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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2018 TMOB 121

Date of Decision: 2018-10-26

IN THE MATTER OF A SECTION 45 PROCEEDING

Climatex AG

Requesting Party

and

Northpeak International Inc.

Registered Owner

TMA325,629 for CLIMATEX

Registration

[1] At the request of Climatex AG (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 February 1, 2017 to Northpeak International Inc. (the Owner), the registered owner of registration No. TMA325,629 for the trade-mark CLIMATEX (the Mark).

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

- (1) Polyurethane fabric.
- (2) Children's one-piece and two-piece snow suits.
- (3) Children's jackets and coats.

[3] 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 between February 1, 2014 and February 1, 2017.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act:

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.

[5] 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.

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Ronnie Lubov, President of the Owner, sworn on April 28, 2017.

[7] Both the Owner and the Requesting Party filed written representations; an oral hearing was not requested.

OVERVIEW OF THE EVIDENCE

[8] In his affidavit, Mr. Lubov asserts that, during the relevant period, the Owner used the Mark in association with the registered goods in Canada. He explains that the goods are manufactured overseas to the Owner’s specifications and subsequently retailed in Canada.

[9] In support, Mr. Lubov attaches purchase orders, shipping confirmations and invoices to his affidavit as Exhibits A through D2. For example, Exhibits A, A1 and A2 consist of the following documents:

- Exhibit A is a purchase order by the Owner from its overseas manufacturer, dated February 2, 2015. I note that the purchased goods are described as “girls snowsuit”, and the “Main Hang Tag” field in the order identifies the goods as “Climatex”.
- Exhibit A1 is a shipping confirmation from the Owner’s overseas manufacturer correlating to the Exhibit A purchase order. The goods are identified on the shipping confirmation as “2 pc suit”.
- Exhibit A2 is an invoice from the Owner to Sears Canada, dated July 1, 2015. Although the nature of the goods is not clearly indicated on the invoice, I note that the style codes and quantities correlate to the Exhibit A1 shipping confirmation.

[10] Similarly, Exhibits B, B1 and B2 consist of a purchase order, shipping confirmation and invoice, respectively, all dated within the relevant period and relating to the goods “boys snowsuit”. I note that the shipping confirmation identifies the goods as “2 pc suit”.

[11] Exhibits C, C1 and C2 consist of a purchase order, shipping confirmation and invoice, respectively, all dated within the relevant period and relating to the goods “Girls Jacket”.

[12] Exhibits D, D1 and D2 consist of a purchase order, shipping confirmation and invoice, respectively, all dated within the relevant period and relating to the goods “slicker jacket”. I note that the invoice to Sears identifies the goods as “PU SLICKER”.

[13] In each case, the purchase orders identify the goods as “Climatex”.

[14] Exhibit E to Mr. Lubov’s affidavit consists of four photographs that he describes as “a selection of photographs showing the trade-mark CLIMATEX as it appears on the goods”. The photographs depict three different styles of jackets or coats, all displaying the Mark.

[15] Finally, Mr. Lubov confirms that the Owner’s CLIMATEX-brand products continue to be sold in Canada through the Sears Canada website. Attached as Exhibit F to his affidavit are screenshots of the Sears website showing clothing items that Mr. Lubov confirms correspond to the girls’ snowsuit goods in Exhibit A2.

ANALYSIS

[16] In its written representations, the Requesting Party notes that the exhibited purchase orders and shipping confirmations do not constitute use of the Mark within the meaning of section 4 of the Act. It further notes that the invoices to Sears do not reference the Mark, nor do they identify the goods. As such, it submits that the Owner has failed to show use of the Mark in the normal course of trade as required by section 4(1) of the Act.

[17] However, in the context of a section 45 proceeding, the evidence as a whole must be considered and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)].

[18] In this case, the Owner's evidence as a whole shows representative transfers of children's two-piece snow suits, jackets and coats bearing the Mark as registered in Canada during the relevant period.

[19] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with "Children's ... two-piece snow suits" and "Children's jackets and coats" within the meaning of sections 4 and 45 of the Act.

[20] However, the clothing items identified in Exhibits A and B are described as two-piece snow suits; there is no evidence before me of sales or transfers of one-piece snow suits. Furthermore, the affidavit is silent with respect to goods (1), "Polyurethane fabric". Even if I were to infer that the "PU SLICKER" goods referenced in Exhibit D2 were made of polyurethane fabric, there is no evidence of sales or transfers of such fabric as a good itself apart from the jackets and coats sold to Sears Canada.

[21] As such, I am not satisfied that the Owner has demonstrated use of the Mark with respect to the remaining goods within the meaning of sections 4 and 45 of the Act. The registration will be amended accordingly.

DISPOSITION

[22] In view of all of the foregoing, 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 the following from the statement of goods:

- (1) Polyurethane fabric.
- (2) [Children's] one-piece and [... snow suits].

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

- (2) Children's two-piece snow suits.
- (3) Children's jackets and coats.

Andrew Bene
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

W. Oliver Hunt

For the Registered Owner

MacRae & Co.

For the Requesting Party