



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

Citation: 2011 TMOB 131
Date of Decision: 2011-07-21

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by De Grandpré Chait LLP against registration
No. TMA174,578 for the trade-mark UTOPIA.**

[1] On January 24, 2008, at the request of De Grandpré Chait LLP (the Requesting Party), the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act) to Galey & Lord Industries, Inc., (the Registrant), the registered owner of registration No. TMA174,578 for the trade-mark UTOPIA (the Mark). The Mark is registered in association with “textile fabrics” (the Wares).

[2] Section 45 of the *Trade-marks Act* requires the registered owner of a trade-mark to show, with respect to each of the wares and/or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three year period 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 January 24, 2005 and January 24, 2008 (the Relevant Period).

[3] The applicable definition of “use” in association with wares, in the present case, is set out in subsection 4(1) of the Act as follows:

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.

[4] The threshold for establishing use in a s. 45 proceeding is quite low (*Cinnabon, Inc. v. Yoo-Hoo of Florida Corp.* (1998), 82 C.P.R. (3d) 513 (F.C.A.)), however, sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the registered wares during the relevant period. A bare statement of use is not sufficient [See *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)].

[5] In response to the s. 45 notice, the Registrant filed the affidavit of Dennis Gilrain, the Managing Director, Sportswear, of Galey & Lord, LLC. He indicates that he has also been the Managing Director, Sportswear, of Galey & Lord, LLC's predecessor Galey & Lord Industries, LLC. Mr. Gilrain attests that Galey & Lord, LLC is the current owner of the trade-mark UTOPIA in Canada; he provides that:

- On October 21, 1988, Galey & Lord, Inc. acquired the rights in the Mark.
- On April 30, 1992, Galey & Lord, Inc. changed its name to Galey & Lord Industries, Inc.
- On November 9, 2004, Galey & Lord Industries, Inc. assigned all rights in the Mark to Galey & Lord Industries, LLC, an affiliate company.
- On July 16, 2008, Galey & Lord Industries, LLC assigned all rights in the Mark to Galey & Lord, LLC, an affiliate company.

[4] Attached as Exhibit "A" to Mr. Gilrain's affidavit is an unsigned and undated confirmatory assignment document which he attests is a draft of a document, to be effective from November 9, 2004, concerning an assignment of the Mark from Galey & Lord Industries, Inc. to Galey & Lord Industries, LLC. Also attached under Exhibit "A" is an executed copy of a second, subsequent assignment document which is dated July 16, 2008 and concerns an assignment from Galey & Lord Industries, LLC to Galey & Lord, LLC. Mr. Gilrain attests that executed copies

of both of these assignments are being filed under separate cover with the Trade-marks Office. I note that the Registrar of Trade-marks (the Registrar) received both assignment documents on July 23, 2008 and recorded each of the documents on September 5, 2008.

[5] The confirmatory assignment document recorded by the Registrar, in which the Mark was assigned from Galey & Lord Industries, Inc. to Galey & Lord Industries, LLC, is dated July 21, 2008, and was signed by S. Gregory Hays, Chapter 7 Trustee for Galey & Lord Industries, Inc. It is entitled “Confirmatory Nunc Pro Tunc Assignment”, and the language in the document is confirmatory rather than retroactive in nature. Mr. Gilrain’s assertion, at paragraph 3 of his affidavit that the assignment was effective as of November 9, 2004, together with the Registrar’s subsequent receipt and recordal of the aforesaid assignment document leads me to conclude that the assignment at issue is a *nunc pro tunc* assignment. A confirmatory assignment document signed and filed after its effective date, and after the issuance of a Section 45 Notice, has been considered acceptable by the Registrar, if the assignment is determined to be *nunc pro tunc* and not retroactive in effect. Accordingly, I conclude that effective November 9, 2004, the Mark was assigned from Galey & Lord Industries, Inc. to Galey & Lord Industries, LLC [see *Star-Kist Foods Inc v Canada (Registrar of Trade Marks)* (1988), 20 CPR (3d) 46 at 49 (FCA)] and as of July 16, 2008, the Mark was assigned from Galey & Lord Industries, LLC to Galey & Lord LLC.

[6] Therefore, as the registered owner of the Mark during the Relevant Period was Galey & Lord Industries, LLC, I must find whether there has been use of the Mark in Canada by Galey & Lord Industries, LLC during the Relevant Period. Mr. Gilrain attests that during the Relevant Period his company (defined in his affidavit as including Galey & Lord, LLC, and Galey & Lord Industries, LLC) sold fabrics bearing the trade-mark UTOPIA to customers in Canada.

[7] Marked as Exhibit “B” to the Gilrain Affidavit is “an image of a sample of fabric as given to customers as part of marketing and sales, including in Canada”. Affixed to the sample is a label, which bears “the style # and trade-mark, in this case ‘UTOPIA’.” I note the Mark is

clearly visible on the label. Mr. Gilrain states that “[t]hese labels would have been applied to the fabrics sold in Canada during the relevant time period for the Section 45 Notice.”

[8] As evidence of such sales, Mr. Gilrain attaches as Exhibit “C” to his affidavit, sample invoices for the years 2006 and 2007 showing sales of fabrics to Canadian customers. I note the invoices bear reference to the Mark under the column entitled “style description and number”. Upon further inspection of the invoices, I note that “Galey & Lord Industries, Inc.” appears at the top of the invoices. However, the invoices also provide that: “Galey & Lord Ind., LLC certifies this fabric is of U.S. origin” and that all payments are “Payable at par in bankable U.S. funds to Galey & Lord Industries, LLC. Mr. Gilrain attests that the reason as to why the registrant’s predecessor-in-title appears at the top of the invoices is merely because old stock invoices were being used. He further indicates that these invoices would have traveled with the shipment of the fabric, or otherwise would have been forwarded to the customer separately shortly after the shipment of the fabric. Lastly, Mr. Gilrain also provides evidence of sales figures for 2005, 2006 and 2007 of UTOPIA brand fabrics for three Canadian customers. He indicates that the figures represent “a small portion” of North American sales for the UTOPIA brand fabrics, but are “representative of sales in the normal course of trade” in Canada.

[9] In view of the foregoing, I am satisfied that the evidence demonstrates use of the Mark within the meaning of s. 4 of the Act during the relevant period by Galey & Lord Industries, LLC. The evidence clearly shows that sales of the registered wares bearing the Mark were made by Galey & Lord Industries, LLC, during the Relevant Period.

[10] For the foregoing reasons, pursuant to my delegation under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

Kathryn Barnett
Hearing Officer

Trade-marks Opposition Board
Canadian Intellectual Property Office

