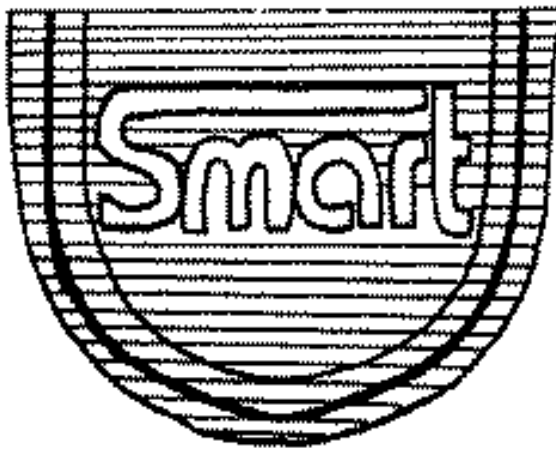


**SECTION 45 PROCEEDINGS**  
**TRADE-MARK: SMART & Design**  
**REGISTRATION NO.: 228187**

On October 31<sup>st</sup>, 2002 at the request of Kryton Holdings Inc., the Registrar forwarded a s 45 notice to ICI Canada Inc., the registered owner of the above-referenced trade-mark registration and hereinafter reproduced:



(the "Mark")

The registration for the Mark includes a claim for colour that reads as follow:

“Drawing is on a navy blue background, the letters SMART are white and the middle line on the outside is gold and the other two lines are light blue.”

The Mark is registered for use in association with the following wares: “paints and varnishes”.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (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/or services listed on 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 use since that date. The relevant period in this case is any time between October 31<sup>st</sup>, 1999 and October 31<sup>st</sup>, 2002.

In response to the notice, the affidavit of Chris J. Kosmala together with exhibits has been furnished. Both parties filed written submissions. Subsequently, the Registrar, by decision dated November 10, 2005, granted leave to the registered owner to file the affidavit of Jennifer L. Morton together with Exhibit A to her affidavit as additional evidence. No oral hearing was requested.

Mr. Kosmala is the Senior Colour Services Manager for the registered owner of the Mark. He states that the registered owner acquired the Mark by way of assignment from 3460640 Manitoba Inc., the prior owner, and such assignment was recorded on May 27, 2002 on the register. Beginning in August 2002, the recorded owner sold four types of interior acrylic paint in association with the Mark, and provided the number of units sold during the period of August to October 2002 for each type of paint.

The registered owner sells its paints to retailers such as Reno-Depot Inc and the Building Box. Black and white copies of photographs of three (3) paint containers bearing the Mark have been filed. There were also produced sample invoices issued by the registered owner during the relevant period to Reno-Depot Inc to evidence the sale of paint bearing the Mark. Finally he alleges having filed as Exhibit C to his affidavit colour copies of paint labels bearing the Mark currently used by the recorded owner of the Mark. He states that those labels bearing the Mark

are representative labels used in August, September and October 2002, in association with paint products. However, the exhibit in question was not a colour copy of those labels but a black and white version.

The requesting party, in its written submissions did raised the following issues:

- a) The exhibits are all black and white copies of labels and therefore there is no evidence of use of the Mark as registered since the Mark does include a colour claim.
- b) Notwithstanding the issue of colours, the evidence shows that the trade-mark used is not the Mark as “...the number, width and representation of the lines making up the borders of the marks are different. The registered mark is u-shaped with three lines bordering the side and bottom portion of the mark. The outer most and inner most lines are of the same width and are relatively thicker than the line in between them. Whereas the mark as allegedly used includes five lines encompassing all side of the mark. The lines are of different width with the outer line being thicker than the inner most line.”

The Morton affidavit, filed after the production of the requesting party’s written arguments, cures the defect raised in sub-paragraph a) above as the affiant did filed into the record colour copies of the labels bearing the Mark. The requesting party maintains however its second argument described above.

First, I wish to point out that there has been no allegation or evidence of use of the Mark with respect to varnishes. As such, the statement of wares in the registration ought to be amended to delete “varnishes”.

As for the second argument raised by the requesting party, I agree with the registered owner of the Mark. The trade-mark appearing on the photographs attached to the Morton affidavit is not substantially different from the Mark. The “U” shape of the design and the tiny deviations or miniscule differences in the thickness of the border lines on the shield are not as such to likely deceive the public in any way as to the source of the wares [See *Promafil Canada Ltee v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 and *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535].

Having considered the evidence, I am satisfied that the registered owner has established use of the Mark within the meaning of s. 4 of the Act in association with “paints”. Therefore the statement of wares in the registration ought to be amended to read: “paints”.

Registration No. 220,469 will be amended accordingly in compliance with the provisions of s. 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 11<sup>th</sup> DAY OF JULY 2006.

Jean Carrière

Member, Trade-marks Opposition Board