



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 76

Date of Decision: 2021-04-22

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar LLP

Requesting Party

and

Kings Landing Limited

Registered Owner

TMA387,969 for PLANET

Registration

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA387,969 for the trademark PLANET (the Mark), owned by Kings Landing Limited (the Owner).

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

GOODS

- (1) Coats, raincoats, blazers, slacks, shirts, skirts, suits, jackets, knitted waistcoats, cardigans, sweaters, pullovers, scarves and belts (for wear), all for women and girls.
- (2) Jewellery and watches; handbags, clutch bags, evening bags, purses, wallets, umbrellas.
- (3) Jewellery and watches.
- (4) Handbags and umbrellas.

SERVICES

(1) Retail sale of jewellery, watches, handbags, clutch bags, evening bags, purses, wallets, umbrellas, formalwear, business attire, high-fashion articles of clothing and ready-made garments, suits, waistcoats, coats, raincoats, blazers, jackets, trousers, skirts, shirts, blouses, vests, t-shirts, cardigans, sweaters, jumpers, pullovers, scarves, shawls, clothing belts, hats, formal footwear, evening footwear, beach footwear, casual footwear, slippers.

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

THE PROCEEDING

[4] On December 10, 2018, the Registrar of Trademarks sent a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Style Group Brands Limited (Style), a predecessor-in-title of the Owner. The notice was sent at the request of Smart & Biggar LLP (the Requesting Party).

[5] The notice required Style to furnish evidence showing that it had used the Mark in Canada, at any time between December 10, 2015 and December 10, 2018 (the Relevant Period), with respect to each of the goods and services specified in registration No. TMA387,969. If the Mark had not been so used, Style was required to furnish evidence providing the date when the Mark was last used in Canada and the reasons for the absence of use since that date.

[6] The relevant definitions of “use” are set out in section 4 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 trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trademarks. The expression “clearing deadwood” has often been used to describe these proceedings. The threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD); *Austin Nichols &*

Co v Cinnabon, Inc (1998), 82 CPR (3d) 513 (FCA)]. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the trademark was used in association with each of the registered goods and services at any time during the relevant period [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. Mere assertions of use are insufficient to prove use of the trademark [*Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 45 CPR (2d) 194 (FCTD), aff'd (1980), 53 CPR (2d) 62 (FCA)].

[8] The evidence filed in response to the Registrar's notice consists in the affidavit of Brenda Rostron, sworn June 27, 2019, with accompanying Exhibits "A" to "C".

[9] Both parties filed written representations. No hearing was held.

PRELIMINARY REMARKS

[10] Although inconsequential in this proceeding, I note that the footnotes to the registration page show the following changes of ownership recorded on July 24, 2019: (i) assignment of June 3, 2017 from Style to Style Investment IPR Limited; and (ii) assignment of July 24, 2018 from Style Investment IPR Limited to the Owner.

THE EVIDENCE

[11] Ms. Rostron introduces the evidence in her capacity as Regional Manager for Jacques Vert (Canada) Inc. (Jacques Vert) for the Western Canada sector covering from Manitoba to British Columbia, during the period between January 2016 and September 28, 2018 (which is within the Relevant Period).

[12] Ms. Rostron states that during the above-mentioned period, Jacques Vert was a closely controlled licensee of the trademark owner [para 1]. I note that Ms. Rostron does not identify the trademark owner when introducing the evidence. However, taking her statement at face value, I find it is reasonable to infer that the use of the terms "trademark owner" by Ms. Rostron in her affidavit refers to Style, Style Investment IPR Limited and the Owner as successive owners of the Mark during the period of her employment with Jacques Vert.

[13] Ms. Rostron states that all products sold under the Mark were received directly from the trademark owner in Great Britain and that the quality of the products were completely under the control of the trademark owner [para 2].

[14] Ms. Rostron states that representatives from the owner in Great Britain attended in Canada approximately four times a year, at the boutiques and clearing centers at which the products were sold. These boutiques and clearing centers, which were located within Hudson's Bay stores across Canada, were operated exclusively by Jacques Vert. Ms. Rostron states: "In each location, there was wall signage and posters bearing the word PLANET. The PLANET mark also appeared on all of the racks where the goods were displayed." [para 2].

[15] Ms. Rostron states that "all of the garments and other goods sold in Canada" under the Mark during the above-mentioned period would have borne a label showing the Mark. The Mark would also have appeared on hangers on which the garments were displayed. In support of her statements, Ms. Rolston attaches the following as exhibits to her affidavit [para 3]:

- photographs showing labels and hangtags of the type used on all garments [Exhibit A]. I note that these photographs show labels affixed inside clothing items;
- a photograph of a garment on a hanger typical of those on which garments were displayed [Exhibit B];
- photographs of a scarf bearing the type of labels which would be used on soft goods such as scarves and shawls [Exhibit C].

[16] At paragraph 4 of her affidavit, Ms. Rostron states that between January 2016 and the end of 2018, there were sales of the following products covered by the registration and bearing the Mark: coats, blazers, slacks, shirts, skirts, suits, jackets, cardigans, sweaters, pull-overs, scarves, belts and handbags.

[17] In reference to the retail sale services, at paragraph 5 of her affidavit, Ms. Rostron states that between January 2016 and the end of 2018, Jacques Vert sold products at retail under the Mark. She states that in particular, the sales of PLANET goods included: coats, blazers, slacks, shirts, blouses, skirts, suits, jackets, cardigans, sweaters, pull-overs, scarves, shawls, hats, belts, handbags and purses.

[18] Finally, Ms. Rostron states that the sales figures for the goods sold under the Mark from the end of January 2016 through 2017 and 2018 were in excess of CA\$1,000,000 [para 6].

THE PARTIES' REPRESENTATIONS

[19] What follows is an overview of the parties' representations to which I will return later, where appropriate.

[20] Citing *Aerosol Fillers Inc*, the Requesting Party submits that the ambiguities in the evidence should be construed against the Owner. However, the Requesting Party does not make further representations in this regard. It essentially submits that the evidence does not provide sufficient facts for allowing the Registrar to conclude that the Mark has been used in Canada during the Relevant Period in association with *each* of the registered goods and services.

[21] For its part, the Owner essentially submits that it has met the onus under section 45 of the Act to show its use of the Mark in Canada in association with each of the registered goods and services.

ANALYSIS AND REASONS FOR DECISION

Registered Goods

[22] Considering the evidence in its entirety, including Ms. Rostron's statement at paragraph 4 of her affidavit as to the products that were sold in Canada during the Relevant Period, the exhibited photographs of labels, as well as the sale figures, I conclude that the following goods have been sold in Canada, during the Relevant Period, in association with the Mark:

coats, blazers, slacks, shirts, skirts, suits, jackets, cardigans, sweaters, pullovers, scarves and belts (for wear), all for women and girls, and handbags.

[23] Accordingly, I am satisfied that the evidence establishes use of the Mark in association with these goods, pursuant to sections 4(1) and 45 of the Act. I would add that this is not disputed by the Requesting Party.

[24] I note that Ms. Rostron does not list purses among the goods sold in association with the Mark in paragraph 4 of her affidavit. Yet in the very next paragraph, with respect to retail services, she lists purses as part of the PLANET goods that were sold at retail in association with the Mark. The reason for this discrepancy is not clear. However, given that Ms. Rostron has clearly sworn that purses were sold in association with the Mark during the Relevant Period, and for similar reasons as the other goods listed above, I am satisfied that the evidence also establishes use of the Mark in association with purses, pursuant to sections 4(1) and 45 of the Act. In reaching this conclusion, I am mindful of the principle that evidence in a section 45 proceeding must be considered as a whole, and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[25] However, I agree with the Requesting Party that the evidence fails to establish use of the Mark in association with the following registered goods:

raincoats and knitted waistcoats, all for women and girls; jewellery and watches; clutch bags, evening bags, wallets, and umbrellas (the Remaining Goods).

[26] Indeed, I find that Ms. Rostron's statement at paragraph 4 of her affidavit suggests that the Remaining Goods might *not* have been sold during the Relevant Period. As a result, I cannot conclude that transfer of any of the Remaining Goods bearing the Mark occurred in Canada during the Relevant Period. Furthermore, no breakdown of the sales figures by product is provided by Ms. Rostron. Therefore, contrary to the Owner's contention, I am not satisfied that it may be reasonably inferred from the evidence that each of the Remaining Goods have been sold in Canada during the Relevant Period.

[27] Accordingly, I find that the evidence does not establish use of the Mark in association with the Remaining Goods. Further, the affidavit does not put forward special circumstances to justify the absence of use in association with the Remaining Goods. Thus, I find that the Remaining Goods ought to be deleted from the registration.

Registered Services

[28] Although Ms. Rostron states at paragraph 2 of her affidavit that the Mark was displayed on wall signage, posters or racks displaying the goods, she does not attach any exhibits to her affidavit demonstrating such use.

[29] The display of a retailer's trademark on hangers, labels and the like is often considered sufficient to demonstrate use in association with retail services [see *Coastal Trademark Services v Edward Chapman Ladies' Shop Limited*, 2014 TMOB 80 at para 10, and *Anderson Instrument Company v 3402983 Canada Inc*, 2015 TMOB 98 at para 18]. Accordingly, I accept that the display of the Mark on labels and hangers, as shown by the exhibits to the affidavit, may serve as evidence of use of the Mark in association with retail sale services.

[30] I note that the Requesting Party does not dispute that the evidence establishes use of the Mark in Canada during the Relevant Period in association with the following:

retail sale of handbags, purses, suits, coats, blazers, jackets, skirts, shirts, blouses, cardigans, sweaters, pullovers, scarves, shawls, clothing belts and hats.

[31] Furthermore, considering the affidavit of Ms. Rostron its entirety, including paragraph 5 of her affidavit with respect to the products sold at retail, I am satisfied that the evidence establishes use of the Mark in association with these services, pursuant to sections 4(2) and 45 of the Act.

[32] Thus, the issue becomes whether the Requesting Party rightly submits that the evidence fails to establish use of the Mark during the Relevant Period in association with the following:

retail sale of jewellery, watches, clutch bags, evening bags, wallets, umbrellas, formalwear, business attire, high-fashion articles of clothing and ready-made garments, waistcoats, raincoats, trousers, vests, t-shirts, jumpers, formal footwear, evening footwear, beach footwear, casual footwear, slippers (the Remaining Services).

[33] The Owner submits that the Requesting Party takes too narrow a view of the evidence. It submits that the statement of services should be granted a generous interpretation as opposed to a restrictive one. That said, I note that the Owner's representations concerning the Remaining

Services focus on the retail sale of “...formalwear, business attire, high-fashion articles and ready-made garments... trousers...”.

Retail sale of formalwear, business attire, high-fashion articles and ready-made garments

[34] The Owner submits that many of the items of clothing listed in paragraph 5 of Ms. Rostron’s affidavit constitute formalwear, business attire, high fashion articles of clothing and ready-made garments. In addition, the Owner submits that clothing items that one would consider formalwear, business attire, high fashion articles and ready-made garments are shown in Exhibits A, B and C. I agree that the general terms “formalwear, business attire, high fashion articles of clothing and ready-made garments” could encompass the clothing items referenced and shown in the evidence.

[35] The Registrar has previously held that “in certain cases, statements of services contain overlapping and redundant terms in the sense that the performance of one service would necessarily imply the performance of another” [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 TMOB 7 at para 15; see also *Provent Holdings Ltd v Star Island Entertainment, LLC*, 2014 TMOB 178 at para 22; *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 148 at para 69]. In view of this principle, considering the affidavit of Ms. Rostron in its entirety, I find that the evidence establishes use of the Mark in association with retail sale of formalwear, business attire, high-fashion articles and ready-made garments, pursuant to sections 4(2) and 45 of the Act.

Retail sale of trousers

[36] Relying upon the definition of “slacks” in *The Canadian Oxford Dictionary*, the Owner submits that the statement of Ms. Rostron, at paragraph 5 of her affidavit, that the goods sold at retail included “slacks” is sufficient to maintaining the retail sale of trousers in the registration. I agree.

[37] Indeed, as I may refer myself to dictionaries, I have confirmed that “slacks” is defined as “trousers, esp. for informal wear”, in the aforementioned dictionary. I would add that the Requesting Party does not dispute that the evidence establishes use of the Mark in association

with the retail sale of slacks. Thus, I find that the evidence establishes use of the Mark in association with retail sale of trousers, pursuant to sections 4(2) and 45 of the Act.

Other Remaining Services

[38] As indicated before, the Owner did not make specific representations directed to the other Remaining Services, namely:

retail sale of jewellery, watches, clutch bags, evening bags, wallets, umbrellas, waistcoats, raincoats, vests, t-shirts, jumpers, formal footwear, evening footwear, beach footwear, casual footwear, slippers.

[39] As with the Remaining Goods, Ms. Rostron's statement at paragraph 5 of her affidavit suggests that the other Remaining Services might *not* have been performed or advertised in association with the Mark during the Relevant Period. Further, contrary to the Owner's overall submissions, I consider that the broad reference to Jacques Vert having "sold products" at retail under the Mark is insufficient to infer from the evidence that the Mark has been used in association with the other Remaining Services during the Relevant Period.

[40] In the end, I agree with the Requesting Party that the evidence is not sufficient to establish use of the Mark in association with the other Remaining Services. Further, the affidavit does not put forward special circumstances to justify the absence of use of the Mark in association with these services. Thus, I find that the other Remaining Services ought to be deleted from the registration.

DISPOSITION

[41] In view of all 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 the following registered goods: raincoats, knitted waistcoats, jewellery, watches, clutch bags, evening bags, wallets, and umbrellas.

[42] Likewise, the registration will be amended to delete from the registered statement of services the retail sale of jewellery, watches, clutch bags, evening bags, wallets, umbrellas,

waistcoats, raincoats, vests, t-shirts, jumpers, formal footwear, evening footwear, beach footwear, casual footwear, and slippers.

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

GOODS

(1) Coats, blazers, slacks, shirts, skirts, suits, jackets, cardigans, sweaters, pullovers, scarves and belts (for wear), all for women and girls.

(2) Handbags, purses.

(4) Handbags.

SERVICES

(1) Retail sale of handbags, purses, formalwear, business attire, high-fashion articles of clothing and ready-made garments, suits, coats, blazers, jackets, trousers, skirts, shirts, blouses, cardigans, sweaters, pullovers, scarves, shawls, clothing belts, hats.

Céline Tremblay
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No Hearing Held

AGENTS OF RECORD

Moffat & Co.

FOR THE REGISTERED OWNER

Smart & Biggar LLP

FOR THE REQUESTING PARTY