

OPIC



CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 91

Date of Decision: 2019-08-28

IN THE MATTER OF A SECTION 45 PROCEEDING

MLT Aikins LLP

Requesting Party

And

Caroline Barrett

Registered Owner

TMA764,973 for Self Made Millionaire

Registration

INTRODUCTION

[1] At the request of MLT Aikins LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on May 11, 2017, to Caroline Barrett (the Owner), the registered owner of registration No. TMA764,973 for the trademark Self Made Millionaire (the Mark).

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

(1) Clothing, namely, casual, beachwear, loungewear, athletic, outdoor winter, ski-wear, exercise, sports, and undergarments.

(2) Footwear, namely, athletic, casual, ski, snowboard, exercise, and outdoor winter.

[3] The notice required the Owner to show whether the trademark 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 May 11, 2014 to May 11, 2017.

[4] The relevant definition of use for goods is set out in section 4 of the Act as follows:

4(1) A trademark 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 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 trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the notice, the Owner furnished her own affidavit, sworn on December 7, 2017, and the affidavit of D. Jill Roberts, a law clerk, sworn on December 6, 2017. Only the Requesting Party filed written representations. Neither party requested an oral hearing.

THE OWNER'S EVIDENCE

Barrett Affidavit

[7] Ms. Barrett attests that she operates a part-time business along with her brother, Nicholas Barrett, selling a line of clothing under the Mark. She explains that during the relevant period and continuing into the present, she has been responsible for all aspects of the business including design, marketing, promotion, and sales. She states that she maintains direct control over the character and quality of goods sold under the Mark and that she is the ultimate decision-maker on all business activities.

[8] Ms. Barrett states that, during the relevant period, she directly promoted, offered for sale and sold t-shirts and hoodies marked with the Mark. She states that based on her experience of selling clothing and her common general knowledge, it is her understanding that both t-shirts and hoodies are considered to be “casual wear, athleticwear and/or sportswear.”

[9] As Exhibit B to her affidavit, Ms. Barrett attaches photographs of various t-shirts and hoodies bearing the words SELF MADE MILLIONAIRE, sometimes in all caps or stylized as “Self Made Millionaire”. Ms. Barrett states that the clothing shown in these images have the same design as clothing that she personally sold to customers during the relevant period. She states that t-shirts were sold for \$20 and hoodies were sold for \$40, and that she and her brother sold approximately \$2,000 worth of clothing during the relevant period. She explains that the clothing was sold to friends, acquaintances, and customers at local events in Burlington, Ontario, and the surrounding area.

[10] In this respect, Ms. Barrett states that she and her brother were vendors at the Sound of Music Festival in Burlington, Ontario, in June of 2014, 2015, and 2016; and that they personally sold t-shirts and hoodies in association with the Mark from a table at the festival’s Downtown Streetfest market. She confirms that this festival is the same as the festival referred to in Ms. Roberts’ affidavit and exhibits, described below. As Exhibit C to her affidavit, Ms. Barrett attaches copies of invoices dated “June/14”, which she states accompanied the sale of t-shirts at the market. The words “Self Made Millionaire” appear on each of the invoices. She explains that the invoices are informal and do not include information about the customers, since in many cases the customers did not ask for invoices.

[11] Further, Ms. Barrett states that for one day in September 2015, she and her brother sold t-shirts and hoodies in association with the Mark at the Krudar martial arts club located in the Kensington Market in Toronto. As Exhibit D to her affidavit, she attaches a photograph of a number of articles of clothing on a table in front of a building, which she states was set out in front of the club. The word “Krudar” appears in a window in the background. As Exhibit E, she attaches copies of a number of further invoices showing sales of t-shirts and hoodies. In some cases, the words “Self Made Millionaire” appear on the invoices. She states that these informal invoices reflect sales made in association with the Mark at this martial arts club.

Roberts Affidavit

[12] Ms. Roberts' affidavit consists primarily of a number of Internet searches she conducted, printouts of which are attached as exhibits to her affidavit. These include the following:

- Exhibits 1 to 5: printouts of a number of trademark registrations. Some of the registered goods for these registrations include sportswear, namely t-shirts and hoodies; others include casual wear, namely t-shirts.
- Exhibits 6 to 7: dictionary definitions from *dictionary.com*, defining "casual wear" as "clothing designed for wear on informal occasions"; and from *oxforddictionaries.com*, defining "casual wear" as "Articles of clothing suitable for informal occasions or situations."
- Exhibits 8 to 16: screenshots from the Wayback Machine located at *www.archive.org* for various pages from the webpage of the Sound of Musical Festival as it appeared in 2014 and 2015.
- Exhibit 17: screenshots from the Wayback Machine from the homepage of the Krudar Muay Thai website located at *www.krudar.com* as it appeared in 2015.

ANALYSIS

[13] As a preliminary matter, I note that the Requesting Party argues that some of the evidence put forward in the Owner's affidavits amounts to hearsay and should not be considered, including Ms. Barrett's statements concerning her brother or her understanding of certain matters, as well as the Wayback Machine evidence.

[14] With respect to the Requesting Party's concerns regarding the reliability of evidence from the Wayback Machine, such evidence has been held to be reliable by the Registrar before [see *ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056, affirmed 2005 FCA 96]. In any event, there is no need for me to consider the Owner's Wayback Machine evidence in this case since, at best, it establishes only that the Sound of Music Festival and the Krudar martial arts club existed during the relevant period, which I am prepared to accept in any event based on Ms. Barrett's sworn statements.

[15] Otherwise, given the summary nature of section 45 proceedings, "concerns with respect to the hearsay nature of evidence can go to weight, rather than admissibility" [*Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18 at para 18]. Therefore, any concerns about

the reliability of Ms. Barrett's statements will be assessed in terms of weight rather than admissibility, as discussed further below.

[16] In the present case, I first note that the Owner has filed no evidence with respect to goods (2), "footwear". As there is no evidence of special circumstances excusing non-use of the Mark before me, the registration will be amended accordingly.

[17] With respect to the remaining "clothing" goods, the Requesting Party first argues that the Owner has not established its normal course of trade. However, I am satisfied that Ms. Barrett's statement that she and her brother sell the goods to friends, acquaintances, and customers at local events in Burlington, Ontario, and the surrounding area, establishes the normal course of trade for the Owner. While Ms. Barrett only provides evidence of two occasions in which goods were sold, it is well established that evidence of a single sale can be sufficient to establish use for the purposes of section 45 expungement proceedings, so long as it follows the pattern of a genuine commercial transaction and is not seen as deliberately manufactured or contrived to protect the registration [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 at para 12]. In this case, Ms. Barrett's statements regarding her business activities are supported by numerous invoices, which are sufficient to demonstrate the requisite pattern of genuine commercial transactions.

[18] The Requesting Party also points out that, in the exhibited photos, the words "SELF MADE MILLIONAIRE" appear to be made of felt and pasted onto the clothing, and that there is no consistency to the layout, capitalization, and font of the words. However, this lack of consistency is irrelevant in this case; it is well established that a registration for a word mark can be supported by use of that mark in any stylized form [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)]. Further, while the Requesting Party argues that the words are used ornamentally rather than to distinguish the Owner's goods, section 45 proceedings are not intended to determine whether a registered trademark is being used descriptively or to distinguish the registered goods [see *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66 and *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. Therefore, the Requesting Party's arguments concerning whether the words are being used to actually distinguish the Owner's goods from those of others are outside the scope of this proceeding.

[19] The Requesting Party also contends that there is “no evidence” to support certain statements in the Barrett affidavit, including that the Owner made approximately \$2,000 in sales of the registered goods during the relevant period, that Ms. Barrett and her brother attended and sold goods at the Sound of Music Festival and the Krudar martial arts club, and that the invoices attached to Ms. Barrett’s affidavit reflected actual sales. However, these facts are provided in sworn statements by Ms. Barrett. Absent evidence to the contrary, an affiant’s sworn statement is to be accepted at face value, and statements in an affidavit must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25]. It is the evidence as a whole that must be considered; dissection of an affidavit in an overly technical manner is inconsistent with the purpose of section 45 proceedings. Accordingly, I accept that the evidence demonstrates that the Owner made approximately \$2,000 in sales of hoodies and t-shirts during the relevant period and that the invoices attached as Exhibits C and E to the Barrett affidavit reflect sales made by Ms. Barrett and her brother at the Sound of Music Festival and at the Krudar martial arts club, respectively.

[20] Finally, the Requesting Party argues that the invoices provided by Ms. Barrett do not establish use of the Mark in association with the goods because there is no evidence that they were presented to customers at the time of transfer, and because the invoices do not clearly correlate the Mark with the goods being sold. However, Ms. Barrett’s affidavit indicates that the invoices were issued only to record sales and in some cases were not asked for by customers. As such, the invoices serve as evidence of sales of the t-shirts and hoodies; because Ms. Barrett’s evidence establishes that the Mark was displayed on the goods themselves, it is not necessary for the purposes of this proceeding whether the invoices also gave notice of association between the Mark and the goods at the time of transfer. Thus, based on the invoices read in conjunction with Ms. Barrett’s sworn statements, I am satisfied that the invoices reflect sales by the Owner of goods bearing the Mark to customers at the Sound of Music Festival and Krudar martial arts club during the relevant period.

[21] Accordingly, I accept that the Owner sold t-shirts and hoodies bearing the Mark in Canada in the normal course of trade during the relevant period. Therefore, the only issue to be determined is whether these sales establish use of any of the registered “clothing” goods. In this respect, I note Ms. Barrett’s statement that it is her understanding that t-shirts and hoodies “are

considered to be casual wear, athleticwear and/or sportswear”, and I note that the evidence depicts a variety of styles of t-shirts and hoodies sold by the Owner, all bearing the Mark. For the following reasons, I agree that the Owner has established use of the Mark in association with the registered goods “clothing, namely casual, [...] athletic, [...] sports”.

[22] First, I accept that “casual” wear encompasses clothing worn during informal occasions based on the definitions attached to the Roberts affidavit, as well as the ability of the Registrar to take notice of dictionary definitions [see *Gervais v CIBC Mellon Global Securities Services Co* (2004), 34 CPR (4th) 571 at para 7; *Shapiro Cohen LLP v Proa*, 2017 TMOB 162 at para 44]. The images of hoodies and t-shirts shown in Exhibit B to the Barrett affidavit are clearly clothing which could be worn during informal occasions.

[23] Similarly, while the Owner provides no definitions with respect to the “athletic” or “sports” clothing categories, a plain reading of the terms would suggest that they encompass clothing that is principally used for sports and athletic activities, but could also be worn casually [for a similar conclusion, see *Gowling Lafleur Henderson v Trio Selection*, 2016 TMOB 77 at para 27]. In this case, I note that the Owner’s t-shirts and hoodies were sold at a martial arts club and that, as noted above, the Owner’s evidence depicts various styles of t-shirts and hoodies, at least some of which I accept could be used in the course of sports or athletic activities and could therefore be considered “sports” or “athletic” clothing.

[24] As such, I find that the Owner’s evidence establishes use of the Mark in association with the registered goods “Clothing, namely, casual, [...] athletic, [...] sports”, within the meaning of sections 4 and 45 of the Act.

[25] However, I am not satisfied that the Owner has established use of the Mark in association with any of the registered “clothing” goods other than “casual”, “athletic”, and “sports”, within the meaning of sections 4 and 45 of the Act. As there is no evidence before me of special circumstances excusing non-use of the Mark in relation to these goods, the registration will be amended accordingly.

DISPOSITION

[26] 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 "..., beachwear, loungewear, [...] outdoor winter, ski-wear, exercise, [...] and undergarments" from goods (1), and to delete the entirety of goods (2).

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

(1) Clothing, namely, casual, athletic, sports.

Gregory Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No Hearing Held

AGENTS OF RECORD

No Agent Appointed

For the Registered Owner

MLT Aikins LLP

For the Requesting Party