



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

**Citation: 2016 TMOB 41
Date of Decision: 2016-03-11**

IN THE MATTER OF A SECTION 45 PROCEEDING

Amerella of Canada Ltd.	Requesting Party
and	
American Girl, LLC	Registered Owner
TMA478,860 for SAMANTHA	Registration

[1] On March 14, 2014, at the request of Amerella of Canada Ltd. (the Requesting Party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to American Girl, LLC (the Owner), the registered owner of registration No. TMA478,860 for the trade-mark SAMANTHA (the Mark).

[2] The Mark is registered in association with the goods “Children’s books, children’s clothing, dolls, doll clothing and doll accessories”.

[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 goods 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.

[4] In this case, the relevant period for showing use is between March 14, 2011 and March 14, 2014.

[5] The relevant definition of “use” in association with goods is set out in section 4(1) 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.

[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 specified in the registration during the relevant period.

[7] In response to the section 45 notice, the Owner furnished the affidavit of Donald B. Aiken, President of the Owner, sworn September 30, 2014 in Erie County, New York. Only the Requesting Party filed written arguments and only the Owner was represented at an oral hearing.

Owner’s Evidence

[8] In his affidavit, Mr. Aiken explains that the Owner is a toy company that markets and sells books, dolls, doll clothing, doll accessories and other items in Canada and around the world in association with the AMERICAN GIRL line of products.

[9] In particular, Mr. Aiken attests that, during the relevant period, the Owner used the Mark in Canada on such products in relation to its AMERICAN GIRL “Samantha” doll and character. He attests that, during the relevant period, the Owner sold “thousands of dollars” worth of books, dolls and related goods bearing the Mark in Canada. He explains that sales took place through a variety of channels, including through Canadian distributors, directly to consumers by online sales and via direct telephone orders.

[10] In its written representations, the Requesting Party focused on the lack of evidence with respect to the registered goods, “children’s clothing”. Indeed, at the oral hearing, the Owner conceded that Mr. Aiken’s affidavit included no evidence of use of the Mark in association with “children’s clothing”.

[11] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with “children’s clothing” within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence of special circumstances excusing such non-use before me. The registration will be amended accordingly.

[12] With respect to the remaining registered goods, the Owner provides ample evidence of use of the Mark. In this respect, attached to Mr. Aiken’s affidavit are examples of display of the Mark in association with children’s books (Exhibit A), dolls & doll clothing (Exhibit B) and doll accessories (Exhibit C), all of which Mr. Aiken attests are representative of the manner of display during the relevant period. The Mark can be seen on the front and back cover of the exhibited book, on the packaging of the exhibited doll (that includes clothing for the doll), and on the packaging of the exhibited “Samantha Treasure Tote”, which includes a mini book, paper dolls, a puzzle page and other accessories.

[13] With respect to transfers in the normal course of trade, Mr. Aiken provides representative purchase orders (Exhibit E) and spreadsheets of sales records (Exhibits F and G) showing sales of such goods in Canada during the relevant period. Mr. Aiken confirms that these sales records correlate to the goods shown at Exhibits A, B and C.

[14] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “children’s books” and “dolls, doll clothing and doll accessories” during the relevant period within the meaning of sections 4 and 45 of the Act.

Disposition

[15] Accordingly, 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 “children’s clothing”.

[16] The amended statement of goods will be as follows: “Children’s books, dolls, doll clothing and doll accessories.”

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

Hearing Date: 2016-03-09

Appearances

Michael O’Neill	For the Registered Owner
No one appearing	For the Requesting Party

Agents of Record

Gowling WLG (Canada) LLP	For the Registered Owner
Pain & Ceballos LLP	For the Requesting Party