

SECTION 45 PROCEEDINGS  
TRADE-MARK: ST-ANDREWS & design  
REGISTRATION NO.: TMA619,431

[1] At the request of St. Andrews Links Limited (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) on June 30, 2008 to Glen Argyle Inc. (the “registrant”), the registered owner of registration No. TMA619,431 for the following trade-mark:



[2] The trade-mark ST-ANDREWS & design is registered in association with the following wares: “Men’s and women’s golf wear and leisure wear, namely bermuda shorts, slacks, polo shirts, sweatshirts, sweaters, jackets and headwear, namely hats.”

[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 each of the wares and/or 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 between June 30, 2005 and June 30, 2008 (the “relevant period”).

[4] “Use” in association with wares is set out in subsections 4(1) and 4(3) 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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, subsection 4(1) applies.

[5] In response to the Registrar's notice, the registrant furnished the affidavit of Catherine Bastien, a director and the president of the registrant, sworn on August 21, 2008, together with Exhibits A and B. Only the requesting party filed written submissions; neither party requested an oral hearing.

[6] In her affidavit, Ms. Bastien states that the registrant has been using the trade-mark in association with the wares specified in the registration on an ongoing basis since 2004. The affidavit states that the registrant imports, sells and distributes the wares to its various customers in Canada. Attached to the affidavit as Exhibit A are invoices which Ms. Bastien states show sales by the registrant of the trade-marked wares. Attached as Exhibit B is a sample hang-tag which Ms. Bastien explains is attached to the garments, and a sample of plastic packaging which Ms. Bastien states is used to contain the garments. I note that there are some variations between the trade-mark shown in Exhibit B and the registered trade-mark.

[7] At the outset it should be noted that the requesting party objected to the affidavit because it contains no indication of the length of time that Ms. Bastien held her position or was employed by the registrant. As such, it was submitted that I should find that she was not employed by the registrant during the relevant period, and that she does not have direct knowledge of the use of the trade-mark during that time.

[8] Bearing in mind the intent and purpose of section 45 proceedings and the principle that some latitude must be allowed in interpreting what constitutes "personal knowledge" given Ms. Bastien's position as a director and the president of the company: *Vapor Canada Ltd. v. MacDonald* (1972), 6 C.P.R. (2d) 204 (F.C.T.D.), affirmed on other grounds, (1972), 8 C.P.R. (2d) 15 (F.C.A.), reversed on other grounds, (1976) 22 C.P.R.

(2d) 1 (S.C.C.); *Season-All Industries, Inc. v. Thermo Window Systems Inc.* (1987) 15 C.P.R. (3d) 477 (T.M.O.B.), I am prepared to accept that she possesses sufficient knowledge of the company's operation to render her affidavit admissible in these proceedings.

[9] The requesting party also claims that Ms. Bastien's statement that the registrant has used the trade-mark in association with the wares on an ongoing basis since 2004 is ambiguous, and insufficient to show that the mark has been in use *during the relevant period*. Although I agree that Ms. Bastien could have been more specific, I am prepared to accept on a fair reading of the affidavit, including the dates of the invoices provided (as discussed below), that the trade-mark was used by the registrant in Canada during the relevant period.

[10] I turn now to the question of whether or not the trade-mark shown to be in use constitutes use of the registered trade-mark within the meaning of section 45 and subsection 4(1) of the Act.

[11] The requesting party submits that the registered trade-mark and the trade-mark shown in Exhibit B are substantially different. Although the two are different, in my view, they differ only in small, unimportant details; such that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used: *Registrar of Trade Marks v. Compagnie Internationale Pour L'informatique CII Honeywell Bull, Societe Anonyme* (1985), 4 C.P.R. (3d) 523 (F.C.A.).

[12] The registered trade-mark is comprised of the words St-Andrews in stylized font appearing below a thistle design. The trade-mark depicted on the hang-tag and packaging (shown below) has the words St-Andrews in the same font as in the registered trade-mark, between two horizontal lines, all of which is superimposed over the thistle design. The dominant impression created by the dominant features in both is that of the words St-Andrews. I consider the different arrangement of the elements, the addition of the two

lines, and the use of reverse colouring, i.e. white lettering on a black or dark background, to be merely minor variations that do not result in the registered trade-mark being unrecognizable. The same dominant features are maintained and the differences are so unimportant as not to mislead an unaware purchaser: *Promafil Canada Ltée v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.).



[13] In view of the above, I have concluded that the use shown constitutes use of the trade-mark as registered.

[14] With regard to the evidence of sales, the registrant furnished invoices showing sales by the registrant to Canadian consumers in British Columbia, Quebec and Ontario. I note that the first three invoices in Exhibit A are all dated in 2004 (before the relevant period). As there is no indication in the affidavit that these invoices are representative of sales of these wares to Canadian customers during the relevant period, these invoices will be disregarded. However, the remaining invoices fall within the relevant period, and show sales of caps, pants and bermuda shorts (invoice no. 003798 refers to sales of “ST-ANDREWS BERM”, which I infer to be an abbreviation of bermuda shorts). I also note that the invoices reference ST-ANDREWS and ST-A (which I infer to be an abbreviation of ST-ANDREWS), to identify the wares. Therefore, I am satisfied that the evidence shows sales of bermuda shorts, slacks (slacks being synonymous with pants) and hats (hats being synonymous with caps) in the normal course of trade in Canada within the relevant period.

[15] I agree with the requesting party that the registrant has not shown use of the trade-mark in association with polo shirts, sweatshirts, sweaters and jackets. Since the registrant has not shown that the trade-mark was in use in Canada with all of the wares

specified in the registration, and has not advanced special circumstances that would excuse the absence of use of the trade-mark with these wares, I conclude that the registration ought to be amended to remove polo shirts, sweatshirts, sweaters and jackets: *John Labatt Ltd. v. Rainier Brewing Co.* (1984), 80 C.P.R. (2d) 228 (F.C.A.) at 236. In my view, the number of wares listed in the registration is not so large that it would have been onerous for the registrant to provide clear statements or supporting documents with respect to each ware.

[16] There is no dispute regarding the actual appearance of the trade-mark on the wares, and Ms. Bastien has provided a statement that the wares in the invoices were sold under the trade-mark. I therefore accept that the bermuda shorts, slacks and hats - to which the invoices relate - were sold to the registrant's Canadian purchasers during the relevant period, with hang-tags and/or in packaging bearing the trade-mark. The use of the trade-mark in this manner satisfies the requirements of section 4(1) of the Act.

[17] For the foregoing reasons, I am satisfied that there was use of the trade-mark within the meaning of section 45 and subsection 4(1) with respect to "bermuda shorts, slacks and hats". Accordingly, and pursuant to the authority delegated to me under subsection 63(3) of the Act, registration No. TMA619,431 will be maintained in respect of "bermuda shorts, slacks and hats" and amended to delete "polo shirts, sweatshirts, sweaters and jackets" from the statement of wares, in accordance with the provisions of subsection 45(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC THIS 30th DAY OF DECEMBER 2009.

P. Heidi Sprung  
Member  
Trade-marks Opposition Board