

TRADUCTION/TRANSLATION



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

Citation: 2012 TMOB 58
Date of Decision: 2012-03-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Ogilvy Renault LLP/SENCRL, against
registration No. TMA618,900 for the trade-mark AIR
TECHNO in the name of Mephisto Inc.**

[1] At the request of Ogilvy Renault LLP/SENCRL (the Requesting Party), the Registrar of Trade-marks (the Registrar) forwarded a notice under section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) on October 26, 2009 to Mephisto Inc. (Mephisto), the owner (the Registrant) of registration No. TMA618,900 for the trade-mark AIR TECHNO (the Mark).

[2] The Mark is registered for use in association with the following wares:

Footwear (except orthopedic footwear), namely children's footwear, footwear for women, footwear for men, exercise footwear, walking shoes, sports footwear, comfort footwear, street shoes, sandals; soles for 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/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. Therefore, the relevant period for showing use is any time between October 26, 2006 and October 26, 2009 (the Relevant Period).

[4] The use of the trade-mark in association with wares is defined in section 4 of the Act, whose applicable provisions are set out as follows:

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] In response to the notice pursuant to section 45, the Registrant filed the affidavit of Frank Weber, Mephisto's Chairman of the Board of Directors. Only the Registrant filed written representations.

[6] The Registrant acknowledges that there is no evidence of use of the mark at issue for the following wares: "children's footwear, footwear for women, exercise footwear, walking shoes, sports footwear, comfort footwear, sandals".

[7] I will therefore focus my analysis on the wares that continue to be of interest to the Registrant, namely "footwear for men", "street shoes", and "soles for footwear".

[8] In paragraphs 6 to 9 of his affidavit, Mr. Weber explains how the AIR-TECHNO mark is displayed on "footwear for men", "street shoes" and "soles for footwear". He provides, in Exhibits A and B of his affidavit, photographs which illustrate the mark at issue displayed on a footwear sole manufactured by Mephisto. This sole is then glued onto a second removable sole. This combination of soles is then inserted into a street shoe for men, which is manufactured by Mephisto and marketed under the mark SPENCER. Mr. Weber adds in paragraph 10 of his affidavit that the soles are always marketed with shoes of the SPENCER mark. He adds, and the photographs indeed indicate, that the Mark is visible from the top and when the consumer puts on the shoes.

[9] One of the issues in these proceedings is to determine if the Mark is associated only with the footwear sole, or if the Mark is associated with both the sole and the street shoes for men. In this case, the sole on which the Mark is displayed is a component part of the street shoes for men, and these are always sold together in Canada. The Canadian consumer, when purchasing shoes bearing the SPENCER mark, may easily see the AIR-TECHNO mark. Jurisprudence

indicates that it is possible to use multiple trade-marks side-by-side for the same ware; in this case SPENCER and AIR-TECHNO [*Kraft Ltd. v. Canada (Registrar of Trade-marks)* (1984) 1 C.P.R. (3d) 457 (F.C.T.D.)]. I therefore find that the Canadian consumer associates the Mark both with the sole and with the street shoes for men.

[10] To demonstrate the continuous use of the mark in Canada during the Relevant Period, Mr. Weber attached Exhibits C to M to his affidavit. These exhibits reveal, for the Relevant Period, 11 copies of sales invoices from Mephisto to Mephisto Canada Inc. for SPENCER brand shoes. Mr. Weber confirms in paragraph 15 of his affidavit that said shoes contained the removable sole with the AIR-TECHNO mark.

[11] Further, Mr. Weber adds in paragraph 16 of his affidavit that he is aware of the fact that shoes sold and delivered in Canada to Mephisto Canada Inc. were resold to the retailer T.F. Firma Inc. during the Relevant Period. This business operates six retail shoe stores in the greater Montreal area.

[12] Mr. Weber's confirmation that the soles on which the Mark is displayed are always sold to Canadian retailers with SPENCER brand shoes is sufficient evidence to convince me of use of the Mark in Canada for the Relevant Period pursuant to subsection 4(1) of the Act.

[13] I note that the AIR-TECHNO mark used differs from the registered AIR TECHNO mark because of the hyphen. In this case, I consider that the addition of a hyphen is an insignificant and acceptable addition as it would not deceive the unaware purchaser as to the origins of the soles or street shoes for men [*Zahnfabrik Bad Nauheim Kommanditgesellschaft Vormals Zahnfabrik Hoddes (Re)* (2006) 57 C.P.R. (4th) 74 at para 12 (T.M.O.B.); *Nightingale Interloc Ltd v Prodesign Ltd* (1984) 2 C.P.R. (3d) 535 at para 8 (T.M.O.B.)].

Disposition

[14] In view of the foregoing, and pursuant to the authority delegated to me under subsection 63(3) of the Act, the registration bearing No. TMA618900 should be amended pursuant to subsection 45(3) of the Act to delete the following wares: "children's footwear, footwear for women, exercise footwear, walking shoes, sports footwear, comfort footwear, sandals".

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
[Jane Kuna]