



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 35

Date of Decision: 2021-02-26

IN THE MATTER OF A SECTION 45 PROCEEDING

John H. Simpson (Shift Law)

Requesting Party

and

Eddie Bauer Licensing Services LLC

Registered Owner

TMA882,140 for SOLID GOOSE DESIGN

Registration

INTRODUCTION

[1] At the request of John H. Simpson (Shift Law) (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 March 20, 2018 to Eddie Bauer Licensing Services LLC (the Owner), the registered owner of registration No. TMA882,140 for the trademark SOLID GOOSE DESIGN, shown below:



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

GOODS:

Back packs; carry-all packs; wheeled and non-wheeled duffel bags; luggage; messenger bags; shoulder bags; sling bags; all purpose carrying bags; wallets; overnight bags; clothing for men, women and children, namely, sweaters, pullovers, shirts, blouses, polo shirts, T-shirts, jeans, pants, socks, leather belts for clothing; outerwear, namely, jackets, wind resistant jackets, parkas, coats, vests, raincoats, mittens, gloves; headwear, namely, hats and caps; footwear, namely, shoes and boots.

SERVICES:

Retail store, online retail store and mail order catalog services featuring clothing, footwear, eyewear, headwear, bags, luggage and bedding.

[3] The notice required the Owner to show that it had used the Mark in Canada in association with each of the goods and services 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 March 20, 2015 to March 20, 2018.

[4] The relevant definitions of use are 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.

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[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 and services specified in

the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] 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.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Domenick Gallo, the Owner's Vice President and General Counsel, sworn October 10, 2018.

[8] Only the Owner submitted written representations. No oral hearing was held.

THE EVIDENCE

[9] The Owner is a retailer that sells a range of clothing, headwear, footwear, luggage and related goods through its own retail stores in Canada and through its website.

[10] In his affidavit, Mr. Gallo asserts use of the Mark in association with all of the registered goods and services. In particular, Mr. Gallo states that, during the relevant period, the Owner sold a total of 51,871 goods bearing the Mark to customers in Canada. Attached to his affidavit is a spreadsheet which Mr. Gallo describes as a sales summary report for such goods [Exhibit B]. The spreadsheet shows 51,871 entry lines, each line providing information regarding a particular sale through either a specific retail store in Canada or through the Owner's website. A total of ten unique products are identified in the report, as follows: "Bygone packs"; "Expedition rolling duffel"; "Bygone duffel"; "Convertible sling pack"; "M's Kachess 1/4-zip mock"; "W's Passenger ponte pants"; "M's Powder Search jacket"; "W's Cloud Cap rain jacket"; "M's Snoqualmie Pass boot"; and "M's Snowfoil boot".

[11] Mr. Gallo explains that, during the relevant period, the Mark was associated with the registered goods by being i) marked on the goods themselves; ii) stamped on tags or packaging for the goods; or iii) displayed in photos appearing in catalogues, in brochures or on the Owner's website.

[12] Mr. Gallo also attaches copies of several purchase orders that he explains are representative of orders received by the Owner from customers in Canada during the relevant

period [Exhibit A]. These purchase orders appear to correlate with the products listed in the sales summary.

[13] Also attached to Mr. Gallo's affidavit are numerous exhibits consisting of excerpts from the Owner's catalogues as well as printouts from the Owner's website, *www.eddiebauer.com*, [Exhibits C to K2]. Mr. Gallo confirms that such catalogues were distributed to customers in Canada and the U.S. during the relevant period. The website and catalogues offer a variety of clothing, footwear, headwear, luggage and bedding products for sale. In addition to other products not sold in association with the Mark, the ten aforementioned products are depicted, showing that the Mark was printed or stamped on such goods themselves.

[14] Mr. Gallo explains how the ten products listed in the exhibited sales summary and purchase orders correlate by way of style ID with some of the products depicted in the Owner's catalogues.

[15] By way of example, paragraphs 22 to 25 and Exhibits F to F3 of the affidavit relate to the Owner's "Cloud Cap" rain jackets for women. Mr. Gallo identifies Exhibits F, F1 and F2 as pages from different catalogues and Exhibit F3 as screenshots from the Owner's website. As explained by Mr. Gallo, each exhibit shows that "Cloud Cap" rain jackets were offered for sale, and how the Mark appeared on a tab attached to the zipper pulls of such jackets. The style ID and product description in the catalogue and on the website correspond with how the goods are identified on the purchase orders and sales summary report. According to the information in the sales report, over 12,000 such rain jackets were sold in Canada during the relevant period.

[16] Similar evidence is provided for all ten products identified in the Exhibit B sales summary. This includes Exhibits C1 to C5, which relate to "Passenger" women's pants.

[17] Exhibit C, however, relates to "T-shirts". As explained by Mr. Gallo, Exhibit C consists of excerpts from the Owner's April 2015 catalogue, which shows t-shirts bearing the Mark. I note, however, that Mr. Gallo does not make a clear assertion that the Owner actually sold t-shirts in Canada during the relevant period or otherwise. Furthermore, neither the aforementioned purchase orders nor the sales summary report appear to indicate any sales or transfers of t-shirts. This discrepancy will be addressed below.

[18] I further note that the products identified in the sales summary report as “M’s Kachess 1/4-zip mock” and described by Mr. Gallo as “‘Kachess’ 1/4-zip mockneck men’s pullovers” are also referred to in the exhibited catalogues as “Kachess 1/4-zip mockneck pullover” [Exhibit D2] and “Kachess 1/4-zip mockneck sweater” [Exhibit D3].

[19] With respect to the registered services, Mr. Gallo asserts that, during the relevant period, the Mark was displayed in catalogues, brochures, mailings, at Canadian retail store locations, and on the Owner’s website. In particular, he states that the Mark was displayed in connection with the Owner’s “Adventure Rewards” loyalty program. In this respect, attached as Exhibit L to the affidavit is a page from the Owner’s October 2016 catalogue which advertises the loyalty program. The Mark is displayed at the top of the advertisement.

ANALYSIS – GOODS

[20] For the ten products identified in the exhibited sales summary report, the evidence is extensive and detailed. There is clear evidence of sales in Canada during the relevant period and that such products displayed the Mark at the time of transfer. Unfortunately, neither Mr. Gallo’s affidavit nor the Owner’s representations make any effort to clearly correlate such products with the particular goods as registered. Nevertheless, given a fair reading of the evidence as a whole, I accept that the products sold in association with the Mark (as identified in the sales summary report) correlate with the registered goods as follows:

- “Bygone packs” with “back packs”;
- “Expedition rolling duffel” with “wheeled duffel bags”;
- “Bygone duffel” with “non-wheeled duffel bags”;
- “Convertible sling pack” with “sling bags”;
- “M’s Kachess 1/4-zip mock” with “[clothing for men, namely] sweaters, pullovers” (in this respect, I consider that neither of the two terms is obviously broader than the other);
- “W’s Passenger ponte pants” with “[clothing for women, namely] pants”;
- “M’s Powder Search jacket” with “outerwear, namely, jackets”;
- “W’s Cloud Cap rain jacket” with “outerwear, namely, ... raincoats”;

- “M’s Snoqualmie Pass boot” and “M’s Snowfoil boot” with “footwear, namely, ... boots”.

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

[22] With respect to the registered goods “T-shirts”, there is some indication that t-shirts bearing the Mark were *offered* for sale during the relevant period. Curiously, though, in contrast to the aforementioned goods, neither Mr. Gallo’s statements nor the supporting exhibits demonstrate actual sale or transfers of t-shirts in Canada during the relevant period or otherwise.

[23] On the contrary, Mr. Gallo’s statement that the Owner sold a total of 51,871 goods along with the exhibited sales summary indicate that the report represents an exhaustive list of the goods sold in Canada during the relevant period. However, I am unable to identify “T-shirts” or the like in any of those listings.

[24] Even if I were to accept that the Owner offered t-shirts for sale in Canada during the relevant period, merely offering goods for sale is not sufficient to satisfy section 4(1) of the Act [see, for example, *The Molson Companies Ltd v Halter* (1976), 28 CPR (2d) 158 (FCTD); and *Gowling, Strathy & Henderson v Royal Bank of Canada* (1995), 63 CPR (3d) 322 (FCTD)]. Some evidence of transfers in the normal course of trade in Canada is necessary. In this case, the Owner furnished no evidence of transfers of t-shirts in Canada during the relevant period or otherwise.

[25] With respect to the remaining registered goods, in view of my findings above, there is either no evidence, or any evidence is insufficient to maintain for the broader category.

[26] For example, with respect to the registered goods “wallets”, while Mr. Gallo asserts use with respect to all of the registered goods, I am unable to identify references to any wallet products in the evidence whatsoever, in association with the Mark or otherwise.

[27] On the other hand, with respect to the registered goods “luggage”, while I accept that “wheeled and non-wheeled duffel bags”, “back packs” or even “sling bags” could be characterized as types of luggage, for the Owner to maintain its registration for the broader

category of “luggage” goods, it had to show use in association with such goods otherwise than by reference to the more specific registered goods [per *John Labatt, supra*].

[28] Lastly, I note that the evidence relating to clothing only references men’s or women’s sizes. Nothing in the evidence indicates that the Owner’s clothing products can be characterized as “clothing ... *for children*”, whether in association with the Mark or otherwise.

[29] In view of the foregoing, I am only satisfied that the Owner has shown use of the Mark in association with the following registered goods: “Back packs”; “wheeled and non-wheeled duffel bags”; “sling bags”; clothing for men, women ..., namely, sweaters, pullovers, ..., pants”; “outerwear, namely, jackets, ..., raincoats”; “footwear, namely, ... boots” within the meaning of sections 4 and 45 of the Act. As the Owner has not submitted any evidence of special circumstances excusing non-use of the Mark, the registration will be amended accordingly.

ANALYSIS – SERVICES

[30] With respect to the registered services, I accept that the evidenced display of the Mark in association with the Owner’s loyalty program demonstrates use of the Mark in association with the Owner’s retail services generally.

[31] However, while Mr. Gallo asserts use with respect to all of the registered services, I am unable to identify references to any services featuring “eyewear” in the evidence, in association with the Mark or otherwise.

[32] Accordingly, I am only satisfied that the Owner has demonstrated use of the Mark in association with the registered services “Retail store, online retail store and mail order catalog services featuring clothing, footwear, ... headwear, bags, luggage and bedding” within the meaning of sections 4 and 45 of the Act. As the Owner has furnished no evidence of special circumstances excusing non-use of the Mark in association with such services featuring “eyewear”, the registration will be amended accordingly.

DISPOSITION

[33] 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 “eyewear” from the statement of services and the following from the statement of goods:

Carry-all packs; ... luggage; messenger bags; shoulder bags; ... all purpose carrying bags; wallets; overnight bags; [clothing for ...] children, ... shirts, blouses, polo shirts, T-shirts, jeans, ... socks, leather belts for clothing; ... wind resistant jackets, parkas, coats, vests, ... mittens, gloves; headwear, namely, hats and caps; ... shoes ...

[34] The amended statement of goods and services will be as follows:

GOODS:

Back packs; wheeled and non-wheeled duffel bags; sling bags; clothing for men and women, namely, sweaters, pullovers, pants; outerwear, namely, jackets, raincoats; footwear, namely, boots.

SERVICES:

Retail store, online retail store and mail order catalog services featuring clothing, footwear, headwear, bags, luggage and bedding.

Andrew Bene
Member
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

Osler, Hoskin & Harcourt LLP

For the Registered Owner

John H. Simpson (Shift Law Professional Corporation)

For the Requesting Party