

SECTION 45 PROCEEDINGS
TRADE MARK: CHUBBY
REGISTRATION NO.: TMA 130,226
APPLICATION NO.: 271,227

On September 9, 1992, at the request of Bereskin & Parr, the Registrar forwarded a Section 45 notice to Kimberly-Clark of Canada Limited, the registered owner of the above-referenced trade-mark registration.

The trade-mark CHUBBY was registered on March 15, 1995, in association with "Absorbent paper".

In response to the Registrar notice, the registered owner furnished the affidavit of T.E. Johnson. Both the requesting party and the registrant filed a written submission. An oral hearing was not conducted with respect to this proceeding.

In his affidavit, Mr. Johnson states in paragraph 2 that the registered owner had changed its name from Kimberly-Clark of Canada Limited to Kimberly-Clark Canada Inc. as of October 1, 1989 and submits the articles of Amendment in support thereof. In paragraph 3 Mr. Johnson claims use of the above-referenced trade-mark in the two year period prior to the Section 45 notice. He submits that the trade-mark is used in conjunction with the sale of facial tissue which he states is a form of absorbent paper. The wares are sold in cartons to retailers who re-sell the product to the general public (paragraph 4). As Exhibit "B" to his affidavit Mr. Johnson includes price lists made available to retailers. Some bear dates within the two-year period. He submits that the price lists identifies CHUBBY as a trade-mark used by his company in conjunction with the sale of facial tissue. Exhibit "C" are copies of invoices issued for the period August 20, 1991 to August 21, 1992 which he states evidence sales of absorbent tissue under the CHUBBY mark. A further invoice dated October 8, 1992 was also included. Copies of advertisements dated October 27, 1991 and May 9, 1992 relating to retail sales were attached as Exhibit "D" to his affidavit. Finally sales figures for 1990 and 1991 as well as advertising figures relating to the two years prior to the date of the affidavit were provided.

From the evidence furnished, it would seem the trade-mark CHUBBY appears on the price lists, in the body of the invoices and in the advertisements. According

to Section 4(1) of the Act, in order for a trade-mark to be deemed use in association with the wares, the trade-mark must be marked on the wares themselves, on the packaging or in a 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". Although, the advertisements submitted as Exhibit "D" to the affidavit of Mr. Johnson are not considered to comply with Section 4(1) of the Act, the price lists and invoices attached as Exhibits "B" and "C" respectively to the affidavit of Mr. Johnson may be considered sufficient. The wares and the trade-mark CHUBBY appear in the body of both documents.

Mr. Johnson has submitted that the price lists which show the trade-mark in association with the wares are used by retailers in ordering the wares from the registrant. In addition, the trade-mark appears in the body of the invoices issued to retailers in Canada. Thus there would be notice of the above-referenced trade-mark in association with the wares when the wares are ordered and the association would still be made when the wares are received by the retailers as the trade-mark appears on the invoices. Although the trade-mark is not marked on the wares and does not appear on the packaging for the wares, the trade-mark is so associated with the wares that notice of the association is given to the retailer to whom the property or possession is transferred. Consequently, I am satisfied that the use shown satisfied the requirements of Section 4(1) of the Act.


The requesting party argues that the word CHUBBY as it appears in the exhibits is not used as a trade-mark but is a descriptive term used to describe "a characteristic of either the wares or the packages". In essence the requesting party contends that the word CHUBBY is a product type or a size description. It submits that CHUBBY appears on the price lists under the category "KLEENEX facial tissues" as "CHUBBY WHITE", followed by several other product size or type designations such as "REGULAR WHITE", "ULTRA WHITE", etc. Although that is correct, the word CHUBBY on the price lists is followed by the R in a circle. Therefore, the registrant identifies it as a trade-mark and, in my view, it would be perceived as such by the retailers purchasing the product. Furthermore, concerning the invoices, there is no prohibition against the use of more than one trade-mark so that both the trade-marks KLEENEX and CHUBBY can identify the same

product. Thus I find that the above-referenced trade-mark is being used as a trade-mark.

The requesting party then argues that the wares "facial tissues" mentioned in the evidence are not the wares covered by the registration, i.e. absorbent paper. Mr. Johnson has stated in his affidavit that facial tissue is a form of absorbent paper. Considering that the term "absorbent paper" is very broad. I am prepared to accept that it would encompass facial tissues. Thus I find the use shown of the above-referenced trade-mark is in association with the registered wares.

In view of the evidence furnished. I conclude that the above-referenced trade-mark has been shown to be in use in Canada by the registered owner in association with the registered wares during the relevant period. Thus, in the absence of an appeal of this decision pursuant to the provisions of Section 56 of the Trade-marks Act. Registration No. TMA 130.226 will be maintained accordingly on the register.

DATED AT HULL. QUEBEC. THIS 6TH DAY OF SEPTEMBER 1995,


D. Savard
Senior Hearing Officer

