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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 120
Date of Decision: 2021-06-14

IN THE MATTER OF A SECTION 45 PROCEEDING

Borden Ladner Gervais LLP

Requesting Party

and

Samsonite IP Holdings S.à.r.l.

Registered Owner

TMA418,575 for SAMMIES

Registration

[1] On December 19, 2017, at the request of Borden Ladner Gervais LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Samsonite IP Holdings S.à.r.l. (the Owner), the registered owner of Registration No. TMA418,575 for the trademark SAMMIES (the Mark). The Mark is registered for use in association with the following goods: “Luggage.”

[2] The notice required the Owner to show use of the Mark in Canada in association with the registered goods 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 such use since that date. In this case, the relevant period for showing use is December 19, 2014 to December 19, 2017.

[3] The relevant definition of use in this case is set out in section 4(1) of the Act as follows:

A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any

other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[4] In the absence of use, the Mark is liable to be expunged unless the absence of use is due to special circumstances that excuse the absence of use [section 45(3) of the Act].

[5] In response to the Registrar's notice, the Owner furnished the affidavit of Richard Andrew Lamb, a director of the Owner, sworn on July 19, 2018. Both parties submitted written representations. Only the Requesting Party requested and attended an oral hearing. The hearing was held jointly with respect to the summary expungement proceeding Registration No. TMA729,678 (SAMMIES), for which a separate decision will issue.

[6] In his affidavit, Mr. Lamb states that the registered goods have been and continue to be widely sold in Canada (paras 2 and 3). He provides bundles of pages from *Amazon.ca* (Exhibit A), *eBay.ca* (Exhibit B), and Kijiji (Exhibit C). Some of the pages are undated, while others are dated after the relevant period. The Mark appears in the product descriptions of some of the items shown, which are described as backpacks, school bags, travel bags, dufflebags, and carry-on luggage. The items shown in Exhibit A appear to be offered for sale by "Samsonite", while the items shown in Exhibit B are described as being pre-owned and appear to be offered for sale by third parties. The items shown in Exhibit C also appear to be offered for sale by third parties. Some items have prices in Canadian dollars, while others appear to be in foreign currency.

[7] None of the evidence provided in Mr. Lamb's affidavit is dated during the relevant period, nor does Mr. Lamb state that the evidence is representative of how the goods or the Mark appeared during the relevant period. Even if I were to accept that the evidence is representative of how the goods and the Mark appeared during the relevant period, the Owner does not provide any evidence of sales or transfer. The Owner only provides evidence that various items were offered for sale, which is not sufficient to show use under section 4(1) of the Act [for similar findings, see *Riches, McKenzie & Herbert LLP v Cleaner's Supply Inc*, 2012 TMOB 211 at paras 12 and 13]. In addition, only the items shown in Exhibit A appear to be offered by "Samsonite" and, of the products shown, the Mark is only displayed alongside backpacks and school bags. As noted by the Requesting Party, no information is provided as to how these products correspond to the registered "luggage" goods. I also note that no information is provided regarding the third

parties that are offering items for sale in Exhibits B and C. In particular, there is no information about the Owner's normal course of trade and whether these third parties are part of the chain of distribution for these goods [*Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD) at para 39].

[8] Based on the findings above, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act, and the Owner has not provided any special circumstances excusing non-use of the Mark.

[9] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be expunged.

Bradley Au
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2021-06-14

APPEARANCES

No one appearing

For the Registered Owner

Peter Cooke

For the Requesting Party

AGENTS OF RECORD

Smart & Biggar LLP

For the Registered Owner

Borden Ladner Gervais LLP

For the Requesting Party