



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

**Reference: 2013 TMOB 177**  
**Date of Decision: 2013-10-16**  
**TRANSLATION**

**IN THE MATTER OF A SECTION 45 PROCEEDING,  
requested by ThelmaPI Investigations against  
Registration No. TMA670638 for the trade-mark  
PHILIPPE DAGENAIS DESIGNER and Drawing in the  
name of Philippe Dagenais Designer Inc.**

[1] This decision relates to a summary expungement procedure concerning registration TMA670638 for the PHILIPPE DAGENAIS DESIGNER and Drawing trade-mark (copied below) (the Mark).



PHILIPPE DAGENAIS DESIGNER

[2] On April 13, 2011, at the request of ThelmaPI Investigations (the Requesting Party), the registrar sent the notice stipulated in Section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Philippe Dagenais Designer Inc. (the Registrant), registered owner of the above-mentioned registration. This notice enjoined the Registrant to show that the Mark had been used in Canada, at any given time between April 13, 2008 and April 13, 2011 (the Relevant Period), in association with each of the wares and each of the services specified in the registration, i.e. the wares and services described in the appendix hereto.

[3] It is well established that the purpose and scope of Section 45 of the Act is to provide a simple, summary and expeditious procedure for clearing the register of “deadwood.” Although

the applicable test is not very demanding and an overabundance of evidence is not necessary, sufficient facts must be presented to enable the registrar to conclude that the trade-mark has been used in association with each ware or service mentioned in the registration during the Relevant Period [*Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 CPR (4th) 270 (CF)]. Mere claims of use are insufficient [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 CPR (2d) 62 (FCA)].

[4] In reply to the registrar's notice, the Registrant submitted a statutory declaration by its president, Philippe Dagenais, dated June 22, 2011. The Registrant alone submitted written representations. Although each party was represented at the hearing, the Registrant made no representation at the time, submitting written representations to the file.

[5] Considering in greater detail the evidence submitted by the Registrant, I agree with the Requesting Party that Mr. Dagenais' statutory declaration proves insufficient to show use of the Mark during the Relevant Period in association with the wares and services described in the registration.

[6] Section 4 of the Act defines use in association with wares and services as follows:

(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property 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.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] This brings me to review Mr. Dagenais' statutory declaration in light of the parties' representations.

[8] Mr. Dagenais states that the Registrant has used and is using the Mark in association with each of the categories of wares and services described in the registration. In this regard, he uses the identifiers "M1" to "M5" and "S1" to "S4" as follows to refer to these categories:

Wares

M1: Bedroom furniture

M2: Dining room furniture

M3: Kitchen furniture

M4: Living room furniture

M5: Decorative objects, specifically dishes, flatware and kitchen utensils, household linen, bed linen, drawings, sculpture and signs.

Services

S1: Interior design

S2: Furniture design

S3: Decorative objects design

S4: Architectural detail design, interior decoration and general design, comprising or not, in regard to all of these services, plans and mock-ups, and/or residential or commercial remodeling services

[9] He continues his declaration in stating that proof of this use is provided in the form of attachments to the latter, which are described in a table. More specifically, this table refers to Exhibits P-3 to P-18.

[10] Before commenting in detail on each of these exhibits separately, I would like to rule on the issue of knowing whether the overall use (copied below) shown is equivalent to use of the Mark as registered or rather to use of the Registrant's company name, as claimed by the Requesting Party.



PHILIPPE DAGENAI'S DESIGNER INC.

Habitat 67, 2600 Pierre Dupuy suite 237 Montréal, Québec, H3C 3R6  
Tél.: 514 875 1360 Fax.: 514 875 1316

Use as a trade-mark versus use as a company name

[11] The issue of determining whether use as a trade name can also be considered as use as a trade-mark depends on the circumstances specific to each case [*Road Runner Trailer Manufacturing Ltd. v. Road Runner Trailer Co.* (1984), 1 CPR (3d) 443 (CF 1st inst)]. Also, “trade-mark and trade-name usage are not necessarily mutually exclusive” [*Consumers Distributing Company Limited v. Toy World Limited*, 1990 CarswellNat 1398 (TMOB)].

[12] In this case, the nominal portion of the Mark made up of the words “PHILIPPE DAGENAIS DESIGNER” appearing on all exhibits P-3 to P-18 is always followed by the abbreviation “INC.” and then by the Registrant’s address. The Mark appears on none of these exhibits in isolation. The use shown above represents the sole and only reference whatsoever to the Registrant found in these exhibits. Furthermore, such use is always positioned at the bottom of the invoices or plans discussed below. Although the Registrant’s address appears in a smaller font, the fact remains that the nominal portion of the Mark is not separated as such from the abbreviation “INC.” At most, the graphic portion of the Mark is separated, which comprises a drawing of a stylized square and can be perceived as a mark in itself distinct from the Registrant’s company name appearing below with its contact information.

[13] In this, I agree with the Requesting Party that this case bears similarity to the *Bereskin & Parr v. 1082205 Ontario Ltd.* (2002), 19 CPR (4th) 103 (TMOB); *Cartem Inc. v. Souhails Renaissance Inc.* (1982), 60 CPR (2d) 1 (CF 1st inst); and *Sunny Fresh Foods Inc. v. Sunfresh Ltd.* (2004), 30 CPR (4th) 118 (TMOB) cases cited by the latter (to name just a few) in which the shown use was deemed to be as a company name only and not a trade-mark.

[14] To conclude on this point, I believe that the shown use is not equivalent to use of the Mark as registered, but rather use of the Registrant’s company name.

[15] Although this conclusion is sufficient to dispose of this file, I would like to add the following comments concerning the evidence submitted.

Use of the Mark in association with the wares

[16] As stressed by the Requesting Party, the table describing the exhibits in Mr. Dagenais' statutory declaration refer to none of the wares described under identifier "M3," i.e. kitchen furniture.

[17] In its written representations, the Registrant submits that "although having in the past regularly used [sic] the Mark in association with this category of wares, the vagaries of contracts received from the clientele did not give it the opportunity to sell this category of wares during the [Relevant Period]."

[18] Such an explanation should have been provided by the deponent. In the absence of evidence to this end, I cannot subscribe to the Registrant's argument.

[19] Considering now the wares described under identifiers M1, M2, M4 and M5, the table refers us to various invoices, i.e.:

- P-3: copy of an invoice dated March 10, 2009 referring to the "Lac Sacacomie Hotel spa" concerning the sale of "10 Monaco fabric armchairs for the spa." This documentary evidence is ambiguous to say the least. As stressed by the Requesting Party, although the table associates this invoice to wares M1, M2 and M4, it is impossible in fact to associate these 10 armchairs to one or other of these categories. Furthermore, as the description of armchairs on the invoice does not refer to the Mark, there is no indication regarding the extent to which the latter in fact bore the Mark. Moreover, as discussed below, the evidence gives the impression that the Registrant sells armchairs under marks other than the Mark. Also, there is no indication provided as to whether this invoice accompanied the wares at the time of transfer or taking possession. [*Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000), 8 CPR (4th) 471 (CF 1st inst)];
- P-4: Copy of an invoice dated March 19, 2010 referring to the "Remodeling and decoration of suites #231, 233, 303 " project at the same hotel concerning sofas and armchairs as well as fabrics. The same comments as those for P-3 apply.

- P-5: Copy of an invoice dated November 15, 2010 referring to a private home concerning the sale of “six yards of semi-transparent white kitchen fabric Ref. 10040.” As pointed out by the Requesting Party, although the table associates this invoice with wares M5, the fabric is not included in any of the “sub-categories” of wares described under M5; and
- P-16, P-17 and P-18: copies of invoices sent to individuals concerning the sale of an “Aly sofa – 2-seater in blue-gray suedette” (invoice P-16 dated September 2, 2009); a “Milano sofa” and two “Oméga armchairs” (invoice P-17 dated June 5, 2009) and an “Oméga lounge armchair in 7791 greyish brown” (invoice P-18 dated September 11, 2009). As pointed out by the Requesting Party, these invoices appear to suggest that these are the marks under which this furniture was sold. Moreover, there is no indication provided as to whether these invoices accompanied the wares at the time of transfer or taking possession.

[20] These ambiguities or shortcomings in the Registrant's evidence must be interpreted against the Registrant [*Plough (Canada)*, cited above; and *Diamant Elinor Inc. v. 88766 Canada Inc.* (2010), 90 CPR (4th) 428 (CF)]. In this regard, it should be recalled that under this procedure the Requesting Party cannot cross-examine the deponent.

[21] Accordingly, even if I had concluded that the use shown above was in fact use of the Mark as registered, all of the wares would have been expunged from the registration.

Use of the Mark in association with the services

[22] Considering now the services described under identifiers S1, S2, S3 and S4, the table included in Mr. Dagenais’ statutory declaration refers us to the following exhibits:

- P-6: samples of headed paper and envelopes. As pointed out by the Requesting Party, these samples in themselves provide no indication regarding the context or dates of use. This said, the samples must be read in conjunction with the copies of invoices, which are printed on the same headed paper;
- P-7: Commercial remodeling plan dated July 21, 2008 concerning the “Sacacomie Spa” project comprising the amendment dated August 22, 2008. The table shows that “these

plans comprise recommendations for interior design, including architectural details, interior decoration details and general design, as well as elements of furniture design” and associates the latter with services S1, S2 and S4. On reviewing these plans, I note that they do in fact comprise such recommendations, including the type of materials, and details such as “wooden niches,” “metal shelves,” etc.

- P-8 and P-9: Copy of invoices, dated during the Relevant Period, relating to the project under P-7, covering professional fees for design services rendered. I note that they refer to professional services for consultation, remodeling and decoration of the hotel in question;
- P-10: Commercial remodeling plan dated March 2011 concerning an office. The table shows that these plans “comprise interior design services, including furniture design, specifically a meeting table, desk and integrated furniture.” On reviewing these plans, I note that they do in fact comprise such elements;
- P-11: Residential remodeling plan dated May 2010 concerning a complete remodeling project and related invoice;
- P-12: Offer of service dated May 12, 2010 for remodeling, decoration, planning and renovation work monitoring related to the project under P-11 and invoice for the corresponding professional fees for “the remodeling, decoration, planning and work supervision [in question];” and
- P-13, P-14 and P-15: Invoices dated in the Relevant Period concerning interior design lighting (P-13); quartz selection (P-14); and bathroom decoration and remodelling, and apartment finishing (P-15) services.

[23] With the exception of Exhibit P-6, the table refers to none of the services described under identifier “S3,” i.e. decorative object design services. The samples of headed paper and envelopes submitted as P-6 prove insufficient in themselves to establish use of the Mark in association with these specific services. Accordingly, even if I had concluded that the use shown

above was in fact use of the Mark as registered, these services would have been expunged from the registration.

[24] However, for the remaining services, my conclusion would have been different.

[25] As stems from my review of Exhibits P-7 to P-15, some of the invoices must be read in conjunction with the corresponding remodeling plans submitted as P-7 and P-11. Accordingly, although the “furniture design” services are not indicated as such on the invoices, these services stem from the remodeling plans submitted. It is the same for services described under identifier S4, i.e. “architectural detail design, interior decoration and general design services, comprising or not, in regard to all of these services, plans and mock-ups, and/or residential or commercial remodeling services.” The residential and commercial aspects of the Registrant’s services also emerge clearly from the exhibits submitted.

#### Decision

Given the above, and since it is not an exceptional case in which the absence of use of the Mark can be explained, the registration will be expunged in compliance with the provisions of Section 45 of the Act in exercising the authority delegated to me pursuant to the provisions of subsection 63(3) of the Act.

---

Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Traduction certifiée conforme  
Alan Vickers



## Appendix

### **WARES**

Bedroom furniture, dining room furniture, kitchen furniture, living room furniture and decorative objects, specifically dishes, flatware and kitchen utensils, household linen, bed linen, drawings, sculpture and signs.

### **SERVICES**

Interior design, furniture design, decorative object design, architectural detail design, interior decoration and general design, comprising or not, in regard to all of these services, plans and mock-ups, and/or residential or commercial remodeling services.