

IN THE MATTER OF A SECTION 45 PROCEEDING
respecting registration No. **199,684** for the trade-
mark **BIRD & UMBRELLA Design** standing in the name of
U L Canada Inc.

On January 17, 1994, at the request of Messrs. Sim & McBurney, the Registrar forwarded a Section 45 Notice to U L Canada Inc., the registered owner of the design mark reproduced below [hereinafter referred to as "the trade-mark"]:

The trade-mark is registered for use in association with the following wares: "baby lotion, baby oil and baby powder".

In response to the Section 45 notice, the registrant furnished the affidavit of Kathryn Morton, Senior Brand Manager of Chesebrough-Pond's (Canada) Division of U L Canada Inc., on July 12, 1994. Both the requesting party and the registrant filed written submissions. No oral hearing was conducted.

Section 45 of the Trade-Marks Act requires the registered owner to evidence use of its registered trade-mark within the two year period immediately preceding the date of the notice (i.e. January 17, 1992 - January 17, 1994) for each of the registered wares. If the registrant cannot show use within that period, it is required to show the date of last use of the mark and provide the reason for the absence of use since such date.

At paragraph 6 of her affidavit, Ms. Morton concedes that the registered wares "baby powder, baby lotion and baby oil" which bore the trade-mark as registered were discontinued sometime in 1979.

At paragraphs 7 and 8, Ms. Morton refers to a variation of the

registered trade-mark used in print advertisements in July 1989 and July 1990. At paragraph 8, she refers to a current label (Exhibit D) used in association with "petroleum jelly" which label shows a mark that differs from the trade-mark as registered. She submits that products bearing this label were launched in January 1994. At paragraph 8, she refers to a photocopy of a booklet entitled "Vaseline Baby and Child Health Care Guide" and its French version. She states that a variation of the trade-mark appears throughout those booklets. She then adds that the bird character is an integral part of the registrant's marketing programmes in the sale and promotion of its various VASELINE products.

From the evidence furnished, it is clear that the registered trade-mark was not in use in Canada in association with "baby lotion, baby oil or baby powder" during the two-year period preceding the date of the Section 45 notice. First, as the requesting party has pointed out, use has not been shown in association with **any** of the **registered wares**. By the registrant's own admission, the wares "baby lotion, baby oil and baby powder" were discontinued in 1979.

Secondly, exhibits C-1 to C-3, D, and E-1 and E-2, do not show the mark as registered. They show marks that differ substantially from the trade-mark as registered. The marks used are the following:
Exhibit C-1 to C-3:

Exhibit D:

Exhibit E-1, E-2:

In my view, the marks as used differ substantially from the trade-mark as registered. The dominant features of the mark as registered consist of the picture of a larger bird holding an umbrella followed by two smaller birds. These features have not been preserved in the marks as used. The marks as used comprise the design of a bird with or without an umbrella and the bird design is quite different from the bird character in the trade-mark as registered. In my view, the marks as used are visually quite different from the trade-mark as registered and would not be seen as use of the registered trade-mark. In this regard, see Nightingale Interloc Ltd. v. Prodesign Ltd., 2 C.P.R.(3d) 535 and Promafil Canada Ltée v. Munsingwear Inc., 44 C.P.R.(3d) 59.

Finally, the only ware for which any evidence of use in the ordinary course of trade was provided is "petroleum jelly". In its written submissions, the registrant contends that petroleum jelly is a similar product to body lotion. However, even if this was the case, it would not meet the requirements of Section 45 which requires use to be shown with the registered wares not wares analogous to those registered.

For the reasons outlined above, I conclude that the registrant has failed to show use of the trade-mark as registered and use in Canada in association with the registered wares within the two-year period immediately preceding the date of the Section 45 Notice. Furthermore, the absence of use has not been shown to have been due to special circumstances excusing the absence of such use.

Accordingly, and in the absence of an appeal from this decision pursuant to the provisions of Section 56 of the Trade-Marks Act, registration No. 199,684 will be expunged from the register.

DATED AT HULL, QUEBEC, THIS 30th DAY OF November, 1995.

D. Savard
Senior Hearing Officer