



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 15

Date of Decision: 2025-01-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Regeena Lifeso

Registered Owner: Toys “R” Us (Canada) Ltd.

Registration: TMA876865 for KOALA BABY & Design

[1] At the request of Regeena Lifeso (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on July 11, 2023, to Toys “R” Us (Canada) Ltd. (the Owner), in respect of its trademark registration No. TMA876865, for the trademark KOALA BABY & Design (the Mark), shown below.



[2] The Mark is registered in association with a wide variety of goods in the nature of clothing for infants and children. The complete statement of goods is reproduced in Schedule A to this decision.

[3] At the request of the Requesting Party, the notice was limited to the following goods (the Goods at Issue):

- coats;
- knit shirts;
- woven shirts;
- pullovers;
- hooded shirts;
- hooded jackets;
- blouses;
- coveralls;
- jackets;
- jeans;
- jogging suits;
- jumpers;
- jumpsuits;
- shortalls;
- knit shirts;
- woven shirts;
- gowns and caps;
- overalls;
- rain coats;
- rain jackets;
- rainwear;
- sandals;
- skorts;

- snow suits;
- socks;
- swimwear coverups;
- tights; and
- wind resistant jackets.

[4] The notice required the Owner to show whether the Mark was used in Canada, in association with the Goods at Issue, at any time within the three-year period immediately preceding the date of the notice. If the Mark had not been so used, the notice required the Owner to show when it was last in use and the reason for the absence of use since that date.

[5] Section 4 of the Act defines trademark use in association with goods 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.

...

(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.

[6] In this case, the relevant period for showing use is July 11, 2020 to July 11, 2023.

[7] In the absence of use, pursuant to section 45(3) of the Act, the registration is liable to be amended, unless the absence of use is due to special circumstances that excuse the absence of use.

[8] For the reasons that follow, the registration will be amended to remove the Goods at Issue.

THE PROCEEDING AND THE EVIDENCE

[9] In response to the Registrar's notice, the Owner furnished an affidavit of Amanda Jazvac, solemnly affirmed on February 12, 2024 (the Jazvac Affidavit). Only the Requesting Party submitted written representations. Both parties were represented at a hearing.

[10] Ms. Jazvac is a Director of Merchandising for the Owner [para 1]. She describes the Owner as the operator of the well-known toy store and baby store chains Toys R Us and Babies R Us [para 2].

[11] Ms. Jazvac states that the Owner sells a wide variety of products bearing the Mark, and provides a list of 36 different products that were sold by the Owner, bearing the Mark, during the relevant period [para 10].

[12] Ms. Jazvac states that, despite her inquiries, no one internal to the Owner was able to confirm when the Owner first or last used the Mark in association with the Goods at Issue [para 16]. She explains that this is because the Owner only has sales data going back to 2018, which in turn is due to the bankruptcy of both the Owner and its former parent company in September 2017 [paras 12-13]. Ms. Jazvac states that, because its former parent company no longer exists, the Owner has no means of accessing sales data from before 2018 [para 14].

[13] Ms. Jazvac explains that, due to the bankruptcy, the Owner lost relationships it had with the vendors that supplied it with the goods it had sold in association with the Mark [para 17]. The Owner also had to restructure its operations to maintain liquidity [para 18]. The Owner decided to "focus on selling baby items (e.g. nursing cushions, bibs, burp cloths,

onesies, etc.), with a view to restarting use of the Mark with other items once [the Owner] had new vendors for sourcing these products, among other reasons” [para 18].

[14] In 2020, the COVID-19 pandemic began. The Owner’s retail stores were closed or were subject to customer capacity restrictions and social distancing rules [para 19], and the Owner faced uncertainty in its cash flow and difficulties getting products from vendors [paras 20-21]. The Owner continued selling products via its website or via curbside pickup [para 19], but in view of the uncertainty it faced, the Owner “decided to not restart use of the Mark” in association with the Goods at Issue during the pandemic [para 22]. The Owner reduced but did not stop ordering other products for sale in association with the Mark [para 23], and earned approximately \$19 million from sales of other products, in association with the Mark, during the years 2020-2022 [para 26].

[15] According to Ms. Jazvac, as of some time between 2022 and 2023, the Owner was in a position to further develop its brands, including the Mark [para 24]. As of February 12, 2024, the date of Ms. Jazvac’s affidavit, while the Owner was selling many of the Goods at Issue in Canada under other trademarks, the Owner had “not made any final decisions” regarding use of the Mark in association with the Goods at Issue [paras 33 and 34].

REASONS FOR DECISION

[16] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act.

[17] The burden of proof in section 45 proceedings is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9]. That being said, sufficient facts must still be provided to allow the Registrar to conclude that the trademark was used in association with the relevant goods or services.

Use in association with the Goods at Issue

[18] Ms. Jazvac states that the Owner sold the goods listed in paragraph 10 of her affidavit, bearing the Mark, during the relevant period. Paragraph 10 of Ms. Jazvac's affidavit does not include any of the Goods at Issue, with the sole exception of "sandals".

[19] With regard to "sandals", the Requesting Party argues that mere assertions of use such as that in paragraph 10 of the Jazvac Affidavit are not sufficient to demonstrate use in the context of section 45 proceedings [Requesting Party's written representations, para 7]. Further, the Requesting Party notes that the Jazvac Affidavit includes tables listing specific products that were sold in association with the Mark during the relevant period, and the numbers of units of each product sold for each of the years 2020-2023 [Jazvac Affidavit, paras 27-28], but that "sandals" are not listed in the tables.

[20] In my view, the evidence does not establish that the Owner sold any sandals in association with the Mark during the Relevant Period. The absence of sandals from the detailed sales information for the relevant period, provided in paras 27-28 of the Jazvac Affidavit, contradicts Ms. Jazvac's assertion in paragraph 10 that sandals were sold during the relevant period. In view of the conflicting evidence on this point, I am not satisfied that sandals were in fact sold by the Owner during the relevant period.

[21] With regard to the remaining Goods at Issue, it is clear that none of them are listed in paragraph 10 of the Jazvac Affidavit. Accordingly, the evidence does not establish that any of the Goods at Issue were exported or sold in Canada in association with the Mark during the relevant period. Since section 4 of the Act requires either export of marked goods or a transfer of property in or possession of goods in order for trademark use to occur, the evidence does not establish any use of the Mark, in association with the Goods at Issue, during the relevant period.

Special circumstances excusing non-use

[22] The general rule is that absence of use will be penalized by expungement, but there may be an exception where the absence of use is excusable due to special circumstances [*Scott Paper Ltd v Smart & Biggar*, 2008 FCA 129 (*Scott Paper*)]. To determine whether the exception is applicable, it must first be determined why in fact the trademark was not used during the relevant period. Then, it must be determined whether the reasons for non-use constitute special circumstances. The Federal Court has held that special circumstances are circumstances that are “unusual, uncommon, or exceptional” [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD) at para 29].

[23] If the reasons for non-use constitute special circumstances, it must then be determined whether the 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 [*Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)].

Reasons for non-use

[24] The Requesting Party argues that non-use of the Mark during the relevant period was due to voluntary business decisions made by the Owner, both in response to the Owner's bankruptcy and the pandemic [Requesting Party's written representations, paras 19 and 26]. At the hearing, the Owner argued that the characterization of the reasons for non-use as voluntary business decisions does not do justice to the Owner's evidence. The Owner argued that, in the circumstances of the Owner's bankruptcy and the pandemic, it was not practical or commercially viable to use the Mark in association with the Goods at Issue during the relevant period.

[25] The evidence is clear that, after the Owner's bankruptcy and prior to the relevant period, the Owner decided to "focus on selling baby items ..." rather than the Goods at Issue [Jazvac Affidavit, para 18]. The evidence is also clear that, during the relevant period, the Owner decided not to use the Mark in association with the Goods at Issue due to the challenges and uncertainties caused by the pandemic [Jazvac Affidavit, paras 20-22]. However, even if I were to accept the Owner's framing of the issue, contrary to the Owner's assertions, the evidence does not establish that the Owner had no practical or commercially-viable alternative to these decisions.

[26] With regard to the Owner's bankruptcy, Ms. Jazvac points to a "restructuring of its operations to maintain liquidity" [Jazvac Affidavit, para 18], and the loss of vendors that supplied the Goods at Issue [Jazvac Affidavit, para 17] as reasons why it could not use the Mark in association with those goods after the Owner's bankruptcy. However, her affidavit is not clear as to how the "restructuring" impeded or prevented the Owner from finding new vendors. Her affidavit also does not state what the Owner did to secure new vendors during the period between the Owner's bankruptcy and the beginning of the relevant period, and why the Owner was not successful.

Without such details, it is at best not clear whether the Owner had a viable alternative to not using the Mark in association with the Goods at Issue, during the period between the Owner's bankruptcy and the pandemic.

[27] Ms. Jazvac also does not provide any evidence of what would have been required to obtain the Goods at Issue during the pandemic (and the relevant period). She also does not provide any details of the "uncertainty" in the Owner's cash flow, and does not evidence whether it jeopardized the Owner's ability to obtain the Goods at Issue. Without details of what it would have taken to use the Mark in association with the Goods at Issue, it is not clear just how impractical or not viable it would have been to use the Mark during the pandemic, in association with the Goods at Issue.

[28] The deficiencies in the evidence become even more significant when considered in relation to what the evidence does say about the Owner's business during the pandemic. In particular, the Owner reduced - but nonetheless continued - to order *other* products for sale in association with the Mark [Jazvac Affidavit, para 23], and made millions of dollars in sales of such other products in association with the Mark [Jazvac Affidavit, para 26]. In the face of evidence that the Owner was able to continue extensive use of the Mark in association with other goods, and no details as to why use in association with the Goods at Issue was not practical or commercially viable, I am unable to conclude that the Owner had no viable option but to not use the Mark, in association with the Goods at Issue. Rather than being unable to use the Mark in association with the Goods at Issue, it would appear that the Owner simply chose to prioritize other goods over the Goods at Issue.

[29] Finally, as of some time between 2022 and 2023, which roughly corresponds to the final year of the relevant period, the Owner was "in a position to further develop and expand its private label brands, including the Mark" [Jazvac Affidavit, para 24]. As of the date of Ms. Jazvac's affidavit,

approximately seven months after the end the relevant period, the Owner was selling many of the Goods at Issue in Canada in association with *other* trademarks, and had been “actively discussing restarting sales of the Goods at Issue with the Mark...” [paras 33 and 34]. However, the Owner had “not made any final decisions” with respect to use of the Mark in association with the Goods at Issue [para 34]. In other words, for a period of approximately 19 months after the pandemic-related challenges subsided, and more than six years after the Owner’s bankruptcy, the Owner had been in a position to restart use of the Mark in association with the Goods at Issue but had still not decided whether to do so. This indicates that the challenges caused by the bankruptcy and the pandemic were not the primary reasons why the Owner was not using the Mark in association with the Goods at Issue, during the relevant period. Rather, it would appear that, in addition to prioritizing other goods over the Goods at Issue, the Owner chose to prioritize other brands and trademarks over the Mark.

[30] In view of the foregoing, I find that the reason for non-use of the Mark, in association with the Goods at Issue, during the relevant period, was the Owner’s decisions not to use the Mark with these goods. I am not satisfied that the Owner’s bankruptcy and the pandemic, and the challenges they created, left the Owner with “no viable alternative” but to not use the Mark in association with the Goods at Issue, as argued by the Owner.

Whether reasons for non-use constitute special circumstances

[31] Whether or not they were impacted or influenced by the Owner’s bankruptcy and the pandemic, I am not satisfied that the reasons for non-use in this case are the sort of “unusual, uncommon or exceptional” reasons that constitute special circumstances within the meaning of section 45 of the Act. Per my finding above, the reason why the Mark was not used during the relevant period was that the Owner had decided not to use the Mark in

association with the Goods at Issue. While the challenges that arose due to the Owner's bankruptcy and the pandemic likely played a role in this decision, challenging business conditions do not amount to "uncommon, unusual or exceptional" circumstances [see, for example, *Gowling WLG (Canada) LLP v Winebow, Inc*, 2023 TMOB 219 at para 26]. Accordingly, the absence of use in association with the Goods at Issue is not due to "special circumstances", within the meaning of section 45 of the Act. This alone is sufficient to justify the removal of the Goods at Issue from the registration.

Whether circumstances excuse non-use

[32] Even if the absence of use could be attributable to special circumstances within the meaning of section 45 of the Act, I would not be satisfied that non-use would be excused in this case. In particular, the length of non-use by the Owner, and the apparent absence of an intention to shortly resume use both weigh against the Owner in this case.

[33] Regarding the length of non-use, the Requesting Party notes that the date of registration of the Mark (May 1, 2014) should be deemed to be the date of last use, because the Owner does not know when it last used the Mark in association with the Goods at Issue [Requesting Party's written representations, paras 12-13, citing Jazvac Affidavit, para 16]. At the hearing, the Owner argued that the unavailability of sales records prior to 2018 due to bankruptcy should be taken into consideration, and the period of non-use should be deemed to have commenced in 2018.

[34] Regardless of whether considered from 2014 or 2018, I find that the length of non-use does not favour the Owner's position. As of the end of the relevant period, the Mark had not been in use in association with the Goods at Issue for at least five years, despite use of the Mark in association with other goods during that period. The challenges faced by the Owner at the

time of its bankruptcy, and during the pandemic, do not excuse such a lengthy period of non-use, in my view.

[35] In addition, I am not satisfied that the Owner has demonstrated a serious intention to shortly resume use of the Mark. At the hearing, the Owner argued that its intention to resume use was evidenced by the following: (i) plans to sell several broad categories of products in association with the Mark in the near future [Jazvac Affidavit, paras 30-32 and Exhibits W-Y]; (ii) the fact that it is now selling many of the Goods at Issue in association with other trademarks [para 33 and Exhibits Z-DD]; and (iii) the fact that the Owner is “actively discussing restarting sales” of the Goods at Issue with the Mark [para 34]. However, while the Owner’s evidence establishes that it is *considering* restarting use of the Mark in association with the Goods at Issue, it does not establish any serious *intention* to restart use. Indeed, Ms. Jazvac explicitly states that no decision about use of the Mark, in association with the Goods at Issue, has been made [para 34], meaning that no serious intention to resume use has been formed.

[36] For at least the foregoing reasons, even if non-use of the Mark was the result of “special circumstances” within the meaning of section 45 of the Act, I would not find that such circumstances excuse the absence of use in this case.

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 remove the Goods at Issue. The amended statement of goods can be found in Schedule B to this decision.

Jaimie Bordman
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Original statement of goods of registration No. TMA876865

(1) Clothing for infants and children, namely, baby bibs not of paper, body suits, bonnets, booties, bottoms, namely pants, baby pants, leggings and pajama bottoms, caps, cardigans, coats, coordinating sets comprising tops namely, children's shirts, knit shirts, woven shirts, collared shirts, pullovers, hooded shirts, hooded sweatshirts, hooded jackets, bodysuits, sweaters, t-shirts, blouses, pajama tops and diaper shirts and bottoms namely pants, baby pants, leggings and pajama bottoms, coveralls, creepers, dresses, hats, jackets, jeans, jogging suits, jumpers, jumpsuits, layette sets comprising shortalls and tops namely, children's shirts, knit shirts, woven shirts, collared shirts, pullovers, hooded shirts, hooded sweatshirts, hooded jackets, bodysuits, sweaters, t-shirts, blouses, pajama tops and diaper shirts, layette sets comprising tops namely, children's shirts, knit shirts, woven shirts, collared shirts, pullovers, hooded shirts, hooded sweatshirts, hooded jackets, bodysuits, sweaters, t-shirts, blouses, pajama tops and diaper shirts and pants, layette sets comprising gowns and caps, layette sets comprising overalls and tops namely, children's shirts, knit shirts, woven shirts, collared shirts, pullovers, hooded shirts, hooded sweatshirts, hooded jackets, bodysuits, sweaters, t-shirts, blouses, pajama tops and diaper shirts, layette sets comprising cardigans and pants, layette sets comprising creepers and pants, layette sets comprising cardigans, tops namely, children's shirts, knit shirts, woven shirts, collared shirts, pullovers, hooded shirts, hooded sweatshirts, hooded jackets, bodysuits, sweaters, t-shirts, blouses, pajama tops and diaper shirts and pants, layettes, mittens, overall sets comprising overalls and tops namely, children's shirts, knit shirts, woven shirts, collared shirts, pullovers, hooded shirts, hooded sweatshirts, hooded jackets, bodysuits, sweaters, t-shirts, blouses, pajama tops and diaper shirt, overalls, pants, rain coats, rain jackets, rainwear, rompers, sandals, shirts, short sets, shortall sets comprising shortalls and tops namely, children's shirts, knit shirts, woven shirts, collared shirts, pullovers, hooded shirts, hooded sweatshirts, hooded jackets, bodysuits, sweaters, t-shirts, blouses, pajama tops and diaper shirts, shortalls, shorts, skirts, skorts, sleepwear, snow suits, socks, sweat shirts, sweat pants, sweaters, swimsuits, swimwear sets comprising swimsuits and coverups, swimwear sets comprising swim trunks and coverups, tee-shirts, tights, tops namely, children's shirts, knit shirts, woven shirts, collared shirts, pullovers, hooded shirts, hooded sweatshirts, hooded jackets, bodysuits, sweaters, t-shirts, blouses, pajama tops and diaper shirts, and wind resistant jackets.

SCHEDULE B

Amended statement of goods of registration No. TMA876865

(1) Clothing for infants and children, namely, baby bibs not of paper, body suits, bonnets, booties, bottoms, namely pants, baby pants, leggings and pajama bottoms, caps, cardigans, coordinating sets comprising tops namely, children's shirts, collared shirts, hooded sweatshirts, bodysuits, sweaters, t-shirts, pajama tops and diaper shirts and bottoms namely pants, baby pants, leggings and pajama bottoms, creepers, dresses, hats, layette sets comprising tops namely, children's shirts, collared shirts, hooded sweatshirts, bodysuits, sweaters, t-shirts, pajama tops and diaper shirts, layette sets comprising tops namely, children's shirts, collared shirts, hooded sweatshirts, bodysuits, sweaters, t-shirts, pajama tops and diaper shirts and pants, layette sets comprising tops namely, children's shirts, collared shirts, hooded sweatshirts, bodysuits, sweaters, t-shirts, pajama tops and diaper shirts, layette sets comprising cardigans and pants, layette sets comprising creepers and pants, layette sets comprising cardigans, tops namely, children's shirts, collared shirts, hooded sweatshirts, bodysuits, sweaters, t-shirts, pajama tops and diaper shirts and pants, layettes, mittens, sets comprising tops namely, children's shirts, collared shirts, hooded sweatshirts, bodysuits, sweaters, t-shirts, pajama tops and diaper shirt, pants, rompers, shirts, short sets, sets comprising tops namely, children's shirts, collared shirts, hooded sweatshirts, bodysuits, sweaters, t-shirts, pajama tops and diaper shirts, shorts, skirts, sleepwear, sweat shirts, sweat pants, sweaters, swimsuits, swimwear sets comprising swimsuits, swimwear sets comprising swim trunks, tee-shirts, tops namely, children's shirts, collared shirts, hooded sweatshirts, bodysuits, sweaters, t-shirts, pajama tops and diaper shirts.

Appearances and Agents of Record

HEARING DATE: 2024-10-10

APPEARANCES

For the Requesting Party: Regeena Lifeso

For the Registered Owner: Lawrence Veregin

AGENTS OF RECORD

For the Requesting Party: No agent appointed

For the Registered Owner: Aird & Berlis LLP