



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 54

Date of Decision: 2024-03-25

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Fitz-Morris Anthony Campbell dba Enlight Designs

Registered Owner: Lululemon Athletica Canada Inc.

Registration: TMA1,070,514 for ENLITE

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. TMA1,070,514 for the trademark ENLITE (the Mark).

[2] The proceeding is restricted to the goods specified in the registration listed below:

Clothing, namely, t-shirts, shirts, tank tops, sweatshirts, sweaters, sports jerseys, jumpers, pants, sweatpants, shorts, skirts, dresses, jackets, coats, vests, [...], underwear, socks, warm-up suits, bodysuits, leotards, tights, leggings, leg warmers; headwear, namely, hats, caps, toques, visors, headbands, bandanas; clothing accessories, namely, belts, scarves, shawls, shoulder wraps, arm warmers, mittens, gloves; sandals.

[3] The only goods in the registration not specified in the restricted notice are “bras”, which are therefore not subject to these proceedings and will remain in the registration.

[4] For the reasons that follow, I conclude that the registration should be amended to delete all the goods that are the subject of the restricted section 45 notice.

PROCEEDING

[5] At the request of Fitz-Morris Anthony Campbell dba Enlight Designs (the Requesting Party), the Registrar of Trademarks issued a restricted notice under section 45 of the Act on February 10, 2023, to Lululemon Athletica Canada Inc. (the Owner), the registered owner of the Mark.

[6] The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods specified in the restricted notice, 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 restricted notice specified all the goods listed in the registration except “bras”. The relevant period for showing use is February 10, 2020, to February 10, 2023.

[7] 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.

[8] Where the owner has not shown “use”, the registration, as it relates to the goods specified in the notice, 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 notice, the Owner furnished an affidavit of Christopher Zimmerman, Vice President of Global Merchandising – Women’s.

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

EVIDENCE

[11] In his affidavit, Mr. Zimmerman indicates that the Owner is a leader in the yoga and fitness industry, operating over 60 retail locations in Canada as well as a transactional website where customers can purchase “merchandise, including but not limited to apparel, shoes, and accessories” [para 5].

[12] He asserts that the Mark “remains important to the business of [the Owner] and has been used by [the Owner] in Canada in association with clothing, namely bras and vests, during the relevant period” [para 6].

[13] With respect to transfers, he states that “between February 10, 2020, and February 9, 2023, the total dollar amount of sales in Canada for ENLITE merchandise, namely bras and vests, well exceeded \$4 million dollars (Canadian)” [para 7]. He also attaches 10 sample invoices which, as acknowledged during the hearing, only include sales of bras and do not show sales of any vests [Exhibit B].

[14] Mr. Zimmerman explains that the Owner’s “invoicing procedure for sales made online and in store remain consistent with the samples [...] included at Exhibit B” and that “invoices corresponding to all ENLITE hydraffinity Vests purchased would also include the [Mark], product name, price, size, and quantity, as well as an image of the merchandise on the invoice for goods purchased online” [para 8]. However, no such invoices were evidenced.

[15] With respect to display of the Mark, he attests that “all ENLITE merchandise prominently uses and displays the [Mark]”, which appears on hangtags. In this regard, Mr. Zimmerman’s affidavit includes 5 photographs of hangtags of products identified as “Enlite Bra” [para 9]. Mr. Zimmerman’s affidavit also includes one photograph of hangtags of a product identified as “Enlite Hydraffinity Vest”, and attests that the “style and appearance of the hangtags affixed to the merchandise remained consistent during the subsequent seasons, including in the relevant period” [para 10]. I note that some of

the hangtags bear stickers indicating “ARCHIVE” (or “ARCHVE”), a season (“SPRING” or “FALL”), and a year.

[16] Additional views of the products described in Mr. Zimmerman’s affidavit are also evidenced at Exhibit C, which shows images of:

- (a) four models of “Enlite bra” with hangtags, each bearing stickers with a season and a year within the relevant period; and
- (b) one model of “Enlite Hydraffinity Vest” with hangtags, which bear two stickers indicating dates before the relevant period, specifically one indicating “SPRING 2019” and another indicating “ARCHVE 2019”.

[17] Mr. Zimmerman states that, during the relevant period, “consumers purchased merchandise online using the ENLITE Trademark” and provides screenshots of the current version of the Owner’s website [para 11]. The screenshots pertain only to bras.

[18] With respect to advertising and promotion, Mr. Zimmerman states that the Owner’s “marketing and promotional campaigns often receive international recognition and are publicized online and through various social media platforms” [para 12]. He states that as such, “Consumers in Canada and worldwide have come to associate [the Owner’s] trademarks with the brand’s high-quality, performance-driven products and services”, and that the Owner has “developed considerable goodwill in its lululemon and related trademarks”, all of which “has resulted in millions of customers worldwide and billions of dollars in sales” [para 13]. I note that such statements are not specific to the Mark.

[19] Mr. Zimmerman concludes his affidavit by reasserting that the evidence shows that the Owner has used the Mark in Canada during the relevant period in association with both bras and vests [para 14].

ANALYSIS AND REASONS FOR DECISION

[20] At the outset, as acknowledged by the Owner at the oral hearing, no evidence was filed pertaining to any goods specified in the restricted notice other than vests, and

no special circumstances excusing non-use were evidenced or claimed. As such, the following goods will be deleted from the registration:

Clothing, namely, t-shirts, shirts, tank tops, sweatshirts, sweaters, sports jerseys, jumpers, pants, sweatpants, shorts, skirts, dresses, jackets, coats, [...] underwear, socks, warm-up suits, bodysuits, leotards, tights, leggings, leg warmers; headwear, namely, hats, caps, toques, visors, headbands, bandanas; clothing accessories, namely, belts, scarves, shawls, shoulder wraps, arm warmers, mittens, gloves; sandals.

[21] Moreover, as noted above, the goods “bras” were not specified in the restricted section 45 notice. As such, the only question at issue is whether the Owner has demonstrated use of the Mark in association with “Clothing, namely ... vests”.

[22] The Requesting Party submits that the evidence pertaining to bras is irrelevant to vests, and that the evidence pertaining specifically to vests is, at best, ambiguous and fails to demonstrate display of the Mark or any actual transfers of property or possession of vests during the relevant period.

[23] The Owner submits that the evidence contains specific statements and details pertaining to vests, notably the sales volume during the relevant period for bras and vests combined. The Owner submits that this is a statement of fact and, unless the credibility of the affiant is impugned, dispositive of the question of transfer of vests. It also submits that the affiant’s statements that “invoices corresponding to all ENLITE Hydraffinity Vests purchased would also include the ENLITE trademark” constitutes evidence of transfer and it should not be held against the Owner that invoices identifying vests were not filed, as invoices are not required in a section 45 proceeding. As such, the Owner argues that the foregoing, together with the images of the vest with hangtags displaying the Mark, constitutes clear evidence of use, or at least sufficient evidence from which an inference of use should be drawn.

[24] At the hearing, when asked about the relevance of the evidence pertaining to bras, the Owner stated that it was provided to show the Owner’s normal course of trade. However, the Owner also submitted that should I find the evidence sufficient to show use of the Mark in association with bras, I should necessarily come to the same conclusion with respect to vests. The Owner argued that the only distinguishing

evidence between bras and vests are invoices for bras, noting the aforementioned principle that invoices are not required in a section 45 proceeding.

[25] With regard to the evidenced sales volume of bras and vests combined, the Owner argues that specific sales volume per good is not required, citing the cases of *Guido Berlucchi & C. Srl's v Brouillette Kosie Prince*, 2007 FC 245 and *Castel Engineering NV v Eneready Products Ltd.*, 2018 TMOB 64. However, in both these cases, only a single good was at issue and sales volumes were considered in the context of a determination as to whether sales, which were otherwise evidenced, were genuine commercial transactions made in the normal course of trade. As such, I find these cases of little assistance here.

[26] Rather, the question at the heart of the present matter is whether the Owner's evidence demonstrates transfer of property or possession of vests. In this regard, combined sales figures alone have been held insufficient to demonstrate transfer of specific goods in the absence of invoices or other specific evidence. This was notably the outcome in *Gowling Lafleur Henderson LLP v Wertex Hosiery Inc.*, 2014 TMOB 193 and *Clark Wilson v Lee Canada Inc.*, 2007 CanLII 80831, cited by the Requesting Party, as well as *Smart & Biggar LLP v ACM Glass Ltd.*, 2024 TMOB 6 (a restricted notice case), cited by the Owner during the hearing. I come to the same conclusion in the present case.

[27] Indeed, evidence that total sales "for ENLITE merchandise, namely bras and vests, well exceeded \$4 million dollars" does not provide facts allowing sales of vests to be isolated from sales of bras. It is at best unclear to what extent such statements apply to the vests as opposed to the only goods from the registration excluded from the restricted notice. As such, I do not find such evidence to constitute a clear statement of transfer of vests in the normal course of trade.

[28] With regard to the statements and arguments made regarding the evidenced invoices, although invoices are not required in response to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD) at 486], some evidence of a transfer in the normal course of trade in Canada of each of

the goods at issue is nevertheless necessary [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[29] In the present case, I find that statements regarding what “would have” been included in invoices for vests, without clear evidence of such purchases having occurred, do not provide “equivalent factual particulars” demonstrating transfers of vests in the normal course of trade during the relevant period. Had evidence similar to that provided for bras been provided for vests, for example, different models available over various seasons during the relevant period and online availability, I may have been prepared, considering the evidence as a whole, to infer transfer of vests; however, this is not the case.

[30] To the extent that the Owner submits that should I find the evidence sufficient to demonstrate use of the Mark in association with bras, I should necessarily find same with regard to vests, I disagree. First, the question of use of the Mark within the meaning of section 4(1) of the Act in association with bras is beyond the scope of this proceeding. Second, this argument is premised on the only difference between the evidence pertaining to vests and bras being the sample invoices provided which, as mentioned above, is not the case.

[31] To the extent that the Owner submits that the evidence of a vest with tags displaying the Mark constitutes “clear” evidence of use, it is well established that evidence of products displaying the Mark alone are not sufficient to demonstrate transfer of property or possession thereof in the normal course of trade [*Alliance Laundry Systems LLC v Whirlpool Canada LP*, 2015 FCA 232; *Goudreau Gage Dubuc v 2430-2614 Quebec Inc.*, 2013 TMOB 109].

[32] While evidentiary overkill is not required and representative evidence can be furnished in section 45 proceedings, the registered owner must still establish a *prima facie* case of use of the trademark in association with *each* of the goods specified in the

registration [*John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA); see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. Indeed, the purpose of evidence tendered by an owner is to “inform the Registrar in detail of the situation prevailing with respect to the use of the trade mark so that he, and the Court on appeal, can form an opinion and apply the substantive rules” [*Sherzady v Norton Rose Fullbright Canada LLP/sencrl, srl*, 2022 FC 1712 at para 21 (citing *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Moreover, “a *prima facie* case must be made allowing the Court to rely on an inference from proven facts rather than on speculation” [*Diamant Elinor* at para 11; *Smart & Biggar v Curb*, 2009 FC 47].

[33] In this case, I do not find that combined sales figures, a statement regarding what “would have” appeared on invoices for sales of vests which are not otherwise evidenced, and images of a single vest with hangtags displaying the Mark but dated “SPRING 2019” and “ARCHVE 2019”, constitutes clear evidence of sufficient details to demonstrate transfers of vests in the normal course of trade during the relevant period.

[34] As argued by the Requesting Party, evidence of a single invoice pertaining to vests, or even clear statements that such sales occurred and invoices were issued, are conspicuously absent. Likewise, it is curious that, in contrast to the evidence pertaining to bras which showed several models which all had hangtags dated during the relevant period, only one vest is evidenced, and the date indicated directly thereon pre-dates the relevant period. Furthermore, it is at best unclear why the Owner chose to conflate its evidence regarding vests with evidence regarding bras. In view of the foregoing, considering the evidence as a whole, I find that the evidence is insufficient to infer transfer of vests in the normal course of trade during the relevant period. I consider such a conclusion would be an exercise in speculation rather than a reasonable inference from proven facts.

[35] In the present case, there is ultimately only one good at issue. I do not consider it to be unreasonable or evidentiary overkill to require the Owner to provide one representative invoice or at the very least statements regarding transfers that clearly distinguish evidence pertaining to vests from evidence pertaining to other goods,

particularly the only good excluded from the restricted notice [*Fetherstonhaugh & Co v HB Fuller Company*, 2019 TMOB 1 at paras 19-20; *Method Law v Boutique Jacob Inc*, 2015 TMOB 5 at paras 23-24; *Gowling Lafleur Henderson LLP v Wertex Hosiery Inc*, 2014 TMOB 193]. Indeed, just as an owner is “playing with fire” when choosing to produce evidence of a single sale [*Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245 at para 20], it is likewise playing with fire when, in the context of a restricted section 45 notice, it chooses to direct its evidence to goods or services not specified in such notice.

[36] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with “Clothing, namely ... vests” within the meaning of sections 4(1) and 45 of the Act.

DISPOSITION

[37] 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 the goods subject of the restricted notice, namely:

[...] t-shirts, shirts, tank tops, sweatshirts, sweaters, sports jerseys, jumpers, pants, sweatpants, shorts, skirts, dresses, jackets, coats, vests, [...], underwear, socks, warm-up suits, bodysuits, leotards, tights, leggings, leg warmers; headwear, namely, hats, caps, toques, visors, headbands, bandanas; clothing accessories, namely, belts, scarves, shawls, shoulder wraps, arm warmers, mittens, gloves; sandals

[38] The statement of goods in the registration will now read as “Clothing, namely, bras”.

Emilie Dubreuil
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-02-07

APPEARANCES

For the Requesting Party: Tanya Reitzel

For the Registered Owner: David S. Lipkus

AGENTS OF RECORD

For the Requesting Party: Coastal Trademark Services Limited

For the Registered Owner: David S. Lipkus