



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

Citation: 2014 TMOB 29
Date of Decision: 2014-02-13

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by MacPherson Leslie & Tyerman LLP against
registration No. TMA707,835 for the trade-mark
DREAM in the name of FGL Sports Ltd.**

[1] At the request of MacPherson Leslie & Tyerman LLP (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 September 9, 2011 to the registered owner FGL Sports Ltd. (under its former name The Forzani Group Ltd.) (the Registrant) of registration No. TMA707,835 for the trade-mark DREAM (the Mark).

[2] The Mark is registered in association with the following wares: “clothing namely athletic clothing, casual clothing and dress clothing; footwear namely athletic shoes, casual shoes, dress shoes, boots, slippers, sandals and thongs; and sporting goods namely bicycles, bicycling gloves, protective helmets for biking, bicycle shorts, inline skates, scooters, volleyball equipment namely, balls, floor plates, net antennas, nets, shoes, uprights, soccer balls, snowboards, snowboard boots and bindings, athletic bags (sold empty), fanny, waist and back-packs (sold empty).”

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares 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 September 9, 2008 and September 9, 2011.

[4] For the purposes of this decision, the relevant definition of “use” is set out in section 4(1) of the Act:

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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*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 et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co 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 wares or services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant filed an affidavit of Kristi Lalach, In-House Legal Counsel for FGL Sports Ltd. Both parties filed written arguments; an oral hearing was not held.

[7] In her affidavit, Ms. Lalach explains that in 2011 The Forzani Group Ltd. merged with other entities to form FGL Sports Ltd. In its written argument, the Requesting Party submits that without evidence to establish the merger, the Registrar is being forced to accept a bald assertion with respect to the chain of title for the registration for the Mark. I disagree. The Registrar has previously held that “it is at least arguable” that the amalgamation of two companies does not form a new company but rather the original companies merely “continue to exist as one” [see *Nabisco Brands Ltd/Nabisco Brands Ltee also trading as Christie, Brown & Co v Perfection Foods Ltd* (1985), 7 CPR (3d) 468 (TMOB), aff’d 12 CPR (3d) 456 (FCTD)]. Applying this reasoning, in the present case, I am prepared to consider that the merger resulting in the new

name for the Registrant can be likened to a change of name. The Registrar routinely accepts changes of name at face value, without any requirement for supporting evidence. Based on the foregoing, I am satisfied that any use which may be evidenced in Ms. Lalach's affidavit is use by the Registrant.

[8] In her affidavit Ms. Lalach explains that the Mark is used to identify a variety of clothing, footwear and sporting goods offered through the Registrant's stores. She makes the sworn statement that the Mark has been used in Canada continuously on these goods since at least as early as January 28, 2008.

[9] Ms. Lalach provides substantial sales figures for products sold in association with the Mark in Canada during the relevant period.

[10] Ms. Lalach breaks the sales figures down into categories and makes sworn statements with respect to the use of the Mark in association with these different categories of goods. In its written argument, the Requesting Party submits that Ms. Lalach does not sufficiently break down the evidence to show use of the Mark in association with each of the wares claimed in the registration. As will be further outlined in the paragraphs that follow, I agree with the Requesting Party that the evidence does not support a finding of use of the Mark during the relevant period in association with some of the registered wares.

[11] Firstly, Ms. Lalach provides details regarding sales of "athletic and casual clothing". Ms. Lalach makes no reference to "dress clothing" in her affidavit. As evidence of the manner in which the Mark has been used in association with clothing, Ms. Lalach provides a photograph of a polo shirt which displays the Mark on hang tags and tags inside the shirt (Exhibit B). Ms. Lalach makes the sworn statement that the photograph evidences how the Mark "appeared on branded clothing products and their hangtags as sold to Canadian consumers within the relevant period" (para 8). Ms. Lalach also attaches to her affidavit purchase orders from 2010 evidencing the Registrant's purchase of clothing from their associates which was subsequently offered for sale during the relevant period through the Registrant's Sports Mart, Atmosphere and Sports Experts retail stores (Exhibit E). I am satisfied that the evidence supports a finding that the Registrant sold "clothing namely athletic clothing, casual clothing" in association with the Mark

in Canada in the normal course of trade during the relevant period. The same cannot be said for “dress clothing” which will be deleted from the registration.

[12] Ms. Lalach provides the same type of evidence with respect to the next category of wares which she defines as “DREAM branded cycling products”. Ms. Lalach makes the sworn statement that this includes the sale of bicycles and cycling accessories. Ms. Lalach provides copies of purchase orders from 2010 which she states evidence the Registrant’s purchase of “cycling products” (Exhibit E). However, I note that the sales figures and purchase orders only cover bicycles – not “bicycling gloves, protective helmets for biking, bicycle shorts”. Furthermore, the representative image attached to the affidavit is of a bicycle (Exhibit C). There are no photographs demonstrating how the Mark would be used in association with “bicycling gloves, protective helmets for biking, bicycle shorts”.

[13] Ms. Lalach makes no reference in her affidavit to the remaining sporting goods namely “inline skates, scooters, volleyball equipment namely, balls, floor plates, net antennas, nets, shoes, uprights, soccer balls, snowboards, snowboard boots and bindings, athletic bags (sold empty), fanny, waist and back-packs (sold empty)”.

[14] Based on the foregoing, I find that the evidence only demonstrates use of the Mark in the relevant period in association with “sporting goods, namely bicycles”. The remainder of the “sporting goods” claimed in the registration for the Mark will be deleted.

[15] Finally, Ms. Lalach provides evidence which the Registrant submits is sufficient to establish use of the Mark in association with the final category of wares, namely footwear. However, unlike with clothing and bicycles, Ms. Lalach has not provided any invoices, or representative images displaying how the Mark was used in association with footwear. Ms. Lalach attaches a sample advertising flyer in which there is an image of footwear displayed in close proximity to the Mark (Exhibit F). However, this evidence is insufficient to establish use of the Mark in association with footwear as advertising alone is not sufficient to establish use of the Mark in accordance with section 4(1) of the Act. As a result, I am not satisfied that the Registrant has established use of the Mark in association with “footwear namely athletic shoes, casual shoes, dress shoes, boots, slippers, sandals and thongs” during the relevant period and these wares will be deleted from the registration accordingly.

Disposition

[16] In view 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 wares "...and dress clothing; footwear namely athletic shoes, casual shoes, dress shoes, boots, slippers, sandals and thongs; ... bicycling gloves, protective helmets for biking, bicycle shorts, inline skates, scooters, volleyball equipment namely, balls, floor plates, net antennas, nets, shoes, uprights, soccer balls, snowboards, snowboard boots and bindings, athletic bags (sold empty), fanny, waist and back-packs (sold empty)."

[17] As a result, the amended statement of wares for the registration will read as follows: "clothing namely athletic clothing, casual clothing; and sporting goods namely bicycles".

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office