



## **“DIRT SHIRT” MARK THROWN TO THE HAMPER OF NON-USED TRADE-MARKS BASED ON VARIED USE, BY FEDERAL COURT OF CANADA**

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The Federal Court of Canada recently granted an appeal whereby the Applicant sought an order reversing the Registrar’s rejection of its opposition to the trade-mark DIRT SHIRT on various grounds of opposition, including descriptiveness and non-use of the mark as applied for [*Coastal Culture Inc. v. Wood Wheeler Inc.*, 2007 FC 472 (Docket T-2208-05), O’Keefe J., May 2, 2007]

### ***The Facts***

The Respondent, Wood Wheeler Inc. (“Wheeler”) applied to register the trade-mark DIRT SHIRT on June 27<sup>th</sup>, 2002, in association with a variety of wares and services, based on use in Canada since May 20<sup>th</sup>, 1997. Amongst its list of wares was souvenir T-shirts dyed with soil from Prince Edward Island and its services, the custom manufacture and sale of such clothing along with other novelty items.

On August 13<sup>th</sup>, 2003, the Applicant, Coastal Culture Inc. (“Coastal”) filed a statement of opposition alleging, amongst other grounds of opposition, (i) the trade-mark DIRT SHIRT was descriptive of the method of manufacture of the products in that it referred to garments dyed to take the colour of dirt and (ii) it was confusing with Coastal’s previously used trade-mark RED DIRT SHIRT. On October 5<sup>th</sup>, 2005, the Registrar rejected the opposition after having found that Coastal had not met the burden of proving its allegations, hence the latter’s present appeal before the Federal Court of Canada.

### ***The Federal Court Judgement***

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In deciding whether or not the Registrar erred in rejecting Coastal's opposition to the registration of the DIRT SHIRT trade-mark, Justice O'Keefe, seized of the appeal, examined additional evidence filed by Coastal. The evidence tendered by Coastal contained observations by its business manager on the manner in which Wheeler's trade-marks were used both in its store and via its Internet website. Coastal submitted that the marks used were THE ORIGINAL P.E.I. DIRT SHIRT and P.E.I. DIRT SHIRT rather than the mark DIRT SHIRT.

The Court also considered the additional evidence filed by Wheeler in the form of an affidavit signed by its president and sole shareholder, explaining the nature of Wheeler's business and the reasons for the varied use of its DIRT SHIRT trade-mark.

### ***Non-compliance with date of first use alleged in application***

One of Coastal's submissions on appeal related to Registrar having erred in not considering the ground of opposition under paragraph 30 (b) of the *Trade-marks Act* which provides that an applicant for the registration of a trade-mark based on use in Canada, shall file with the Registrar an application containing the date of such first use.

### ***Sufficiency of Coastal's pleadings***

Prior to discussing the merits of this ground of opposition, the Court addressed the issue of the Registrar's refusal to consider Coastal's submissions under this ground because it was not raised in its Statement of Opposition. The Court agreed with Coastal that the Registrar erred in refusing to consider this ground insofar as any deficiency in Coastal's pleadings was cured by the evidence it filed. The Court reiterated the principle that consideration of the sufficiency of pleadings in isolation is a thing of the past.

### ***Varied use of Wheeler's DIRT SHIRT trade-mark***

The Court proceeded to consider the merits of Coastal's opposition challenging Wheeler's allegation of first use in Canada since May 20<sup>th</sup>, 1997. Coastal argued that Wheeler's use of the DIRT SHIRT mark was non-compliant use because it was varied use to the point and that Wheeler should not be able to remove components of the trade-marks it used (THE ORIGINAL P.E.I. DIRT SHIRT and P.E.I. DIRT SHIRT) in order to rely on the date of first use alleged in its application, namely May 20<sup>th</sup>, 1997.

On the other hand, Wheeler argued the variations on its trade-mark were acceptable deviations in that the dominant features of its mark “DIRT SHIRT” remained and the addition of the words “P.E.I.” and “THE ORIGINAL” were minor deviations.

In determining the nature of the deviations, the Court first determined, based on the evidence before it, that Wheeler never used the DIRT SHIRT mark alone but rather with the added elements “P.E.I.” or “THE ORIGINAL P.E.I.” preceding the words “DIRT SHIRT”. Next, the Court noted that the word “P.E.I.” was written in the same font and size as the words “DIRT SHIRT” while the words “THE ORIGINAL” were smaller and displayed above the words “P.E.I. DIRT SHIRT”.

The Court took note of Wheeler’s explanation that the words “THE ORIGINAL” were added to the DIRT SHIRT mark in order to distinguish its wares from those of other vendors and considered it a minor deviation. However, the Court was unable to ignore the evidence that Wheeler never sold products with only the mark DIRT SHIRT, absent the word “P.E.I.” and held this deviation to be more than minor.

In granting the appeal, setting aside the Registrar’s decision and directing the latter to refuse Wheeler’s application for the registration of the DIRT SHIRT trade-mark, the Court did not deal with the other issues raised by Coastal, such as descriptiveness.

### ***Conclusion***

It is trite law that with any varied use, the owner of a trade mark could find itself playing with fire. Case law has routinely demonstrated the perils associated with unacceptable varied use of a trade-mark within the context of administrative cancellation proceedings: the expungement of the owner’s trade-mark registration from the register. However, in the present case, the Court’s decision is a useful reminder of the consequences of such varied use at a much earlier stage, that is, during the course of the trade-mark application process.

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