



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

Citation: 2017 TMOB 125

Date of Decision: 2017-09-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Soph Co. Ltd.

Requesting Party

and

M.J. Soffe, LLC

Registered Owner

TMA673,517 for SOFFE & Design

Registration

[1] At the request of Soph Co. Ltd., the Registrar of Trade-marks issued a notice under section 45 of the Trade-marks Act RSC 1985, c T-13 (the Act) on June 19, 2015 to M.J. Soffe, LLC (the Owner), the registered owner of registration No. TMA673,517 for the trade-mark SOFFE & Design (the Mark). The Mark is shown below:



[2] The Mark includes the following colour claim:

Colour is claimed as a feature of the trade-mark. The colours red and blue are claimed as a feature of the trade-mark. The mark consists of the word SOFFE in large red capital letters with two blue underlines above and two blue underlines below the word SOFFE.

[3] The Mark is registered for use in association with the following goods:

Clothing namely jackets, jerseys, tee shirts, polo shirts, tank tops, sports bras, socks, blankets, shorts, sweat pants, sweat shirts and sweat suits.

[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 goods 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 June 19, 2012 to June 19, 2015.

[5] The relevant definition of use with respect to goods is set out in section 4(1) 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.

[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 goods specified in the registration during the relevant period.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Justin M. Grow, General Counsel of the Owner, sworn on January 19, 2016 in Greenville, South Carolina. Only the Owner filed written representations; an oral hearing was not requested.

THE OWNER'S EVIDENCE

[8] In his affidavit, Mr. Grow attests that the Owner manufactures and distributes apparel in the United States and internationally. He explains that the Owner sells its products to various retailers, such as internet-based retailers, bookstores, independent dealers, and "cheer dealers" who, in turn, sell the SOFFE-branded products to the public in Canada. In particular, he states that the Owner "provides short and long sleeve tops, briefs, shorts, pants, sweats, jerseys dresses,

skirts, underwear and leggings” as well as “accessories, such as hats, totes, socks, and others”. Mr. Grow states that the Owner also markets and sells its products online at its website, *www.soffe.com*.

[9] With respect to display of the Mark, Mr. Grow attests that the Mark appears on hangtags, on packaging or on the apparel products directly.

[10] With respect to sales in Canada during the relevant period, Mr. Grow attests that from 2012 to 2015 the Owner sold over 24,000 units in Canada, totalling over USD\$115,000 in sales.

[11] In support, attached to his affidavit are the following exhibits:

- Exhibit A is a four-page table listing various clothing items that Mr. Grow attests are sold in association with the Mark. Mr. Grow explains that the table is organized to correspond with the goods listed in the registration. The table appears to list “Canada Sales” for 2012 to 2015, broken down by fiscal year.
- Exhibit B consists of 12 photographs of SOFFE-branded clothing tops that Mr. Grow attests are representative of how the Mark is displayed on such goods. I note that the Mark as registered is displayed on tags or labels affixed to the depicted shirts and sweaters.
- Exhibit C consists of seven photographs of SOFFE-branded clothing bottoms that Mr. Grow attests are representative of how the Mark is displayed on such goods. Again, I note that the Mark as registered is displayed on tags or labels affixed to the depicted pants and shorts.
- Exhibit D is a photograph of a pair of SOFFE-brand socks that Mr. Grow attests is representative of how the Mark “typically appears” on the packaging of some of the Owner’s clothing goods. The Mark appears on the socks’ packaging.
- Exhibit E consists of four representative invoices showing sales from the Owner to a customer located in Canada. The invoices are all dated within the relevant period and show sales of various styles of shorts as attested to by Mr. Grow.

- Exhibit F is a four-page sales summary of the “total quantity of products sold in association with [the Mark] in Canada” from 2012 to 2015. With the exception of “sports bras”, “blankets” and “socks”, I am able to identify products corresponding with each of the registered goods.

ANALYSIS

[12] In his affidavit, Mr. Grow provides a general list of goods offered by the Owner (at paragraph 6) as well as a four-page table listing the specific clothing items sold by the Owner in Canada during the relevant period (at Exhibit A). He also provides photographs of goods (at Exhibits B, C and D) and sample invoices listing some particular clothing items sold during the relevant period.

[13] In its written representations, the Owner provides a table to correlate nine of the registered goods with particular line items in the Exhibit A sales report. Notably omitted from this correlation table are the registered goods “sports bras”, “blankets” and “socks.”

[14] Indeed, in reviewing Mr. Grow’s affidavit and supporting exhibits, I do not find reference to the registered goods “sports bras” or “blankets” whatsoever.

[15] With respect to the registered goods “socks”, Mr. Grow does attach an image of SOFFE-branded socks at Exhibit D to his affidavit. Curiously, though, he does not make a clear assertion that the Owner actually sold such goods in Canada during the relevant period or otherwise. Although he provides lists of the SOFFE-branded clothing goods sold in Canada at Exhibits A and F to his affidavit, none of the listings appear to be for “socks” or the like. In its written representations, the Owner does not explain this discrepancy and, despite doing so for other goods, does not identify any of the sales report line items as reflecting sales in Canada of SOFFE-branded socks.

[16] Even if I were to accept that the Owner offered SOFFE-branded socks for sale in Canada during the relevant period, merely offering goods for sale is not sufficient to satisfy section 4(1) of the Act [see, for example, *The Molson Companies Ltd v Halter* (1976), 28 CPR (2d) 158 (FCTD); and *Gowling, Strathy & Henderson v Royal Bank of Canada* (1995), 63 CPR (3d) 322 (FCTD)]. Some evidence of transfers in the normal course of trade in Canada is necessary. In

this case, the Owner furnished no evidence of transfers of socks in Canada during the relevant period or otherwise.

[17] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “socks”, “sports bras” or “blankets” within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances excusing non-use of the Mark before me, the registration will be amended accordingly.

[18] With respect to the remaining goods, namely “jackets, jerseys, tee shirts, polo shirts, tank tops, ... shorts, sweat pants, sweat shirts and sweat suits”, I am able to identify relevant sales of each at Exhibits A and F to Mr. Grow’s affidavit. Together with Exhibits B and C, showing how the Mark was displayed on such goods, I am satisfied that the Owner has demonstrated use of the Mark in association with such remaining goods within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[19] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete “sports bras, socks, blankets” from the statement of goods.

[20] The amended statement of goods will be as follows:

Clothing namely jackets, jerseys, tee shirts, polo shirts, tank tops, shorts, sweat pants, sweat shirts and sweat suits.

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

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Blake, Cassels & Graydon LLP

For the Registered Owner

Moffat & Co.

For the Requesting Party