



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Reference: 2024 TMOB 52

Date of Decision: 2024-03-25

[UNREVISED ENGLISH CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

Applicant: Shift Law Professional Corporation

Registered owner: 9110-5460 Québec inc

Registration: TMA987,289 for KILANI

INTRODUCTION

[1] This is a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA987,289 for the trademark KILANI (the Mark).

[2] The Mark is registered in association with:

[TRANSLATION]

Goods

(1) Belts, suitcases, wallets, coin purses, gloves, toiletry bags, travel bags, attaché cases, portfolios, casual clothing, bracelets, necklaces, telephone cases, computer cases, tablet computer cases, card holders, handbags, beach bags, sports bags

Services

(1) Retail store for clothing, jewellery, luggage, and fashion accessories, namely hair accessories, handbags, coin purses, hats, belts, shoes, boots, and watches; online sale of clothing, jewellery, luggage, and fashion accessories, namely hair accessories, handbags, coin purses, hats, belts, shoes, boots, and watches; retail of clothing, jewellery, luggage, and fashion accessories, namely hair accessories, handbags, coin purses, hats, belts, shoes, boots, and watches;

(Collectively, Goods and Services)

[3] For the reasons that follow, I conclude that the registration ought to be amended.

PROCEEDING

[4] At the request of Shift Law Professional Corporation (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 7, 2022, to 9110-5460 Québec inc. (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods and services 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 November 7, 2019 to November 7, 2022.

[6] The relevant definitions of “use” are set out in section 4 of the Act 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.

[7] In the absence of use as defined above, a trademark registration is liable to be expunged, unless the absence of use is due to special circumstances.

[8] In response to the Registrar's notice, the Owner filed the affidavit of its President, Louay Kilani, sworn on June 6, 2023, to which were attached Exhibits LK1 to LK6.

[9] Neither party submitted written representations; however, both parties were represented at the hearing.

SUMMARY OF THE OWNER'S EVIDENCE

[10] Although I have reviewed all the evidence, this summary focuses on the portions that are relevant to my findings.

[11] In his affidavit, Mr. Kilani states that the Owner used the Mark in association with the Goods in the normal course of trade in Canada during the relevant period. He also states that the Owner used the Mark in association with the Services [para 3].

[12] With respect to the Goods, Mr. Kilani states that they are sold on the Owner's transactional website, *www.bykilani.com*. He further states that the Mark is affixed directly to the Goods and to labels attached to them [paras 4–6].

[13] In support of his assertions of use of the Mark in association with the Goods, Mr. Kilani attached as Exhibit LK1 excerpts from the Owner's website. Mr. Kilani states that the website has not been modified since the end of the relevant period [para 4]. These excerpts show several goods with their prices in Canadian dollars. The Mark is displayed at the top of each excerpt and on certain goods. As Exhibit LK2, Mr. Kilani attached 15 photographs showing essentially the same goods as in the excerpts, taken individually, on which the Mark is prominently displayed.

[14] As evidence of transfer, Mr. Kilani attached, as Exhibit LK6, 15 invoices dated during the relevant period. He states that all the goods listed on these invoices bore the Mark [para 9]. For example, invoice No. 96192 details a "TABLET CLUTCH", a "CARD HOLDER", a "PASSPORT/WALLET", and "CLUTCHS". The same invoice-lists a "SPLEEN KILANI NECKLACE" and identifies two other goods with the abbreviations "LTHR NCKLAC" and "LTHR TIE NCKLAC". Invoice No. 95363 lists a "Change Holder", a "BRIEFCASE", a "Belt", and several bracelets.

[15] In support of his assertions of use of the Mark in association with the Services, Mr. Kilani attached as Exhibit LK4 excerpts from the Internet Wayback Machine website showing the Owner's website as it was during the relevant period. The excerpts show the "CONTACT US" section of the website. A telephone number in Canada, the information email address *info@bykilani.com*, and a field for sending a message are shown in this section. These excerpts also show three product selection pages in which the price, colour, and features of these goods are displayed next to the "Add to Cart" button. The Mark is displayed at the top of these excerpts.

PRELIMINARY COMMENTS: THE OWNER'S CONCESSIONS

[16] At the hearing, the Owner acknowledged that the evidence does not support the use of the Mark in association with Goods such as "gloves" and in association with the Services relating to "hair accessories", "shoes", and "watches".

[17] As the Owner has provided no evidence of special circumstances excusing non-use of the Mark in association with these goods, the registration will be amended to delete "gloves" from the statement of goods, and "hair accessories", "shoes", and "watches" from the statement of services.

POSITIONS OF THE PARTIES

[18] The substance of the submissions made at the hearing, by both parties, is summarized as follows.

[19] With respect to the Goods, the Requesting Party notes, on the one hand, that all the goods in evidence are made of leather, while most of the Goods are set out in very general terms in the registration. In particular, it argues that the bracelets in evidence do not correspond to "bracelets". In support of its allegation, it refers me to the Goods and Services Manual (the Manual), which includes "leather bracelets". The Requesting Party even requests that the statement of goods be amended to include "leather" to reflect actual evidence of use. On the other hand, the Requesting Party points out that the designation chosen by the Owner of "necklaces" is very specific, and it submits that leather necklaces do not correspond to these goods. Since the Owner has not provided

evidence of the statements of “bracelets” and “necklaces”, the Requesting Party requests that these goods be deleted from the registration. For the remaining Goods, it submits that the evidence does not support the use of the Mark under the Act.

[20] With respect to the Services, the Requesting Party submits that the evidence does not support the use of the Mark in association with the “retail store” and “retail” services.

[21] In response, the Owner argues that the statement of goods is set out in ordinary commercial terms and that there was no requirement for the Owner to specify the manufacturing equipment for its goods. It also argues that correlation is possible, especially since some terms in the statement are [TRANSLATION] “interchangeable”. In its view, this is the case for toiletry bags, beach bags, travel bags, and sports bags, as well as suitcases and attaché cases. Overall, the Owner considers that it has provided sufficient evidence establishing use of the Mark in association with each of the Goods.

[22] With respect to the Services, although the Owner acknowledges that it does not have a brick-and-mortar retail store, it claims use of the Mark in association with each of the Services. In this regard, it submits that it operates its retail store and sells its retail goods through its website.

ANALYSIS

[23] 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. In light of this, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 38] and “evidentiary overkill” is not required [see *Union Electric Supply Co Ltd v Registrar of Trademarks* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. However, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the mark in association with *each* of the goods and services covered by the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

The Goods

The necklaces and bracelets

[24] Per section 30 of the Act, goods must be stated in ordinary commercial terms, and whether a trademark has been used in association with the registered goods is to be determined on a case-by-case basis [see *Express File Inc v HRB Royalty Inc*, 2005 FC 542]. It follows that the goods described in the registration must be given their ordinary meaning and interpreted in accordance with common sense.

[25] In this case, with respect to “necklaces”, I agree with the Requesting Party that the registration identifies a very specific good whose nature differs from that of the goods in evidence. In this regard, I am of the view that the necklaces, shown in the photographs and excerpts from the website, do not reasonably correspond to the very specific designation chosen by the Owner of “necklaces”. Furthermore, the invoices in evidence do not support the conclusion that the Owner has sold necklaces bearing the Mark. As noted above, one of the invoices describes two goods with the abbreviations “LTHR NCKLAC” and “LTHR TIE NCKLAC”, which I find reasonably designate leather necklaces. The same invoice lists a good without explicit reference to the manufacturing components, namely, “SPLEEN KILANI NECKLACE”. However, this good is also made of leather as it is shown on the excerpts of the Owner’s website [Exhibit LK1, page 14].

[26] Since no necklace in evidence specifically corresponds to the designation set out in the registration, I am not satisfied that the Owner has provided sufficient evidence establishing use of the Mark in association with “necklaces” within the meaning of sections 4(1) and 45 of the Act. Given that the evidence does not indicate any special circumstances excusing non-use of the Mark in association with “necklaces”, the registration will be amended accordingly.

[27] Pursuant to *Express File, supra*, I come to a different conclusion with respect to the “bracelets”. I am of the view that the designation chosen by the Owner of “bracelets” does not exclude evidence of use of a more specific good, such as leather bracelets. On the one hand, the goods shown on the excerpts from the website reasonably correspond to bracelets. On the other hand, they are identified as such on these

excerpts and in the invoices in evidence. Therefore, I am satisfied that the Owner has demonstrated use of the Mark in association with “bracelets” within the meaning of sections 4(1) and 45 of the Act.

[28] Before analyzing the remaining Goods, I would like to comment on the Requesting Party’s position on the Manual and its request to amend the statement of goods.

[29] The section 45 proceeding is limited in scope. Its purpose is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. This procedure is not intended to try contested issues of fact, nor is it intended to determine substantive rights in respect of a trademark. Rather, these issues must be decided by applying to the Federal Court under section 57 of the Act [see *Meredith & Finlayson v Canada (Registrar of Trademarks)* (1991), 40 CPR (3d) 409 (FCA); *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66 and *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at p 294]. Therefore, the question of whether the wording of the registration accurately expresses or sets out the Owner’s rights or complies with the Manual is outside the scope of the section 45 proceeding [see *Ridout & Maybee srl v Omega SA*, 2005 FCA 306]. It follows that the amendment proposed by the Requesting Party will not be discussed further.

The remaining Goods

[30] The Owner provided photographs and excerpts from its website showing belts, coin purses, and card holders bearing the Mark. It also provided invoices demonstrating the transfer of these goods to Canada during the relevant period. The Owner also provided photographs and excerpts from its website showing handbags bearing the Mark that are described as “CLUTCHS”, as well as an invoice showing the sale of these goods in Canada during the relevant period.

[31] In addition, the same invoice lists a “tablet clutch” and a “passport/wallet” showing the sale of these goods in Canada during the relevant period. Given that Mr. Kilani states that all the goods listed on the invoices bore the Mark [para 9], I find

that this invoice shows the sale of a “TABLET CLUTCH” and a “PASSPORT/WALLET” bearing the Mark [see *Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25 for the well-established principle that an affiant’s statements must be accorded substantial credibility in a section 45 proceeding]. Given the description of these two goods on the invoices, I find that they reasonably correspond to “tablet computer cases” and “portfolios”, respectively.

[32] Other correlations between the evidence and the Goods are less obvious; for example, this is the case for some of the goods shown in the excerpts from the website, namely, “City Bag”, “Duffle -24 Hour”, “Duffel-Weekend”, and “Briefcases”. That said, I do not consider it necessary to address the Owner’s position regarding their correlation with the Goods as the invoices in evidence show only the sale of “Briefcases” [Exhibit LK6, page 66].

[33] In short, I am satisfied that the Owner has demonstrated use of the Mark in association with “belts”, “coin purses”, “attaché cases”, “portfolios”, “tablet computer cases”, “card holders”, and “handbags” within the meaning of sections 4(1) and 45 of the Act.

[34] This is not the case for the remaining Goods, that is, “suitcases”, “wallets”, “toiletry bags”, “travel bags”, “casual clothing”, “telephone cases”, “computer cases”, “beach bags”, and “sports bags”. Although some of these are shown on the photographs and excerpts from the website, they are not listed on any invoice, and their sale cannot be inferred from the evidence produced. In the absence of a clear statement as to the representative nature of the invoices or other evidence of transfer, I am not satisfied that the Owner has provided sufficient evidence establishing the use of the Mark in association with these goods within the meaning of sections 4(1) and 45 of the Act. Given that the evidence does not indicate any special circumstances excusing the non-use of the Mark in association with these goods, the registration will be amended accordingly.

Services

[35] With respect to online sales services, the Owner provided excerpts from the website bearing the Mark and showing several goods for sale. These excerpts also show product selection pages and the possibility of adding these goods to a virtual cart to place the order online. I am therefore satisfied that the Owner has demonstrated use of the Mark in the advertising of online sales services and that it was prepared and able to provide them in Canada during the relevant period. In addition, the invoices in evidence demonstrate the performance of online sales services related to the goods they list, which will be detailed below.

[36] With respect to retail store and retail sales services, the Federal Court has held that retail store services may also be performed within the meaning of the Act without a physical presence in Canada [*Dollar General Corporation v 2900319 Canada Inc*, 2018 FC 778; and *Saks & Co v Canada (Registrar of Trademarks)* (1989), 24 CPR (3d) 49 (FCTD)]. In such cases, a trademark owner must demonstrate a certain level of interactivity with Canadian customers in order for there to be a benefit in Canada sufficient to support its registration. The benefit must be a tangible, meaningful benefit enjoyed in Canada from the services relied upon by the owner [see *Hilton Worldwide Holding LLP v Miller Thomson*, 2018 FC 895, aff'd 2020 FCA 134; and *Live! Holdings, LLC v Oyen Wiggs Green & Mutala LLP*, 2019 FC 1042, aff'd 2020 FCA 120].

[37] In this case, I accept that the Owner has demonstrated a sufficient level of interactivity with Canadian customers to ensure that there is a sufficient benefit for them. In particular, the “Contact Us” section of the website includes a telephone number in Canada and the possibility of contacting the Owner by email to request further information on the goods. The website also includes a specific field on the product selection page where customers can enter initials to be engraved on the selected item. In my view, such services are similar to what might be found in a retail store or a brick-and-mortar retail store. Therefore, I find that the Owner’s customers could enjoy a tangible, meaningful benefit in Canada during the relevant period [see *TSA Stores, Inc v Registrar of Trademarks*, 2011 FC 273 at para 19; and *Perley-Robertson, Hill & McDougall LLP v Window World International, LLC*, 2022 TMOB 53 at paras 42–44].

[38] Therefore, I am satisfied that the Owner has demonstrated use of the Mark in the advertising of retail store and retail sales services in Canada during the relevant period.

[39] Furthermore, in view of the fact that the Owner operates its retail store and sells its retail goods only through its website, I accept that the performance of the online sales service may have necessarily resulted in the performance of the shop and retail services [see *Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 TMOB 7 at para 15; *Provent Holdings Ltd v Star Island Entertainment, LLC*, 2014 TMOB 178 at para 22; and *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 148 at para 69].

[40] The goods included in the wording of the Services have yet to be determined. In this regard, I first note that the statement of services refers to goods that are not quite the same as those specified in the statement of goods. This is the case for the goods covered by the Owner's concessions at the hearing and for "clothing", "jewellery", "luggage", "hats", and "boots".

[41] As concerns clothing, jewellery, hats, and boots, these goods are not shown on any excerpt from the website. Since the Owner did not provide evidence of special circumstances justifying non-use of the Mark in the advertising of Services relating to "clothing", "jewellery", "hats", and "boots", the registration will be amended accordingly.

[42] However, having concluded above that the Owner has demonstrated use of the Mark in association with "attaché cases", the performance of the Services related to "luggage" is demonstrated accordingly.

[43] In view of the invoice description in evidence, I am satisfied that these demonstrate the performance of the Services related to handbags, coin purses, and belts.

[44] In short, I am satisfied that the Owner has provided sufficient evidence to establish use of the Mark in association with the Services related to "luggage and fashion accessories, namely handbags, coin purses, belts" within the meaning of sections 4(2) and 45 of the Act.

DECISION

[45] In view of all 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 shall be amended to delete:

Goods

(1) ..., suitcases, wallets, ..., gloves, toiletry bags, travel bags, ..., casual clothing, ..., necklaces, telephone cases, computer cases, ..., beach bags, sports bags

Services

(1) [Retail store] for clothing, jewellery, ... hair accessories, ..., hats, ..., shoes, boots, and watches; [online sale] of clothing, jewellery, ..., hair accessories, ..., hats, ..., shoes, boots, and watches; [retail] of clothing, jewellery, ..., hair accessories, ..., hats, ..., shoes, boots, and watches.

[46] The statement of goods and services will read as follows:

Goods

(1) Belts, coin purses, attaché cases, portfolios, bracelets, tablet computer cases, card holders, handbags

Services

(1) Retail store for luggage and fashion accessories, namely handbags, coin purses, hats, belts; online sale of luggage and fashion accessories, namely handbags, coin purses, belts; retail of luggage and fashion accessories, namely handbags, coin purses, belts;

Maria Ledezma
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Appearances and Agents of Record

DATE OF HEARING: 2024/03/08

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