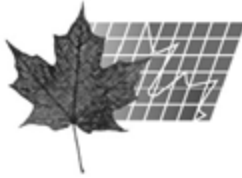


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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 63**

**Date of Decision: 2020-03-31**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Aird & Berlis LLP**

**Requesting Party**

**And**

**Galerie De Pop Co., Ltd.**

**Registered Owner**

**TMA887,596 for SAGE DE CRÊT  
DESIGN**

**Registration**

INTRODUCTION

[1] At the request of Aird & Berlis LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on November 8, 2017, to Galerie De Pop Co., Ltd. (the Owner), the registered owner of Registration No. 887,596 for trademark SAGE DE CRÊT Design (the Mark), shown below:

**SAGE DE CRÊT**

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

Casual clothing, athletic clothing, baby clothing, children's clothing, business clothing, dress clothing, outdoor winter clothing, clothing namely, suits, jackets, skirts, trousers, overcoats, topcoats, raincoats, cardigan jackets, sweaters, waistcoats, blouses, sport shirts, t-shirts, hosiery, socks, stockings, shawls, scarves, ear muffs, belts; footwear, namely shoes, boots, sandals and slippers; headwear, namely hats and caps; sports headgear.

[3] For the reasons that follow, I conclude that the registration ought to be maintained in part.

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with the goods 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 November 8, 2014 to November 8, 2017.

[5] 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.

[6] It is well established that bare statements that a trademark is in 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)].

[7] On February 5, 2018, in response to the Registrar's notice, the Owner furnished a notarized document purporting to be an affidavit of Tsukasa Kobayashi. That document was not made of record as it did not appear to have been sworn before an individual authorized to administer oaths. The Owner was then granted a retroactive extension of time to furnish evidence

until September 8, 2018. On August 21, 2018, the Owner furnished the affidavit of Seiichi Inomata, sworn August 7, 2018. That document appears to have been properly sworn and was accordingly made of record. Only the Owner filed written representations. An oral hearing was not requested.

#### THE OWNER'S EVIDENCE

[8] Mr. Inomata states that he is the General Manager of the Business Management Department of the Owner, a Japanese corporation. He states that the Owner uses the Mark in association with each of the registered goods, which he refers to collectively as the “SAGE DE CRÊT goods”. He explains that the Owner uses the Mark in association with these goods in several ways, including on labels attached to its goods. As Exhibit B, he attaches photographs of shirts and jackets bearing labels that display the Mark. Mr. Inomata states that these photographs are representative of how the Mark is used on all the registered goods.

[9] Mr. Inomata states that the Owner manufactures the registered goods according to its designs and standards, and that it does business in Canada through its United States subsidiary (Galerie U.S.). He explains that Galerie U.S. makes sales of the registered goods to Canadian buyers, and then orders the goods directly from the Owner, who manufactures and ships the purchased items, often directly to the Canadian buyer.

[10] Mr. Inomata states that the Owner “has sold the SAGE DE CRÊT Goods in Canada, during the [relevant period]”. As an example, as Exhibit C through E, Mr. Inomata attaches purchase orders, an invoice, and a packing list relating to a transaction between the Galerie U.S. and the retailer Simons, located in Québec City, which occurred in January 2016. The goods are identified by product codes in all three documents; the invoice and packing list describe the goods as “JACKET (WOVEN)”, “PANTS (WOVEN)”, “COAT (WOVEN)”, and “SHIRT (WOVEN)”. I note that the words SAGE DE CRET appear at the top of the product description column in the invoice and packing list. The documents, as well as a Fed Ex shipping label attached as Exhibit F, indicate that the goods in question were shipped from the Owner in Tokyo to Simons in Québec City on January 7, 2016.

[11] Finally, as Exhibit G, Mr. Inomata attaches a copy of an invoice relating to a transaction between Galerie U.S. and an Edmonton-based retailer called Gravity Pope which occurred in February 2015. The invoice is in a similar format to the Exhibit D invoice and shows sales of “PANTS (WOVEN)”, “JACKET (WOVEN)”, “PANTS (KNIT)”, “SHIRT (WOVEN)”, and “T-SHIRT (KNIT)”.

#### ANALYSIS

[12] The Owner submits that Mr. Inomata’s evidence establishes that it uses the Mark in association with each of the registered goods by way of the exhibited labels, and that all of the goods have been sold in Canada during the relevant period. While the Owner points to the two transactions as examples of sales of the registered goods in Canada during the relevant period, it submits that Mr. Inomata’s sworn statements are sufficient to establish use in association with each of the registered goods. In this respect, the Owner submits that documentary evidence such as photographs and invoices is not required with respect to each of the goods, citing *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FCTD) [*Saks*].

[13] The *Saks* principle is only applicable where a registered owner has provided sufficiently detailed evidence, and explained such evidence with sufficient clarity, that the Registrar can logically conclude that a trademark was used in association with each of the goods in the registration [see *Matthew S George v Dr’s Own, Inc*, 2018 TMOB 147 at paras 71-77; *Sim & McBurney v en Vogue Sculptured Nail Systems Inc*, 2020 TMOB 9 at paras 24-25]. I further note that in *Saks*, there were 28 distinct categories of goods and services; to furnish evidence for all of these would have placed an unreasonable burden on the registered owner. In the present case, because the list of goods is relatively short, I find it reasonable to expect the registered owner to furnish some evidence with respect to each of the goods [for similar conclusions, see *Method Law v Boutique Jacob Inc*, 2015 TMOB 5 at paras 23-24; *Fetherstonhaugh & Co v HB Fuller Company*, 2019 TMOB 1 at paras 19-20].

[14] Accordingly, I do not consider *Saks* to be applicable in the present case. Without any corroborative evidence, Mr. Inomata’s statements that the Owner uses the Mark in association with each of the registered goods, and that the Owner “has sold the SAGE DE CRÊT Goods in Canada, during the [relevant period]”, in and of themselves, do not provide a sufficiently detailed

factual foundation upon which I could conclude that the Owner has sold *each* of the registered goods in the normal course of trade during the relevant period.

[15] However, I accept that the evidence pertaining to the transactions with Simons and Gravity Pope establish that the Owner sold jackets, pants, shirts, t-shirts, and coats in Canada during the relevant period, in the normal course of trade. Based on Mr. Inomata's statement that the labels shown in Exhibit B are representative of how the Owner used the Mark in association with all of the registered goods, I am satisfied that notice of association between the Mark and these goods would be given at the time of transfer. I am also satisfied that there is no issue concerning whether the Owner controls the character and quality of its goods sold by Galerie U.S., as Mr. Inomata has provided a clear sworn statement that the Owner manufactures the registered goods itself.

[16] As such, the question to be determined is which of the registered goods can be correlated with the products for which the Owner has shown use. In this respect, I note that "jackets" and "t-shirts" appear in the list of registered goods. Accordingly, I find that the Owner has shown use of the Mark in association with the registered goods "clothing namely, [...] jackets, [...] t-shirts" within the meaning of sections 4 and 45 of the Act.

[17] While the Owner has also provided evidence showing that it has used the Mark in association with pants, shirts, and coats, these items do not appear in the registration, and the Owner did not correlate them with any of the registered goods. It is not for the Registrar to speculate as to the nature of the registered goods [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13; *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 at para 12 (TMOB)]; however, in this case, I am satisfied that the Owner's evidence with respect to these items is sufficient to support use of certain registered goods. I reach this conclusion bearing in mind the principles that 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)]; and that where use in association with a specific good could potentially support two goods in a registration, the more specific registration will be maintained over the more generalized [*Sharp*

*Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD) at paras 14-16; *88766 Canada Inc v Freedom Scientific BLV Group, LLC*, 2019 TMOB 129 at paras 30-31; *DLA Piper (Canada) LLP v Huer Foods Inc*, 2019 TMOB 62 at para 19].

[18] In the absence of further details, I find that use of the listed items “PANTS (KNIT)” and “PANTS (WOVEN)” can be most logically correlated with the registered good “trousers”. With respect to the listed item “SHIRT (WOVEN)”, there is not enough detail to allow me to correlate this item with some of the more specific registered goods such as “sport shirts” or “blouses”; however, I am satisfied that a woven shirt could fall within the ambit of the registered good “Casual clothing”. Similarly, while there is not enough detail to permit me to correlate the listed item “COAT (WOVEN)” with any of the specific types of coat listed in the registration, such as “overcoats”, “topcoats”, or “raincoats”, I am satisfied that a woven coat could logically be considered to be “outdoor winter clothing”.

[19] As such, I am satisfied that the Owner has established use of the Mark in association with the registered goods “Casual clothing”, “outdoor winter clothing”, “jackets”, “t-shirts”, and “trousers” within the meaning of sections 4 and 45 of the Act.

[20] As the Owner put forward no evidence of special circumstances which would excuse non-use of the Mark in association with the remaining registered goods, the registration will be amended accordingly.

#### DISPOSITION

[21] 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 “athletic clothing, baby clothing, children's clothing, business clothing, dress clothing, [...] suits, [...] skirts, [...] overcoats, topcoats, raincoats, cardigan jackets, sweaters, waistcoats, blouses, sport shirts, [...] hosiery, socks, stockings, shawls, scarves, ear muffs, belts; footwear, namely shoes, boots, sandals and slippers; headwear, namely hats and caps; sports headgear.” from the list of registered goods.

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

Casual clothing, outdoor winter clothing, clothing namely, jackets, trousers, t-shirts.

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

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

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Moffat & Co.

For the Registered Owner

Aird & Berlis LLP

For the Requesting Party