

SECTION 45 PROCEEDINGS
TRADE-MARK: GOSSIP GIRLS
REGISTRATION NO.: TMA566,705

[1] At the request of Bereskin & Parr (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 July 6, 2007 to Almo-Dante Mfg. (Canada) Ltd./Manufacturiers Almo-Dante (Canada) Ltd., the registered owner of the above-referenced trade-mark (the “registrant”). I note that the registrant refers to itself as Almo-Dante Mfg. (Canada) Ltd./Manufacturiers Almo-Dante (Canada) Ltée throughout the proceedings; despite the minor discrepancy between the two names, it would appear to be the same entity.

[2] The trade-mark GOSSIP GIRLS is registered for use in association with the following wares:

Wearing apparel for women, men and children, namely, jumpsuits, suits, jackets, pants, t-shirts, scarves, sweatshirts, hoods, midriff tops, tube tops, vests, shorts, pullovers, tights, tank shirts, tie-up tops, swim trunks, swim tops, robes, shirts, blouses, jeans, hats, tuques, caps, back-packs, bags namely all purpose sport bags, beach bags, travelling bags, shoulder bags, school bags, clutch bags and garment travel bags, shoes, boots and sandals.

[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 and/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 July 6, 2004 and July 6, 2007.

[4] “Use” in association with wares is set out in subsections 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, subsection 4(1) of the Act applies.

[5] In response to the Registrar's notice, the registrant furnished the affidavit of Irwin Tauben, sworn on September 24, 2007, together with Exhibits 1 through 16. Both parties filed written submissions; an oral hearing was not requested.

[6] Mr. Tauben states that he is the Secretary-Treasurer of Almo-Dante Mfg. (Canada) Ltd./Manufacturiers Almo-Dante (Canada) Ltée; for more than twenty years, he has been actively involved in the day-to-day operations of the company. As such, he has personal knowledge of the matters set out in the affidavit.

[7] At the outset of the decision, I would like to draw attention to paragraph 20 of Mr. Tauben's affidavit, which states that the subject trade-mark has not been used by the registrant during the relevant period in association with "hats, tuques, caps, back-packs, all purpose sports bags, beach bags, travelling bags, shoulder bags, school bags, clutch bags, garment travel bags, shoes, boots and sandals". As special circumstances have not been advanced to excuse such non-use, these wares will be deleted from the registration.

[8] Thus, the remaining wares under consideration are:

Wearing apparel for women, men and children, namely, jumpsuits, suits, jackets, pants, t-shirts, scarves, sweatshirts, hoods, midriff tops, tube tops, vests, shorts, pullovers, tights, tank shirts, tie-up tops, swim trunks, swim tops, robes, shirts, blouses, jeans.

[9] 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/services specified in the registration during the relevant period.

[10] With respect to the manner in which the trade-mark was associated with the wares in question, Mr. Tauben provides that “each and every garment sold in Canada by Almodante [the registrant] in association with its GOSSIP GIRLS trade-mark had attached thereto a label on which GOSSIP GIRLS was inscribed [...] or else had GOSSIP GIRLS inscribed on the garment itself [...] and/or had GOSSIP GIRLS hang-tags affixed to the garments”.

[11] In support, Mr. Tauben submits several photographs of clothing items, representative of those sold during the relevant period in Exhibits 2 to 7. The subject trade-mark can be seen either inscribed on a label attached to the garment or imprinted on the inside of the garment itself, sometimes accompanied by a design. The items shown are described as “velour hooded jacket”, “pullover”, “tube tops”, “tops”, “pullover sweaters” (one can be seen with a hood), and “long sleeve knitted jump-suits”. Having considered the photographs together with the affiant’s statement, I am prepared to accept that the subject trade-mark was marked on all the garments sold by the registrant during the relevant period in the manners described and shown in the evidence.

[12] Additional information pertaining to the specific types of garment sold by the registrant in association with the subject trade-mark can be found in paragraphs 10 to 18 of Mr. Tauben’s affidavit and Exhibits 8 to 15. In particular, Mr. Tauben provides a series of randomly selected purchase orders evidencing clothing items imported by the registrant, which in turn were sold to retailers in Canada during the relevant period. The affiant explains that all these items had “GOSSIP GIRLS labels affixed thereto”, consistent with references made to the subject trade-mark in the “Main Label” field of the

attached purchase orders, notwithstanding typographical errors found in several of the documents. In these exhibits, the clothing items are described as “ladies knit tank top with lace”, “ladies knit v-neck hood sweater”, “ladies v-neck sweater”, “ladies knit L/S hoody jacket”, “ladies knit pull on pant”, “ladies knitted top”, “ladies knit S/S top w/print”, “ladies top jersey preshkn”, “ladies L/SLV v-neck”, “ladies L/SLV print”, and “ladies interlock top”.

[13] Having regard to the various patterns, inscriptions, the overall appearances of the items shown in the photographs (i.e. white star with red heart patterns, the words WITH LOVE on a label), as well as the reference to ladies’ clothing in all the purchase orders submitted, it would appear that the evidence pertains exclusively to ladies’ wear. Furthermore, bearing in mind the principle that “one is not to be astutely meticulous when dealing with language used in a statement of wares” [*Levi Strauss & Co. v. Canada (Registrar of Trade-marks)* (2006), 51 C.P.R. (4th) 434 (F.C.T.D.)], I am prepared to accept the evidence provided in relation to “ladies knit s/s top w/print”, “ladies v-neck sweater”, “ladies knit tank top with lace”, “ladies knitted top” and “ladies top jersey preshkn” as consistent with showing use in association with “t-shirts”, “sweatshirts”, “tank shirts” and “shirts”. Consequently, I am satisfied that the subject trade-mark was marked on “wearing apparel for women, namely, jumpsuits, jackets, pants, t-shirts, sweatshirts, hoods, tube tops, pullovers, tank shirts, shirts”.

[14] With respect to the normal course of trade during the relevant period, Mr. Tauben provides that the registrant “is in the business of manufacturing and importing wares and then offering for sale, selling and distributing such wares to retailers throughout Canada”. In particular, Mr. Tauben explains that many of the clothing items sold by the registrant in Canada during the relevant period were manufactured for it in China (as seen in the series of randomly selected purchase orders issued to third party suppliers as mentioned above), and later on sold to retailers in Canada (as seen in the randomly selected invoices issued by the registrant to retailers in Canada around the time of the relevant period). It is noted that many of the descriptions and the style numbers of the clothing items found in

the purchase orders correspond to the descriptions found in the sales invoices, providing a view of the chain of transactions regarding these garments.

[15] The requesting party argues that the evidence does not show use of the trade-mark by the registrant, that it “merely shows that goods bearing the mark were purchased by a company with the trade name THREDS APPAREL INTERNATIONAL” and “there is no clear evidence of sales to consumers by the registrant”. In paragraph 4 of his affidavit, Mr. Tauben explains that the registrant has used the trade-mark THREDS APPAREL INTERNATIONAL in association with import, manufacture and wholesale of clothing, accessories and footwear since at least 1997. In support, a copy of the corresponding trade-mark registration is attached as Exhibit 1. Thus, it would appear that THREDS APPAREL INTERNATIONAL is used both as a trade name by the registrant to identify its import, manufacture and wholesale business as well as a trade-mark for the related services. Seeing as nothing prevents the use of a trade name and/or of a distinct trade-mark to identify its services, I accept that the registrant has sold at least some of the registered wares during the relevant period in Canada, as evidence by the sales invoices produced by Mr. Tauben.

[16] In reference to Exhibits 11 and 12, the requesting party argues that these purchase orders dated July 5, 2007 should be disregarded since the shipments are only scheduled to be delivered to the registrant in September 2007, after the relevant period. When the evidence is viewed in its entirety, it is clear that the registrant imported and sold a large variety and quantity of women’s clothing items during the relevant period. Some were sold once the inventory was at hand; others were sold prior to the delivery of the shipments. While I recognise that the physical transfer of the clothing items in question, namely “ladies knit L/S hoody jacket” and “ladies knit pull on pant”, occurred after the relevant period, it is clear that the sales transaction between the registrant and the retailers with respect to these garments took place during the relevant period. In his affidavit, Mr. Tauben indicates that these garments have been “presold by Almo-Dante to retailers in Canada” during the relevant period. In *ConAgra Foods, Inc. v. Fetherstonhaugh & Co.* (2002), 23 C.P.R. (4th) 49 (F.C.T.D.), the Federal Court has determined that the

acceptance of an order before the date of the s. 45 notice coupled with the delivery of the wares thereafter constitutes use. Thus, I am satisfied that the wares in question were sold to retailers in Canada during the relevant period.

[17] Similarly, the purchase orders produced as Exhibit 15 are dated prior to the relevant period, but when read in conjunction with the invoice issued by the registrant on July 20, 2004 (attached as Exhibit 16), I am satisfied that the “ladies top jersey preshnk”, “ladies L/S v-neck”, “ladies L/SLV print” and the “ladies interlock top” bearing the trade-mark were sold to retailers in Canada during the relevant period.

[18] Finally, in view of Mr. Tauben’s clear statements that the registrant has sold the wares shown in the accompanying exhibits, I am satisfied that the randomly selected purchase orders and invoices attached as Exhibits 8 to 16 are merely representative of the registrant’s sales of the clothing items bearing the subject trade-mark in the normal course of trade during the relevant period, and not the only items that were sold over the course of the three-year period.

[19] Hence, the registrant has established use of the trade-mark in association with “wearing apparel for women, namely, jumpsuits, jackets, pants, t-shirts, sweatshirts, hoods, tube tops, pullovers, tank shirts, shirts”. As for men’s or children’s wearing apparel, the requesting party argues, and correctly so, that the registrant did not provide any evidence of use regarding those items. Additionally, I find no reference to the remaining women’s apparel specified in the registration. Mr. Tauben states that “Almo-Dante has no intention to cease using its said trade-mark in Canada in association with the wares for which [it] is registered”; nevertheless, in order to establish special circumstances, the registrant must provide the date when the trade-mark was last in use and the reason for the absence of such use since that date. Since special circumstances have not been advanced to excuse such non-use, the remaining wares will be deleted from the registration.

[20] In view of the foregoing, I am satisfied that there was use of the subject trade-mark within the meaning of section 45 and subsection 4(1) of the Act on the following wares: “wearing apparel for women, namely, jumpsuits, jackets, pants, t-shirts, sweatshirts, hoods, tube tops, pullovers, tank shirts, shirts”. Accordingly, and pursuant to the authority delegated to me under subsection 63(3) of the Act, registration TMA566,705 for the trade-mark GOSSIP GIRLS will be amended to delete:

wearing apparel for [...] men and children, [...], suits, [...], scarves, [...], midriff tops, [...], vests, shorts, [...], tights, [...], tie-up tops, swim trunks, swim tops, robes, [...], blouses, jeans, hats, tuques, caps, back-packs, bags namely all purpose sport bags, beach bags, travelling bags, shoulder bags, school bags, clutch bags and garment travel bags, shoes, boots and sandals.

in compliance with the provisions of section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT MONTREAL, QUEBEC THIS 9TH DAY OF DECEMBER 2009.

P. Fung
Hearing Officer
Trade-marks Opposition Board