



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 135

Date of Decision: 2025-06-27

IN THE MATTER OF A SECTION 45 PROCEEDING

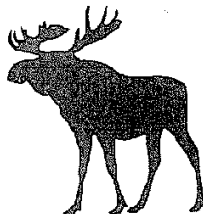
Requesting Party: 14095863 CANADA INC.

Registered Owner: Abercrombie & Fitch Trading Co., an Ohio corporation

Registration: TMA730,185 for Solid Moose Design

THE RECORD

[1] At the request of 14095863 CANADA INC. (the Requesting Party), the Registrar of Trademarks issued a notice on March 21, 2024, pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Abercrombie & Fitch Trading Co., an Ohio corporation (the Owner), the registered owner of registration No. TMA730,185 for the trademark Solid Moose Design set out below (the Mark):



[2] The Mark is registered in association with the following Goods and Service:

Class	Goods and Services
3	(1) Fragrances, namely, perfume and colognes.
14	(3) Jewelry, namely, necklaces and bracelets.
18	(4) Duffel bags, gym bags, tote bags and travel bags.
25	(2) Clothing, namely, polo shirts, blouses, sweaters, t-shirts, knit shirts, knit tops, sweatshirts, sweatpants, sweat suits, pants, jogging suits, jeans, shorts, skirts, caps, hats, scarves, jackets, coats, sandals, flip flops, socks, belts, tank tops, underwear, boxer shorts, swim suits, pajamas, sleepwear and thongs.
35	(1) Mail order catalogue services and online retail services featuring clothing, footwear, accessories, fragrances and jewelry.
35	(2) Retail store services.

[3] Section 45 of the Act requires the registered owner of the trademark to show whether the trademark has been used in Canada in association with each of the goods and services specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the Relevant Period for showing use is between March 21, 2021 and March 21, 2024.

[4] The relevant definitions of “use” are set out in sections 4(1) and 4(2) of the Act:

4(1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] In response to the Registrar's notice, the Owner submitted the affidavit of Lindsay Yeakel Capps, Director, Legal – Intellectual Property of Abercrombie & Fitch Co. The Owner is a subsidiary of Abercrombie & Fitch Co.

[6] Both parties submitted written representations.

ANALYSIS

Use Shown Enures to the Owner

[7] The use of the Mark enures to the Owner who exercised direct or indirect control in respect of the character and quality of the Goods and Services sold by its authorized licensee, AFH Canada Stores Co., in association with the Mark (para 9). Further, the Owner is the source of all of the goods (para 9). As Ms. Capps provides the requisite statement of care and control over the manner of use of the Mark, I am satisfied that the use shown enures to the benefit of the Owner pursuant to section 50 of the Act .

Evidence is Silent with respect to the Following Goods and Services

[8] The evidence is silent with respect to use of the Mark in association with the following Goods and Services. As there is no evidence of special circumstances which could excuse non-use of the Mark, the registration will be amended to delete the following:

Class	Goods and Services
14	Jewelry, namely, necklaces and bracelets.
18	Duffel bags
35	Mail order catalogue services and online retail services featuring jewelry.

Use is Shown with the Remaining Goods

[9] The evidence of the Owner details its normal course of trade (para 7). The Owner's licensee operates ABERCROMBIE & FITCH and ABERCROMBIE KIDS stores

in Alberta, British Columbia and Ontario (Exhibits B-D) as well as a website through which Canadians can order goods shipped to them (Exhibit E).

[10] Ms. Capps' evidence at Exhibits F1-F35 includes pictures of the following goods either bearing the Mark or with the Mark displayed on webpages used for ordering purposes (which can provide the required notice of association) [see, for example, *Dart Industries Inc v Baker & McKenzie LLP*, 2013 FC 97; *Fraser Milner Casgrain LLP v LG Electronics Inc*, 2014 TMOB 232] where, as is the case here, proof of transfer of the goods is provided:

Fragrances, namely, perfume and colognes, gym bags, tote bags and travel bags, clothing, namely, polo shirts, blouses, sweaters, t-shirts, knit shirts, knit tops, sweatshirts, sweatpants, sweat suits, pants, jogging suits, jeans, shorts, skirts, caps, hats, scarves, jackets, coats, sandals, flip flops, socks, belts, tank tops, underwear, boxer shorts, swim suits, pajamas, sleepwear and thongs.

[11] Although there is no requirement that either direct or documentary proof be furnished with respect to every good listed in a registration [*Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)], sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the registered goods during the Relevant Period. The Registrar must be able to form an opinion or logically infer use within the meaning of section 4 of the Act [*Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, at para 18].

[12] The evidence relating to sales includes the following:

1. At para 6, Ms. Capps defines Moose Products as goods bearing the Mark. Ms. Capps indicates that the Mark was shown in a similar manner as Exhibits F1-F35 on, or in association with all Moose Products sold in Canada during the Relevant Period (para 13).
2. At para 14, Ms. Capps states that "based on my review of the business records of A&F, I believe that A&F has made sales in Canada, during the Relevant Period, of each of the items listed in the above chart, or of another Moose Product in the same product category."

3. At Exhibits I-L emails to Canadian customers confirming shipping of many of the goods during the Relevant Period are attached. These emails include miniature pictures of the goods ordered. For many of these goods, the Moose Design can be seen including: polo shirts, t-shirts, knit shirts, sweat suits, pants, shorts, skirts, caps, hats, scarves, jackets, boxer shorts, swim suits, pajamas, and sleepwear.

[13] When this evidence is viewed in conjunction with the fact that the Owner's licensee operated at least six stores in Canada throughout the Relevant Period (para 10) and there are over \$1 Million of sales of products with the Mark (para 22), I infer that the evidence is sufficient to meet the Owner's prima facie burden of proving use of the Mark in association with the goods listed in paragraph 10. I find this even though the affiant swears the affidavit on the basis of information and belief as in *Eva Gabor International Ltd v 1459243 Ontario Inc*, 2011 FC 18 at para 17, the Federal Court explained that evidence on information and belief is acceptable.

[14] Further, this case can be distinguished from cases such as *Emily Schultz Inc. and Ralf Hütter*, 2023 TMOB 199 at para 29 where the affiant did not have access to records. Here, Ms. Capps has reviewed the records before swearing her affidavit and there is documentary evidence of the transfer of property for many of the goods.

[15] Lastly, in several instances the trademark used is only a minor deviation of the Mark, as shown in the representative examples below this paragraph, such that display of these trademarks amounts to display of the Mark. The Mark remains recognizable despite the addition of ABERCROMBIE and ABERCROMBIE AND FITCH. While the trademark appears alongside two other elements, it is well established there is nothing to prevent two or more trademarks being used at the same time [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].



[16] In view of the foregoing, I am satisfied that the Owner has shown use of the Mark with the following goods: Fragrances, namely, perfume and colognes, gym bags, tote bags and travel bags, clothing, namely, polo shirts, blouses, sweaters, t-shirts, knit shirts, knit tops, sweatshirts, sweatpants, sweat suits, pants, jogging suits, jeans, shorts, skirts, caps, hats, scarves, jackets, coats, sandals, flip flops, socks, belts, tank tops, underwear, boxer shorts, swim suits, pajamas, sleepwear and thongs.

Use is Shown with the Following Services

[17] Ms. Capps' evidence is that the Owner and its licensee operated Abercrombie & Fitch and Abercrombie KIDS retail locations in Canada and the Canadian subdomains of the Abercrombie.com website (para 7). The evidence is that the Mark appeared on signage in retail stores and on the website where purchases of clothing, footwear, accessories, fragrances took place during the Relevant Period [paras 16-18; Exhibits G-H]. The website provides detailed information specific to Canadian consumers (Exhibit E). The Requesting Party raises numerous objections to the evidence, however, many of them can be resolved simply by pointing out that there is no requirement to evidence sales so long as the Owner's services are available in Canada. If a trademark has been used or displayed in the advertising of those services, the trademark has been used within the meaning of the Act [*Carbon Trust v Pacific Carbon Trust*, 2013 FC 946 at para 68]. Finally, there is no requirement that use in association with services be in the normal course of trade for the purposes of section 45 of the Act [*Montréal Production Inc. and H-D U.S.A., LLC*, 2022 TMOB 234 at para 18] .

[18] As such, the registration will be maintained with respect to the following services: online retail services featuring clothing, footwear, accessories, and fragrances and retail store services.

DISPOSITION

[19] 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 goods and services below:

Class	Goods and Services
14	(3) Jewelry, namely, necklaces and bracelets.
18	(4) Duffel bags,
35	(1) Mail order catalogue services and online retail services featuring and jewelry.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

AGENTS OF RECORD

For the Requesting Party: No Agent Appointed

For the Registered Owner: CPST INTELLECTUAL PROPERTY INC.