



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

Citation: 2011 TMOB 74
Date of Decision: 2011-04-27

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Adrian Brooks carrying on business as AB
Technology Group against registration No. TMA233,364
for the trade-mark FLAME-GARD in the name of
Ranpro Inc.**

[1] At the request of Adrian Brooks carrying on business as AB Technology Group (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 July 28, 2009 to Ranpro Inc., the registered owner (the Registrant) of registration No. TMA233,364 for the trade-mark FLAME-GARD (the Mark).

[2] The Mark is registered for use in association with the following wares: (1) flame retardant garments.

[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 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 July 28, 2006 and July 28, 2009 (the Relevant Period).

[4] The relevant definition of “use” in association with wares is set out in subsection 4(1) of the *Trade-marks 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.

[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 Chris Ransome, Vice-President of Marketing of Ranpro Inc., sworn October 20, 2009, together with Exhibits 1 through 17. Both parties filed written submissions; an oral hearing was not held.

[7] In his affidavit, Mr. Ransome attests that during the Relevant Period, the Registrant sold fire retardant garments in association with the Mark in Canada. Attached as Exhibit 6 are photographs of fire retardant coats, jackets and pants. Included in these photographs are photographs of the labels sewn into such garments. Exhibit 5 consists of photocopies of such labels, a selected example of which is reproduced below:



[8] I note that FLAME-GARD appears in two places on each of the labels; in addition to “Ranpro Flame-Gard®” appearing near the top of each label, FLAME-GARD® alone is prominently displayed in a stylized font against a background letter “R” and stylized globe design. Although perhaps not apparent in the reproduction above, it is clear, from the evidence filed, that the ® symbol appears after the instance of FLAME-GARD alone. I also note the Registrant’s website address, *www.ranpro.com*, appears at the bottom of each label.

[9] Mr. Ransome attests that these garments are representative of the garments sold by the Registrant during the Relevant Period, and identifies each of the garments by a product style number. As proof of sales of these garments, Mr. Ransome attaches at Exhibits 7, 8 and 9 sample invoices that appear to list various coats, pants and jackets with corresponding product style numbers, all of which are dated within the Relevant Period. From a review of the invoices, it can be concluded that the normal course of trade of the registrant’s business is to sell fire retardant garments to distributors and end users with the labels sewn into the garments. Accordingly, I am satisfied that the invoices provided demonstrate sales of the wares from the Registrant to various companies in Canada during the Relevant Period. Mr. Ransome also provides sales figures of these garments for the period between January 1, 2009 and July 28, 2009 as follows: coats, 1314 units sold, total revenue \$82,601; pants, 6920 units sold, total revenue \$338,054; and jackets, 7158 units sold, total revenue \$604,214.

[10] The Requesting Party disputes whether the evidence demonstrates use of the Mark as registered, submitting that the mark displayed is “Ranpro Flame-Gard”, rather than “Flame-Gard”. Mr. Ransome attributes the difference to an ordering error on the part of Ranpro when it placed the order for the labels with the printer. Notwithstanding the printing error, the Registrant submits that such usage constitutes use of the Mark as registered.

[11] In support of its position, the Registrant cites as authority *A.W. Allen Ltd. v. Canada (Registrar of Trade Marks)* (1985), 6 C.P.R. (3d) 270 (F.C.T.D.). In that case, the court considered whether evidence of use of the trade-mark COOLMINT in conjunction with the trade-mark HALLS (displayed as HALLS COOLMINT) was sufficient to maintain the mark COOLMINT in the section 44 (now section 45) proceeding. The court upheld the Registrar’s decision to maintain the mark on the Register, noting that “the law is also quite clear that there is nothing to prevent two registered trade marks being used at the same time”.

[12] The Registrant also cites *Mantha & Associates v. Old Time Stove Co. Inc.* (1990) 30 C.P.R. (3d) 574 (T.M.O.B.) and *Comstock Ltd. v. Commodity Quotations Inc.* (1997) 83 C.P.R. (3d) 240 (T.M.O.B.). In *Mantha & Associates*, the Hearing Officer considered the use of the registered mark BEAUMONT in conjunction with other words designating sub-brands of the Beaumont line of products (for example BEAUMONT CHALET) to be the use of two different marks, and maintained the registration for BEAUMONT. Similarly, in *Comstock Ltd.*, the Opposition Board found that usage of S&P COMSTOCK was actually usage of two different trade-marks. In reaching its conclusion, the Opposition Board distinguished that case from *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984) 2 C.P.R. (3d) 535 (T.M.O.B.), noting that S&P appeared to be the applicant’s house mark and trade name. As well, it also did not consider *Registrar of Trade-marks v. Compagnie Internationale pour l’Informatique CII Honeywell Bull SA* (1985) 4 C.P.R. (3d) 523 (F.C.A.) to be applicable, as *CII Honeywell Bull* considered a composite mark whereas S&P COMSTOCK was a case of two different marks.

[13] Applying the reasoning of the above cases to the present situation, I am satisfied that the average consumer on seeing the label would understand that “Ranpro” is either the Registrant’s house mark or trade name and thus view FLAME-GARD as a mark separate from “Ranpro”.

This is further emphasized by the fact that “Ranpro” appears without FLAME-GARD on the label as part of the Registrant’s website address. In short, the word FLAME-GARD appears twice, once with the word “Ranpro”, and once without it, in a stylized font as its own distinctive element in front of the stylized “R” and globe design. Whether or not FLAME-GARD could also be considered part of an overall design mark incorporating the stylized “R” and globe design is not a relevant consideration in these proceedings, as, in any event, I am satisfied that FLAME-GARD alone is a dominant feature, and furthermore that the ® symbol clearly relates to the FLAME-GARD portion.

[14] Accordingly, 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(1) of the Act during the Relevant Period.

[15] In view of the findings above, it is unnecessary to discuss the rest of the evidence or to consider whether special circumstances existed that would excuse non-use of the Mark.

[16] 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.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office