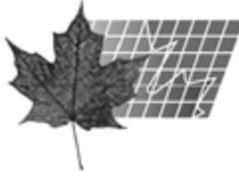


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C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 145

Date of Decision: 2019-12-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Self-Portrait Ltd.

Requesting Party

and

**Hardwater Fashion Inc./Les Modes
Hardwater Inc.**

Registered Owner

TMA557,021 for PORTRAIT

Registration

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA557,021 for the trademark PORTRAIT (the Mark), owned by Hardwater Fashion Inc./Les Modes Hardwater Inc.

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

Ladies', misses', juniors' and girls' dresses, pant suits, blouses, shirts, skirts, beach pyjamas, coats, raincoats, car coats, hats, bathing suits, slacks suits, playsuits, pinafores, jackets, vests, jodhpurs, shorts, jumpers, pedal pushers and culottes; belts, buttons for clothing, buckles for clothing, braids and slide fasteners.

[3] For the reasons that follow, I conclude that the registration ought to be maintained only with respect to the registered goods "coats" and "jackets".

INTRODUCTION

[4] At the request of Self-Portrait Ltd. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on June 28, 2017, to Hardwater Fashion Inc./Les Modes Hardwater Inc. (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the trademark has been used in Canada in association with 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 28, 2014 to June 28, 2017.

[6] 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.

[7] On September 28, 2017, in response to the Registrar's notice, the Owner furnished the affidavit of Jeffrey Langleben, sworn on September 28, 2017. Both parties filed written representations and were represented at an oral hearing.

PRELIMINARY MATTER: RETROACTIVE EXTENSION OF TIME TO FILE EVIDENCE

[8] At the outset, I note that there are documents referred to in Mr. Langleben's affidavit that are missing from the exhibits; namely, "Instructions for Production" documents in Exhibits 14, 17, and 21. At the hearing, counsel for the Requesting Party advised that these documents were included in its copy of the Owner's evidence.

[9] However, upon review of the evidence at the hearing, it also came to light that a number of pages of invoice evidence had been omitted from yet another exhibit (Exhibit 12) of the Requesting Party's copy of the Owner's evidence, but had been included in the Registrar's copy of the Owner's evidence.

[10] These missing documents do not form part of the evidentiary record. As the Owner's deadline to file evidence in this proceeding expired on September 28, 2017, the Owner is required to apply for a retroactive extension of time pursuant to section 47(2). Such an extension cannot be granted unless the prescribed fee is paid and the Registrar is satisfied that the failure to do the act or to apply for the extension of time within the relevant deadline was not reasonably avoidable. At the hearing, Ms. Monique Couture, counsel for the Requesting Party, graciously consented to the Owner being granted such an extension for the missing Exhibit 14, 17, and 21 documents, which the Requesting Party had received but the Registrar had not.

[11] On September 20, 2019, the Owner requested a retroactive extension of time to file evidence. The appropriate fee was paid and the Owner explained that the oversight was unintentional and was not noticed when the documentation was verified prior to being submitted. I note that there continue to be some issues with the materials submitted by the Owner; for example, it appears that the Owner submitted documents pertaining to Exhibits 13 and 16, which are copies of materials already in evidence, rather than the missing documents from Exhibits 14 and 17. Nevertheless, I am satisfied that the failure to file the missing materials was not reasonably avoidable. The retroactive extension of time is therefore granted until September 20, 2019, and the materials submitted by the Owner will be made of record. In any event, I am satisfied that these documents will not be material to the outcome of my decision, since they pertain only to goods identified as "coats"; as discussed below, the Owner's evidence is sufficient to establish use of the Mark in association with "coats" even without these materials.

THE OWNER'S EVIDENCE

[12] In his affidavit, Mr. Langleben states that he has been president of the Owner since its inception; prior to that, he was president of importation of Fen-Nelli Inc. [Fen-Nelli] and president of Fen-Nelli Fashions Inc./Modes Fen-Nelli Inc. [Fen-Nelli Fashions]. He explains that Fen-Nelli Fashions and Fen-Nelli amalgamated in 2012, and that the Owner is the successor of these entities. He further explains that the Mark was initially used by Fen-Nelli Fashions since 2002, and then by Fen-Nelli, before it was transferred to the Owner on May 1, 2017. Mr. Langleben states that the Owner and its predecessors in title have been involved in the manufacture and importation into Canada of the registered goods, which have been and continue

to be distributed to retailers and distributors across Canada in the ordinary course of business, and have been sold in every province of Canada.

[13] Mr. Langleben states that each of the registered goods had “a label and/or a hang-tag affixed” to it at the time that the registered goods were delivered to retail customers and at the time that they were offered for sale to the public. As Exhibits 2 and 3, he attaches photos of labels and hang-tags, respectively. Each label and hang-tag includes the word “PORTRAIT” alongside a design element in the form of a stylized letter “P” or alongside the words “PAR/BY FEN-NELLI”.

[14] Exhibits 4, 6, 8, and 10 to 17 include invoices showing sales by the Owner’s predecessors to retailers in Canada. I note, however, that only Exhibits 4, 10, and 12 to 16 include invoices dated within the relevant period. Each invoice includes the product description “Jackets” for all listed items; the items are otherwise identified only by style number. While the Mark does not appear on the invoices themselves, Mr. Langleben states that, due to his knowledge of the style numbers used on the invoices, he is able to indicate which of the listed items are associated with the Mark.

[15] Exhibits 5, 7, 9, 11 to 13, 16, 18, 19, and 22 include “Instructions for Production” documents showing sketches of garments and instructions for manufacturers. Mr. Langleben explains that it has been the practice of the Owner and their predecessors in title to prepare sketches of its goods about one year in advance of the season during which the goods would be sold to the public. Each document includes a column entitled “Labels”, with the word “Portrait” appearing in the “Neck” row. The documents include dates, product descriptions, and style numbers. A few of these documents are accompanied by photographs of the garments.

[16] Many of the exhibits include both Instructions for Production documents and invoices. In his affidavit, Mr. Langleben correlates some of the product style numbers listed on the invoices with the garments shown in the Instructions for Production documents; further to this, I note that in many cases, the same style number appears on both the invoices and the corresponding Instructions for Production documents. In particular, I note that Exhibits 13 and 16 both include invoices dated within the relevant period, as well as corresponding Instructions for Production documents for garments identified as “coats” in their product descriptions. The same style

numbers appear in the Instructions for Production documents and in the corresponding invoices in these exhibits.

[17] While some of the Instructions for Production documents show garments identified as “car coats” or “jackets”, each such document corresponds to an invoice dated outside the relevant period. In some cases, Mr. Langleben states that these documents refer to garments that the Owner is in the process of marketing in Canada and intended to sell after the relevant period. However, all of the invoices dated within the relevant period correspond to garments identified simply as “coats”, with the exception of the invoices attached as Exhibit 15. The Exhibit 15 invoices are not correlated with any other documentary material; instead, Mr. Langleben states that these invoices show sales of “PORTRAIT wares conforming to style A4230”, without further explanation. As with all of the invoices, the word “Jackets” appears in the product description heading for all items listed on the Exhibit 15 invoices.

[18] Mr. Langleben states that he is informed from his review of corporate records and from conversations with sales representatives and the Owner’s retail customers that many thousands of garments bearing the Mark have been purchased by customers in Canada from the retail customers between 2002 and the present. He confirms that there were sales in association with the Mark during the relevant period of coats, raincoats, car coats, and jackets, but not of pants, pant suits, slacks, playsuits, shorts, pedal pushers, belts, or hats. He explains that these latter goods were sold in association with different trademarks “because special programs have been made for particular retailers.”

ANALYSIS

[19] At the outset, I note that the Owner concedes that there were no sales of the goods “Ladies’, misses’, juniors’ and girls’ dresses, pant suits, blouses, shirts, skirts, beach pyjamas, [...] hats, bathing suits, slacks suits, playsuits, pinafores, [...] vests, jodhpurs, shorts, jumpers, pedal pushers and culottes; belts, buttons for clothing, buckles for clothing, braids and slide fasteners” in association with the Mark during the relevant period, and has put forward no special circumstances that would excuse such non-use. Thus, the only goods at issue are coats, raincoats, car coats, and jackets.

[20] With respect to these remaining goods, the Requesting Party submits that the Owner has only attempted to establish use of the Mark in association with coats, car coats, and jackets, and that in any event, the evidence with respect to these goods is not sufficient. In this regard, the Requesting Party points to a number of deficiencies in Mr. Langleben's affidavit; namely, that it includes inadmissible hearsay, that the trademark displayed on the labels and hang tags is not the registered Mark, that Mr. Langleben does not specify that labels or hang tags were used in association with certain goods during the relevant period, and that the documentary evidence is otherwise insufficient to establish use of the Mark in association with any of the registered goods. While the Requesting Party also notes that Exhibit 19 was not commissioned in its copy of the evidence, the exhibit is properly commissioned in the affidavit submitted to the Registrar. The Requesting Party's remaining submissions will now be considered in turn.

Hearsay

[21] The Requesting Party submits that Mr. Langleben's statements regarding sales by its retail customers, or the display of the Mark at the retail level, must be disregarded as inadmissible hearsay given that the Owner and its predecessors are engaged only in the manufacture, importation, and distribution of goods. However, it is well established that, 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 Mr. Langleben's statements in the analysis that follows will be assessed in terms of weight rather than admissibility.

Deviation

[22] The Requesting Party submits that the trademarks shown in the Owner's evidence are composite design and composite word marks, rather than the Mark as registered, as they include the word "PORTRAIT" alongside the words "PAR/BY FEN-NELLI" or alongside a stylized letter "P" design element.

[23] Use of a word mark in combination with additional words or design elements qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark

per se as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. Here, with respect to the Mark as it appears alongside the words “PAR/BY FEN-NELLI”, I am satisfied that the average buyer would understand that “FEN-NELLI” is either the Owner’s house mark or trade name and thus view “PORTRAIT” as a mark separate from the additional matter [for similar outcomes, see *Brooks v Ranpro Inc*, 2011 TMOB 74; *Gowling Lafleur Henderson LLP v Ten Ren Tea Co*, 2012 TMOB 21; *Bennett Jones LLP v Pirelli Tyre SpA*, 2013 TMOB 37]. With respect to the inclusion of the stylized letter “P” design element, the Mark is separate and apart from the design element above it, and nothing prevents a word mark in such cases from being displayed in combination with design elements [see *Cox & Palmer v PB Brands Inc*, 2018 TMOB 15 at para 22]. As such, I am satisfied that either formulation of the Mark would constitute use of the Mark as registered.

Labels and Hang Tags

[24] The Requesting Party submits that Mr. Langleben fails to assert that the labels and hang tags bearing the Mark were used on the goods during the relevant period. However, as noted above, Mr. Langleben’s affidavit clearly states that each of the registered goods had “a label and/or a hang-tag affixed” to it at the time that the registered goods were delivered to retail customers and at the time that they were offered for sale to the public. While it may be that Mr. Langleben’s statements regarding how the Mark was displayed when the goods were offered for sale to the public lack reliability, I have no difficulty concluding that Mr. Langleben would have direct knowledge as to whether the labels or hang tags were attached to the goods at the time of transfer of possession from the Owner to its retail customers.

[25] The law is clear that the use of a trademark at any point along the chain of distribution is sufficient to demonstrate use as defined in section 4 of the Act, and that such use will accrue to the benefit of the owner provided that the goods bearing the trademark originate from the owner [*Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD); *Osler, Hoskin & Harcourt v Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD)]. As such, given Mr. Langleben’s clear sworn statements on this matter, I accept that labels or hang tags bearing the Mark that were attached to any of the registered goods delivered to retail

customers during the relevant period would establish notice of association between the Mark and those goods.

Documentary Evidence

[26] The Requesting Party submits, and I agree, that the Instructions for Production documents do not, in themselves, establish use of the Mark. While I accept Mr. Langleben's statements that it has been customary for the Owner and its predecessors to provide sketches of their goods approximately a year in advance of their potential sale, the existence of these sketches does not establish that such sales actually took place. However, Mr. Langleben's affidavit correlates many of these documents with items listed in the invoice evidence. As such, the utility of the Instructions for Production documents lies in clarifying the nature of the goods listed in the invoice evidence as having been sold during the relevant period.

[27] With respect to the Owner's invoice evidence, the Requesting Party notes that the products listed therein are identified by style number only, with no indication as to whether they displayed the Mark, and submits that a negative inference should be drawn, as "we are invited to rely on the affiant's own knowledge of style numbers to be assured that these display the [Mark]". In its oral representations, the Requesting Party argued that it strains credulity that the affiant in 2017 could recall which style number corresponded to which product in 2014, especially given the change in ownership and the fact that the Owner and its predecessors manufactured goods in association with multiple trademarks.

[28] The Owner notes that Mr. Langleben's affidavit explains that it is not the practice of the Owner or its predecessors to indicate use of trademarks on its commercial documents. It further notes that Mr. Langleben was the President of the Owner and its predecessors, and has been involved with each of those entities on a full-time basis. In addition, the Owner refers to Mr. Langleben's confirmation in his affidavit that each of his statements is true to his personal knowledge, and that he has personally verified that the materials, documents, and exhibits accurately reflect the record of the Owner and its predecessors.

[29] There is nothing in Mr. Langleben's affidavit that would cause me to doubt his credibility or the reliability of his sworn statements. 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]. Here, I agree with the Owner that it is not far-fetched for a longtime businessperson to know the style numbers of products sold in association with particular trademarks. Accordingly, I accept that the statements in Mr. Langleben's affidavit accurately reflect which of the style numbers in the invoices correspond to goods sold in association with the Mark.

[30] In any event, I note that in certain cases, notably Exhibits 13 and 16, the style numbers appearing on the Instructions for Production documents also appear on the corresponding invoices. Further, those Instructions for Production documents include a "Label" column containing the word "Portrait", and list "Coat" in the product description. Additionally, I note that the Owner has provided a sworn statement that the aforementioned labels or hang tags accompanied all goods described in his evidence at the time of transfer to the Owner's retail customers. Because the invoices in Exhibits 13 and 16 show sales within the relevant period to customers in Canada, I am satisfied, based on these pieces of evidence, that the Owner has established use of the Mark in association with the registered goods "coats" within the meaning of sections 4 and 45 of the Act.

[31] As discussed above, all of the invoices describe the items sold only as "jackets", even those invoices identified by Mr. Langleben as corresponding to Instructions for Production documents identifying the goods sold as "coats" or "car coats". This suggests to me that the term "jacket" is being used as a broader category on the invoices encompassing other, more specific descriptors such as "coats" and "car coats". Nevertheless, as discussed above, I note that Exhibit 15 shows sales within the relevant period of a product identified by Mr. Langleben as "PORTRAIT wares conforming to style A4230", described only as a "jacket" in the invoice and not otherwise described in other documents. Because this product is described in Mr. Langleben's evidence only as a "jacket", and because of Mr. Langleben's sworn statement that each garment referred to in Exhibits 4 to 22 was accompanied by a label or hang tag displaying the Mark at the time of transfer to the Owner's retail customers, I am also satisfied that the Owner has established use of the Mark in association with the registered goods "jackets" within the meaning of sections 4 and 45 of the Act.

[32] Some of the other Instructions for Production documents include the product description “car coat”; however, none of these documents correspond to invoices dated within the relevant period. Accordingly, I cannot find that the Owner has established use of the Mark in association with these goods within the meaning of sections 4 and 45 of the Act.

[33] Finally, because none of the documentary evidence includes the descriptor “raincoat”, and because Mr. Langleben has not correlated raincoats with any of the style numbers in the evidence, I cannot conclude that the Owner has established use of the Mark in association with this good within the meaning of sections 4 and 45 of the Act. While it may be that some of the coats shown to have been sold during the relevant period could conceivably be used as raincoats, use evidenced in association with one specific good cannot generally serve to maintain multiple goods within the statement of goods, as the Owner is required to provide evidence of use for *each* of the registered goods [see *John Labatt; Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD)].

[34] The Owner has not put forward any special circumstances which would excuse non-use of the Mark in association with the registered goods “car coats” and “raincoats”. While Mr. Langleben states that the Owner intended to sell some of the “car coat” goods after the relevant period, the law is clear that a continuing intention to use a trademark cannot amount to special circumstances on its own, as articulated by the Federal Court of Appeal in *Scott Paper Ltd v Smart & Biggar*, 2008 FCA 129:

[28] It is apparent from this analysis that a registrant’s intention to resume use of a mark which has been absent from the marketplace, even when steps have been taken to actualize those plans, cannot amount to special circumstances which excuse the non-use of the trade-mark. The plans for future use do not explain the period of non-use and therefore, cannot amount to special circumstances. No reasonable construction of the words used in section 45 could lead to that conclusion.

[35] As the Owner has put forward no other circumstances to excuse non-use of the Mark in association with “car coats” and “raincoats”, these goods will be removed from the registration.

[36] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “coats” and “jackets” within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[37] 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 “Ladies’, misses’, juniors’ and girls’ dresses, pant suits, blouses, shirts, skirts, beach pyjamas, [...] raincoats, car coats, hats, bathing suits, slacks suits, playsuits, pinafores, [...] vests, jodhpurs, shorts, jumpers, pedal pushers and culottes; belts, buttons for clothing, buckles for clothing, braids and slide fasteners” from the list of registered goods.

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

Coats, jackets.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2019-09-18

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