



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

**Citation: 2014 TMOB 13**  
**Date of Decision: 2014-01-22**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Viking Fottøy AS against registration  
No. TMA444,368 for the trade-mark FUSSFÖRM BY  
VIKING in the name of Baker Footwear Limited**

[1] At the request of Viking Fottøy AS (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 January 11, 2012 to Baker Footwear Limited (the Registrant), the registered owner of registration No. TMA444,368 for the trade-mark FUSSFÖRM BY VIKING (the Mark).

[2] The Mark is registered for use in association with the following wares: footwear namely, shoes and sandals.

[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 such use since that date. In this case, the relevant period for showing use is between January 11, 2009 and January 11, 2012.

[4] The relevant definition of “use” in association with wares 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 mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite 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)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Registrant furnished the affidavit of David Koa, President of the Registrant, sworn on April 10, 2012. Both parties filed written representations; an oral hearing was not held.

[7] In his brief affidavit, Mr. Koa asserts use of the Mark during the relevant period, though he does not clearly identify whether it was by the Registrant, a licensee or another party, simply asserting that the Mark "has been used in Canada in association with the wares during the [relevant] period". He does state that the Registrant "sells the wares bearing the Mark to Canadian retail stores such as Walking on a Cloud and other footwear distributors." However, Mr. Koa does not clearly state whether such sales occurred during the relevant period. I further note that the Registrant has not furnished any documentary evidence of transfers or sales of the wares during the relevant period or otherwise. No invoices have been provided nor does Mr. Koa give any indication of sales volumes to assist in determining whether the sales vaguely attested to were in the normal course of trade during the relevant period.

[8] The only supporting evidence that the Registrant has furnished consists of two exhibits attached to Mr. Koa's affidavit. Exhibit A is two photographs, one of an adult-sized sandal and the other of a child-sized clog shoe. Although partially obscured in the photograph of the clog, both shoes have labels on the insole displaying the Mark. Mr. Koa states that these "samples of footwear displaying the [Mark] are representative to those sold in Canada during the Relevant Period." However, I note that nothing in the photographs indicates that these shoes are sold in

Canada; indeed, the shoe size on the sandals (37) and German wording on the labels underneath the Mark suggest that these shoes are not necessarily those targeted for the Canadian market.

[9] I am also not satisfied that his statement clearly connects the Exhibit A footwear to the other evidence, in particular Exhibit B. That exhibit consists of printouts of webpages that Mr. Koa states are from Canadian retailers, including the aforementioned Walking on a Cloud, “that displayed, advertised and sold wares bearing the [Mark] during the Relevant Period”. The first part of the exhibit consists of webpage printouts from Walking on a Cloud’s website *walkingonacould.ca* dated February 22, 2012, in particular a company information page for “Viking”, and two pages showing various “Viking” sandals for sale. I note there is a reference to “Fussform by Viking” in a text paragraph on the company information page; however, there is no reference to the Registrant and Mr. Koa provides no explanation regarding the relationship, if any, between the Registrant and Viking. Furthermore, none of the sandals pictured on the webpage printouts appear to bear the Mark or correspond with the footwear shown in Exhibit A. Indeed, where a trade-mark is visible on the footwear appearing on the Walking on a Cloud website, it appears only as VIKING.

[10] The second portion of Exhibit B is printouts from *flyerland.ca*, which Mr. Koa describes as “a third-party Canadian website operated by Metroland Media Group, which is ... promoting shoes sold by Walking on a Cloud”. I note that the *flyerland.ca* webpage printouts contain references to “Viking” and “fussform molds” in the product descriptions, but not to the Mark as registered or to the Registrant. Furthermore, each page displays an information box stating that “This product may no longer be available”.

[11] With respect to evidence of transfers of the wares, in its written submissions, the Registrant states that the February 2012 printouts from the Walking on a Cloud website identify “popular accessories” that a customer can add to their online “Shopping Bag” next to the depicted footwear. The Registrant submits that it is reasonable to infer that Walking on a Cloud made sufficient sales prior to February 2012 in order to determine which accessories for such footwear were, in fact, “popular”. I am not prepared to make such an inference; the relationship, if any, between the “Shopping Bag” suggestions and the particular product on the webpage is not in evidence.

[12] The Registrant further submits that the website printouts from the *flyerland.ca* website confirm the wares were advertised for sale by Walking on a Cloud between October and December 2010, which is during the relevant period. In this respect, the Registrant notes that these web pages have a notice indicating when the information was pulled or “updated” from the Walking on a Cloud website. The Registrant submits that the Registrar can accept such evidence from a third-party website, citing *Royal Canadian Golf Association v ORCGA* (2009), 72 CPR (4th) 59 (TMOB). However, even with a generous reading, the probative value of these printouts is limited; advertisements, much less online ones by third-parties, are insufficient to show transfers in the normal course of trade. At best, the website shows that shoes *may* have been advertised for sale early in the relevant period.

[13] In any event, it is not clear that such shoes bore the Mark as registered. As noted above, where a trade-mark is visible on the depictions of footwear on the website printouts, it is not of the Mark as registered. I consider Mr. Koa’s statement that the Exhibit A shoes are “representative to those sold in Canada during the relevant period” to be ambiguous. He does not clearly state that the depicted footwear was sold in the normal course of trade, either by the Registrant or on its behalf and, especially given the absence of evidence of actual transfers of the wares, I cannot infer a connection to the Exhibit B printouts.

[14] In view of the foregoing, I find that the Registrant has failed to satisfy its *prima facie* burden to show use of the Mark within the meaning of the Act [see *Brouillette Kosie Prince v Great Harvest Franchising, Inc* (2009), 77 CPR (4th) 247 (FC)]. It should have been a simple matter for the Registrant to provide more direct evidence of sales during the relevant period and for Mr. Koa to make clear statements connecting such transfers with footwear displaying the Mark. Instead, without providing clear statements with respect to its normal course of trade during the relevant period, the Registrant curiously relied on third party advertisements dating from after the relevant period that are, in any event, deficient with respect to display of the Mark.

[15] As such, I cannot conclude that the Registrant has demonstrated use of the Mark in association with the wares within the meaning of sections 4 and 45 of the Act. Furthermore, the Registrant has provided no evidence of special circumstances excusing the absence of such use.

#### Disposition

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

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