



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

Citation: 2014 TMOB 74
Date of Decision: 2014-03-28

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Vetex against registration No. TMA679,711
for the trade-mark V-TECH in the name of Alliance
Mercantile Inc.**

[1] At the request of Vetex, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on April 25, 2012 to Alliance Mercantile Inc. (the Owner), the registered owner of registration No. TMA679,711 for the trade-mark V-TECH (the Mark).

[2] The Mark is registered for use in association with the wares “waterproof breathable fabrics made of nylon, polyester, or other fabrics coated with waterproof breathable polyurethane and other waterproof breathable coatings”.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with the wares 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 between April 25, 2009 and April 25, 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 wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is

in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Owner filed the affidavit of Douglas Bell, President of the Owner, sworn on July 20, 2012. No written representations were filed; an oral hearing was not held.

[7] In his affidavit, Mr. Bell attests that the Owner is a manufacturer and distributor of a variety of products, including industrial and recreational waterproof outerwear. He explains that the Owner has approximately 3700 customers in Canada, and sells its safety wear products to a broad range of distributors, retailers and individual customers.

[8] With respect to the registered wares, he asserts that the Owner has used the Mark in association with “waterproof breathable fabrics coated with waterproof breathable polyurethane coatings” since at least 2006. He explains that the fabric is made of polyester and is coated with a waterproof breathable multilayer polyurethane coating. He describes two types of fabric for different lines of clothing manufactured by the Owner during the relevant period, both fabrics being made of polyester. He attests that the Owner has “also developed, for future launch, a nylon fabric with laminated polyurethane-polyamide coating”.

[9] Mr. Bell attests that the Owner markets its fabric in association with the Mark in a variety of ways. In particular, he explains that clothing wares manufactured with V-TECH fabric have hang tags bearing the Mark attached to them. These tags describe the waterproof features of the V-TECH fabric. Attached as Exhibits D and E are copies of hang tags, which Mr. Bell attests are representative of those attached to clothing made with V-TECH fabric and sold in Canada during the relevant period. The hang tags prominently display the Mark with the description “Waterproof/Breathable” underneath.

[10] Mr. Bell attests that, in Canada during the relevant period, the Owner had sales of approximately \$800,000 of clothing garments made with its V-TECH fabric and displaying the Mark. In support, he provides a sales report of such sales (Exhibit F), and representative invoices (Exhibits G, H and I). Mr. Bell also provides evidence of the Owner's promotion of the Mark during the relevant period, including excerpts from the Owner's website (Exhibit A) and copies of the Owner's product catalogues from the relevant period (Exhibits B and C). These exhibits show the advertisement of various clothing items such as jackets and pants featuring the V-TECH fabric.

[11] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the wares "waterproof breathable fabrics made of polyester, nylon or other fabrics coated with waterproof breathable polyurethane coatings" during the relevant period within the meaning of sections 4 and 45 of the Act.

[12] In coming to this conclusion, I note that the statement of wares as registered is open to more than one interpretation. However, in my view, the most reasonable interpretation is that it encompasses a variety of waterproof breathable fabrics having a variety of waterproof breathable coatings. The evidence furnished by the Owner supports this interpretation. Although Mr. Bell's assertion of use is not limited to a particular fabric, the corresponding evidence with respect to the relevant period would appear to show use of the Mark in association with only one particular fabric (polyester) having one particular type of coating (polyurethane).

[13] Nonetheless, with respect to the "waterproof breathable fabrics", the construction of the statement of wares using "or" to delineate the types of fabrics favours maintaining this first portion as registered. In this respect, while a coherent statement may result if reference to "nylon" and "other fabrics" was deleted, I note an absurd result had the Owner furnished evidence with respect to a fabric other than nylon or polyester and an attempt was made to amend the statement of wares accordingly [see also *Shapiro Cohen v Trapeze Software Inc* (2000), 8 CPR (4th) 409 (TMOB) regarding the Registrar's lack of authority under section 45 of the Act to amend a broad statement of wares to be more specific].

[14] On the other hand, with respect to the second portion of the statement of wares regarding the types of coatings, I note that Mr. Bell's assertion of use specifically refers to "polyurethane

coatings” and not to any “other” types of coatings. In contrast to the “or” in the first portion of the statement of wares, the “and” in the second portion raises the potential for competing interpretations with respect to the nature of the coatings. As such, in lieu of representations from either party, I am inclined to take Mr. Bell’s assertion at face value and conclude that neither the assertion of use nor the corresponding evidence furnished supports the registration with respect to “other” waterproof breathable coatings.

[15] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with “...fabrics coated with ... other waterproof breathable coatings” 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 in association with such wares before me. In view of the particular circumstances of this case and consistent with Mr. Bell’s assertion of use, the registration will be amended accordingly.

Disposition

[16] 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 following from the statement of wares: “...and other waterproof breathable...”.

[17] The amended statement of wares will be as follows: “Waterproof breathable fabrics made of nylon, polyester, or other fabrics coated with waterproof breathable polyurethane coatings”.

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