

IN THE MATTER OF A SECTION 45 PROCEEDING

Respecting Registration No. 236,635 for the trade-mark "FRANCALDO-FIRENZE"

In the name of Franca Shoe Inc. Chaussure Franca Inc

**TRADUCTION**

At the request of Messrs. Phillips & Vineberg, the Registrar issued a s. 45 notice dated November 1, 1991 to Franca Shoe Inc. Chaussure Franca Inc., the current owner of the trade-mark "FRANCALDO-FIRENZE" (the "trade-mark"). The trade-mark was registered on October 12, 1979 for use in association with ladies' and men's shoes, sandals and boots. In response to the Registrar's Section 45 notice, the registered owner furnished the sworn affidavit of Aurele Lacroix, president of Franca Shoe Inc. since its inception in 1965 and Exhibits AL-1 through AL-4.

By way of a general comment, it is noted that in the affidavit (e.g. para 10) and in some of the exhibits (e.g. AL-3(a)), the name of the registrant appears as "Chaussure Franca Shoe Inc.". The registrant has given no explanation for this discrepancy, but I am prepared to infer without evidence to the contrary that this is merely a bilingual form of the registrant's name and that the evidence demonstrates use of the trade-mark by the registrant.

In the affidavit, Mr. Lacroix describes the business operations of Franca Shoe Inc. and its use of the registered trade-mark. The affiant states that the trade-mark has been in use in the normal course of trade in association with the wares mentioned in the registration, i.e. ladies' and men's shoes, sandals, and boots since 1985, generating yearly sales of merchandise in association with the "FRANCALDO-FIRENZE" trade-mark varying between \$500,000 and \$700,000 a year.

The requesting party argues that the registered owner has not shown use in Canada at the relevant time in association with the items of wares listed in the registration.. The arguments made in the requesting party's written submissions shall be given consideration below.

I. What is the relevant time at which the registrant must show use of the trade-mark in association with the wares mentioned in the registration?

As a result of recent amendments to Section 45 of the *Trade Marks Act* (January 1, 1994), the

registrant is required to show that the trade-mark was in use in Canada "at any time during the two-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date".

The section 45 notice was issued by the Registrar on November 1 1991, hence the relevant time as determined by the legislation is between November 1, 1989 and the date the notice was issued.

Thus, most of the evidence contained in Exhibit AL-4 pertains to the relevant period. In paragraph 8 of the affidavit, Mr. Lacroix states that the evidence contained in Exhibit AL-3 represents a sample of promotional material advertising wares labelled with the registered trade-mark during the last three years. Some of the material, then, might not fall within the relevant period. At least two items in Exhibit AL-3, however, can be shown to date back to the two-year period. The date printed at the bottom of the back page of the extract submitted from the "Canadian Footwear Journal" clearly indicates that the advertisement dates from January of 1990. As to the advertisement contained in Exhibit AL-3(b), the affiant claims that it originates from the December 18, 1990 edition of "Le Reveil"; I accept the time of publication to be as claimed.

II. Has the registrant established use of the trade-mark in association with each of the wares mentioned in the registration within the two-year period preceding the date of notice?

The purpose of a s. 45 inquiry is to remove trade-marks that have become "deadwood" from the Registry. As J. Mahoney pointed out in Union Electric Supply Co. Ltd. v. Registrar of Trade Marks (1982) 63 C.P.R. (2d) 56 (F.C.T.D.) at p. 57 of his dicta:

"There is absolutely no justification in putting a trademark owner to the expense and trouble of showing his use of the trade mark by evidentiary overkill when it can be readily proved in a simple straightforward fashion."

The Registrar's role is to determine whether the registered owner has submitted enough evidence to conclude that he or she has "shown" use or, at least, has sufficiently related the facts from which such use can be inferred.

The evidence submitted by the registrant is not without deficiencies. The requesting party's allegation is correct that it is impossible to determine conclusively from the invoices which items

of footwear listed bore the trade-mark, because the invoices contain descriptions such as "FAREX", "ALICE", and "FIGARO" but do not indicate whether the wares sold also bore the trade-mark "FRANCALDO-FIRENZE". However, the sample footwear and the photographs of wares provided by the registrant show that the registrant's footwear bears the trade-mark and at the same time is associated with other trade-marks. The photographs show the other trade-marks as being "FRANCA", "FAREX", "ALICE", "MABEL" and "FIGARO". The sample footwear shows "PANAMA", "PASTA" and other marks. The invoices submitted as Exhibit AL-4 contain specific references to the trade-marks "FAREX", "ALICE", "FIGARO", "PANAMA" and "PASTA".

Having considered all the evidence, it appears that there are various lines or styles, if you will, of "FRANCALDO-FIRENZE" footwear, and it is the names of the lines or styles that appear on the invoices. There is nothing in the *Trade Marks Act* to prohibit the use of two or more trade-marks at the same time: A. W. Allen Ltd. v. Warner-Lambert Canada, (1985) 6 C.P.R. (3d) 270 (F.C., T.D.). Consequently, I conclude that the invoices confirm that sales of the wares associated with the trade-mark were made during the relevant period.

On balance, I believe that enough relevant evidence can be gleaned from the registrant's statements to maintain registration. The affidavit contains a clear statement to the effect that the registrant has used the trade-mark in association with each item of wares specified in the registration and the registrant has furnished examples of such use. The registrant has provided approximate annual sales figures regarding the wares. It has provided shoes and sandals stamped with the trade-mark, portions of shoe boxes bearing the trade-mark and a guarantee also bearing the mark "FRANCALDO-FIRENZE" which it is stated is attached to "boots". The registrant has also submitted invoices. In my opinion, the items of evidence, when taken together, create a chain of proof that makes it possible to conclude that the trade-mark is not deadwood in relation to any of the wares, and that it has been used in association with sales of men's and women's shoes, boots and sandals within the two years preceding the issuance of the notice.

**Disposition:**

Registration No. 236,635 will be maintained in compliance with the provisions of Section 45(5) of the *Trade Marks Act*.

DATED AT HULL, QUEBEC, THIS                      DAY OF                      1994

D. Savard  
Senior Hearing Officer  
Section 45