

SECTION 45 PROCEEDINGS
TRADE-MARK: SILKS Design
REGISTRATION NO. TMA416,975

On March 7, 2006, at the request of Deeth Williams Wall LLP, the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) to P.S. Atlantic Limited, carrying on business as Paint Shop, the registered owner of registration No. TMA416,975 for the trade-mark SILKS Design (the “Mark”). The Mark, which is shown below, is registered in association with “paint”.



Section 45 requires the registered owner of a trade-mark to indicate whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice, in this case between March 7, 2003 and March 7, 2006. If the mark has not been used during that time period then the registered owner is required to indicate the date on which it was last used and the reason why it has not been used since that date.

In response to the s. 45 notice, the registered owner filed the affidavit of Paul Burt. Neither party filed a written argument and an oral hearing was not requested.

Mr. Burt is the President of P.S. Atlantic Limited (“PSAL”). Paragraphs 2 and 3 of his affidavit are

reproduced below:

2. PSAL is the franchiser of retail outlets operating in Canada under the trade name “Paint Shop” that are engaged in the retail sale of paints, wall-coverings, window treatments, floor-coverings and associated materials.

3. The SILKS Design trade-mark is used by PSAL and by its franchisees under license from PSAL in association with various types of interior paints sold by it to franchisees. The paints are sold by PSAL to its franchisees for subsequent sale to retail customers. By agreement, the paints are manufactured by Benjamin Moore & Co. Limited (“Benjamin Moore”) on behalf of PSAL and the labels featuring the trade-mark are applied to the paint cans prior to the paint being shipped by Benjamin Moore from its warehouse in Montreal, Quebec, directly to PSAL’s franchisees.

Mr. Burt attests that the SILKS Design trade-mark appears prominently on the labels attached to the paint cans and provides a photograph showing the front of a paint can, displaying the Mark. He also provides invoices dated during the relevant three-year period that evidence the sale by the registrant of paint to Canadian customers; Mr. Burt attests that the paint listed in such invoices was SILKS Design paint. In addition, he attests that a total of 276,422 gallons of paint was sold in Canada in association with the Mark during the relevant three-year period.

I note that Mr. Burt has indicated that the registrant’s licensees use the Mark under licence. He has not stated that the registrant controls the character and quality of the paint under this licence but such control is apparent from the fact that the registrant sells the paint to its franchisees; moreover, such paint is manufactured on behalf of the registrant. Although the front of the label provided does not list the name of any entity, I note that the name under which the registrant carries on business, PAINT SHOP, appears at the top.

Overall, I am satisfied that the registrant’s evidence shows that it used the Mark in Canada in association with paint in its normal course of trade during the relevant three-year period. Registration

TMA416,975 will therefore be maintained, in accordance with the provisions of s. 45(5) of the Act.

DATED AT TORONTO, ONTARIO THIS 15th DAY OF NOVEMBER 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board