



TRANSLATION

THE REGISTRAR OF TRADE-MARKS

**Citation: 2017 TMOB 53**

**Date of Decision: 2017-05-11**

**[UNREVISED ENGLISH  
CERTIFIED TRANSLATION]**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Clopay Building Products Company, Inc.                      Requesting Party**  
**and**

**Portes Patio Novatech Inc.    Registered Owner**

**TMA497,512 for IMAGINE    Registration**

THE RECORD

[1] On February 9, 2015 at the request of Clopay Building Products Company, Inc. (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 Portes Patio Novatech Inc. (the Registered Owner), registered owner of registration No. TMA497,512 for the IMAGINE trade-mark (the Mark).

[2] This notice enjoined the Registered Owner to provide an affidavit or a statutory declaration that its Mark was used in Canada at any time between February 9, 2012 and

February 9, 2015 (the relevant period), in association with the goods specified in the registration, namely [translation] "Portes de PVC" (*Doors made of PVC*), and, in the negative, the date when the Mark was used for the last time and the reason for its failure to use it since that date.

[3] In response to the Registrar's notice, the Registered Owner filed an affidavit by its President, Jean Champagne, signed on June 22, 2015.

[4] Both parties produced written representations. No hearing was held.

#### ANALYSIS

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing "deadwood" from the register; this is why the applicable test is not very stringent. As stated by Judge Russell in *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC), at page 282:

We know that the purpose of s. 45 proceedings is to clean up the "deadwood" on the register. We know that the mere assertion by the owner that his trade-mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owner's business and merchandising practices.

[6] In the present case, section 4(1) of the Act defines use in association with goods as follows:

A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[7] This leads me to review the evidence filed by the Registered Owner.

### **Jean Champagne's affidavit**

[8] Mr. Champagne explains that the Registered Owner specializes in manufacturing patio doors, which are sold to construction contractors or door and window retailers. It does not sell its products directly to consumers.

[9] Mr. Champagne attaches to his affidavit, under Exhibit JC-1, copies of representative invoices, issued by the Registered Owner between March 27, 2012 and January 12, 2015, in association with the same of IMAGINE mark PVC patio doors. Each invoice clearly indicates the doors sold are patio doors under the Mark.

[10] Mr. Champagne confirms in paragraph 5 of his affidavit that all the patio doors manufactured by the Registered Owner and sold under the Mark are manufactured in a wood frame covered with PVC. He attaches to this effect, under Exhibit JC-2, a copy of the Registered Owner's brochure promoting patio doors under the Mark, available since September 2014.

[11] Mr. Champagne also attaches, under Exhibits JC-3 and JC-4, photographs showing the labels displaying the Mark, affixed to the wood frame and the glass of each patio door sold and delivered to the customers by the Registered Owner. Mr. Champagne confirms that such labels were affixed to the patio doors manufactured and sold by the Registered Owner under the Mark during the relevant period.

### **The position of the Requesting Party**

[12] As pointed out by the Registered Owner, the Requesting Party does not contest the demonstration of the use of the Mark during the relevant period, but instead submits that Mr. Champagne's affidavit represents the use of the Mark in association with goods other than those described in the registration. Thus, the Requesting Party submits that the patio doors presented in evidence are not included in the definition of doors made of PVC.

[13] I agree with the Registered Owner that such an argument cannot succeed in the present case.

[14] As noted by the Registered Owner, the Registrar automatically may take note of the dictionary definitions. Thus the word "porte" (door) is defined as follows in *Le Petit Robert*:

[TRANSLATION] Opening specially made in a wall, a fence, etc., to allow passage; the frame of this opening; moving piece or panel that can block the bay of a door.

[15] I agree with the Registered Owner that a patio door is a door, thus acting as a moving panel that can block the bay of a door. Moreover, both Mr. Champagne in paragraph 5 of his affidavit, and the brochures under Exhibit JC-2, clearly attest that the doors under the Mark are covered with PVC. The same is true of the labels under Exhibit JC-3 and some of the invoices under Exhibit JC-1, which contain the following description: "PORTE PATIO PVC Imagine" (Imagine PVC PATIO DOOR). Thus, these are PVC doors.

[16] As recalled by the Registered Owner, the jurisprudence has repeatedly concluded that the evidence of use of a trade-mark in association with specific goods, when the registration refers to a more general description, is sufficient to conclude the mark is used for the broader category, as described in the registration. It is sufficient to mention, as examples, the following decisions cited by the Registered Owner:

- *Sim & McBurney v Placements 1360 Inc*, 2013 TMOB 230, 117 CPR (4th) 213 (TMOB), in which the Registrar, referring to the definition of "tarte" (pie) concluded that the use of the mark in question in this case in association with pies constituted proof of use of the mark in association with "pâtisseries" (pastry) goods.
- *Mantha & Associates v Le Cravatte di Pancaldi S.r.l.* (1998), 84 CPR (3d) 455 (FC), in which the Federal Court, referring to the definition of the word "foulard" (scarf) confirmed the decision of the Registrar, who had concluded that a "pocket scarf" constitutes a "foulard" (scarf).
- *MacBeth & Johnson v Dylex Ltd* (1997) CarswellNat 3442 (TMOB), in which the Registrar concluded that the Registered Owner's evidence regarding the use of the mark in question in this case in association with "jeans" constituted a use of the marks in association with "pantalons" (*pants*), since jeans are included in the definition of "pants".

[17] I also agree with the Registered Owner that the Requesting Party seems to make an erroneous interpretation of the decision *Alcan Aluminium Ltd v Oakwood Lumber & Millwork Co* (1994 CarswellNat 3083, 58 CPR (3d) 552), cited by it in its written representations. The Requesting Party suggests that the Registrar's conclusion regarding the absence of use of the mark in question in this case for "fabrication sur mesure de portes" (custom door manufacturing) services arises from the fact that doors are not included in the definition of "fabrication sur mesure" (custom manufacturing) services. The Registrar had concluded that the mark was used in association with doors, but otherwise concluded that the use of the mark in association with "fabrication sur mesure de portes" (custom door manufacturing) services had not been demonstrated. There was no question of determining whether the evidence of use of the mark in association with goods of a more specific nature than is indicated in the registration falls under the definition of the goods as described in the registration. As pointed out by the Registered Owner, the decision in the *Alcan* cases concerns a completely different problem, namely that of knowing if the evidence of use of a trade-mark in association with goods is sufficient to conclude this mark is used in association with services.

[18] Moreover, the present case can easily be distinguished from the decision *Costello Group Inc v Teh Yor Co*, 2014 TMOB 170, 126 CPR (4th) 155, cited by the Requesting Party, in which the Registrar concluded that the evidence of use of the mark in question in this case with the specific goods, "folding blinds" described in the registration, could not also demonstrate the use of the mark in association with the other goods described therein, including "window blinds" and "door blinds", because the Registered Owner had established a distinction among these three types of blinds in the statement of goods.

DISPOSAL

[19] Consequently, in exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, the registration will be maintained.

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

Certified translation  
Arnold Bennett

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS REGISTERED IN THE CASE**

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No Hearing Held

**AGENT(S) OF RECORD**

Gowling WLG

FOR THE REGISTERED OWNER

MACRAE & CO

FOR THE REQUESTING PARTY