



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

Citation: 2012 TMOB 237
Date of Decision: 2012-12-21

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Cane Springs, Inc. against registration
No. TMA502,880 for the trade-mark SECRET FIT in the
name of Manufacturier de Bas de Nylon Doris Ltee/Doris
Hosiery Mills Ltd.**

[1] At the request of Cane Springs, Inc. the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on July 30, 2010 to Manufacturier de Bas de Nylon Doris Ltee/Doris Hosiery Mills Ltd. (the Registrant), the registered owner of registration No. TMA502,880 for the trade-mark SECRET FIT (the Mark).

[2] The Mark is registered for use in association with the wares: “clothing, namely hosiery, socks, stockings, panty hose, kneehighs, tights, shoes, slippers, panties, underwear and active wear, namely exercise tights, leggings, leotards, sweat pants, sweat shirts, T-shirts, shorts, exercise tops”.

[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 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 July 30, 2007 and July 30, 2010 (the Relevant Period).

[4] The relevant definition of “use” with respect to wares is set out in section 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant filed the affidavit of Michael Poirier, President of the Registrant, sworn on February 23, 2011. Both parties filed written arguments but an oral hearing was not held.

[7] In his affidavit, Mr. Poirier admits that the Registrant did not use the Mark in association with the wares “socks, tights, shoes, slippers, panties, underwear and active wear, namely exercise tights, leggings, leotards, sweat pants, sweat shirts, T-shirts, shorts, exercise tops” in Canada during the Relevant Period. Furthermore, no special circumstances have been demonstrated that would excuse the absence of the use of the Mark in association with these wares. Accordingly, the wares “socks, tights, shoes, slippers, panties, underwear and active wear, namely exercise tights, leggings, leotards, sweat pants, sweat shirts, T-shirts, shorts, exercise tops” will be deleted from the registration.

[8] Mr. Poirier does state that the Registrant has used the Mark continuously since 2008 in association with panty hose, kneehighs and ankles highs, which he states are all articles of hosiery. Specifically, Mr. Poirier states that the Mark is used on labels affixed to the plastic envelope containing these hosiery products.

[9] In support of this statement, Mr. Poirier attaches, as Exhibits 1 to 5 of his affidavit, photographs of sample packaging for the Registrant's panty hose, kneehighs and ankle highs (defined as the SECRET FIT Products). I note that the Mark is featured on a sticker label that, in the samples provided, appears to generally be placed on the back of the packaging. Mr. Poirier attaches a sample of the label to his affidavit at Exhibit 6. I note that the SECRET FIT Products as shown in Exhibits 1 to 5 are also sold under the trade-marks SECRET and SECRET PLUS in such a way that the Mark is acting as a secondary trade-mark. This is not detrimental to the Registrant's position, however, as there is no restriction against displaying more than one trade-mark on wares [*Mantha & Associates v Old Time Stove Co* (1990), 30 CPR (3d) 574 (TMOB)].

[10] Mr. Poirier confirms that the use shown on the sample packaging is representative of how the Mark has been used in association with the SECRET FIT Products since 2008 and continuously to date. I am therefore satisfied that the evidence is representative of the manner in which the Mark was used in association with the SECRET FIT Products during the Relevant Period.

[11] With respect to the packaging, the Requesting Party submits that there is no reference on the packaging to the Registrant or to any licensee or distributor of the Registrant aside from one reference on one of the samples in Exhibit 2 and thus the evidence is insufficient to support use by the Registrant.

[12] Firstly, I agree with the Registrant that the Act does not require the name of the Registrant to appear in association with the Mark [see, for example, *Vogue Brassiere Inc v Sim & McBurney* (2000), 5 CPR (4th) 537 (FCTD) at para 36].

[13] Secondly, I note that even if there was a requirement to show the Registrant's name on the packaging, the Requesting Party itself has admitted that one of the sample packages attached to Mr. Poirier's affidavit does display the Registrant's name. Case law supports a finding that one sale may be sufficient to support a registration in any event [*JC Penney Co. v. Gaberdine Clothing Co* (2001), 16 CPR (4th) 151 (FCTD)].

[14] As evidence of sales, Mr. Poirier states that the Registrant has sold the SECRET FIT Products in Canada from 2008 continuously to the date of his affidavit to major retailers such as

Zellers, Walmart, London Drugs, Safeway, Rexall, Overwaitea, Metro and Lawton's Drugs as well as to independent drug stores (see para 13). In support of this statement, Mr. Poirier attaches to his affidavit sample invoices showing representative sales of the SECRET FIT Products to retailers across Canada from 2008 to July 2010 (Exhibit 7). As pointed out by the Requesting Party, the Mark is not present on the invoices. Rather, the invoices display other trade-marks, namely SECRET and SECRET PLUS. The absence of the Mark from the invoices is not detrimental, however, as Mr. Poirier clearly stated that the invoices relate to the SECRET FIT Products, which I have already accepted display the Mark.

[15] Mr. Poirier also provides sales figures for the SECRET FIT Products during the Relevant Period. Specifically, Mr. Poirier provides sales figures for SECRET and SECRET PLUS panty hose, SECRET and SECRET PLUS knee-highs and SECRET ankle-highs from 2008 to December 31, 2010 all of which I am satisfied were sold in association with the Mark. While some of these sales were outside the material date, I am satisfied that the Registrant has established significant sales of the SECRET FIT Products in the Relevant Period.

[16] The Requesting Party also submits that Mr. Poirier failed to clearly state that the materials attached to his affidavit and the sales figures included in his affidavit relate specifically to Canada. When the evidence is considered as a whole I have no reason to doubt that the evidence relates to Canada and thus I refuse to accept the Requesting Party's submissions on this point.

[17] In view of the foregoing, the evidence is clear that the Registrant has used the Mark in the normal course of trade in Canada in association with "hosiery, panty hose, knee-highs" during the Relevant Period and thus the registration for the Mark is maintained for these wares.

[18] The evidence is less clear, however, with respect to "stockings", as there is no clear statement regarding stockings in Mr. Poirier's affidavit. The Requesting Party submits that in the absence of a clear reference to them, the Registrant has failed to evidence use with respect to stockings. Since stockings are listed as a distinct item, separate and apart from panty hose and knee-highs, the Requesting Party submits that it should be deleted from the registration. I am not persuaded by this submission as I note that the evidence does make reference to sales of ankle-highs in association with the Mark in the normal course of trade during the Relevant Period. For

the reasons that follow, I am satisfied that the evidence of use of the Mark in association with ankle highs can support a finding of use with respect to “stockings”.

[19] Jurisprudence indicates that it is improper to engage in an overly meticulous analysis of the specification of wares for the purposes of section 45 [see, for example, *Loro Piana SPA v Canadian Council of Professional Engineers (CCPE)*, 2009 FC 1096]. Furthermore, I note that the Registrar is permitted to reference dictionary definitions in analyzing the nature of the wares included in a specification [see, for example, *Fasken Martineau DuMoulin LLP v In-N-Out Burgers* (2007), 61 CPR (4th) 183 (TMOB); *Ogilvy Renault v Compania Roca-Radiadores SA* (2008) CarswellNat776 (TMOB)].

[20] In the present case, I have looked into the *Canadian Oxford Dictionary* and note that the definition for stockings includes the following: “either of a pair of separate, close-fitting knitted or woven coverings for the feet and part or all of the leg worn by women or girls”. When analyzing the evidence I must take into account the purpose and scope of section 45 which is to provide a simple, summary and expeditious procedure for removing “deadwood” from the Register [*Performance Apparel Corp v Uvex Toko Canada Ltd* (2004), 31 CPR (4th) 270 (FC)]. Taking into account the foregoing, I am satisfied that, for the purposes of this proceeding, ankle highs can be classified as stockings. As a result, I am satisfied that the Registrant has also demonstrated use of the Mark in association with “stockings” in the normal course of trade during the Relevant Period. The registration for the Mark is thus also maintained for “stockings”.

Disposition

[21] In view of the foregoing, 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 wares “socks, tights, shoes, slippers, panties, underwear and active wear, namely exercise tights, leggings, leotards, sweat pants, sweat shirts, T-shirts, shorts, exercise tops”.

[22] The amended statement of wares will read as follows:

Clothing, namely hosiery, stockings, panty hose, kneehighs.

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