



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

**Citation: 2011 TMOB 134**  
**Date of Decision: 2011-08-10**

**IN THE MATTER OF A SECTION 45 PROCEEDING**  
**requested by Gowling Lafleur Henderson LLP against**  
**registration No. TMA556,048 for the trade-mark**  
**ORAGESKI.COM in the name of Coalision, Inc.**

**and**

**IN THE MATTER OF A SECTION 45 PROCEEDING**  
**requested by Gowling Lafleur Henderson LLP against**  
**registration No. TMA556,050 for the trade-mark ORAGE**  
**Dessin in the name of Coalision, Inc.**

**and**

**IN THE MATTER OF A SECTION 45 PROCEEDING**  
**requested by Gowling Lafleur Henderson LLP against**  
**registration No. TMA558,316 for the trade-mark A**  
**ORAGE & Design in the name of Coalision, Inc.**

[1] At the request of Gowling Lafleur Henderson LLP (the Requesting Party), the Registrar of Trade-marks forwarded three notices under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on January 20, 2009 to Coalision, Inc., the registered owner (the Registrant) in respect of registration Nos. TMA556,048 for the trade-mark ORAGESKI.COM, TMA556,050 for the trade-mark ORAGE Design and TMA558,316 for the trade-mark A ORAGE & Design.

[2] ORAGESKI.COM, TMA556,050 trade-mark and ORAGE Design, TMA558,316 are both registered for use in association with the following wares:

(1) Vêtements de ski, nommément pantalons de ski, chandails, chandails cols roulés, combinaisons de ski, sous-vêtements; vêtements de sport et accessoires pour hommes, femmes et enfants, nommément pantalons, chemises, shorts, jupes, blouses, costumes, manteaux, anoraks, tee-shirts, blousons, maillots de bain, bas, chapeaux, ceintures, tuques, foulards, gants et mitaines, bandeaux, masques de ski, lunettes de soleil, cordons de lunettes, étuis de lunettes et pochettes de lunettes, sacs fourre-tout, sacs de voyage; chaussures, nommément souliers, pantoufles, bottes, bottes de skis; skis, bâtons de ski et sacs pour le transport des skis.

These wares as translated on the CIPO database read as follows:

(1) Ski clothing, namely ski pants, sweaters, turtleneck sweaters, one-piece ski suits, underclothing; sports clothing and accessories for men, women and children, namely pants, shirts, shorts, skirts, blouses, suits, coats, anoraks, T-shirts, waist-length jackets, swim suits, hose/socks, hats, belts, toques, scarves, gloves and mitts, headbands, ski masks, sunglasses, eyeglasses retainer cords, eyeglass cases and eyeglass pouches, carry-all bags, travel bags; footwear, namely shoes, slippers, boots, ski boots; skis, ski poles and ski bags.

[3] ORAGE Design, TMA558,316 (hereinafter ORAGE) is shown below:

**ORAGE**

[4] The third mark, A ORAGE & Design, TMA558,316 (hereinafter A ORAGE) is shown below:



:

[5] A ORAGE is registered for use in association with the following wares:

(1) Sunglasses, eyeglasses, eyeglass chains, eyeglass frames; bags, namely tote bags, all purpose sport bags, rucksacks, eyeglass cases; ski wear for men, women and children, namely ski suits, ski pants, ski tops, ski masks, ski gloves, thermal underwear, underwear, ski boots, after ski boots, ski boot bags; sportswear and accessories for men, women and children, namely tops, sweaters, pants, shirts, shorts, blouses, coats, suits, blanket coats, T-shirts, wind resistant jackets, bathing suits, socks, belts, hats, toques, caps, scarves, gloves and mittens; footwear, namely shoes, slippers and boots; snow skis, ski poles, portable ski carriers.

[6] 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 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 between January 20, 2006 and January 20, 2009 (the Relevant Period).

[7] The relevant definition of “use” in association with wares is set out in subsection 4(1) of the *Trade-marks 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.

[8] 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 evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] 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.

[9] In response to each of the Registrar's notices, the Registrant filed an affidavit of Alain Nolet, Vice President, Operations, of the Registrant; the three affidavits are similar and were sworn on April 20, 2009. Both parties filed written arguments; an oral hearing was held on June 15, 2011, at which only the Requesting Party appeared.

[10] Although there are some differences in the evidence submitted for each registration, the commonalities can be summarized as follows. Mr. Nolet attests that the Registrant manufactures and sells various types of clothing in Canada. He further states that in December 2008, three companies (9013-0501 Quebec Inc., 9200-9059 Quebec Inc and Coalision Inc.) merged to form the Registrant, Coalision Inc. Prior to this merger, 9013-0501 Quebec Inc. was the owner of the registration and licensed use of the marks to Coalision Inc. The licence agreements provided for 9013-0501 Quebec Inc.'s control of the character and quality of the wares; the agreement was terminated at the time of the merger.

[11] In each of the three affidavits (notwithstanding that the statement of wares differs in the A ORAGE registration), Mr. Nolet states that the Registrant has used the trade-mark in Canada, in the normal course of trade, in association with the following wares:

Ski clothing, namely ski pants, sweaters, turtleneck sweaters, one-piece ski suits, underwear; thermal underwear; sports clothing and accessories for men, women and children, namely pants, shirts, shorts, skirts, blouses, suits, coats, wind resistant jacket, anoraks, T-shirts, waist-length jackets, hats, belts, toques, scarves, gloves and mitts; headbands, carry-all bags, travel bags, ski bags and sport bags.

[12] Mr. Nolet refers to this list as the "Wares" in each of his affidavits. He indicates that the Registrant's approximate sales of the Wares for the years 2006 to 2008 were as follows: 2006 (\$12,746,065,065.18), 2007 (\$14,396,835.01), and 2008 (\$14,087,349.64). He further states that "the majority" of these Wares displayed one or more of the subject marks.

[13] The Requesting Party submitted that for all three registrations, the wares for which no assertion of use was made should be deleted from the respective registrations as follows:

- TMA556,048 and TMA556,050 (as translated): swim suits, hose/socks, ski masks, sunglasses, eyeglasses retainer cords, eyeglass cases and eyeglass pouches; footwear, namely shoes, slippers, boots, ski boots; skis, ski poles.
- TMA558,316: Sunglasses, eyeglasses, eyeglass chains, eyeglass frames; tote bags, rucksacks, eyeglass cases; ski tops, ski masks, ski gloves, ski boots, after ski boots, ski boot bags; tops, bathing suits, socks; footwear, namely shoes, slippers and boots; snow skis, ski poles, portable ski carriers.

[14] I agree that Mr. Nolet makes no assertion of use nor is there any evidence from which to infer use with respect to the wares set out in paragraph 13 above; the registrations will be amended accordingly.

[15] I note that at the oral hearing it was conceded that some use of the first two marks (ORAGESKI and ORAGE) had been shown; however, the Requesting Party submitted that some of the Wares for which an assertion of use was made should be deleted as no further reference to them appears in the documentary evidence. The items for which no further reference appears are as follows:

- TMA556,048 and TMA556,050: turtleneck sweaters, shorts, skirts, blouses, suits, anoraks, gloves, headbands, carry-all bags, travel bags, ski bags.
- TMA558,316: all purpose bags, sports bags, underwear, shorts, blouses, gloves.

[16] Finally, and in any event, with respect to A ORAGE, the Requesting Party submitted that the registration should be expunged in its entirety as the exhibits do not show use of the mark as registered.

[17] With respect to the Requesting Party's second submission regarding the Wares for which use was asserted but no documentary evidence provided, it may be useful to provide a brief summary of all the relevant evidence provided. In his affidavits, Mr. Nolet identifies various means that the Registrant used to display the mark on its wares during the Relevant Period. The exhibits are substantially similar in each affidavit; for example, with respect to ORAGESKI, Mr. Nolet provided the following exhibits:

- Exhibit A comprises pictures of two sample labels affixed to the inside of a jacket; in addition to other design elements, the subject mark is displayed as “www.orageski.com”, which I consider a minor deviation from the mark as registered.
- Exhibit B comprises pictures of an underwear (shirt) packaging carton displaying “www.orageski.com” in addition to other information and design elements.
- Exhibit C comprises two pictures of hang tags. The affidavit refers to the exhibit as a hang tag attached to ski pants, which hangs from the product by a thread and provides pricing and product information; I note that the second picture appears to be of a hang tag labelled for women's mitts. The subject mark appears as registered at the bottom of each tag.
- Exhibit D is a copy of the Registrant's 2006-2007 Fall/Winter catalogue. I note that the subject mark is displayed on the side of each page that displays the various clothing and accessory items. Mr. Nolet attests that the catalogues were produced and distributed by the Registrant throughout Canada during the Relevant Period to retailers, clients and potential clients. He further states that the wares displayed in the catalogues were marked with the subject mark by one of the means above when sold in Canada during the Relevant Period.

[18] I note that the same catalogue is submitted as evidence for the other two registrations, as are similar (though not necessarily identical) sample label, packaging and hang tag exhibits. As

well, the other two registrations include an additional exhibit in the form of pictures of stitching on two jackets, a sweater and an all purpose bag.

[19] Finally, at Exhibit E of the ORAGESKI affidavit and Exhibit F of the other two affidavits are copies of sample invoices showing sales of some of the wares in Canada during the Relevant Period. The ORAGE mark appears on the top of the invoices along with the Registrant's name and address.

[20] The Registrant submits that it should not be subjected to evidentiary overkill and that the exhibit catalogue is detailed and allows the Registrar to see the diversity of the wares the Registrant manufactures and distributes. Relying on *Saks & Co. v. Canada (Registrar of Trade marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.), the Registrant argues that the invoices produced are representative of one of two larger categories of wares, namely ski clothing or sport clothing and accessories for men, women and children. Accordingly, the Registrant submits that sufficient evidence of use has been shown for all of the wares as registered, as they fall under one of these two categories, for which sufficient representative evidence has been provided.

[21] As noted by the Registrant, there is no requirement that direct evidence be furnished for every registered ware where such wares have been logically and properly categorized and representative evidence has been furnished for each category [see *Saks, supra*]. The present case involves only two categories of wares as identified by the Registrant whereas *Saks* involved 14 categories of wares; however, upon reviewing the evidence as a whole and considering that the nature of the wares is a comprehensive line of ski clothing and related accessories, I am satisfied that sufficient evidence has been furnished regarding the remaining wares that appear in the catalogue but for which no labels or photographs have been provided.

[22] With respect to the Requesting Party's final submission that the evidence does not show use of the A ORAGE mark as registered, the Registrant submits that the mark as used preserves the dominant features of the mark, namely the stylized A design and the word ORAGE. Relying on *Promafil Canada Ltee v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.), the Registrant

submitted that the unaware purchaser would infer that all the trade-marks shown in the exhibits would have the same origin despite the “minor variations”.

[23] With respect to the variations, I note that throughout the exhibits several orientations or placements of the dominant features of the ORAGE mark appear. For example, Exhibit A comprises pictures of the mark in stitching on two jackets, a sweater and an all purpose bag; on the jacket stitching, a line and a space separates the stylized A element from the word ORAGE below it; on the bag, the stylized A appears on a strap, whereas the word ORAGE appears vertically on the bag; and on the sweater, the stylized A and the word ORAGE appear next to each other along the zipper pull at the neck. In Exhibit B, one of the labels shows the stylized A to the right of the word ORAGE in a vertical orientation with some additional text in between. In Exhibit C, the underwear packaging displays a variation of the subject mark with the stylized A and the word ORAGE separated by a space. In the hang tag in Exhibit D, the stylized A appears below and slightly to the left of the word ORAGE; underneath ORAGE there is additional text in smaller font. Lastly, at Exhibit E, on most of the pages of the catalogue next to the product information, the word ORAGE is displayed in a different font than that of the registration, and appears below the stylized A in the margin of each page.

[24] Having reviewed the exhibits, I note that the dominant features of the A ORAGE mark appear prominently and in close proximity to each other in each of the exhibits; this is so notwithstanding that they do not always appear in the same placement as in the registration. Accordingly, I agree with the Registrant that the dominant features of the mark as registered are preserved and find that neither the additional text nor the variations in placement of the dominant features would mislead an unaware purchaser [see *House of Kwong Sang Hong International Ltd. v. Borden Ladner Gervais* (2004), 31 C.P.R. (4th) 252 (F.C.) and *Promafil, supra*].

[25] Given all of the foregoing, I am satisfied that the Registrant has evidenced use of the marks in association with the following wares as registered within the meaning of s. 45 and s. 4(1) of the Act during the Relevant Period:



- TMA556,048 and TMA556,050 (as translated): Ski clothing, namely ski pants, sweaters, turtleneck sweaters, one-piece ski suits, underclothing; sports clothing and accessories for men, women and children, namely pants, shirts, shorts, skirts, blouses, suits, coats, anoraks, T-shirts, waist-length jackets, hats, belts, toques, scarves, gloves and mitts, headbands, carry-all bags, travel bags; ski bags.
- TMA558,316: Bags, namely all purpose sport bags; ski wear for men, women and children, namely ski suits, ski pants, thermal underwear, underwear; sportswear and accessories for men, women and children, namely sweaters, pants, shirts, shorts, blouses, coats, suits, blanket coats, T-shirts, wind resistant jackets, belts, hats, toques, caps, scarves, gloves and mittens.

[26] Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registrations will be amended to delete the following from the respective statements of wares in compliance with the provisions of s. 45 of the Act:

- TMA556,048 and TMA556,050 (as translated): swim suits, hose/socks, ski masks, sunglasses, eyeglasses retainer cords, eyeglass cases and eyeglass pouches; footwear, namely shoes, slippers, boots, ski boots; skis, ski poles.
- TMA558,316: Sunglasses, eyeglasses, eyeglass chains, eyeglass frames; tote bags, rucksacks, eyeglass cases; ski tops, ski masks, ski gloves, ski boots, after ski boots, ski boot bags; tops, bathing suits, socks; footwear, namely shoes, slippers and boots; snow skis, ski poles, portable ski carriers.

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P. Heidi Sprung  
 Member  
 Trade-marks Opposition Board  
 Canadian Intellectual Property Office