



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

Citation: 2011 TMOB 106
Date of Decision: 2011-06-23

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Plastibec Inc. against registration
No. TMA660,594 for the trade-mark WOOD TRENDS in
the name of Newell Window Furnishings, Inc.**

[1] At the request of Plastibec Inc. (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 Newell Window Furnishings, Inc., the registered owner (the Registrant) of registration No. TMA660,594 for the trade-mark WOOD TRENDS (the Mark).

[2] The Mark is registered for use in association with the following wares: (1) Decorative curtain and drapery hardware, namely cafe rods, curtain rods, drapery rods, traverse rods, decorative non-metal finials, non-metal rings and non-metal mounting brackets for the foregoing; roller shades for windows.

[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 May 11, 2006 and May 11, 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 Mike Muyal, Director of Marketing of Newell Window Furnishings, a division of Newell Industries Canada, Inc., sworn November 9, 2009. Only the Registrant provided written submissions; an oral hearing was not held.

[7] In his affidavit, Mr. Muyal attests that Newell Industries Canada, Inc., through its division Newell Window Furnishings (NWF Canada), is an importer and distributor of a wide variety of window furnishing products manufactured by or for the Registrant. Mr. Muyal states that these products include the wares as registered, with the exception of “roller shades for windows”, for which no evidence of use was furnished and no assertion of use was made by the Registrant. Accordingly, the registration will be amended to delete the wares “roller shades for windows”. For purposes of this decision, the remaining wares are identified below as the Wares.

[8] Mr. Muyal explains the normal course of trade for the Wares, namely that they are primarily sold by NWF Canada to distributors who in turn sell them to persons in the interior design field (such as interior designers, decorators and specialized design retailers) for use in design projects for their individual customers. Mr. Muyal indicates that NWF Canada has a group of approximately 12 distributors in the interior design field, who in turn have thousands of designers who order and purchase the Wares as needed for their customers. Sales are made through the use of catalogues and price lists that display the Wares; these catalogues and price lists are either provided to distributors by NWF Canada or NWF Canada allows text and pictures from their catalogues to be reproduced in distributors' own catalogues. Designers use the catalogues to place orders for their customers with their respective distributor, who in turn order the product(s) from NWF Canada.

[9] Mr. Muyal provides numerous exhibits in support of the Registrant's assertion of use of the Mark during the Relevant Period:

- Exhibit A is a copy of a price list entitled "2009 Full-line Canadian Price List/Index", effective as of January 2009. Products are listed by part number, with a description and pricing information. I note that the Mark does not appear in the price list.
- Exhibit B is a copy of the Registrant's catalogue entitled "WOOD TRENDS Decorative Drapery Catalogue", published in October 2007. Here the Mark appears throughout the catalogue to refer to the drapery hardware products found in the catalogue. On a review of these products in conjunction with the affiant's description of same, I find that they appear to be consistent with the aforementioned Wares.
- Exhibit C is a copy of excerpts from the Registrant's catalogue entitled "2" Decorative Traverse Rod" published in 2008. The Mark appears at the top of pages in a portion of the catalogue with product listings for various wood poles and drapery hardware components, which also appear to be consistent with the Wares.

- Exhibit D is a copy of catalogue excerpts from one of the Registrant's Canadian distributors, published in 2009. Again, the Mark appears at the top of some pages listing drapery hardware components, which appear consistent with the Wares.
- Exhibit E is copies of sample invoices showing sales of the Wares in Canada in April 2009 to various distributors. From the brief product descriptions in the invoices it appears that they refer to the Wares; I note that the Mark does not appear on the invoices. The Registrant's distributor, NWF Canada, is identified in a box labelled "Please Remit To" at the top right of each invoice.
- Exhibit F: a comprehensive sales summary of WOOD TRENDS products in Canada from January 1, 2009 to October 31, 2009, showing a total sales figure of \$118,296.49. The products listed appear to be consistent with the Wares.

[10] I note that although the Mark does not appear on the Wares or the packaging, the Mark does appear in each of the three catalogues at Exhibits B, C and D in close proximity to the listings of the Wares. Furthermore, although the Mark does not appear on the price list or the invoices, the invoices do show product codes that Mr. Muyal identifies as corresponding to the product codes for the relevant WOOD TRENDS products found in the aforementioned catalogues. As such, the present circumstances appear similar to *Lapointe Rosenstein v. Elegance Rolf Offergelt GmbH* (2005), 47 C.P.R. (4th) 196 (T.M.O.B.), wherein the Hearing Officer accepted that notice of association between the trade-mark and the wares was made when customers placed orders by way of a catalogue that displayed the trade-mark in close proximity to the wares, and that notice of association continued when the wares were delivered and invoices received [see also *Swabey, Ogilvy Renault v. Miss Mary Maxim Ltd.* (2003), 28 C.P.R. (4th) 543 (T.M.O.B.)]. The Hearing Officer made this conclusion notwithstanding that the Mark did not appear on certain wares or subsequent invoices, since consumers could compare the style/product number appearing on the invoices with the style/product number of the wares ordered from the catalogues.

[11] In the present case, at paragraphs 24 to 27 of his affidavit, Mr. Muyal identifies certain product numbers found on a selection of the Exhibit E invoices that correspond to the product numbers found in the catalogues with respect to each of the Wares. Having considered the nature and channels of the Registrant's trade and the aforementioned jurisprudence, I am satisfied that sufficient notice of association between the Mark and the Wares has been demonstrated by the Registrant.

[12] Given the foregoing, I am satisfied that the Registrant has evidenced use of the Mark within the meaning of s. 45 and s. 4(1) of the Act in association with the wares as registered, with the exception of "roller shades for windows" as noted above.

[13] Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete "roller shades for windows" from the statement of wares in compliance with the provisions of s. 45 of the Act.

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