



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

**Citation: 2010 TMOB 74**  
**Date of Decision: 2010-05-18**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Clandestine Industries, Inc. against  
registration No. TMA568,657 for the trade-mark  
CLANDESTINE in the name of Clandestine Industries,  
Inc.**

[1] At the request of Clandestine Industries, Inc. (the requesting party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on June 19, 2008 to Kovac Manufacturing Inc. (the registrant), the registered owner of the above-referenced trade-mark at that time. The requesting party was recorded as the new owner of the registration on July 2, 2009, following an assignment of April 21, 2009.

[2] The trade-mark CLANDESTINE (the Mark) is registered for use in association with “women's clothing, namely skirts, pants, tops, blazers, dresses, blouses and shorts”.

[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 19, 2005 and June 19, 2008 (the relevant period).

[4] “Use” in association with wares is set out in sections 4(1) and 4(3) 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, section 4(1) applies.

[5] In response to the Registrar's notice, the registrant furnished the affidavit of John Kovac sworn on September 5, 2008 together with Exhibits "JK-1" through "JK-4". Mr. Kovac states that he is the vice-president of sales of the registrant. Only the registrant filed written submissions; an oral hearing was not requested.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in these 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 or services specified in the registration during the relevant period.

[7] With respect to the manner in which the trade-mark is associated with the wares, Mr. Kovac provides a specimen label bearing the Mark as Exhibit "JK-2", representative of the ones affixed to the clothing items sold during the relevant period. I note that the specimen label consists of a piece of fabric on which appears the Mark together with a design element, as well as the words "MADE IN/FABRIQUÉ AU CANADA". Despite the additional wording and design element, I am of the view that the Mark retains its identity and remains recognizable in this case.

[8] Mr. Kovac further submits a series of photographs of women's clothing bearing the said label as Exhibit "JK-1", representative of those sold in Canada during the relevant period. The affiant identifies the items shown in the photographs as a "sleeveless blouse", a "jacket", a "dress", a "top", a pair of "shorts", a "skirt", and a pair of "pants". I note that the said label can be seen sewn onto all the clothing articles in the exhibits. In view of the evidence, I am satisfied that the Mark was affixed to the registered wares at the time of sale during the relevant period.

[9] In terms of the registrant's normal course of trade, Mr. Kovac indicates that the registrant manufactures and sells different women's clothing lines to Canadian consumers. As evidence of sales during the relevant period, Mr. Kovac attaches copies of invoices issued by the registrant between March 2007 and April 2008 with respect to each of the registered wares as Exhibit "JK-3"; the affiant also identifies the specific pieces of clothing that correspond to the style numbers documented in the invoices in paragraph 7 of his affidavit. I note the registrant's name appears on the top left corner of the invoices, while the Canadian billing and shipping addresses of the customers can be seen right below. Based on the names and the addresses of the customers identified on the invoices, it would appear that the items are sold to retailers across Canada. Having regard to the evidence as a whole, I am satisfied that the registrant has shown sale of each of the registered wares bearing the Mark in the normal course of trade in Canada during the relevant period.

[10] In view of the foregoing, I am satisfied that there was use of the Mark within the meaning of sections 45 and 4(1) of the Act on "women's clothing, namely skirts, pants, tops, blazers, dresses, blouses and shorts". Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, registration TMA568,657 for the trade-mark CLANDESTINE will be maintained in compliance with the provisions of section 45 of the Act.

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P. Fung  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office