

**IN THE MATTER OF AN OPPOSITION
by R.W.S. Hoists & Cranes Inc. to application
No. 899,154 for the trade-mark RICHARDS-
WILCOX filed by Richards-Wilcox Canada Inc.
(now Raynor Canada Inc. carrying on business
as Richards-Wilcox Canada)**

**On December 11, 1998, Richards-Wilcox Canada Inc. filed an application to register
the trade-mark RICHARDS-WILCOX. The application covers the following wares:**

- (1) Multiplex doors, aircraft hangar, large single or double swing doors, blast and sound doors
- (2) Single girder over-running and under-running cranes
- (3) Double girder over-running and under-running cranes; gantry, runout and jib cranes; manually, hand chain and electrically operated cranes; monorail systems, interlocking monorail and crane systems; runway systems for cranes; custom built hoists, ramp or dock levels for vehicle load

and the following services:

- (1) Installation and servicing industrial door systems
- (2) Installation of cranes, runways, monorails and hoists; installation and servicing hoists, conductor systems, below hook attachments, jib cranes, automated systems and dock systems.

The application is based on use of the trade-mark in Canada since January 1, 1951 for wares (1) and services (1) and use in Canada since January 1, 1930 for wares (2) and (3). The application was advertised for opposition purposes on November 17, 1999. As a consequence of an amalgamation, the application now stands in the name of Raynor Canada Inc. carrying on business as Richards-Wilcox Canada.

The opponent, R.W.S. Hoists & Cranes Inc. (“R.W.S.”), filed a statement of opposition on April 17, 2000, a copy of which was forwarded to the applicant on May 2, 2000. The first ground of opposition is that the applicant’s application does not conform to the requirements

of Section 30(b) of the Trade-marks Act because the applicant has not used the applied for mark continuously, if at all, since the dates of first use claimed. The second ground is that the applicant's application does not conform to the requirements of Section 30(i) of the Act because the applicant could not have been satisfied that it was entitled to use the applied for mark in Canada. In support of this ground, the opponent alleged that the applicant

....was aware of the Opponent's prior and continuous use of the trade-mark RICHARDS-WILCOX and RICHARDS-WILCOX HOIST PRODUCTS. The applicant is aware of the Opponent's purchase of, amongst other things, RICHARDS-WILCOX MATERIAL HANDLING DIVISION, including the trade-mark rights and associated goodwill in 1990 for, amongst other things, hoists, cranes and material handling products.

The third ground of opposition is that the applicant is not the person entitled to registration of the applied for trade-mark pursuant to Section 16(1) of the Act because the opponent purchased the right to use the mark in association with cranes, hoists and other material handling equipment in 1990. The fourth ground is that the applied for trade-mark is not distinctive and is not adapted to distinguish the applicant's wares and services from those of the opponent and others.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Fadel Fahmy, the President of the opponent. As its evidence, the applicant submitted three affidavits of Raymond Friesen, the President of the applicant. The first affidavit is headed "Affidavit", the second "Supplementary Affidavit" and the third "Further Supplementary Affidavit." Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

The Evidence

In his first affidavit, Mr. Friesen, the applicant's President, details the history of the trade-mark RICHARDS-WILCOX. According to Mr. Friesen, Richards-Wilcox of Canada Limited ("RWCL") operated in the United States and Canada since 1912 manufacturing commercial and industrial door products and associated hardware. Appended as exhibits to his second affidavit are photocopies of various product catalogues that Mr. Friesen states were used from the 1930s to the 1980s (see paragraphs 12-25 and 27-32 of the second Friesen affidavit). Those catalogues illustrate doors, cranes and associated hardware. However, those catalogues consistently identify the source of the wares as Richards-Wilcox Canadian Company Limited ("RWCCCL") rather than RWCL. Furthermore, Mr. Friesen identifies RWCCCL as the "Canadian plant" for Richards-Wilcox Mfg. Co. ("RWMC"), an American company based in Aurora, Illinois.

According to Mr. Friesen, RWCL amalgamated with Serco Engineering Limited on January 1, 1974 and the amalgamated company continued as RWCL (see Exhibit B to the first Friesen affidavit). On May 27, 1986, Red River Door Systems Ltd. ("Red River") purchased RWCL. On May 30, 1986, Red River changed its name to 54444 Manitoba Inc. which, in turn, changed its name to Richards-Wilcox Canada Inc. ("RWCI") on July 17, 1987. As part of the May 27th transaction, RWCL undertook to change its name to not include the words Richards-Wilcox (see paragraph 7 of the first Friesen affidavit). At the same time, Red River licensed back the right to use certain trade-marks including the mark RICHARDS-WILCOX for hoists to RWCL for a period of three years (see paragraph 8 of the first Friesen affidavit).

In satisfaction of its undertaking, RWCL changed its name to TI Serco Corporation (“TI Serco”) on September 29, 1986. On January 1, 1987, Serco Manufacturing Corporation and Serco Engineering Corporation amalgamated with TI Serco and continued as TI Serco. TI Serco subsequently changed its name to The Serco Corporation (“Serco”). On April 1, 1991, Serco amalgamated with Dockfab Limited and continued as Serco.

Mr. Friesen states that RWCI became aware of the opponent’s use of the trade-mark RICHARDS-WILCOX in 1991. RWCI subsequently sent a cease and desist letter to the opponent on May 13, 1991 (see exhibit I to the first Friesen affidavit). However, there is no evidence that RWCI took any further steps to enforce its alleged rights against the opponent. On April 1, 1996, RWCI reorganized as a new Ontario corporation (see Exhibit A to the first Friesen affidavit). On March 1, 1999, RWCI became a wholly-owned subsidiary of Raynor Canada Inc. (“Raynor”). Mr. Friesen states that Raynor licenses its distributor Richards-Wilcox Material Handling Division (Ontario) who designs, manufactures, repairs, sells, installs and advertises doors, cranes, hoists and associated hardware. He does not, however, state that the distributor uses the trade-mark RICHARDS-WILCOX. Furthermore, the Friesen affidavits do not establish any use of the trade-mark by the applicant or its predecessors in title from about 1986 on.

In his affidavit, Mr. Fahmy confirms the earlier history of RWCL in respect of the trade-mark RICHARDS-WILCOX. However, it is Mr. Fahmy’s position that rights to the trade-mark passed to his company. He states that in 1983 RWCL “made over” to Serco

.....the manufacture and management of certain products in its line, including hoists and cranes; dock equipment; door hardware and door

seals, as well as other products. (see paragraph 8(c) of the Fahmy affidavit)

Apart from the fact that it is unclear that Serco was even in existence at that time, the “making over” did not likely involve a transfer of trade-mark rights for the listed products since Red River licensed back such rights to RWCL on May 27, 1986 for a three-year period and RWCL then changed its name to TI Serco to honor its undertaking to stop using the name Richards-Wilcox.

Mr. Fahmy states that Serco used the trade-mark RICHARDS-WILCOX with hoists and cranes from 1983 to August of 1990. At that time, he states that Serco sold “the goodwill and assets” of that part of its business known as The Serco Corporation - Hoist Division to the opponent R.W.S. Appended as Exhibit A to the Fahmy affidavit is a photocopy of the August 17, 1990 agreement between the parties. The agreement makes reference to rights to the name and logo SERCO but there is no reference to any rights to the trade-mark RICHARDS-WILCOX. It seems likely that the agreement covered a hoists and cranes business that may have included some RICHARDS-WILCOX products as part of its inventory but not any rights to the mark. The subsequent correspondence to customers and others is consistent with that interpretation (see Exhibits B, C and D to the Fahmy affidavit). According to Mr. Fahmy, the door and hardware divisions of Serco were “made over” to RWCI in 1998 although he does not provide any supporting documentation for that allegation.

Mr. Fahmy states that, since 1990, the opponent has used the trade-mark RICHARDS-WILCOX in association with its hoists and cranes business. However, Mr. Fahmy provides little in the way of sales figures, advertising and documentation to support that contention.

Exhibit G is a photocopy of a nameplate that Mr. Fahmy states his company applies to its products. However, the nameplate shows not only the trade-mark RICHARDS-WILCOX but also the trade-mark R-W which is registered in the name of the applicant under No. 120,717 for *inter alia* hoists and cranes. It therefore seems likely that the products bearing the nameplate were not produced by the opponent.

Exhibit E to the Fahmy affidavit comprises photocopied extracts from the Toronto business telephone directory for the years 1997 to 2001. Those extracts show ads placed by the applicant under the heading Richards-Wilcox Hoist Products followed by the description “All Crane/Hoist Parts - 24 Hr. Service.” However, those ads do not necessarily establish use of the mark RICHARDS-WILCOX by the opponent for hoists and cranes. Rather, they are more likely an indication that the opponent services RICHARDS-WILCOX cranes and hoists and sells parts for such products.

Immediately above each of the opponent’s ads is an ad under the heading Richards-Wilcox Cranes followed by the wording “Authorized Sales and Service.” The company identified is Richards-Wilcox Materials Handling Limited which may well be the licensee of Raynor identified by Mr. Friesen in his first affidavit.

The Grounds of Opposition

As for the opponent's first ground of opposition, the onus or legal burden is on the applicant to show that its application conforms to the requirements of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3

C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-conformance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent's evidential burden can be met by reference to the applicant's own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

The applicant claims that there had been use of the trade-mark RICHARDS-WILCOX since the date claimed by RWCL. However, as discussed, the earlier product catalogues identify the source of the goods as RWCL and Mr. Friesen states that this company was the Canadian plant for the American company RWMC. Thus, there is some doubt as to which company was using the trade-mark in the 1930s, 40s and 50s.

The catalogues from the 1960s, 70s and early 80s show RWCL as the source of the goods. Since RWCL was purchased by Red River in 1986 and Red River subsequently changed its name to RWCI (the original applicant), it was incumbent on the applicant to include RWCL as a predecessor in title. Although it is not necessary to include amalgamating companies as predecessors (see the opposition decision in Molson Breweries, A Partnership v.

John Labatt Ltd. (1994), 56 C.P.R.(3d) 107 at 113, where there has been an actual change in ownership, predecessors in title must be included covering the period of use claimed in the application: see the opposition decisions in **Hardee's Food Systems Inc. v. Hardee Farms International Ltd. (1984), 1 C.P.R.(3d) 417 at 430** and **Sanna, Inc. v. Chocosuisse Union des Fabricants Suisses de Chocolat (1986), 14 C.P.R.(3d) 139 at 142.**

As also discussed, the applicant's evidence is sketchy with respect to establishing use of its mark from 1986 on by RWCI and the current owner Raynor. Given the lengthy period of possible non-use, it appears that there may not have been continuous use of the trade-mark RICHARDS-WILCOX since the dates claimed.

In view of the above, I consider that the opponent has met its evidential burden respecting its first ground of opposition. It was therefore incumbent on the applicant to clearly evidence continuous use of its mark since the dates claimed and to include the appropriate predecessor or predecessors in title in its application to support those claimed dates. Since the applicant has failed to do so, the first ground is successful.

As for the second ground, it does not raise a proper or complete ground of opposition. The mere fact that the applicant may have been aware of the opponent's trade-marks is insufficient to support a ground of non-conformance with Section 30(i) of the Act. The opponent failed to allege that the applicant knew that its mark was confusing with the opponent's marks. In any event, the opponent failed to clearly evidence use of its trade-marks. Thus, the second ground is unsuccessful.

As for the third ground of opposition, since the applicant's claimed dates of first use have not been supported, the latest date the applicant can rely on is its filing date - i.e. - December 11, 1998. However, in order to rely on its ground of prior entitlement, the opponent was obliged to evidence use of its trade-mark RICHARDS-WILCOX prior to that date. As discussed, the opponent failed to clearly evidence use of its trade-mark at any time. Thus, the third ground is unsuccessful.

As for the fourth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). However, as before, there is an initial burden on the opponent to prove its allegations of fact in support of this ground. The material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - April 17, 2000): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

Neither party has clearly evidenced use of its trade-mark in recent years. The opponent has evidenced telephone directory ads in which it uses the description Richards-Wilcox Hoist Products. Those directories also include ads referring to Richards-Wilcox Cranes and Richards-Wilcox Materials Handling Limited which may or may not be a licensee of the current applicant, Raynor. Furthermore, there appear to be third parties who also use the words Richards-Wilcox as part of their names (see paragraph 25 of the Fahmy affidavit) and

it is not clear if any or all of them have been licensed by the applicant. Thus, I find that, on a balance of probabilities, the applicant has failed to satisfy the burden on it to show that its trade-mark RICHARDS-WILCOX was distinctive in Canada as of the filing of the present opposition. The fourth ground is therefore successful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT GATINEAU, QUEBEC, THIS 30th DAY OF SEPTEMBER, 2004.

**David J. Martin,
Member,
Trade Marks Opposition Board.**