

**SECTION 45 PROCEEDING
TRADE-MARK: SUPER-E
REGISTRATION NO.: TMA 350,798**

On August 1, 1999, at the request of MacRae & Co., the Registrar forwarded a Section 45 notice to Western Profiles Limited, the registered owner of the above-referenced trade-mark registration.

The trade-mark SUPER-E is registered for use in association with the following wares: (1) Windows (2) Weatherstripping.

In response to the notice, the affidavit of Fred Wall together with exhibits has been furnished. Each party filed a written argument. An oral hearing has not been requested in this case.

In his affidavit, Mr. Wall states that the trade-mark is used, and has at all material times during the relevant period been continuously used by the registrant in association with weatherstripping by being prominently displayed on packing slips which accompany and are shipped with the wares. As Exhibit A he attaches representative samples of said packing slips, which he states demonstrates how the trade-mark was used in association with weatherstripping.

Concerning the wares "windows" he states that the registrant manufactures, and has continuously since 1987 manufactured, vinyl extrusions and various window components including window frames and window sashes in association with the trade-mark. Since 1987, the registrant has supplied its SUPER-E window components to Humphrey Products of Winnipeg Ltd., for assembly of windows and window systems sold by such company under the trade-mark SUPER-E, who sells the windows to dealers who distribute the windows at the retail level to consumers in Canada. He explains that the dealers enter into written contracts of purchase and sale with each ultimate Canadian consumer and said contracts prominently feature the trade-mark. As Exhibit B, he encloses representative samples of said contracts. As Exhibits C and D, he attaches representative samples of invoices and he states that total sales by Humphrey of SUPER-E windows in Canada between August 16, 1996 and August 16, 1999 totaled in excess of \$5

million (Cdn.). He specifies that the use of the trade-mark by Humphrey has been under license by the registrant and the registrant has controlled the character and quality of the windows assembled and sold by Humphrey in association with the trade-mark. He adds that during the relevant period, his company and/or Humphrey has extensively advertised the wares to dealers, retailers and prospective customers, said advertising comprising of flyers, brochures, signage for displays, and promotional items such as coffee warmers, hats and t-shirts. As Exhibit D, he encloses a number of brochures and flyers used during the relevant period, as Exhibit E he submits a photograph of a display and signage used by a dealer and retailer and as Exhibit F he provides representative samples of promotional items.

Concerning the wares “weatherstripping”, I agree with the requesting party that the packing slips (Exhibit A) do not bear the trade-mark “SUPER-E” but only the letters “SE” in the following combinations “WWIN - SE - F1072”, and “HUMP - SE - F1072”. As Mr. Wall has indicated that the packing slips represent the manner the trade-mark was associated with the wares at the time of transfer of the wares in the normal course of trade, I conclude that the evidence fails to show use of the trade-mark SUPER-E as none of the packing slips bear the trade-mark “SUPER-E” as registered, and as none of the above-mentioned combinations, in my view, can be said to constitute use of the trade-mark SUPER E. Consequently, I conclude that the wares “weatherstripping” ought to be deleted from the registration. I would add, that although one of the flyers in Exhibit D shows the trade-mark SUPER-E in association with “doorsweeps” which Mr. Wall indicates in paragraph 4 of his affidavit equate to weatherstripping, this consists of advertising of the trade-mark and advertising alone is insufficient to comply with the provisions of Section 4(1) of the Act.

Concerning the wares “windows”, I am satisfied that the evidence is sufficient to permit me to conclude that the trade-mark “SUPER-E” was being used in association with such wares during the relevant period. The written contracts attached as Exhibit B between the dealer of the wares and the ultimate consumers, clearly show that the customer is made aware that it is purchasing windows associated with the trade-mark SUPER-E. In particular, the contract dated June 23, 1998 bears the trade-mark SUPER “E” together with the words “PVC windows” and from the

contract itself it is clear that such windows were purchased. Although the mark as used thereon omits the hyphen, such omission consists of a minor variation of the mark as registered and, in my view, is not apt to deceive or injure the public in any way.

The other contracts and the brochures refer to the trade-mark SUPER-E together with a four digit number, namely 3000. Mr. Wall has indicated in paragraph 11 of his affidavit that such number connotes a particular model of SUPER-E windows. I am prepared to accept his explanation concerning the four digit number and I am prepared to infer that the four digit number could be perceived as such, namely as a reference to a particular model of "SUPER-E" window. I note that the display and signage at one of the dealers (Exhibit E) clearly refer to the trade-mark "SUPER-E" per se. This would seem to support Mr. Wall's allegation that the four digit number "3000" as used with the trade-mark is a reference to a particular model.

As Mr. Wall has indicated that total sales of SUPER-E windows between August 16, 1996 and August 16, 1999 totaled in excess of \$5 million dollars, I conclude that sales of windows in the normal course of trade associated with the trade-mark in the manner required by Section 4(1) of the Trade-marks Act were made during the relevant period. I am also satisfied that the trade-mark shown to be in use constituted use of the registered trade-mark.

In view of the evidence furnished, I conclude that the trade-mark registration ought to be amended so that the statement of wares will read "windows".

Registration No. TMA 350,798 will be amended accordingly in compliance with the requirements of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF January, 2001.

D. Savard
Senior Hearing Officer
Section 45