

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 154

Date of Decision: 2021-01-26

IN THE MATTER OF A SECTION 45 PROCEEDING

Cassels Brock & Blackwell LLP

Requesting Party

and

IW Apparel, LLC

Registered Owner

TMA724,408 for LIBERTY & Design

Registration

INTRODUCTION

[1] At the request of Cassels Brock & Blackwell 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 June 5, 2017 to Williamson-Dickie Holding Company, the registered owner at that time of registration No. TMA724,408 for the trademark LIBERTY & Design (the Mark), shown below:



[2] I note that, subsequent to the issuance of the notice, the Registrar recorded several changes in title of the registration. These changes of title are not at issue in this proceeding. As such, where any distinction is irrelevant, these different owners will simply be referred to as “the Owner” below.

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

Men’s women’s and children’s clothing, namely, overalls, trousers, slacks, jackets, shirts, jeans, blouses, insulated jackets and pants, sweaters, camouflage clothing, namely, jackets, pants, shirts and overalls, gloves and shoes.

[4] The notice required the registered owner to show that it had used the Mark 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 June 5, 2014 to June 5, 2017.

[5] The relevant definition of use for goods is set out in section 4(1) 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 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)].

[7] In the absence of use, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Bill McFarlane, sworn April 2, 2018.

[9] Only the Requesting Party submitted written representations and attended an oral hearing.

THE EVIDENCE

[10] In his affidavit, Mr. McFarlane identifies himself as a President & General Manager with Williamson Dickie Canada Co. He explains that this company is the Canadian division of Williamson-Dickie Manufacturing Company, a U.S.-based manufacturer of workwear, apparel, and accessories, and a licensee of the Mark.

[11] According to Mr. McFarlane, the Owner’s “LIBERTY brand” is used in association with workwear apparel, specifying that “the flagship LIBERTY branded product is bib overalls” [para 4].

[12] He explains that “LIBERTY overalls have been marked with and are still available in the marketplace with three variants of LIBERTY & Design” trademarks, as shown below [para 4]:



(the Mark)



(Liberty Crest Design)

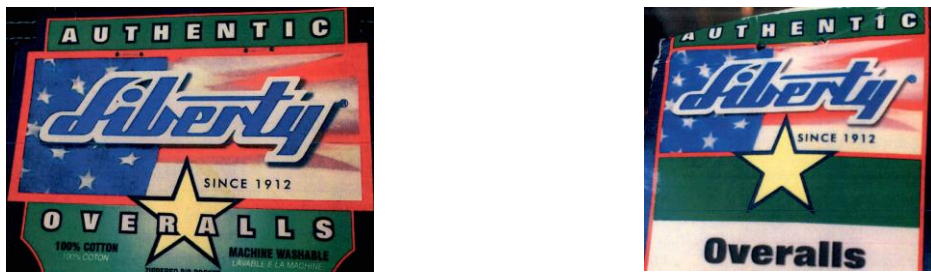


(Liberty 1912 Design)

[13] With respect to Canada, Mr. McFarlane asserts that the Owner has used the Mark “actively and continuously ... since at least as early as 1990” [para 6], and that “LIBERTY & Design branded products are available for purchase online and in retail locations including Marks Work Wearhouse and Walmart” [para 3].

[14] Mr. McFarlane explains that, in Canada, “LIBERTY branded apparel is currently mostly available with the Liberty 1912 Design”, but that there are also some overalls available with a “new Liberty & flag Design” [para 5]. Although not explicit, it appears that Mr. McFarlane

refers to the following design as the “New Liberty & Flag Design” (see below two examples as shown in Exhibit G):



(New Liberty & Flag Design)

[15] In support of the foregoing, the following exhibits are also attached to Mr. McFarlane’s affidavit:

- Exhibit E consists of documents identified by Mr. McFarlane as “Product Development Packs”, that contain information and instructions regarding the design, manufacture and packaging of overalls for the 2012, 2013 and 2014 seasons. While the Mark does not appear in these documents, I note that the Liberty 1912 Design, the Liberty Crest Design and the New Liberty & Flag Design appear in some of the manufacturing instructions.
- Exhibit F consists of an undated printout of the “Liberty Overalls” page from the website of a third-party U.S. retailer, Overalls and Work Clothes Warehouse. The page offers adult and child overalls for sale; the Mark is displayed at the top of the page. There is no indication in the evidence as to whether this website has been accessed by Canadians or whether the overalls were available for shipping to Canada.
- Exhibit G consists of close-up photographs of labels and buttons on overalls that display the New Liberty & Flag Design, the Liberty Crest Design and a variation of the Liberty 1912 Design. Mr. McFarlane explains that these photographs were taken at a Walmart store in Pennsylvania in March 2018.
- Exhibit H consists of a March 2018 printout from the website of Walmart Canada showing Liberty-brand overalls offered for sale; I note that the overalls bear labels with the Liberty 1912 design.
- Exhibit I consists of an undated printout from the website of the Amazon Canada marketplace showing Liberty-brand overalls offered for sale by a third-party; I note that

these overalls also bear labels with the Liberty 1912 design. Mr. McFarlane does not explain the Owner's relation to the seller.

- Exhibit J consists of undated printouts from the website of eBay showing Liberty-brand overalls offered for sale by two different U.S.-based sellers, both offering shipping to Canada. One of the overalls displays a label with the Mark and the other one shows a label with the New Liberty & Flag Design. Mr. McFarlane does not explain the Owner's relation to either seller.

ANALYSIS AND REASONS FOR DECISION

[16] As a preliminary remark, I note that the only goods represented in the evidence are overalls, namely plain blue overalls, without any camouflage design. Therefore, I agree with the Requesting Party that no evidence has been provided to show use of the Mark in association with any of the remaining registered goods, namely "trousers, slacks, jackets, shirts, jeans, blouses, insulated jackets and pants, sweaters, camouflage clothing, namely, jackets, pants, shirts and overalls, gloves and shoes".

[17] With respect to the registered goods "overalls", the Requesting Party argues that, since the affidavit does not disclose any invoices or sales figures, there is "simply no evidence of use" of the Mark.

[18] As noted by the Requesting Party, it is well established that "offering for sale" is not the same as "selling" [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)], and that advertising alone is insufficient to establish use of a trademark in accordance with section 4(1) of the Act [see *Riches, McKenzie & Herbert LLP v Cleaner's Supply Inc*, 2012 TMOB 211].

[19] Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], some evidence of transfer in the normal course of trade in Canada is necessary [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Such evidence can be in the form of documentation like invoices and sales reports, but can also be through clear sworn statements

regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[20] While Mr. McFarlane makes an assertion of “continuous use” of the Mark in Canada since 1990, his affidavit otherwise contains neither clear sworn statements nor invoices, sales reports or other exhibits demonstrating facts which would allow me to infer that there were any transfers of overalls bearing the Mark in Canada, during the relevant period or otherwise.

[21] In the absence of evidence of transfers of overalls, I am not satisfied that the Owner has demonstrated use of the Mark in association with overalls within the meaning of sections 4 and 45 of the Act.

[22] Accordingly, it is unnecessary to deal with the other issues raised by the Requesting Party, namely that some exhibits are either undated or dated outside the relevant period; that the Owner did not demonstrate the requisite control to satisfy section 50 of the Act; and that the trademarks shown in the evidence are not the Mark as registered.

[23] However, on this last issue, I will note that I consider the New Liberty & Flag Design to be an acceptable deviation from the Mark. The Requesting Party submits that the individual elements of the Mark are displayed differently in the New Liberty & Flag Design, and that the new design also contains additional elements. Nevertheless, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I consider the dominant feature of the Mark to be the combination of the word LIBERTY in its distinctive font against a flag background. As such, I find that this dominant feature has been maintained in the evidenced display of the New Liberty & Flag Design. In contrast, I agree with the Requesting Party that the identity of the Mark has not been maintained with respect to the evidenced display of the Liberty 1912 Design and the Liberty Crest Design.

[24] In conclusion, in the absence of evidence of transfers of overalls and given the absence of evidence generally with respect to the remaining registered goods, I am not satisfied that the Owner has shown use of the Mark in association with any of the registered goods within the

meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence of special circumstances excusing non-use of the Mark before me.

DISPOSITION

[25] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-01-11

APPEARANCES

No one appearing

For the Registered Owner

Stephen Selznick

For the Requesting Party

AGENTS OF RECORD

Kirby Eades Gale Baker

For the Registered Owner

Cassels Brock & Blackwell LLP

For the Requesting Party