



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

Citation: 2014 TMOB 227
Date of Decision: 2014-10-17

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Harpo, Inc. against registration
No. TMA746,605 for the trade-mark OZ SPORTS &
Design in the name of OZ Sports Inc.**

[1] At the request of Harpo, Inc. (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 October 31, 2012 to OZ Sports Inc. (the Registrant), the registered owner of registration No. TMA746,605 for the trade-mark OZ SPORTS & Design (the Mark), shown below:



[2] The Mark is registered for use in association with the following wares and services:

Wares:

Vêtements de sport nommément chandails de hockey en polyester, hockey jersey, chandails de football, survêtements de culottes de hockey et de gaine de hockey, dossards, pantoufles pour glisser.

Track suits, sacs de hockey, tuques, casquettes, t-shirt, chandails de hockey en laine et acrylique, bas de hockey.

Services:

Service de pose de numéros en twill sur les chandails, service de papier transfert de numéros sur les chandails.

Service de sublimation, service de fabrication des vêtements sur demande, service de vente de tricot polyester.

(the Wares and Services)

[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 October 31, 2009 and October 31, 2012.

[4] For the purposes of this decision, the relevant definitions of use are set out in sections 4(1) and 4(2) 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.

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 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 Kevin Cournoyer the Registrant's Vice-President.

[7] Only the Registrant filed written representations.

Has the Registrant evidenced use of the Mark during the relevant period?

[8] In his affidavit, Mr. Cournoyer makes the sworn statement that the Registrant has manufactured, distributed and sold sport clothing in Canada continuously since September 3, 1998. He provides the location of the Registrant's manufacturing facility and includes photographs thereof (Exhibit 1). The Mark is clearly displayed on the outdoor signage at the Registrant's manufacturing facility.

[9] Mr. Cournoyer also provides materials printed from the Registrant's website which feature the Mark as well as photographs of both the manufacturing facility and the manufacturing process for the Registrant's sports jerseys (Exhibit 2). The Mark is also displayed on the Registrant's website.

[10] Mr. Cournoyer provides a non-exhaustive list of the Registrant's Canadian customers and explains that the majority of these customers' orders are for custom sports apparel.

[11] Mr. Cournoyer explains that the Registrant specializes in the manufacture and sale of hockey uniforms and as a result most of its products are used by amateur hockey players across Canada. In support of this statement he provides materials printed from the Registrant's website featuring hockey players wearing jerseys which he states have been sold in association with the Mark (Exhibit 3). However, I note that the quality of the photographs is such that I am unable to see whether the Mark appears on the uniforms.

[12] Mr. Cournoyer explains that the Registrant affixes to its clothing items tags/labels which display the Mark. In support of this statement, Mr. Cournoyer provides samples of tags/labels which display the Mark (Exhibit 4).

[13] In addition to affixing tags/labels to its clothing wares, Mr. Cournoyer states that the Registrant occasionally places the Mark on the front or back of the clothing items as well, as per the customer's specifications. In support of this statement, Mr. Cournoyer provides photographs of clothing wares, dated within the relevant period, which display the Mark on the item itself, in addition to being displayed on tags/labels (Exhibits 5 and 6).

[14] Mr. Cournoyer explains that in the normal course of its business activities, the Registrant sends visual proofs to its customers to review before commencing manufacture of the custom orders. Once the proofs have been approved, the Registrant will commence manufacturing, bill the client and ship the clothing. He attaches to his affidavit sample proof sheets (Exhibit 8). The proof sheets all display the Mark and are dated within the relevant period.

[15] In support of his statement that the Registrant offers the services of "poser des numéros en twill sur des chandails; poser des numéros avec du papier transfert sur des chandails", Mr. Cournoyer provides printouts from the Registrant's website displaying sample logos, monograms and numbers which he states the Registrant affixes to customers' clothing as well as photographs of sample clothing on which the Registrant has placed a name, number or logo – all dated from within the relevant period (Exhibit 10).

[16] Mr. Cournoyer provides sample prices for some of the Registrant's Wares and Services, namely:

- (a) Chandails de hockey;
- (b) Chandails de soccer;
- (c) Culottes et gaines de hockey;
- (d) Track suits;
- (e) Sacs de hockey;
- (f) Tuques;
- (g) T-shirts;
- (h) Bas de hockey;

- (i) Matériel de tricot de polyester;
- (j) Poser des numéros en twill sur des chandails;
- (k) Poser des numéros avec du papier transfert sur des chandails;
- (l) Sublimier une inscription ou un logo sur une pièce de vêtement.

[17] Mr. Cournoyer provides sales figures for the years 2008 – 2013 for the Registrant’s business as a whole – as well as a breakdown showing sales figures specifically for clothing wares sold in association with the Mark. The sales figures are not insubstantial. He also explains that 90% of the sales for clothing wares can be attributed to sales of uniforms and clothing for sports sold in association with the Mark.

[18] In support of the sales figures, Mr. Cournoyer attaches to his affidavit sample invoices from 2009 – 2013, thereby encompassing the relevant period, which he states evidence both sales of the Wares and provision of the Services all in association with the Mark (Exhibit 11).

[19] In terms of promotional activities, Mr. Cournoyer explains that the Registrant occasionally sends sales representatives to visit sports teams and sports stores to pitch the Registrant’s Wares and Services to new customers. The sales representatives provide prospective customers with business cards which display the Mark and the Registrant’s website link. Mr. Cournoyer attaches sample business cards to his affidavit (Exhibit 12).

[20] In reviewing the evidence as a whole, I note that the Registrant has not made any specific reference to the wares defined as: “dossards, pantoufles pour glisser”. As a result, these wares will be deleted from the registration for the Mark.

[21] However, when the evidence is reviewed as a whole, I am satisfied that the Registrant has established that the Mark is displayed on the wares identified as “vêtements de sport nommément chandails de hockey en polyester, hockey jersey, chandails de football, survêtements de culottes de hockey et de gaine de hockey” (the Maintained Wares) and that these wares were sold in Canada in the normal course of trade, during the relevant period. I am also satisfied that the Registrant provided the Services during the relevant period and that the Mark was displayed both in the provision and the advertisement of, the Services.

[22] Based on the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark in association with the Maintained Wares and the Services within the meaning of sections 4 and 45 of the Act.

Disposition

[23] 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 “dossards, pantoufles pour glisser”.

[24] The amended statement of wares will read as follows:

Wares:

Vêtements de sport nommément chandails de hockey en polyester, hockey jersey, chandails de football, survêtements de culottes de hockey et de gaine de hockey.

Track suits, sacs de hockey, tuques, casquettes, t-shirt, chandails de hockey en laine et acrylique, bas de hockey.

Services:

Service de pose de numéros en twill sur les chandails, service de papier transfert de numéros sur les chandails.

Service de sublimation, service de fabrication des vêtements sur demande, service de vente de tricot polyester.

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