



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 127
Date of Decision: 2016-07-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Croll & Co.

Requesting Party

and

Lucite International, Inc.

Registered Owner

TMA667,621 for LUCITE

Registration

[1] At the request of Croll & Co., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on January 31, 2014 to Lucite International, Inc. (the Owner), the registered owner of registration No. TMA667,621 for the trade-mark LUCITE (the Mark). Subsequent to the issuance of the notice, the Owner voluntarily amended the registration.

[2] As a result, the Mark is now registered for use in association with the following goods:

(1) Plastics in the form of suspensions or solutions for use in industrial processes, namely such plastics containing acrylic compounds; dispersion of plastics for use in manufacturing of solid shapes; unprocessed epoxy and synthetic resins; acrylic components for use in adhesive formulations, substances and materials for making adhesives; organic glass; unprocessed acrylic resin for use in manufacturing of solid shapes; ink resins; mould release preparations and moulding preparations, moulding powders for use in industry; chemical reagents namely methyl methacrylate and sodium cyanide; resin beads.

(2) Material for filling and stopping teeth; dental polymers; dental cements and adhesives for dentures; moulding wax; chemicals and reagents for medical and veterinary purposes; bone cement; hoof beak and bone repair preparations.

(3) Signs, illuminated and mechanical signs, including any such signs in 3-D; writing components of electronic display and projection devices; back lights for liquid crystal displays; liquid crystal displays; light guide panels for liquid crystal displays; light

diffusion panels for liquid crystal displays; projection screens; components of electronic display and projection devices including screens and projection screens; CDs; optical fibres; furniture especially made for laboratories; parts and fittings for all the aforesaid goods.

(4) Orthopaedic joints; dentures, artificial teeth, artificial eyes; adhesives and modelling materials for surgical, medical, dental and veterinary purposes; including all of the aforesaid goods made wholly or principally of polymers; parts and fittings for all the aforesaid goods.

(5) Light diffusers, reflectors and refractors; transport lights and cover for transport lights; display lighting; baths, showers, shower cubicles, shower trays, sinks, hand wash bowls and hand wash basins; sauna baths, sitz baths, spa baths; bathroom furniture; worktops and vanity units; toilet seats; installations; shelving for cooking and refrigerating appliances and installations including illuminated shelving for cooking and refrigerating appliances and installations; parts and fittings for all the aforesaid goods.

(6) Transport glass and transport windows; protective covers and coatings for transport namely covers and coatings to protect exposed surfaces such as the underside of motor vehicles; transport interiors namely panels and seats; parts and fittings for all the aforesaid goods.

(7) Book binding material; artists material namely plastics for modelling; modelling materials namely modelling polymer; adhesive for stationery and household purposes; indoor aquarium; parts and fittings for all the aforesaid goods.

(8) Synthetic resins, namely synthetic resins comprising polymer in monomers or solvent, with additives, for use in chemical reactions with solid articles; plastic film other than for wrapping purposes; materials used to caulk and seal; insulating fabrics; parts and fittings for all the aforesaid goods.

(9) Floor coverings namely floor boards and tiles; building glass and building safety glass; window louvres and panels for use in building, including such windows, louvres and panels when made of plastics or synthetic resin; aquaria structures including glazing for aquaria structures; artificial stone, cladding, facings and sidings including vinyl sidings; door frames and door panels; roof lights; signs, illuminated signs and 3-D signs; parts and fittings for all the aforesaid goods.

(10) Showcases, shelves, display shelves and sliding shelves; sign boards of wood or plastics; transport identification signs and number plates; non-metallic furniture fittings; glass, artificial glass and plastics for furniture; kitchen and bathroom furniture including worktops and vanity units; parts and fittings for all the aforesaid goods.

(11) Household, bathroom and kitchen utensils and containers namely tea and coffee pots, menu card holders; glassware namely bowls and jars; bottles, acrylic sheets and formed shapes, namely wash basins and integrated sink/countertops; and utensils, napkin holders, toilet cases, trash cans; soap dishes and towel rails; parts and fittings for all the aforesaid goods.

[3] Section 45 of the 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 goods specified in 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 such use since that

date. In this case, the relevant period for showing use is between January 31, 2011 and January 31, 2014.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Owner furnished the affidavits of Brent A. Long, sworn on November 24, 2014 and Marc Dussault, sworn on November 21, 2014. Only the Owner filed written representations and attended an oral hearing held on April 18, 2016.

The Owner’s Evidence

[7] In his affidavit, Mr. Long attests that he is the Business Director of the Owner. He explains that the Owner is a market leader of the “methacrylate monomer” market, and supplies a significant percentage of the global demand for “methyl methacrylate”. He indicates that “methyl methacrylate” is used in the production of acrylic polymers and methacrylate esters, which have a variety of industrial and commercial applications.

[8] As such, Mr. Long identifies two broad categories of goods within the statement of goods set out in the registration. He identifies the first category as “building-block” products manufactured by the Owner, which he also refers to as the “core goods”.

[9] With respect to the second category, Mr. Long explains that the core goods are used by the Owner’s industrial customers to produce a variety of “end products”. As described below, these “end products” are often consumer goods, such as bath and shower products manufactured by one of the Owner’s industrial customers, Oceania Baths.

Evidence of use with respect to the “core goods”

[10] Mr. Long identifies the following registered goods as core goods in particular:

- “chemical reagents namely methyl methacrylate” (which he refers to as Lucite Monomers) from goods (1);
- “unprocessed acrylic resin for use in manufacturing of solid shapes”, “moulding powders for use in industry”, and “resin beads” (which he collectively refers to as Lucite Resins), all from goods (1); and
- “acrylic sheets” (which he refers to as Lucite Sheets) from goods (11).

[11] With respect to the normal course of trade, Mr. Long attests that these core goods are all sold under the Mark, by or on behalf of the Owner, to industrial customers in Canada. He confirms that the Owner exercised control over the character and quality of these core goods sold during the relevant period.

[12] In support, Mr. Long attaches the following exhibits to his affidavit:

- Exhibit B consists of a Material Safety Data Sheet for “methyl methacrylate” and photographs of drums containing “METHYL METHACRYLATE - STABILIZED”. The exhibited data sheet contains various technical details for methyl methacrylate, such as ingredients list, handling information, and manufacturer information. The Mark is prominently displayed on the drum label as well as throughout the data sheet.
- Exhibit C consists of a Material Safety Data Sheet for “LUCITE ® XL” and photographs of boxes labelled as containing “LUCITE cast acrylic”. Mr. Long confirms that this

exhibit corresponds to the registered goods “acrylic sheets”. The data sheet contains various technical and product details for “LUCITE ® XL”, including a description of the product as an acrylic sheet used in a wide range of applications. The Mark is prominently displayed on the boxes as well as throughout the data sheet.

- Exhibit D consists of a Material Safety Data Sheet for “LUCITE ® ACRYLIC RESIN” and photographs of drums containing “LUCITE Solid Acrylic Resins”. Mr. Long attests that these drums contain “Lucite Resins”. The data sheet contains various technical and product details for “LUCITE ® ACRYLIC RESIN”, such as the fact that the product is an acrylic resin used in the manufacture of dental products. The Mark is prominently displayed on the drum label as well as throughout the exhibited data sheet.

As noted above, Mr. Long defines “Lucite Resins” as encompassing three of the registered goods; however, I note that he provides only the one data sheet and the exhibited photographs show only the one product, acrylic resin, in relation to such “Lucite Resins”.

- Exhibit E consists of seven “representative” invoices that show sales of the aforementioned core goods during the relevant period to customers in Canada. The Mark appears at the top of the invoice as well as in some of the product descriptions. With respect to the products listed in the first four invoices, Mr. Long identifies “MMA” as corresponding to the registered good “methyl methacrylate”. In the second invoices, Mr. Long identifies “LUCITE 6751-60 MESH” and “LUCITE 4FLG-100 MESH” as corresponding to “Lucite Resins”. However, he does not state more specifically whether these invoiced products are the registered goods “unprocessed acrylic resin for use in manufacturing of solid shapes”, “moulding powders for use in industry”, or “resin beads”. With respect the last three invoices, Mr. Long identifies the products “L” and “XL” as corresponding to the registered goods “acrylic sheets”.

Evidence of use with respect to the “end products”

[13] Mr. Long states that industrial customers use the core goods in a variety of end products, such as: organic glass; transport glass; protective covers and coatings for transport; medical and

dental items; adhesives and modeling materials for medical purposes; lighting; signs; a wide variety of household items; aquariums; laboratory goods; construction materials; and bath/shower items including baths, showers, shower cubicles and shower trays.

[14] Mr. Long confirms that the Owner's industrial customers are licensed to use the Mark. He explains that, in order to ensure optimal and consistent quality of the end products, representatives of the Owner are made available to these industrial customers. These representatives ensure "that the core goods are being properly handled and applied in the manufacture of these end products". Furthermore, he states that the Owner provides technical and usage information for the core goods, telephone "troubleshooting" assistance, and on-site visits to its industrial customers. He confirms that the Owner provided these support services to its industrial customers during the relevant period.

[15] Although Mr. Long *asserts* use of the Mark in association with a variety of end products, he does not provide any documentary evidence *demonstrating* such use with respect to any of the end products in his affidavit. Mr. Long's substantive evidence is limited to the particular "core goods" noted above. Instead, the Owner relies on the evidence of Mr. Dussault to support its broad assertion of use with respect to such end products.

[16] In his affidavit, Mr. Dussault attests that he is the president of Oceania Baths, an industrial customer of the Owner. He states that Oceania purchases "LUCITE brand-acrylic sheets" (*i.e.*, one of the aforementioned core goods) from the Owner for use in the manufacture of the end products corresponding with the following registered goods: "baths, showers, shower cubicles, shower trays". He confirms that "90%" of these bath products sold by Oceania during the relevant period were sold in association with the Mark.

[17] In this respect, Mr. Dussault first attests that, during the relevant period, the Mark appeared on Oceania's website, *www.oceania-attitude.com*, as well as throughout Oceania's print and electronic promotional materials and brochures for its aforementioned bath products.

[18] Mr. Dussault also attests that the Mark appeared on warranty and instruction documents that accompanied Oceania's bath products. He confirms that Oceania had permission from the Owner to use the Mark on these documents.

[19] Furthermore, Mr. Dussault states that during the “product selection and purchase process [Oceania’s] customers are presented with promotional and informational materials that feature the LUCITE trade-mark”. As an example of how customers used these materials, he attests that, when considering the colour of their bath products, customers reviewed the “Lucite Bath Color Selector Sheet” and/or physical samples of “LUCITE-brand acrylic” in different colors. He confirms that these promotional and informational materials were provided by the Owner and made available to Oceania’s customers in Canada during the relevant period.

[20] In support, Mr. Dussault attaches the following exhibits to his affidavit:

- Exhibit A consists of representative copies of warranty and instruction documents for Oceania’s bath products that accompany the product when they are delivered. The third and fourth pages of the English language warranty documents refer to “Lucite Cast Acrylics”. Likewise, the French language warranty documents refer to “Lucite Acrylic”.
- Exhibit B consists of two representative invoices showing sales of Oceania’s various bath products during the relevant period to customers in Canada. Mr. Dussault confirms that the various bath products listed in these invoices show sales of “baths, showers, shower cubicles, shower trays”. Although the Mark does not appear on either invoice, he attests that these products are manufactured using “LUCITE brand acrylic sheets”.
- Exhibit C consists of photographs of “color selector sheets”, coloured samples of LUCITE-brand acrylic, and a “Color Cross Reference Chart Sheet”. Mr. Dussault confirms that these materials were provided by the Owner for use by Oceania’s customers. He attests that customers used these materials to assist in the color selection of Oceania’s bath products. The Mark is prominently displayed on each of the materials.
- Exhibit D consists of copies of Oceania’s print and electronic promotional brochures and other materials for various bath products. Mr. Dussault attests that the Mark appears on some of the materials and brochures made available to customers in Canada during the relevant period. For example, the Mark appears on the “guarantee page” of Oceania’s catalogue. Another example is in Oceania’s brochure for sliding glass door showers,

where the Mark appears alongside a description of Oceania's MARELLA SERIES showers.

[21] Finally, I note that although the various "core goods" and "end products" identified by Mr. Long and Mr. Dussault encompass *some* of the registered goods, many of the registered goods are not clearly categorized as either core goods or end products.

Analysis – "core goods"

[22] As described above, Mr. Long attests that the Owner manufactures the following core goods in association with the Mark: "chemical reagents namely methyl methacrylate"; "unprocessed acrylic resin for use in manufacturing of solid shapes", "moulding powders for use in industry", "resin beads"; and "acrylic sheets".

[23] With respect to methyl methacrylate and acrylic sheets, Mr. Long's assertion that these core goods were sold in association with the Mark during the relevant period is supported in each case by the exhibited photographs and Material Safety Data Sheets of the goods. As noted above, the evidence of sales are set out in the corresponding invoices at Exhibit E of the Long affidavit.

[24] In the absence of representations from the requesting party, I am satisfied that the Owner has demonstrated use of the Mark in association with the following registered goods within the meaning of sections 4 and 45 of the Act: "chemical reagents namely methyl methacrylate" and "acrylic sheets".

[25] Otherwise, it would appear that, given Mr. Long's attempt to categorize specific goods collectively as "Lucite Resins", he asserts use with respect to each of "unprocessed acrylic resin for use in manufacturing solid shapes", "moulding powders for use in industry", and "resin beads".

[26] However, as noted above, while Mr. Long identifies Exhibit D as relating to "Lucite Resins", he does not identify the particular registered good shown in the photograph or referenced in the data sheet. Furthermore, it is not self-evident which particular Lucite Resin product or products are referenced in the Exhibit E invoice.

[27] While the product shown at Exhibit D could correspond to all three registered goods at issue, I consider both “moulding powders for use in industry” and “resin beads” as being broader than “unprocessed acrylic resin for use in manufacturing solid shapes”. In this respect, “moulding powders” and “resin beads” could encompass products that are not acrylic-based.

[28] Having distinguished these three goods in the registration, the Owner is obligated to provide some evidence with respect to each of these goods accordingly [per *John Labatt Ltd v Rainer Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)]. In reviewing the evidence as a whole, I am unable to identify any additional products that correspond with the registered goods “moulding powders for use in industry” or “resin beads”. Therefore, I find that this evidence is only sufficient to maintain the registration with respect to “unprocessed acrylic resin for use in manufacturing of solid shapes”.

[29] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “unprocessed acrylic resin for use in manufacturing of solid shapes” within the meaning of sections 4 and 45 of the Act. However, I am not satisfied that the Owner has demonstrated use of the Mark in association with “moulding powders for use in industry” or “resin beads”.

Analysis – “end products”

[30] As described above, Mr. Dussault provides evidence of how the Mark was associated with Oceania’s bath products during the relevant period. For example, the Mark appears on materials used by customers when making product selections and on product warranty documents that accompany the bath products. Furthermore, Mr. Dussault evidences sales of such bath products during the relevant period. As such, I am satisfied that the Owner has demonstrated use of the Mark by Oceania in association with “baths, showers, shower cubicles and shower trays” within the meaning of sections 4 and 45 of the Act.

[31] As to whether such use enures to the benefit of the Owner, the Federal Court has stated that there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control;

or third, by providing a copy of the license agreement that provides the requisite control [per *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248 at paragraph 84].

[32] On the facts of this particular case, and in the absence of representations from the requesting party, I am satisfied that the evidence as a whole demonstrates that the Owner exerted the requisite control required by section 50 of the Act. Consequently, in my view, the demonstrated use of the Mark by Oceania described above enures to the benefit of the Owner.

Analysis – remaining goods

[33] The Owner submits that section 45 proceedings do not require a registered owner to provide direct or documentary proof with respect to each and every good, so long as the affidavit states that the trademark is used on all of the goods and that the registered owner has supplied adequate examples from each category [citing *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FCTD)].

[34] However, this is not a case where the evidence is representative of a broader category of goods. In the present case, the Owner furnished no evidence with respect to any of the other identified “end products”, such as aquariums, signs and dental implants. Presumably, these products have their own unique channels of trade and potential means of association of the Mark.

[35] Furthermore, if the registered goods include other “core goods” not specifically identified by Mr. Long, this is not clear. To the contrary, nothing in the evidence with respect to the identified core goods suggests that it is actually representative of other such goods. As such, I am not prepared to infer that evidence with respect to the aforementioned bath products and core goods is representative of any of the remaining registered goods.

[36] Therefore, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the remaining goods within the meaning of sections 4 and 45 of the Act. Furthermore, the Owner provided no evidence of special circumstances excusing the absence of such use.

Disposition

[37] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete all of the registered goods in (2) to (4) and (6) to (10) as well as the following goods from (1), (5) and (11):

(1) Plastics in the form of suspensions or solutions for use in industrial processes, namely such plastics containing acrylic compounds; dispersion of plastics for use in manufacturing of solid shapes; unprocessed epoxy and synthetic resins; acrylic components for use in adhesive formulations, substances and materials for making adhesives; organic glass; ...; ink resins; mould release preparations and moulding preparations, moulding powders for use in industry; ... and sodium cyanide; resin beads.

(5) Light diffusers, reflectors and refractors; transport lights and cover for transport lights; display lighting; ... sinks, hand wash bowls and hand wash basins; sauna baths, sitz baths, spa baths; bathroom furniture; worktops and vanity units; toilet seats; installations; shelving for cooking and refrigerating appliances and installations including illuminated shelving for cooking and refrigerating appliances and installations; parts and fittings for all the aforesaid goods.

(11) Household, bathroom and kitchen utensils and containers namely tea and coffee pots, menu card holders; glassware namely bowls and jars; bottles, ... and formed shapes, namely wash basins and integrated sink/countertops; and utensils, napkin holders, toilet cases, trash cans; soap dishes and towel rails; parts and fittings for all the aforesaid goods.

[38] The amended statement of goods will read as follows:

(1) Unprocessed acrylic resin for use in manufacturing of solid shapes; chemical reagents namely methyl methacrylate.

(2) Acrylic sheets.

(3) Baths, showers, shower cubicles, shower trays.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

Hearing Held: 2016-04-18

APPEARANCES

Robert A. MacDonald

For the Registered Owner

No one appearing

For the Requesting Party

AGENTS OF RECORD

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Amy Croll (Croll & Co. Ltd.)

For the Requesting Party