

SECTION 45 PROCEEDINGS
TRADE-MARK: PENGUIN
REGISTRATION NO: TMA 518,903

On March 2, 2005, at the request of Bereskin & Parr (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* to Eye Spy Accessories Inc., the registered owner of the above referenced trade-mark (the “registrant”).

The trade-mark PENGUIN is registered for use in association with the following wares: “handbags, cooler bags, business cases, water bottles”.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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 this case, the relevant period for showing use is any time between March 2, 2002 and March 2, 2005.

“Use” in association with wares is set out in subsection 4(1) of the *Trade-marks Act*:

A trade-mark is deemed to have been 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.

In response to the Registrar’s notice, the affidavit of Howard Javasky together with exhibits has been furnished. Neither party filed a written argument; an oral hearing was not held in this case.

Mr. Javasky states that he is the President of Eye Spy Accessories Inc. He explains that he has held this position since the company was incorporated in 1993, and therefore has

personal knowledge of the matters at hand. In paragraph 5 of his affidavit, Mr. Javasky indicates that throughout the relevant period his company sold handbags, business cases and cooler bags bearing the PENGUIN trade-mark through various retail outlets in Canada; these wares were also available through the company's website. The PENGUIN trade-mark was embossed or sewn onto the wares at the time these products were sold, shipped and delivered to Canadian stores.

Attached as Exhibit A is a 2003-2004 Luggage, Leathergoods & Accessories Annual Buyers Guide. I note that PENGUIN appears under a listing of "Brand Names" for Luggage, Backpacks, and Daypacks. Exhibits "B-1" to "B-3" are invoices dated within the relevant period indicating sales of "portfolios" to various retailers in Canada. Exhibits "B-4" and "D-4" appear to be images from the registrant's website that depict a Portfolio and an Insulated Lunch Bag. Exhibits "B-5" and "D-5" appear to be enlarged photographs of the same bags. These images clearly show the PENGUIN mark embossed or sewn onto the both the portfolios and the lunch bags. Exhibit E appears to be a page from a catalogue depicting two insulated lunch bags bearing the PENGUIN mark. Mr. Javasky states that the portfolio cases and cooler bags referred to in the invoices were clearly marked with the subject trade-mark as depicted in the aforementioned images.

There is an issue as to whether "business cases", as listed in the statement of wares, includes "portfolios". *The Canadian Oxford Dictionary* defines a "portfolio" as "a case for keeping loose sheets of paper, drawings, etc"; since business papers could conceivably be kept in a portfolio, I am prepared to accept, for the purposes of s.45 of the *Act*, that a "portfolio" could be considered a "business case".

With respect to whether or not an "insulated lunch bag" is a "cooler bag" as listed in the statement of wares, I note that at paragraph 15 of Mr. Javasky's affidavit he states "this lunch bag is a cooler bag for the temporary transportation and/or storage of food and beverages". I therefore am prepared to accept that "insulated lunch bags" are "cooler bags".

With respect to the wares “handbags”, I note that Mr. Javasky does not direct us to invoices or images that relate to specifically to “handbags” marked with the subject trade-mark. In fact, throughout the affidavit, the affiant uses the words handbags and business cases together, somewhat vaguely, as though they might be the same ware. While in some cases it has been found that use of the trade-mark on one ware in a category can be considered use of another ware in the same general category (*Saks & Co. v. Canada (Registrar of Trade-marks)* (1989) 24 C.P.R. (3d) 49 (F.C.T.D.)), generally, use must be shown of all wares listed in the registration (*Sharp Kabushiki Kaisha v. 88766 Canada Inc* (1997), 72 C.P.R. (3d) 195). In the present case, in the absence of an unambiguous assertion of use of the subject trade-mark on handbags, and without explanation of the relationship of handbags to business cases/portfolios and why the terms are used together in the affidavit, I find that the ambiguity in the affidavit must be held against the affiant (*Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1979), 45 C.P.R. (2d) 194). I am unable to accept that use of the subject trade-mark on business cases should be considered use on handbags.

Mr. Javasky makes no assertion that the mark was used “water bottles” during the relevant period, and presents no special circumstances that would excuse the absence of use.

In view of the all of the foregoing, I am satisfied that there was use of the subject trade-mark on “cooler bags” and “business cases” within the meaning of section 45 and subsection 4(1) of the Act. Registration No. TMA 518,903 for PENGUIN will therefore be amended to delete “handbags” and “water bottles” in compliance with the provisions of subsection 45(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC, THIS 5th DAY OF DECEMBER 2007.

P. Heidi Sprung

Member, Trade-marks Opposition Board