



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 017

Date of Decision: 2024-01-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Drake Marks Associates

Registered Owner: Kenneth Cole Productions Inc.

Registration: TMA1,033,120 for LOOK GOOD, FOR GOOD

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. TMA1,033,120 for the trademark LOOK GOOD, FOR GOOD (the Mark).

[2] The Mark is registered for use in association with the goods and services set out in Schedule A to this decision.

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

PROCEEDING

[4] At the request of Drake Marks Associates (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 11, 2022, to Kenneth Cole Productions 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 and services 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 11, 2019 to July 11, 2022.

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

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.

4(3) 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] 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 Andrea F. Ashton, sworn on February 13, 2023, together with Exhibits A to G.

[9] Only the Requesting Party submitted written representations and no oral hearing was held.

EVIDENCE

[10] In her affidavit, Ms. Ashton identifies herself as the Owner's trademark agent employed at the law firm acting on the Owner's behalf in this proceeding. She states having "personal knowledge of the matters [therein] set forth" [para 1].

[11] Ms. Ashton states that, on the day of the signature of her affidavit, she searched for the webpages located at *kennethcole.com/pages/for-good* (the Kennethcole Webpage) and *truepatriotlove.com/partnerships/moores-the-suit-people-inc* (the Truepatriotlove Webpage) on the Internet Archive website known as the Wayback Machine [paras 2 to 9]. She provides two printouts of the Kennethcole Webpage dated September 21, 2021 [Exhibit C] and May 17, 2022 [Exhibit D]. The Mark is displayed in the middle of both printouts. The first printout shows the tabs "Men", "Women", "Kids", "Shoes", "Accessories", "Luggage & Home" and "For Good". The second printout shows the tabs "Wellness Watch", "Men", "Women", "Kids", "Shoes", "Accessories", "Luggage & Home" and "Sale". Ms. Ashton also provides a printout of the Truepatriotlove Webpage dated July 7, 2022 [Exhibit F]. This printout refers to a partnership with the Canadian retailer Moores and to the "Kenneth Cole AWEARNESS products", which collection "raised over \$700,000 in donations to support Canadian military families". I note that the Mark does not appear on this last printout.

[12] Ms. Ashton also states having visited the "Corporate Social Responsibility" webpage within the Kennethcole Webpage (the Corporate Social Responsibility Webpage) at *kennethcole.com/pages/csr-give-back-program* [para 10]. She provides a printout of the Corporate Social Responsibility Webpage [Exhibit G] showing the following headings: "Fellowship Programs", "Membership and Associations" and "Give Back Program". The Mark appears in the middle of the printout followed by "KENNETH COLE IS WORKING WITH GIVE BACK BOX® to reduce waste and donate items to those in need".

PRELIMINARY MATTER: ADMISSIBILITY OF THE AFFIDAVIT

[13] In its written representations the Requesting Party submits that as Ms. Ashton is employed by the trademark agent for the Owner the affidavit does not comply with

rule 82 of the Federal Court Rules [citing *Cross Canada Auto Body Supply (Windsor) Limited v Hyundai Auto Canada*, 2005 FC 1254, aff'd 2006 FCA 133].

[14] However, rule 82 applies to evidence submitted before Federal Court and Federal Court of Appeal by a party's solicitor. In the present case, the parties are represented by registered trademark agents, and there is no equivalent provision in the Trademarks Regulations governing the conduct of such agents.

[15] Moreover, although Ms. Ashton is a trademark agent employed at the law firm acting on the Owner's behalf, I note that she merely states having searched and visited the Owner's Webpages. As such, her affidavit does not contain any opinion or conclusion that could be considered as related to controversial and central matters in this proceeding. Consequently, I do not find that her affidavit ought to be excluded from consideration pursuant to the case relied upon by the Requesting Party. In reaching this conclusion, I have been guided by the opposition decisions in *Industria de Diseño Textil, S.A. and Zara Natural Stones Inc.*, 2022 TMOB 241 at para 16; and *The University of British Columbia and SAGE Dining Services Inc.*, 2023 TMOB 185 at paras 14-20.

[16] The Requesting Party also submits that most of the documented evidence [Exhibits C, D and F] is also inadmissible hearsay as it emanates from a third-party website [citing *Bereskin & Parr v Mövenpick-Holding* (2008), 69 CPR (4th) 243 (TMOB)]. However, the case relied upon by the Requesting Party predates *Eva Gabor International Ltd v 1459243 Ontario Inc.*, 2011 FC 18, where the Federal Court held at paragraph 18 that considering the summary nature of section 45 proceedings, any concerns with respect to the hearsay nature of the evidence can go to weight, rather than admissibility.

[17] In any case, even if I were to give some weight to the evidence, I would not be satisfied that the Owner has demonstrated use of the Mark in accordance with sections 4 and 45 of the Act for the reasons below.

ANALYSIS AND REASONS FOR DECISION

[18] 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 [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 38] 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]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the mark was used in association with the goods and services.

[19] In the present case, I agree with the Requesting Party’s submission that the Owner has not put forward any evidence of use of the Mark in Canada during the relevant period.

[20] With respect to the registered goods, Ms. Ashton does not state that the Mark was used in association with them in Canada during the relevant period. Further, the evidence does not show how the Mark is associated with the goods. In this regard, I note that although two of the printouts display the Mark [Exhibits C and D], they do not show any product. Even though these printouts show tabs suggesting that there are webpages associated with the Mark and devoted to products displaying the Mark, Ms. Ashton does not provide any printout showing the tabs’ content. In addition, the evidence is silent as to any transfer of the goods. Indeed, Ms. Ashton neither provides invoices nor factual particulars from which transfers of the goods in or from Canada during the relevant period might be inferred [see *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA); and *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[21] With respect to the registered services, the Corporate Social Responsibility Webpage [Exhibit G] is not taken from the Wayback Machine and Ms. Ashton does not state that it is representative of the way such Webpage appeared during the relevant period. As such, this piece of evidence is dated after the relevant period, and it is not of assistance to the Owner. As for the Truepatriotlove Webpage printout [Exhibit F],

although its content appears to relate to “charitable fundraising services”, the Mark does not appear anywhere on the printout. In any event, Ms. Ashton does not even state that prospective Canadian customers accessed any of the Webpages during the relevant period, and such access cannot be otherwise inferred from the evidence [*Shift Law v Jefferies Group, Inc*, 2014 TMOB 277; and *Ridout & Maybee LLP v Residential Income Fund LP*, 2015 TMOB 185]. Without a clear statement or further evidence, the mere existence of the Webpages, archived or not, is not sufficient to establish that Canadians accessed them so as to constitute advertising within the meaning of the Act.

Furthermore, the evidence is silent as to the performance of the registered services or as to the Owner’s willingness and ability to perform them in Canada during the relevant period [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)] .

[22] For all the reasons above, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods and services within the meaning of sections 4 and 45 of the Act. Moreover, the Owner has not put forward evidence of special circumstances excusing the absence of use of the Mark.

DISPOSITION

[23] 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 expunged.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Goods

(1) Fragrances and perfumery, deodorants, after-shave balm, hair and body wash; shower gel; eyeglasses, sunglasses, eyeglass frames, carrying cases for cell phones and laptop computers; downloadable mobile applications for accessing public advocacy and charitable services information and initiatives; Jewelry, watches, cufflinks, tie clips, watch cases; Books, folders, journals, notebooks, paper clips, money clips; Luggage, luggage straps, travel bags, garment bags, hand bags, clutches, evening bags, tote bags, athletic bags, duffel bags, beach bags, diaper bags, cosmetic bags, school bags, shoe bags, toiletry cases, wallets, brief cases, business cases, portfolios, business card cases, umbrellas; Casual clothing; sportswear; hats, caps, knit caps, casual footwear, evening footwear, dress shoes, children's footwear, sneakers; clothing, namely, socks, hosiery, scarves, neckties, bow ties, pants, shorts, dresses, skirts, coats, sport coats, suits, sweaters, rainwear, shirts, blouses, tops, t-shirts, underwear, lingerie, belts, robes, and swimwear

Services

(1) Public advocacy, advertising services, namely, promoting the goods and services of others through print, audio, video, digital and on-line medium and charitable services, to promote awareness of civil liberties, equal rights, HIV/AIDS research and prevention and other health initiatives, artistic activism, social change, education, volunteerism, and the distribution of goods, namely, footwear, apparel, fragrances, books, luggage, bags, eyewear, jewelry, neckwear, watches, sunglasses, eyewear, housewares, luggage straps, travel bags, garment bags, briefcases, portfolios, attaché cases, handbags, pocketbooks, leather and fabric evening bags, clutches, tote bags, athletic bags, duffel bags, beach bags, shoe bags, diaper bags, cosmetic bags, toiletry cases, knapsacks, waist packs, umbrellas, wallets, billfolds, business card cases, credit card cases, change purses and key cases to communities in need; Providing incentive award programs through product giveaways, discounts, experiences and events, namely, live musical concerts, fashion shows, and personal appearances by a celebrity, in support of the foregoing public advocacy and charitable services; On-line retail store services in the fields of footwear, apparel, fragrances, books, luggage, bags, eyewear, jewelry, watches, belts, scarves, neckwear, sunglasses, luggage straps, travel bags, garment bags, briefcases, portfolios, attaché cases, handbags, pocketbooks, leather and fabric evening bags, clutches, tote bags, athletic bags, duffel bags, beach bags, shoe bags, diaper bags, cosmetic bags, toiletry cases, knapsacks, waist packs, umbrellas, wallets, billfolds, business card cases, credit card cases, change purses and key cases; Charitable fundraising services

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Drake Marks Associates

For the Registered Owner: Norton Rose Fulbright Canada

LLP/S.E.N.C.R.L.,S.R.L.