

TRADUCTION/TRANSLATION

SECTION 45 PROCEEDINGS
TRADE-MARK: HEMISPHERES
REGISTRATION NO: TMA 435,253

On February 10, 2005, at the request of Heenan Blaikie (the “requesting party”), the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) to DELSEY, SOCIÉTÉ ANONYME, the registered owner of registration No. TMA 435,253 for the trade-mark HEMISPHERES (the “Mark”). The Mark is registered for use in association with “Sacs à mains, sacs de voyages, valises et bagages, malles, serviettes, petites mallettes extra-plates pour le transport de documents, cannes et parapluies, sellerie, nommément fouets, harnais, selles, coussins pour voitures, articles en cuir et en imitation du cuir, nommément sacs à main, sacs de voyages, sacs à dos, malles, valises, porte-documents, porte-monnaie, chéquiers, porte-cartes, porte-billets, porte-clés”.

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 February 10, 2002 and February 10, 2005.

“Use” in association with wares is set out in subsections 4(1) and 4(3) of the *Trade-marks Act*:

- (1) 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.

- (3) A trade-mark that is marked in Canada on wares, or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be use in Canada in association with those wares.

In response to the Registrar's notice, the registrant furnished the affidavit of Mr Emmanuel Stevenart, the CFO of the registered owner. The registrant also filed a written argument. The requesting party did not file a written argument and neither party requested an oral hearing.

In his affidavit, Mr Stevenart states that he has access to the registrant's files and records regarding the information contained in the affidavit and has knowledge of the matters therein. He states that the Mark has been used during the relevant period by the registrant, under its official name as well as under its trade name DELSEY Worldwide Headquarters. Its Canadian distributor is Samboro Luggage (Canada) Corp and it does business under its official name as well as under its trade name DELSEY/SAMBORO LUGGAGE.

Mr Stevenart states that during the relevant period, the registrant sold "travel bags" (sacs de voyage), "suitcases" (valises) and "luggage" (bagages) in Canada in association with the Mark. I note that the invoices entered as Exhibit E-2 clearly confirm that bona fide sales from the distributor were made within the relevant period. Mr. Stevenart has indicated that the products are identified by a hang tag bearing the trade-mark attached to the product at the time of sale. Exhibit E-1 features specimens of hang tags representative of those found on the Canadian market. While it is not stated that the hang tags are representative of those found on the Canadian market during the relevant period, this can be inferred from the evidence as a whole. I note that the trade-mark on the hang tags appears in the singular rather than in the plural form, however, this is considered a minor deviation which would not deceive or injure the public in any way. Consequently,

based on the above, I accept that at the time of transfer of the wares the trade-mark was associated with the wares in a manner complying with the requirement of s-s. 4(1) of the Act. Accordingly, I am satisfied that the evidence shows use of the Mark in association with the “travel bags” (sacs de voyage), “suitcases” (valises) and “luggage” (bagages) in a manner complying with the requirements of the Act.

Turning now to the issue of whether the Mark was used in association with the remaining wares during the relevant period, I note that Mr Stevenart has referred only to the wares “travel bags” (sacs de voyage), “suitcases” (valises) and “luggage” (bagages) and that the evidence appears to demonstrate use only in association with these wares. In its written argument, the registrant also refers only to these specific wares.

In view of all the foregoing, it is my conclusion that registration no. TMA 435,253 for the trade-mark HEMISPHERES ought to be amended to delete “Sacs à mains, malles, serviettes, petites mallettes extra-plates pour le transport de documents, cannes et parapluies, sellerie, nommément fouets, harnais, selles, coussins pour voitures, articles en cuir et en imitation du cuir, nommément sacs à main, sacs de voyages, sacs à dos, malles, valises, porte-documents, porte-monnaie, chéquiers, porte-cartes, porte-billets, porte-clés.” from the description of wares.

Registration No. TMA 435,253 will be amended accordingly in compliance with the provisions of subsection 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 20TH DAY OF DECEMBER 2007.

D. Savard
Senior Hearing Officer
Section 45 Division