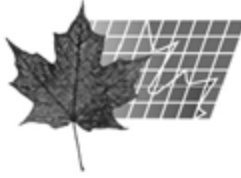


O P I C



C I P O

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

Citation: 2017 TMOB 132

Date of Decision: 2017-09-28

IN THE MATTER OF A SECTION 45 PROCEEDING

**Robinson Sheppard Shapiro
S.E.N.C.R.L./L.L.P.**

Requesting Party

and

Exo Inc.

Registered Owner

TMA453,477 for EXO

Registration

INTRODUCTION

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA453,477 for the trade-mark EXO (the Mark), presently owned by Exo Inc. (the Owner).

[2] The Mark is registered for use in association with the following goods and services:

Goods :

(1) Vêtements et accessoires pour homme et pour femme nommément tee-shirts, gilets, chemises, vestons, manteaux, pantalons, jeans, bermudas, shorts, casquettes, bonnets, ceintures, bandeaux, lacets, bas, chaussures, nommément souliers et bottes spécialement conçus pour la pratique du skateboard, porte-monnaie, sacs à dos;

- (2) *Skateboards et roues;*
- (3) *Disques compacts audio préenregistrés;* and

Services :

- (1) *Exploitation de boutiques de vêtements pour dame et pour homme comprenant la vente d'accessoires de vêtements pour dame et pour homme de même que la vente de chaussures;*
- (2) *Exploitation de magasins de vente au détail de vêtements et accessoires pour homme et pour femme, nommément tee-shirts, gilets, chemises, vestons, manteaux, pantalons, jeans, bermudas, shorts, casquettes, bonnets, ceintures, bandeaux, lacets, bas, chaussures, nommément souliers et bottes spécialement conçus pour la pratique du skateboard, porte-monnaie, sacs à dos;*
- (3) *Vente au détail de skateboards et roues;*
- (4) *Vente au détail de disques compacts audio préenregistrés. (the Services)*

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete some of the Goods and Services.

THE PROCEEDING

[4] On September 3, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to the Owner of the Mark. The notice was sent at the request of Robinson Sheppard Shapiro S.E.N.C.R.L./L.L.P.(the Requesting Party).

[5] The section 45 notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between September 3, 2012 and September 3, 2015 (the Relevant Period), in association with the registered goods and services. 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.

[6] The relevant definitions of “use” in association with goods and services are set out in section 4 of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

(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.

[7] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the Register. The criteria for establishing use are not demanding and an overabundance of evidence is unnecessary. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the goods or services specified in the registration at any time during the relevant period [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use of the trade-mark [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar’s notice, the Owner filed the solemn declaration of Jay Manek, sworn on April 4, 2016 with references to Exhibits A to C inclusive.

[9] Both parties filed written representations and were present at a hearing.

THE OWNER’S EVIDENCE

[10] Mr. Manek has been the Owner’s President since 1998. He states that the Owner operates a skateboarding shop, in association with the Mark, located in Quebec City that sells skateboards and accessories related to skateboards, such as clothing, shoes and music paraphernalia. Its clientele is mostly composed of teenagers and young adults who are looking for a sportier and trendier line of clothing associated with skateboarding.

[11] Mr. Manek states that approximately 25 000 people visit the store every year. The Owner also hosts events in Quebec City such as skateboard competitions and music concerts.

[12] Mr. Manek affirms that since 1998, the Owner has sold in Canada clothing, skateboards and accessories bearing the Mark. He asserts that during the Relevant Period the Owner sold the Goods in Canada in association with the Mark and has used the Mark in association with the Services. I reproduce below the allegations describing in more details how the Mark has been allegedly used in association with the Goods and Services:

9. The [Mark] always figures prominently on the goods. Exhibit A shows the mark as used in relation to clothing and accessories (“vêtements et accessoires pour homme et pour femme”). The mark is referred to on the invoices, a bundle of which shows use of

the mark in the period preceding the Registrar's notice. The invoices as attached to the goods are a pertinent example of the use of the mark.

10. The [Mark] always figures prominently on the goods. Exhibit B shows the mark as used in relation to skateboards, wheels and cds ("skateboards et roues, disques compacts audio préenregistrés"). The mark is referred to on the invoices, a bundle of which shows use of the mark in the period preceding the Registrar's notice. The invoices as attached to the goods are a pertinent example of the use of the mark.

11. A picture of the outside and inside of the store where the mark is displayed is attached as Exhibit C. It shows how the services of "exploitation de boutique de vêtements" and "exploitation de magasins de vente au détail" are used in the performance of services. Also, Exhibit C, represents an example of an advertisement showing how the mark is displayed in the performance of the services.

[13] Exhibit A consists of pictures of labels on T-shirts and sweaters as well as pictures of a shirt bearing the Mark. There are also pictures of jeans and pants, caps, tuques, laces, hosiery, a change holder, backpacks and belts, all bearing the Mark. Also included as part of Exhibit A are 18 invoices issued during the Relevant Period for each of those goods.

[14] On each invoice, there is:

- The inscription of the French word "*Commande*" which translates to "Order" in English;
- a picture of each of the items sold to the customer;
- a reference to the trade-mark associated to the item sold, including references to the Mark;
- an order number;
- the name and address of the customer;
- the quantity of each item ordered;
- the unit price of each item sold as well as the total cost of the purchase, including all taxes;
- the delivery address;
- the mode of payment used by the customer to pay the invoice; and
- the store name EXOSHOP and its civic address.

[15] Exhibit B consists of pictures of various types of skateboards as well as pictures of wheels and compact discs, all bearing the Mark. Also included as part of Exhibit B are four invoices issued during the Relevant Period evidencing the sale of each of those goods and containing the information detailed above.

[16] Except for one, these invoices appear to have been issued to customers who placed orders via the Internet, through the website located at *www.exoshop.com*.

[17] Exhibit C consists of various photographs of the exterior and interior of a store. The photograph of the exterior of the store shows an exterior sign on which appears the Mark. Finally, there are copies of two advertisements, one published in QuébecScope in December 2013 and another one published in the winter 2013 issue of Voilà Québec, illustrating how the Mark was displayed on advertising material promoting the Services.

[18] At the hearing, I mentioned to the parties that the invoices described above bear the trade name EXOSHOP and not the Mark. As such, the parties made brief submissions on the issue whether the use of the trade name EXOSHOP can be considered use of the Mark in association with the Services.

THE REQUESTING PARTY'S ARGUMENTS

[19] The Requesting Party, in its written representations and at the hearing, has taken the approach of dissecting and commenting on each of the sentences contained in most of the paragraphs of Mr. Manek's declaration. I would note that this is the wrong approach; the evidence must be viewed as a whole in order to determine whether the Owner has established use of the Mark in association with each of the Goods and Services.

[20] However, I will discuss the following issues argued by the Requesting Party:

- Site photographs do not prove that the Services were actually performed during the Relevant Period;
- Product photographs do not prove that goods appearing on the photographs and bearing the Mark were actually sold during the Relevant Period;
- There is no evidence of use of the Mark in association with: “vests, jackets, coats, Bermuda shorts, shorts, headbands, footwear, namely shoes and boots specifically designed for skateboarding” (the Unused Goods) and, as such, those goods should be deleted from the list of Goods;
- As for the invoices filed, they are actually copies of orders referring to various goods. Moreover, it is impossible to know if the goods identified in those orders relate to products bearing the Mark since either there is no corresponding photographs of the

products, or the photographs of the products appearing on the orders are so small that one cannot identify the Mark on them, their packaging or tags attached thereto.

THE OWNER'S ARGUMENTS

[21] For its part, the Owner contends that it did not have to show use of the Mark in association with each and every Goods and Services, citing the judgment of the Federal Court in *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FCTD). Therefore, the Owner submits that the registration should be maintained in its entirety despite the lack of evidence of use of the Mark in association with some of the Goods and Services.

[22] The Owner also argues that the evidence must be viewed as a whole. Finally, any evidence of use of the trade name EXOSHOP constitutes evidence of use of the Mark in association with the Services.

ANALYSIS

Use of the Mark in association with each of the Goods and Services

[23] I will start first with the Owner's contention that it did not have to prove use of the Mark in association with each and every Goods and Services.

[24] In *Saks*, there were numerous categories of goods and services logically and properly categorized and each category contained a list of multiple goods and services. More significantly, there were also statements and documents indicating that there were sales of those goods and services. The evidence filed, as a whole, was representative of the use of the Mark in association with the goods and services in issue. It was in that context that the Court concluded in *Saks* that there was no obligation to file direct evidence or documentary proof regarding each item in each category of the goods and the services.

[25] In the present case, there are only three general categories of goods (men's and women's clothing and accessories, skateboards and wheels and finally, pre-recorded audio compact discs) and one general category of services, namely the operation of retail stores. Moreover, Mr. Manek

did not clearly state that the Owner sold each of the Goods in association with the Mark and that the invoices only show evidence of transfers of some of the Goods.

[26] Consequently, absence of evidence of use in association with any of the Goods or Services shall result in the striking of those goods and/or services from the list covered by the registration.

The orders filed are invoices

[27] In view of the content of the orders as described above, I am of the view that, despite their title, they are invoices and not simply orders.

Use of the Mark in association with the Goods

[28] Firstly, I agree with the Requesting Party that there are no photographs of any of the Unsued Goods and/or invoices supporting an allegation of sale of any of the Unsued Goods in association with the Mark during the Relevant Period. Moreover, there is no evidence before me of special circumstances excusing non-use of the Mark in association with those goods. Consequently, the registration shall be amended accordingly.

[29] Otherwise, as mentioned above, the Requesting Party has isolated each document forming part of Exhibits A and B to conclude that there is no evidence of use of the Mark in association with any of the items illustrated or documented therein. However, those exhibits must be viewed in their proper context with their description provided by Mr. Manek in his affidavit.

[30] With that in mind, the general structure of the affidavit and the assembly of the Exhibits can be described in the following manner:

- First, there are pictures of certain types of clothing namely, T-shirts, shirts, pants, jeans, hair bonnets, peak caps, belts, laces, hosiery, change holder, backpacks;
- They are followed by invoices illustrating the sale of those goods;
- The invoices, for the most part, contain an illustration of the goods sold;
- The same sequence is found for skateboards, skateboard wheels and audio compact discs.

[31] The Requesting Party submits that, in many instances, it is difficult to tell which goods are depicted on the invoices, as the pictures are too small. Nevertheless, I am of the view that such evidence, when viewed as a whole, demonstrates use of the Mark in association with some of the Goods during the Relevant Period as:

- The photographs of the goods clearly show the Mark on the goods themselves or their packaging;
- These photographs are followed by invoices listing and depicting such goods (for example a T-Shirt) and the Mark appears beside the photograph in the description of the item sold;
- The invoices list the products sold and the trade-mark associated to the products, including the Mark; and
- All the invoices were issued during the Relevant Period.

[32] In this context, the invoices, as described above, show sales of various goods and I am satisfied that the accompanying photographs show that such goods bore the Mark. One must remember that the purpose of section 45 proceeding is to get rid of dead wood and not to expunge a trade-mark on mere technicalities.

[33] Consequently, the evidence, as a whole, shows use of the Mark during the Relevant Period in association with the following goods: Men's and women's clothing and accessories, namely T-shirts, shirts, pants, jeans, peak caps, hair bonnets, belts, headbands, laces, hosiery, change holders, backpacks; skateboards and wheels; pre-recorded audio compact discs.

Use of the Mark in association with Services

[34] There are two sample advertisements promoting a retail store in association with the Mark, located in Quebec City. Those ads were published during the Relevant Period. They promote the sale of articles of clothing and accessories, but in particular the following: T-shirts, hair bonnets, peak caps, belts; footwear; backpacks; and skateboards.

[35] As noted above, Mr. Manek asserts use of the Mark in association with "*exploitation de boutique de vêtements*" and "*exploitation de magasins de vente au détail*" generally. However, as can be seen, the registered services are limited to specify certain goods in particular. As

mentioned earlier, there is no evidence before me of sales of the Unused Goods, in association with the Mark or otherwise. With the exception of “footwear”, referenced in the sample advertisements, there is no further evidence of use of the Mark in association with the retail sale of the Unsued Goods.

[36] Mr. Manek does not provide any evidence of special circumstances excusing non-use of the Mark in association with those services. The registration will be amended accordingly.

[37] What is left then is, to determine if the exhibited invoices could support the allegation that the Mark was used in association with the operation of retail stores selling shirts, pants, jeans, hosiery, laces, change holders and the retail sale of wheels, as those products are not illustrated on the advertisements described above. As noted, the invoices were issued by EXOSHOP. Consequently, the further issue is whether the use of the trade name EXOSHOP on invoices constitutes use of the Mark in association with the operation of retail stores selling those products?

[38] Use of a trade name in association with services does not exclude use of that trade name as a trade-mark within the meaning of section 4(2) of the Act [*Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB)]. It has been established that in the context of services, a trade-mark appearing at the top of an invoice is sufficient to show use [see *Tint King of California Inc v Registrar of Trade-marks et al*, 2006 FC 1440, 56 CPR (4th) 223 (FC) at paragraph 35]. Furthermore, whether the display of a trade name constitutes trade-mark use depends on the circumstances of each particular case [*Bereskin & Parr v Kleen-Flo Tumbler Industries Ltd*, 2010 CarswellNat 3505 (TMOB) at paragraph 10].

[39] In this particular case, it is difficult to conclude that the use of EXOSHOP on the invoices as a trade name excludes the use of that name as a trade-mark in association with services. In this case, I find that customers would perceive “EXOSHOP” as both the business name and the trade-mark used in association with the services provided. Indeed, especially in the limited context of this section 45 proceeding, it is hard to conclude that the Owner’s name was not used for the purpose of “distinguishing ... services performed by him from those ... performed by others” within the meaning of “trade-mark” per section 2 of the Act.

[40] However, EXOSHOP is not the Mark per se.

[41] Nevertheless, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear* (1992), 44 CPR (3d) 59 (FCA), I consider, in this case, the addition of “SHOP”, a descriptive word, to be only a minor deviation from the Mark as registered that could not mislead the consumer as to the origin of the Services.

[42] Consequently, those invoices combined with the photographs of the interior and exterior of the stores, and the two advertisements satisfy me that the Mark was used during the Relevant Period in association with the operation of retail stores selling men's and women's clothing and accessories, and footwear; as well as the operation of retail stores selling men's and women's clothing and accessories, namely T-shirts, shirts, peak caps, hair bonnets, belts, footwear, namely shoes and boots specially designed for skateboarding, backpacks; and retail sale of skateboards and wheels.

[43] As such, I am satisfied that the Owner has demonstrated use of the Mark in association with:

(1) Vêtements et accessoires pour homme et pour femme nommément tee-shirts, chemises, pantalons, jeans, casquettes, bonnets, ceintures, lacets, bas, porte-monnaie, sacs à dos;

(2) Skateboards et roues;

(3) Disques compacts audio préenregistrés; and

(1) Exploitation de boutiques de vêtements pour dame et pour homme comprenant la vente d'accessoires de vêtements pour dame et pour homme de même que la vente de chaussures;

(2) Exploitation de magasins de vente au détail de vêtements et accessoires pour homme et pour femme, nommément tee-shirts, chemises, pantalons, jeans, casquettes, bonnets, ceintures, lacets, bas, chaussures, nommément souliers et bottes spécialement conçus pour la pratique du skateboard, porte-monnaie, sacs à dos;

(3) Vente au détail de skateboards et roues;

within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[44] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to read:

(1) Vêtements et accessoires pour homme et pour femme nommément tee-shirts, chemises, pantalons, jeans, casquettes, bonnets, ceintures, lacets, bas, porte-monnaie, sacs à dos;

(2) Skateboards et roues;

(3) Disques compacts audio préenregistrés; and

(1) Exploitation de boutiques de vêtements pour dame et pour homme comprenant la vente d'accessoires de vêtements pour dame et pour homme de même que la vente de chaussures;

(2) Exploitation de magasins de vente au détail de vêtements et accessoires pour homme et pour femme, nommément tee-shirts, chemises, pantalons, jeans, casquettes, bonnets, ceintures, lacets, bas, chaussures, nommément souliers et bottes spécialement conçus pour la pratique du skateboard, porte-monnaie, sacs à dos;

(3) Vente au détail de skateboards et roues;

(4) Vente au détail de disques compacts audio préenregistrés.

in compliance with the provisions of section 45 of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2017-08-24

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