



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

Citation: 2017 TMOB 144

Date of Decision: 2017-10-24

IN THE MATTER OF A SECTION 45 PROCEEDING

Riches McKenzie & Herbert LLP

Requesting Party

and

Mantique Fashions Ltd.

Registered Owner

TMA691,846 for SAKURA

Registration

[1] This is a decision involving summary expungement proceedings with respect to registration No. TMA691,846 for the trade-mark SAKURA (the Mark), owned by Mantique Fashions Ltd.

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

Goods:

Women's clothing, namely, camisoles, blazers, boleros, shrugs, capri pants, cardigans, coats, dresses, halter tops, jackets, zip-ups, denim jeans, jumpsuits, leather jackets, pants, ponchos, shirts, blouses, shorts, skirts, sweaters, sweat tops, t-shirts, tank tops, tube-tops, tunics, underwear, undershirts, vests, raincoats, rain jackets, trench coats, turtlenecks, hot-shorts, track suits, leotards, beach wear, cover-ups, sundresses, loungewear, bodysuits, panties, belts, belt buckles, hosiery, stockings, socks, hats, gloves, mitts, leg warmers, sashes, flip-flops, shoes, caps, scarves, purses, handbags, costume jewellery, sunglasses,

tote bags, casual bags, hair accessories, head bands, gear bags, sport bags, duffle bags, backpacks, athletic wear, bonnets, boots, watches, fur, knitwear, lingerie, pyjamas, sleepwear, suits, swimwear, robes, perfume, wallets, slippers, trousers, yoga wear, hoodies, toques, visors, capes, stoles, culottes, overalls, brassieres, shawls bathing suits, and parkas.

Services:

Operation of a clothing store selling women's clothing and accessories to others on a retail basis.

[3] For the reasons that follow, I conclude that the registration ought to be maintained with respect to the services, and maintained in part with respect to the goods.

THE PROCEEDINGS

[4] On September 4, 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 Mantique Fashions Ltd. (the Owner). The notice was sent at the request of Riches McKenzie Herbert LLP.

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between September 4, 2012 and September 4, 2015, in association with each of the goods and services specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definitions of use 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 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] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression “clearing deadwood” has often been used to describe such proceedings [*Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289

(FCTD)]. While it is true that the threshold for establishing use in a section 45 proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD) at 480; *Austin Nichols & Co v Cinnabon, Inc* (1998), 82 CPR (3d) 513 (FCA)], 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 registered goods and services during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. It was established in *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA) that assertions of use as a matter of law are insufficient to demonstrate use. However, statements of fact demonstrating use are not merely bald assertions [*Mantha & Associes/Associates v Central Transport, Inc* (1995), 64 CPR (3d) 354 (FCA)]. Furthermore, it has also been held that evidentiary overkill is not required when use can be shown in a simple, straightforward fashion; use must be shown, not examples of all uses [*Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit Gino Cuglietta, sworn December 3, 2015, together with Exhibits A to E.

[9] Neither party filed written submissions or requested an oral hearing.

THE EVIDENCE

[10] Mr. Cuglietta is the President of the Owner.

[11] Mr. Cuglietta explains that the Owner is in the clothing and fashion accessory retail business, operating six clothing stores in British Columbia, two of which operate under the SAKURA name. He attests that the SAKURA stores sell women's fashion garments and accessories, with one such store opening in December 2009 and the other opening in April 2010, both of which have operated under the SAKURA name continuously since their respective openings.

[12] Mr. Cuglietta states that the Owner has prominently and extensively used the Mark in association with the following goods that it sold in Canada during the relevant period:

Women's clothing products (including camisoles, blazers, boleros, capri pants, cardigans, coats, dresses, halter tops, jackets, zip-ups, denim jeans, leather jackets, pants, ponchos, shirts, blouses, shorts, skirts, sweaters, sweat tops, t-shirts, tank tops, tube-tops, underwear, vests, panties, knitwear and hoodies) and accessories (including belts, gloves, hats, purses, handbags, costume jewellery, sunglasses, tote bags and casual bags).

He also attests to use of the Mark in the operation of clothing stores selling women's clothing and accessories. I note that he does not make any specific mention of the following registered goods:

Women's clothing, namely, [...], shrugs, [...], jumpsuits, [...], tunics, [...], undershirts, [...], raincoats, rain jackets, trench coats, turtlenecks, hot-shorts, track suits, leotards, beach wear, cover-ups, sundresses, loungewear, bodysuits, [...], belt buckles, hosiery, stockings, socks, [...], mitts, leg warmers, sashes, flip-flops, shoes, caps, scarves, [...], hair accessories, head bands, gear bags, sport bags, duffle bags, backpacks, athletic wear, bonnets, boots, watches, fur, [...], lingerie, pyjamas, sleepwear, suits, swimwear, robes, perfume, wallets, slippers, trousers, yoga wear, [...], toques, visors, capes, stoles, culottes, overalls, brassieres, shawls, bathing suits, and parkas.

[13] Mr. Cuglietta attests that during the relevant period, the goods sold in Canada were prominently marked with or associated with the Mark. In support, he provides as Exhibits A and B respectively, photographs of labels and hangtags and photographs of jewellery, clothing and handbags with such labels and hangtags attached. He states that these photographs are accurate representations of how the Mark appeared on the goods that were sold in Canada during the relevant period. I note that the Mark clearly appears on the labels and hangtags, and the goods shown in Exhibit B include necklaces, cardigans, dresses, jackets, zip-ups, pants, shirts, skirts, sweaters, tank tops, vests, belts, scarves, handbags, knitwear, and hoodies.

[14] Mr. Cuglietta attaches as Exhibit C to his affidavit, copies of receipts for sales of the goods at SAKURA stores to customers in Canada during the relevant period. He states that these receipts are only a small sample of the Owner's sale of the goods, all of which he attests bore the Mark, as per Exhibits A and B. He attests that the receipts shown in Exhibit C are examples of the sale of the following goods during the relevant period: women's tops, women's skirts, women's caps, women's jeans, women's cardigans, and choker necklaces. A review of the receipts is consistent with this assertion.

[15] Mr. Cuglietta attests that the Owner's point-of-sale computer system tracks all sales of the goods. In support, he attaches as Exhibit D to his affidavit what he attests is a table

summarizing data accurately extracted from the Owner's point-of-sale computer system regarding sales of the goods to customers in Canada during the relevant period. He explains that the table shows the goods sold by class of product, style of product, quantity sold, price, approximate total dollar amount of sales in the style, and the total number of styles of that class of product. He states that all goods sold in these transactions bore the Mark, and that the sales reflected in Exhibit D are just examples of the goods sold in Canada during the relevant period, and are not a complete list of all such sales. The goods listed in the table are as follows: bag, belt, blazer, blouse, bolero, bracelet, camisole, capri, cardigan, choker, coat, dress, gloves, hat, hoodie, jacket, jeans, jumper, leather, leggings, pants, poncho, scarf, seamless, shorts, skirt, sunglass, sweater, t shirt, tank, top, underwear, and vest.

[16] With respect to the registered services, Mr. Cuglietta attests that each of the Owner's SAKURA stores displays the Mark on the front of the store, and did so during the relevant period. He reiterates that the Owner operates these stores and sells the registered goods at these stores on a retail basis. In support, he provides as Exhibit E to his affidavit, pictures of the Owner's two SAKURA stores in Canada, wherein the Mark is clearly visible on signage for retail stores selling women's clothing and accessories. He states that these pictures accurately represent how the Mark appeared on signage at the Owner's SAKURA stores during the relevant period.

ANALYSIS AND REASONS FOR DECISION

Services

[17] As previously indicated, in accordance with section 4(2) of the Act, 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.

[18] In the present case, the evidence clearly shows the Mark on store signage. Given that it is clear from Mr. Cuglietta's attestations, as well as from the dates on the receipts, that the stores shown in the evidence were operational during the relevant period and sold women's clothing and accessories, I accept that the Owner has shown use of the Mark in the performance of the services in Canada during the relevant period.

[19] Accordingly, the registration for the Mark will be maintained with the respect to the services.

Goods

[20] As previously indicated, Mr. Cuglietta only asserts use of the Mark in association with the following goods, namely:

Women's clothing products (including camisoles, blazers, boleros, capri pants, cardigans, coats, dresses, halter tops, jackets, zip-ups, denim jeans, leather jackets, pants, ponchos, shirts, blouses, shorts, skirts, sweaters, sweat tops, t-shirts, tank tops, tube-tops, underwear, vests, panties, knitwear and hoodies) and accessories (including belts, gloves, hats, purses, handbags, costume jewellery, sunglasses, tote bags and casual bags).

[21] With respect to the specific goods identified above, I accept that the Owner has demonstrated use in association with these goods in compliance with sections 4(1) and 45 of the Act. In this regard, Mr. Cuglietta has provided representative labels and hangtags, sales receipts, sales transaction data, photographs of goods bearing the Mark and of SAKURA stores which clearly show a wide variety of the aforementioned goods available for sale. All of this, coupled with Mr. Cuglietta's sworn statements regarding the labelling of the goods sold and that such evidence is representative is sufficient, in my view, to establish a *prima facie* case of use with respect to each of these goods.

[22] However, although Mr. Cuglietta uses the non-exhaustive term "including" in his attestation of use of the Mark, I am not prepared to conclude that use of the Mark has been shown with respect to goods other than those specifically identified in his aforementioned attestation and represented in the evidence (either through the photographs, listed in the sales transaction data, etc.). Those goods which appear in the evidence that were not specifically listed in Mr. Cuglietta's attestation of use of the Mark are "scarves" and "caps" (see Exhibits B and C).

[23] The non-exhaustive term "including" in Mr. Cuglietta's attestation of use is ambiguous as to what additional registered goods may be intended to be covered by this statement. Furthermore and more importantly, none of the remaining registered goods, with the exception of "scarves" and "caps", appear to be represented anywhere in the evidence. Without further evidence, and due to the lack of a clear statement of use or statements of fact regarding use, it

would be an exercise in speculation as to which of the remaining registered goods may have been sold in association with the Mark during the relevant period.

[24] This is not a situation like the one in *Saks & Co v Canada (Registrar of Trademarks)* (1989), 24 CPR (3d) 49 (FCTD), where there were 28 distinct categories of goods and services and furnishing evidence for all of which would have placed an unreasonable burden on the registered owner. In the present case, the list of relevant goods is relatively small and concerns only a few related categories of goods, such that I do not find it unreasonable to expect the registered owner to furnish some evidence with respect to each of the goods. As previously stated, while the registered owner is not required to engage in evidentiary overkill in order to demonstrate use of its trade mark for the purposes of section 45, there must be *some* evidence upon which the Registrar can conclude that the trade mark has been used in association with each relevant good during the three-year period preceding the date of the notice.

DISPOSITION

[25] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained with respect to the services and amended to delete the following goods in compliance with the provisions of section 45 of the Act:

Women's clothing, namely, [...], shrugs, [...], jumpsuits, [...], tunics, [...], undershirts, [...], raincoats, rain jackets, trench coats, turtlenecks, hot-shorts, track suits, leotards, beach wear, cover-ups, sundresses, loungewear, bodysuits, [...], belt buckles, hosiery, stockings, socks, [...], mitts, leg warmers, sashes, flip-flops, shoes, [...], hair accessories, head bands, gear bags, sport bags, duffle bags, backpacks, athletic wear, bonnets, boots, watches, fur, [...], lingerie, pyjamas, sleepwear, suits, swimwear, robes, perfume, wallets, slippers, trousers, yoga wear, [...], toques, visors, capes, stoles, culottes, overalls, brassieres, shawls, bathing suits, and parkas.

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

Goods:

Women's clothing, namely, camisoles, blazers, boleros, capri pants, cardigans, coats, dresses, halter tops, jackets, zip-ups, denim jeans, leather jackets, pants, ponchos, shirts, blouses, shorts, skirts, sweaters, sweat tops, t-shirts, tank tops, tube-tops, underwear, vests, panties, belts, hats, gloves, caps, scarves, purses, handbags, costume jewellery, sunglasses, tote bags, casual bags, knitwear, and hoodies.

Kathryn Barnett
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

DLA PIPER (CANADA) LLP

FOR THE REGISTERED OWNER

RICHES MCKENZIE & HERBERT LLP

FOR THE REQUESTING PARTY