

SECTION 45 PROCEEDINGS
TRADE-MARK: PENN ENGINEERING
REGISTRATION NO.: 189,289

On October 19, 1999, at the request of the Canadian Council of Professional Engineers, the Registrar forwarded a Section 45 notice to Penn Engineering & Manufacturing Corp., the registered owner of the above-referenced trade-mark registration.

The trade-mark PENN ENGINEERING is registered for use in association with the following wares: self-clinching fasteners, self-locating weld fasteners, and self-clinching drill bushings.

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 response to the notice, the affidavit of Leon Attarian together with exhibits was furnished.

The requesting party filed a written argument. The registrant requested and was granted a retroactive extension of time pursuant to Section 47(2) of the Trade-marks Act to file additional evidence in the nature of a second affidavit of Leon Attarian. The registrant then filed a written argument. An oral hearing was held at which each party was represented.

In his affidavits, Mr. Attarian states that the trade-mark is in current use and has been continuously in use in Canada in association with each of the wares for a number of years, and was in use during the relevant period. He specifies that the registrant is the manufacturer of the wares which are sold under the trade-mark in Canada and that it distributes the wares in Canada through the normal course of trade. He indicates that the wares are shipped to Canada in boxes to which the registrant applies its trade-mark PENN ENGINEERING. He has submitted examples of the way the trade-mark is applied to the packaging and copies of two representative invoices which show sales of fasteners in association with the trade-mark.

The requesting party has raised several arguments, one being that the term PENN ENGINEERING is an element of the registrant's corporate name and is not used as a trade-mark; another argument is that the evidence does not show use in association with each of the registered wares.

Having considered the evidence, I totally agree that any use shown by the evidence is use of the registrant's name "Penn Engineering & Manufacturing Corp." and not use of the trade-mark "PENN ENGINEERING" per se. The words "Penn Engineering & Manufacturing Corp.", appearing on the packaging for the fasteners and on the invoices are all in the same font and size. The words "PENN ENGINEERING" do not stand out from the other elements namely "Manufacturing Corp.", and therefore would not be perceived as forming a distinct trade-mark (see *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) at 535 Principle 1).

The registrant argues that the words PENN ENGINEERING followed by an encircled ® appear on the packaging and therefore the words PENN ENGINEERING are also being used as a trade-mark. The manner the words PENN ENGINEERING followed by the ® symbol appear on the packaging is as follows:

As pointed out by the requesting party, this is merely a message that the registrant is the owner of several trade-marks. The trade-mark PENN ENGINEERING does not stand out from the other marks and therefore would not be perceived as the trade-mark being used in association with the wares contained in the packaging. Rather, it is the trade-mark PEM which appears to be used in association with the wares. Further, I completely agree with the requesting party that it is one thing to enumerate on a packaging a list of trade-marks a registrant owns, it is quite another thing for a registrant to show use. In my view, the evidence begs the question whether the trade-mark PENN ENGINEERING is in use in association with wares. Surely, the purpose of Section 45

would be defeated if a registrant could save a trade-mark that is “deadwood” just by listing on its packaging all of the trade-marks it owns.

Consequently, I conclude that the message on the packaging to the the effect that the registrant is owner of several trade-marks and a listing of such trade-marks is not a use complying with Section 4(1) of the Act. In my view, notice of the association between the trade-mark PENN ENGINEERING and the wares is not being provided to the purchaser of the wares when the marks appears in such a manner.

As I have concluded that the evidence fails to show use of the trade-mark PENN ENGINEERING “per se” and use complying with Section 4(1) of the Act, I need not address the other issue raised by the requesting party. However, I would add that none of the invoices show a transfer of the wares in Canada during the relevant period. The invoice dated “19 February 1997” shows that the wares were shipped to Tonawanda, New York, and therefore such invoice does not show a transfer of the wares in Canada. As for the invoice dated “16 March 2000” it shows a sale in Canada having occurred subsequent to the relevant period.

Registration No. 189,289 will be expunged in compliance with the provisions of Section 45(5) of the Act.

DATED AT HULL, QUEBEC, THIS 20th DAY OF DECEMBER 2001.

D Savard
Senior Hearing Officer
Section 45 Division