

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 95

Date of Decision: 2021-05-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Low Murchison Radnoff LLP

Requesting Party

and

IW Apparel, LLC

Registered Owner

**TMA548,032 for SURVIVORS BY
KODIAK & BEAR HEAD DESIGN
(HALF MOON)**

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to Registration No. TMA548,032 for the trademark SURVIVORS BY KODIAK & BEAR HEAD DESIGN (HALF MOON) (the Mark), which is shown below:



[2] During the course of this proceeding, the Registrar updated the registration to record an assignment of the Mark from Kodiak Group Holdings Co. to W-D Apparel Company, LLC and subsequently to IW Apparel, LLC. These changes of title are not an issue in this proceeding. Accordingly, these three entities will be collectively referred to as the “Owner” in this decision.

[3] The Mark is registered for use in association with the goods set out in Schedule A, including “Socks and hosiery for men, women and children.”

[4] For the reasons that follow, I conclude that the registration ought to be maintained, but only with respect to men’s and women’s socks.

THE PROCEEDING

[5] At the request of Low Murchison Radnoff LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on December 28, 2017.

[6] The notice required the Owner to show whether the Mark had 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 December 28, 2014 to December 28, 2017.

[7] The relevant definition of “use” in this case is set out in section 4(1) of the Act as follows:

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.

[8] In the absence of use, the Mark is liable to be amended or expunged unless the absence of use is due to special circumstances that excuse the absence of use [section 45(3) of the Act].

[9] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. As such, the evidentiary threshold that the Owner must meet is quite low [*Lang Michener, Lawrence*

& Shaw v Woods Canada (1996), 71 CPR (3d) 477 (FCTD) at para 9] and evidentiary overkill is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the Mark was used 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) at para 14].

[10] In response to the Registrar's notice, the Owner furnished the affidavit of its Executive Assistant, Shannon Tessier, dated March 27, 2018. Only the Owner submitted written representations. No oral hearing was held.

[11] The Owner filed separate but similar affidavits and written representations in the section 45 proceedings involving Registration No. TMA436,677 for the trademark SURVIVORS, Registration No. TMA465,020 for the trademark SURVIVORS BY KODIAK, and Registration No. TMA511,781 for the trademark SURVIVORS BY KODIAK & DESIGN. These proceedings are the subject of separate decisions.

THE EVIDENCE

[12] With respect to the Owner's normal course of trade, Ms. Tessier explains that the Owner is involved in the manufacture, distribution, marketing and sale of footwear, apparel and accessories for men, women and children. The Owner also operates a licensing program and retail stores.

[13] Ms. Tessier provides a copy of a license agreement between the Owner and 4207602 Canada Inc. (Cameo Knitting). Ms. Tessier attests that the Owner has continuously been exercising control over the character and quality of the licensed articles sold by Cameo Knitting, including men's and women's socks.

[14] With respect to transfer of the registered goods, Ms. Tessier provides copies of invoices, which are dated during the relevant period and which show sales and shipments of goods identified as "LADIES THERMAL", "MEN'S ASSORTED WORK", and "MEN'S THERMAL" from Cameo Knitting to Giant Tiger and Hart Department Store locations in

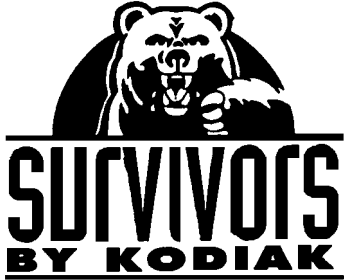
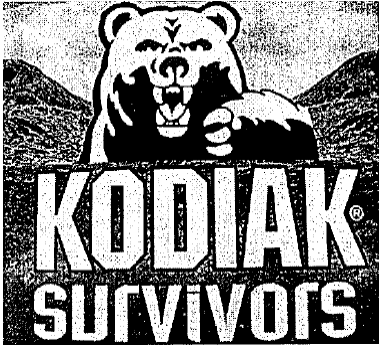
Canada. Ms. Tessier explains that the products listed in the invoices are men’s work socks and men’s and women’s thermal socks.

[15] With respect to display of the Mark, Ms. Tessier provides physical samples and photographs of socks where a variation of the Mark appears on the packaging (namely, the wrapping band) of the products. The items are identified on the packaging as men’s and women’s thermal socks and men’s work socks and the product codes on the packaging match the product codes on the invoices.

ANALYSIS AND REASONS FOR DECISION

[16] Ms. Tessier provides ample evidence by way of invoices, physical samples and photographs to show use with respect to men’s and women’s socks.

[17] Although the Mark as registered is comprised of a stylized bear at the top of the design with visible teeth and a paw with claws coming from the right side located above the word SURVIVORS on one line and the words BY KODIAK on the next line, the trademark that appears on the physical samples and in the photographs is substantially the same bear design located above the word KODIAK on one line and the word SURVIVORS on the next line. Despite these differences, I find that the Mark does not lose its identity and it remains recognizable [per *Canada (Registrar of Trademarks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) (*Honeywell Bull*) at para 5].

The Mark as registered	The trademark in evidence
	

[18] I come to this conclusion by considering the dominant features of the Mark, which are the bear design and the words “SURVIVORS” and “KODIAK”. These dominant features are preserved from the Mark as registered to the trademark in evidence [per *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA) (*Promafil*) at paras 34 to 36].

[19] Applying the principles set out in *Honeywell Bull* and *Promafil*, I find that use of the trademark in evidence constitutes use of the Mark as registered.

[20] As a result, I am satisfied that the Owner has demonstrated use of the Mark, within the meaning of sections 4 and 45 of the Act, in association with men’s and women’s socks.

[21] However, I do not find that the Owner has shown use for any of the remaining registered goods. As the Owner has not provided any special circumstances excusing non-use of the Mark in association with any of the remaining registered goods, they will be deleted from the registration accordingly.

DISPOSITION

[22] Based on the findings above, 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 all of the goods, except for men’s and women’s socks.

[23] The registration will now read as follows: “Socks for men, women.”

Bradley Au
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A: ORIGINAL STATEMENT OF GOODS

Goods:

- (1) Boots, shoes and sandals.
- (2) Jackets, shorts, trousers, skirts, T-shirts, waders, vests, overalls, shirts, underwear, sweaters, raincoats and parkas, hats and jeans.
- (3) Coveralls, smocks, aprons and yoke.
- (4) Sweat shirts and turtle necks.
- (5) Gloves and mittens for men, women and children.
- (6) Socks and hosiery for men, women and children.
- (7) Sleeping bags, tents, backpacks, travel bags and duffle bags.
- (8) Bathrobes, ties, scarves, snowmobile suits, pajamas, night dresses, bands for glasses, sunglasses, belts, suspenders, wallets, passport holders, coin purses, money clips, compounds for preserving, polishing and waterproofing of all forms of leathers, imitation leathers and synthetic materials, laces, shoe trees, bottled water, portable coolers and insulated containers for foods and beverages.
- (9) Clothing, namely blouses, tops, pants, coats, overcoats, overalls, tunics, slacks, sweatshirts, turtle necks and camisoles; headwear, namely caps; slippers.
- (10) Diaries, portfolios, mess kits, school bags and soft cooler bags.
- (11) Sleep pants and sleep shirts, sleep robes and boxer shorts.
- (12) Foot deodorizers, insoles and rubber overshoes.
- (13) Men's and women's industrial work related garments, namely industrial grade coveralls and overalls, industrial grade work smocks and aprons, industrial grade work pants and work jeans, industrial grade work outerwear jackets and parkas, industrial grade work vests, industrial grade work shirts, industrial grade quilted flannel shirts and industrial grade flannels shirts.
- (14) Towels and mats; linen, namely sheets, bed covers, bedspreads, bedspread skirts, comforters, pillows, pillow cases, pillow shams, decorative pillows, quilt covers, blankets and duvet covers; and camping gear tables, chairs and hammocks.

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

HEARING DATE No oral hearing held

AGENTS OF RECORD

Robinson Sheppard Shapiro SENCRL/LLP

For the Registered Owner

Moffat & Co.

For the Requesting Party