



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 114

Date of Decision: 2019-10-18

IN THE MATTER OF A SECTION 45 PROCEEDING

McMillan LLP

Requesting Party

and

Glenn D. Forbes

Registered Owner

TMA630,629 for CANNIBAL

Registration

[1] At the request of McMillan LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on June 28, 2017 to Glenn D. Forbes (the Owner), the registered owner of registration No. TMA630,629 for the trademark CANNIBAL (the Mark).

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

Men's and women's casual clothing, namely, shirts, t-shirts, shorts, pants, and socks, and men's and women's sportswear, namely, cycle jerseys, cycle shorts, bibs, swim wear, shorts, t-shirts, sleeveless tank tops, short sleeveless training tops, sport socks, caps, and footwear namely boots, shoes and slippers, sunglasses, backpacks, sports wear, triathletic sports wear, and beer.

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the goods specified in the registration, at any time between June 28, 2014 and June 28, 2017. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence

of use since that date.

[4] The relevant definition of use with respect to goods is set out in section 4 of the Act as follows:

4(1) A trademark 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 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 trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar's notice, the Owner furnished his own affidavit, sworn on January 16, 2018 in Coolangatta, Australia. Only the Owner filed written representations. An oral hearing was not requested.

THE OWNER'S EVIDENCE

[7] At paragraph 3 of his affidavit, Mr. Forbes states the following:

CANNIBAL IN SPORT PTY LTD, a company wholly owned by me, has sold at retail [the Owner's] CANNIBAL products ... throughout the world, including Canada, continuously since 1999 (including during ... the "Relevant Period") including [list of the registered goods].

[8] I note that this recited list of goods generally corresponds with the goods listed in the registration, with the exception of the registered goods "t-shirts". However, in view of the evidence as discussed below, this appears to be an inadvertent omission.

[9] Mr. Forbes attests that, since 1999, he has operated a website at *cannibal.com.au* through which customers, including Canadian customers, order items from the Owner. Attached as Exhibit A to his affidavit are 17 pages of screenshots from this website, showing for sale various clothing items and cycling accessories displaying the Mark. I note that the copyright notice on some of the pages is dated 2016, and Mr. Forbes attests that Exhibit A includes a screenshot of the website as it appeared on April 10, 2016.

[10] Mr. Forbes confirms that items ordered through the website were delivered to Canadian customers through a combination of Australia Post and Canada Post.

[11] Mr. Forbes further confirms that the Mark “appears on the garment or article itself as depicted in the [Exhibit A] images ... and in the case of garments, caps and [footwear], also on hangtags affixed to such items ... at the time the items are physically delivered to the customer.” Attached as Exhibit B to his affidavit are examples of such hangtags. The Mark appears on the hangtags.

[12] At paragraph 7 of his affidavit, Mr. Forbes states that, during the relevant period, he “sold to Canadians residing in Canada a wide assortment of CANNIBAL products upon which the CANNIBAL trademark is prominently displayed”, and provides three examples of sales, as follows:

- CANNIBAL-branded “jerseys, mens bib & brace (ie. cycling shorts) and mens t-shirts” sold to an individual in Regina, Saskatchewan, with invoices dated August 26, 2014 and May 7, 2017. Attached as Exhibit C1 to his affidavit are copies of these invoices, and attached as Exhibit C2 are images of some of these goods.
- CANNIBAL-branded “tights, jerseys, cycling apparel, triathlon suit, shorts, triathlon tops and shorts and mens swimming trunks” sold to an individual in British Columbia, with “some of these transactions” evidenced by an invoice dated November 5, 2016. Attached as Exhibit D1 to his affidavit is a copy of this invoice, and attached as Exhibit D2 is an image of a cyclist wearing CANNIBAL-branded shorts and a top, as well as an image showing a CANNIBAL-branded cap. I note that the invoice only itemizes the following

goods: “CANN Fatigue Short”, “CANN Black/Blue UTS with Sleeves”, and “Mesh Cap Cannibal Running Cap”.

- CANNIBAL-branded “tights, jerseys, cycling apparel, triathlon suit, shorts, triathlon tops and shorts and mens swimming trunks, and swimming caps” sold to an individual in Vernon, British Columbia, with “some of these transactions” evidenced by an invoice dated September 5, 2016. Attached as Exhibit E1 to his affidavit is a copy of this invoice, and attached as Exhibit E2 are images of CANNIBAL-branded women’s swimsuits and a swimming cap. I note that the invoice only itemizes the following goods: “Ladies 1P Trainer Fantasy”, “Girl’s 1P Trainer Fantasy”, “Kids Nutrigrain Girls One Piece”, “Swim Cap Can Blue Silicone”.

ANALYSIS

[13] In its brief written representations, the Owner refers in part to paragraph 3 of Mr. Forbes’ affidavit, asserting that the “evidence and documentation provided clearly evidences the use of [the Mark] in the normal course of trade in Canada during the Relevant Period on the Goods listed in the Registration.”

[14] However, I do not find Mr. Forbes’ statement at paragraph 3 of his affidavit to constitute a clear statement that all of the registered goods were actually sold in Canada during the relevant period. At best, his statement indicates that the registered goods were made available for sale worldwide, including Canada, since 1999.

[15] In the context of a section 45 expungement proceeding, it is insufficient, for purposes of section 4(1) of the Act, that goods were merely available for sale in or to Canada [see, for example, *The Molson Companies Ltd v Halter* (1976), 28 CPR (2d) 158 (FCTD); and *Gowling, Strathy & Henderson v Royal Bank of Canada* (1995), 63 CPR (3d) 322 (FCTD); *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)]. Some evidence of transfers in the normal course of trade in Canada is necessary.

[16] In this respect, the evidence of actual transfers of goods is limited to the three “examples” of sales to Canadian customers that Mr. Forbes provides at paragraph 7 of his affidavit.

[17] As noted above, the first example relates to sales of “jerseys, mens bib & brace (ie cycling shorts) and mens t-shirts”, for which Mr. Forbes attaches two invoices covering such goods.

[18] The second example relates to sales of “tights, jerseys, cycling apparel, triathlon suit, shorts, triathlon tops and shorts and mens swimming trunks”. However, the supporting invoice only refers to three goods: “Fatigue Short”, “UTS with Sleeves” and “Running Cap”.

[19] The third example relates to sales of “tights, jerseys, cycling apparel, triathlon suit, shorts, triathlon tops and shorts and mens swimming trunks, and swimming caps”. However, the supporting invoice appears to relate only to swimwear and swimming caps.

[20] Nevertheless, in contrast to Mr. Forbes’ general statement at paragraph 3 of his affidavit, I accept that the goods listed in paragraph 7 of his affidavit were actually sold to Canadian customers during the relevant period, notwithstanding that supporting invoices were not provided in all cases. In this respect, it is well established that invoices are not necessary to successfully respond to a section 45 notice [see, for example, *Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. Furthermore, evidence of a single sale can be sufficient to establish use for the purposes of section 45 expungement proceedings, so long as it follows the pattern of a genuine commercial transaction and is not seen as deliberately manufactured or contrived to protect the registration [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at para 12].

[21] In this case, Mr. Forbes states that certain goods were sold to particular Canadian customers during the relevant period, and I accept that such sales would have been consistent with the Owner’s normal course of trade as articulated in his affidavit (*i.e.* sales made through the Owner’s website and then delivered to Canada by mail).

[22] Furthermore, in reviewing the exhibited images of the goods, including those shown in the Exhibit A website screenshots, I accept that the goods evidenced to have been sold during the relevant period would have displayed the Mark either on the goods themselves or through the affixed hang tags as shown at Exhibit B.

[23] The only issue, then, is to determine which of the registered goods correlate to the goods listed in paragraph 7 of Mr. Forbes' affidavit as having been sold to Canadian customers in Canada. Unfortunately, Mr. Forbes uses terminology in the examples that differs somewhat from the goods as listed in the registration. Nevertheless, having reviewed Mr. Forbes' statements in conjunction with the exhibited images and descriptions of the goods, I accept that the goods listed in paragraph 7 correlate to the following registered goods: "Men's and women's casual clothing, namely, shirts, t-shirts, shorts, pants, ... , and men's and women's sportswear, namely, cycle jerseys, cycle shorts, bibs, swim wear, shorts, t-shirts, sleeveless tank tops, short sleeveless training tops, ... , caps, and ... , sports wear, triathletic sports wear, ...".

[24] With respect to the remaining registered goods – "casual clothing, namely ... socks" , "sportswear, namely ... sport socks", "footwear namely boots, shoes and slippers", "sunglasses", "backpacks" and "beer" – I am unable to find a clear correlation with any of the goods identified by Mr. Forbes in paragraph 7 as having actually been sold and delivered to Canadian customers during the relevant period.

[25] For example, although images of CANNIBAL-branded socks and backpacks appear in the Exhibit A screenshots, Mr. Forbes provides no evidence of actual sales or transfers of socks or backpacks to Canada during the relevant period. With respect to "boots", "shoes", "slippers", "sunglasses" and "beer", I am further not even able to identify such goods in the exhibited screenshots.

[26] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the following registered goods only within the meaning of sections 4 and 45 of the Act:

"Men's and women's casual clothing, namely, shirts, t-shirts, shorts, pants, ... , and men's and women's sportswear, namely, cycle jerseys, cycle shorts, bibs, swim wear, shorts, t-shirts, sleeveless tank tops, short sleeveless training tops, ... , caps, and ... , sports wear, triathletic sports wear, ...".

[27] As there is no evidence of special circumstances excusing non-use of the Mark before me, the registration will be amended accordingly.

DISPOSITION

[28] 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 the provisions of section 45 of the Act, the registration will be amended to delete the following from the registration:

... socks, ... sport socks, ... and footwear namely boots, shoes and slippers, sunglasses, backpacks, ... and beer.

[29] The amended statement of goods will be as follows:

Men's and women's casual clothing, namely, shirts, t-shirts, shorts and pants, and men's and women's sportswear, namely, cycle jerseys, cycle shorts, bibs, swim wear, shorts, t-shirts, sleeveless tank tops, short sleeveless training tops, caps, and sports wear, triathletic sports wear.”

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Kerr & Nadeau

For the Registered Owner

McMillan LLP

For the Requesting Party