



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 38

Date of Decision: 2020-04-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Karol Pawlina

Requesting Party

And

Howard W. Outerbridge

Registered Owner

**TMA363,808 for TOO RAD FOR MOM
AND DAD**

Registration

INTRODUCTION

[1] At the request of Karol Pawlina (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 7, 2017, to Howard W. Outerbridge (the Owner), the registered owner of Registration No. TMA363,808 for the trademark TOO RAD FOR MOM AND DAD (the Mark).

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

T-shirts, tank tops, sweat tops, shorts, sweat pants, trousers and wallets.

[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 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 November 7, 2014 to November 7, 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] In response to the Registrar's notice, the Owner furnished his own affidavit, sworn on June 1, 2018. Neither party filed written representations or requested an oral hearing.

THE OWNER'S EVIDENCE

[8] In his affidavit, the Owner attests that the Mark has been used in association with t-shirts, tank tops, and sweat tops in Canada continuously since July 1987. He explains that while his goods were originally sold to customers through his own retail stores, those stores closed in 1997, and he now sells the goods through third-party retailers. He explains that these retail customers will typically place orders for the goods directly with him by phone or email.

[9] As Exhibit A, the Owner attaches four invoices dated during the relevant period, which he states are representative of sales of "TOO RAD FOR MOM AND DAD products" in Canada. The invoices list sales of t-shirts, tank tops, sweatshirts, and hoodies to retail customers in

Ontario and British Columbia. The Owner's name appears at the top of the invoices together with customer addresses located in Canada. The words "Too Rad" appear before the size and clothing item in the product descriptions.

[10] As Exhibits B and C, the Owner attaches photographs of t-shirts and tank tops with the Mark printed on them. He states that these are the "Too Rad" t-shirts and tank tops listed in the Exhibit A invoices dated June 24, 2015 and August 10, 2015. Similarly, as Exhibit D, the Owner attaches photographs of a sweatshirt, t-shirt, and hoodie with the Mark printed on them. He states that these are the "Too Rad" sweatshirts, t-shirts, and hoodies listed in the Exhibit A invoice dated February 19, 2016. As Exhibit E, the Owner attaches photographs of a t-shirt with the Mark printed on it. He states that this is the "Too Rad" t-shirt listed in the Exhibit A invoice dated April 2, 2017.

ANALYSIS

[11] The Owner only asserts use with respect to the goods "t-shirts", "tank tops", and "sweat tops". As no evidence was adduced to show use with respect to the remaining goods and no special circumstances were put forward to excuse absence of use, the remaining goods will be expunged from the registration. Accordingly, the sole issue to be determined is whether the Owner used the Mark in association with t-shirts, tank tops, and sweat tops within the meaning of sections 4 and 45 of the Act. In this respect, I interpret the registered good "sweat tops" as including sweatshirts and hoodies, bearing in mind the well-established principle that "one is not to be astutely meticulous when dealing with language used in a statement of wares" [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17].

[12] While the Exhibit A invoices only include the words "Too Rad" rather than the Mark as registered, invoices do not need to bear the trademark when the trademark is shown to appear on the registered goods themselves or their packaging. In such cases, the invoices may serve to establish sales. In this case, the Mark is prominently displayed on the clothing items depicted in the photographs in Exhibits B through E, and the invoices in Exhibit A demonstrate the sale of these items.

[13] In particular, use of the Mark in association with the goods “t-shirts”, “tank tops”, and “sweat tops” is demonstrated by the photographs in Exhibits B through E, together with the invoices in Exhibit A. The invoices show sales of t-shirts, tank tops, and sweat tops to retail customers in Canada during the relevant period, while the Exhibit B-E photographs, which the Owner states depict the same goods referenced in the invoices, show that the Mark was displayed on the goods themselves.

[14] Accordingly, I find that the Owner has shown use of the Mark in association with t-shirts, tank tops, and sweat tops within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[15] 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 “shorts, sweat pants, trousers and wallets” from the registration.

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

T-shirts, tank tops, sweat tops.

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 No Hearing Held

AGENTS OF RECORD

Miller Thomson LLP

For the Registered Owner

Karol Pawlina

For the Requesting Party