



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

Citation: 2015 TMOB 125
Date of Decision: 2015-07-10

IN THE MATTER OF SECTION 45 PROCEEDINGS

Laverana GmbH & Co. KG

Requesting Party

and

Heather Ruth McDowell

Registered Owner

TMA767,075 for HONEY

Registrations

TMA767,134 for HONEY & DESIGN

[1] At the request of Laverana GmbH & Co. KG (the Requesting Party), the Registrar of Trade-marks issued notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on June 10, 2013 to Heather Ruth McDowell (the Owner), the registered owner of registration Nos. TMA767,075 and TMA767,134 for the trade-marks HONEY and HONEY & DESIGN (the Marks). The HONEY & DESIGN mark appears below:



[2] The Marks are both registered for use in association with the following goods:

Clothing, namely, trousers, jeans, sweat pants, yoga pants, active wear, pants, sweaters, sweatshirts, polo shirts, shirts, skirts, blouses, dresses, hosiery, jackets, blazers, coats, ski

jackets, down filled jackets, fur jackets, wool coats, shorts, bathing suits, loungewear; lingerie; footwear, namely, shoes, sandals, boots, slippers; men's, women's and children's shoes made of leather, suede or silk, namely pumps, high heels, dress shoes of any kind, sneakers, running shoes, basketball shoes, golf shoes, training shoes, court shoes, track shoes, beach shoes, namely sandals, flip flops and thongs; headwear, namely, hats, caps, bandannas, headbands, visors; jewellery; fashion accessories, namely, scarves, shawls, purses, gloves, watches; hair accessories, namely, combs, brushes, hair bands made of cloth or plastic, barrettes, scrunchies, ponytail holders, hair clips, hair pins, and hair ornaments; belts, sunglasses; cosmetics, namely foundation made of liquid or powder, face creams, blush, eye shadow, eye liner, mascara, lipstick, lip gloss, lip liner, make-up bags sold empty; giftware, namely, lamps, trays, vases; ornaments and figurines made from ceramic, chinaware, glass, porcelain; candy dishes.

[3] The Marks are also both registered for use in association with the following services:

Retail store services, namely, the operation of a clothing, footwear, headwear, fashion accessory and giftware outlet.

[4] The notices required the Owner to furnish evidence showing that the Marks were used in Canada, in association with each of the goods and services specified in the registrations, at any time between June 10, 2010 and June 10, 2013. If the Marks had not been so used, the Owner was required to furnish evidence providing the date when the Marks were last used and the reasons for the absence of use since that date.

[5] 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.

[6] 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 the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and 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 registrations during the relevant period.

[7] In response to the Registrar's notices, the Owner furnished her own affidavits, both sworn on January 9, 2014. I note that the affidavits furnished in response to each notice are substantially identical. Only the Requesting Party filed written representations, but both parties attended an oral hearing held on March 30, 2015.

The Owner's Evidence

[8] In her affidavits, Ms. McDowell attests that she licenses the Marks to corporations which operate retail stores in Toronto. However, she states that she is also the sole Director and the President of each of these licensees. She asserts that these licensed retail stores sell "clothing, footwear, headwear, jewelry, fashion accessories, watches, hair accessories and cosmetics" in association with the Marks. Ms. McDowell explains that she regularly travels to each retail store and determines which goods are made available for sale in her role as the "principal buyer" for each store.

[9] With respect to sales, Ms. McDowell attests that, during the relevant period, "average sales of the HONEY Wares bearing the [Marks] in each year were well in excess of \$50,000." However, she does not provide any further break down of sales figures with respect to any of the particular registered goods.

[10] With respect to the manner of display of the Marks, Ms. McDowell attests that the Marks were displayed on the retail storefronts, as well as on in-store signage. She further attests that the Marks were displayed on hangtags or stickers attached to the goods, and by placing the goods in shopping bags or boxes displaying the Marks at the time of sale.

[11] In support, Ms. McDowell provides the following exhibits attached to her affidavits:

- Exhibit A consists of photos of HONEY retail store fronts and in-store signage which Ms. McDowell attests are identical to or representative of those used during the relevant period. Both Marks are displayed at the store entrances and in the windows. I note that

various goods are displayed in the store windows, including different types of clothing, scarves, jewelry, purses, and sandals.

- Exhibit B consists of copies of hangtags that Ms. McDowell attests are representative of those affixed to all of the clothing, headwear and fashion accessories sold in HONEY retail stores during the relevant period in Canada. The HONEY & DESIGN mark is displayed prominently on the hang tag. Ms. McDowell attests that each hangtag “remains attached to the clothing, headwear and fashion accessories and is visible throughout the purchase process and the transfer of possession of the HONEY Wares to the purchaser.” Exhibit B also contains a barcode sticker displaying the HONEY word mark only. Ms. McDowell explains that such barcode stickers were affixed to smaller items such as hair accessories and cosmetics which were not always wrapped in tissue paper and sealed (per Exhibit C).
- Exhibit C is an adhesive sticker displaying the HONEY & DESIGN mark, which Ms. McDowell attests is representative of those affixed to tissue paper or other packaging used to wrap purchased goods. She notes that the sticker “is still affixed while the customer is completing the purchase and the purchaser takes the HONEY Ware or Wares out of the store.”
- Exhibit D consists of “advertising cards” that Ms. McDowell attests “were used by me to promote the HONEY Wares and Services during the Relevant Period.” The HONEY & DESIGN mark is displayed on the cards along with the website address *shophoney.com* and street addresses for different HONEY retail stores. One of the cards advertises various brands that appear to be available in HONEY retail stores, as follows: “She LOVES Seven for Mankind, Juicy Couture, New York, Paige, LA, Ed Hardy, Hudson ... and much more”.
- Exhibit E consists of sample gift cards and loyalty cards displaying the HONEY & DESIGN mark, which Ms. McDowell simply attests were “used to advertise the HONEY services and sell the HONEY wares during the Relevant Period.”

- Exhibit F consists of sample business cards displaying the HONEY & DESIGN mark, which Ms. McDowell attests were displayed at the checkout counter and placed in customers' shopping bags at the time of purchase during the relevant period.
- Exhibit G consists of photos of shopping bags and boxes which display the HONEY & DESIGN mark and the website address, *shophoney.com*. Ms. McDowell explains that purchases “are placed in a shopping bag and/or box as depicted in Exhibit G at the time of purchase and transfer of possession of the HONEY Wares at the checkout counter, both now and during the Relevant Period.”
- Exhibit H consists of copies of various advertising and signage displaying the HONEY & DESIGN mark which Ms. McDowell attests was used both in stores and in general shopping mall areas during the relevant period. Some of the signs list multiple third-party brands such as North Face and Michael Kors, indicating that such brands were available in the HONEY retail stores.
- Exhibit I is a photocopy of two sales receipts which Ms. McDowell attests are representative of those issued to customers who purchased goods at HONEY stores during the relevant period. Although one of the receipts is partially obscured by a reproduction of a HONEY gift card, I note that the receipts appear to be for the same transaction, dated October 10, 2011, showing sales totaling \$196.11. Although the HONEY & DESIGN mark appears at the top of the receipts, the goods sold are identified as “Heathered L/S Top Grey S/P”, “COLLIN SKINNY BOO DENI 27”, and “Top w/ Open Back Grey S/P CHAR”.
- Exhibit J consists of a photo of a garment bag displaying the HONEY & DESIGN mark which Ms. McDowell attests was used to hold various clothing items at the time of sale during the relevant period.

[12] In reviewing the evidence, I note that many of the exhibits display the HONEY & DESIGN mark as registered. However, I accept that display of this design mark constitutes display of the HONEY word mark as well [for similar treatment of a registered word mark, see *Cassels Brock & Blackwell LLP v Sweet Creations Inc*, 2015 TMOB 27 at para 24, 2015

CarswellNat 1399]. As such, reference below to “the Marks” generally refers to the display of the HONEY & DESIGN mark, but constituting use of the word mark as well.

Analysis – Licensed Use of the Marks

[13] As a preliminary matter, the Requesting Party argues in its written representations that any use of the Marks does not enure to the Owner’s benefit because the Owner has not satisfied the requirements set out in section 50(1) of the Act. In this respect, the Requesting Party notes that the Owner has not produced any licensing agreement and argues that the Owner did not “identify the corporations or companies to which she licenses use of the [Marks]”. However, the Requesting Party did not provide any jurisprudence indicating that registered owners are required to identify their licensees by name.

[14] Furthermore, it is well-established that trade-mark owners are not required to evidence written license agreements *per se* in a section 45 proceeding; a clear statement of control can be sufficient [see *Gowling, Strathy & Henderson v Samsonite Corp* (1996), 66 CPR (3d) 560 (TMOB)]. Control over the character and quality of the goods or services can also be inferred where there is an overlap in corporate control or ownership between the licensor and the licensee [see *Lindy v Canada (Registrar of Trade Marks)*, 1999 CarswellNat 652 at para 9 (FCA); 88766 *Canada Inc v Black Pearl Coffee*, 2014 TMOB 276 at para 26, 2014 CarswellNat 5512].

[15] In the present case, the Owner attests that she controls the character and quality of the goods and services offered at HONEY stores through her role as the director of each of the licensed corporations and through her regular visits to each HONEY retail store location. In my view, the Owner’s explanation of the licensing arrangement and statement of control satisfies any requirements of section 50(1); as such, I am satisfied that any evidenced use of the Marks by the licensees enures to the Owner’s benefit.

Analysis - Services

[16] As described above, the Owner has shown that the Marks were displayed on the exterior of HONEY retail stores (at Exhibit A), on different types of signage (at Exhibit H), on business cards (at Exhibit F), and on shopping bags (at Exhibit G). In its written representations, the

Requesting Party submitted that there was only evidence of use of the Marks in association with “Retail store services, namely the operation of a clothing ... outlet”, but not with respect to the operation of a “footwear, headwear, fashion accessories and giftware outlet”. However, the Exhibit A photographs of the HONEY stores show sandals, scarves, and jewelry, in addition to clothing. As it appears that a wide variety of goods were available at HONEY stores during the relevant period, I accept that the photographic evidence, along with Ms. McDowell’s sworn statements, show that the Owner’s licensees operated “clothing, footwear, headwear, fashion accessory and giftware” outlets during the relevant period.

[17] Indeed, at the oral hearing, the Requesting Party conceded that the affidavits with supporting exhibits were sufficient to show use of the Marks in association with the services as registered.

[18] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Marks with respect to the registered services within the meaning of sections 4(2) and 45 of the Act.

Analysis - Goods

[19] With respect to the use of the Marks in association with the registered goods, the parties’ remaining submissions raise two issues. The first issue is whether the evidence shows transfers of *each* of the registered goods during the relevant period. The second issue is whether the manner of display of the Marks constitutes use in association with *any* of the goods sold in HONEY stores, rather than in association with retail store services only.

Transfers of Each of the Registered Goods

[20] In order to satisfy the definition of “use” under section 4(1) of the Act, it is well established that the goods must actually be transferred in the normal course of trade during the relevant period; merely *offering* goods for sale is not sufficient [see, for example, *The Molson Companies Ltd v Halter* (1976), 28 CPR (2d) 158 at 177 (FCTD); and *Gowling, Strathy & Henderson v Royal Bank of Canada* (1995), 63 CPR (3d) 322 at 327 (FCTD)].

[21] Although, as noted above, I accept that the HONEY retail stores operated as “footwear, headwear, fashion accessory and giftware” outlets, it is not sufficient that such general categories

of goods may have been available for sale. Indeed, the Requesting Party argues that the Owner has not provided evidence to show that *each* of the registered goods was sold during the relevant period.

[22] In this respect, although Ms. McDowell provides a global figure for sales, she does not provide a breakdown of sales for any of the specific registered goods. Given the dollar value of the sales attested to by Ms. McDowell, it is reasonable to assume that at least some of the registered goods were sold in the normal course of trade during the relevant period. However, aside from the receipts evidenced at Exhibit I, it is not clear which particular registered goods were sold. At best, the exhibited receipts show actual sales and transfers of two shirts and one pair of jeans during the relevant period. It is not clear whether there were sales for the other registered goods such as running shoes, sunglasses, lip gloss, or candy dishes. Ms. McDowell does not attest to the specific sales of any of these goods, nor does she provide receipts or other evidence to show that these other goods were in fact sold at HONEY retail stores during the relevant period.

[23] It is well established that use must be shown in association with all of the goods as registered [see *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)]. This is not to say that a registered owner is obligated to provide invoices for each registered good [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. However, in the absence of invoices, the Owner should have been prepared to furnish evidence regarding volumes of sales, dollar value of sales or equivalent factual particulars to allow the Registrar to conclude that transfers in the normal course of trade actually occurred in Canada with respect to *each* of the registered goods [see *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79, 2014 CarswellNat 2439; *Gowling Lafleur Henderson LLP v Wertex Hosiery Incorporated*, 2014 TMOB 193 at para 15, 2014 CarswellNat 4624].

[24] In the absence of such particulars, I do not accept the exhibited receipt(s) as representative evidence of transfers with respect to any of the other registered goods. Ms. McDowell's statements amount to mere assertions of use, rather than statements of fact showing use with respect to each of the registered goods. Therefore, I am not satisfied that the evidence shows sales or transfers of each of the registered goods during the relevant period.

[25] In any event, as discussed below, this issue is moot as I am not satisfied that the evidenced manner of display constitutes use of the Marks in association with any goods sold in the HONEY retail stores pursuant to section 4(1) of the Act.

Association of the Marks with the Goods

[26] At the oral hearing, the Requesting Party argued that the Owner failed to show that the Marks were associated with the goods. It argued that while the Owner may have decided which goods to sell in the HONEY stores, the goods themselves were manufactured by third parties and branded with their own respective trade-marks rather than the Owner's Marks. In other words, the Owner is not the source of the goods sold, but rather she only operates retail stores which sell third-party goods. As such, consumers would have associated the goods with their respective third-party trade-marks, and would have associated the HONEY trade-marks with the retail store services only, notwithstanding that the Marks appeared on hang tags, stickers, shopping bags and the like.

[27] In support of this position, the Requesting Party points out that Ms. McDowell's evidence does not show any HONEY tags actually affixed to the goods (such as in the form of stitched-in labels) and argues that the exhibited hangtags are merely price tags which were placed on third-party goods. The Requesting Party also notes that Ms. McDowell refers to her role as the "principle buyer", which further suggests that the Owner merely sold third-party goods through the licensed retail stores. Finally, the Requesting Party notes that the advertising cards at Exhibit D and the signage at Exhibit H both list a number of third-party brands that are available at the HONEY retail stores, but HONEY itself is not listed among the available brands.

[28] At the oral hearing, in response to the Requesting Party's arguments, the Owner first noted that while the aforementioned exhibits list third-party trade-marks, they also include the phrase "and much more". The Owner submitted that this indicates that the lists were open-ended, meaning that the sale of HONEY-branded goods was not precluded.

[29] The Owner also submitted that it is acceptable for a single good to display more than one trade-mark, including a trade-mark that belongs to a third-party [citing *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)]. The Owner argued that where both the

Owner's Marks and third-party trade-marks appeared on goods, the Owner's Marks could nonetheless be associated with the goods that were sold [citing *Sara Lee Corp v Kretschmar Inc*, 2005 CarswellNat 4474 at para 18 (TMOB) and *Rogers, Bereskin & Parr v Peerless Carpet Corp* (1995), 63 CPR (3d) 551 at 553 (TMOB)].

[30] In turn, the Requesting Party submitted that this is not a case of co-branding where multiple trade-marks are displayed on a particular good, but rather a case where price tags bearing the HONEY Marks were affixed to goods which already displayed third-party trade-marks.

[31] In any event, the issue in this case is whether the various ways in which the Owner displayed the Marks meet the requirements of section 4(1) of the Act. In this respect, the question is whether the Marks were "marked on the goods themselves or on the packages in which they are distributed" or were "in any other manner so associated with the goods that notice of the association [was] then given to the person to whom the property or possession [was] transferred".

[32] In order for a trade-mark to be "marked on the goods themselves", a trade-mark generally has to be displayed on the goods in a permanent fashion, typically by the manufacturer of the goods [see also *Moffat & Co v Big Erics Inc*, 2015 TMOB 52 at para 29]. A relevant example would be a trade-mark displayed on a shirt's stitched-in label. In the present case, there is no evidence to show that the Marks were "marked on the goods themselves". Instead, the Owner implicitly relies on the display of the Marks "on the packages in which they are distributed" and further made submissions at the oral hearing regarding the display of the Marks "in any other manner so associated with the goods". In this respect, the Owner submitted that section 4(1) of the Act should be read broadly to account for a wide variety of ways that the Marks could be associated with the goods.

[33] In her affidavit, Ms. McDowell only refers to "packaging" when describing how goods were wrapped in tissue paper at the time of purchase and transfer. She attests that most of the goods were wrapped in tissue paper and sealed with a sticker displaying the Marks. The goods were then placed in a shopping bag or box which also displayed the Marks. As such, the question

then becomes whether the Owner's display of the Marks on the bags, boxes, and stickers can be considered display of the Marks on "packaging" within the meaning of section 4(1) of the Act.

[34] In *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 at 16-17 (FCTD), the Federal Court stated the following:

...section 4 contemplates the normal course of trade as beginning with the manufacturer, ending with the consumer and with a wholesaler and retailer or one of them as intermediary. When the applicant sold to the retailer and the retailer sold to the public, the public came to associate applicant's mark with the ... belt; s. 4 contemplates that the use between the retailer and the public enures to the benefit of the manufacturer and its use in Canada. In other words -- if any part of the chain takes place in Canada, this is "use" in Canada within the meaning of s. 4.

[35] As such, the question of whether a particular trade-mark is displayed in accordance with section 4(1) of the Act needs to be considered in part with this distribution "chain" in mind.

[36] In my view, and consistent with the jurisprudence discussed below, section 4(1) of the Act contemplates the manufacturer's packaging and not necessarily the packaging that is used by a retailer to convey goods to the customer. The interpretation and application of section 4(1) with respect to "packages" will depend upon the particular circumstances and the normal course of trade involved in each case. However, in general, reference to "the packages in which they are distributed" in section 4(1) contemplates the packaging that goods are distributed in along the entirety of the chain and not just at the retail stage.

[37] In this case, Ms. McDowell only attests to the goods being placed in HONEY shopping bags and boxes during retail transactions; she does not provide any detail regarding the normal course of trade related to the actual manufacturing of the goods and their packaging, if any. Therefore, I do not consider the Marks' appearance on shopping bags and the like as constituting the Marks being "marked ... on the packages in which they are distributed" within the meaning of section 4(1) of the Act.

[38] The Owner must therefore rely on the position that it took at the oral hearing, namely that the evidenced manner of display constitutes use of the Marks "in any other manner" pursuant to section 4(1) of the Act. Accordingly, the key issue in this case is whether the display of the

Marks on shopping bags, hangtags, signage, and the like is sufficient “that notice of the association is then given to the person to whom the property or possession is transferred”.

[39] With respect to the HONEY hangtags, I agree with the Requesting Party that the hangtags appear to be price tags which are only affixed to third-party goods when they are offered for sale in the HONEY retail stores. The Registrar has previously held that merely attaching a store’s price tags to a third-party good does not constitute use of a trade-mark pursuant to section 4(1) of the Act [see *Coastal Trade-mark Services v Edward Chapman Ladies’ Shop Limited*, 2014 TMOB 80, 2014 CarswellNat 1825]. Where a retailer’s trade-mark appears only on a price tag affixed by the retailer, it does not distinguish the goods but, rather, it distinguishes the retailer’s services from those of other retailers.

[40] As the Requesting Party aptly put it: “A CANADA GOOSE® jacket purchased at a HONEY store does not become a HONEY jacket.” As such, I find that the display of the Marks on the evidenced hangtags does not give the requisite notice of association pursuant to section 4(1) of the Act.

[41] With respect to the shopping bags and boxes, while I already determined above that these are not “packages” within the meaning of section 4(1), I must nonetheless determine whether the display of the Marks on the shopping bags and boxes constitutes association of the Marks with the goods “in any other manner”. However, the Registrar has previously held that the display of a trade-mark on a retailer’s shopping bags and boxes does not constitute use in association with the goods sold, notwithstanding the fact that the goods are given to customers in those bags or boxes at the time of purchase and transfer [see *Gowling, Strathy & Henderson v Karan Holdings Inc* (2001), 14 CPR (4th) 124 (TMOB); *London Drugs Ltd v Brooks* (1997), 81 CPR (3d) 540 (TMOB); and *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)]. As such, the display of the Marks on shopping bags and boxes is “more akin to use of the trade-mark in association with a service namely to distinguish the registrant’s retail outlet from retail outlets of others” [per *Karan Holdings, supra*, at para 8]. Therefore, I find that the evidenced display of the Marks on shopping bags and boxes does not give the requisite notice of association pursuant to section 4(1) of the Act.

[42] With respect to the photographs of exterior and in-store signage, the Requesting Party argued that the Marks as displayed on the signage are only associated with the Owner's services, not the goods [citing *Batteries Plus LLC v Source (Bell) Electronics Inc*, 2012 TMOB 202, 107 CPR (4th) 469]. In *Batteries Plus*, the Registrar stated the following:

While the display of a trade-mark on signage in close proximity may satisfy the requirements of section 4(1) of the Act ... in this case the Mark appears over a display of a variety of third party brands of batteries. In my view, such display of a trade-mark on store signage, whether interior or exterior, is use of the Mark in association with retail services, and not the wares themselves. [at para 16]

[43] The present case is similar as the Marks are displayed on both exterior and in-store signage, but the evidence indicates that the goods offered for sale in the HONEY stores display third-party trade-marks. As such, this would lead customers to associate the Marks with the retail store services only and associate the third-party trade-marks with the goods themselves. Therefore, I find that the display of the Marks on the exterior and in-store signage does not give the requisite notice of association pursuant to section 4(1) of the Act.

[44] With respect to the display of the Marks on other types of advertising material such as advertising cards, business cards, and loyalty cards, the Requesting Party again argues that, at best, this constitutes use of the Marks in association with the retail store services only. Indeed, the Registrar has previously held that promotional materials that are placed in shopping bags along with purchases may constitute evidence of use in association with retail store services, but not in association with the goods themselves [see *Riches, McKenzie & Herbert v Calderone Shoe Co*, 1997 CarswellNat 3267 at para 6 (TMOB); *Clark, Wilson v Myriad Innovative Designs Inc*, 2001 CarswellNat 4074 (TMOB)]. Therefore, I find that the evidenced display of the Marks on the advertising cards, business cards, and loyalty cards does not give the requisite notice of association pursuant to section 4(1) of the Act.

[45] Finally, with respect to the sales receipts furnished by the Owner, the Federal Court of Appeal has held that display of a trade-mark at the top of an invoice *may* in some circumstances constitute use of that mark in association with the goods listed on the invoices [see *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321 at paras 13-15, 2012 CarswellNat 4836]. The major consideration remains "whether the trade-mark is being used as a trade-mark in describing

the wares contained in the invoice and, as such, whether appropriate notice of such use is being given to the transferee of the wares” [per *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440 at para 32, 56 CPR (4th) 223]. In this respect, a major factor to consider is whether other trade-marks appear on the invoices, either in the body of the invoice or otherwise [per *Hortilux, supra*, at para 12].

[46] In the present case, I note that one of the three items shown on the receipts is identified as “COLLIN SKINNY BOO DENI 27”. While this appears to reference a sale of “skinny boot” denim jeans, the Owner does not explain the significance of “COLLIN”. The reasonable inference is that “COLLIN” is a third-party trade-mark and that the receipt simply shows that a COLLIN-branded good was sold at the HONEY store. This is consistent with the other evidence before me – such as the exhibited advertising cards and signage – which show that the HONEY stores sold various third-party brands. Accordingly, I find that the evidenced display of the Marks at the top of receipts does not give the requisite notice of association pursuant to section 4(1) of the Act in this case. Rather, as with the display of the Marks on signage, shopping bags and the like discussed above, such display of the Marks constitutes use in association with the retail store services only.

[47] In view of the foregoing, I agree with the Requesting Party that the Owner has not demonstrated that the Marks were displayed on the goods themselves, on their “packaging”, or “in any other manner” as required by section 4(1) of the Act.

[48] At best, the evidence is ambiguous with respect to whether any of the goods sold at the HONEY retail stores were HONEY goods rather than third-party goods. Pursuant to *Plough, supra*, this ambiguity must be resolved against the interests of the Owner.

[49] In any event, in view of the evidence as a whole, it is apparent that the Owner operates a chain of retail stores that sell a variety of third-party brands. While this constitutes use of the Marks in association with the registered services, I am not satisfied that the Owner has demonstrated use of the Marks in association with any of the registered goods within the meaning of sections 4(1) and 45 of the Act. Furthermore, there is no evidence of special circumstances excusing such non-use of the Marks in association with the goods before me.

Disposition

[50] 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 section 45 of the Act, the registrations will be amended as indicated below.

[51] Registration No. TMA767,075 for the trade-mark HONEY will be amended to delete the statement of goods. The registration will be maintained with respect to the registered services.

[52] Registration No. TMA767,134 for the trade-mark HONEY & DESIGN will be amended to delete the statement of goods. The registration will be maintained with respect to the registered services.

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

Hearing Date: 2015-03-30

Appearances

Mr. Kenneth D. McKay

For the Registered Owner

Mr. Adam Haller

For the Requesting Party

Agents of Record

Sim & McBurney

For the Registered Owner

Norton Rose Fulbright Canada

For the Requesting Party