

SECTION 45 PROCEEDINGS
TRADE-MARK: MAGS & DESIGN
REGISTRATION NO: TMA 495,342

At the request of Magaschoni Apparel group, Inc., the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on December 17, 2004 to Johannes L. Kappetein the registered owner of the above referenced trade-mark.

Registration No: TMA 495, 342 MAGS & Design shown below is registered as a trade-mark in association with “shoes, specifically excluding insoles”.



TMA 495,342

Section 45 of the *Trade-marks 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/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 December 17, 2001 and December 17, 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 Johannes Kappetein. The requesting party and the registrant filed written submissions; neither party requested an oral hearing.

The Kappetein affidavit provides evidence of sales of shoes in Canada through a number of retailers in Canada through licencees and sub-licencees. Copies of licence agreements are provided. The affiant also provides details of the manner in which he maintains control over the quality of the wares. The requesting party concedes that there have been sales of shoes in Canada during the relevant period in the normal course of trade.

The issues in this proceeding relate to the fact that the licence agreements and the photographs of the wares do not refer to or contain the subject trade-mark, but rather a variation thereof. The variation is referred to in the licence agreements and the affidavit as the "Jumping Man" MAG & Design. The affiant states in paragraph 5 of the affidavit that the change from the trade-mark as registered to the Jumping Man occurred during the years 1991 to 2002. The reason given is that the Jumping Man takes up less width when marked on the shoes.



TMA 495,342



Jumping Man

Where the mark as used deviates from the mark as registered, the question to be asked is whether the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used (*Canada (Registrar of Trade-marks) v. Cie International pour l'informatique CII Honeywell Bull* (1985), 4 C.P.R. (3d) 523 at 525 (F.C.A.)). In deciding this issue, one must look to see if the "dominant features" have been preserved, *Promafil Canada Ltée v. Munsingwear Inc.*, 44 C.P.R. (3d) at 59 (FCA). Whether the differences between the marks are "so unimportant that an unaware

purchaser would be likely to infer that both, in spite of their differences identify goods having the same origin” (*Canada (Registrar of Trade-marks) v. Cie International pour l’informatique CII Honeywell Bull, supra* at p. 525), is a question of fact.

The registrant submits that “every essential aspect of the mark has been perpetuated” in the mark as used. I do not agree. The differences between the registered trade-mark and the mark as used are more than slight visual differences. Firstly, I find that the “man design” portion of the registered trade-mark is a dominant feature of the mark and it has not been preserved in its entirety – the zigzag lines are missing from under its feet in the mark as used. Secondly, I find that the fancy M (consisting of the “man design”) in the word MAGS is dominant; this too has not been preserved in the mark as used. Thirdly, with respect to the placement of the features of the trade-mark, I consider that the fact that MAGS becomes MAG and is moved to the top of the “man design” in the mark as used, is an alteration of a dominant feature of the mark. The mark as used is no longer one word (with a fancy “M”) but is clearly composed of two elements – the man design and the word MAG. In my view this change in placement of the features of the registered trade-mark creates a different mark - one that is clearly composed of two separate elements – a design and a word.

With respect to the decisions in *Inso Corp.v. Alliance Technologies Inc.*, 4 C.P.R. (4th) 102, and *Blaney, McMurty, Stapels, Friedman v. Spectra Computer Services Ltd.*, 5 C.P.R. (4th) 106, referred to by the registrant, I note that in both those cases the dominant element of the marks was either only a word or a word with minimal design features; in each case the word was preserved in its entirety. In the present proceeding, however, the facts are that both the word portion and the design portion have been altered. Further, the placement of the elements has changed, and the design and its dual function in the mark have been altered.

In view of all of the foregoing, I consider that the differences between the subject registered trade-mark and the mark as used are too substantial to be considered minor deviations; the changes are such that the registered trade-mark *per se*, is no longer

recognizable. It is therefore my conclusion that TMA 495,342 for MAGS & Design ought to be expunged from the Register for failure to show use pursuant to Section 45 of the Trade-marks Act.

DATED AT GATINEAU, QUEBEC, THIS 18th DAY OF JANUARY 2007.

P. Heidi Sprung
Member,
Trade-marks Opposition Board