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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2018 TMOB 147

Date of Decision: 2018-11-30

IN THE MATTER OF SECTION 45 PROCEEDINGS

Matthew S. George

Requesting Party

and

Dr.'s Own, Inc.

Registered Owner

TMA648,942 for GOOD FEET & Design

Registrations

TMA688,023 for GOOD FEET & Design

[1] At the request of Matthew S. George (the Requesting Party), the Registrar of Trade-marks issued notices under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Dr.'s Own, Inc. (the Owner), the registered owner of registrations No. TMA648,942 and No. TMA688,023 for the trade-marks GOOD FEET & Design reproduced below:

Good Feet

TMA648,942

Good Feet

TMA688,023

[2] Both trade-marks consist of the words GOOD FEET with a line drawing of feet within the letter G. As there is only a minor difference between these two trade-marks—one being

slightly taller and narrower overall—they will be considered the same trade-mark (the Mark) for the purposes of this decision.

[3] With respect to TMA648,942, the notice issued on June 13, 2016 and the trade-mark is registered for use in association with the following goods and services:

Goods: Foot orthotics, orthotic foot cushions, arch supports and heel cushions and heel cups. [the Orthotic Goods]

Services: Retail store services in the field of shoe supports, shoe cushions and foot orthotics; on-line retail store and mail order services in the field of shoe supports, shoe cushions and foot orthotics; and distributorships in the field of shoe supports, shoe cushions and foot orthotics [the Services]

[4] With respect to TMA688,023, the notice issued on June 10, 2016 and the trade-mark is registered for use in association with the following goods:

Foot and body care products, namely, foot and body sprays, creams, lotions, powders, massage oils, scrubs, soaps, moisturizers, rough skin remover, softening lotions, foot and shoe deodorant sprays, foot and shoe antiperspirant sprays, foot and shoe refresher sprays, nail care preparations, sunscreen preparations, non-medicated topically applied ointments, essential oils and fragrance for personal use; pre-recorded digital video discs, CDs, MP3s, video tapes and audiotapes featuring infomercials and promotional presentations promoting goods and services in the fields of foot orthotics, orthotic foot cushions, arch supports, cushion inserts and insoles for shoes or boots, and footwear; T-shirts, shirts, sweatshirts, sweat pants, belts, socks, hosiery, boots, shoes and sneakers, slippers, hats, caps, visors, insoles, heel cushions, heel liners, and heel rests; foot and body stretching and exercise equipment, namely, toe flexors, resistance bands for strength training and flexibility, balance boards, stretch cords, flex boards, foot massagers, foot wheels, compression wraps, bands and pads for comfort, balance and support, water bottles and water bottle carriers, walking sticks, walking canes, and pedometers. [the Related Goods]

[5] 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 goods 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 the trade-mark was last so used and the reason for the absence of such use since that date. In this case, the relevant period for showing use with respect to TMA648,942 is between June 13, 2013 and June 13, 2016; with respect to TMA688,023 it is between June 10, 2013 and June 10, 2016.

[6] The relevant definitions of “use” are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

4(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.

[7] With respect to services, the display of a trade-mark on advertising is sufficient to meet the requirements of section 4(2) of the Act when the trade-mark owner is offering and prepared to perform the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[8] In response to the Registrar’s notices, the Owner furnished the affidavit of its Director of Legal Affairs and Secretary, Jill P. Tuck, sworn on January 9, 2017, in California. Only the Owner filed written representations; a hearing was not requested.

OVERVIEW OF THE EVIDENCE

[9] In her affidavit, Ms. Tuck identifies the Owner as a manufacturer of foot care products and accessories, headquartered in California. She specifies that the Owner manufactures foot orthotics, orthotic foot cushions, arch supports, heel cushions and heel cups, as well as a variety of other related foot care products and accessories, which it then sells around the world, including in Canada, in association with the Mark. In particular, Ms. Tuck states that such goods are sold by a worldwide chain of retail stores, which also provide “expert advice and fitting to customers with respect to these products”. She attests that such stores are operated by the Owner through a franchise system in association with the Mark.

[10] Ms. Tuck further attests that the franchise system includes a licence agreement under which the Owner has direct and indirect control over the character and quality of the goods and services provided by its franchisees. In this respect, she also specifies that retail stores are

“operated in accordance with strict specifications set out by [the Owner]” and that the Owner “has designed and oversees the systems for training of retail staff”.

The Owner’s Retail Stores

[11] Ms. Tuck asserts that the Owner provided retail store services, on-line retail store and mail order services, and distributorships—all in the field of shoe supports, shoe cushions and foot orthotics—in Canada in association with the Mark throughout the relevant period.

[12] More particularly, she states that, via a franchisee and pursuant to the licence agreement described above, the Owner operated a retail store in Surrey, British Columbia, in association with the Mark, continuously throughout the relevant period. She attests that, as part of the standard franchise agreement, goods branded with the Mark were purchased from the Owner by the Canadian franchisee, and then distributed by the Owner to the franchisee by mail, for ultimate sale to customers in Canada. She further attests as follows:

In addition to selling [the Owner’s] products bearing [the Mark], the GOOD FEET retail store in Canada also provided customers with expert advice regarding foot care, including foot orthotics, shoe cushions and shoe selection during [the relevant period]. The GOOD FEET retail store in Canada also sold running and walking shoes during [the relevant period].

[13] In support of her assertions, Ms. Tuck attaches, as Exhibit A to her affidavit, a printout of three webpages from the Owner’s website at *www.goodfeet.com*, which she confirms was in operation and accessible to Canadians throughout the relevant period.

[14] The first of these webpages is the site’s home page, which provides links to various features, such as “Company Info”, “Corporate Sales”, “Franchise Opportunities”, “Franchise Portal”, “Products” and “Warranty Registration”. Visitors are invited to view a brochure, sign up for a free newsletter and “special offers”, use the online store finder, and “come in for [a] free, personalized arch support fitting”. The second webpage describes and depicts services available at GOOD FEET stores, in particular, personalized arch support fittings and consultations regarding “the Good Feet® brand of arch support and pain relief products”. It also provides some basic information about these products. The third webpage provides location, store hours

and contact information for the Surrey retail store, as well as some links to information about foot pain.

[15] I note that there is no indication, in any of the exhibited webpages, of it being possible to make actual purchases online. Nor does Ms. Tuck state that the website has or had this particular functionality at any time.

[16] Furthermore, although references to “The Good Feet Store” and “Good Feet®” appear throughout the exhibited webpages, the Mark as registered does not appear. A GOOD FEET logo is shown in a couple of the store images, including an image of what appears to be an entranceway to the Surrey store. However, if the foot design is present on such signage, it is not visible in the exhibited images.

[17] Ms. Tuck also attaches, as Exhibit C to her affidavit, photographs of “in-store banners and posters” that she attests were displayed in the GOOD FEET retail store in Canada during the relevant period. She states that the Mark is “prominently displayed” on such “point-of-sale” banners and posters, including “desk signage ... where the customer receives and pays for the products”. The signage shown in these photographs includes a storefront sign; hanging signs promoting GOOD FEET products, including “Good Feet Arch Support Inserts”; floor signs relating to foot issues; a small reception counter sign with information for customers with diabetes; and a large front desk sign in the style of an oversized gift certificate, bearing the notation “Give the Gift of ‘Comfort, Balance and Support’”.

[18] The storefront sign depicted at Exhibit C clearly displays a GOOD FEET logo that resembles the Mark, but omits the foot design within the letter G (the Variation). The Mark as registered is displayed on each of the remaining types of sign. It is typically displayed along with a tiled design and one of various slogans, such as “America’s #1 Arch Support”, “Insert Comfort Here!” or “Your Arch Support Store”. However, I am satisfied that the Mark stands out and remains recognizable as a distinct trade-mark.

The Orthotic Goods

[19] Ms. Tuck asserts that the Owner sold foot orthotics, orthotic foot cushions, arch supports, heel cushions and heel cups— manufactured by the Owner and branded with the Mark—at its

retail store in Canada throughout the relevant period. She attaches, as Exhibit B to her affidavit, representative examples of the “packaging” for each of these goods.

[20] The images at Exhibit B appear to be scans rather than photographs and, as such, do not show the nature and shape of each package. Nor does Ms. Tuck offer any explanations in this regard. However, a photograph attached to the affidavit as Exhibit H (discussed in more detail below) shows part of a “Cushio[n] SUPER ATHL[ETIC]” package that resembles the “Cushion HEEL PAD” design depicted at Exhibit B. From Exhibit H, it appears that such cushions at least are packaged with a printed card in a clear plastic bag.

[21] Ms. Tuck does not correlate each of the images at Exhibit B with a specific registered good. Nevertheless, the images themselves indicate that the packaged products are heel pad cushions, “Relaxer” heel cups, “Max Exerciser” arch supports, and “Skinny Relaxer” shoe inserts. There are also two images of instructions for trimable cushions to be used on top of the arch supports. With respect to the “Exerciser” and “Relaxer” products, I note that these are explained on the second webpage at Exhibit A, which indicates that “Exercisers” reposition the foot, whereas “Maintainers” provide comfortable support and “Relaxers” provide partial support and foot pain relief.

[22] With respect to the Mark, it is displayed on the packaging images for most of the products represented at Exhibit B, although the Variation is displayed instead on the “Exerciser” image and on what appear to be related cushion instructions. I note that the letter G containing the foot design (the Stylized G) is also displayed on its own on those particular instructions.

The Related Goods

[23] Ms. Tuck further asserts that the Owner sold the following goods in Canada in association with the Mark during the relevant period:

Foot and body care products, namely, foot and body sprays, creams, and lotions; pre-recorded digital video discs, CDs, video tapes and audiotapes featuring infomercials and promotional presentations promoting goods and services in the fields of foot orthotics, orthotic foot cushions, arch supports, cushion inserts and insoles for shoes or boots, and footwear; T-shirts, shirts, socks, shoes and sneakers, slippers, insoles, heel cushions, heel liners, and heel rests; foot massagers, and bands and pads for comfort, balance and support.

[24] In support of this assertion, Ms. Tuck attaches to her affidavit the following images of various products that she attests were sold in Canada branded with the Mark during the relevant period:

- Exhibit D contains photographs of the Mark stitched on polo shirts and printed on their hang tags. It also shows the Mark on packages of socks. Ms. Tuck correlates the depicted products with the registered goods “t-shirts, shirts and socks”.
- Exhibit E shows the Mark displayed on labelling for “Dr’s Own Nourishing Foot Lotion Intensive Therapy for Dry Skin”, which Ms. Tuck identifies as “packaging for foot cream”. Although barely visible in this faint image, an indication that the product is “Made Exclusively For The Good Feet Store” is also displayed.
- Exhibit F shows the Mark on labelling for a “Motorized Mini Acupressure Massager”, shown in use on both hands and feet. Ms. Tuck confirms that the image is of “packaging for a foot massager”.
- Exhibits G and H are photographs of the Mark displayed on a pair of insoles and on a shoehorn, respectively.

[25] Ms. Tuck attests that the Mark’s display on these products is representative of the Owner’s use of the Mark on the Related Goods sold in Canada during the relevant period through the GOOD FEET retail store.

[26] The quality of the exhibited images is such that the foot design in the Mark is not always visible. However, I note that, throughout the exhibits, in images of the Mark where the foot design *is* visible, the G’s horizontal serif under the foot is elongated and curved, somewhat resembling an arch support. Accordingly, where at least this distinctive serif is visible, I am prepared to accept that the Mark is being displayed as registered.

[27] As mentioned above, Ms. Tuck also attests that the GOOD FEET retail store in Canada sold “running and walking shoes” during the relevant period. She states that these products can be seen on display in the photographs in Exhibit C. Indeed, a wall displaying various shoes is shown in some of the photographs. Two of the shoes are also partially visible in the Exhibit H photograph of a shoehorn, which is shown hanging on the same wall. However, if the Mark is

displayed on any of the depicted shoes or on associated signage, it is not visible in any of these photographs. Rather, a large “BROOKS” logo is displayed on the wall amid the various shoes.

[28] Finally, Ms. Tuck states that, during the relevant period, the Canadian franchisee purchased from the Owner pre-recorded digital video discs, CDs, video tapes and audiotapes featuring infomercials and promotional presentations promoting goods and services in the fields of foot orthotics, orthotic foot cushions, arch supports, cushion inserts and insoles for shoes or boots, and footwear. She specifies that these pre-recorded infomercials and promotional presentations displayed the Mark when viewed, and were played on televisions within the GOOD FEET retail store in Canada during the relevant period, to educate both retail staff and Canadian customers on the benefits of the Owner’s products branded with the Mark. However, no supporting exhibits are provided in this regard.

Evidence of Transfers

[29] Ms. Tuck attaches, as Exhibit I to her affidavit, 22 representative store receipts for the sale of Orthotic Goods branded with the Mark in Canada. The first 16 such receipts are dated during the relevant period; the remaining six are dated in the months following it. Ms. Tuck confirms that customers would have received such a receipt with their purchases at the time of sale.

[30] The store receipts come in two styles. The 12 earliest receipts display the Mark in the upper left corner, above the description “Foot Comfort Centre”, next to the Surrey store’s address and telephone number. Purchased products are listed by hand in the body of the receipt, for example, “Diamond Exerciser Orthotic”; “Flex Maintainer Orthotic”; “Flex Relaxer Orthotic”; “Cushion Dress Large”; “Cushion Super At”; “Shoe Tenevis Cardiff Black”; and “Brooks Addiction 11”.

[31] The ten later store receipts display the Variation centred at the top of the receipt, above the notations “Your Arch Support Store®”, “(Good Feet)” and “{Las Vegas, Surrey, Seattle}”, with a list of the purchased products being printed below this. I note that one of these invoices, from the relevant period, lists a “Comp Dunham Dress Shoe”, but it appears to have been

provided at no charge, under a discount “To Be used on old inventory such as Tenevis, NB & others not normally stocked”.

[32] Ms. Tuck also attaches, as Exhibit J to her affidavit, a spreadsheet printout that she attests is from the business records of the Owner’s Canadian franchisee. She states that this spreadsheet sets out the monthly sales and customer visits, among other particulars, for the Canadian GOOD FEET retail store. Substantial gross revenues are shown for each month of the relevant period; however, no breakdown with respect to goods or brands is provided.

ANALYSIS

[33] I note at the outset that Ms. Tuck does not assert use of the Mark in Canada during the relevant period in association with the following registered goods:

powders, massage oils, scrubs, soaps, moisturizers, rough skin remover, softening lotions, foot and shoe deodorant sprays, foot and shoe antiperspirant sprays, foot and shoe refresher sprays, nail care preparations, sunscreen preparations, non-medicated topically applied ointments, essential oils and fragrance for personal use; MP3s; sweatshirts, sweat pants, belts, hosiery, boots, hats, caps, visors; toe flexors, resistance bands for strength training and flexibility, balance boards, stretch cords, flex boards, foot wheels, compression wraps, water bottles and water bottle carriers, walking sticks, walking canes, and pedometers.

[34] Indeed, there is no evidence of these particular goods being sold or otherwise transferred in the normal course of trade in Canada in association with the Mark during the relevant period. Since there is also no evidence before me of special circumstances excusing non-use of the Mark, these goods will be deleted from the relevant registration.

[35] With respect to the remaining goods and services, although Ms. Tuck asserts that the Owner used the Mark in association with each one of them in Canada during the relevant period, 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 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in section 45 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 Ltd v 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 goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[36] However, the test to be met in this respect is not a heavy one: the registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Cinnabon, Inc v Yoo-Hoo of Florida Corp* (1998), 82 CPR (3d) 513 (FCA); and *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428].

[37] Moreover, to the extent that use of the Mark during the relevant period was under licence, I am satisfied that such use accrues to the Owner's benefit under section 50(1) of the Act. In this regard, Ms. Tuck attests to the Owner's control over the character and quality of the goods and services provided in association with the Mark under licence.

TMA648,942: Use in association with the Services

[38] Although the Owner's evidence with respect to the Services is centred around its Surrey retail store, the Owner submits that there is sufficient evidence to maintain on-line retail store, mail order and distributorships services in the registration as well. In this respect, citing the Federal Court's decisions in *Kraft Ltd v Canada (Registrar of Trade Marks)* 1984, 1 CPR (3d) 457 (FCTD) and *Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express* (2000), 9 CPR (4th) 443 (FCTD), the Owner takes the position that "services" should be interpreted broadly—to include any activity that offers a benefit to the public—given that the Act makes no distinction between "primary, incidental or ancillary services".

[39] Although I accept that services such as "on-line retail store and mail order services" and "distributorships" may be secondary to the Owner's primary business of providing "retail store services", it is still necessary to determine whether the evidence demonstrates activities that fall within the scope of each of these services and use or display of the Mark in their performance or advertising. In this respect, whether a given activity constitutes performance of a given registered service must be decided "on a case-by-case basis" [*Express File Inc v HRB Royalty Inc*, 2005 FC 542, 39 CPR (4th) 59 at paragraph 23].

Retail store services

[40] Ms. Tuck provides clear evidence of the Mark's display in the performance and advertising of "retail store services" during the relevant period. Specifically, the evidence shows the Mark displayed on various store signs at the Owner's Canadian retail store (Exhibit C) and on store receipts from the relevant period (Exhibit I). The evidence further shows that the store was operating in the field of shoe supports, shoe cushions and foot orthotics.

[41] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in Canada during the relevant period in association with the services "retail store services in the field of shoe supports, shoe cushions and foot orthotics".

On-line retail store services

[42] In contrast to the evidence with respect to the Owner's bricks-and-mortar store, there is no evidence that the Owner or a licensee operated an *on-line* retail store, during the relevant period or otherwise. As mentioned above, the exhibited excerpts from the Owner's website offer no indication of it being possible to make actual purchases online. Furthermore, although the exhibited website appears to offer information about foot pain and GOOD FEET products, there is no indication that the site provides "expert advice and fitting" online, or otherwise assists customers in selecting products to purchase. Rather, the site invites prospective customers to visit the physical store for a free fitting.

[43] The Owner cites *Heenan Blaikie LLP v Sports Authority Michigan Inc*, 2011 FC 273, 91 CPR (4th) 324 (*TSA*), for the proposition that a website accessible in Canada that provides information and guidance about a company's products—or information about its bricks-and-mortar retail store—provides "retail store services". In the Owner's submission, the only requirement is that such "ancillary" services provided online provide a benefit to Canadians, for example, akin to the benefits of a discussion with a salesperson. The Owner submits that its own on-line services, like those in *TSA*, are "ancillary services" that provide a benefit to Canadians and therefore constitute "online retail store services".

[44] However, the decision in *TSA* is distinguishable. In that case, the evidence showed that the owner's website was an *actual store* through which purchases could be made. Although

customers were apparently unable to have their purchases delivered to Canada through the website, the evidence showed that Canadian customers could benefit from other features of the site that were held to be in the nature of retail store services. For example, it appears that a customer in Canada could, among other things, do the following:

- use the website’s “Buyers Guides” to receive “detailed information and assistance (e.g. sizing, fit tips, care information, identifying suitable equipment, providing product availability, etc.) relating to virtually all items available to be purchased”;
- use the website’s “Help me Choose Gear” service to determine “how to identify suitable equipment depending on the age and expertise of the user, how to select correct sizes and how to care for the products”, in a manner akin to a discussion with a knowledgeable salesperson; and,
- use the website’s “Shoe Finder” service to “identify the running shoe which best suits his or her needs”.

[45] As such, the evidence in *TSA* demonstrated not merely an informational website promoting products and services available at the owner’s bricks-and-mortar store, but an actual on-line retail store, which, in turn, was found to provide a level of interactivity in Canada sufficient to constitute the provision of retail store services in Canada.

[46] No comparable evidence was furnished in the present case.

[47] I would also note that, in the present case, the furnished website excerpts do not display the Mark *as registered*. Although the Variation is displayed, in applying the principles set out by the Federal Court of Appeal in *Canada (Registrar of Trade Marks) v Cie International pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523, and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59, I find that a dominant feature of the Mark as registered—the foot design—has not been preserved in the Variation. Even if some visitors to the Owner’s website might perceive the Variation as being derived from the Mark, the Mark’s identity has not been maintained and the registered Mark is not recognizable as such.

[48] Consequently, I am not satisfied that the Owner has demonstrated use of the Mark in Canada in association with “online retail store ... services in the field of shoe supports, shoe cushions and foot orthotics” during the relevant period.

Mail order services, and distributorships

[49] Ms. Tuck’s evidence with respect to “mail order services” and “distributorships” is that franchisees purchased goods branded with the Mark from the Owner, who then distributed the goods to the franchisees by mail.

[50] In this respect, it has been held that the use of a trade-mark on goods can also constitute use in association with ancillary services such as the sale and distribution of those goods [see *Anderson Instrument Co v 3402983 Canada Inc* 2015 TMOB 98, 2015 CarswellNat 2789; and *LIDL Stiftung & Co KG v Thornbury Grandview Farms Ltd.* (2005), 48 CPR (4th) 147 (TMOB)]. Indeed, the Federal Court of Appeal has confirmed that nothing in section 4(2) of the Act restricts services to those that are independently offered to the public or that are not ancillary or connected with goods [*Gesco Industries Inc v Sim & McBurney* (2000), 9 CPR (4th) 480 (FCA) at 484]. In such cases, display of a manufacturer’s trade-mark on its goods can also be considered an advertisement for the manufacturer’s sale and distribution of such goods.

[51] In the present case, given the nature of the Owner’s business as attested to by Ms. Tuck, for the purposes of this proceeding, I am prepared to accept display of the Mark on goods or their packaging as both use in association with the goods themselves and use in association with the Owner’s mail order and distributorship services in respect of such goods.

[52] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in Canada during the relevant period in association with “mail order services in the field of shoe supports, shoe cushions and foot orthotics” and “distributorships in the field of shoe supports, shoe cushions and foot orthotics”.

TMA648,942: Use in association with the Orthotic Goods

[53] With respect to the Orthotic Goods, namely “foot orthotics, orthotic foot cushions, arch supports and heel cushions and heel cups”, Ms. Tuck explains how such goods are sold through

the Owner's retail stores, and she provides representative examples of how the Mark was displayed on packaging for such goods during the relevant period (Exhibit B), as well as representative invoices demonstrating sales of such goods during that period (Exhibit I).

[54] To the extent that some packages display the Variation rather than the Mark as registered, I do not consider it to be problematic in the particular circumstances of these sales. In this respect, I find that the Mark's display on point-of-sale signage is sufficient to create a notice of association between the Mark as registered and goods branded with the Variation, particularly in cases where the Stylized G is displayed not far from the Variation as well. In my view, under such circumstances, the goods would be associated not only with the Variation on the packaging but also with the Mark seen on the related signage. In this respect, it has been held that the appearance of a trade-mark on in-store displays in close proximity to the goods at the time of their sale may satisfy the requirements of section 4(1) of the Act, if the display provides notice that the trade-mark is associated with such goods [see, for example, *Loblaws Ltd v Richmond Breweries Ltd* (1983), 73 CPR (2d) 258 (TMOB); *Lafco Enterprises Inc v Canadian Home Publishers*, 2013 TMOB 44; and *Riches McKenzie & Herbert LLP v Parissa Laboratories Inc* (2006), 59 CPR (4th) 219 (TMOB)].

[55] Furthermore, Ms. Tuck clearly states that the furnished sales receipts are merely representative and that the Owner did in fact sell each of the Orthotic Goods in Canada throughout the relevant period. Indeed, taking the images furnished by Ms. Tuck as a whole, I am satisfied that they show the Mark displayed in association with each of the Orthotic Goods. Therefore, considering the nature of the Owner's business, I am prepared to infer that the sales evidenced by the spreadsheet in Exhibit J included all of the Orthotic Goods.

[56] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in Canada during the relevant period in association with "foot orthotics, orthotic foot cushions, arch supports and heel cushions and heel cups".

TMA688,023: Use in association with the Related Goods

[57] As indicated above, the Owner also states that it sold various Related Goods in Canada in association with the Mark throughout the relevant period. The Related Goods with which the

Owner asserts use include various foot and body care products and accessories, including footwear, apparel, and exercise and stretching equipment, as well as pre-recorded discs and tapes.

Footwear

[58] With respect to the registered footwear goods—namely “shoes and sneakers” and “slippers”— as noted above, Ms. Tuck’s assertion is that, “[i]n addition to” selling the Owner’s products bearing the Mark, the GOOD FEET retail store “also” provided customers with expert advice and “also” sold running and walking shoes.

[59] It would appear from these statements that the shoes sold were third-party products that did not bear the Mark. Indeed, the evidenced images of the in-store footwear display show such shoes encircling a large “BROOKS” logo. Moreover, while Ms. Tuck furnished close-up images of other goods—like the shoehorn hanging next to the shoes in this display—to demonstrate their branding, no such close-ups are provided for running and walking shoes.

[60] Accordingly, it would appear that the Owner is relying on the evidenced point-of-sale signage and store receipts to demonstrate use of the Mark in association with footwear.

[61] However, although the display of a trade-mark on point-of-sale signage in close proximity to the goods *may* satisfy the requirements of section 4(1) of the Act in certain circumstances, in the present case the footwear appears to be manufactured by third parties and to be sold under those third parties’ trade-marks. In these circumstances, I consider the display of the Mark on in-store signage insufficient to provide a notice of association between the Mark and such goods. In my view, in this situation, display of a trade-mark on in-store signage would be perceived as use of the trade-mark in association with retail store services, and not the goods themselves [for similar findings, see *Batteries Plus LLC v Source (Bell) Electronics Inc*, 2012 TMOB 202, 107 CPR (4th) 469; *Riches, McKenzie & Herbert v Calderone Shoe Co*, 1997 CarswellNat 3267 (TMOB); and *Clark, Wilson v Myriad Innovative Designs Inc*, 2001 CarswellNat 4074 (TMOB)].

[62] Similarly, display of a trade-mark on an invoice or store receipt that accompanies the goods at the time of sale will only satisfy the requirements of section 4(1) of the Act if it

provides the requisite notice of association between the Mark and the goods [see *Gordon A MacEachern Ltd v National Rubber Co Ltd* (1963), 41 CPR 149 (Ex Ct); and *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD)]. In this respect, the major consideration is “whether the trade-mark is being used as a trade-mark in describing the wares” and “whether appropriate notice of such use is being given to the transferee of the wares” [see *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440, 56 CPR (4th) 223 at paragraph 32]. This determination depends upon such factors as the prominence of the trade-mark, whether other trade-marks appear in the invoice or receipt, and whether other goods or manufacturers are referenced [see *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321, 2012 CarswellNat 4836, at paragraphs 11 - 12].

[63] In the present case, the shoes listed in the store receipts are identified by different trade-marks, such as BROOKS and TENEVIS. Thus it appears that the receipts may include goods from more than one manufacturer. Moreover, the Mark is displayed above the descriptor “Foot Comfort Centre” and the store’s address, suggesting an association with the store issuing the receipt, rather than with any particular goods listed therein. Accordingly, I am not prepared to find that display of the Mark at the top of the Exhibit I store receipts would provide a notice of association between the Mark and the shoes listed in the receipts. In my view, the Mark as displayed on the store receipts would instead be associated with the Owner’s retail store services.

[64] Consequently, I am not satisfied that the Owner has demonstrated use of the Mark in Canada during the relevant period in association with “shoes and sneakers, slippers”.

Other foot and body care products and accessories

[65] Ms. Tuck also asserts use of the Mark in Canada during the relevant period in association with the following foot and body care products and accessories:

Foot and body care products, namely, foot and body sprays, creams, and lotions; T-shirts, shirts, socks, insoles, heel cushions, heel liners, and heel rests; foot massagers, and bands and pads for comfort, balance and support.

[66] However, the evidence only shows the Mark displayed on *some* of the goods in these categories—or on their “packaging”—and none of these goods are represented in the exhibited

sales receipts. Moreover, although the evidence as a whole demonstrates that the Owner's retail stores sell the Orthotic Goods (registration no. TMA648,942) in the normal course of trade, the evidence is not clear with respect to the Related Goods (registration no TMA688,023) . Nevertheless, Ms. Tuck does state that the Owner manufactures "a variety of other related foot care products and accessories, which it then sells around the world, including in Canada, in association with the Mark". Furthermore, Exhibit H shows a related accessory, namely a shoehorn, displayed for sale in the Owner's Surrey store.

[67] Accordingly, in light of Ms. Tuck's sworn statement that such goods were sold in Canada during the relevant period, and bearing in mind that the Owner need only establish a *prima facie* case of use, I am prepared to infer that "related foot care products and accessories" of the type depicted in the "representative" Exhibits D to G were sold through the Surrey store during the relevant period. In addition, to the extent that some descriptions in the statement of goods for registration no TMA688,023 appear to be alternate descriptions for goods already listed in registration no. TMA648,942, I also accept that goods of the type depicted in Exhibit B were sold in the Surrey store during the relevant period.

[68] Upon review of these exhibits in light of the evidence as a whole, I am satisfied that the Owner has demonstrated use of the Mark in Canada during the relevant period in association with the following registered goods: "Foot care products, namely, foot creams, lotions; T-shirts, shirts, socks, insoles, heel cushions, heel liners, and heel rests; foot and body stretching and exercise equipment, namely, foot massagers, and pads for comfort, balance and support".

[69] The Mark is also shown displayed on a shoehorn at Exhibit H; however, shoehorns are not among the goods listed in the registration.

[70] Ms. Tuck also states that the Owner sold "foot and body sprays", "body ... creams, lotions" and "bands... for comfort, balance and support" through its retail store in Canada during the relevant period. However, such goods are not represented in the exhibited photographs, packaging images, or store receipts. Indeed, there is no other reference to these goods in the evidence. In the circumstances, Ms. Tuck's statement that these goods were sold under the Mark during the relevant period amounts to a bare assertion of use, which is insufficient to meet the requirements of section 45 of the Act.

[71] On this point, I note that the Owner cites *Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD) and *Etigson v KPM Industries Ltd* (2001), 15 CPR (4th) 411 (TMOB) for the proposition that, “[w]hen addressing a lengthy list of goods in a registration that are all of the same category, it is not necessary for the registrant to provide evidence showing how the mark appears on each and every specific good, provided that at least one example is shown and the evidence states that the example is representative of how the mark appears on the other goods”.

[72] However, although there is no requirement that either direct or documentary proof be furnished with respect to each and every good listed in a registration [*Saks, supra*], sufficient evidence must still be provided to permit the Registrar to form an opinion or logically infer use within the meaning of section 4 of the Act [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401 (FC) at paragraph 18]. Accordingly, whether the principle from *Saks* is applicable depends on the degree of detail that the registered owner provides and the clarity with which it explains the representative evidence.

[73] For example, in *Etigson*, the registered Owner “described the manner the trade-mark was associated with [the goods in question] at the time of sale” and “provided representative invoices and packaging and labelling as examples of use” [at paragraph 8]. The evidence also included a representative advertisement for the company’s products, and the sales figures provided appear to have been, at least to some extent, broken down by product. Taken as a whole, the evidence left “no reason to doubt the affidavit’s enumeration of the particular wares sold” [at paragraph 8].

[74] In the present case, the “representative” invoices provided by Ms. Tuck only include orthotic products, inserts and footwear. In the absence of representative invoices for “foot and body care products” or “stretching and exercise equipment”, and in the absence of images representing sprays, body care products, or bands in particular, there is no factual basis from which one might conclude that such goods were sold in Canada during the relevant period.

[75] Indeed, given that an image of a product *not* listed in the registration was furnished (the shoehorn at Exhibit H), it is not clear why examples of the remaining goods for which use is claimed were omitted. As the list of relevant goods in this case is relatively short, the burden of furnishing such examples would not seem to be unreasonable.

[76] Furthermore, I am not prepared to infer, from the limited information provided in the affidavit, that the image of “Dr’s Own Nourishing Foot Lotion Intensive Therapy for Dry Skin” is representative of the Mark’s display on “spray” or “body care” products or that any of the images are representative of “bands”. Since the evidence shows that the Mark as registered is not necessarily displayed consistently, in the absence of a specific correlation by Ms. Tuck I am not prepared to infer that the Mark as registered was necessarily displayed on Related Goods that are not depicted in the evidence.

[77] Accordingly, I am not satisfied that use of the Mark in Canada during the relevant period has been demonstrated in association with “foot and body sprays”, “body creams”, “body lotions” or “bands for comfort, balance and support”.

Pre-recorded discs and tapes

[78] Finally, Ms. Tuck attests that that, during the relevant period, the Canadian franchisee purchased from the Owner pre-recorded digital video discs, CDs, video tapes and audiotapes featuring infomercials and promotional presentations. She explains that such videos were played on televisions within the GOOD FEET retail store in Canada to educate staff and customers on the benefits of the Owner’s products branded with the Mark. However, although Ms. Tuck attests that the Mark was displayed on screen when the videos were viewed, she does not specify how or in what context the Mark appeared. More importantly, she does not specify whether the Mark was also displayed on the discs and tapes themselves, or on their packaging, or otherwise associated with these goods *at the time of their transfer to the franchisee*.

[79] In the circumstances, I am not satisfied that a notice of association between the Mark and the pre-recorded discs and tapes was given at the time of transfer of the property in or possession of the goods in the normal course of trade, as required by section 4(1) of the Act.

[80] Consequently, I am not satisfied that the Owner has demonstrated use of the Mark in Canada during the relevant period in association with “pre-recorded digital video discs, CDs, video tapes and audiotapes featuring infomercials and promotional presentations promoting goods and services in the fields of foot orthotics, orthotic foot cushions, arch supports, cushion inserts and insoles for shoes or boots, and footwear”.

DISPOSITION FOR TMA648,942

[81] In view of all the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the goods “foot orthotics, orthotic foot cushions, arch supports and heel cushions and heel cups” and the services “retail store services in the field of shoe supports, shoe cushions and foot orthotics”; “mail order services in the field of shoe supports, shoe cushions and foot orthotics”; and “distributorships in the field of shoe supports, shoe cushions and foot orthotics” only.

[82] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete the following services:

On-line retail store and [... services in the field of shoe supports, shoe cushions and foot orthotics].

[83] The amended statement of goods and services will be as follows:

Goods: Foot orthotics, orthotic foot cushions, arch supports and heel cushions and heel cups.

Services: Retail store services in the field of shoe supports, shoe cushions and foot orthotics; mail order services in the field of shoe supports, shoe cushions and foot orthotics; and distributorships in the field of shoe supports, shoe cushions and foot orthotics.

DISPOSITION FOR TMA688,023

[84] In view of all the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the registered goods “foot care products, namely, foot creams, lotions; T-shirts, shirts, socks, insoles , heel cushions, heel liners, and heel rests; foot and body stretching and exercise equipment, namely, foot massagers, pads for comfort, balance and support” only.

[85] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete the following goods:

[Foot] and body [care products, namely, foot] and body sprays, ... powders, massage oils, scrubs, soaps, moisturizers, rough skin remover, softening lotions, foot and shoe deodorant sprays, foot and shoe antiperspirant sprays, foot and shoe refresher sprays, nail care preparations, sunscreen preparations, non-medicated topically applied ointments, essential oils and fragrance for personal use; pre-recorded digital video discs, CDs, MP3s, video tapes and audiotapes featuring infomercials and promotional presentations promoting goods and services in the fields of foot orthotics, orthotic foot cushions, arch supports, cushion inserts and insoles for shoes or boots, and footwear; ... sweatshirts, sweat pants, belts, ... hosiery, boots, shoes and sneakers, slippers, hats, caps, visors ...[; foot and body stretching and exercise equipment, namely,] toe flexors, resistance bands for strength training and flexibility, balance boards, stretch cords, flex boards, ... foot wheels, compression wraps, bands ..., water bottles and water bottle carriers, walking sticks, walking canes, and pedometers.

[86] The amended statement of goods will be as follows:

Foot care products, namely, foot creams, lotions; T-shirts, shirts, socks, insoles, heel cushions, heel liners, and heel rests; foot and body stretching and exercise equipment, namely, foot massagers, pads for comfort, balance and support.

Oksana Osadchuk
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Smart & Biggar

FOR THE REGISTERED OWNER

Ridout & Maybee LLP

FOR THE REQUESTING PARTY