



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 3

Date of Decision: 2025-01-16

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Partnership between Mohammid Simon and Kenniesha Simon, doing business as Killa Garments

Registered Owner: Kurt Geiger Limited

Registration: TMA762,454 for KG (Stylised)

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. TMA762,454 for the trademark KG (Stylised) (the Mark), reproduced below.

KG

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

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

PROCEEDING

[4] At the request of the partnership between Mohammad Simon and Kenniesha Simon doing business as Killa Garments (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 26, 2023, to Kurt Geiger Limited (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 from July 26, 2020 to July 26, 2023.

[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] In response to the Registrar’s notice, the Owner furnished the affidavit of its Finance Director, Dale Christilaw, sworn on February 26, 2024, together with Exhibits A and B.

[8] Neither party submitted written representations. Only the Owner was represented at a hearing.

REASONS FOR DECISION

[9] In his affidavit, Mr. Christilaw describes the Owner as a luxury British footwear and accessories company. He explains that the Mark is an acronym

formed from the initial letters of the Owner's company name, Kurt Geiger [paras 1 to 3].

[10] Mr. Christilaw expressly claims use of the Mark in association with "footwear, namely boots, shoes, slippers and sandals" and with "protective footwear" (the Claimed Goods) in Canada during the relevant period. At the hearing, the Owner also submitted that use is shown in association with "purses". Otherwise, Mr. Christilaw claims that special circumstances justify the absence of use of the Mark in Canada during the relevant period [paras 4 to 9].

[11] The Owner's evidence will be discussed in detail further below.

The use of the Mark

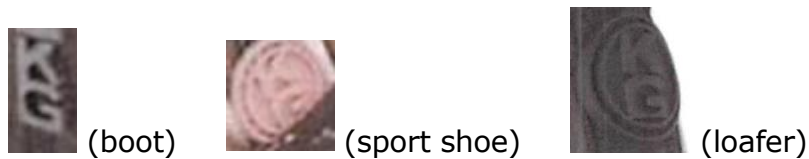
[12] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing "deadwood" from the register. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko 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.

[13] Mr. Christilaw states that the Mark has been used since at least as early as 2007. He also states that the Owner owns over 70 branded retail stores around the world and that the Claimed Goods are sold worldwide, including in Canada. According to Mr. Christilaw, "a number of Canadian sales" are made through the Owner's global website at *global.kurtgeiger.com* (the Global Website) and the Canada specific website at

kurtgeigercanadashop.com (the Canadian Website; collectively, the Websites) [paras 2 to 3 and 7].

[14] In support of his statements of use of the Mark, Mr. Christilaw reproduces in the body of his affidavit one screenshot for each of the Websites. The Global Website screenshot shows several shoes in the background with a pop-up window announcing shipping to Canada and payment in Canadian dollars. The Canadian Website screenshot shows one sandal and two different boots with prices in Canadian dollars. I note that only one of the boots displays the Mark, on its zipper.

[15] In addition, Mr. Christilaw provides “examples of some of the [Claimed Goods] sold in Canada” in association with the Mark [Exhibit B; para 6]. These examples consist of eight photographs showing a suede leather boot, a sport shoe and a leather loafer from various angles. Vertical variations of the Mark are displayed on the boot’s zipper, on the sport shoe’s tongue and on the loafer’s heel decoration, as reproduced below:



[16] I accept the display of these variations to constitute display of the Mark as registered for the purpose of this proceeding [per *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltée v Munsingwear Inc.* (1992), 44 CPR (3d) 59 (FCA); and *Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc*, 2016 FCA 265]. In my view, the disposition of the letters does not change the identity of the Mark, as its dominant feature, that is, the letters “K” and “G”, are preserved within the variations.

[17] From the evidence as a whole, I accept that the photographs and the Canadian Website are representative of how the Mark was displayed on boots and shoes during the relevant period. I also accept that these goods were available for purchase by Canadian consumers on the Websites during the same period. Further, given that the boots and shoes in evidence bear the Mark, I am satisfied that Canadian customers would be given sufficient notice of association between the Mark and these goods at the time of sales or delivery.

[18] Mr. Christilaw asserts that sales of the Claimed Goods to Canadian customers during the relevant period were over CA\$20,000.00. However, as he only provides examples of display of the Mark in association with boots and shoes, I am only satisfied that the Owner has demonstrated transfer of “footwear, namely boots, shoes” in Canada during the relevant period.

[19] I therefore conclude that the Owner has demonstrated use of the Mark in association with “footwear, namely boots, shoes” within the meaning of sections 4(1) and 45 of the Act.

[20] I come to a different conclusion with respect to the balance of the Claimed Goods, namely “slippers and sandals” and “protective footwear”.

[21] It is settled law that, generally, use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration [per *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) at paras 13 and 14]. Having distinguished four separate goods within the broad category of footwear, the Owner was obligated to furnish evidence with respect to *each* of them accordingly. Similarly, having included “protective footwear” separately in the registration, the Owner was required to provide separate evidence with respect to this good.

[22] At the hearing, the Owner submitted that any ambiguity in the evidence should be resolved in its favour. However, I do not consider the evidence submitted to be ambiguous.

[23] In my view, none of the photographed goods correlates with “slippers”, which are commonly known as being cozy shoes to be wear at home.

[24] With respect to “sandals”, contrary to one of the boots shown on the Canadian Website, the sandal shown in the same screenshot does not appear to bear the Mark or otherwise to be identified with the Mark. Further, I do not consider the Owner’s name “Kurt Geiger”, which appears cropped in the sandal’s description, to equate to display of the Mark or to be an acceptable variation thereof. As a result, I am unable to conclude that the Mark was associated with “sandals” at the time of transfer or delivery in Canada during the relevant period.

[25] As for “protective footwear”, I first note that Mr. Christilaw does not explain what a protective footwear is. More importantly, he does not state that any of the footwear in evidence can be used or can be considered as “protective footwear”. Absent further evidence, I am not prepared to accept that use evidenced with respect to boots or shoes also serves to maintain “protective footwear”.

[26] In closing on this point, I note that it would not have been an unreasonable burden for the Owner to provide separate evidence with respect to another three of the Claimed Goods. In the alternative, it would also have been an easy matter for Mr. Christilaw to state that the examples provided are representative of the manner in which the Mark was associated with the balance of the Claimed Goods in Canada during the relevant period.

[27] With respect to “purses”, Mr. Christilaw reproduces several posts of the Owner’s Instagram and Facebook accounts in the body of his affidavit. Two posts show a bag with a chain strap bearing the Mark. At the hearing, the agent for the Owner correlated this bag with the registered good “purses” and submitted that the evidence also demonstrates use of the Mark in association with “purses”.

[28] However, in my view, if Mr. Christilaw wanted to claim use in association with “purses”, he would have stated as such. In any event, he does not claim sales in Canada through the Owner’s social media accounts. Indeed, Mr. Christilaw simply states that these accounts displayed the Mark and that Canadian followers accessed the Instagram posts during the relevant period. As such, the posts merely advertise the purse in association with the Mark during the relevant period, which is generally insufficient to establish use of a trademark in association with goods within the meaning of the Act [see *Tint King of California Inc v Canada (Registrar of Trademarks)*, 2006 FC 1440 at para 40]. Absent further evidence, I am not prepared to conclude that Mr. Christilaw intended to claim use in association with “purses” or that his aggregate sales figures include this good.

[29] I therefore conclude that the Owner has failed to demonstrate use of the Mark in association with the balance of the registered goods within the meaning of sections 4(1) and 45 of the Act.

The special circumstances

[30] As there is no evidence of use of the Mark in association with the registered goods other than “footwear, namely boots, shoes” (the Remaining Goods) in Canada during the relevant period, I must now consider whether, pursuant to section 45(3) of the Act, special circumstances excuse non-use.

[31] An exception to the rule that non-use is penalized by expungement is made where the absence of use is excusable due to special circumstances to which the absence of use is attributable [*Smart & Biggar v Scott Paper Ltd*, 2008 FCA 129 at para 22].

[32] To determine whether special circumstances have been established, I first must determine why the Mark was not used during the relevant period. Second, I must determine whether these reasons for non-use constitute special circumstances [per *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)]. The Federal Court has held that special circumstances mean circumstances or reasons that are “unusual, uncommon, or exceptional” [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD) at para 29]. If I determine that the reasons constitute special circumstances, I must still decide whether such special circumstances *excuse* the absence of use. This involves the consideration of three criteria: (i) the length of time during which the trademark has not been in use; (ii) whether the reasons for non-use were beyond the control of the registered owner; and (iii) whether there exists a serious intention to shortly resume use [per *Harris Knitting Mills*].

[33] The Owner submits that the absence of use of the Mark in association with the Remaining Goods is the result of the pandemic. In particular, Mr. Christilaw states that the Owner was significantly impacted by the enforced closure of its physical stores and by “other increased restrictions” [para 5]. In support, he provides, as Exhibit A, an article published on October 31, 2022 at *uk.fashionnetwork.com* (the Article).

[34] However, although the enforced closure of the Owner’s physical stores may have impacted its business around the world, the Owner does not operate brick-and-mortar stores in Canada. In this respect, I note that the agent for the Owner confirmed at the hearing that sales in Canada were

made through the Websites. It is therefore unclear how enforced closures of retail stores abroad could have impacted online sales in Canada. I also note that Mr. Christilaw provides no details as to the nature of the “other increased restrictions” faced by the Owner during the pandemic or at any time during the relevant period. That said, I accept that pandemic-related government restrictions may have impacted the Owner’s activities in Canada to some degree.

[35] With respect to the Article, I first note that it does not expressly refer to the Canadian market. I further note that the Article appears to concern a one year period ending in January 2022, as the article was published on October 31, 2022 and refers to the Owner’s “results for the year to the end of January”. In any case, the Article reports net profits up from the loss experienced in the previous period. As such, the Article refers to the Owner’s bounce back after the pandemic.

[36] At the hearing, the Owner relied on *Cassels Brock & Blackwell LLP v Vescio Group Inc.*, 2024 TMOB 146, for the proposition that the pandemic-related government restrictions constitute special circumstances.

[37] However, I find the present case distinguishable from *Vescio Group* for at least two reasons. First, in that case the trademark was registered in association with restaurant services to be provided in brick-and-mortar restaurants in Canada. In this case, however, the Owner does not sell through physical retail stores in Canada. Second and more importantly, in *Vescio Group*, the Registrar concluded that the pandemic-related restrictions concerned a *substantial part of the relevant period*, based on the amount of overlap between the relevant period and these restrictions. While there is some amount of overlap in the present case, I do not consider it to be substantial.

[38] In this respect, it has been held that special circumstances must apply to the entire relevant period [see, for example, *Oyen Wiggs Green & Mutala LLP v Rath*, 2010 TMOB 34 at para 12; *PM-DSC Toronto Inc v PM-International AG*, 2013 TMOB 15 at para 15, and *The Wonderful Company LLC and Fresh Trading Limited*, 2023 TMOB 8].

[39] If there were other reasons explaining why the Owner could not have used the Mark in association with the Remaining Goods in Canada during the relevant period or after the pandemic-related government restrictions, such reasons are not set out in the evidence.

[40] In view of the foregoing, I am not satisfied that the Owner has demonstrated that the reasons for non-use constitute special circumstances.

[41] In any event, I am not satisfied that the Owner's reasons excuse the period of non-use in this case.

[42] With respect to the first criterion, as the Owner has not provided a date of last use, the date of registration is the relevant date for purposes of assessing the length of non-use [per *Oyen Wiggs*, supra]. The registration date is March 24, 2010; therefore, the total length of time during which the Mark was not in use is 13 years and four months. This lengthy period of non-use weighs against the Owner.

[43] With respect to the second criterion, which is essential for a finding of special circumstances excusing non-use, the evidence is silent as to why the Owner could not use the Mark from the registration date to the beginning of the pandemic-related restrictions ten years later. The evidence is also silent as to the reasons for non-use for the last part of the relevant period.

[44] Absent reasons explaining the absence of use of the Mark before and after the pandemic-related government restrictions, I cannot determine

whether such reasons were beyond the Owner's control. As a result, I am not satisfied the essential second criterion has been met.

[45] Lastly, with respect to the third criterion, Mr. Christilaw states that the Owner has “aggressive plans” to use the Mark in association with the Remaining Goods in the near future. In this regard, he asserts that the Owner devised a strategic plan for the fiscal years 2025-2029, which it has already started to implement. According to Mr. Christilaw, the plan includes the launch of stand-alone stores in the Americas and an Americas-focused website to accelerate the Owner’s Canadian digital business [paras 8 to 9]. However, the Owner’s intention to resume use of the Mark is insufficient on its own to excuse non-use [per *Scott Paper* at para 28].

[46] In view of the above, I am not satisfied that the Owner has demonstrated special circumstances within the meaning of section 45(3) of the Act.

DISPOSITION

[47] 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 amended to delete the following goods:

(1) Soaps namely, skin soaps, body soaps, facial soaps and cosmetic soaps; perfumery, essential oils, cosmetics, namely, beauty creams, beauty gels, beauty lotions, beauty masks, beauty milks, blush, cosmetic creams, cosmetic preparations for body care, cosmetic soaps, cosmetic sun-protecting preparations, cosmetic sun -tanning preparations, cotton buds for cosmetic purposes, eye cream, eye lotions, make up products for the face and body, foundations, make-up pencils, make-up powder, make-up removing milk, gel, lotions and creams, nail polish, nail polish removers, toiletries namely, bath oils and salts, bath soaps in liquid, solid or gel form, deodorant for personal use, shower and bath foam, shower creams, shower gels, sunscreen creams, suntan cream [self-tanning cream], toning lotion for the face, body and hands, hair care and hair colouring products, namely, hair lotions, hair colourants and dyes and hair mascara, body lotions, hand lotions, foot lotions; dentifrices; shoe cream, shoe polish, shoe wax; credit cards, debit cards, reward cards and payment cards; unencoded magnetic cards;

integrated circuit cards; encoded bank cards;, blank magnetic data carriers, namely, plastic cards with magnetic strips used in connection with payment services, blank recording discs; pre-recorded CD's, CD ROM's, tapes and discs for music; sunglasses, spectacles, sunglasses and spectacles cases and frames, contact lens and contact lens containers, protective footwear; jewellery; clocks and watches; cuff-links; buckles; precious stones; precious metals and their alloys and goods in precious metals or coated therewith, namely, platinum, rhenium, gold and silver; leather and imitations of leather, and goods made of these materials, namely, key cases, shoulder bags change purses, coin purses, attaché cases, briefcases, suitcases, luggage, leather trunks, leather briefcase like portfolios, credit card holders, rucksacks, backpacks, garment bags for travel, vanity cases sold empty, cosmetic cases sold empty, carry on bags, leather jewellery rolls and pouches; trunks, travelling bags and travelling sets, namely, suitcases for travel, shoe bags for travel and garment bags for travel handbags, purses, wallets, hat boxes, umbrellas, parasols, walking sticks; clothing, namely, leather coats, leather jackets and leather trousers, raincoats, long jackets, long coats, cloaks, coats of cotton, jackets of woolen fabric, short pants, short coats, winter jackets, blazers, blousons, pants for ladies, suits for ladies, suits, suede jackets, skirts, skirt business suits, men's business suits, anorak other than for sports, children's clothing, trousers, overalls, overcoats, overtrousers, overcoats (other than clothing for exclusive use for sports and Korean traditional clothing), one-pieces dresses, infant's clothing, evening dresses, jean pants, capes, coats, combination suits, top coats, tuxedos, feather jackets, two-piece dresses tunics, trench coats, twin sets, parkas, pants, frocks, dress of leather, blouses, shirts, t-shirts, pullovers, men's socks, headbands, shawls and stoles, shoulder wraps, shoulder scarves, scarves, socks, sock covers, wool socks, tights, head scarves and waterproof clothing, namely, water proof jackets and waterproof trousers, [...] slippers and sandals, headgear, namely, caps, hats and headscarves.

The amended statement of goods will read as follow:

(1) Footwear, namely boots, shoes.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Registered goods

(1) Soaps namely, skin soaps, body soaps, facial soaps and cosmetic soaps; perfumery, essential oils, cosmetics, namely, beauty creams, beauty gels, beauty lotions, beauty masks, beauty milks, blush, cosmetic creams, cosmetic preparations for body care, cosmetic soaps, cosmetic sun-protecting preparations, cosmetic sun -tanning preparations, cotton buds for cosmetic purposes, eye cream, eye lotions, make up products for the face and body, foundations, make-up pencils, make-up powder, make-up removing milk, gel, lotions and creams, nail polish, nail polish removers, toiletries namely, bath oils and salts, bath soaps in liquid, solid or gel form, deodorant for personal use, shower and bath foam, shower creams, shower gels, sunscreen creams, suntan cream [self-tanning cream], toning lotion for the face, body and hands, hair care and hair colouring products, namely, hair lotions, hair colourants and dyes and hair mascara, body lotions, hand lotions, foot lotions; dentifrices; shoe cream, shoe polish, shoe wax; credit cards, debit cards, reward cards and payment cards; unencoded magnetic cards; integrated circuit cards; encoded bank cards; , blank magnetic data carriers, namely, plastic cards with magnetic strips used in connection with payment services, blank recording discs; pre-recorded CD's, CD ROM's, tapes and discs for music; sunglasses, spectacles, sunglasses and spectacles cases and frames, contact lens and contact lens containers, protective footwear; jewellery; clocks and watches; cuff-links; buckles; precious stones; precious metals and their alloys and goods in precious metals or coated therewith, namely, platinum, rhenium, gold and silver; leather and imitations of leather, and goods made of these materials, namely, key cases, shoulder bags change purses, coin purses, attaché cases, briefcases, suitcases, luggage, leather trunks, leather briefcase like portfolios, credit card holders, rucksacks, backpacks, garment bags for travel, vanity cases sold empty, cosmetic cases sold empty, carry on bags, leather jewellery rolls and pouches; trunks, travelling bags and travelling sets, namely, suitcases for travel, shoe bags for travel and garment bags for travel handbags, purses, wallets, hat boxes, umbrellas, parasols, walking sticks; clothing, namely, leather coats, leather jackets and leather trousers, raincoats, long jackets, long coats, cloaks, coats of cotton, jackets of woolen fabric, short pants, short coats, winter jackets, blazers, blousons, pants for ladies, suits for ladies, suits, suede jackets, skirts, skirt business suits, men's business suits, anorak other than for sports, children's clothing, trousers, overalls, overcoats, overtrousers, overcoats (other than clothing for exclusive use for sports and Korean traditional clothing), one-pieces dresses, infant's clothing, evening dresses, jean pants, capes, coats, combination suits, top coats, tuxedos, feather jackets, two-piece dresses tunics, trench coats, twin sets, parkas, pants, frocks, dress of leather, blouses, shirts, t-shirts, pullovers, men's socks, headbands, shawls and stoles, shoulder wraps, shoulder scarves, scarves, socks, sock covers, wool socks, tights, head scarves and waterproof clothing, namely, water proof jackets and waterproof trousers,

footwear, namely boots, shoes, slippers and sandals, headgear, namely, caps, hats and headscarves.

Appearances and Agents of Record

HEARING DATE: 2024-12-10

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Stephanie Vaccari

AGENTS OF RECORD

For the Requesting Party: Lei Zhou (Witmart Inc)

For the Registered Owner: Baker & McKenzie LLP