

SECTION 45 PROCEEDINGS
TRADE-MARK: PEER
REGISTRATION NO.: 351,430

On July 23, 1999, at the request of Peerdirect Inc., the Registrar forwarded a Section 45 notice to The Peer Group Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark PEER is registered for use in association with the following wares: computer software.

In response to the notice, the affidavit of Robert Harris together with exhibits was furnished. The registrant alone filed a written argument. An oral hearing has not been requested in this case.

In his affidavit, Mr. Harris states that since 1992, the registrant has been in the business of designing, marketing and selling automation control and information management computer software in the field of manufacturing, and providing consultation, installation and maintenance services related to said computer software. As Exhibit A he attaches a copy of three pages printed from the web page of the registrant illustrating the nature of the products and services offered. He indicates that the present registrant, The Peer Group Inc., purchased all rights, title and interest in and to the trade-mark PEER on December 3, 1996 and that since that time it has been using the trade-mark PEER in Canada in association with computer software and sold computer software contained on diskette, and on CD-ROM and also delivered software electronically via the internet. The registrant has sold the wares to manufacturers within Canada including Toyota Motor Manufacturing Inc., and Guelph Products. As Exhibit C, he attaches a sheet of labels displaying the PEER trade-mark which he states are identical to the labels which were attached to the diskettes when sold in Canada during the relevant period and as Exhibit D, he submits a copy of a label attached to the diskette containing the software sold to Toyota Motors Manufacturing Inc. during the relevant period. As Exhibit E, he provides a copy of the invoice to Toyota Manufacturing Inc. and in paragraph 7 of his affidavit, he provides sales figures for computer software sold in Canada in association with the trade-mark PEER for the years 1997 to 1999.

It is clear from the evidence furnished that the registrant sold computer software in Canada during the relevant period. It is also clear that at the time of transfer of the wares, during the relevant period, a label of the type provided in Exhibits C and D was affixed to the software.

I note that the trade-mark "PEERGROUP" is the trade-mark that appears most prominently on the labels. Nevertheless, the word PEER "per se", followed by the ® symbol also appears thereon albeit in a smaller format. In my view, as the word PEER "per se" appears on the label and is clearly identified as being a registered trade-mark, it is quite probable that it would be perceived as such by the public. Consequently, I conclude that the evidence shows the trade-mark PEER was associated with the wares at the time of their transfer in the normal course of trade and that the notice required pursuant to Section 4(1) of the Act was given to the purchaser of the wares. Concerning the fact that more than one trade-mark is being used on the label, the law is quite clear that there is nothing to prevent two trade-marks being used at the same time (*A.W. Allen Ltd. v. Warner-Lambert Canada Inc.*, 6 C.P.R. (3d) 270).

In view of the evidence furnished, I conclude that the trade-mark registration ought to be maintained.

Registration No. 351,430 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT HULL, QUEBEC, THIS 18th DAY OF APRIL 2001.

D Savard
Senior Hearing Officer
Section 45 Division