

SECTION 45 PROCEEDINGS
TRADE-MARK: SURE GRIP
REGISTRATION NO.: TMA517,301

[1] At the request of Riches, McKenzie & Herbert LLP (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) on January 9, 2008 to Tana Canada Inc. (the “registrant”), the registered owner of the above-referenced trade-mark registration.

[2] The trade-mark SURE GRIP is registered for use in association with an “anti-slip pad attached to the bottom of footwear to prevent slipping”.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares and/or 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 it was 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 between January 9, 2005 and January 9, 2008 (the “relevant period”).

[4] “Use” in association with wares is set out in subsections 4(1) and 4(3) of the Act:

4. (1) A trade-mark is deemed to be 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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, subsection 4(1) applies.

[5] In response to the Registrar's notice, the registrant furnished the affidavit of Robert Clark sworn on May 14, 2008, together with Exhibits A, B and C. Only the registrant filed written submissions; an oral hearing was not requested.

[6] Mr. Clark states that he is the Director of Marketing for the Shoe Care North America division at Sara Lee Corporation ("Sara Lee") and that he has held this position since October 2000. He explains that, by virtue of his position, he has access to and is familiar with records and information relating to the marking and sale of products for which the registrant, a subsidiary of Sara Lee, holds trade-marks. He has knowledge of the matters deposed to based on personal knowledge and a review of the company's business records.

[7] At paragraph 4 of his affidavit, Mr. Clark describes the registrant's normal course of trade in Canada – stating that the registrant sells the wares to Canadian retailers who then sell them to end users in Canada. The registrant receives orders either through a sales broker, directly from Canadian retailers, or US based retailers, and distributes the wares to retail outlets in Canada through its business division, Sara Lee Household and Body Care Canada. He states that all wares are shipped from the registrant's warehouse in Mississauga, Ontario.

[8] Mr. Clark's affidavit demonstrates that during the relevant period, wares bearing the trade-mark were sold by the registrant and delivered to its customers in the normal course of trade, as described above. Attached as Exhibit B is "a specimen of the Wares bearing the SURE GRIP trade-mark as it would have appeared on the Wares sold in Canada during the Material Period". I note that the packaging prominently displays the trade-mark, contains instructions that identify the wares by the trade-mark, and indicates that the wares are distributed by TANA CANADA Inc., Montreal, Quebec. I also note that the packaging depicts photographs showing a pad attached to the bottom of footwear, and includes the descriptions "ANTI-SLIP" and "Helps guard against slipping on slick surfaces".

[9] In view of the above, I am satisfied that the trade-mark shown constitutes use of the trade-mark as registered, and that the use of the trade-mark in this manner satisfies the requirements of section 4(1) of the Act, as the packaging would provide notice of the association to the person to whom the property or possession is being transferred.

[10] With regard to the evidence of sales, Mr. Clark furnished seven invoices, all dated within the relevant period, issued by Sara Lee Household Body Care Canada, a division of the registrant, all demonstrating sales of the wares to retailers in Canada. He states that these invoices relate to sales of the subject wares, which is further supported by the appearance in each invoice, among the list of items sold, of references to the trade-mark in conjunction with what appears to be the size of the wares, i.e. "Sure Grip Medium".

[11] In view of all of the above, I find that the registrant's evidence clearly demonstrates that there was use of the trade-mark within the meaning of section 45 and subsection 4(1) in association with an "anti-slip pad attached to the bottom of footwear to prevent slipping". Accordingly, and pursuant to the authority delegated to me under subsection 63(3) of the Act, registration no. TMA517,301 for the trade-mark SURE GRIP will be maintained in compliance with the provisions of section 45(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC THIS 6TH DAY OF JANUARY 2010.

P. Heidi Sprung

Member

Trade-marks Opposition Board