

CHANGE IN MEANING OF TERM FOR GARMENT FOUND IN 1950 STATEMENT OF WARES CANNOT SERVE TO EXPUNGE TRADE-MARK IN USE

Barry Gamache*
LEGER ROBIC RICHARD, LLP
Lawyers, Patent & Trademark Agents
Centre CDP Capital
1001 Victoria-Square – Bloc E – 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel. (514) 987 6242 – Fax (514) 845 7874
info@robic.com - www.robic.ca

Levi Strauss & Co. is the owner in Canada of trade-mark registration UCA44368 for the mark LEVI'S RED TAB Design secured on July 4, 1950 for "clothing, namely, men's, women's and children's overalls and similar garments especially garments and overalls of the patch pocket type". Canada's Federal Court recently analyzed this registration's statement of wares in order to determine what exactly is covered by the 1950 term "overalls" and to provide guidelines when interpreting terms in statement of wares or services whose meaning has changed over the decades. (*Levi Strauss & Co. v. Aird and Berlis LLP and Registrar of Trade-marks*, 2006 FC 654 (F.C., Hughes, J., May 30, 2006)).

On December 9, 2002, at the instigation of the Toronto law firm Aird & Berlis LLP, the Registrar issued a notice against the owner of registration UCA44368 under section 45 of Canada's *Trade-marks Act*, R.S.C. 1985, c. T-13. Section 45 is the "use it or lose it" provision of the Act which allows the Registrar of Trade-marks to expunge the registration of trade-marks which are not in use.

Here, the Registrar issued a notice requiring the owner of registration UCA44368 (in this case, Levi Strauss & Co.) to show use of its registered trade-mark, failing which such mark would be expunged.

Section 45 provides in part: "45. (1) The Registrar may at any time and, at the written request made after three years from the date of the registration of a trade-mark by any person who pays the prescribed fee shall, unless the Registrar sees good reason to the contrary, give notice to the registered owner of the trade-mark requiring the registered owner to furnish within three

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months an affidavit or a statutory declaration showing, *with respect to each of the wares or services specified in the registration*, whether the trade-mark was in use in Canada at any time during the three year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date.” (emphasis added).

In response to the section 45 notice, Levi Strauss & Co. filed affidavit evidence before the Registrar which purported to establish use of its registered trade-mark in association with the wares listed in its registration.

The evidence was reviewed by the Registrar who found that the trade-mark was in use in association with children’s overalls, that is garments comprising trousers with a bib and shoulder straps. As for use of the trade-mark in association with men’s and women’s overalls, the Registrant had presented evidence of use of the trade-mark in association with jeans.

However, according to the Registrar, proof of use of the mark in association with jeans could not save the wares described as men’s and women’s overalls - which were therefore to be expunged from the statement of wares - since use of the trade-mark in association with men’s and women’s jeans was not use in association with the garments described in the registration, that is trousers with a bib and shoulder straps, for men and women.

Levi Strauss & Co. appealed the Registrar’s decision under section 56 of the *Trade-marks Act* and filed additional evidence, as permitted under the Act. This additional evidence was the expert testimony of an historian employed by the Registrant and whose various duties included the gathering of historical data relating to Levi Strauss garments over the various decades during which these have been available to consumers in North America.

Levi Strauss & Co.’s expert testimony established that in the late 19th century, the word “overalls” was generally understood to refer to clothing worn over other clothing and more generally to protective work clothing. Additionally, as early as the 1920s, the term “overalls” could also mean the piece of garment now known as jeans. Moreover, until about the 1960s, the terms “waist overalls” and “jeans” were considered synonyms.

However, the coming of age of the baby boomer generation in the 1960s saw the rapid spread of the use of the term “jeans” and the equally rapid demise of the use of its older equivalent “waist overalls”. With this new evidence, the Registrant was in effect arguing that what were then known as “overalls” (at least for some garments) were now known as jeans.

The issue then for the Court was “what to do when the commonly accepted meaning of a word used in the definition of wares set out in (a) registration of a trade-mark has changed from the time of its registration to the time when use of the trade-mark is challenged.”

This is what happened here: In 1950, the term “overalls” was used to describe both trousers commencing at the waist, without a bib or shoulder straps, *and* those incorporating these features. Over the years, the trousers without a bib or shoulder straps became known as “jeans”. In the Court’s words, to refer to such trousers today as “overalls” is, at best, archaic.

In order to determine whether use of the registered trade-mark had been made out in this case, the Court wrote that one is not to be astutely meticulous when dealing with language used in a statement of wares. Moreover, summary expungement proceedings under section 45 are not the forum to entertain “the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge” (*Whirlpool Corp. v. Camco Inc.*, (2000) 2 S.C.R. 1067 in quoting from the House of Lords in *Catnic Components Ltd. v. Hill & Smith Ltd.*, (1982) R.P.C. 183). In light of the fact that the Registrant had established evidence of use of its trade-mark in association with jeans which would have been defined more than fifty years earlier as “overalls”, the Court allowed Levi Strauss & Co.’s appeal and ordered that “overalls” for men and women be maintained in its registration.

The Court’s decision confirms the common sense approach that is required when analyzing a statement of wares. Of course, if a party is to argue that the meaning of a word has changed over the years but that the underlying use of a trade-mark in association with a specific ware has in fact remained the same, a Registrant should submit relevant evidence which will assist the Registrar or the Court in the determination of such issue.

