



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

Citation: 2011 TMOB 166
Date of Decision: 2011-09-28

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Goudreau Gage Dubuc LLP against
registration No. TMA564,782 for the trade-mark OPERA
in the name of Royal Group Inc.**

[1] At the request of Goudreau Gage Dubuc LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on January 13, 2009 to Royal Group Inc. (the Registrant), the registered owner of registration No. TMA564,782 for the trade-mark OPERA (the Mark).

[2] The Mark is registered for use in association with patio doors (the Wares).

[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 wares and services 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 13, 2006 and January 13, 2009 (the Relevant Period).

[4] “Use” in association with wares is set out in s. 4(1) and s. 4(3) of the Act:

4. (1) A trade-mark is deemed to be 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 used in Canada in association with those wares.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 C.P.R. (2d) 194, aff'd (1980), 53 C.P.R. (2d) 63 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], 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 wares or services specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Registrant furnished the affidavit of Jacques L'Estage, Regional Marketing and Communications Manager of the Registrant, sworn July 9, 2009. Both parties filed written submissions and attended an oral hearing held on May 3, 2011.

[7] In his affidavit, Mr. L'Estage attests that the Registrant manufactures and markets home improvement, building and construction products relating to the following general product categories: custom profiles and window and door systems, outdoor products, pipes and fittings, mouldings and millwork, and siding and accessories. Mr. L'Estage states that the Registrant's window and door systems division is known as RoyalPlast.

[8] Mr. L'Estage explains that after the Mark was registered on July 16, 2002 by Thermoplast Inc., by reason of a merger between Thermoplast Inc. and Royal Quebec Custom Limited, ownership of the Mark was transferred to the latter on October 1, 2002. As a result of a corporate name change, the Mark came under the ownership of Royal Group Technologies (Quebec) Inc. and was subsequently assigned to the Registrant in September 2006.

[9] With respect to the normal course of trade, Mr. L'Estage states that the Registrant's RoyalPlast division sells its patio doors to door and window manufacturers, home improvement centres and lumber yards across Canada and the United States. Mr. L'Estage states that a

product sticker displaying the Mark is affixed on the patio doors prior to shipment. In support of this statement, he produces as Exhibit B a photograph of a patio door bearing a product sticker along with a copy of the product label that is placed on the doors. Mr. L'Estage also states that the Mark is affixed on the protective packaging for the patio doors, although no supporting evidence was provided in this regard. Finally, Mr. L'Estage states that an installation manual bearing the Mark, attached as Exhibit C, is also included with all OPERA patio doors.

[10] As proof of sales of the Wares, Mr. L'Estage provides sales sheets as Exhibit D showing the Registrant's patio door sales in Canada and the United States for 2006 to 2008 and attests that gross sales figures in Canada for OPERA patio doors were as follows: 2006 - \$562,000; 2007 - \$1,670,800; 2008 - \$934,700. Mr. L'Estage also attaches representative invoices as Exhibits E and F, showing sales of the Wares in Canada and the United States, respectively, during the Relevant Period. I note that at the top of each invoice, Royalplast's address appears next to a logo which includes the statement "A division of Royal Group Inc." in small print underneath what appears to be another trade name, "Royal Window and Door Profiles".

[11] In its written submissions, the Requesting Party argues that the evidence does not show that the Mark was used in association with the Wares at the time of transfer. In particular, they submit that the Mark cannot be seen on the photograph at Exhibit B and it is unclear whether the installation manual is provided with the Wares at the time of transfer. Although the Exhibit B photograph is not very clear, and part of the word OPERA is hidden by a product information sticker, I note that the Mark does appear on the patio door in the same font and style as it appears on the manual cover at Exhibit C. Furthermore, although the Requesting Party questioned Mr. L'Estage's statement regarding the inclusion of the installation manuals in paragraph 11 of his affidavit, in the context of the affidavit as a whole, in particular after having described the normal course of trade in paragraphs 9 and 10, I am satisfied that the Registrant has furnished evidence that the Mark appeared on the Wares directly and on the manual included with the Wares at the time of transfer.

[12] In the alternative, the Requesting Party submits that if any evidence of use has been shown, such use does not enure to the benefit of the Registrant pursuant to s. 50(1) of the Act. Section 50(1) of the Act provides as follows:

50(1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

[13] Where evidence of use of the trade-mark is submitted in a s. 45 proceeding, it must be shown that it was the registered owner or a licensee, whose use of the mark accrues to the benefit of the registered owner, who used it [see e.g. *The House of Kwong Sang Hong International Ltd v. Borden Ladner Gervais*, 31 C.P.R. (4th) 252 (F.C.); *Tucumcari Aero, Inc v. Cassels, Brock & Blackwell LLP*, 2010 F.C. 267, 81 C.P.R. (4th) 372 (F.C.)].

[14] The Requesting Party submits that the evidence is ambiguous regarding the source of the Wares as there are multiple commercial names for the sender on the invoices. In addition, they submit that the evidence shows that RoyalPlast has multiple Canadian addresses, none of which match the address on the register for Royal Group Inc., which is located in the United States. Consequently, they submit that the invoices suggest that the Mark is being used by a Canadian company named RoyalPlast, rather than by the Registrant, an American company.

[15] In response to these alleged deficiencies, the Registrant submits in their written arguments that “the fact that the Registrant has chosen to structure itself with divisions has no effect on the use of the Trade-mark” and “it is clearly a trite point that companies often have more than one office or commercial location in the world and that different addresses may be used in association with their businesses.” Furthermore, at the oral hearing, the Registrant stated that RoyalPlast, as a division of the Registrant, does not form a separate legal entity from the Registrant. I note that in his affidavit, Mr. L’Estage states that “Royal’s door and window system division is also known as RoyalPlast.” While it may have been preferable if Mr. L’Estage had explicitly stated that this division was not a separate legal entity from the Registrant and was also referred to as “Royal Window and Door Profiles” (as shown on the invoices), I do not consider this to be a case where section 50 is applicable. While the Requesting Party has dissected the evidence for apparent inconsistencies, I note that in the context of a section 45 proceeding, the evidence as a whole must be considered and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v. Compute (Bridgend) Limited* (2005),

47 C.P.R. (4th) 209 (T.M.O.B.)] Having reviewed the evidence as a whole, I find it reasonable to conclude that the use of the Mark shown was by the Registrant directly and not by an unlicensed separate entity, as suggested by the Requesting Party.

[16] Consequently, I am satisfied that the Registrant has evidenced use of the Mark in association with the Wares within the meaning of s. 45 and s. 4 of the Act during the Relevant Period.

[17] Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

Darlene Carreau
Chairperson
Trade-marks Opposition Board
Canadian Intellectual Property Office