



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

Citation: 2014 TMOB 80
Date of Decision: 2014-04-14

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Coastal Trademark Services against
registration No. TMA719,603 for the trade-mark
EDWARD CHAPMAN LADIES SHOPS in the name of
Edward Chapman Ladies' Shop Limited**

[1] At the request of Coastal Trademark Services (the Requesting Party), 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 19, 2012 to Edward Chapman Ladies' Shop Limited, (the Registrant), the registered owner of registration No. TMA719,603 for the trade-mark EDWARD CHAPMAN LADIES SHOPS (the Mark).

[2] The Mark is registered for use in association with the wares “women’s clothing, namely, suits, skirts, sweaters, t-shirts, blouses, jackets, dresses, slacks, coats, rain coats”.

[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 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 19, 2009 and April 19, 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] In response to the Registrar's notice, the Registrant furnished the affidavit of John Rea, President of the Registrant, sworn on June 28, 2012. Both parties filed written representations and attended an oral hearing.

[6] As a preliminary matter, the Requesting Party submits that Mr. Rea does not indicate how he has personal knowledge of the facts he attests to in his affidavit; therefore, the Requesting Party submits that the affidavit must be considered inadmissible.

[7] However, the Registrant notes that Mr. Rea identifies himself as the President of the Registrant and submits that affidavits are regularly provided by senior officials in section 45 proceedings [citing *Smart & Biggar v Jarawan* (2006), 52 CPR (4th) 26 (FCTD); and *A & A Jewellers Ltd v Messrs Malcolm Johnston & Associates* (2000), 8 CPR (4th) 56 (FCTD)].

[8] I agree with the Registrant that due to the responsibilities associated with Mr. Rea's position as President, it can reasonably be inferred that he would "have personal knowledge of the matters herein deposed" as he attests in paragraph 1 of his affidavit. This is consistent with the purpose and scope of section 45 of the Act, which is to provide a simple, summary and expeditious procedure for removing "deadwood" from the register [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

Evidence of Use of the Mark

[9] In his affidavit, Mr. Rea attests that the Registrant is a ladies clothing and accessories retail chain, which operated five locations throughout the Greater Vancouver area during the relevant period. In support of his assertion of use of the Mark in association with each of the registered wares during the relevant period, Mr. Rea provides the following exhibits:

- Exhibit B consists of copies of woven labels depicting the Mark. Mr. Rea attests that the Registrant sold women's clothing with the label until "as recently as Spring 2010".

Although Mr. Rea acknowledges he was unable to locate photographs of women's clothing with the label, he attests that "the sewn-in labels were applied to orders of sweaters, t-shirts, jackets, dresses, coats and blouses by the manufacturer of such items at my request" and that the "sewn-in labels were applied to the balance of the items in-house by [the Registrant's] staff at my direction".

- Exhibits C through H consist of photocopies of order forms from the Registrant to various clothing manufacturers dated during the relevant period. Mr. Rea attests that the order forms were used by the Registrant when ordering various types of women's clothing and that the order forms include handwritten notes requesting that the label shown in Exhibit B be sewn in as part of the manufacturing process. He confirms that the Registrant received the ordered clothing and further states when the particular ordered clothing items were sold in the Registrant's retail store, all falling generally within the early part of the relevant period in 2009 or early 2010.
- Exhibit I consists of photocopies of numerous "tickets" – *i.e.* price tags – that Mr. Rea attests were attached to various woman's clothing at the time of sale during the relevant period. I note that the Registrant's name and logo is displayed on one side of the ticket while the price, item description and bar code is displayed on the other side.
- Exhibit J consists of photocopies of 16 sales receipts that Mr. Rea attests are representative of the sales receipts issued by the Registrant to customers during the relevant period. Although the receipts cover all of the registered wares with the exception of "suits", they do not appear to be for the clothing items corresponding to the Exhibits C through H orders, as the receipts are all dated from 2011 or 2012.
- Exhibit K consists of 12 photographs showing clothes hangers displaying the Mark and various women's clothes on the hangers. Mr. Rea explains that during the relevant period, clothes in the Registrant's stores were displayed on such hangers.
- Exhibit L consists of photographs of a garment bag displaying the Mark. Mr. Rea attests that during the relevant period, lengthy items of clothing were placed into such garment bags and given to customers at the time of sale.

[10] With respect to the display of the Mark on the tickets/price tags, hangers, garment bags and at the top of the Registrant's sales receipts, I agree with the Requesting Party that, at best, such display constitutes display in association with services, not the registered wares.

[11] It is clear from the evidence that, with respect to some of the clothes sold in its stores, the Registrant was merely the retailer of certain clothing brands, such as GERRY WEBER. Placing such clothes on the Registrant's hangers or placing them in a garment bag displaying the Mark at the time of purchase does not amount to use of the Mark in association with the wares themselves [see, for example, *London Drugs Ltd v Brooks* (1997), 81 CPR (3d) 540 (TMOB); *Gowling, Strathy & Henderson v Karan Holdings Inc* (2001), 14 CPR (4th) 124 (TMOB)]. Similarly, merely attaching the store's price tags does not constitute use of the Mark pursuant to section 4(1) of the Act.

[12] However, I am satisfied that the Exhibit B labels – which Mr. Rea attests were woven into certain clothing items – in combination with Mr. Rea's statements that such labelled items were sold by the Registrant during the relevant period, constitutes evidence of use of the Mark in association with the Registrant's wares. By having the Mark woven into the clothing items directly, this constitutes display of the Mark on the wares themselves.

[13] As noted above, although Mr. Rea states that he was unable to locate photographs of clothing items with the label, he confirms that “the sewn-in labels were applied to orders of sweaters, t-shirts, jackets, dresses, coats and blouses by the manufacturer of such items at my request”. While the Registrant appears to have discontinued this private label practice at some point in 2010, the evidence shows use of the Mark in this manner earlier in the relevant period. I accept that the order forms at Exhibits C through H are corroborative of Mr. Rea's statements that the Registrant's private label depicting the Mark were sewn into certain clothing items during the manufacturing process or by in-house staff and sold in the normal course of trade by the Registrant during the relevant period.

[14] In particular, I am satisfied that the Registrant has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with all of the registered wares with the exception of “suits”.

[15] Although Mr. Rea asserts use of the Mark in association with “suits” at paragraph 4 of his affidavit and states at paragraph 5 that “[the Registrant’s] suits are sold in components of jackets and shirts or jackets and slacks”, the exhibits do not support such assertions. Mr. Rea does not clearly identify “suits” as having been labelled with the Exhibit B labels, nor does he provide evidence of sales of suits displaying the Mark, rather than just the component parts sold individually. While a “suit” is identified in Exhibit K photographs and appears to be sold as a unit, this appears to be a suit offered for sale by the Registrant later in the relevant period, and not sold in association with the Mark.

[16] Notwithstanding the Registrant’s assertion in its oral and written representations, in view of Mr. Rea’s own statements and the supporting exhibits, it would appear that, during the relevant period, the Registrant’s use of the Mark was limited to the following wares: “women’s clothing, namely, skirts, sweaters, t-shirts, blouses, jackets, dresses, slacks, coats, rain coats”.

[17] As for “suits”, the evidence is insufficient to establish use of the Mark within the meaning of sections 4 and 45 of the Act and the Registrant has furnished no evidence of special circumstances justifying non-use with respect to this ware.

Disposition

[18] In view the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete “suits” from the statement of wares.

[19] The amended statement of wares will be as follows: “Women’s clothing, namely, skirts, sweaters, t-shirts, blouses, jackets, dresses, slacks, coats, rain coats”.

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