



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 208

**Date of Decision:** 2023-12-08

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

**Requesting Party:** HAVE&BE Co., Ltd.

**Registered Owner:** Nasri International Inc.

**Registrations:** TMA970615 for EVERYDAY SUNDAY, and  
TMA897948 for EVERYDAY SUNDAY & Design

## **INTRODUCTION**

[1] This is a decision involving summary expungement proceedings under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration Nos. TMA970615 and TMA897948 for the trademarks EVERYDAY SUNDAY (the Word Mark) and EVERYDAY SUNDAY & Design (the Design Mark; collectively, the Marks). The Design Mark is shown below:



EVERYDAY SUNDAY

MONTRÉAL

[2] The Marks, owned by Nasri International Inc. (the Owner), are registered in association with, *inter alia*, clothing and accessories, bags, towels and pillows. The Word Mark is also associated with the online sale of certain goods. A full list of the goods with which the Marks are registered, as well as the statement of services in the registration for the Word Mark are contained in Schedule A (the Goods and Services, respectively).

[3] For the reasons set out below, I conclude the registrations ought to be maintained in part.

### **PROCEEDING**

[4] At the request of HAVE&BE Co., Ltd. (the Requesting Party), the Registrar of Trademarks issued notices under section 45 of the Act on December 22, 2022, to the Owner.

[5] The notices required the Owner to show whether each Mark was used in Canada in association with each of the Goods (and Services in respect of the Word Mark) specified in the registrations 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 22, 2019 to December 22, 2022 (the Relevant Period).

[6] 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.

(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] 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 a registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. That said, 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)], and 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)].

[8] Where an owner has not shown “use”, a registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[9] In response to the Registrar’s notices, on March 23, 2023, the Owner filed the affidavit of Nathalie Nasri (the Nasri Affidavit), identified as the managing director of the Owner.

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

## **EVIDENCE**

[11] The Nasri Affidavit contains the following statements and exhibits:

- Advertising expenditures for the Goods for the years 2019 to 2022 ranging from approximately \$200,000 to over \$550,000 annually (para 14);
- All Goods sold and marketed by the Owner in Canada during the Relevant Period had either a label and/or hangtag attached depicting at least one of the Marks (para 15, Exhibit 2);

- Randomly selected invoices for sales of the Owner's Goods to Canadian retailers during the Relevant Period along with the statement that all Goods listed in the invoices had either a label and/or hangtag bearing one or the other of the Marks (paras 16 and 17, Exhibit 3);
- Documents containing the annual online sales for each of the years 2019 to 2023 (para 18, Exhibit 4); and
- A copy of the Owner's annual catalogue for 2020 and selected pages from the Owner's 2019, 2020 and 2021 catalogue (para 19, Exhibit 5).

[12] The Nasri Affidavit does not contain any mention of special circumstances relating to any non-use of the Marks during the Relevant Period.

## **ANALYSIS**

### ***Submissions of the Requesting Party***

[13] The Requesting Party submits that the Owner has failed to show that the Marks were displayed on each of the Goods and that the Word Mark was used in association with the Services, failed to provide proof of sale with respect to each of the Goods and Services, and failed to provide any special circumstances that would excuse non-use of the Marks with the Goods, as well as the Word Mark in association with the Services [Requesting Party's written representations, para 12].

[14] More specifically, the Requesting Party submits:

- While the Owner provided evidence in the form of labels and hangtags used in association with the Goods in respect of beachwear and loungewear, there was no evidence as to how the Marks were displayed on the remaining Goods [para 22].
- The Owner's catalogue attached as Exhibit 5 to the Nasri Affidavit shows that Goods were offered for sale during the Relevant Period, however, the Exhibit does not show how the Marks were displayed in association with the Goods [para 22].

- The Goods in the Owner’s catalogue are displayed with other word elements including EVERYDAY BAG, SUNDAY, MESA, CARA, VINTAGE TROPIC, RETRO BEACH and PRESS PAUSE, which are other branding elements that create doubt as to whether the Goods are sold in association with the Marks [para 22].

[15] While I consider the first two points raised by the Requesting Party to have merit and will address them in my assessment below, the last point regarding the possible use of other “branding elements” in association with the Goods is not a relevant consideration. Even if I were to accept that the other word elements associated with the Goods were trademarks, there is nothing in the Act precludes the use of more than one trademark at the same time in association with the same goods or services [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

***Is there evidence of use of the Marks by the Owner during the Relevant Period?***

The Registrations at Issue

[16] There are two registrations at issue in these proceedings – one for the Word Mark and the other for the Design Mark. While the Owner has filed evidence to support use of the Marks during the Relevant Period, in many cases the evidence refers to the use of “one or the other” of the Marks or the Marks collectively, rather than each Mark individually.

[17] Firstly, I consider use of the Design Mark to also be use of the Word Mark, as, in my view, the words EVERYDAY SUNDAY in the Design Mark stand out sufficiently within this composite trademark to maintain its identity and be recognizable as a separate trademark, namely EVERYDAY SUNDAY [see *Nightingale Interloc Limited v ProDesign Limited*, [1984] TMOB No 52, 2 CPR (3d) 535 at paras 7-8; *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA*, 1985 CanLII 5537 (FCA)].

[18] Secondly, as noted by the Requesting Party, the evidence does not directly show either Mark associated with the Goods. However, considering the evidence in its totality,

the nature and purpose of proceedings under section 45 of the Act (the main purpose being the removal of “deadwood” from the Register), the low evidentiary threshold for such proceedings, and the reasons set out below, I accept that use of both the Word and Design forms of the Marks were used by the Owner to the extent set out below during the Relevant Period.

#### Evidence of Use of the Marks

[19] It is clear from the evidence of record, and even acknowledged by the Requesting Party in its written representations, that the Owner has used the Marks with some, but not all Goods, and that the same applies in respect of the Word Mark and the Services. In fact, the Owner itself submits that it has used the Marks only in association with the following goods:

Pants, trousers, jackets, shorts, board shorts, beach shorts, clothing tops, crop tops, shirts, t-shirts, polo shirts, camisoles, vests, sweaters, hoodies, vests, jumpers, dresses, sweatpants, robes, tunics, kimonos, sundresses, sweatshirts, sweatsuits, sweatpants, athletic tops, athletic shorts, athletic pants, swimwear, swimsuits, bikinis, swim bottoms, swim shorts, swim trunks, beach robes, beach cover-ups, beach rompers, beach hats, clothing caps, beach bags, loungewear, bathrobes, athletic bags, tote bags [Owner’s written representations, pg 5].

[20] Having reviewed the evidence in full, I am of the view that the registrations for the Marks should be maintained in part. In coming to this conclusion, I specifically note the statements in the Nasri Affidavit that each and every good sold and marketed by the Owner in Canada had either a label and/or hangtag depicting one or the other of the Marks and that the sales demonstrated by the invoices provided all relate to the sale of goods bearing at least one of the Marks on a label or hangtag [Nasri Affidavit, paras 15 and 17]. In my view, these statements, considered in association with the invoices, sample labelling which depict both the Word Mark and the Design Mark, and the catalogues provided in Exhibits 2, 3 and 5 of the Nasri Affidavit, support use of the Marks during the Relevant Period in association with the following subset of goods:

Pants, jackets, shorts, board shorts, clothing tops namely halter tops, sweat tops, tank tops and crop tops; shirts, t-shirts, camisoles, jumpers, tunics, kimonos, sweat pants, athletic tops, athletic shorts, athletic pants, swimsuits, bikinis, swim trunks, beach cover-ups, beach rompers

[21] With respect to the Services associated with the Word Mark, Exhibit 4 of the Nasri Affidavit contains the annual online sales figures for goods associated with the Marks for the years 2019 to 2023. As the sales figures for 2019, 2020 and 2023 cover periods that fall outside of the Relevant Period I have not considered them for the purposes of this assessment. Nonetheless, I am satisfied that the sales figures for 2021 and 2022 demonstrate online sales of certain goods during the Relevant Period. As noted above, section 4(2) of the Act provides that 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. I am therefore satisfied that the online sales figures and product catalogue demonstrate use of the Word Mark with the following services:

Online sales of clothing, clothing accessories namely, hats, bags

### **DISPOSITION**

[22] 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 registrations for the Marks will be amended to delete the goods shown in strikethrough below, with the maintained goods shown in bold:

**Pants, trousers, jackets, jeans, skirts, shorts, bermuda shorts, board shorts, knickers, clothing tops namely halter tops, sweat tops, tank tops and crop tops; shirts, blouses, t-shirts, polo shirts, camisoles, vests, ponchos, sweaters, hoodies, cardigans, jumpers, leggings, dresses, tunics, robes, kimonos, sundresses, sweat shirts, sweat pants, sweat suits, athletic bras, athletic tops, athletic shorts, athletic capris, athletic pants, athletic hoodies, swimsuits, bikinis, swim vests, bathing shorts, swim trunks, beach robes, beach cover-ups, beach rompers, cabana tops, cabana shorts, beach hats, beach towels, beach bags, beach shoes, pajamas, pajama pants, pajama shorts, loungewear sets, sleep shirts, night shirts, night gowns, bathrobes, house coats, boxer shorts, briefs, panties, bikini briefs, thongs, bras, shapers, lingerie, shawls, hats, head bands, sunglasses, flip-flops, rings, bracelets, anklets, earrings, necklaces, broaches, pony tail holders, decorative charms, decorative pins, pendants, clutch purses, wallets, travel bags, shoulder bags, athletic bags, overnight bags, tote bags, back-packs, baggage tags, towels, pillows, decorative pillows, candles, perfume, lip gloss.**

[23] In addition, registration TMA970615 for the Word Mark will also be maintained with the services set out in bold below:

**Online sales of clothing, clothing accessories namely shawls, caps, hats and belts; footwear, sunglasses, jewellery, bags, purses, wallets, towels, pillows, beauty aids**

~~namely cosmetics and lip gloss; candles, perfume and other wares namely head bands,  
pony tail holders, hair ties, baggage tags, swim vests and shapers~~

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Leigh Walters  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



## **SCHEDULE A**

### ***Owner's Goods in the Registrations for the Marks***

#### **Goods**

(1) Pants, trousers, jackets, jeans, skirts, shorts, bermuda shorts, board shorts, knickers, clothing tops namely halter tops, sweat tops, tank tops and crop tops; shirts, blouses, t-shirts, polo shirts, camisoles, vests, ponchos, sweaters, hoodies, cardigans, jumpers, leggings, dresses, tunics, robes, kimonos, sundresses, sweat shirts, sweat pants, sweat suits, athletic bras, athletic tops, athletic shorts, athletic capris, athletic pants, athletic hoodies, swimsuits, bikinis, swim vests, bathing-shorts, swim trunks, beach robes, beach cover-ups, beach rompers, cabana tops, cabana shorts, beach hats, beach towels, beach bags, beach shoes, pajamas, pajama pants, pajama shorts, loungewear sets, sleep shirts, night shirts, night gowns, bathrobes, house coats, boxer shorts, briefs, panties, bikini briefs, thongs, bras, shapers, lingerie, shawls, hats, head bands, sunglasses, flip-flops, rings, bracelets, anklets, earrings, necklaces, broaches, pony-tail holders, decorative charms, decorative pins, pendants, clutch purses, wallets, travel bags, shoulder bags, athletic bags, overnight bags, tote bags, back-packs, baggage tags, towels, pillows, decorative pillows, candles, perfume, lip gloss.

### ***Owner's Services in Registration TMA970615 for EVERYDAY SUNDAY***

#### **Services**

(1) Online sales of clothing, clothing accessories namely shawls, caps, hats and belts; footwear, sunglasses, jewellery, bags, purses, wallets, towels, pillows, beauty aids namely cosmetics and lip gloss; candles, perfume and other wares namely head bands, pony-tail holders, hair-ties, baggage tags, swim vests and shapers.

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** Borden Ladner Gervais LLP

**For the Registered Owner:** Harold W. Ashenmil