

SECTION 45 PROCEEDINGS  
TRADE-MARK: AVON ROADRUNNER  
REGISTRATION NO: TMA 216,308

At the request of Borden Ladner Gervais LLP on behalf of Warner Bros. Entertainment Inc. (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on October 15, 2004 to Cooper Tire & Rubber Company, the registered owner of the above referenced trade-mark (the “registrant”).

The trade-mark AVON ROADRUNNER is registered for use in association with “tyres”.

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 October 15, 2001 and October 15, 2004.

“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.

In response to the Registrar’s notice, the registrant furnished the affidavit of Larry Hoppe, President of Hoppe & Associates, the distributor and marketer of the registrant’s tires in the United States and Canada. Each party filed a written argument; an oral hearing was not requested.

In paragraph 4, Mr. Hoppe attaches a sales report (Exhibit A) that lists sales of AVON ROADRUNNER tires in Canada since 2001. It appears that approximately 500 sales occurred annually during the relevant period. The requesting party speculated that this appeared to be rather a low volume of sales, and submitted that information regarding market share and distribution networks should also have been provided. I find however, on a reasonable reading of the affidavit, that the sales record is sufficient to establish that there were sales in Canada in the normal course of trade. Section 45 proceedings do not require evidentiary overkill.

Mr. Hoppe states that each and every tire sold in Canada during the relevant period, as evidenced in Exhibit A, was marked with the subject trade-mark at the time of sale; the trade-mark appears on the tread label attached to each tire and is also moulded into the sidewall of each tire. Exhibit B consists of photographs of a tread label, and of a tire sidewall.

With respect to the tread label in Exhibit B, I note that the tread label is a white inner rectangle with an outer blue border. AVON appears in the blue border just above the word “tyres”; “tyres” is in smaller font and also in the blue border. ROADRUNNER appears within the inner white rectangle of the label with other information in numerical form – which may be the tire size or model number. With respect to the photograph of the tire sidewall, I note that the words AVON and ROADRUNNER are moulded on the tire sidewall in prominent fashion, separated by 180 degrees; smaller less prominent words and numbers also appear in a ring around the tire sidewall.

Exhibit C comprises three pages from a product catalogue. In the first of the pages provided, AVON appears at the top of the page in conjunction with the word “tyres” and a small design of horizontal lines; this configuration appears again in the middle of the page adjacent to information on various ROADRUNNER models of tires. On the second catalogue page (p. 76), AVON appears alone at the top of the page as part of the phrase “Avon Street Performers” and again one third of the way down the page, in larger format with the horizontal line design and the word “tyres”. On both pages, ROADRUNNER

(without AVON) appears within the content of the page identifying one or models of tires. In the third catalogue page (p.77), AVON appears at the top of the page as part of the phrase “Avon Specialty Tires”, and ROADRUNNER appears in the body of the page identifying one or models of tires.

The requesting party argues that in the tread label (Exhibit B), the two portions of the mark, AVON and ROADRUNNER, are too separated from each other to be perceived as one mark. The requesting party makes the same argument with respect to the trade-mark as shown in the three catalogue pages which comprise Exhibit C.

I agree with the requesting party with respect to the tread label of Exhibit B and *two* of the three pages (76 and 77) of Exhibit C. In the remaining page of Exhibit C, however, I find the use of the subject trade-mark to be a borderline situation. In this page AVON appears in the body of the page adjacent to the information regarding ROADRUNNER tire models; in other words AVON and ROADRUNNER are in fairly close proximity to each other. Turning to a consideration of the tire sidewall (Exhibit B), I note that although the word AVON and ROADRUNNER are separated by 180 degrees, they are the two most prominent words on the tire. I am of the opinion that the circular nature of the tire has the effect of linking the two portions of the mark together, and in my view it would be natural for the consumer to link the two prominent words together to read AVON ROADRUNNER. Further, I find the extraneous matter on the tire is not such as to prevent the public from linking the two portions together and perceiving the trade-mark AVON ROADRUNNER *per se* as being used. In view of the foregoing, I am willing to conclude that the manner in which the subject trade-mark is being used is sufficient for the purposes of section 45 (see *Distillerie Stock U.S.A. Ltd. v Vincor International Inc.* 43 C.P.R. (4th) 476, and *Filodoro Calze S.p.A. v Doris Hosiery Mills Ltd.* (1998) 85 C.P.R. (3d) 76).

The requesting party also argued that the affidavit is not acceptable as it originates from a distributor rather than the registered owner of the mark. It should be noted however, that pursuant to the leading case of *Manhattan Industries Inc. v. Princeton Manufacturing*

*Ltd.* 4 C.P.R. (2d) 6, wares of the registrant sold through another entity, can be sufficient to satisfy the requirements of s. 4. In other words, the principle of “normal course of trade” recognizes a continuity of actions that commence with the owner through intervening transactions by agents or distributors to the ultimate consumer (*Philip Morris Inc. v. Imperial Tobacco Ltd.* (1985), 7 C.P.R. (3d); 88766 *Canada Inc. v Paulaner-Salvator-Thomasbrau AG* 68 C.P.R. (3d) 360).

In view of all of the foregoing, it is my conclusion that registration TMA 216,308 for the trade-mark AVON ROADRUNNER ought to be maintained on the Register pursuant to Section 45(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC, THIS 15<sup>TH</sup> DAY OF NOVEMBER 2007.

P.Heidi Sprung

Member, Trade-marks Opposition Board