

SECTION 45 PROCEEDINGS
TRADE-MARK: LEE Design
REGISTRATION NO. TMA205,274

On June 12, 2003, at the request of Clark, Wilson, the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) to Lee Canada Inc., the registered owner of registration No. TMA205,274 for the trade-mark LEE Design (the “Mark”). The Mark, which is registered in association with “western style garments, namely, jeans, jackets, and outer shirts”, is shown below:



Section 45 requires the registered owner of a trade-mark to indicate whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice, in this case between June 12, 2000 and June 12, 2003. If the mark has not been used during that time period then the registered owner is required to indicate the date on which it was last used and the reason why it has not been used since that date.

What qualifies as use of a trade-mark is defined in s. 4 of the Act, which is reproduced below:

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

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

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In response to the s. 45 notice, the registered owner filed the affidavit of Brian Williams. Only the registered owner filed a written argument. An oral hearing was not requested.

Mr. Williams is the Vice-President, Export Sales for Canada and Puerto Rico of VF Canada, Inc. He states that VF Canada, Inc. and Lee Canada Inc. are indirect, wholly owned subsidiaries of VF Corporation, a Pennsylvania Corporation. Mr. Williams attests that his duties include responsibility for arranging the importation, sales and marketing of LEE brands of clothing in Canada. He also attests that he has full access to Lee Canada Inc.'s business records.

According to Mr. Williams, during the material three-year period, Lee Canada Inc. authorized "Wrangler, a VF Company" to manufacture and distribute LEE Garments to Canadian retailers for resale to Canadian consumers, and at all material times, Lee Canada Inc. maintained direct or indirect control of the character or quality of the LEE Garments manufactured and distributed by "Wrangler, a VF Company". "Wrangler, a VF Company" is the trade-name of Wrangler Apparel Corp.

Mr. Williams defines LEE Garments as western style garments, namely jeans, jackets and outer shirts and provides representative samples of labels and/or hang tags that display the Mark that were on LEE Garments distributed in Canada.

It appears to me that all of the exhibits provided by Mr. Williams relate to pants, including jeans. I do not see any tags or labels that relate to jackets or outer shirts. Moreover, the style numbers listed in the invoices and other business records provided relate to pants. I acknowledge that Mr. Williams has stated that the total sales of LEE Garments in Canada during the relevant time period totaled more than \$5 million, but if there were in fact sales of garments other than pants, then it should have been a simple matter for Mr. Williams to provide some documentary evidence regarding same.

Overall, I am satisfied that Mr. Williams has shown use in association with western garments, namely jeans, but not in association with jackets and outer shirts. Evidentiary overkill is not required in s. 45 proceedings but it is trite law that any ambiguities in evidence presented should be interpreted against the interest of the trade-mark owner, given that cross-examination is not available.

Accordingly, registration TMA205,274 will be amended to remove “jackets and outer shirts” from the statement of wares, in accordance with the provisions of s. 45(5) of the Act.

DATED AT TORONTO, ONTARIO THIS 1st DAY OF NOVEMBER 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board