

SECTION 45 PROCEEDING
TRADE-MARK EARTH
REGISTRATION NO.: 327,295

On March 9, 2004, at the request of Gowling Lafleur Henderson, the Registrar forwarded the notice prescribed under Section 45 of the Trade-Marks Act to Meynard Designs, Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark EARTH is registered for use in association with the following wares namely:

- (1) shoes
- (2) hosiery and hats

Section 45 of the Trade-marks 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/or services listed on 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. The relevant period in this case is any time between March 9, 2001 and March 9, 2004.

In response to the notice the affidavit of Philippe Meynard together with exhibits has been furnished. Each party filed a written argument and was represented at the oral hearing.

Mr. Meynard is Treasurer and Vice President of the registered owner (hereinafter “owner”). He

indicates that the owner has used the trade-mark in Canada prior to the date of the Section 45 notice and continuously to the date of his affidavit (i.e. October 29, 2004). He states that the owner distributes its EARTH brand shoes and clothing in Canada through its distributor Jury Inc. and that all EARTH brand footwear and clothing referenced in the affidavit is manufactured by or for his company, and shipped to Jury Inc. for ultimate sale in Canada. He confirms that at the time of manufacture the trade-mark is applied to the footwear and clothing, prior to being shipped to Jury Inc.

He adds that Jury Inc. is authorized to prepare advertising for use in Canada and as Exhibit A he provides an extract from the Canadian trade magazine entitled Canadian Footwear Journal of October 2002 and as Exhibit B he provides material relating to the preparation of an advertisement that appeared in the August 2001 edition of Canadian Footwear Journal. As Exhibit C he provides an extract from the Edmonton Journal of February 12, 2002 which makes reference to EARTH brand footwear. As Exhibit D he submits current pages from his company's website.

As Exhibit E he provides samples of invoices from the three-year period prior to March 9, 2004 as well as after, evidencing the sale of footwear to retailers in Canada. He explains that even though the invoices make reference to model names such as Solar, Harvest and Speedy and others, these are all style names of EARTH brand footwear which bear the registrant's EARTH trade-mark as indicated earlier.

As examples of the manner the trade-mark is applied to the footwear prior to being shipped to Jury Inc., Mr. Meynard has provided boxes and labels for the shoes or their packaging. He then specifies that all of the foregoing is produced to show use of the trade-mark EARTH and sale of his company's EARTH brand footwear, in the normal course of trade, during the relevant period.

Then he refers to the owner's website which he states shows reference to hosiery and hats and he provides as Exhibit G examples of hosiery and hats bearing the trade-mark and manufactured by or for the registrant and shipped to Jury Inc. for distribution to customers and people attending trade shows and the like continuously over the last 4 years.

The requesting party argues that the evidence fails to show sales of hosiery or hats in Canada during the relevant period. It adds that the give away of products as promotional items does not constitute sales in the normal course of trade. Consequently, it submits that the wares "hosiery and hats" ought to be deleted from the trade-mark registration.

With respect to "shoes" the requesting party submits that the evidence is so vague and imprecise that it requires a number of assumptions and inferences to be made regarding the use of the trade-mark in association with the shoes sold during the relevant period. It argues that although the invoices may evidence sales of shoes, there is no clear evidence that such shoes were associated with the trade-mark or were sold in the boxes furnished as Exhibit F. It adds that the mere existence of the boxes produced as Exhibit F without any clear assertion or proof that the shoes were actually sold in Canada in these types of boxes during the relevant period is irrelevant.

Having considered the evidence, I totally agree with the requesting party that it completely fails to show that transfers in the normal course of trade of “hosiery and hats” were made in Canada during the relevant period.

What we have is an assertion in paragraph 4 of the affidavit that all EARTH brand clothing referenced in the affidavit are shipped to Jury Inc. for ultimate sale in Canada. However, this assertion is not supported by the evidence. In fact in paragraph 12 of the affidavit, Mr. Meynard refers to the shipment of hosiery and hats for “distribution” by Jury Inc. to customers and people attending trade shows and the like over the last 4 years (i.e. prior to October 29, 2004). In my view, the term “distribution” is broad and raises questions. If the products that were shipped were for sale by Jury Inc. then Mr. Meynard could have clearly stated so and could have provided clear evidence to that effect. As he chose to be vague and ambiguous, I interpret the ambiguity against the registrant.

Concerning the fact that there is a reference on the registrant’s website to a “cap” bearing the trade-mark being offered for sale, as properly argued by the requesting party the website is outside the relevant period and all it shows is that one model of a cap was being offered for sale subsequent to the relevant period.

Consequently, having regard to the above, the wares “hosiery and hats” will be deleted from the trade-mark registration.

With respect to the wares “shoes”, Mr. Meynard has provided invoices showing that sales of footwear were made during the relevant period. The issue is whether the trade-mark was associated with the shoes in a manner satisfying the requirements of s-s. 4(1) of the Act.

In paragraph 4 of the affidavit, there is an assertion that the EARTH trade-mark is applied to the footwear prior to being shipped to Jury Inc. and as Exhibit F Mr. Meynard has provided examples of the manner his company’s trade-mark is applied to the footwear prior to being shipped to Jury Inc. As I pointed out at the oral hearing, one of the shoe boxes furnished as Exhibit F and bearing the trade-mark clearly refers to a shoe called “Lotus”. As Invoice No. 00003991 dated February 26, 2003 refers to the sale of “Lotus” shoes, I accept, having regard to the evidence as a whole, that the “Lotus” shoes were most probably sold in the type of box for such shoes furnished as Exhibit F. As the sale of “Lotus” shoes was made during the relevant period, and as I have concluded that the trade-mark was associated with such shoes in a manner complying with the requirements of s-s. 4(1) of the Act, I find this sufficient to permit me to conclude that the trade-mark was in use in Canada during the relevant period in association with shoes.

Accordingly I conclude that the wares “shoes” ought to be maintained on the trade-mark registration.

Registration No. 327,295 will be amended so that the statement of wares will read “shoes” in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 28TH DAY OF FEBRUARY 2007.

D. Savard
Senior Hearing Officer
Section 45 Division