



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

**Citation: 2017 TMOB 136**

**Date of Decision: 2017-10-04**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Gaines Group LLC**

**Requesting Party**

**and**

**The TJX Companies, Inc.**

**Registered Owner**

**TMA702,157 for PINK ZEBRA**

**Registration**

INTRODUCTION

[1] At the request of Gaines Group LLC (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 25, 2015 to The TJX Companies, Inc. (the Owner), the registered owner of registration No. TMA702,157 for the trade-mark PINK ZEBRA (the Mark).

[2] The Mark is registered for use in association with the following goods:

Children's clothing, namely, sweaters, dresses, tops, bottoms, jackets, coveralls and shoes.

[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. In this case, the relevant period for showing use is September 25, 2012 to September 25, 2015.

[4] The relevant definition of use with respect to 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.

[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 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.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Karen Abel sworn on April 19, 2016 in Toronto. Only the Owner filed written representations; a hearing was not requested.

#### THE OWNER'S EVIDENCE

[7] In her affidavit, Ms. Abel identifies herself as the Manager of Product Safety and Regulatory Compliance with Winners Merchants International L.P., a subsidiary of the Owner.

[8] Ms. Abel explains that the Owner is a retailer of apparel and home fashions in the United States, Canada and worldwide, operating over 3300 stores with revenues of over US\$29 billion in 2014 alone. She attests that, by the end of 2014, the Owner operated over 230 Winners stores in Canada. She states that Winners stores offer a wide variety of products in Canada, including women's, men's and children's apparel, family footwear, accessories, and other merchandise, such as home fashions and beauty products.

[9] Ms. Abel attests that, in addition to selling a wide variety of brand name merchandise, the Owner also designs and sells a selection of its own private label goods under several trade-marks, including the Mark. In particular, Ms. Abel attests that, during the relevant period, Winners was a licensed user of the Mark and that the Owner maintained direct or indirect control over the character and quality of products sold in association with the Mark in Canada. She confirms that “Winners sells both third party brand name products and TJX’s private label products, such as those sold under the PINK ZEBRA trade-mark”, through its various retail store locations in Canada.

[10] In particular, Ms. Abel asserts use of the Mark in Canada during the relevant period in association with “children’s apparel”. Ms. Abel explains that the Mark appears on patches that are sewn directly into the Owner’s clothing products.

[11] In support, attached to her affidavit are the following exhibits:

- Exhibit A consists of printouts from the Owner’s website, *www.tjx.com*, that give general information about the Owner’s business and its various stores.
- Exhibit B consists of printouts from Winners’ website, *www.winners.ca*, that give general information about Winners and its store locations in Canada.
- Exhibit C is a photograph of a two-piece children’s outfit, which Ms. Abel attests is representative of how the Mark appeared on garments sold through Winners retail stores in Canada, including during the relevant period.
- Exhibit D consists of two photographs of PINK ZEBRA patches that Ms. Abel confirms are representative of the patches attached to the Owner’s children’s apparel sold in Canada during the relevant period.
- Exhibit E is a sample purchase order from December 2012 that Ms. Abel attests is for “an order for 5300 units of PINK ZEBRA branded products”. Ms. Abel explains that the purchase order was a joint order between the Owner’s U.S. operations and Winners. She confirms that “480 PINK ZEBRA branded garments were actually received by Winners in August 2013 and were distributed by Winners through [its] stores, and were offered for

sale and sold to Canadian customers” in 2013.

Although Ms. Abel does not identify the particular children’s apparel items sold by Winners, the descriptions in the purchase order identify the products as two styles of “chambray cascade tunic full length legging”; this description is consistent with the children’s outfit shown in Exhibit C.

#### ANALYSIS

[12] In this case, the issue is whether the Owner has furnished evidence of use of the Mark in association with each of the “Children’s clothing” goods specified in the registration. In this respect, the only evidence of use of the Mark is limited to the two-piece children’s outfit shown at Exhibit C.

[13] Although Ms. Abel does not clearly correlate the Exhibit C outfit with the Exhibit E purchase order and her statements regarding that particular order, the purchase order description (being a tunic and leggings) is consistent with the depicted two-piece outfit. As such, I accept that the “480 PINK ZEBRA branded garments” that Ms. Abel attests were sold in Canada in 2013 were this two-piece outfit.

[14] Furthermore, in the absence of written representations from the requesting party, I agree with the Owner that this tunic and leggings combination can be correlated with the registered goods “tops” and “bottoms”.

[15] With respect to the remaining goods, however, there is no evidence of use of the Mark before me. Although Ms. Abel asserts that the evidence shows use of the Mark in association with “clothing and footwear” during the relevant period, the evidence of use is limited to the exhibited tunic and leggings combination. Ms. Abel attests to Winners’ revenues generally, but does not attest to sales of PINK ZEBRA goods generally, much less specifically with reference to each of the registered clothing goods. The only evidence of actual sales in Canada during the relevant period is limited to Ms. Abel’s statements relating to the Exhibit E purchase order for the depicted tunic and leggings combination.

[16] Contrary to the Owner’s assertion in its written representations, if the exhibits regarding this outfit were intended to be representative of the other registered goods, this is not clear from

Ms. Abel's affidavit. To infer from the evidence before me that the Mark was also used in association with the remaining registered goods, such as "shoes", would be mere speculation.

[17] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark only in association with "Children's clothing, namely ... tops, bottoms" within the meaning of sections 4 and 45 of the Act. In the absence of special circumstances excusing non-use, the registration will be amended accordingly.

DISPOSITION

[18] 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 "... sweaters, dresses, ... jackets, coveralls and shoes" from the statement of goods.

[19] The amended statement of goods will be as follows: "Children's clothing, namely, tops and bottoms".

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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**

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Gowling WLG (Canada) LLP

For the Registered Owner

Finlayson & Singlehurst

For the Requesting Party