



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2015 TMOB 72**  
**Date of Decision: 2015-04-15**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Sim & McBurney against registration  
No. TMA663,238 for the trade-mark MILK & HONEY in  
the name of Pure & Simple Clothing Inc.**

[1] At the request of Sim & McBurney (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on April 2, 2013 to Pure & Simple Clothing Inc. (the Owner), the registered owner of registration No. TMA663,238 for the trade-mark MILK & HONEY (the Mark).

[2] Although the Mark was originally registered in association with a broad variety of clothing goods and related sale services, subsequent to the issuance of the notice and just prior to the oral hearing, the Owner voluntarily amended the registration. The Mark is now registered in association with the following goods and services:

**GOODS**

All women's and girls' wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters, T-shirts, underclothing, undergarments, underwear, lingerie, panties, hosiery, camisoles and sleepwear, together with all accessories, namely, belts, socks, caps and hats.

**SERVICES**

The sale of all women's, and girls' wearing apparel, namely, shirts, pants, blazers, jackets, vests, skirts, shorts, jeans, sweaters, T-shirts, underclothing, undergarments, underwear, lingerie, panties, hosiery, camisoles and sleepwear, together with all accessories, namely, belts, socks, caps and hats.

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the goods and services specified in the registration, at any time between April 2, 2010 and April 2, 2013. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definitions of use with respect to goods and services are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark 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 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.

[5] It is well established that 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)]. Although evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods and services specified in the registration during the relevant period. With respect to services, the display of the Mark on advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Ted Rozenwald, President of the Owner, sworn on October 17, 2013. Neither party filed written representations, but both were represented at an oral hearing held on December 15, 2014.

#### The Owner's Evidence

[7] In his affidavit, Mr. Rozenwald attests that the Owner and its licensee, Manhattan International Trade Inc., operate a fashion garment business in Montreal. He explains that, since

2005, a non-written agreement has existed between the Owner and Manhattan whereby the Owner has granted Manhattan the right to use the Mark in association with the registered goods and services. He attests that the Mark appeared on labels either printed or embroidered on the clothing goods or on labels affixed or engraved on the goods. As such, he attests that the Mark was displayed on the goods at the time of transfer to Manhattan's customers.

[8] In support, attached as Exhibit TR-2 to the affidavit are copies of sample labels that Mr. Rozenwald attests were attached to Manhattan's clothing items. The labels bear the Mark, and the exhibit includes photographs of representative shirts and dresses showing the labels sewn-in or directly printed on the goods.

[9] Although not clearly referenced in his affidavit, Exhibit TR-2 includes a 14-page document entitled "Spring 2011 Ladies Delivery Jan 7 – Sep 10, 2010" showing drawings and photographs of various "ladies" clothing items. Although the document appears to be some sort of catalogue, Mr. Rozenwald makes no statements regarding the distribution of the document to customers during the relevant period.

[10] With respect to transfers during the relevant period, Mr. Rozenwald provides evidence of 23 sales to the retail store Winners at Exhibit TR-3. In this respect, he provides various documents, from the initial purchase order by Manhattan from its supplier in China through to the final invoice from Manhattan to Winners. All of the invoices are from the relevant period and document sales of various styles of dresses, tops and "denim" jeans in various quantities.

[11] Mr. Rozenwald also states that Manhattan used the Mark on its website, *www.manhattaninc.com*, during the relevant period. He attests that the Mark "appears on various items of merchandise as examples of the wares set out in the registration" and states that Exhibit TR-4 consists of "copies of the pages appearing on Manhattan's website accessed and used by Manhattan's customers". However, Exhibit TR-4 consists only of the homepage of the website. Although the Mark does appear, the only clothing items appearing on the exhibited page are women's tops.

### Analysis

[12] Aside from Mr. Rozenwald's general assertions, there is nothing in the evidence showing that Manhattan sold girls' clothing in association with the Mark during the relevant period. Furthermore, there is no evidence before me that Manhattan sold any of the registered "accessories". All of the exhibits relate only to women's clothing and the sale thereof.

[13] At the oral hearing, the Owner submitted that the distinction between "women's" clothing and "girls" clothing is blurred. However, nothing in the evidence supports this assertion. In any event, having distinguished "women's apparel" from "girls' apparel" in the statement of goods, the Owner was obligated to produce evidence with respect to "girls' apparel" accordingly [see *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA); *Sharp Kabushiki v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD)].

[14] Similarly, at the oral hearing, the Owner submitted that the other apparel and accessory goods, not shown in the exhibits, would typically be part of any fashion "collection". The Owner submitted that it should be inferred that such goods were part of the Milk & Honey collection in this case. Again, however, there is nothing in the evidence to support this assertion. Most of the sales evidenced at Exhibit TR-4 appear to be for particular clothing items, rather than for collections or sets of items. Furthermore, if the 14-page catalogue at Exhibit TR-2 is intended to show a particular collection, I note that it does not even include all of the registered goods, including any of the registered accessories.

[15] In any event, even if I were to accept that Manhattan offered a collection comprised of a wide variety of apparel and accessories, it is insufficient to show that goods were available to be sold in Canada during the relevant period. Some evidence of transfers in the normal course of trade is required. Unfortunately, Mr. Rozenwald makes no statements regarding sales volumes for any of the goods and provides no clear statements regarding which of the registered women's clothing apparel were available for sale or actually sold during the relevant period. Accordingly, the only evidence of sales and transfers is at Exhibit TR-4, which is limited to only some of the registered goods.

[16] As noted above, the evidence of actual transfers at Exhibit TR-4 is limited to "ladies" shirts, dresses and jeans. Although half of the exhibited sales relate to "dresses", this is not one of the enumerated goods in the registration. However, I consider that at least one of the styles of

“dresses” shown at Exhibit TR-4 could also be considered a “skirt”; indeed, at the oral hearing, the Requesting Party submitted that, at best, the Owner has demonstrated sales only in association with “shirts, jeans and skirts”. With respect to the statement of goods, I agree with this assessment of the evidence.

[17] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the following goods only within the meaning of sections 4 and 45 of the Act: “All women’s wearing apparel, namely, shirts, skirts, [and] jeans”. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark, the registration will be amended accordingly.

#### Use of the Mark in Association with the Services

[18] With respect to the registered services, the Requesting Party submitted that the evidence does not show use of the Mark in association with “the sale of” women’s apparel, in part because Manhattan is not a retailer for third parties, but is instead a manufacturer or wholesaler. Implicit in the submission is that the registration should not be maintained for both “women’s apparel” and “*sale of* women’s apparel”, as any sale is simply incidental to getting the goods to market.

[19] However, services are to be interpreted broadly, and nothing in section 4(2) restricts services to those that are independently offered to the public or that are not ancillary or connected with goods [per *Gesco Industries Inc v Sim & McBurney* (2000), 9 CPR (4th) 480 (FCA)]. While it may be best understood that the Owner is using the Mark in association with goods, it is also offering a service through the sale of such goods. In this case, there is evidence of sales, and the registration in this case is not limited to a particular form of sales such as “wholesale” or “retail”. As such, a member of the public, in this case broadly understood to include the retail store Winners, benefits from such sales service in association with the Mark.

[20] In any event, the evidence in this case is not entirely restricted to the display of the Mark on particular goods; the Mark also appears on Manhattan’s website that Mr. Rozenwald attests was used and accessed by Manhattan’s customers. However, as noted above, the website at best shows “shirts” advertised in association with the Mark, and Mr. Rozenwald provides no

particulars regarding the distribution of the 14-page document included at Exhibit TR-2. In the absence of further particulars regarding the goods that were actually advertised to potential customers, it is appropriate to amend the statement of services to those products for which the Owner furnished actual evidence of sales during the relevant period.

[21] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the services “The sale of women’s wearing apparel, namely, shirts, skirts, [and] jeans” only. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark, the registration will be amended accordingly.

#### Disposition

[22] In view of all of the foregoing, 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 from both the statement of goods and the statement of services: “... and girls’ ... pants, blazers, jackets, vests, ... shorts, ... sweaters, T-shirts, underclothing, undergarments, underwear, lingerie, panties, hosiery, camisoles and sleepwear, together with all accessories, namely, belts, socks, caps and hats.”

[23] The amended statement of goods will be as follows: “All women’s wearing apparel, namely, shirts, skirts, and jeans.”

[24] The amended statement of services will be as follows: “The sale of all women’s wearing apparel, namely, shirts, skirts, and jeans.”

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Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office