



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 145**

**Date of Decision: 2021-07-21**

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

**Clark Wilson LLP**

**Requesting Party**

**and**

**Mey GmbH & Co KG**

**Registered Owner**

**TMA509,013 for MEY**

**Registration**

**INTRODUCTION**

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA509,013 for the trademark MEY (the Mark), owned by Mey GmbH & Co. KG (the Owner).

[2] For the reasons that follow, I conclude that the registration ought to be maintained.

**THE PROCEEDING**

[3] At the request of Clark Wilson LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on August 27, 2018.

[4] The notice required the Owner to show whether the Mark had 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 August 27, 2015, to August 27, 2018.

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

(1) Knitted garments, namely knitted underwear.

(2) Knitted underwear.

[6] The relevant definition of use in the present case 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.

[7] It is well established that 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)]. However, 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)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Guido Buck, sworn on March 21, 2019 (the First Buck Affidavit). The Requesting Party submitted written representations on July 30, 2019.

[9] On September 12, 2019, the Owner wrote to the Registrar stating that Mr. Buck had inadvertently attached an incorrect document as Exhibit B1 to his affidavit. Attached to this correspondence was an affidavit of Guido Buck, sworn September 6, 2019 (the Second Buck Affidavit), attaching as Exhibit A the document that was intended to be attached as Exhibit B1 to

the First Buck Affidavit. Written representations of the Owner were also attached to this correspondence.

[10] On October 24, 2019, after reviewing submissions from both parties, I granted the Owner a retroactive extension of time to file this additional evidence pursuant to section 47(2) of the Act.

[11] I then exercised my discretion to grant the Requesting Party two months to file additional written representations, followed by a further two months for the Owner to file further written representations. In turn, both parties filed further written representations and requested that such representations fully replace any previously filed written representations. Accordingly, I have only considered these most recent written representations of the Requesting Party and the Owner.

[12] On October 25, 2019, after the extension had been granted but before the Requesting Party had been alerted as such, the Requesting Party reiterated its objections to the Owner's request for a retroactive extension of time, submitting, *inter alia*, that retroactive extensions under section 47(2) can only be granted where the requestor's failure to meet its deadline was not reasonably avoidable, and that the clerical error described by the Owner does not meet this criterion. The Requesting Party also states in its written representations that it maintains its objections to the extension being granted. However, as noted in the Registrar's ruling of October 24, 2019, the Federal Court has cautioned against letting section 45 proceedings become a "trap for the unwary" with respect to errors in affidavits [see *Baume & Mercier SA v Brown* (1985), 4 CPR (3d) 96 at para 8] and I am satisfied that the Owner's clerical error in the present case was a genuine error, such that the Owner's failure to meet its deadline was not reasonably avoidable. In any event, as indicated below, nothing in this decision turns on the document intended to be attached as Exhibit B1 to the First Buck Affidavit and attached as Exhibit A to the Second Buck Affidavit.

[13] No oral hearing was held in this proceeding.

#### THE EVIDENCE

[14] In the First Buck Affidavit, Mr. Buck explains that he holds the position of Specialist, International Sales & Training, at the Owner. He states that the Owner designs, manufactures

and sells a variety of clothing, including underwear, and knits and finishes the fabric used in such clothing. All such clothing “is sold in association with the MEY trademark and/or a MEY-formative trademark”. As Exhibit A, he attaches photographs of underpants and undershirts. The words “MEY EMOTION” appear on the waistband of one of the pairs of underpants, while the word “MEY” appears on hangtags attached to each garment. The word “EMOTION” appears on some hangtags, separate from the word “MEY”.

[15] Mr. Buck explains that the Owner distributes its clothing through ICO Sportswear Ltd. (“ICO”), a Toronto-based entity that has acted as the Owner’s distributor since 2017. As Exhibits B1 and C1, he attaches documents he identifies as invoices issued to ICO. As noted above, an incorrect document was attached as Exhibit B1; the correct document is attached as Exhibit A to the Second Buck Affidavit. The documents in Exhibits C1 and A are addressed to ICO and dated during the relevant period. Each document displays the Mark in the header and reads “INVOICE – consist of”, listing quantities of items including “Nightshirts and pyjamas” and “Underwear” along with customs tariff numbers and prices in Canadian dollars. At the bottom of each document is a statement that reads “The exporter of the products covered by this document (customs authorization No. [number]) declares that, except where otherwise indicated, these products are of Canada / EU- preferential origin.” I note the Second Buck Affidavit’s Exhibit A document and the First Buck Affidavit’s Exhibit C1 document are substantially the same, listing similar products transferred on different dates.

[16] As Exhibits B2 and C2, Mr. Buck attaches catalogs showing the Owner’s clothing, with certain items circled by hand. The catalogs display the Mark on the front cover. He states that the circled items correspond to MEY Clothing products listed in the invoice documents. I note that one such product, a pair of underpants, is identified as “Jazz-Pants”, product code 59 201.

[17] As Exhibit D, Mr. Buck attaches invoices dated during the relevant period issued by ICO to various Canadian retailers. He states that the invoices “relate exclusively to MEY clothing items”. The invoiced items include a product identified as “Jazz-Pants”, with the same product code as the “Jazz-Pants” underpants shown in the Exhibit C2 catalog. Mr. Buck confirms that these “Jazz-Pants” are made of knitted fabric, and that the Mark was displayed on the waistband and on a hangtag and clothes hanger, as shown in Exhibit A of the First Buck Affidavit, at the

time this item was sold by ICO to the Toronto-based retailer listed in the corresponding invoice. He states that this sale is representative of the Owner's normal course of trade during the relevant period.

### REASONS FOR DECISION

[18] The Requesting Party makes a number of submissions with respect to the Owner's evidence, including that the Buck affidavits are unreliable, that the evidence does not establish the Owner's normal course of trade or that the invoiced items were not merely promotional in nature, and that the Mark was not associated with the registered goods at the time of transfer. Each submission will be addressed in turn.

#### Reliability of the Evidence

[19] The Requesting Party submits that Mr. Buck's evidence is unreliable, and any statements not supported by the documentary evidence ought to be dismissed. The Requesting Party submits that the First Buck Affidavit, in particular, "has been shown to be incredibly unreliable" as it "contains a large number of statements which are either inconsistent with the documents affixed as Exhibits, silent with respect to the required elements under section 45 of the *Act*, or unsupported by the documentary evidence affixed as Exhibits." The Requesting Party further submits that the explanation in the Second Buck Affidavit that a clerical error led to an incorrect document being attached to the First Buck Affidavit "suggests that the affiant did not review the materials attached to his Affidavit in any detail prior to providing a sworn statement containing descriptions of these materials and implicit claims as to their accuracy". As such, the Requesting Party submits that Mr. Buck's claims ought not to be taken at face value. The Requesting Party confirms that it is not suggesting that Mr. Buck's credibility is in question, but notes that a credible affiant may nevertheless provide unreliable evidence.

[20] In addition, the Requesting Party refers to other apparent inconsistencies in Mr. Buck's evidence, including the following:

- The invoices attached as Exhibit C1 to the First Buck Affidavit and Exhibit A to the Second Buck Affidavit are "*pro forma* invoice[s], intended for review by

a customs authority, issued to facilitate the transfer of goods across borders”, despite Mr. Buck describing it as an invoice issued by the Owner to ICO;

- Despite Mr. Buck’s statement that the items listed in the Exhibit D invoices “relate exclusively to MEY clothing items”, several of the item numbers in the invoices correspond to items associated with other trademarks in the Exhibit B2 and C2 catalogs.

[21] In response, the Owner submits that the fact that the incorrect document was attached due to a clerical error “entirely explains the inconsistencies in Mr. Buck’s evidence alleged by the Requesting Party”. I note that the Owner’s submissions do not refer to the additional points listed above. In my view, however, Mr. Buck’s statements are consistent with the contents of the documents attached to his affidavits. While the document erroneously attached as Exhibit B1 is a “PRO-FORMA-INVOICE”, the Owner’s other invoices are not identified as such. Mr. Buck describes these documents as “invoice[s] issued by the Registered Owner to ICO [...] relating to items of MEY Clothing”, and the invoices attached as Exhibit C1 to the First Buck Affidavit and Exhibit A to the Second Buck Affidavit are entirely consistent with that description. Similarly, each of the Exhibit D invoices reads “Collection Mey” beneath the listed items, and while numerous clothing items in the catalogs appear alongside other trademarks, the catalogs display the Mark on the front cover and Mr. Buck confirms in his affidavit that all clothing manufactured by the Owner is sold in association with the Mark or a “MEY-formative trademark”.

[22] The Requesting Party further submits that “[w]here a statement is unsupported by the evidence, that statement itself is insufficient to show use during the Relevant Period”, citing *Bereskin & Parr v Cie de Literie Provinciale Ltée* (2005), 48 CPR (4th) 298 (TMOB) at para 20. However, that case does not stand for such a broad proposition; instead, it merely reaffirms the principle that bare statements that a trademark has been in use are insufficient to meet the requirements of section 45 of the Act, as set out in *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA). Sworn statements of fact showing use are to be taken at face value in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25]. Notwithstanding the erroneously-attached document, I am prepared to

take the remainder of Mr. Buck's statements at face value given that they appear to be consistent with the documentary evidence.

#### Transfers in the Normal Course of Trade

[23] The Requesting Party submits that Mr. Buck does not explain the Owner's normal course of trade, and does not state that the sales shown in the Exhibit D invoice were in the Owner's normal course of trade, as opposed to that of a different party. Further, the Requesting Party submits that the Exhibit D invoices show an "extraordinarily small distribution" of goods in the amount of approximately \$300, and that such a small amount does not allow for an inference to be drawn that those transfers were in the normal course of trade.

[24] In response, the Owner submits, and I agree, that Mr. Buck has clearly set out the Owner's normal course of trade as a manufacturer of clothing, and the specific nature of its trade in Canada. Evidence of a single sale can be sufficient to establish use for the purposes of section 45 expungement proceedings, so long as the sale 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]. In this case, I concur with the Owner that the Exhibit C1 and D invoices are consistent with the Owner's description of its normal course of trade.

[25] In addition, the Requesting Party submits that the evidence suggests that the invoiced transfers were promotional in nature, in view of the small volume of goods at issue and given that the document erroneously attached as Exhibit B1 shows that the Owner transferred a number of catalogs and "marketingfolder[s]" to ICO on the same day as the transfer listed in the invoice attached as Exhibit A to the Second Buck Affidavit. In my view, however, to conclude that these transactions were merely promotional in nature based on these indicia would be speculative and inconsistent with Mr. Buck's sworn statements regarding the nature of the Owner's trade.

[26] Furthermore, the Requesting Party notes that the Exhibit D invoices include the line "Title of these goods remains the property of ICO Sportswear Ltd. until the order is paid in full", and submits that there is no evidence that such a transfer of title or possession ever took place. However, Mr. Buck clearly states that the Jazz-Pants listed in the invoice issued on February 1,

2018, were “sold and delivered to [the retailer] in February 2018”. In any event, it would be evidentiary overkill to require a registered owner to provide evidence that possession of the goods was actually transferred where that owner has provided a sworn statement that sales took place as well as invoices detailing such sales [see *Gowling WLG (Canada) LLP v ZICAFPE SpA*, 2020 TMOB 120 at para 20].

[27] Finally, the Requesting Party submits that there is no indication that the Owner was the source of the MEY Clothing distributed by ICO to the distributors in the Exhibit D invoices, noting that the Owner’s name does not appear on the invoices or on the Exhibit C2 catalogs. However, as noted by the Owner, Mr. Buck clearly states that the Owner is the manufacturer of the MEY Clothing; the law is clear that the use of a trademark at any point along the chain of distribution is sufficient to demonstrate use as defined in section 4 of the Act, and that such use will accrue to the benefit of the owner provided that the goods bearing the trademark originate from the owner [*Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD); *Osler, Hoskin & Harcourt v Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD)]. In this respect, I note that the Act does not require a registered owner’s name to appear in association with a trademark [*Vogue Brassiere Inc v Sim & McBurney* (2000), 5 CPR (4th) 537 (FCTD) at para 36].

#### Association of the Mark with the Registered Goods at the Time of Transfer

[28] The Requesting Party submits that Mr. Buck has not explained how the Exhibit A photographs are “representative” of how the Mark was displayed on the Jazz-Pants or provided documentary evidence that the Jazz-Pants amount to “knitted underwear”. However, as noted by the Owner, the Exhibit C2 catalog clearly shows that the Jazz-Pants are underwear, and Mr. Buck has confirmed that they are made of knitted fabric and display the Mark on their waistband as shown in Exhibit A.

[29] I note that the Exhibit A photographs show the words “MEY EMOTION” on the pants’ waistband. Use of a trademark in combination with additional words or features will be considered use of the mark *as registered* when the public, as a matter of first impression, would perceive the mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. This is a question of fact which is dependent on whether the mark stands out



from the additional material, for example, by the use of different lettering or sizing, or whether the additional material would be perceived as clearly descriptive or as a separate trademark or tradename. In this case, “MEY” is spaced apart from “EMOTION” and appears in different lettering and sizing. In my view, the additional word “EMOTION” would be perceived as a separate trademark; in this respect, there is nothing in the Act that precludes a trademark owner from using more than one trademark at the same time in association with the same goods [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

[30] In sum, the Owner has explained its normal course of trade and provided evidence of transfers of registered goods displaying the Mark (namely, the Jazz-Pants) in Canada in the normal course of trade during the relevant period. Accordingly, I am satisfied that the Owner has used the Mark within the meaning of sections 4 and 45 of the Act.

#### DISPOSITION

[31] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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G.M. Melchin  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Bereskin & Parr LLP

For the Registered Owner

Clark Wilson LLP

For the Requesting Party