

**SECTION 45 PROCEEDINGS  
TRADE-MARK: SHOPPER STOPPERS  
REGISTRATION NO.: TMA 192,141**

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On June 29, 1999, at the request of Messrs. Osler, Hoskin & Harcourt, the Registrar forwarded a Section 45 notice to Sears Canada Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark SHOPPER STOPPERS is registered of use in association with the following services: advertising and promotional activities in the operation of a departmental store and catalogue sales.

In response to the notice, the affidavit of Sharon Landry has been furnished. Each party has filed a written argument. An oral hearing has not been requested in this case.

In her affidavit, Ms. Landry states that the registrant operates 110 retail stores and approximately 1900 catalogue outlets throughout Canada, all under the trade-mark and trade name SEARS. The trade-mark and trade name SEARS are also associated with a retail catalogue business offering a wide variety of products. She explains that from time to time a special sale catalogue is published and distributed by Sears which features the trade-mark SHOPPER STOPPERS. As Exhibit A she attaches the front cover and sample pages from "a Sears SHOPPER STOPPER catalogue", that was distributed beginning April 28, 1997 and which expired September 28, 1997, all of which pages depict the trade-mark. She states that there were approximately 4,160,000 copies printed and distributed to Sears cardholders in Canada. As Exhibit B, she provides a copy of the front cover and sample pages of a Sears SHOPPER STOPPER catalogue that was released February 22, 1999 and expired on September 26, 1999.

In its written argument, the requesting party argues that the evidence fails to show use of the trade-mark as registered; in addition, the requesting party submits that the registrant has failed to show use in relation to both categories of services for which the mark is registered.

Having considered the evidence and the arguments of the parties, I conclude that the use shown by the evidence constitutes use of the registered trade-mark. In my view, the use of SHOPPER STOPPER (in the singular rather than in the plural) and the use of SHOPPER STOPPERS! with an exclamation mark constitutes use of the registered trade-mark. The dropping of the “S”, in the first instance consists of a minor modification of the trade-mark as registered. Similarly, the addition of the punctuation mark to the words SHOPPER STOPPERS in the second instance does not prevent the words “SHOPPER STOPPERS” “per se” as being perceived as the trade-mark being used. As properly argued by the registrant, the trade-mark has not lost its identity and remains recognizable in spite of the minute differences between the form in which it is registered and the form it is being used (*Promafil Canada Ltée v. Munsingwear Inc.*, 44 C.P.R. (3d) 59). In arriving at this conclusion, I also had regard to the principles enunciated in *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535, *Registrar of Trade-marks v. CII Honeywell Bull*, 4 C.P.R. (3d) 523 and *Honey Dew Ltd. v. Rudd*, [1929] 1 D.L.R. 449. Further as stated in *John Labatt Ltd. v. Molson Breweries, a partnership*, 46 C.P.R. (3d) 6, the basic principle to be derived from the jurisprudence is that a registered owner of a trade-mark will not lose his rights to the trade-mark even if the mark as used deviates from the registered mark when the deviation is such that no person would be deceived or injured by it. Here, I am of the view that the minor changes to the mark would not deceive or injure the public in any way.

Concerning the requesting party’s second argument, I find it can be argued that the display of the trade-mark in the registrant’s catalogues is a use of the trade-mark in association with advertising and promotional activities in the operation of a departmental store as well as in association with catalogue sale services. As Ms. Landry has indicated that the catalogues are distributed to Sears cardholders in Canada and further are available for pick up by shoppers in all Sears stores as well as catalogue outlets, I am prepared to conclude that the publication of the catalogue is an activity that is also incidental to the operation of the registrant’s stores, and therefore I conclude that the use shown of the trade-mark is use in association with each of the registered services.

In view of the above, I conclude that the trade-mark registration ought to be maintained on the register.

Registration No. TMA 192,141 will be maintained in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF January, 2001.

D. Savard  
Senior Hearing Officer  
Section 45