

O P I C



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**LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS**

Citation: 2022 TMOB 044

Date of Decision: 2022-03-11

IN THE MATTER OF SECTION 45 PROCEEDINGS

Gowling WLG (Canada) LLP

Requesting Party

and

Saucony UK, Inc.

Registered Owner

TMA669,290 for CUSHE:DESIGN

Registrations

TMA769,922 for CUSHE

[1] At the request of Gowling WLG (Canada) LLP (the Requesting Party), the Registrar of Trademarks issued notices under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on June 12, 2019, to Saucony UK, Inc. (the Owner), the registered owner of registrations No. TMA699,290 for the trademark CUSHE:Design (the Design Mark) and TMA769,922 for the trademark CUSHE (the Word Mark; collectively, the Marks). The Design Mark is shown below:

cushe

[2] The Marks are registered for use in association with footwear related products:

CUSHE:Design: (1) Footwear namely athletic footwear, beach footwear, formal footwear, casual footwear, outdoor winter footwear, rain footwear, exercise footwear and trainers.

CUSHE: (1) Footwear, namely boots, shoes, and sandals.

[3] For the reasons that follow, I conclude that the registrations ought to be expunged.

[4] The notices require the Owner to show whether the Marks have been used in Canada in association with the registered goods at any time within the three-year period immediately preceding the date of the notices and, if not, the date when the Marks were 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 June 12, 2016 to June 12, 2019.

[5] The relevant definition of use is set out in section 4 of the Act:

4(1) A trademark 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.

[6] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[7] 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 these proceedings is 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 trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR

(2d) 228 (FCA)]. While it is clear from the jurisprudence that this burden is not a stringent one, the owner must establish a *prima facie* case of use during the relevant period within the meaning of section 4 of the Act [*Brouillette Kosie Prince v Orange Cove-Sanger Citrus Association*, 2007 FC 1229].

[8] In response to the Registrar's notices, the Owner furnished the affidavit of Christopher Bolinger. Both parties filed written representations and the Owner attended the hearing.

EVIDENCE SUMMARY

[9] In his affidavit, Mr. Bolinger identifies himself as Senior Intellectual Property Counsel of Wolverine World Wide, Inc., the parent company of the Owner. Mr. Bolinger explains that the Owner acts as a wholesaler and manufacturer of athletic shoes for men, women and children and has granted a license to Wolverine World Wide, Inc. to use the Marks (para 3). With respect to the use of the Marks, Mr. Bolinger states that a number of pairs of CUSHE footwear were sold to Canadian consumers in 2018 and 2019 by the online reseller, Northern Shipments, through the Amazon Canada website *www.amazon.ca* (para 6). As evidence of sales, he attaches an email from Northern Shipments (Exhibit B). Mr. Bolinger also provides photographs of footwear and packaging, which he attests "are representative of the manner in which the Marks have been and continue to be displayed on CUSHE Footwear sold in Canada during the Relevant Period and today" (para 8, Exhibit D).

[10] Below, I note several deficiencies in Mr. Bolinger's evidence which taken together result in his evidence being insufficient for the Owner to demonstrate a *prima facie* case of use.

ANALYSIS AND REASONS FOR DECISION

Evidence is Silent as to Whether Sales by Northern Shipments are in the Normal Course of Trade

[11] While Mr. Bolinger explains that the Owner acts as a wholesaler and manufacturer of athletic shoes for men, women and children and that it has licensed the Marks, the evidence is silent as to whether orders placed through the reseller Northern Shipments on *www.amazon.ca* are in the normal course of trade. There is no evidence on which I could infer that the sales

through Northern Shipments are in the normal course of trade as opposed to being token sales [see, for example, *Barrette Legal Inc v Biologische Heilmittel Heel GmbH*, 2021 TMOB 240].

No Evidence of Use That Enures to the Owner

[12] The law is clear that the use of a trademark at any point along the chain of distribution is sufficient to demonstrate use as defined in section 4 of the Act, and that such use will enure to the benefit of the owner provided that the chain of distribution begins with the trademark owner [*Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD)].

[13] In the present case, Mr. Bolinger does not identify the Owner or its licensee, Wolverine Worldwide, Inc., as beginning the chain of distribution of the CUSHE footwear discussed in the affidavit. Nor does Mr. Bolinger identify the Owner or its licensee as manufacturing or arranging for the manufacture of the registered goods or otherwise being the source of the goods sold by Northern Shipments.

Insufficient Evidence that Sales by Northern Shipments are of the Registered Goods in Association with the Marks

[14] With respect to evidence of sales during the relevant period, Mr. Bolinger states that Northern Shipments sold a number of pairs of footwear to Canadian consumers and attaches the following correspondence to Erin Gleason at eringlsn@yahoo.com from Northern Shipments as evidence in support (Exhibit B):



You have received a message from the Amazon Seller - Northern Shipments

Hello,

Thank you for your response. We can confirm that we fulfilled orders for Cushe products during the time period in question.

Best,
Adam

On Wednesday, August 28, 2019 at 3:37 AM, northernshipments wrote:

> Hello,

>

> We have received your message and are looking into this. We will respond as soon as possible.

>

> Thank you,

>

> Joy

>

[15] The ability of this email to show use of the Marks in association with specific registered goods is in accordance with section 4(1) of the Act is very limited. First, the reliability of this evidence is unclear as the confirmation from Northern Shipments to Erin Gleason at the email address eringlsn@yahoo.com cannot be considered a business record of the Owner. Second, Northern Shipments does not confirm that the Cushe products for which the orders were fulfilled are any of the registered goods sold in association with the Marks.

[16] Finally, neither the email from Northern Shipments, nor the affidavit of Mr. Bolinger provides evidence that the products sold by Northern Shipments include the Marks on packaging, tags or on footwear. Rather, Mr. Bolinger states:

(para 8) Each item of CUSHE branded Footwear sold by Saucony and by third party reseller has displayed and displays the CUSHE Trademarks... attached as Exhibit "D" are photographs or images of labels, tags or packaging featuring the CUSHE Trademarks. These tags are representative of the manner in which CUSHE Trademarks have been and continue to be displayed on CUSHE Footwear sold in Canada during the Relevant Period and today.

In the absence of further evidence correlating the sales by Northern Shipments to the photographs, and in particular the tags, at Exhibit D, Mr. Bolinger's statement amounts to a bare assertion of use rather than facts showing use. Further, little weight can be given to this statement. Mr. Bolinger is intellectual property counsel of the Owner's parent company and his affidavit does not confirm that he has knowledge of the information in his affidavit, nor access to the relevant business records, such as those dealing with the reseller Northern Shipments. Finally, I do not find that Mr. Bolinger's description of his responsibilities results in the inference that he would have knowledge of the evidence in this paragraph as it pertains to the sales by Northern Shipments.

[17] In view of the foregoing, the Owner fails to meet its *prima facie* burden of showing use of the Marks.

DISPOSITION

[18] Accordingly, 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 registrations for the Design Mark and the Word Mark will be expunged.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2022-03-04

APPEARANCES

No one appearing

For the Registered Owner

James Green

For the Requesting Party

AGENTS OF RECORD

Borden Ladner Gervais LLP

For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party