



“L’AMADEI” TRADE-MARK NOT “DEAD WOOD” RULES FEDERAL COURT IN SUMMARY EXPUNGEMENT CASE

BARRY GAMACHE^{*}
LEGER ROBIC RICHARD, LLP
LAWYERS, PATENT & TRADEMARK AGENTS

In a case that reviewed the applicable principles in summary expungement proceedings under section 45 of Canada’s *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereafter: the “Act”), the Federal Court ordered that the trade-mark L’AMADEI, registered for various clothing items, remain in part on the trade-mark register (*Vêtement Multi-Wear Inc. v. Riches, McKenzie & Herbert LLP*, 2008 FC 1237 (F.C., Shore J., November 5, 2008)).

On August 7, 1998, *Vêtement Multi-Wear Inc.* (hereafter: “MULTI-WEAR”), a clothing manufacturer, secured registration in Canada of the trade-mark L’AMADEI in association with ladies’ clothing, namely pants, vests, skirts, dresses, blouses and sweaters.

Nearly a decade later, at the request of *Riches, McKenzie & Herbert LLP*, (hereafter: “RMH”), the Registrar of Trade-marks issued on March 28, 2007 a section 45 notice against MULTI-WEAR’s 1998 registration for the trade-mark L’AMADEI.

Section 45 of the Act provides in part that the Registrar may at any time and, at the written request made after three years from the date of registration of a trade-mark by any person who pays the prescribed fee, shall give notice to the registered owner of a trade-mark requiring it to furnish evidence of use of said trade-mark with respect to each of the wares or services specified in the registration, whether the trade-mark in question was in use in Canada at any time during the three year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date. If no evidence of use is filed, or if only partial evidence is submitted, the registration of the trade-mark is liable to be expunged or amended accordingly.

The power granted to the Registrar under section 45 is quite considerable as he can order the expungement of a trade-mark if it does not seem to be in use. Such appeared to be the fate set for the L’AMADEI trade-mark before the Registrar.

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^{*} Lawyer, Barry Gamache is a member of LEGER ROBIC RICHARD, L.L.P., a multidisciplinary firm of lawyers, and patent and trademark agents. Published in the February 2009 issue of the World Intellectual Property Report. Publication 142.220

LEGER ROBIC RICHARD, L.L.P.
1001 Square-Victoria - Bloc E - 8th floor
Montreal (Quebec) Canada H2Z 2B7
Tel.: (514) 987-6242 Fax: (514) 845-7874
www.robic.ca info@robic.ca

Indeed, upon receipt of the March 28, 2007 notice issued by the Registrar, MULTI-WEAR consulted its attorney and, by its own inadvertence, neglected to supply its legal representative with all the information and documentation required to respond to the notice. This led to a failure by MULTI-WEAR to file a timely response. Accordingly, as provided for under the Act, the Registrar handed down a short decision by which it ordered the expungement of MULTI-WEAR's registration. It appeared that MULTI-WEAR was about to lose its registration because of the lack of evidence of use of its trade-mark in these "use it or lose it" proceedings.

As allowed by section 56 of the Act, MULTI-WEAR filed an appeal against the Registrar's decision before Canada's Federal Court. There, as permitted by subsection 56(5), it submitted its evidence of use allowing the Court to review documents that were not before the Registrar. In effect, under section 56, MULTI-WEAR had a second chance to provide evidence of use and make its case why its registration should not be expunged.

What kind of evidence is required in section 45 proceedings? Shore J. referred to the words of the Federal Court of Appeal in *Eclipse International Fashions Canada Inc. v. Shapiro Cohen*, 2005 FCA 64, where a unanimous Court stated that "it is not necessary, in the context of an expungement request under section 45, to provide an over-abundance of evidence of use or utilization of the mark. The purpose of section 45 is to rid the register of "dead wood"". Additionally, as Shore J. noted, even evidence of a single sale in a normal course of trade has been found to be sufficient so long as it is considered to be a genuine commercial transaction, and not contrived to protect the registration of a trade-mark.

With these guidelines, Shore J. reviewed the evidence filed for the first time before the Court. Shore J. was satisfied that the evidence supported use of the trade-mark L'AMADEI in respect of ladies' clothing, namely pants, skirts, dresses and blouses. However, no evidence of use was found for vests and sweaters. These wares were therefore expunged as section 45 requires proof of use "with respect to each of the wares or services". However closely related two items may be in a statement of wares (such as blouses and vests), evidence of use must be submitted for each item the registrant has identified in his statement of wares.

Apart from the legislative requirement, the underlining reason for this rule was highlighted by Stone J.A. in *John Labatt Ltd. v. Rainer Brewing Co.* (1984), 80 C.P.R. (2d) 228 (F.C.A.), a case where the registrant had registered its trade-mark in association with similar types of alcoholic beverages, at pp. 236-7: "It is apparent that 'beer', 'ale', 'porter' and 'stout' are related wares, belonging to a single family of brewery products... Specification of the wares other than beer suggests, in the absence of proof to the contrary, that each is indeed different in some degree from the others and from 'beer' itself, as otherwise the words 'ale, porter, stout, malt beverages, malt syrup and malt extracts' are superfluous... In this case, the respondent has not shown that the trade-mark RAINIER is in use in Canada with

respect to all the wares specified. It has shown only that the mark is in use with respect to 'beer'. The fact that the other wares specified fall within a group of wares that are in some way related to beer is not sufficient, in my view, to preserve the registration intact. That could only be done if the respondent had also shown that the trade-mark is in use in Canada with respect to each of these other wares".

The important lesson to traders is that the phrase "use it or lose it" applies to each registered ware or service. Care must therefore be shown when drafting a trade-mark application to ensure that protection is not sought for multiple variations of the same item. Otherwise, in section 45 cases, what are supposed to be summary proceedings might turn out to be very costly for a registrant.



