



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

**Citation: 2013 TMOB 112
Date of Decision: 2013-06-21**

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Bull, Housser & Tupper LLP against
registration No. TMA390,097 for the trade-mark SACHA
LONDON in the name of Sacha London, S.L.**

[1] At the request of Bull, Housser & Tupper LLP (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 December 9, 2009 to Sacha London, S.L. (the Registrant), the registered owner of registration No. TMA390,097 for the trade-mark SACHA LONDON (the Mark).

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

Wares: Footwear, namely shoes, boots, slippers and sandals.

Services: Retail store services in connection with the sale of footwear and related accessories.

[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 December 9, 2006 and December 9, 2009.

[4] Section 4 of the Act sets out the meaning of use. In this case, the following subsections apply:

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.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*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 v Canada (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 and services specified in the registration during the relevant period.

[6] With respect to services, where the trade-mark owner is offering and prepared to perform the services in Canada, use of the trade-mark on advertising of those services meets the requirements of section 4(2) [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)]. In other words, advertising in Canada alone is insufficient to demonstrate use; at the very least, the services have to be available to be performed in Canada. By way of example, use of a trade-mark on advertising in Canada of services only available in the United States does not satisfy the provisions of section 4(2) [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct)].

[7] In response to the Registrar's notice, the Registrant furnished the affidavit of Julian Gabriel Sanchez, Chief Executive Officer of the Registrant, sworn in Spain on June 30, 2010.

[8] As a preliminary matter, in its written representations, the Requesting Party questioned the validity of the affidavit, submitting it was insufficient to meet the burden on the registrant in this proceeding. In this respect, the affidavit appears to have been affirmed before Julian Sanchez

Fernandez. However, underneath the name and signature of Mr. Fernandez, the word “proxy” appears. Thus, the Requesting Party argues that it would appear that Mr. Fernandez is not himself a Commissioner of Oaths or other person authorized to receive an oath.

[9] In response, the Registrant submitted that the affidavit “appears to have been properly commissioned as it is indicated that it was affirmed solemnly before Julian Sanchez Fernandez” and that “the addition of the term “proxy” does not change anything to the document”.

[10] In section 45 proceedings, the Registrar generally accepts affidavits sworn in foreign jurisdictions as long as they meet the requirements of that country [See *Dubuc v Montana* (1991), 38 CPR (3d) 88 (TMOB)]. In this case, I have no indication, and neither was I provided with any, that the affidavit executed and solemnly affirmed in Elda, Spain, does not meet the requirements of that country. Therefore, given the limited context of a section 45 proceeding, I agree with the Registrant that the affidavit should be taken at face value.

Use with respect to the Wares

[11] In his affidavit, Mr. Sanchez attests that the Registrant is a Spanish company engaged in the manufacture, distribution and retail of footwear. He states that the Registrant exports its footwear to various countries around the world, including to Canada.

[12] Mr. Sanchez provides that the Registrant sells its Wares in Canada to 168700 Canada Inc. (168700), the exclusive Canadian distributor of the Registrant’s products, which in turn sells to Canadian retailers and wholesalers. Mr. Sanchez states that 168700 is authorized by the Registrant through a license to “use the Mark in association with the retail of the [Wares]”.

[13] In its written representations, the Requesting Party does not contest the evidence with respect to the Wares. That evidence consists of the following:

- Exhibit 1 is a photograph of the box in which the Wares are sold. Mr. Sanchez attests that this is an example of the type of packaging used in Canada by the Registrant during the relevant period. The Mark appears on the box.
- Exhibit 2 consists of copies of the Registrant’s catalogues from 2007, 2009, and 2010 showing a variety of SACHA LONDON footwear products. Mr. Sanchez attests that

these catalogues are examples of the type of promotional catalogues used in Canada by the Registrant during the relevant period.

- Exhibit 3 consists of photocopies of six representative invoices dated within the relevant period and issued to 168700 by Asociacion de Exportadores, S.L. (AESL). Mr. Sanchez explains that AESL is a wholly-owned subsidiary of the Registrant and is authorized by license to deal with the exportation of the Registrant's products, under control of the Registrant. I note that the invoices show sales in tens of thousands of Euros and reference large volumes and varieties of footwear, which Mr. Sanchez attests corresponds with the SACHA LONDON footwear depicted in the Exhibit 2 catalogues.
- Exhibit 4(e) consists of pages from the Autumn 2007 issue of Canadian magazine *Elle Québec Accessoires*. Mr. Sanchez attests that the Wares sold in Canada during the Relevant Period bear the Mark "either on the interior and/or exterior sole". Page 3 of the exhibited magazine shows an example of such display of the Mark on the Registrant's footwear.

[14] Furthermore, Mr. Sanchez attests that the Registrant's sales of the Wares in the normal course of trade to 168700 during the relevant period exceeded 190,000 Euros.

[15] In view of the foregoing, I am satisfied 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.

Use with respect to the Services

[16] In contrast, the Requesting Party submits that Mr. Sanchez's affidavit does not show use of the Mark in association with the Services during the Relevant Period. It notes that even in the concluding statement of his affidavit, Mr. Sanchez states only that "it is clear" the Registrant was and is using the Mark "in association with *the products*", and that "Canadian consumers associate the [Mark] with its *wares*", without any mention of the Services [emphasis added]. The only assertions made by Mr. Sanchez regarding the Services are at paragraphs 21 and 22 of his affidavit, where he briefly describes the operation of the Registrant's website and the Registrant's exclusive Canadian distributor, 168700.

[17] At paragraph 21 of his affidavit, Mr. Sanchez states that the Registrant operated a website at *www.sachalondon.com*, through which "it was possible" to purchase the Wares during the relevant period. However, he provides no exhibits to show the appearance of the website during the relevant period or otherwise, and merely states that the "website can be *consulted* throughout

the world, including Canada” [emphasis added]. It is unclear whether Canadian consumers could make purchases through the website and have purchases delivered to Canadian addresses. Nor is it clear whether Canadian consumers could avail themselves of other services amounting to retail store services via the website [see, for example, *Lapointe Rosenstein LLP v West Seal Inc* (2012), 103 CPR (4th) 136 (TMOB)]. As such, I am not satisfied from the evidence before me that the Registrant was able to perform any retail store services in Canada via its website.

[18] At paragraph 22 of his affidavit, Mr. Sanchez states that 168700 is authorized by a license to use the Mark in association with the retail of the Wares. In support, photographs of 168700’s Canadian office are provided at Exhibit 5, showing exterior signs depicting the Mark.

[19] As the Requesting Party submits, however, although the signs display the Mark outside an office, there is nothing to indicate that the signage is retail store signage. I agree that the office shown appears to be a corporate office with warehouse facilities in an industrial park. There is no indication in the exhibited photographs or in Mr. Sanchez’s statements that any potential consumers ever attend 168700’s office to make retail purchases of the Registrant’s Wares. As such, I cannot conclude that the display of the Mark on signs outside the office of 168700 constitutes use in association with the Services as registered.

[20] Indeed, it is clear from the affidavit that 168700 is only a distributor of the Registrant’s Wares. Throughout his affidavit, Mr. Sanchez repeatedly describes 168700 as the Registrant’s exclusive distributor in Canada. Accordingly, I am of the view that 168700 is only engaged in the wholesale and distribution of the Registrant’s Wares, and not in their retail sale.

[21] Since no other evidence is provided with respect to the operations of 168700, I cannot conclude that 168700, as a licensee, used the Mark in the advertising or performance of retail store services in connection with footwear and related accessories.

[22] Given all of the foregoing, I cannot conclude that there was use of the Mark in association with the Services during the relevant period in Canada 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

[23] Pursuant to the authority delegated to me under section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the statement of services only.

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