



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

Citation: 2010 TMOB 53
Date of Decision: 2010-04-22

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Baker & McKenzie, LLP against registration
No. TMA325,914 for the trade-mark SNICKERS in the name
of M & M Footwear Inc.**

[1] At the request of Baker & McKenzie LLP (the requesting party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on May 9, 2007 to M & M Footwear Inc. (the registrant), the registered owner of the above referenced trade-mark.

[2] The trade-mark SNICKERS (the Mark) is registered for use in association with “footwear, namely casual and leisure footwear”.

[3] Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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. In this case the relevant period for showing use is any time between May 9, 2004 and May 9, 2007.

[4] The registrant is required to show use of each of the wares set out in the statement of wares; 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 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at

480], and evidentiary overkill is not required, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares/services specified in the registration during the relevant period.

[5] Use in association with wares is set out in subsection 4(1) of the *Trade-marks Act*:

A trade-mark is deemed to have been 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.

[6] In response to the Registrar's notice, the registrant furnished the statutory declaration of Bernard London. Both parties filed written submissions and were represented at an oral hearing.

[7] Mr. London states that he is the registrant's Comptroller, Senior Vice-President and Marketing and Sales Manager. Mr. London provides that the registrant has been marketing, selling and distributing the above wares in a continuous and uninterrupted fashion since February 1987 under the Mark and intends to continue to do so.

[8] The requesting party objects to the many positions apparently held concurrently by Mr. London, stating that for this reason his position with the registrant appears to be unclear and ambiguous. However, I do not find it unreasonable that in a small to medium sized business one person would fulfill multiple job functions and thus have a wide ranging knowledge of the business. I find the affiant has identified himself and the basis for his knowledge sufficiently for the purpose of these proceedings.

[9] The requesting party further notes that use in 1987 would have been by an entity with a different name - M & M Trading Inc. I would observe that the record shows that an assignment took place well before the relevant period in September 2001 (filed on October 25, 2001), from M & M Trading Inc. to the current owner. Since the current registered owner was in fact the owner during the relevant period, and since evidence of use has been provided during the relevant period (as set out below) any statement of use prior to the relevant period is irrelevant to these proceedings. Accordingly, I find the requesting party's argument of little consequence in this regard.

[10] Mr. London further specifies that the wares sold under the Mark are men's casual and leisure shoes. These wares have been sold through numerous retail outlets and distributors across Canada, including Northwest Company, Giant Tiger, Sann Stores, and Logisti-Solve Bargain Shop. The affiant provides that "during the last three years, the registrant has sold approximately 50,000 pairs of shoes in association with the trade-mark SNICKERS at a global sale price of approximately \$500,000." Although as the requesting party pointed out, the "last three years" could conceivably include the period of time between the end of the relevant period May 9, 2007(date of s.45 notice) and the date of the statutory declaration - July 6, 2007, I find it reasonable to infer that 50,000 pairs of shoes would not all have been sold during the two months between the s.45 notice and the date of the statutory declaration. As well, on a fair reading of the statutory declaration as a whole, I am willing to infer that the sales referred to are to the aforementioned retailers in Canada.

[11] In any event, the affiant attaches sample invoices of sales to retailers in Canada, dated within the relevant period, which will be discussed below.

[12] With respect to sales in the normal course of trade, Mr. London attaches a sample purchase order and several sample invoices. The requesting party pointed out that although the declarant states (in paragraph 9) that the sample purchase order (Exhibit R-1) relates to men's casual and leisure shoes, it actually lists ladies shoes. However, since the sample invoices provided (Exhibits R-2, R-3, R-4) do relate to men's shoes and are dated during the relevant period (2005, 2006 and 2007-up to and including May 9, 2007), I do not find that the error in respect of the purchase order contradicts the statutory declaration when read as a whole. Even if I disregard the sample purchase order, the sample invoices clearly support Mr. London's statements regarding the sale of men's footwear during the relevant period.

[13] I note that these invoices refer to "men's jogger" with a style number of 12233. The shoes sold appear to be either navy or black and with or without Velcro.

[14] Sample invoices indicating that sales continued after the relevant period, are attached as Exhibit R-5. I note that those invoices also refer exclusively to style no. 12233 "men's jogger". The declarant also refers to wares in inventory at the end of the relevant period (paragraph 13). I agree with the requesting party that these facts are irrelevant to the requirements of s.45 of the

Act; I take these statements and the invoices dated after the relevant period to be merely reinforcing the registrant's stated interest in continuing to commercialize its products under the Mark, and not as actual evidence of use.

[15] A photograph is attached displaying the manner in which the Mark SNICKERS appeared on the shoes (Exhibit R-6); SNICKERS appears clearly displayed on the inside of the shoe along the sole at the heel end of the shoe. Mr. London states that each of the items of footwear sold by the Registrant in association with SNICKERS has always carried the label SNICKERS as in the photograph or through use of labels similar to the one which appears in the photograph.

[16] The requesting party submits that there is no evidence that the label was visible at the time of sale since no description of how the shoes were packaged at the time of sale was provided. I am of the view however, that visibility of the Mark at the time of sale is not an issue, since at least some (if not most) members of the public would look at the shoes (if not try them on), before purchase. I therefore find the photograph of the shoe bearing the Mark to be satisfactory demonstration of the manner in which SNICKERS was associated with the wares at the time of sale.

[17] Furthermore, in my view identification under oath of labeling of wares during the relevant period as either shown or "similar" to that shown in the photograph is sufficient for the intent and purpose of s.45 to support evidence that the Mark was associated with the wares at the time of sale pursuant to s.4(1) of the Act.

[18] In paragraph 16 Mr. London states that the registrant "maintains a number of styles of men's casual and leisure footwear". He provides three different style numbers (including 12233) for shoes his company "offers to various retailers across Canada". While I agree with the requesting party that these statements are not evidence that such styles were actually sold during the relevant period, I am of the view that this is irrelevant to the determination to be made here for reasons set out below.

[19] Evidence of use is provided by the statutory declaration as a whole including the relevant invoices (Exhibits R-2, R-3, R-4) and the photograph of the manner in which the Mark is associated with the wares at the time of sale. The declarant clearly states throughout the evidence

that “casual and leisure shoes” were sold during the relevant period. No references are made to “casual shoes” and “leisure shoes” separately; rather on a fair reading of the statutory declaration, I am persuaded on the balance of probabilities, that it is not unreasonable that the “men’s jogger” (which the declarant refers to as casual and leisure shoes) listed in the relevant invoices, are sold and worn for “casual and leisure” purposes. I am therefore satisfied, taking into consideration the purpose and intent of s.45 of the Act, that the requisite use of the Mark SNICKERS on “footwear, namely casual and leisure footwear” has been demonstrated.

[20] In view of all of the foregoing pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

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