



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

Citation: 2011 TMOB 12
Date of Decision: 2011-01-18

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by CMRG Apparel LLC against registration
No. TMA382,319 for the trade-mark CASUAL MAN &
Design in the name of Grafton-Fraser Inc.**

[1] At the request of CMRG Apparel LLC (the requesting party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on November 13, 2008 to Grafton-Fraser Inc. (the registrant), the registered owner of the above referenced trade-mark.

[2] The trade-mark CASUAL MAN & Design (the Mark), depicted below, is registered for use in association with “Men's dress shirts, sport shirts, knitted shirts, t-shirts, pullover sweaters, cardigan sweaters, dress pants, casual pants, jeans, outing shorts, athletic shirts, athletic shorts, sweat tops, sweat pants, spring jackets, warm up jackets, light weight shells, leather jackets, winter jackets, ski jackets, parkas, snowmobile suits, jogging suits, pyjamas, dressing gowns, swimwear and hosiery.”



[3] Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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 this case the relevant period for showing use is any time between November 13, 2005 and November 13, 2008.

[4] 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 evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] 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.

[5] Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares/services specified in the registration during the relevant period.

[6] Use in association with wares is set out in subsection 4(1) of the *Trade-marks Act*:

4. (1) A trade-mark is deemed to have been 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.

[7] In response to the Registrar's notice, the registrant furnished the affidavit of Norman Cooper. Both parties filed written submissions and were represented at an oral hearing.

[8] Mr. Cooper states that he is the President of the registrant; he has been employed by the registrant since November 1985 and has been serving in his present capacity since July 2006. Mr. Cooper has held various positions with the registrant including store manager, buyer, vice president and Merchandise Manager for various chains of retail stores (such as Mr. Big & Tall, Tip top Tailors, Grafton & Co.), all owned by the registrant. I am prepared to infer from the history provided of the acquisitions that these are companies owned by the registrant. Mr. Cooper has access to all the books and records of his company and has consulted same for the purpose of his affidavit.

[9] The affiant states that the registrant "sells clothing" bearing the Mark "through" its Mr. Big & Tall men's clothing stores; a list of Mr. Big & Tall stores across Canada is attached as Exhibit B. Mr. Cooper further provides that his company "affixes labels" bearing the Mark on the products listed in the registration. In support, he attaches photographs of a variety of T-shirts, a close up of a single T-shirt, and a sport shirt as Exhibits C-1, C-2 and C-3 respectively; all are affixed with neck labels bearing the Mark.

[10] The requesting party argued that the affiant merely states that his company (the registrant) sells the wares "through" its Big & Tall stores, without specifying who manufactures the wares or the details of the business relationship between the registrant and the Mr. Big & Tall retail stores. The registrant responded that it was clear that it is the registrant who affixes the trade-mark to the wares since the Mr. Big & Tall stores are retail establishments merely selling the registrant's wares. I agree with the registrant, this is not a case where evidence of a license agreement pursuant to the provisions of s.50 of the Act is required.

[11] The affiant further provides three representative sample sales receipts for a variety of T-shirts bearing the Mark, all dated in October of 2008. Mr. Cooper provides a list of product codes corresponding to the codes used to identify the T-shirts in the invoices. The requesting party objected to this evidence on the basis that there was no clear statement that these items were sold in Canada. However, taking into consideration the list of stores in Canada provided as Exhibit B, the history of Mr. Big & Tall as a Canadian company (having started in Western Canada in about

1977) I am prepared to infer when reading the affidavit as a whole that the sales referred to in the affidavit took place in stores in Canada.

[12] The requesting party made much of the fact that the affidavit is in the present tense, and in particular that the paragraphs describing the manner of marking the wares are in the present tense and do not specify that such practices were in place during the relevant period. I note that Mr. Cooper does, however, provide the general statement that the registrant first used the Mark in association with a variety of men's clothing since at least as early as February 1991 and continues to use the Mark in Canada to the present time. Furthermore, the affidavit when read as a whole, considering the evidence of sales of T-shirts (bearing the Mark) during the relevant period, supports the fact that the statements are to be read as encompassing past activities. Based on the affidavit as a whole, I find that there is evidence of sales of T-shirts during the relevant period that were marked with the Mark in the same way as they as those shown in Exhibits C-1, C-2, and C-3.

[13] With respect to the nature of the wares for which use is shown, I observe that Mr. Cooper refers to the wares as "men's clothing" or "T-shirts" throughout the affidavit; I note that one polo sport shirt is also referred to and shown bearing the Mark in Exhibit C-3. Nowhere is there a clear statement that the Mark was used on *each* of the wares listed in the registration. Other than the specific reference to T-shirts and the sport shirt, the wares are referred to simply as "the clothing" or "a variety of men's clothing". I agree with the requesting party, it would have been a simple matter to state that the Mark had been affixed to each of the wares in the registration and sold in that manner.

[14] Mr. Cooper provides examples of in-store advertising and website advertising and states that a Christmas catalogue for 2008 was mailed directly to 44,746 Canadian households across all provinces of Canada. A copy of the catalogue is attached as Exhibit E. I note that the catalogue does not contain any images of wares marked with the Mark, although the Mark does appear on the back page as one of the brands shown to be sold by Mr. Big & Tall. The requesting party objected to this evidence stating that it wasn't clear that these catalogues were actually distributed during the relevant period. In this regard the registrant argued that the catalogue includes a coupon that expires November 30, 2008, and invited the inference that said catalogues

must therefore have been distributed by the middle of November at the latest. In any event, the catalogue is irrelevant, as there is no indication that it was used for the purpose of ordering wares. It is trite law that evidence of advertising of wares is not evidence of use within the meaning of s. 4(1) of the Act. Similarly, in the absence of evidence of sales of wares through the website, website advertising is irrelevant to the issue of use under s. 4(1). Furthermore, with respect to the website, I note that it was not established until just after the relevant date.

[15] The affiant also provides a photograph of a sign bearing the Mark shown hanging in a section of a retail store (Exhibit D). While in-store advertising in the nature of point of sale material is sometimes considered evidence of association of a trade-mark with the wares at the time of transfer (depending on factors such as its proximity to the wares), in this case the photograph is insufficient. No indication is given that the sign existed during the relevant period and no information is provided as to which items of clothing shown in the photo are considered to be part of this section of the store. Nor is it even apparent from the photograph what all the items of clothing (some hanging and some on shelves) are, and whether this section includes diverse items such as ski parkas, swimwear or hosiery, for example. Unfortunately, in describing the wares in this section of the store, the affiant refers only to “men’s clothing”.

[16] The registrant submitted that the advertising material should be considered since it supports the other evidence of sales of men’s clothing; however, the only evidence of sales is of T-shirts and possibly sport shirts. There is no evidence of sales of any other wares, nor even any clear statement by the affiant to which such advertising material could lend its support. Thus, in my view the principle that use of a trade-mark in relation to wares cannot be shown by mere advertising or distribution of promotional materials applies [*Gowling & Henderson v. John Morton Ltd* (1992) 47 C.P.R. (3d) 268 at 270].

[17] The evidence is insufficient to demonstrate use on any of the wares other than T-shirts and sport shirts. Further, in the absence of evidence amounting to special circumstances excusing such absence of use, I find that use has not been shown within the meaning of s.45 on any wares other than “T-shirts” and “sport shirts”.

[18] In view of all of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete all wares except for “T-shirts” and “sport shirts” in compliance with the provisions of s. 45(5) of the Act.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office