

IN THE MATTER OF A SECTION 45 PROCEEDING  
regarding registration No. 240,840 for the trade-mark  
SKOR standing in the name of  
Maheer Inc.

The trade-mark SKOR was registered under No. 240,840 in the name of Maheer Inc., on March 7, 1980, for its use in relation with "boots and shoes". On October 26, 1992, at the request of the firm of Smart & Biggar, a notice was issued pursuant to section 45 of the Trade-marks Act to the registrant.

In response to the notice, Kevin Huckle Investments Inc. (hereafter KHI Inc.) submitted the affidavit of its President, Mr. Kevin Huckle, dated April 16, 1993. The requesting party alone filed a written submission, while KHI Inc. submitted on March 11, 1994 a supplementary affidavit of its President. By letter dated April 5, 1994, I advised KHI Inc. that the second affidavit was to be considered supplementary evidence and, as such, could only be filed if a retroactive extension of time was requested and granted under section 47(2) of the Act. By the same letter KHI Inc. was given one month to present such a request. KHI Inc. did not reply. Consequently, the only evidence deemed to have been filed in relation to the present proceedings consists of the April 16, 1993 affidavit. An oral hearing was not conducted.

An additional difficulty in the present case is that the evidence of use is by a person other than the registered owner. It is admitted that in a section 45 proceedings, evidence of use by a third party entitled to be registered as the owner is admissible provided that it is established that this person was so entitled at the date of the notice.

In his affidavit, Mr. Huckle states that on or about June 25, 1992, KHI Inc. purchased the trade-mark from the registered owner. However, the affidavit offers no evidence in support to that statement. It appears instead from the trade-mark file that, on the same date that it filed the affidavit, KHI Inc. tentatively

filed with the Trade-marks Office copy of an assignment, along with a request to be recorded as current owner of the trade-mark. By letter dated June 1st, 1993, the Assignment section of the Office informed KHI Inc. that the change in title could not be recorded for the following reasons:

1) A search of the register revealed the existence of an associated trade-mark which, in view of section 15(3) of the Act, had to be assigned at the same time, and

2) the assignment document submitted was merely a photocopy while the Office needed an original or a notarially certified copy.

As of today, KHI Inc. has not filed with the Trade-marks Office satisfactory evidence that would establish its title in the trade-mark nor did it give any indication as to when it intended to do so. As it also did not reply to the official letter of April 5, 1994, it would appear that the owner might have lost interest in its trade-mark.

What ever the case is, I must proceed with the decision on the finding that the sole evidence filed in the present case seeks to show use of the trade-mark by a third party which did not establish its right to be registered as the owner of the trade-mark. In other words, no evidence of use by the registered owner of the trade-mark, a licensee thereof, or a person entitled to be recorded as the owner has been filed in response to the section 45 Notice. Moreover, since it is the alleged owner's own inaction that prevented the change in title from being recognized and recorded, I am of the view that this does not qualify as "special circumstances" as found in Baume & Mercier S.A. v. Brown<sup>1</sup> and George Weston Ltd. v. Sterling & Affiliates<sup>2</sup>.

1 (1985) 4 C.P.R. (3d) 96 (F.C.T.D.).

2 (1984) 3 C.P.R. (3d) 527 (F.C.T.D.).

I would also point out that, had I been satisfied that KHI Inc. were entitled to be registered as the owner of the trade-mark, I would have been at trouble finding that the evidence showed use by KHI Inc.

Indeed, Exhibit B contains one invoice for the sale of shoes dated within the relevant time period. This invoice is made in the name of International Footwear Management Inc. (thereafter IFM Inc.) to Joggers/First Effort. Mr. Huckle states in paragraph 7 of his affidavit that KHI Inc. "contracted with IFM Inc. to market a line of boots and shoes bearing the name SKOR". He further states in paragraph 8 that "IFM Inc. has been providing this service since July 1992 ••• ". However, is IFM Inc. acting as a mere distributor for KHI Inc.? If it is a manufacturer, is it a licensee of RHI Inc. in the meaning of Section 50(1) of the Act? The affiant does not sufficiently explain what the relationship is between IFM Inc. and KHI Inc. so that it can be said that use by the former amounts to use by the latter pursuant to the Act.

In view of the above, Registration No. 240, 840 will be expunged in accordance with section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 25<sup>th</sup> DAY OF NOVEMBER 1994.



**D. Savard**  
Senior Hearing Officer