



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 5

Date of Decision: 2025-01-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Borden Ladner Gervais LLP

Registered Owner: JAWHP, LLC

Registration: TMA1,044,194 for JOE JUST ONE EARTH JOSEPH ABBOUD &
Design

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. TMA1,044,194 for the design trademark depicted below (the Mark):



[2] The Mark, owned by JAWHP, LLC (the Owner), is registered in association with the following goods (the Goods):

(1) Eyewear, namely, optical eyeglass frames for vision correction and sunglasses; eyewear accessories, namely, eyewear cases, straps, neck cords which restrain eyewear from movement on a wearer

(2) Watches; cufflinks; tie bars; tie clips; tie pins

(3) Small leather goods, namely, wallets, business card cases, mobile phone cases, tablet cases, portfolios, and briefcases

(4) Belts, Coats, Footwear, namely, shoes, boots and slippers, Headwear, namely, hats and caps, Jackets, Neckwear, namely, neck ties, bow ties and scarves, Shirts, Socks, Sweaters, Topcoats, Tuxedos, Underwear, Vests

(5) Pants

(6) Dress Shirts

(7) Sport Coats, Suits

[3] For the reasons set out below, I conclude that the registration ought to be maintained in respect of “jackets”, “neckwear, namely neck ties, bow ties and scarves”, “shirts”, “sweaters”, “vests”, “pants”, “dress shirts”, “sport coats” and “suits”, as well as “eyewear, namely, optical eyeglass frames for vision correction” and “eyewear accessories, namely, eyewear cases”, and amended to delete all remaining goods.

PROCEEDING

[4] At the request of Borden Ladner Gervais LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act to the Owner on June 19, 2023.

[5] The notice required the Owner to show whether the Mark was used in Canada with each of the Goods at any time within the three-year period immediately preceding the date of the section 45 notice. If not, the Owner had to provide the last date of use and the reason for the absence of use

since that date. In this case, the relevant period for showing use is June 19, 2020 to June 19, 2023 (the Relevant Period).

[6] The definition of "use" for a trademark in association with goods 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] 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 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 notice, on February 16, 2024, the Owner filed the affidavits of Jeffery Jones (the Jones Affidavit), identified as the vice president for the JOSEPH ABBOUD brand for the Owner, Jillian Marro (the

Marro Affidavit), vice president at Altair Eyewear, Inc. (Altair), exclusive licensee of the JOSEPH ABBOUD brand for use in association with eyewear and John Tighe (the Tighe Affidavit), president of Tailored Brands, Inc. (Tailored Brands), exclusive licensee of the JOSEPH ABBOUD brand for use in association with men's clothing and fashion accessories.

[10] Both parties filed written representations and attended an oral hearing that was held in conjunction with hearings for related registrations TMA1,066,389 and TMA1,044,162, both for the trademark JOE JOSEPH ABBOUD & Design, decisions for which will be issued under separate cover.

EVIDENCE

The Jones Affidavit

[11] The Jones Affidavit contains, *inter alia*, the following statements, information, and exhibits:

- The Owner owns the JOSEPH ABBOUD brand, which includes trademarks comprised of, or which include, JOSEPH ABBOUD and/or JOE, and includes the Mark (collectively, the JA Marks) [para 2].
- All business activities related to the JOSEPH ABBOUD brand are controlled and managed by the Owner. More specifically, the goods sold in association with the Mark are manufactured, sold, and provided by the Owner's network of authorized licensees [para 3].
- Although the specific terms of the license agreements with the authorized licensees are confidential, all of the licenses for the JA Marks have terms providing the Owner has control over the character and quality of the goods manufactured, sold and

provided by the licensees in association with the JA Marks [para 4].

- The Owner's licensee Altair sold "eyewear, namely, optical eyeglass frames for vision correction" and "eyewear accessories, namely, eyewear cases" in association with the JA Marks (collectively, the Altair JA Eyewear) to retailers in Canada during the Relevant Period. These retailers then sold the Altair JA Eyewear to end consumers in Canada through bricks and mortar stores and online [para 6].
- The Owner's licensee, Tailored Brands, sold "belts", "jackets", "neckwear, namely, neck ties, bow ties and scarves", "shirts", "sweaters", "vests", "pants", "dress shirts", "sport coats" and "suits" in association with the JA Marks (collectively, the JA Clothing) in Canada during the Relevant Period through Moores Clothing for Men (Moores) stores, both in bricks and mortar stores and online [para 7].
- A redacted excerpt of the annual sales report for Tailored Brands relating to sales of the JA Clothing in 2022 is attaches as Exhibit A. A chart listing specific items of JA Clothing with corresponding sum of sales and unit sales is provided [para 8].
- The Owner exercised control over the character and quality of the Altair JA Eyewear and the JA Clothing sold in Canada during the Relevant Period [para 9].
- The Relevant Period covers a period of transition and unusual circumstances in the business of the Owner with respect to the manufacture and sale of the goods "watches" and "cufflinks; tie bars; tie clips; tie pins" (the Jewellery Goods) bearing the Mark in Canada [para 10].

- The Owner only acquired the Mark, along with the other JA Marks, in March 2020. Attached as Exhibit B is a copy of the trademark assignment for the JA Marks to the Owner. Further, the Owner does not have access to the business records of the prior owner of the JA Marks [para 11].
- Following the acquisition of the JA Marks, the relationship with some of the licensees of the JA Marks, including those licensed to use the JA Marks with watches and the Jewelry Goods, were terminated [para 12].
- For watches, a new license for the JA Marks was signed around July 2020. Attached as Exhibit C is a copy of a press release dated July 29, 2020 announcing the appointment of E. Gluck Corporation (Gluck) as the new licensee of the JA Marks in association with watches and describing Gluck's intention to launch a new collection of watches associated with the JA Marks in Winter 2020 which would be available at Gluck's existing retail partners in the United States and internationally. The reference to "internationally" in the press release includes Canada as the license between the Owner and Gluck extends, among others, to Canada [para 13].
- In respect of the Jewelry Goods, notwithstanding diligent efforts, the Owner has not yet signed a new licensee for these goods [para 13].
- Further, the acquisition of the JA Marks, termination of existing license agreements, and signing of Gluck as a new licensee for watches all took place during the global COVID pandemic (the Pandemic). Attached as Exhibit C are printouts from the World Health Organization (WHO) website that show the Pandemic was declared a public health emergency of international concern by

WHO on January 30, 2020 and was not declassified as such until May 5, 2023. This period of time overlaps almost entirely with the Relevant Period [para 14].

- The Pandemic significantly affected (a) the ability of the Owner to sign a new licensee for the Jewelry Goods and (b) the ability of the Gluck, the Owner's new licensee for the JA Marks in association with watches, to develop, design, manufacture and sell watches during the Relevant Period for the following reasons:
 - Worker availability was affected due to illness and/or stay-at-home mandates;
 - Supply chain issues made it difficult to manufacture, ship, and/or sell any goods due to increased costs (in production, storage and shipping);
 - Labour shortages resulted in shipping delays, both in respect of components necessary to manufacture goods and the shipping of finished goods; and
 - Many retailers/distributors/wholesalers of watches and the Jewelry Goods were shut down and, therefore, there was no demand for new stock. This lack of demand eliminated the desire for manufacturers, such as Gluck and any other potential new licensee for the Jewelry Goods, to develop new product lines [para 15].
- Notwithstanding the above-noted difficulties, it is, and has at all times been, the Owner's intention to sell watches and Jewelry Goods bearing the Mark in Canada [para 16].

The Marro Affidavit

[12] The Marro Affidavit contains, *inter alia*, the following statements, information, and exhibits:

- Altair has been an exclusive licensee of the JOSEPH ABBOUD brand for use in association with eyewear, including, optical frames, sunglasses, readers and accessories related to eyewear since 2003 including the following design trademark [para 2]:



(the JOE JA Design Mark)

- Pursuant to the terms of a license agreement between Altair and the Owner, Altair has the exclusive rights to manufacture, distribute, advertise and sell eyewear and accessories related to eyewear in association with the JA Marks to certain categories of retailers in Canada and elsewhere [para 3].
- During the Relevant Period, Altair sold the Altair JA Eyewear to retailers in Canada. These retailers in Canada then sold the Altair JA Eyewear to end consumers in Canada, both in stores and online [para 4].
- Attached as Exhibit A are photographs showing examples of the Altair JA Eyewear representative of those sold to retailers in Canada during the Relevant Period [para 5].
- Attached as Exhibit B is a photograph showing examples of the Altair JA Eyewear on display in a store in Canada during the Relevant Period. The JOE JA Design Mark was displayed on each of the Altair JA Eyewear products sold to retailers in Canada during the Relevant Period in a manner identical or similar to the samples depicted in Exhibits A and B [para 5].

- Attached as Exhibit C are representative invoices relating to sales of Altair JA Eyewear to stores in Canada during the Relevant Period [para 6]. These invoices show sales from Marchon Canada (located in Quebec), which is a company with common ownership and control as Altair, to FYi doctors stores in Canada. The Altair JA Eyewear products are received by the purchaser within a week of being shipped [para 7].
- The Altair JA Eyewear listed in the invoices in Exhibit C are comprised of a package that included both eyewear frames and cases in a manner identical or similar to the representative examples shown in Exhibits A and B [para 8].

The Tighe Affidavit

[13] The Tighe Affidavit contains, *inter alia*, the following statements, information, and exhibits:

- Tailored Brands has been an exclusive licensee of the JOSEPH ABBOUD brand, which includes the Mark, for use in association with men's clothing and fashion accessories since March 2020 [para 2].
- During the Relevant Period, Tailored Brands sold the JA Clothing in association with the Mark in Canada specifically at Moores stores, both at bricks and mortar stores and online [para 4].
- Attached as Exhibit A are photographs of items of men's clothing and accessories showing goods (and hangtags for goods) representative of those sold through Moores stores in Canada during the Relevant Period. As shown in the images, the Mark appears on labels and/or hangtags affixed to all of the goods [para 5].

- Attached as Exhibit B is a redacted excerpt of the annual sales report of Tailored Brands relating to sales in 2022 for goods sold through Moores stores (both in store and online). The annual sales reports are prepared by Tailored Brands and provided to the Owner in the ordinary course of business for the purposes of reporting royalties [para 6].
- All orders made through Moores online would have been shipped to a Canadian address as this is the only option through the Moores website, and all goods ordered through the Moores website are received by customers within no more than one to two weeks of date of purchase [para 6].

ANALYSIS

Goods for Which Use is Asserted

The JA Clothing

[14] The Owner asserts that the Mark was used in Canada during the Relevant Period in association with the JA Clothing, an assertion which is supported by the Jones and Tighe Affidavits.

[15] Having reviewed the evidence of record, with the exception of “belts”, I am satisfied that the Owner has evidenced use of the Mark with the JA Clothing in Canada during the Relevant Period. Specifically, the Tighe Affidavit establishes that during the Relevant Period, the Mark was displayed on the JA Clothing or on labels or hangtags attached to the JA Clothing, with the exception of “belts” [Tighe Affidavit, para 6, Exhibits A and B].

[16] While both the Jones Affidavit and the Tighe Affidavit contain statements that the Mark was used with “belts” in Canada during the Relevant Period, unlike the remaining JA Clothing, there is no reference to actual sales of belts, nor any images of belts bearing the Mark in either the

Jones or Tighe Affidavits. While I acknowledge that in section 45 proceedings an affiant's sworn statement is to be accepted at face value and must be accorded substantial credibility in the absence of evidence to the contrary [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc.*, 2018 TMOB 79], and both the Jones and Tighe Affidavits contain sworn statements regarding representative sales and examples of the Mark used in association with the JA Clothing, in both affidavits "belts" are completely absent from either the detailed sales figures or representative images. I also note that the Jones Affidavit contains the statement "...the following goods were sold through [Moore's] in Canada in 2022" followed by a table listing all of the JA Clothing with the exception of "belts" [para 8]. The Tighe Affidavit contains a similar statement followed by a table of goods sold in Canada in 2022 which also omits "belts" [para 6]. Given the discrepancy between the general statements that the Mark was used with all of the JA Clothing in Canada during the Relevant Period, and the actual evidence of use of record, I am of the view that the Owner's assertions of use of the Mark in association with "belts" are bare assertions and, therefore, not sufficient to support a finding of use with these goods [*Aerosol Fillers Inc v Plough (Canada) Ltd* (1979), 45 CPR (2d) 194 (FCTD) aff'd (1980) 53 CPR (2d) 62 (FCA)].

[17] The Requesting Party argues that the evidence does not support use of the Mark in association with "suits" given that it is not clear in the images of clothing in the exhibits to the Tighe Affidavit depict "suits" or "...simply a suit jacket, a blazer, a sport coat, or something else" [written representations, para 67]. However, while it may not be clear that the images attached to the Tighe Affidavit are definitively "suits", I am satisfied that the sworn statements in the Tighe Affidavit attesting to use of the Mark with suits in Canada during the Relevant Period, along with the annual sales report for 2022 that lists at least three categories of suits in the division column provide sufficient facts to support the conclusion that the Mark was used

with suits in Canada during the Relevant Period, keeping in mind the low evidentiary threshold for establishing use in section 45 proceedings [Tighe Affidavit, paras 4, 6 and Exhibit B].

[18] Accordingly, the registration for the Mark will be maintained in respect of “jackets”, “neckwear, namely neck ties, bow ties and scarves”, “shirts”, “sweaters”, “vests”, “pants”, “dress shirts”, “sport coats” and “suits”.

The Altair JA Eyewear

[19] The Owner relies on the Marro Affidavit to demonstrate use of the Mark in association with eyewear through its licensee Altair. However, the evidence provided in the Marro Affidavit does not evidence use of the Mark at issue in this proceeding, but rather use of the JOE JA Design Mark depicted in paragraph 12 above. Accordingly, the first issue to be determined is whether use of the JOE JA Design Mark constitutes use of the Mark.

[20] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 1985 CanLII 5537 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 1992 CanLII 12831 (FCA)] and consider whether the differences between the marks are “so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin” [*Honeywell Bull*]. The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of

use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[21] The Requesting Party submits the JOE JA Design Mark is missing a dominant feature of the Mark, namely the phrase “JUST ONE EARTH” located above the letter O in JOE in a semi circular shape in the Mark [written representations, para 55]. However, in my view, the dominant feature of the Mark is the word JOE with the globe design in the centre of the O. This dominant element is preserved in the trademark as used, being the JOE JA Design Mark, and, accordingly, I consider the use of the JOE JA Design Mark to constitute use of the Mark. In this respect, I also note that the Mark and the JOE JA Design Mark have the same wording under the dominant word JOE, namely, the name JOSEPH ABBOUD. This additional consistency between the Mark and the JOE JA Design Mark further supports the finding that the trademark in the form as used did not lose its identity and remains recognizable as the Mark. While it is clear that the JOE JA Design Mark differs from the Mark given the omission of the wording “JUST ONE EARTH” above the letter O in the word JOE, the fact that this wording is in a much smaller font than the remaining elements of the Mark and, overall, comprises a minor element of the Mark, leads me to conclude that an unaware purchaser would likely infer that the Goods associated with the JOE JA Design Mark have the same origin as the Mark.

[22] While the Requesting Party points to the fact that the Owner has separate registrations for the Mark and the JOE JA Design Mark to support its assertion that the Mark and the JOE JA Design Mark are separate and distinct trademarks, nothing precludes an owner from using 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)].

[23] As I have concluded that use of the JOE JA Design Mark constitutes use of the Mark, what remains to be determined is whether the Mark was used with the Altair JA Eyewear in Canada during the Relevant Period and whether this use accrued to the benefit of the Owner.

[24] With respect to the latter, I am satisfied based on the sworn statements in the Jones Affidavit that the Owner maintained the requisite control over the character and quality of the Altair JA Eyewear during the Relevant Period such that use of the Mark by Altair is deemed use by the Owner pursuant to section 50 of the Act.

[25] With respect to use of the Mark during the Relevant Period, as summarized above, the Marro Affidavit confirms that Altair sold the Altair JA Eyewear in association with the JOE JA Design Mark in Canada during the Relevant Period to retailers, who in turn sold the Altair JA Eyewear to end consumers in Canada, both in stores and online [para 4]. The exhibits to the Marro Affidavit include images of eyeglass frames with lenses depicting the JOE JA Design Mark as well as eyeglass cases branded with the JOE JA Design Mark and invoices for sales of the Altair JA Eyewear to retailers in Canada during the Relevant Period [paras 5 to 7, Exhibits A to C]. Finally, the Marro Affidavit contains the statement that the Altair JA Eyewear listed on the invoices in Exhibit C “comprised a package that included both an eyewear frame and eyewear case” both displaying the JOE JA Design Mark [para 8].

[26] While the Requesting Party has argued that the Mark is not depicted on the eyeglass frames *per se* and is rather depicted on the lenses in the frames, I find this argument has little merit given that the JOE JA Design Mark is clearly very closely associated with the frames and, in my view, falls within the “in any 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” provision of section 4(1) of the Act.

[27] Overall, I am satisfied that the evidence establishes use of the Mark in Canada during the Relevant Period in association with the Altair JA Eyewear and, as such, the registration for the Mark will be maintained in respect of “eyewear, namely, optical eyeglass frames for vision correction” and “eyewear accessories, namely, eyewear cases” and amended to delete the remaining eyewear and eyewear accessories.

Goods for Which Special Circumstances Excusing Use are Asserted

[28] As it is clear from the evidence of record that there was no use of the Mark with watches and Jewellery Goods in Canada during the Relevant Period, what must be assessed is whether the Owner has established that special circumstances existed during the Relevant Period that excuse the lack of use.

[29] In determining whether special circumstances have been established, the Registrar must first determine why the trademark was not used during the relevant period. Second, the Registrar must determine whether these reasons for non-use constitute special circumstances [*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)].

[30] If the Registrar determines that the reasons for non-use constitute special circumstances, the Registrar must still decide whether such special circumstances excuse the period of non-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 [*Harris Knitting Mills*].

[31] As set out above in the summary of the Jones Affidavit, the circumstances surrounding the lack of use of the Mark with watches are more complex than the lack of use with the Jewellery Goods. I will therefore address each of these circumstances separately below.

Do Special Circumstances Excuse Non-use with Watches?

[32] The Owner submits that the combination of acquiring rights in the Mark only a few months prior to the Relevant Period, the significant transitions associated with the acquisition of the Mark, the termination of relationships with certain licensees of the Mark (including the licensee for the Mark in association with watches), the signing of a new licensee for watches in approximately July 2020, and the negative effects of the Pandemic on business and trade represent special circumstances [Jones Affidavit, paras 7 to 9 and 11].

[33] The Requesting Party submits that the Owner's reasons for the lack of use with certain goods, including watches, do not constitute special circumstances as:

- It is not uncommon to purchase entire trademark portfolios, and while a recent assignment might excuse a short absence of use, this alone cannot be considered a special circumstance [written representations, para 35];
- As the Mark was acquired by the Owner three months before the Relevant Period, the Owner had a total of three years and three months to commence use of the Mark. Three years is considered to be the usual time post-registration of a trade mark to commence use of the mark (based on the time at which

section 45 proceedings can be commenced). Accordingly, the Requesting Party submits that the Owner, as an assignee of the Mark, had sufficient time to commence use of the Mark [written representations, para 38];

- The Owner provided no evidence to support that significant transition and little carry-over of employees after the acquisition of the Mark was unusual or uncommon when a trademark portfolio is purchased [written representations, para 39]. Further, as the fact the Owner states that there was “little carry-over of employees” implies that there was some carry-over of employees and, therefore, this fact does not amount to a special circumstance [written representations, para 40];
- While the Owner’s evidence provides that relationships with some licensees of the Mark were terminated following the acquisition of the Mark, the Owner provides no explanation as to why the licensees were terminated. There is no evidence that the terminations were not merely business decisions on the part of the Owner [written representations, paras 43 and 44]; and
- The Owner also does not provide information on any steps taken to rectify the non-use of the Mark with watches by the new licensee, despite the fact that the Owner must have been aware that the new licensee was not meeting its purported target (being an expected launch of a new watch collection in Winter 2020) [written representations, para 46].

[34] With respect to the Owner’s evidence relating to minimal carry-over of employees and termination of relationships with licensees following the acquisition of the JA Marks, I agree with the Requesting Party that the Owner’s evidence does not make it clear whether the loss of employees and licensees were common in such cases (*i.e.* the acquisition of a trademark

portfolio) or whether these were matters within or beyond the control of the Owner. In any event, as the Owner entered into a new licence agreement with Gluck around July 2020, approximately three to four months after the acquisition of the JA Marks, it does not appear that either the loss of several employees or the termination of certain relationships with former licensees, were, individually or in combination, special circumstances that posed long term challenges to entering new licence agreements for the Goods.

[35] Having entered into a new license agreement with Gluck for use of the Mark with watches, the only further special circumstance relied on by the Owner for the lack of use of the Mark with watches during the Relevant Period is the Pandemic. More specifically, the Owner asserts that the Pandemic overlapped with almost the entire Relevant Period restricting worker availability, causing supply chain issues, increasing costs and causing a lack of demand for goods, including watches. This lack of demand eliminated the desire for manufacturers such as Gluck to develop new lines of goods, such as watches associated with the Mark [Jones Affidavit, para 11].

[36] Overall, I am willing to accept that the combination of the acquisition of the Mark shortly after the commencement of the Relevant Period, the transitional challenges associated with the acquisition in combination with the Pandemic covering almost all of the Relevant Period, constitute special circumstances. What must now be determined is whether these special circumstances excuse the lack of use of the Mark during the Relevant Period in accordance with the three-part *Harris Knitting Mills* test.

[37] With respect to the first criterion of the *Harris Knitting Mills* test, while the period of non-use is generally calculated from the last known date of use of the trademark, in the present case, the Owner has attested to the fact that it has no access to the records of the previous owner and provides no

last known date of use of the Mark. Given the lack of evidence of actual use of the Mark, and considering the acquisition of the Mark occurred less than two months after the commencement of the Relevant Period, the period of non-use will be assessed from the March 2020 acquisition date [see *Centric Brands Holding LLC v Stikeman Elliott LLP*, 2024 FC 204 at para 40].

[38] With respect to the second criterion of the *Harris Knitting Mills* test, for reasons specified by the Owner in its evidence [Jones Affidavit, para 11], I am satisfied that the trade and commerce challenges posed by the Pandemic were beyond the control of the Owner. Accordingly, the fact that the Owner had not commenced use of the Mark three years and three months after its acquisition is not particularly noteworthy in this case given that the majority of the Relevant Period overlapped with the Pandemic.

[39] Finally, for special circumstances to excuse non-use of a trademark during the relevant period, there must be a clear intention to shortly resume use of the trademark. To satisfy this third criterion of the *Harris Knitting Mills* test, the serious intent to shortly commence use of a trademark must be substantiated by factual elements [*Molson, supra*; *Arrowhead Spring Water Ltd v Arrowhead Water Corp* (1993), 47 CPR (3d) 217 (FCTD); *NTD Apparel Inc v Ryan* 2003 FCT 780].

[40] In the present case, the Owner's evidence contains the statement that it is, and has at all times been, the Owner's intention to sell watches in association with the Mark in Canada [Jones Affidavit, para 12], but provides no information as to what steps the Owner has taken to commence use of the Mark or details of any plans to commence such use. Accordingly, the Owner's evidence merely provides a bald assertion that it intends to use the Mark in association with watches in Canada.

[41] As the Owner has not provided any facts to substantiate the commencement of use of the Mark with watches, it has failed to establish it had a serious intention to commence such use. Accordingly, the Owner has failed to establish special circumstances that excuse the period of non-use of the Mark with watches.

Do Special Circumstances Excuse Non-use with the Jewellery Goods?

[42] The Owner's evidence and submissions regarding the absence of use of the Mark with the Jewellery Goods is more limited than those for watches.

[43] Essentially, the Owner's evidence in respect of the Jewellery Goods is based solely on the acquisition of the Mark approximately three months prior to the commencement of the Relevant Period, and the effects on business and trade during the Pandemic, which coincide with most of the Relevant Period.

[44] Despite the statement in the Jones Affidavit that the Owner has at all times intended to sell the Jewellery Goods in association with the Mark in Canada, as with the watches, there are no facts in the evidentiary record that allow me to conclude that the Owner has a serious intention to shortly commence use of the Mark with the Jewellery Goods. The Owner has not provided any information as to steps it took to secure new licensing arrangements for use of the Mark with the Jewellery Goods or what steps it has taken or plans to take to shortly commence use.

[45] Accordingly, the Owner has failed to establish special circumstances that excuse the period of non-use of the Mark with the Jewellery Goods.

Goods for which No Use or Special Circumstances are Asserted

[46] The Owner has filed no evidence of use with "small leather goods, namely, wallets, business card cases, mobile phone cases, tablet cases,

portfolios, and briefcases” or “eyewear accessories, namely, ...straps, neck cords which restrain eyewear from movement on a wearer”, nor has it submitted any evidence or arguments in support of special circumstances that would excuse the lack of use of the Mark with these goods in Canada during the Relevant Period. Accordingly, all of these goods will be deleted from the registration for the Mark.

DISPOSITION

[47] 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 in respect of “jackets”, “neckwear, namely neck ties, bow ties and scarves”, “shirts”, “sweaters”, “vests”, “pants”, “dress shirts”, “sport coats” and “suits”, as well as “eyewear, namely, optical eyeglass frames for vision correction” and “eyewear accessories, namely, eyewear cases”, and amended to delete all remaining goods.

Leigh Walters
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-10-17

APPEARANCES

For the Requesting Party: Jeff Gordon and David Schnittker

For the Registered Owner: Kevin Graham

AGENTS OF RECORD

For the Requesting Party: Borden Ladner Gervais LLP

For the Registered Owner: Stikeman Elliott S.E.N.C.R.L., SRL/LLP