

SECTION 45 PROCEEDINGS
TRADE-MARK: HERCULES & DESIGN
REGISTRATION NO.: 306,969

On March 6, 2000, at the request of Permanent Developments Inc., the Registrar forwarded a Section 45 notice to Gants Laurentide Ltée, the registered owner of the above-referenced trade-mark registration.

The trade-mark HERCULES & Design (shown below) is registered for use in association with the following wares:

Gants, mitaines, chapeaux, casquettes, vestons, gilets et vêtements imperméables, nommément: vestes, salopettes, manteaux, capuchons, chapeaux et casquettes.



Section 45 of the Trade-marks 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 listed on 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 use since that date.

In response to the notice, the affidavit of Joan Monk with exhibits has been furnished. Each party filed a written argument. An oral hearing has not been requested in this case.

In her affidavit, Ms. Monk indicates that the registrant is an importer and manufacturer producing all types of work-related clothing such as protective gloves and mittens as well as various outerwear items. She states that the items that have been manufactured in and/or imported to Canada during the past three years, and indeed since May 29, 1985 in association with the trade-mark are “gloves, mittens, hats, caps, jackets, waistcoats, and waterproof clothing, namely vests, overalls, coats, hoods, hats and caps”. She specifies that the trade-mark is visible on packaging and labels for the wares and she provides photographs showing the trade-mark on some of the above-noted items. She provides the style numbers for the items shown on the photographs and submits that the style numbers correspond with the registrant’s catalogue entitled “Protective Waterproof Clothing Industrial Safety Clothing Safety Gloves and Mitts (3rd edition)” also attached to the affidavit. She also provides a coverall enclosed in a plastic packaging and a pair of gloves.

At paragraph 7 of her affidavit, she explains that in the normal course of trade, the registrant’s sales force or commissioned sales staff visit the retail outlets and/or industrial purchasing agents with the registrant’s catalogues and the buyers for the retail store or company or distributor then place their order for the styles of work-related clothing that they wish to purchase. In 1997, the annual sales by the registrant of the above-mentioned work-related clothing items under the trade-mark totalled \$1,232,664; in 1998, the annual sales totalled \$1,233,179; and in 1999, the

annual sales totalled \$939,188. Five invoices have been submitted evidencing sales of some items bearing the trade-mark.

The requesting party has raised several arguments concerning the evidence furnished.

The requesting party questions the admissibility of the affidavit evidence as the affidavit was sworn May 31, 2000 while the exhibits refer to an affidavit sworn June 1, 2000. However, the registrant has explained the discrepancy to my satisfaction. It submits that it had the affidavit notarized a second time as a result of the notary not being in possession of the original exhibits the first time, but only photocopies. It seems that in sending back the affidavit and exhibits to the registrant's agent for filing, the registrant simply mixed up the affidavits and sent the earlier affidavit instead of the later executed affidavit. Based on the above explanation and as the exhibits in question are clearly identified in the affidavit, I conclude that the affidavit together with the exhibits is admissible and I am prepared to give it proper weight.

Concerning the use shown by the evidence, I am satisfied that sufficient facts have been provided to permit me to conclude that the trade-mark was in use in Canada during the relevant period in association with each of the registered wares.

In paragraph 3 of the affidavit, it is clearly stated that the registrant is an importer and manufacturer producing all types of work-related clothing and that the items that have been manufactured in and/or imported to Canada during the relevant period and since May 29, 1985 in

association with the trade-mark are “gloves, mittens, hats, caps, jackets, waistcoats, and waterproof clothing, namely, vests, overalls, coats, hoods, hats and caps”. Ms. Monk has explained the manner the trade-mark was associated with the wares at the time of transfer, i.e. the trade-mark appeared on packaging, labels and tags for the wares, and she has provided examples of such use. She also has provided annual sales figures (approximately a million for each year) with respect to the work-related clothing items in question. In my view, the statements in the affidavit are statements of fact which show use of the trade-mark during the relevant period in association with each of the registered wares (see *Mantha & Associates v. Central Transport Inc.*, 64 C.P.R. (3d) 354). Concerning the requesting party’s objection that invoices have not been provided for each of the registered wares, as stated in *Lewis Thompson & Sons Ltd. v. Rogers, Bereskin & Parr*, 21 C.P.R. (3d) 483, invoices are not required in a Section 45 proceeding. As for the fact that a sample of each of the wares sold has not been provided, as stated in *Union Electric Supply Co. Ltd. v. RTM*, 63 C.P.R. (2d) 179 (No. 2), evidentiary overkill is not required. What the registrant was required to do was provide sufficient facts or evidence from which a conclusion of use could be inferred. This, in my view, the registrant has done.

The fact that the style numbers of the items of clothing provided in evidence do not match the styles in the catalogue furnished, is not fatal. The items in question clearly bear the trade-mark, and the invoices show that such items were sold during the relevant period. Further, based on the statements made in paragraph 7 of the affidavit, I am prepared to infer that the catalogue provided as Exhibit C is not the only catalogue in existence.

In my view, when the affidavit is given a fair reading and when the evidence is considered as a whole, I find it is sufficient to permit me to conclude that the trade-mark was in use in Canada in association with the registered wares during the relevant period. Further, I am satisfied that the use was in compliance with Section 4(1) and Section 45 of the Trade-marks Act. I have arrived at this conclusion bearing in mind the purpose of Section 45.

Registration No. 306,969 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 30th DAY OF JANUARY 2003.

D Savard
Senior Hearing Officer
Section 45 Division