRANSLATION]

Goods in the “Sophie la girafe” line have been continuously sold across Canada in association with the [Mark] since 2006, through major distributors and resellers, such as Toys “R” Us and, more recently, QHouse Kids. [para 16]

[14] Ms. Arnaud details the amount of sales from the “‘Sophie la girafe’ line of goods” to Canadian distributors for each year during the relevant period, but does not specify the nature of the goods sold. [para 17]

[15] Ms. Arnaud states that, from 2014 to 2016, Bug in a Rug Canada Inc. was the distributor of the Goods and Services in Canada and that, since September 2016, QHouse Kids is the

exclusive Canadian distributor of [TRANSLATION] “goods in ‘Sophie la girafe’ line in Canada”.
[para 21]

[16] Ms. Arnaud states that SLG directly and indirectly controlled and controls the character and quality of goods and services provided by its licensees and sub-licensees in association with the Mark. She explains that Deliso acts as an agent of SLG to ensure adequate control of the character and quality of the goods manufactured, advertised and sold by the Canadian sub-licensees. In this regard, she states that Deliso regularly asks its sub-licensees, on behalf of SLG, to demonstrate the compliance of the goods sold in association with the Mark by means of quality tests. [para 26]

[17] In support of her statements, Ms. Arnaud attaches the following exhibits to her affidavit:

- Exhibit B: [TRANSLATION] “documents showing the history of Vulli and the toy figure ‘Sophie la Girafe’”.
- Exhibit C: [TRANSLATION] “2017 catalogue of goods in the ‘Sophie la girafe’ line, distributed to local distributors in various countries, including Canada, so they can place orders for goods.” Ms. Arnaud adds that similar catalogues were distributed during the Relevant Period and that the catalogue produced in Exhibit C “illustrates the Goods and their packaging featuring the Mark”. I note that the Mark is featured in various formats. I will come back to this point in my decision.
- Exhibit D: [TRANSLATION] “sample lists of goods ordered by Canadian distributors during the Relevant Period and samples of invoices for sales to Canadian distributors.” Ms. Arnaud adds that “these documents show that substantial sales were made in Canada in association with the [Mark] during the Relevant Period.” I note that the “samples of lists of goods ordered” consist of a report from Vulli entitled “Statistical impression of multi-criteria orders (by order date)”, detailing the quantities of specific goods ordered for various periods of time, including the Relevant Period. With respect to the invoices, I note that they report sales during the Relevant Period by Vulli to the Canadian distributors identified by Ms. Arnaud, i.e. Bug in a Rug Canada and QHouse Kids.

- Exhibit E: [TRANSLATION] “details of sales to Canadian distributors”. I note that this exhibit details the number of units sold by Vulli to Bug in a Rug Canada, Toys “R” Us and QHouse Kids during the Relevant Period; however, the nature of the goods sold is not specified.
- Exhibit F: table entitled [TRANSLATION] “Table associating exhibits showing sales in Canada and exhibits showing the goods sold featuring the Mark”. Although the table refers to several of the goods and services covered by the registration, I note that a correlation with certain other exhibits filed in support of Ms. Arnaud’s affidavit is only provided for some of those goods and services. I will come back to this point later in my decision.
- Exhibit G: [TRANSLATION] “screen captures” of local specialty reseller websites, particularly Toy Corporation and QHouse Kids, for September 22 and 29, 2016, respectively, obtained using the *Wayback Machine* on December 12, 2017. Ms. Arnaud adds that “during the Relevant Period, the Goods in the ‘Sophie la girafe’ line were available for purchase online on those websites. Here again, I note that the Mark is featured in various forms.
- Exhibit H: [TRANSLATION] “statement of sales” by Bug in a Rug Canada for the book entitled “The True Story of Sophie la girafe” (*L’histoire vraie de Sophie la girafe*). I note that the “sales report” refers to invoices, all dated during the Relevant Period, for the sale of that book to various retailers, such as Winners, Toys “R” Us, etc.
- Exhibit I: invoices dated during the Relevant Period, indicating sales by QHouse Kids to [TRANSLATION] “large retail chain stores” in Canada, such as Toys “R” Us, Bo Bebe, etc.
- Exhibit J: [TRANSLATION] “table showing the visual of the Goods covered in Canada by [the] active sub-licences during the Relevant Period”. Here again, I note that the Mark is featured in various forms.

- Exhibit K: [TRANSLATION] “invoices and royalty statements [from] sub-licence holders for sales they made to their distributors in Canada”. Specifically, I note the following exhibits:
 - Exhibit K-1: a royalty statement that appears to show royalties owed by the sub- licensee Alva Organics OY in respect of specific goods. Although various information is redacted, I note that the report indicates the quantity of specific goods for which royalties are calculated and covers periods within the Relevant Period.
 - Exhibit K-2: royalty statements that seem to show royalty payments owed by Penguin Books Ltd. in Great Britain to the licensee Deliso on the sale of books in the “Sophie la girafe” collection during the Relevant Period.
 - Exhibit K-3: royalty statements that seem to show royalty payments owed by sub- licensee The Experiment in New York to the licensee Deliso on the sale of books in the “Sophie la girafe” collection during the Relevant Period. This exhibit also includes two invoices during the Relevant Period showing sales of similar books by the Workman Publishing Company in New York, which Ms. Arnaud describes in her affidavit as the distributor for The Experiment.
 - Exhibit K-4: invoices dated during the Relevant Period, showing sales by the sub- licensee Juratoys in Canada.
 - Exhibit K-5: table entitled “Sophie la girafe/Deliso Sales Report”, which appears to list the quantity of goods sold in several countries, including Canada.

[18] Ms. Arnaud states that the [TRANSLATION] “[Mark] is featured on the packaging of the Goods in the ‘Sophie la girafe’ line and is also featured, in whole or in part, on the Good itself, as seen in the catalogue [in] Exhibit C, and also appears on related goods sold by the sub- licensees of the [Mark], as seen in Exhibit J”. [para 27]

[19] Ms. Arnaud also states that the [TRANSLATION] “[Mark] is featured on displays near the shelving or counters for the Goods” [para 19; and images of the displays in the catalogue in Exhibit C]. Here again, I note that the Mark is featured in various forms.

[20] Ms. Arnaud concludes her affidavit by stating that [TRANSLATION] “SLG has continually used the [Mark] in Canada in association with the Goods and Services for at least three years, through its licences and for its own benefit.” [para 29]

ANALYSIS

[21] In this case, I find that there are three key issues: (i) can the use shown in the evidence be attributed to SLG?; (ii) does the evidence establish use of the Mark *as registered?*; and iii) has SLG established use of the Mark in association with *each* of the goods and services listed in the registration?

[22] I will examine each issue in turn.

Can the use shown in the evidence be attributed to SLG?

[23] Under section 50 of the Act, for the use of a trademark under licence to benefit the registered owner, the owner must exercise direct or indirect control of the character or quality of the goods and services sold in association with the mark. A clear statement in this regard is enough to establish such control [*Empresa Cubana Del Tabaco c Shapiro Cohen*, 2011 FC 102, at para 84].

[24] In the case at hand, not only does Ms. Arnaud clearly state that SLG controlled and controls the quality of goods and services offered by its licensees and sub-licensees in association with the Mark, she also gives a specific example of how that control is exercised. I am therefore satisfied that any use of the Mark by the licensees and sub-licensees identified by Ms. Arnaud benefits SLG under section 50 of the Act.

[25] Moreover, it is well established that the ordinary course of business of a registered owner will often involve distributors and wholesalers, and that any part of the distribution chain being in Canada is generally enough to establish use for the benefit the registered owner [*Manhattan*

Industries Inc v Princeton Manufacturing Ltd (1971), 4 CPR (2d) 6 (FCTD); and *Lin Trading Co v CBM Kabushiki Kaisha* (1988), 21 CPR (3d) 417 FCA]. As such, I am also satisfied that any use of the Mar by a distributor of SLG, its licensees and sub-licensees in Canada benefits SLG for the purposes of this proceeding.

Does the evidence establish use of the Mark *as registered*?

[26] As noted above in my review of the evidence, the Mark is featured in various forms in the evidence. In Annex A hereto, I present a few examples of the various forms in which the Mark is featured on the goods and packaging shown in the evidence.

[27] The examples reproduced in Annex A show several variations compared to the Mark as registered, including:

- The colours of the giraffes shown and the words “SOPHIE LA GIRAFE” differ from those described in the colour claim contained in the registration.
- Regarding the element of the Mark consisting of a design of a giraffe, the giraffes shown do not have facial features, or have facial features that differ slightly from those of the giraffe shown in the Mark as registered. As well, the giraffe is sometimes lying down.
- Regarding the element of the Mark consisting of the words “SOPHIE LA GIRAFE”, there are changes in the font and positioning of the words “SOPHIE LA GIRAFE”. In particular, the words “SOPHIE LA GIRAFE” are sometimes on two separate lines and are positioned next to or below the design of the giraffe, and are sometimes followed by the word “PARIS” appearing below the words “LA GIRAFE”.

[28] In determining whether the display of a trademark constitutes a display of the mark as registered, the question to be asked is whether the trademark has been used in such a way that it has retained its identity and has remained recognizable despite the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trademarks) v Cie International pour l'Informatique CIIHoneywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. To determine this issue, it must be determined whether the “dominant features” of the registered

trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[29] In this case, I find that the dominant features of the Mark consist of the *combination* of the image of a stylized giraffe and the words “SOPHIE LA GIRAFE”.

[30] Based on the principles set out in *CII Honeywell Bull S.A. et Promafil, supra*, I find that the different variations of the Mark as shown in Annex A are only minor variations of the Mark as registered. Indeed, in each of the images reproduced in Annex A, the Mark remains recognizable, has not lost its identity and the different variations are not likely to deceive or mislead the public, as the dominant features have been preserved.

[31] I find that this conclusion is consistent with many previous decisions in which it was held that similar variations did not make trademarks substantially different [see for example: *Diageo Canada Inc v Heaven Hill Distilleries, Inc*, 2017 FC 571; *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar S.P.A*, 2016 FC 895; *Aird & Berlis LLP v Sonaco SARL*, 2014 TMOB 37; *Gowling Lafleur Henderson LLP v Coalision Inc*, 2011 TMOB 134; and *Pain & Ceballos LLP v Diamond Foods, Inc*, 2013 TMOB 143].

[32] Moreover, I find that the fact that the Mark is not used in the colours claimed is of little importance in this case. The colour claim in the registration does not necessarily mean that colour is a dominant feature of a trademark [*Novopharm v Novo Nordisk A/S* (2005) 43 CPR 4th 305 (TMOB)].

[33] In short, I am satisfied that, as long as the dominant features of the Mark are present, the different variations of the Mark as shown in Annex A are only minor and are a use of the Mark as registered.

Has SLG established use of the Mark in association with *each* of the goods and services listed in the registration?

[34] Based on the correlation table (Exhibit F) and the various exhibits listed in the table below, I am satisfied that the evidence establishes use of the Mark in Canada, during the

Relevant Period, in association with the toy figure (doll) “Sophie la girafe” and each of the goods listed below, included in the registration that is the subject of this proceeding.

Good(s) included in the registration [TRANSLATION]	Exhibit showing the display of the Mark with acceptable variations on the goods or their packaging	Exhibit(s) showing the transfer of the goods in Canada during the Relevant Period (only those deemed most useful are mentioned)
Body soap	Exhibit J, p. 119	Exhibit K-1, pp. 132, 134, 136, 138, 140, 142 and 144
Perfumery	Exhibit J, pp. 119 and 120	Exhibit K-1, pp. 132, 134, 136, 138, 140, 142 and 144
Notebooks	Exhibit J, p. 128	Exhibit K-3, pp. 157, 162 and 164
Agendas	Exhibit J, p. 128	Exhibit K-3, pp. 160 and 166
Newspapers	Exhibit J, p. 128	Exhibit K-3, pp. 155, 156, 158, 165 and 167
Albums	Exhibit J, p. 128	Exhibit K-3, pp. 159, 161 and 163
Posters, pictures, drawings	Exhibit J, p. 129	Exhibit K-5, p. 175
Books	Exhibit J, p. 129	Exhibit H
Bibs	Exhibit C, p. 20	Exhibit D, p. 68
Slippers		
Bonnets		
Bathrobes	Exhibit C, p. 23	Exhibit D, p. 76
Infant sleepers	Exhibit C, p. 29	Exhibit D, p. 72
Scarves	Exhibit C, p. 20	Exhibit D, p. 77
Stuffed animals	Exhibit C, p. 36	Exhibit D, p. 79
Bath toys	Exhibit C, pp. 23 and 31	Exhibit D, pp. 73, 76 and 81 Exhibit I, pp. 113 and 114
Balls	Exhibit C, p. 22	Exhibit D, p.77 Exhibit I, p. 114
Rattles	Exhibit C, p. 35	Exhibit D, p. 78
Cloth books		
Teething rings	Exhibit C, p. 21	Exhibit D, pp. 71, 73, 74, 75, 76, 83 and 85
Toy rings		Exhibit I, pp. 112, 113 and

		116
Counting frames	Exhibit J, p. 123	Exhibit K-4, pp. 171–173

[35] Indeed, after reviewing Ms. Arnaud’s affidavit as a whole, in addition to the invoices filed in evidence (Exhibits I and K), I accept that the “sample lists of goods ordered by Canadian distributors” for products ordered during the periods from 01/2015 to 12/2015 and 01/2016 to 12/2016 (Exhibit D), the “statement of sales” by Bug in a Rug Canada (Exhibit H), the royalty statements (Exhibit K-3) and the “Sophie la girafe/Deliso Sales Report” table (Exhibit K-5), show sales of the goods listed in Canada during the Relevant Period.

[36] However, I am not satisfied that the use of the Mark has been shown for the remaining goods and all the services listed in the registration, for the following reasons.

[37] As noted above in my review of the evidence, while the correlation table in Exhibit F refers to several goods and services listed in the registration, that table does not provide any correlation between each of those goods and services and the other exhibits intended to show the use of the Mark in Canada during the Relevant Period.

[38] While a registered owner is not required to provide direct or documentary evidence regarding each of the goods and services set out in the registration [*Saks & Co v Canada (Registrar of Trademarks)* (1989), 24 CPR (3d) 49 (FC)], the registered owner must still present sufficient evidence to allow the Registrar to form an opinion or logically infer use within the meaning of section 4 of the Act [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, at para 18]. Consequently, the issue of whether the principle set out in *Saks, supra*, applies depends on the amount of detail provided by the registered owner and the clarity of its explanations regarding the representative evidence.

[39] In the case at hand, apart from the general assertions of use made by Ms. Arnaud, there is no indication in the evidence that the Mark as registered, or with acceptable variations such as those shown in Annex A hereof, was in fact used within the meaning of section 4 of the Act during the Relevant Period in association with *each and every* good and service set out in the registration. It should be emphasized that the correlation table in Exhibit F completely ignores several of the goods and services listed in the registration, and that the correlations provided with

respect to certain groups of goods and services referred to in the registration only apply to some of those goods and services.

[40] More specifically, I note that all services listed in the registration, except those described as [TRANSLATION] “publication of books, magazines, comic strips and texts (other than advertising texts)” discussed later in my analysis, and the following listed goods, are not referred to in any way in the correlation table (Exhibit F), are not the subject of any specific assertion by Ms. Arnaud, and do not appear to be represented in any of the exhibits filed in support of her affidavit:

[TRANSLATION]

cartoons on cassettes and compact disks; exposed film, video tapes, game software; artist’s supplies, namely easels, canvases, paint brushes; printers’ type, printing plates; games, namely playing cards, bowling sets.

[41] For the other goods and services for which a precise correlation has been provided, I find that some of the correlations are problematic and do not establish use of the Mark in association with those products and services for the following reasons.

For the goods described in the registration as [TRANSLATION] “photograph holders”

[42] The correlation table (Exhibit F) refers to the item *My baby album with Sophie the giraffe* shown in Exhibit J for both goods described as “albums” and “photograph holders”. However, the image only relates to an album. The same applies to the evidence of transfer referred to in the table for this item.

[43] I am therefore not prepared to accept the correlation with the “photograph holders”, but only with the “albums” (correlation with the latter item accepted in my table above, at paragraph 34 of my decision).

For the goods described in the registration as [TRANSLATION] “musical mobiles”

[44] The correlation table (Exhibit F) refers to the item entitled [TRANSLATION] “*Musical night light*” shown in Exhibit C. However, Exhibit C describes this item as a “musical night light” and

never as a “musical mobile”. The same applies to the evidence of transfer referred to in the table for this item.

[45] Under the circumstances, I am not prepared to accept the correlation provided for “musical mobiles”.

For the goods described in the registration as [TRANSLATION] “drawing paper”, “cardboard portfolios” and “colouring books”

[46] The correlation table (Exhibit F) refers globally to the “notebooks, colouring books, notepads, agendas” shown under the items *Handprint Kit Sophie la girafe*; *My pregnancy journal with Sophie la girafe*; *Baby’s first months Sophie la girafe*; and *My book of firsts with Sophie the giraffe* in Exhibit J and the royalty statements in Exhibit K-3.

[47] On reviewing the images for those items in the evidence, I do not see how any of those items can correspond to any of the “cardboard portfolios”, “drawing paper” or “colouring books” items. More specifically regarding the *Handprint Kit Sophie la girafe*, it appears to be a kit for a baby’s handprint, referring on its packaging to a *Baby’s little book of firsts*. Although this good is described as a kit, without any explanations from Ms. Arnaud, I am unable to determine what is included in this kit, as the other indications on its packaging are illegible.

[48] Under the circumstances, I am not prepared to accept the correlation provided for “cardboard portfolios”, “drawing paper” and “colouring books”. However, I would add in closing on this point that I accept the correlation made between these items and the “notebooks”, “agendas” and “newspapers” (correlation with these products accepted in my table above at paragraph 34 of my decision).

For the services described as [TRANSLATION] “publication of books, magazines, comic strips and texts (other than advertising texts)”

[49] The correlation table (Exhibit F) refers to the books *The True Story of Sophie la Girafe*; *My first Sophie la Girafe Let’s Get Counting*; and *Baby Touch and Feel: Sophie la Girafe: Sophie’s Busy (Board Book)* and Exhibits G, J, H and K-2, to establish the use of the Mark in association with [TRANSLATION] “book publishing services”.

[50] However, while the sale of these books shows the use of the Mark with the “books” products described in the registration, I am not prepared to consider that the mere advertising of such books on Toy Corporation’s website for resale (Exhibit G), or the sale of such books by the distributor Bug in a Rug Canada (Exhibit H), shows the use of the Mark in association with actual services for the “publication of books, magazines, comic strips and texts (other than advertising texts)”.

[51] Moreover, without any further details or explanations in this regard, I do not see how the royalty statements regarding the sale of books in the “Sophie la girafe” collection in Exhibit K by foreign companies show the use of the Mark in Canada in association with the provision of actual book publishing services.

[52] In short, I find that there is not enough evidence to reasonably conclude that SLG, on its own or through licensees, in fact offered such publishing services in Canada during the Relevant Period.

Other products generally referred to in the correlation table (Exhibit F), but not the subject of specific correlations

[53] Finally, with respect to the other goods set out in the registration which are only referred to in very general terms in the correlation table in Exhibit F, without any specific correlation with one or more of the other exhibits filed in support of Ms. Arnaud’s affidavit, I will simply point out, first, the absence of any representation by SLG. It would have been easy for SLG to submit written or verbal representations at a hearing. However, without such representations, I do not find that I need to carefully scrutinize each and every large exhibit filed in support of Ms. Arnaud’s affidavit, in an attempt to identify, on the one hand, exactly which of the other goods in the long list of goods set out in the registration, were shown in the evidence to feature the Mark, or an acceptable variation of it, and to what extent satisfactory evidence of transfer was provided in relation to them during the Relevant Period.

[54] On this last point, I would add that I find that the explanations provided by Ms. Arnaud in her affidavit are not clear enough for me to apply the principle set out in *Saks, supra*, regarding the representativeness of the evidence for each and every good. In this regard, returning to the

correlation table (Exhibit F) and some of the groups of goods presented in it, I find the few specific examples of correlation provided with respect to some of the goods listed therein clearly insufficient to reasonably infer the use of the Mark within the meaning of sections 4 and 45 of the Act with each and every good listed in those groups.

[55] For example, I do not see how the use of the Mark demonstrated in association with babies' "bibs", "bonnets", "slippers", "bathrobes" and "infant sleepers" (items for which a precise correlation was provided in the correlation table in Exhibit F), can be considered sufficient to demonstrate/infer use of the Mark with each item included in the wide range of clothing and accessories listed in the registration. Suffice it to mention that there is no specific assertion by Ms. Arnaud that the use shown in association with baby's bibs, bonnets, slippers, bathrobes and infant sleepers is representative of use in association with a wide collection of clothing and accessories, and that the evidence does not seem to suggest the existence of such a large collection. As another example, I do not see how the use of the Mark shown in association with various "notebooks", "agendas" and "albums" can be considered sufficient to demonstrate/infer use of the Mark with each of the items included in the wide range of office and stationery items listed in the registration, the existence of which does not at all seem to be suggested in the evidence.

[56] In light of all of the above, and without special circumstances justifying the absence of use of the Mark during the Relevant Period, the registration shall be amended to delete from the statement the goods and services for which use of the Mark has not been satisfactorily demonstrated.

DECISION

[57] Accordingly, 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 statement of services in its entirety, as well as the following descriptions from the statement of goods:

[TRANSLATION]

[...] cartoons on cassettes and compact disks; exposed film, video tapes, game software; cardboard portfolios and cardboard hat boxes; paper, namely drawing paper, writing paper, papier mâché, wallpaper; [...] colouring books, notepads, file folders, document files (stationery), envelopes, rulers, adhesive tape dispensers, pencil cases, pencil sharpeners, stamp pads, staplers and staples, pens, markers, chalk, pencils, erasers, letter openers, paper clips, pencil holders, desk pads, [...] brochures, leaflets, magazines, catalogues; photographs, [...] comic strips, [...] magazines, cards, post cards, adhesives for stationery or household, namely paper glue; artist's supplies, namely easels, canvases, paint brushes; office requisites (except furniture), namely photograph holders, photograph frames, binder clips, pencil holders, pencil and pen stands, poster and display card holders, book weights, paper weights, bookends, pen cases, paper folders, mail baskets, letter openers, writing pads and inkstands; printers' type, printing plates; [...] anoraks, blouses, boleros, shawls, sweaters, windbreakers, scarves, coats, tunics, raincoats, rain slickers, parkas, overcoats, waist-length jackets, vests, sports jackets, pants, suspenders, belts, shirts, pullovers, polo shirts, tank tops, socks, gloves, dresses, skirts, slippers, blouses, [...] T-shirts, shorts, jeans, overalls, Bermuda shorts, nightshirts, pyjamas, [...] swim suits, [...] underclothing; [...] shoes, sandals, [...] sports footwear, sneakers, moccasins and boots; [...] hats, caps, balaclavas, berets, [...] games, namely playing cards, bowling sets; [...] scooters, balloons, [...] playing mats, mobiles, musical mobiles, swing sets, [...]

[58] The amended statement of goods will read as follows:

[TRANSLATION]

(1) Perfumery, body soap; stationery, namely notebooks, agendas; printed matter, namely newspapers, photographs, pictures, albums, posters, books; clothing, namely bibs, bathrobes, infant sleepers, scarves; footwear, namely slippers; headgear, namely bonnets; toys, namely stuffed animals, bath toys, dolls, balls, developmental toys and activities, namely rattles, cloth books, teething rings, toy rings, counting frames.

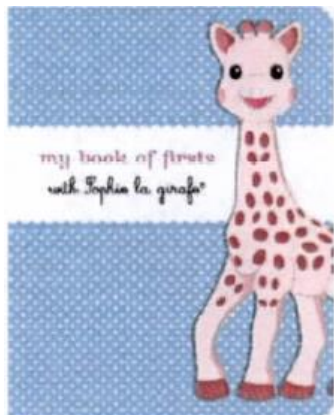
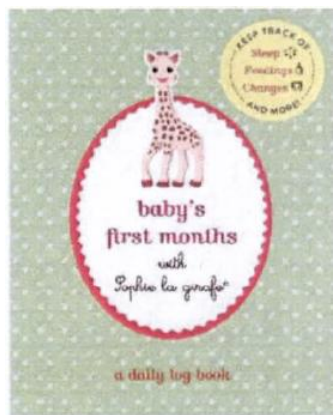
(2) Perfumery, developmental toys and activities, namely rattles, teething rings, toy rings.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified Translation
Gerald Woodard

ANNEX A

Pictures from Exhibits C and J



**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

CABINET JURIDIQUE ST. LAWRENCE S.E.N.C.R.L. FOR THE REGISTERED OWNER

RIDOUT & MAYBEE LLP FOR THE REQUESTING PARTY