



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

**Citation: 2010 TMOB 180**  
**Date of Decision: 2010-10-25**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Oyen Wiggs Green & Mutala LLP against  
registration No. TMA455,196 for the trade-mark  
STONES in the name of Dressmaster GmbH (formerly  
Dressmaster Bekleidungswerk GmbH & Co. KG)**

[1] At the request of Oyen Wiggs Green & Mutala LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on June 6, 2007 to Dressmaster Bekleidungswerk GmbH & Co. KG (the Registrant), the registered owner of the above-referenced trade-mark registration. The trade-mark STONES (the Mark) is registered for use in association with “clothing for men, women and children namely, coats, jackets, suits, pants, skirts, blouses, shirts, sweaters, underwear; footwear namely boots, sneakers, loafers, shoes, leger shoes, sandales and slippers” (the Registered Wares).

[2] I note that the Canadian Intellectual Property Office (CIPO) recorded a change of name of the Registrant on June 18, 2008 recording the Registrant’s new name as Dressmaster GmbH. The effective date of the name change recorded by CIPO is August 30, 2000.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares 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 any time between June 6, 2004 and June 6, 2007 (the Relevant Period).

[4] “Use” in association with wares is set out in s. 4 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, s. 4(1) of the Act applies.

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing deadwood from the register and as such, the threshold test is quite low. As stated by Mr. Justice Russell in *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270 (F.C.T.D.):

68. [...] We know that the purpose of s. 45 proceedings is to clean up the “dead wood” on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must “show” how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade mark owners business and merchandising practices.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Jean Lefebvre sworn December 5, 2007, together with Exhibits “A” through “I”. Mr. Lefebvre has been the President of 3509885 Canada Inc. since its incorporation in 1998. Mr. Lefebvre states that 3509885 Canada Inc. does business as an importer and wholesale vendor of clothing in Canada under the name Style & Transition (“Style & Transition”). Mr. Lefebvre states that, since 1998, Style & Transition has acted as the Registrant’s sole Canadian distributor for clothing sold in association with the Mark. Prior to 1998, Mr. Lefebvre was the Sales Director of the Registrant’s prior Canadian distributor which, at the time, was a subsidiary of the Registrant’s parent company.

[7] I note that the case law is clear that in a s. 45 proceeding, the evidence filed need not have been sworn by the trade-mark owner itself so long as it is “furnished” by the trade-mark owner [see *Canada (Registrar of Trade Marks) v. Harris Knitting Mills Ltd.* (1985), 4 C.P.R. (3d) 488 (F.C.A.)]. Based on the foregoing, I find that an affidavit of a Canadian distributor for the trade-mark owner, as in the present case, is acceptable.

[8] Only the Registrant filed written representations and no oral hearing was requested.

[9] I will now turn to the evidence introduced by the Registrant, which I note relates only to menswear.

[10] Firstly I note that Mr. Lefebvre states that the Registrant’s change of name occurred in 2004; this does not correspond to the effective date recorded by CIPO. In any event, the effective date of the change of name is not determinative of any of the issues in the present case.

[11] Mr. Lefebvre states that the Registrant manufactures and sells garments under its various trade-marks, including the Mark. Mr. Lefebvre states that the Registrant manufactures most of its inventory at its own facilities but that it also sub-contracts a small portion of its inventory to outside manufacturers. Mr. Lefebvre attaches to his affidavit photocopies of sample invoices from the Relevant Period issued by the Registrant to Style & Transition for menswear sold under the Mark (Exhibit A). I note that these invoices clearly show the wares identified therein as emanating from the Registrant.

[12] Acting as the Registrant’s sole distributor in Canada for clothing sold under the Mark, Mr. Lefebvre states that Style & Transition imports clothing and accessories from the Registrant for resale to Canadian retailers. Mr. Lefebvre states that, in furtherance of this relationship, he meets with the Registrant’s management in Germany two to four times per year. Mr. Lefebvre explains that Style & Transition sells the Registrant’s clothing and accessories to Canadian retailers through its showrooms located in Montreal and its agent located in Vancouver. Mr. Lefebvre explains that these Canadian retailers then sell the clothing and accessories to individual customers in Canada.

[13] The Court has stated on several occasions that use of a trade-mark at any point along the chain of distribution is sufficient to demonstrate use as defined in s. 4 of the Act and that use will

accrue to the benefit of a registrant provided that the wares bearing the trade-mark originate from the registrant [see *Manhattan Industries Inc. v. Princeton Manufacturing Ltd.* (1971), 4 C.P.R. (2d) 6 (F.C.T.D.) and *Venice Simplon-Orient-Express, Inc. v. Société Nationale des Chemins de fer Français SNCF* (2000), 9 C.P.R. (4th) 443 (F.C.T.D.)]. In the present case, based on a review of the affidavit evidence as a whole, I am satisfied that the menswear sold under the Mark during the Relevant Period originated from the Registrant. Furthermore, I am satisfied that Style & Transition acts solely as the Canadian distributor for these products.

[14] In his affidavit, Mr. Lefebvre states that since 1998, Style & Transition has sold approximately 10,000 to 12,000 units each year of the Registrant's menswear and fashion accessories to Canadian retailers across Canada (Exhibit C). Mr. Lefebvre states that annual sales in the Relevant Period for products sold under the Mark in Canada by Style & Transition have amounted to approximately \$999,000 in 2007, \$876,000 in 2006, \$866,000 in 2005 and 881,000 in 2004.

[15] As proof of these sales, Mr. Lefebvre attaches photocopies of representative sample invoices for selections of menswear sold under the Mark by Style & Transition to Canadian retailers during the Relevant Period (Exhibit B). These sample invoices feature the Mark and include brief descriptions of the nature of the products covered by these invoices (i.e. variously covering: coats, jackets, suits, pants, shirts and/or knitwear). I accept the invoices as corroborating Mr. Lefebvre's testimony as to the sales of menswear associated with the Mark in the Relevant Period.

[16] Mr. Lefebvre states that the Mark can be seen on labels and/or hang tags attached to the Registrant's clothing at the time of sale. As proof of this, Mr. Lefebvre attaches to his affidavit a selection of the Registrant's clothing with labels and hangtags attached as well as a selection of detached tags and labels (Exhibit D). I note that the labels, tags and clothing attached to Mr. Lefebvre's affidavit all display the Mark.

[17] Mr. Lefebvre attaches to his affidavit a photograph of a retail store location for one of Style & Transition's Canadian retailer customers, namely, BTQ, located in Montreal (Exhibit F). The photograph shows the Mark displayed in close proximity to the Registrant's menswear.

[18] Mr. Lefebvre attaches to his affidavit a selection of garment bags, paper bags and boxes that display the Mark and are used by retailers to package the Registrant's menswear (Exhibit G).

[19] I note that Mr. Lefebvre has not specifically indicated whether the sample wares (Exhibit D), sample tags and labels (Exhibit D), photograph of a retail store location (Exhibit F) and sample packaging (Exhibit G) attached to his affidavit are representative of how the Mark was used during the Relevant Period. Although it would have been preferable for Mr. Lefebvre to have specifically indicated this; I am prepared to accept on a fair reading of the Lefebvre affidavit as a whole that the Mark was used in association with the Registrant's menswear during the Relevant Period.

[20] Mr. Lefebvre provides evidence of advertising for menswear sold in association with the Mark (Exhibits E, H, I). The advertising evidence is of little assistance to the Registrant's case as it is all dated after the Relevant Period. In any event, I note that use of the Mark in advertising is not in itself sufficient to constitute use in association with wares [see *BMW Canada Inc. v. Nissan Canada Inc.* (2007), 60 C.P.R. (4th) 181 (F.C.A.)].

[21] Following my analysis of the evidence, I am satisfied that the Registrant has evidenced use of the Mark in Canada within the meaning of s. 4(1) of the Act in association with "clothing for men, namely, coats, jackets, suits, pants, sweaters" during the Relevant Period. However, I find that there is no evidence of use of the Mark in association with "clothing for women and children", "skirts", "blouses", "underwear" and "footwear namely boots, sneakers, loafers, shoes, leger shoes, sandales and slippers" during the Relevant Period nor any evidence with respect to the date the Mark was last in use in association with these wares and the reasons for the absence of use.

[22] Pursuant to the authority delegated to me under s. 63(3) of the Act, Registration No. TMA455,196 will be amended by deleting "...women and children, ... skirts, blouses, ... underwear; footwear namely boots, sneakers, loafers, shoes, leger shoes, sandales and slippers" from the Registered Wares.

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office