



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

Citation: 2013 TMOB 222
Date of Decision: 2013-12-19

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Riches, McKenzie & Herbert LLP against
registration No. TMA584,328 for the trade-mark NYC &
Design in the name of Chaussures M & M Inc./M & M
Footwear Inc.**

[1] At the request of Riches, McKenzie & Herbert LLP (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 February 14, 2012 to Chaussures M & M Inc./M & M Footwear Inc. (the Registrant), the registered owner of registration No. TMA584,328 for the trade-mark NYC & Design (the Mark) shown below:



[2] The Mark is registered for use in association with the following wares: footwear, namely, ladies', men's and children's shoes, consisting of fashionable shoes, casual shoes, and beach footwear.

[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 wares and services 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 use since that date. In this case, the relevant period for showing use is between February 14, 2009 and February 14, 2012.

[4] The relevant definition of “use” is set out in section 4(1) of the Act:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares 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 the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Cliffert Peschlow, Operations Manager of the Registrant, sworn on March 9, 2012. Only the Registrant filed written representations; an oral hearing was not held.

[7] In his affidavit, Mr. Peschlow attests that the Registrant has been marketing, selling and distributing footwear in Canada since January 1996 and since then has sold “well over one million pairs of footwear”.

[8] Mr. Peschlow explains that the Registrant sold its footwear through various retailers across Canada and, in each year of the relevant period, sold over 100,000 pairs of footwear in association with the Mark, representing approximately \$750,000 in annual sales. In support of his assertion of use of the Mark during the relevant period, Mr. Peschlow provides the following exhibits:

- Exhibit R-1 consists of 19 photographs depicting various types of footwear, which Mr. Peschlow identifies as examples of footwear produced by the Registrant. The photographs are of various styles of shoes for men, women and children, including beach footwear, and I note that several models bear the Mark.

- Exhibit R-10 consists of two photographs depicting a shoe box that Mr. Peschlow attests is the type of shoe box used by the Registrant in the sale of its footwear bearing the Mark. I note that the Mark is prominently displayed on the depiction of the shoe box.
- Exhibits R-2, R-3 and R-4 together consist of over 30 invoices from the Registrant to various customers located in Canada, all dated within the relevant period. Mr. Peschlow attests that the invoices reflect some of the aforementioned sales of the Registrant's footwear bearing the Mark.
- Exhibit R-9 consists of a chart listing footwear style numbers which Mr. Peschlow attests identify units of footwear sold in association with the Mark. I note the style numbers are listed on several of the invoices at Exhibits R-2, R-3 and R-4.

[9] Corroborative of the above, Mr. Peschlow also provides the following: purchase orders for footwear by the Registrant from its supplier in Hong Kong (Exhibit R-5); a copy of a brochure and a photograph of a banner (Exhibit R-6) and a copy of a list of exhibitors (Exhibit R-7) relating to the Registrant's participation in trade shows in Toronto during the relevant period; and printouts from the Registrant's website showing footwear bearing the Mark (Exhibit R-8).

[10] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with the wares as registered.

[11] Although the Requesting Party did not file any written representations prior to its administrative deadline to do so, in correspondence subsequently sent to the Registrar, the Requesting Party contends that "the Registrar appears to have been receiving correspondence from an entity which is not the registered agent of the registrant nor the registrant. Accordingly, cancellation of the registration is respectfully requested." In this respect, the Requesting Party further submitted that in accordance with section 8 of the *Trade-marks Regulations* (the Regulations), correspondence with the Registrar "shall be with the registrant or its duly appointed agent."

[12] In response, the Registrant's representative stated that "all representations in respect to this matter have emanated from myself through my office as a registered trade-mark agent of the registered trade-mark holder".

[13] I would note that section 8 of the Regulations does not apply to section 45 proceedings, as it specifically relates to correspondence submitted to the Registrar during the prosecution of a trade-mark *application*:

8(1) Subject to subsections (2) and (4), correspondence relating to the prosecution of an application for the registration of a trade-mark shall be with the applicant.

[14] Furthermore, it is clear from section 45(2) of the Act that the Registrar may hear representations made by or *on behalf of* the registered owner of the trade-mark:

45(2) The Registrar shall not receive any evidence other than the affidavit or statutory declaration, but may hear representations made by or on behalf of the registered owner of the trade-mark or by or on behalf of the person at whose request the notice was given.

[15] In the present case, the Registrar received evidence in the form of an affidavit sworn by Mr. Peschlow, Operations Manager of the Registrant and written representations filed by the Registrant's representative.

[16] In my view, the Requesting Party's contention has no real basis in fact or law. There is no doubt that Mr. Peschlow is an authorized representative of the Registrant, such that the evidence was, in fact, "furnished" by the Registrant in accordance with section 45(1) of the Act. Furthermore, there is no doubt that the written representations were properly submitted on behalf of the Registrant by its representative in accordance with section 45(2) of the Act.

[17] In any event, in view of the purpose and scope of section 45 proceedings, the Federal Court has cautioned against letting technical requirements become "a trap for the unwary" where a trade-mark has been obviously in use by its rightful owner [see *Baume & Mercier SA v Brown Carrying On Business as Circle Import* (1985), 4 CPR (3d) 96 (FCTD)]. On this basis in the present case, I would be prepared to accept the Registrant's evidence and written representations as admissible.

Disposition

[18] Accordingly, pursuant to the authority delegated to me under subsection 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be maintained.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office