



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 195**

**Date of Decision: 2021-08-31**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Banana Republic (ITM) Inc.**

**Requesting Party**

**and**

**Itochu Corporation**

**Registered Owner**

**TMA371,140 for HUNTING WORLD  
& DESIGN**

**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. TMA371,140 for the trademark HUNTING WORLD & DESIGN (the Mark), which is owned by Itochu Corporation (the Owner) and shown below:



[2] The Mark is registered for use in association with the goods set out in Schedule A.

[3] For the reasons that follow, I conclude that the registration ought to be maintained, but only with respect to “Men’s, boy’s, women’s and girl’s sportswear; namely, hats, sweaters, scarves.”

#### THE PROCEEDING

[4] At the request of Banana Republic (ITM) Inc. (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on April 3, 2018.

[5] The notice required the Owner to show use of 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 April 3, 2015 to April 3, 2018.

[6] The relevant definition of “use” in this case is set out in section 4(3) of the Act as follows:

A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[7] 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].

[8] 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 registered 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].

[9] In response to the Registrar's notice, the Owner furnished the affidavit of its Representative Director, Fumihiko Kobayashi, sworn on November 2, 2018. Both parties submitted written representations. No oral hearing was held.

#### THE EVIDENCE

[10] The Owner is one of the largest general trading companies in Japan [para 4]. The Owner regularly imports and exports various classes of goods around the world, including textile and clothing products that are sold at wholesale and retail outlets [para 4].

[11] Mr. Kobayashi asserts that the Mark has been used in Canada in association with men's, boy's, women's and girl's sportswear since at least as recently as 2016 [para 13].

[12] With respect to the export of the registered goods, Mr. Kobayashi provides an invoice and a waybill for a shipment of sweaters, toques/hats, and scarves from Canadian Sweater Company Ltd. (CSC) to the Owner [para 14; Exhibit D]. He explains that these goods were manufactured under licence in Canada by CSC [para 14]. Mr. Kobayashi attests that the Owner maintained control over the character and quality of the goods manufactured by CSC, including those referred to in Exhibit D [para 14]. He explains that the goods in Exhibit D were sold to the Owner and were subsequently exported from Canada during the relevant period [para 14].

[13] With respect to display of the Mark, Mr. Kobayashi provides photographs of sweaters, scarves, and toques, where the Mark appears on patches, tabs, and tags that are attached to the goods [para 15; Exhibit E]. He explains that the photographs are of the goods referred to in Exhibit D [para 15].

#### ANALYSIS AND REASONS FOR DECISION

[14] The Requesting Party submits that there is no use by the Owner under section 4(3) of the Act. The Requesting Party raises several issues on this point, which can generally be organized

into three broad categories: (1) source and control over the goods; (2) display of the Mark; and, (3) export of the registered goods. I will discuss each of these categories in turn.

### **Source and Control over the Goods**

[15] The Requesting Party submits that CSC is the source of the goods, rather than the Owner. To the extent that the Requesting Party is questioning whether the Owner is entitled to the registration, I note that any such issues of ownership are more properly dealt with by way of application to the Federal Court pursuant to section 57 of the Act, given that the validity of a registration is not in dispute in section 45 proceedings [*Ridout & Maybee srl v Omega SA*, 2005 FCA 306 at para 2]. Furthermore, in *Smart & Biggar v Canadian Tire Corporation, Limited*, 2017 TMOB 153 at para 16, the Registrar found that:

[...] the Act does not require the owner of a trade-mark itself be the manufacturer. For example, it may outsource that function or have one or more manufacturer suppliers. In other words, to the extent the question is even relevant in a section 45 proceeding – where a registered owner need only establish a *prima facie* case of use – contrary to the Requesting Party’s suggestion, a registered owner need not be established as the actual manufacturer of goods for it to be considered the source of such goods for purposes of the Act.

[16] With this in mind, it is proper to presume that the registered owner is the source of the goods in question, unless the evidence indicates otherwise, such as a case where the licensee is the source of the goods [*Marks & Clerk v Tritap Food Broker*, 2017 TMOB 35 at paras 18 and 19; *Gowling Lafleur Henderson LLP v Henry Company, LLC*, 2017 TMOB 51 at para 19]. In this regard, the Requesting Party notes that CSC affixed an additional tag with its own trademark on the toque and scarf shown in Exhibit E. However, there is nothing that prevents two trademarks from being used at the same time [*AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (FCTD) at para 9] and, given that Mr. Kobayashi attests that the Owner maintained control over the character and quality of the goods manufactured by CSC [para 14], I am satisfied that the Owner is the source of the goods.

[17] The Requesting Party also submits that there is no evidence of use of the Mark by CSC under a licence from the Owner or that the Owner exercised control over CSC. However, Mr. Kobayashi makes a clear, sworn statement that the goods were manufactured under licence in

Canada by CSC and that the Owner exerts the requisite control over the character and quality of the goods manufactured by CSC [para 14]. This is sufficient to meet the requirements set out in section 50(1) of the Act [*Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102 at para 84, aff'd 2011 FCA 340; see also *Live! Holdings, LLC v Oyen Wiggs Green & Mutala LLP*, 2020 FCA 120 at para 24].

### **Display of the Mark**

[18] The Requesting Party submits that there is no evidence that the Mark was affixed to the goods in Canada before they were exported to Japan. In particular, the Requesting Party submits that it is not known where or when the photographs at Exhibit E were taken and Mr. Kobayashi does not state whether the Mark was affixed to the goods in Canada or Japan. The Requesting Party also notes that the Mark does not appear on the invoice or waybill. However, it is necessary to consider the evidence as a whole. Mr. Kobayashi makes clear, sworn statements that the goods were manufactured in Canada and exported during the relevant period and that the Mark appeared on the goods [paras 14 and 15]. This is supported by the invoice and waybill at Exhibit D, which are dated during the relevant period and show the fulfillment of an order and a shipment of goods from Canada to Japan, as well as the photographs at Exhibit E, which show the Mark on patches, tabs, and tags that are attached to the goods. Mr. Kobayashi attests that the photographs are of the goods referred to in Exhibit D [para 15]. When I consider all of this together, I am satisfied that the Mark was affixed to the goods in Canada when they were sold on August 11, 2016 and before they were exported to Japan on August 23, 2016 [para 14; Exhibit D].

### **Export of the Registered Goods**

[19] The Requesting Party submits that the single export of goods does not show a pattern of genuine commercial transactions in the ordinary course of business. However, unlike section 4(1) of the Act, section 4(3) does not require a transfer of goods in the normal course of trade [*Molson Cos v Moosehead Breweries Ltd* (1990), 32 CPR (3d) 363 (FCTD) at para 21]. In addition, use under section 4(3) can be established by evidence of an isolated commercial transaction [*Moosehead Breweries* at para 23]. In this case, Mr. Kobayashi attests that the goods were sold and subsequently exported from Canada [para 14]. This is supported by the invoice

and waybill at Exhibit D, which show the quantity and dollar amount of the items that were purchased, shipped, and exported. Given that the Owner is a large trading company that is involved in the import and export of clothing products [para 4], I am satisfied that this constitutes a genuine commercial transaction that was in the ordinary course of business for the Owner.

### **Conclusion Regarding Use**

[20] In view of the invoice and waybill at Exhibit D, the photographs at Exhibit E, and Mr. Kobayashi's corresponding description of the goods at paragraphs 14 and 15 of his affidavit, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(3) and 45 of the Act in association with hats, sweaters, and scarves.

[21] These specific goods are listed under a general category of goods (namely, "Men's, boy's, women's and girl's sportswear") and the Requesting Party submits that it is unclear whether the sweaters are for men, women or children. The Requesting Party submits that they appear to be unisex and for adults because of the sizes ("S" to "XL") in the invoice and based on the photographs. However, the Federal Court of Appeal has held that "analyzing the wording of the registration and the general class to which some specifically identified [goods] are associated" lies beyond the scope of section 45 of the Act and the jurisdiction of the Registrar; instead, it is only necessary to find that a trademark is "being used in regard to property specified under the general class" [*Omega* at paras 3 and 4; *Empresa Cubana* at para 79]. In any case, I agree with the Requesting Party that the goods appear to be unisex; however, I do not agree that the goods are for adults only, given that Mr. Kobayashi makes a clear assertion of use for men's, boy's, women's and girl's sportswear [para 4]. As a result, even if I were to analyze the general category of goods, I would nevertheless find that use has been shown for "Men's, boy's, women's and girl's sportswear".

[22] Finally, I agree with the Requesting Party that there is no evidence of export 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 the remaining registered goods, they will be deleted from the registration accordingly.

DISPOSITION

[23] 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 registered goods, except for hats, sweaters, and scarves.

[24] The registration will now read as follows:

- (1) Men's, boy's, women's and girl's sportswear; namely, hats, sweaters, scarves.

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Bradley Au  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

SCHEDULE A: ORIGINAL STATEMENT OF GOODS

**Goods:**

- (1) Perfume, cologne, personal deodorant, hand cream, body cream, sunscreen preparations, bath oil, body powder, astringent lotion and toilet soap.
- (2) Sunglasses.
- (3) Gun cases.
- (4) Jewelry and jewel cases; jewel cases not of precious metal or coated therewith.
- (5) Watches.
- (6) Wallets, bill folds, key cases, coin purses, hand luggage, attaché cases, brief cases, document cases, hand-bags for men and women, saddlery, all being made of leather and canvas and fabric or combinations thereof.
- (7) Men's, boy's, women's and girl's sportswear; namely, jackets, shirts, hats, belts, slacks, pants, shoes, boots, sandals, culottes, shorts, dresses, sweaters, coats, socks, slippers, capes, vests, scarves, gloves, mittens, rainwear.
- (8) Board games.



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

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**HEARING DATE** No oral hearing held

**AGENTS OF RECORD**

Ridout & Maybee LLP

For the Registered Owner

Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L.

For the Requesting Party