



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 214

Date of Decision: 2023-12-13

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Self-Portrait IP Limited

Registered Owner: J&J Lang Inc. / Gestion J&J Lang Inc.

Registration: TMA557,021 for PORTRAIT

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. TMA557,021 for the trademark PORTRAIT (the Mark).

[2] The Mark is registered for use in association with: coats, jackets.

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

PROCEEDING

[4] At the request of Self-Portrait IP Limited (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 20, 2022, to J&J Lang Inc. / Gestion J&J Lang Inc. (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark was 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 July 20, 2019 to July 20, 2022.

[6] The relevant definition of “use” in the present case is 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.

[7] Where the Owner does not show “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Jeffrey Langleben, sworn August 26, 2022, together with exhibits JL-1 to JL-30.

[9] Both parties submitted written representations and were represented at an oral hearing.

EVIDENCE

[10] Mr. Langleben is the President of the Owner, a company operating in the business of “arranging for the manufacture of, and the importation into Canada of, fashion clothing”. He asserts he was also the President of the Owner’s predecessors-in-title, namely Importation Fen-Nelli Inc. (Fen-Nelli) and Hardwater Fashion Inc. / Les Modes Hardwater Inc. (Hardwater). I will refer to Fen-Nelli and

Hardwater, collectively, as “the Predecessors”. As President of the Predecessors, Mr. Langleben asserts he was involved on a full-time basis “in each and all” of their activities [paras 1 to 8].

[11] Mr. Langleben states that the Predecessors sold and distributed wholesale clothing in association with the Mark since its registration in 2002. He further states that since May 2020, the goods have been sold and distributed in Canada on the Owner’s behalf by its sales representative, M.C. Apparel Inc. / Vêtements M.C. Inc. (MC) [paras 8, and 10 to 11].

[12] According to Mr. Langleben, sales of “coats and jackets” in Canada exceeded \$200,000 from September 1, 2021, to May 25, 2022 [para 14]. In support, he provides two internal sales documents (the Internal Sales Documents). The first document, issued by “FEN NELLI-Hardwater”, is described by Mr. Langleben as listing “sales and distribution” of “PORTRAIT styles” to Canadian customers during the relevant period [paras 19 to 33]. A few of these documents, namely those relating to product styles H2715, H2714, and H2716 [Exhibits JL-8, JL-10, and JL-12, respectively], list specific customers located in Canada, along with the number of products purchased by those customers, broken down by size. The second document, issued by MC, is entitled “M.C. Apparel Inc. Customer Sales Summary Report” for the period between September 1, 2021, and May 25, 2022 [Exhibit JL-3]. This document lists two customers along with all the style numbers purchased by each of them during that period. I note that one of the customers, namely Manteaux Manteaux, purchased several items of the product style M6217.

[13] Mr. Langleben also provides purchase orders from several customers located in Canada, including Manteaux Mateaux [Exhibit JL-24]. The purchase orders relate to many product styles, including style numbers H1701 and H3701XP [Exhibit JL-26], and K2938 [Exhibit JL-23].

[14] Mr. Langleben refers to the products listed in the Internal Sales Documents and purchase orders as “garments”, and does not specifically correlate those products with either of the registered goods. However, Mr. Langleben does provide documents which

he states were used by MC in the course of selling and distributing “PORTRAIT garments” in Canada. The documents are essentially specification sheets providing manufacturing details such as garment measurements, fabric, and color, as well as sketches of the garments in question. Some of the exhibited specification sheets specifically identify the garment type as a “coat”, and all of the sketches depict coats or jacket-like outerwear.

[15] By way of example, the following exhibits contain specification sheets which describe and depict products which are also referenced in the exhibited purchase orders and Internal Sales Documents:

- Exhibit JL-5: style number M6217, identified on the sheet as a 30" COAT,
- Exhibits JL-7 and JL-9: style numbers H2714 and H2715, identified on the sheet as a 34" COAT,
- Exhibit JL-11: style number H2716, identified on the sheet as a 34 ½" COAT,
- Exhibits JL-16 and JL-18: style number H1701, identified on the sheet as a 33" COAT + DETACH HOOD,
- Exhibit JL-19: style number H3701XP, identified on the sheet as a 35" COAT + DETACH HOOD, and
- Exhibit JL-23: style number K2938, garment type not identified.

[16] With respect to the display of the Mark, Mr. Langleben asserts that each and every product sold or distributed in Canada in the Owner’s normal course of trade, either by MC or previously by the Predecessors, had labels and hangtags bearing the Mark [paras 12 to 13]. In support, he provides photographs depicting:

- labels and a hangtag, all bearing the Mark [Exhibits JL-1 and JL-2], and
- three different outerwear products that Mr. Langleben describes as “garment[s] of the type sold in Canada during the Relevant Period by or on behalf of [the Owner]” [Exhibits JL-28 to JL-30]. I note that the Exhibit JL-1 labels are affixed to the depicted products.

ANALYSIS

Preliminary comments: facts not in evidence

[17] At the hearing, the Requesting Party submitted that the Owner's written representations reference facts not in evidence. In particular, it refers to passages where the Owner provides further details regarding the specification sheets and the manner in which the goods were promoted and sold through MC. I agree. I will therefore not consider such details in my decision.

Admissibility of the evidence

[18] The Requesting Party submits that all the MC-related documents, that is the Internal Sales Documents issued by MC and the purchase orders identifying MC as supplier, constitute inadmissible hearsay. In particular, it submits that these documents should be disregarded as the evidence does not satisfy the test of necessity and reliability.

[19] However, it is well established that, given the summary nature of section 45 proceedings, "concerns with respect to the hearsay nature of evidence can go to weight, rather than admissibility" [*Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18 at para 18]. Therefore, any concerns about the reliability of Mr. Langleben's statements and the evidence will be assessed in terms of weight rather than admissibility.

[20] In any event, it is reasonable to assume that the president or owner of a business would have knowledge of the manner in which the business's products are distributed [see, for example, *Messrs Marks & Clerk v Cristall USA Inc* (2007), 59 CPR (4th) 475 (TMOB); and *Sim & McBurney v Anchor Brewing Co* (2003), 27 CPR (4th) 161 (TMOB)]. Accordingly, I accept that the purchase orders in Exhibit JL-24 and the Internal Sales Documents in Exhibit JL-3 are admissible in support of Mr. Langleben's assertions of sales of the goods in Canada during the relevant period.

[21] Relying on *Miller Thomson Pouliot Sencrl v Oasis Corp* (2009), 78 CPR (4th) 147 (TMOB), the Requesting Party submits that the documents from the Predecessors

should be disregarded as well. In particular, it submits that it is unclear as to how these documents were obtained and whether they are reliable.

[22] In my view, the present case is distinguishable from *Miller Thomson Pouliot Sencrl*, as in that case the evidence was silent as to whether the affiant was involved with the predecessor-in-title and as to his personal knowledge of the invoices' content. In this case, Mr. Langleben states that he was involved "in each and all" the Predecessors' activities and that he was their President. I therefore find that he was involved with the Predecessors and had the personal knowledge required to attest to the validity of the information contained in any of the documents issued by Hardwater and Fen-Nelli. Consequently, I accept the remaining purchase orders [Exhibits JL-23 and JL-26] as admissible evidence in this proceeding.

Use within the normal course of trade accruing to the Owner

[23] The Requesting Party argues that the Owner has not clearly established its normal course of trade. Relying on *Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102, aff'd 2011 FCA 340, it also submits that use established by the evidence, if any, does not enure to the Owner's benefit [Requesting Party's written representations, paras 21 to 23 and 28 to 30].

[24] Although Mr. Langleben does not indicate what entity is the actual manufacturer of the goods, the lack of such information is inconsequential. The Act does not require a registered owner to be the actual manufacturer of goods for it to be considered the source of such goods for purposes of the Act [see *Smart & Biggar v Canadian Tire Corporation, Limited*, 2017 TMOB 153 at para 16]. Given the nature and purpose of section 45, it is proper to presume that a registered owner is the "source" of the goods in question, unless the evidence indicates otherwise, such as in the case of a licensee.

[25] In the present case, I find that a such a presumption is consistent with the evidence as the Owner is not claiming use through any licence agreement. Rather, it claims use through its Predecessors and sales representative by relying on their sales to Canadian retailers during the relevant period. In such a context, there is no need for the Owner to show that it exerted control over the character or quality of the goods.

Thus, I find the present case distinguishable from *Empresa Cubana del Tabaco* where the evidence contained explicit references to a license agreement.

[26] From a fair review of the evidence, I infer that the Owner's normal course of trade is to sell at wholesale imported clothing bearing the Mark. Mr. Langleben states that the Owner is in the business of arranging for the manufacture and importation of clothing into Canada. He also states that the Owner's Predecessors have sold at wholesale clothing bearing the Mark to Canadian retailers since the registration in 2002, and that MC has done the same on the Owner's behalf since May 2020. In this regard, I note that as sales representative, MC is a point along the distribution chain from the Owner to the retailer and ultimately to the consumer. A trademark owner's ordinary course of trade will often involve a chain of transactions occurring between the manufacturer and the ultimate consumer, potentially involving various distributors, wholesalers and/or retailers. It is well established that distribution and sale of the owner's goods through such entities can constitute trademark use that enures to the owner's benefit without the need for a licence, so long as the owner has initiated the first link in the chain of transactions [*Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD); *Lin Trading Co v CBM Kabushiki Kaisha* (1988), 21 CPR (3d) 417 (FCA); *Osler, Hoskin & Harcourt v Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD)].

[27] Accordingly, I am satisfied that use shown by the Predecessors and MC accrues to the Owner.

Use of the Mark in association with coats and jackets

[28] 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. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9].

[29] In the present case, the Owner provides photographs showing the Mark displayed on labels and hangtags, which Mr. Langleben states were attached to the goods sold in Canada during the relevant period. It also provided specification sheets detailing styles numbers and showing sketches and photographs of the goods. As evidence of transfers, the Owner provided sales figures and Internal Sales Documents supporting Mr. Langleben's statements of sales in Canada during the relevant period. In addition, the Owner furnished purchase orders issued by Canadian retailers during the relevant period.

[30] All in all, I find that the evidence establishes a *prima facie* case of use of the Mark in Canada during the relevant period. The question remains as to whether the evidence supports the conclusion that the Mark was used in association with both coats and jackets.

[31] The alternative submission of the Requesting Party is that the evidence only shows use in association with coats and not jackets. In particular, it submits that "a coat tends to be a longer and heavier piece of outer clothing and a 'jacket' tends to be a shorter and lighter piece of outer clothing", and refers to dictionary definitions of "coat" and "jacket" [Requesting Party's written representations, para 36].

[32] However, it is a well-established principle that when interpreting a statement of goods or services in a section 45 proceeding, one is not to be "astutely meticulous when dealing with [the] language used" [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17].

[33] It remains nonetheless that use in association with one specific good cannot generally serve to maintain multiple goods within the statement of goods, as the Owner is required to provide evidence of use for *each* of the registered goods [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Having distinguished coats and jackets in the registration, I agree with the Requesting Party that the Owner was obligated to furnish evidence with respect to each good. Thus, the key issue in this case is whether the Owner can rely on the evidence submitted to maintain both goods.

[34] The evidence contains many examples of coats. I note for example that the style number H3701XP, identified as a 35" COAT + DETACH HOOD in its specification sheet, is listed in an exhibited purchase order. Similarly, with respect to jackets, I find that the garment depicted on the specification sheet for style number K2938R, and listed in at least two exhibited purchase orders, can reasonably be considered to correspond to a "jacket", even though the specification sheet itself does not explicitly identify the garment as a jacket.

[35] In view of the evidenced examples of labels bearing the Mark, as well as Mr. Langleben's statement that labels were affixed to garments sold in Canada, I am satisfied that the Owner has met its *prima facie* burden to show use of the Mark in association with coats and jackets pursuant to sections 4(1) and 45 of the Act.

DISPOSITION

[36] Accordingly, 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 maintained.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-09-27

APPEARANCES

For the Requesting Party: Nathan Piché

For the Registered Owner: Harold W. Ashenmil

AGENTS OF RECORD

For the Requesting Party: Gowling WLG (Canada) LLP

For the Registered Owner: Harold W. Ashenmil