



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

**Citation: 2011 TMOB 146**  
**Date of Decision: 2011-08-09**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by David DiCenzo against registration  
No. TMA626,652 for the trade-mark HOOLIGAN in the  
name of Andreas Backer and Frank Dann, a partnership**

[1] On October 29, 2009, at the request of David DiCenzo (the Requesting Party), the Registrar forwarded a notice under s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Andreas Backer and Frank Dann, a partnership, the registered owner (the Registrant) of registration No. TMA626,652 for the trade-mark HOOLIGAN (the Mark).

[2] The Mark is registered in association with the following wares:

Clothing, namely shirts, tank tops, singlets, underwear, dresses, pants, shorts, sweat shirts, sweat jackets, hats, caps, fleece vests, belts, jackets, gloves, scarves; shoes, slippers; textile articles, namely decorative patches, banners, wallets, fabric key chains, backpacks, sports bags, toiletry bags, hip bags, book bags; sporting goods, namely boxing gloves, sunglasses; leather and imitation leather articles, namely wallets, belts and jackets; trunks and travelling bags; umbrellas; parasols.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show, with respect to each of the wares or services specified in the registration, whether the trade-mark was in use in Canada at any time during 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 October 29, 2006 and October 29, 2009 (the Relevant Period).

[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, s. 4(1) of the Act applies.

[5] In response to the Registrar's notice, the Registrant furnished the affidavit of Andreas Backer, one of the partners in the partnership, together with Exhibits A to D, affirmed May 28, 2010. Neither party filed written submissions or requested an oral hearing.

[6] 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 threshold test is quite low. As stated by Mr. Justice Russell in *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270:

68. [...] 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.

[7] I will now turn to the evidence introduced by the Registrant.

[8] Mr. Backer states that the Registrant “is in the clothing and accessories business and sells its clothing and accessories in association with the [Mark] on-line to customers internationally, including customers in Canada”. Mr. Backer adds that the Registrant “sometimes carries on business simply as ‘Hooligan Streetwear’ and ‘Hooligan Streetwear Backer u. Dann GbR’”.

[9] Mr. Backer states that “during the [Relevant Period], the [Registrant] advertised and offered for sale on-line at its website *www.hooligan.de* various items of clothing and accessories bearing the [Mark] to customers in Canada”. In support of his statements of use, he attaches the following exhibits:

- Exhibit A that consists of printouts from such website. More particularly, Mr. Backer states that these printouts show “jackets”, “shirts”, “sweatshirts”, “sweat jackets”, “scarves”, “hats” (beanies), “caps”, “fleece vest”, “underwear”, “shorts”, “pants”, “tank tops”, “banners”, “shoes”, “wallets”, “toiletry bags”, “hip bags”, “sport bags”, “book bags”, “fabric key chains” and “leather belts” bearing the Mark. Upon review of these printouts, I note that the wares “tank tops” also amount to “singlets”. Mr. Backer states that although these printouts are dated 2010, he can confirm that the items shown in the printouts bearing the Mark were featured on the Registrant’s website and available for sale to Canadians during the Relevant Period and the item numbers have not changed. He further states that although it is difficult to see on some of the printouts, in addition to appearing on the clothing items themselves, the Mark also appears on the labels inside the clothing;
- Exhibit B that consists of printouts showing how many Canadian customers accessed the Registrant’s website and “webshop” during the month of May in the years 2008 and 2009;
- Exhibit C that consists of copies of representative pages of the Registrant’s 2007 and 2008 catalogues which featured various clothing and accessories in association with the Mark and which were distributed to Canadian customers during the Relevant Period. Mr. Backer states that the Registrant’s annual catalogues are available to Canadian by mail upon request. Mr. Backer further states that in addition to some of the clothing and accessory items described above, these catalogue pages also show the Mark in

association with “backpacks”, “key chains”, “leather jackets”, “belts” (not of leather) and “patches”; and

- Exhibit D that consists of copies of invoices showing representative sales of various items, including “jackets”, “shirts”, “sweatshirts”, “sweatjackets”, “scarves”, “tank tops”, “gloves”, “fabric key chains” and “hats” (beanies) in association with the Mark to Canadian customers during the Relevant Period.

[10] Mr. Backer also provides the approximate annual sales figures of the Registrant’s clothing and accessories in Canada for the years 2006-2009, which vary between about CAN\$550 and CAN\$2,000. He concludes his affidavit stating that the Registrant continues to advertise and sell its clothing and accessories on-line in association with the Mark to customers in Canada at the present time.

[11] Upon review of the evidence as a whole, I am satisfied that the Registrant has used the Mark in association with the following wares, and that such wares were sold in Canada during the Relevant Period:

Clothing, namely shirts, tank tops, singlets, underwear, pants, shorts, sweat shirts, sweat jackets, hats, caps, fleece vests, belts, jackets, scarves; shoes; textile articles, namely decorative patches, banners, wallets, fabric key chains, backpacks, sports bags, toiletry bags, hip bags, book bags; leather and imitation leather articles, namely wallets, belts and jackets.

[12] However, the Registrant has not adduced any evidence with respect to the wares described as “dresses, gloves, slippers, sporting goods, namely boxing gloves, sunglasses; trunks and travelling bags; umbrellas; parasols”. Indeed, Mr. Backer does not attest that the Registrant has sold any of these wares in Canada in association with the Mark during the Relevant Period. There are no facts which would permit me to conclude that during the Relevant Period, the Mark was also in use in association with these remaining wares, and there is no evidence of special circumstances that would excuse the absence of such use.

[13] To the contrary, Mr. Backer’s explicit statements of use with respect to the particular wares enumerated above, together with the accompanying specimens of use and photographs of

the wares lead me to conclude that the Registrant has not used the Mark in Canada during the Relevant Period in association with the remaining wares enumerated above.

[14] The fact that the wares described as “dresses” fall under the general category of “clothing” and that the Registrant has evidenced use of the Mark with respect to each of the other items of clothing listed in the Registrant’s registration (except “gloves” mentioned above) is not sufficient, in my view, to preserve the registration intact as the Registrant’s evidence of use leads me to conclude that the Registrant’s clothing is designed for men only, as opposed to men and women.

[15] Furthermore, while the Registrant’s evidence of use of the Mark in association with each of the various items of clothing and accessories listed above in paragraph 11 may arguably lead to the inference that there have been sales of the wares described as “gloves” and “slippers” in association with the Mark during the Relevant Period, I am not prepared to consider that the evidence adduced by the Registrant amounts to “representative use” as described by Senior Hearing Officer Savard in *Mendelson, Rosentzveig & Shacter v. Giogio Beverly Hills, Inc.* (1994), 56 C.P.R. (3d) 399 at 402-403 (T.M.O.B.) as Mr. Baker has failed to provide at least a general statement of sales having been made during the Relevant Period in association with *each* item of wares listed in the registration. I wish to reproduce on this point, the following comments of Ms. Savard in *Mendelson*:

[...] the registrant is not required to engage in "evidentiary overkill" in order to demonstrate use of its trade mark for the purposes of s. 45, [...]. But still, there must be some evidence upon which the Registrar can conclude that the trade mark has been used in association with each item of wares during the two-year period preceding the date of the notice. For example, *there ought to be at the least a general statement of sales having been made during the relevant period in association with each item of wares listed in the registration together with examples of such use.* There is no such statement in the evidence. Accordingly, the evidence submitted in this case does not meet the standards set out by Saks, *supra*, with respect to this category of wares. [Emphasis mine]

[16] In view of the above, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended in compliance with the provisions of s. 45 of the Act to delete the following wares:

Dresses, gloves, slippers, sporting goods, namely boxing gloves, sunglasses; trunks and travelling bags; umbrellas; parasols.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office