



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

Citation: 2014 TMOB 239
Date of Decision: 2014-11-05

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Gowling Lafleur Henderson LLP against
registration No. TMA723,265 for the trade-mark
SWAGGER in the name of Faisal Anashara**

[1] At the request of Gowling Lafleur Henderson LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on July 9, 2012 to Faisal Anashara (the Owner), the registered owner of registration No. TMA723,265 for the trade-mark SWAGGER (the Mark).

[2] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the wares and services specified in the registration, at any time between July 9, 2009 and July 9, 2012. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[3] After the issuance of the notice, the registration with respect to certain toiletry and fragrance wares was partially transferred to The Proctor & Gamble Company. Pursuant to section 50 of the *Trade-marks Regulations*, SOR/96-195, when a registered trade-mark is partially transferred and becomes the property of multiple parties, each party is deemed to be a separate registered owner. Proctor & Gamble subsequently assigned its registration to Shulton Inc. and at the request of the Requesting Party and Shulton Inc., the section 45 proceeding in respect of Shulton Inc.'s registration was discontinued. As such, this decision only addresses those wares and services in respect of which Mr. Anashara retained ownership.

[4] Accordingly, the Mark is registered for use in association with the services “Publishing of magazines in print and electronic form accessible and downloadable via the internet or other global computer network” and the following wares:

(1) T-shirts, golf shirts, pullovers and long sleeved shirts.

(2) Men's, women's and children's apparel and footwear, namely, shoes, sneakers, knitwear, namely, hats made of interlock, ribbed or double looped knitting, skirts, blouses, jeans, underwear, sweaters, sweatshirts, sweatpants, sports shirts, track suits, jerseys, tank tops, t-shirts, sportswear and athletic apparel, namely, socks, shorts, uniforms, head bands, wristbands, visors, sports jackets, track suits, track pants, jackets, socks, boxer shorts, polo shirts, dress shirts and pants, ties, handkerchiefs, scarves and gloves, hats, accessories namely, sunglasses, eyeglasses, eyeglass cases, jewelry, watches, dress bags, sports bags; umbrellas.

[5] The relevant definitions of use with respect to wares and services are set out in sections 4(1) and 4(2) 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(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[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 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares and services specified in the registration during the relevant period.

[7] In response to the Registrar’s notice, the Owner furnished his own affidavit, sworn on October 9, 2012. Neither party filed written representations; however, the Requesting Party was represented at an oral hearing.

The Owner's Evidence

[8] At the oral hearing, the Requesting Party noted that while the Owner's evidence is voluminous, it is not logically organized or well explained. As discussed below, in the absence of representations from the Owner, it is difficult to understand the full context of some of the exhibits which would allow me to make inferences favourable to the Owner.

[9] In his affidavit, the Owner asserts that he has "continuously used the Swagger brand in Canada since on or about August 14, 2005". From the affidavit, it would appear that the Owner is involved in the fashion business with the stated intention to "design, develop, market, and sell or license merchandise" under the SWAGGER brand.

[10] A good portion of the Owner's affidavit deals with events occurring before the relevant period; as such, it is largely irrelevant to the question of use for purposes of this proceeding. For example, the Owner attests that he sold a variety of wares bearing the Mark at the Toronto Clothing Show in 2007 and 2008, and at Afrofest in 2008, all of which occurred before the relevant period.

[11] Further, much of the evidence is with respect to the Owner's efforts to promote the SWAGGER brand; however, such evidence does not demonstrate transfers of the wares in the normal course of trade as required by section 4(1) of the Act. In this respect, the Owner's evidence includes the following: print advertising and blog reviews (at Exhibit G); letters to various clothing retailers and distributors (at Exhibit C); letters to celebrities such as Jay-Z (at Exhibit F); correspondence exchanged with potential licensees (at Exhibits E and H); and promotional photographs of some clothing items, accessories, and toiletries bearing the Mark (at Exhibit I). As indicated above, portions of the exhibits are presented without adequate context, and it is unclear whether the items appearing in the promotional photographs were actually available for purchase during the relevant period.

[12] The Owner does provide some evidence from the relevant period that appears to relate to more than just promotional activities. For example, the Owner attests that 5,200 woven "Swagger labels" were purchased from a third party in 2010. At Exhibit D, the Owner attached receipts to support this attestation. He further attests that the labels were used on his products

including those shown in the promotional photographs at Exhibit I, though he does not specify when or where such products were available for purchase. In any event, the purchase of labels bearing the Mark by the Owner does not constitute use of the Mark for purposes of this proceeding.

[13] The Owner does attest that Exhibit D includes sales receipts from 2011; however, he attests to no further details whatsoever with respect to those alleged sales, apparently allowing the exhibit to speak for itself. Indeed, Exhibit D includes what appear to be 16 hand-written receipts, each dated “01/01/11”. The receipts appear to show individual sales of certain clothing items, some of which correspond to wares listed in the registration. These include t-shirts, jeans, hats, hoodies, jackets, and shoes. However, I note that these receipts do not display the Mark and the Owner does not explain in any detail the context of the transactions, including whether such sales were with respect to clothing items bearing the Mark.

[14] With respect to the magazine publishing services, I would first note that the Owner attests that he “registered the internet domain name *www.swaggerswagger.com* to market my brand, and enable me to make my products available to Canadian and international customers.” In support of this attestation, he provides a copy of a domain name search and a domain name renewal notice at Exhibit A. He further attests that “photographs, products, magazine publication and promotional material of some of my Swagger trademark/brand are attached ... as Exhibit I”.

[15] At Exhibit I, the Owner provides a poor quality screenshot from his website, *www.swaggerswagger.com*. However, the printout is undated and the only date visible on the webpage screenshot itself is June 3, 2008, prior to the relevant period. In any event, nothing on this screenshot indicates the production or distribution of a magazine in any form.

[16] Exhibit I does includes two pages of a printout from another website, *www.swaggeroriginal.com*. The first page shows an article titled “In Design – Beautiful Dwellings”, apparently posted on May 19, 2012. A third page that follows these two webpage printouts is entitled “SWAGGER NEWS”; the date at the bottom of the page is “March 2012”. It is not clear if this third page is from the same website or a different source. In any event, while

the Mark is displayed on these pages, the Owner does not provide any information regarding who operated the website or produced the articles.

Use of the Mark in Association with the Wares

[17] As noted above, instead of describing sales, the majority of the Owner's affidavit explains his efforts to promote and market his business. For example, he attests at length to having given away free samples at a number of events and to his efforts to secure celebrity endorsements for his products. However, it has been established that giving away wares for free does not constitute use in the normal course of trade [see *JC Penney Co v Gaberdine Clothing Co* (2001), 16 CPR (4th) 151 (FCTD)]. At the oral hearing, the Requesting Party submitted that most of the Owner's statements in his affidavit were aspirational and focused on what he intended to do with the Mark rather than on actual use. I agree with the Requesting Party that none of the Owner's promotional efforts demonstrate use of the Mark within the meaning of section 4(1) of the Act.

[18] As mentioned above, the Owner attests that he sold a variety of wares at clothing shows and festivals in 2007 and 2008. However, such sales do not show use of the Mark for the purposes of this proceeding because the sales occurred before the relevant period.

[19] Furthermore, with respect to the Exhibit D receipts dated "01/01/11", I cannot accept that these receipts demonstrate use of the Mark for two reasons. First, it is not clear that the receipts represent sales of wares bearing the Mark as registered. In this respect, the Owner does not provide any detail regarding the sales and the Mark is not displayed on the receipts. Second, the receipts do not appear to represent sales in the normal course of trade. It would appear that the receipts were all prepared on New Year's Day 2011. Considering that the rest of the evidence does not demonstrate sales during the relevant period and that the Owner has not explained the 2011 receipts, it is difficult to conclude that the receipts demonstrate a pattern of genuine commercial transactions [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)].

[20] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered wares within the meaning of sections 4(1) and 45 of the Act.

Use of the Mark in Association with the Services

[21] With respect to the registered services, the Owner includes screenshots from a website, *www.swaggeroriginal.com*, which appear to display portions of an online “magazine”. The dates shown on the pages are from the relevant period, with the Mark appearing on both pages. However, as noted by the Requesting Party at the oral hearing, the Owner does not explain the relevance of these webpages or screenshots. Indeed, while the Owner attests that his website is *www.swaggeroriginal.com* and provides registration documents to demonstrate his ownership, he makes no reference whatsoever to *www.swaggeroriginal.com* in the body of his affidavit. There is nothing in the exhibit itself which enables me to make any inference that the website is owned or operated by the Owner or that the articles were produced by the Owner or a licensee. In the absence of further explanatory details, I am unable to conclude that any display of the Mark on that website constitutes use by the Owner in association with the registered services.

[22] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of sections 4(2) and 45 of the Act.

Special Circumstances

[23] With respect to whether special circumstances existed to excuse non-use of the Mark, the Owner does not explicitly attest that there were special circumstances. However, he does attest that he has “been involved in a lawsuit for the last two years fighting Proctor & Gamble ... to protect my trademark”.

[24] A determination that there were special circumstances justifying non-use depends on the consideration of three criteria: first, the length of time during which the trade-mark has not been in use; second, whether the reasons for non-use were beyond the control of the registered owner; third, whether there exists a serious intention to shortly resume use [see *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)]. It has been determined that

the second criterion *must* be met in order for there to be a finding of special circumstances [see *Smart & Biggar v Scott Paper Ltd* (2008), 65 CPR (4th) 303 (FCA)].

[25] In this case, it would appear that the Owner became involved in a legal dispute with Proctor & Gamble at some point after their initial correspondence on November 25, 2008, which lasted for an indeterminate length of time. Despite the legal dispute, the Owner continued with his promotional activities and attempts to develop business relationships with clothing retailers. As such, the entirety of the evidence would indicate that the legal dispute was not the cause of non-use. Instead, it would appear that, at best, the Owner did not use the Mark due to poor or unfavourable market conditions. Such conditions are not generally considered special circumstances justifying non-use [per *Harris Knitting Mills, supra*].

[26] Accordingly, I am not satisfied that the Owner has demonstrated special circumstances excusing non-use of the Mark.

Disposition

[27] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the Owner's registration will be expunged.

[28] For greater certainty, I note that this decision applies only to the registration owned by Faisal Anashara (File No. 1,597,597) and not the registration owned by Shulton Inc. (File No. 1,597,598).

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office