



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

Citation: 2012 TMOB 22
Date of Decision: 2012-02-08

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Boughton against registration
Nos. TMA536,550 and TMA569,037 for the trade-marks
BUTTER and BUTTER & Design in the name of West 49
Inc.**

[1] At the request of Boughton (the Requesting Party), the Registrar of Trade-marks forwarded notices under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on April 13, 2010 and April 15, 2010, respectively, to West 49 Inc., the registered owner (the Registrant) of registration No. TMA536,550 for the trade-mark BUTTER (the Word Mark) and registration No. TMA569,037 for the trade-mark BUTTER & Design (the Design Mark), shown below (hereinafter referred to together as the Marks).

butter

[2] The Word Mark is registered for use in association with “*clothing, namely jeans, blouses, pants, skirts, sweaters, sweatshirts, shorts, t-shirts, tank tops, outerwear, namely jackets, coats, vests; underwear and lingerie; clothing accessories, namely socks, hats, hair bands, hair ties, hair clips, belts, handbags, wallets, purses*”.

[3] The Design Mark is registered for use in association with “*clothing, namely pants, skirts, sweatshirts, shorts, t-shirts, tank tops; outerwear, namely jackets, coats, vests; clothing, namely jeans, blouses, sweaters; underwear and lingerie; clothing accessories, namely socks, hats, hair bands, hair ties, hair clips, belts, handbags, wallets, purses*”.

[4] Section 45 of the Act 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 these cases, the relevant periods for showing use are any time between April 13, 2007 and April 13, 2010 for the Word Mark and any time between April 15, 2007 and April 15, 2010 for the Design Mark (the Relevant Periods).

[5] The relevant definition of “use” in the present case is set out in s. 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.

[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. It was established in *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.) that assertions of use as a matter of law are insufficient to demonstrate use. A recipient of a s. 45 notice must put forward evidence showing how it has used the trade-mark in order that the Registrar may assess if the facts qualify as use of the trade-mark pursuant to s. 4 of the Act. However, it has also been held that evidentiary overkill is not required when use can be shown in a simple, straightforward fashion [see *Union Electric Supply Co. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)].

[7] In response to the Registrar's notices, the Registrant furnished the identical affidavit of Marcus Fraser, sworn August 12, 2010, together with Exhibits A through E for both files. Only the Registrant filed written submissions. No oral hearings were conducted.

[8] In his affidavit, Mr. Fraser identifies himself as the General Merchandise Manager of Off the Wall, a marketing division of the Registrant. Mr. Fraser explains that Off the Wall is not a separate legal entity, but rather is a trading style of the Registrant used for the purpose of marketing certain products, including products bearing the Marks.

[9] I note that the affidavit is silent with respect to: jeans, blouses, pants, sweatshirts, shorts, t-shirts, coats, vests; underwear and lingerie; clothing accessories, namely socks, hats, hair bands, hair ties, hair clips, belts, handbags, wallets, purses. Furthermore, I note that there are no submissions with respect to use of the Marks in association with these wares or special circumstances that would excuse the absence of such use. As a result, these wares will be deleted from the registration.

[10] I now turn to the remaining wares, namely, *clothing, namely, skirts, sweaters, tank tops; outerwear namely, jackets* (the Remaining Wares). In his affidavit, Mr. Fraser states that during the Relevant Periods the Registrant sold the following wares bearing the Marks: jackets (tunics), tank tops, cardigans (sweaters), dresses and skirts through its retail stores carrying on business as Off the Wall.

[11] In support of maintaining the Remaining Wares, the Registrant has adduced the following relevant evidence:

- (a) Mr. Fraser attaches to his affidavit what he states is a sample hangtag which displays the Design Mark (Exhibit C). Throughout his affidavit, Mr. Fraser refers to the appearance of the Design Mark on the sample hangtag as being representative of the manner in which the Marks appeared on clothing during the Relevant Period. I am satisfied that use of the Design Mark qualifies as use of the Word Mark as the Registrant is not under a restriction to use the Word Mark in any particular format by virtue of the fact that the registration is for a word mark.

- (b) Mr. Fraser states that sales of the Remaining Wares amounted to over \$35, 000 for the years 2007 to April 2010, inclusive.
- (c) Mr. Fraser attaches to his affidavit a “supplier report” which he states shows the quantities of the Remaining Wares purchased during the period between January 2010 and April 2010 (Exhibit D). The report lists “BUTTER” under the heading “Brand” and shows the number and type of products ordered and sold under the BUTTER brand. These products are: “woven tunic tops, woven tank tops, knit tops that tie in the back, tank tops, cardigan sweaters, jackets, dresses and skirts”. Mr. Fraser specifies that the trade-mark referred to as BUTTER under the heading “Brand” is the Design Mark as depicted on the sample hangtag in Exhibit C.
- (d) Mr. Fraser also attaches to his affidavit a sales report for the Remaining Wares (Exhibit E). As with the supplier report, the report covers products sold under the “Brand” BUTTER, which Mr. Fraser states is the Design Mark as displayed on the sample hangtag attached as Exhibit C. Mr. Fraser states that the report shows sales of the Remaining Wares displaying the Marks that took place between January 18 – 30, 2010 in ten store locations in British Columbia, three store locations in Alberta and four store locations in Ontario.

[12] The evidence clearly demonstrates that the Registrant has sold the Remaining Wares in Canada through its stores operating under the trading style Off the Wall during the Relevant Periods. Furthermore, the evidence clearly demonstrates that the Marks were displayed on the Remaining Wares at the time of transfer in the course of genuine commercial transactions during the Relevant Periods. For the purposes of s. 45, that is all that is required [see *Philip Morris Inc. v. Imperial Tobacco Ltd. et al* (1987), 13 C.P.R. (3d) 289 (F.C.T.D.) and s. 4(1) of the Act]. Thus, I am satisfied that the Registrant has shown use of the Marks in association with *skirts, sweaters, tank tops and jackets* in the manner prescribed by s. 4(1) and s. 45 of the Act.

Disposition

[18] Having regard to the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, registration Nos. TMA536,550 and TMA569,037 will be amended to delete the following wares: *jeans, blouses, pants, sweatshirts, shorts, t-shirts, coats, vests; underwear and lingerie; clothing accessories, namely socks, hats, hair bands, hair ties, hair clips, belts, handbags, wallets, purses* in compliance with the provisions of s. 45 of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office