

**SECTION 45 PROCEEDINGS  
TRADE-MARK: EVOLUTION  
REGISTRATION NO.: TMA 460,656**

On May 29, 2003, at the request of Sara Lee Corporation, the Registrar forwarded a Section 45 notice to Mark Naylor, doing business as Classic Cowboys Design, the registered owner of the above-referenced trade-mark registration.

The trade-mark EVOLUTION is registered for use in association with the following wares:

“Men’s, women’s and children’s clothing, namely, shirts, tank-tops,  
T-shirts, sweatshirts, pants, shorts, skirts, jackets, hats, caps.”

Section 45 of the *Trade-marks Act* requires the registered owner to show, with respect to each of the wares or services specified in the registration, whether the trade-mark 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 use since that date. Thus, the relevant period with regard to the registered trade-mark in this case is any time between May 29, 2000 and May 29, 2003.

In response to the notice the affidavit of Mark Naylor together with exhibits has been furnished. Each party filed a written argument. The requesting party alone was represented at the oral hearing.

In his affidavit, Mr. Naylor states that he is carrying on business under the name Classic

Cowboys Design which he then refers to as “CCD”. He indicates that “CCD” has used and continues to use the trade-mark EVOLUTION in Canada in association with the wares namely men’s, women’s and children’s clothing namely shirts, tank-tops, T-shirts, sweatshirts, pants, shorts, skirts, jackets, hats and caps.

As Exhibit A, he provides pictures of wares he states are sold under the trade-mark EVOLUTION. I would note here that the “hat” pictured therein bears a completely different trade-mark namely EVO SOCCER. He then explains that CCD’s business is a “made to order” business and that the wares are sold to customers upon request. He states that the selling of the wares under the trade-mark EVOLUTION is a part-time business and stock is not readily available unless ordered. He adds that CCD’s wares are primarily sold to ski resorts, golf clubs, sports organizations or teams and faculties within colleges and universities.

He indicates that CCD has sold their wares at kiosks which are set up in shopping malls, in every major city in Canada and as Exhibit C (incorrectly referred to as “B” in his affidavit) he provides photographs of a kiosk which he states shows use of the trade-mark EVOLUTION.

As Exhibit B (incorrectly referred to as “C” in his affidavit) he provides copies of invoices for the years 2000 to 2002 which he states reflects customers and retailers of the wares owned by CCD. He then provides CCD’s revenues for the years 2000 to 2002. For the year 2003 he states that CCD focused on restructuring the direction of the business and financing of a new product line and that only single orders have been placed through the website but nothing of significance.

As Exhibit D he provides a copy of the website where customers can place their orders for the wares.

The requesting party has raised several arguments concerning the evidence furnished, the main ones are summarized as follows:

If any use has been shown, it is not use by the registered owner or accruing to the registered owner.

Further, any use shown is not of the word EVOLUTION as a trade-mark or use of EVOLUTION *per se*.

In the alternative, if it is considered that use has been shown then it is only in association with women's and men's T-shirts and sweatshirts.

Concerning the requesting party's first argument I am of the view that when the affidavit is given a fair reading and when it is considered as a whole, it can be concluded that any reference in the affidavit to "CCD" is a reference to the trade name of the registered owner namely CLASSIC COWBOYS DESIGN which I accept is not a separate legal entity from the registered owner.

As Mr. Naylor has clearly indicated that he carries on business under the trade name CLASSIC COWBOYS DESIGN that is sufficient for purposes of Section 45 to permit me to conclude that any use by CLASSIC COWBOYS DESIGN is use by the registered owner. As the name CLASSIC COWBOYS DESIGNS appears at the top of the invoices I consider this to be a reference to the trade-name of the registered owner (even if it appears in the plural form) and therefore I conclude that the invoices show sales by the registered owner. Although I agree that the invoices bear addresses that differ from the address of record of the registered owner, I find

this to be insufficient to arrive at a conclusion that the use is not by the registered owner.

Concerning the words EVOLUTION SPORTSWEAR also appearing at the top of the invoices, I accept based on the evidence as a whole, that the expression is merely another trade-name and/or trade-mark of the registrant.

I will now address the issue of whether the use shown is of the trade-mark EVOLUTION “*per se*”.

I have to agree with the requesting party that the word EVOLUTION with additional matter appearing on the front of the sweatshirt and T-shirt shown in Exhibits A and C and as it appears on some of the designs found in Exhibit D would not be perceived as use of the trade-mark EVOLUTION *per se*. I have reproduced below a copy of the sweatshirt and T-shirt found under Exhibit A and a few examples of similar designs found in Exhibit D:

Exhibit A

Exhibit D

The word EVOLUTION is being used with additional matter which consists of a series of designs with reading matter. I have to agree with the requesting party that in each case the word EVOLUTION would probably be perceived as forming an integral part of the “overall design” and therefore as an element of the whole rather than as a separate trade-mark. Notwithstanding the use of the “TM” symbol after the word EVOLUTION (see Exhibit A) the overall impression created is use, in my view, of an overall design having a combination of elements. Consequently, I conclude that use of any one of the combinations shown above does not constitute use of the trade-mark EVOLUTION “per se”. (*Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535, Principle 1 and *Registrar of Trade-Marks v. Compagnie Internationale pour l’Informatique CII Honeywell Bull S.A.*, 4 C.P.R. (3d) 523 (F.C.A.)).

Exhibit D shows another series of designs the registered owner uses on wares. I have reproduced below a few of these designs:

Exhibit D

Concerning the above-referenced designs I find that arguably the public could perceive the word EVOLUTION *per se* as being used considering that the word EVOLUTION stands out sufficiently from the additional matter to create a separate impression in the minds of the public. However, it is unclear from the evidence which of the registered wares were sold during the relevant period bearing the trade-mark in such manner.

The requesting party also raised the argument that the use of the trade-mark on the front of t-shirts and sweatshirts is ornamental and is not trade-mark use to distinguish the registrant's wares from those of others. However, in view of my conclusions above, it is unnecessary for me to address this issue.

The evidence also shows that the word EVOLUTION appears on signage at kiosks, at the top of the registrant's website and in the body of some of the invoices.

Concerning the display of the trade-mark on signage at kiosks which the affiant has indicated were set up in shopping malls in every major cities in Canada, I am of the view that the public would probably perceive the trade-mark EVOLUTION SPORTSWEAR thereon as being used rather than the trade-mark EVOLUTION "per se". Even if I could conclude that the trade-mark on the signage could be perceived as use of EVOLUTION "per se", there is a complete lack of evidence as to when these kiosks were in place and therefore I would not be able to conclude that the use in such manner occurred during the relevant period.

Concerning the display of the trade-mark at the top of the registrant's website, although EVOLUTION "per se" would be perceived as being used, I conclude that such use is not a use satisfying the requirements of s-s. 4(1) of the Act as the website would not provide the required notice of association between the trade-mark and the wares at the time of transfer of the wares. In addition, I find it is unclear whether such website was in operation during the relevant period.

Concerning the invoices, I am satisfied that in the body of some of the invoices reference is made to the trade-mark EVOLUTION "per se". In particular I refer to Invoice No. 1859 which clearly bears a date within the relevant period. However, the requesting party argues that as the registered owner has failed to indicate that the invoices in question accompanied the wares then the invoices cannot be considered as having provided the required notice of association between the trade-mark and the wares to the purchaser at the time of transfer of the wares. In support of its position the requesting party relies on the case *Riches, McKenzie & Herbert v. Pepper King Ltd.*, 8 C.P.R.(4th) 471.

I agree that the affiant has not stated that the invoices accompanied the wares and I am familiar with the decision of the Federal Court in *Riches, McKenzie & Herbert, supra*, that held that the Registrar cannot assume that invoices accompany wares in the absence of evidence to that effect.

Here, however, I will accept that the invoices did accompany the wares given that on the invoices it is indicated that the supply of products was on a cash on delivery basis (C.O.D.). It seems that in order for the customer to be aware of the amount to be paid upon delivery of the wares the



customer would have to have received the invoice together with the products and, in my view, this would have provided sufficient notification for purposes of s-s. 4(1) of the Act. In reaching this conclusion I rely in part on the decision of the Exchequer Court in *Gordon A. MacEachern Ltd. V. National Rubber Co. Ltd.*, 41 C.P.R. 149.

As the invoices mentioned above relate only to the sale of t-shirts and sweatshirts and no other wares then I conclude that use of the trade-mark as registered has been shown but only in association with “t-shirts and sweatshirts”. Further, having regard to the evidence as a whole I conclude that the T-shirts and sweatshirts were probably “men’s and women’s T-shirts and sweatshirts”. Accordingly I conclude that only the wares “men’s and women’s clothing namely T-shirts and sweatshirts” ought to be maintained on the trade-mark registration.

Registration No. TMA 460,656 will be amended accordingly in compliance with the provisions of Section 45(5) of the *Trade-marks Act*.

DATED AT GATINEAU, QUEBEC, THIS 17TH DAY OF MARCH 2006.

D. Savard  
Senior Hearing Officer  
Section 45 Division