

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

Citation: 2018 TMOB 161
Date of Decision: 2018-12-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Uniropce Limited

Requesting Party

and

WireCo Worldgroup Inc.

Registered Owner

**TMDA48989 for ROPE WITH YELLOW
STRAND DESIGN**

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMDA48989 for the trade-mark ROPE WITH YELLOW STRAND DESIGN set out below (the Mark), owned by WireCo Worldgroup Inc. (WireCo or the Owner).



Trademark description A yellow coloured strand running through a length of a wire rope, no claim being made to the representation of a wire rope as shown in the accompanying drawing apart from the presence of the yellow strand

[2] The Mark is registered for use in association with wire rope.

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

The Proceeding

[4] On March 4, 2016, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Amstead Industries Incorporated. An assignment of the Mark to the Owner (effective as of May 12, 1999) was recorded on December 20, 2016. This notice was sent at the request of Unirope Limited (the Requesting Party).

[5] The notice required the Owner to provide evidence showing that it had used the Mark in Canada, at any time between March 4, 2013 and March 4, 2016 (the relevant period), in association with wire rope. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of “use” is set out in section 4(1) of the Act:

4(1) 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] It has been 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”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary; however, sufficient evidence must be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered services during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of John Embray, its Vice President of Sales, sworn on October 3, 2016, together with Exhibits A and B.

[9] While both parties filed written representations, only the Owner appeared at an oral hearing.

The Evidence

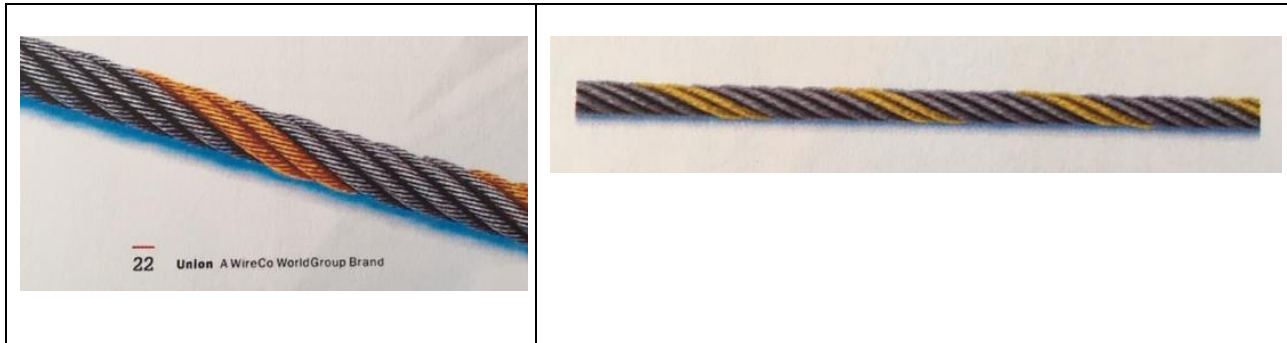
[10] In his affidavit, Mr. Embray provides the following:

- (a) WireCo is a world leader in manufacturing, engineering and distributing wire rope including the Flex Line of wire rope (para 2). Union Rope, a WireCo WorldGroup brand, oversees the sale of WireCo's Flex line of wire rope products (para 4). Included in the Flex line are 7-Flex wire ropes, which are made up of 7 strands and come in a number of designs. WireCo oversees the sale and distribution of 7-Flex wire rope including what Mr. Embray describes as the Yellow Strand Design and the 2 Yellow Strand Design throughout Canada (para 5).
- (b) Representative photos showing both the Yellow Strand Design and the 2 Yellow Strand Design are attached as Exhibit A (para 4) and are excerpted below:



- (c) A page from a product catalogue and user guide for the line of 7-Flex wire ropes which includes photos of the 2 Yellow Strand Design shown below is also attached as part of Exhibit A. There is no evidence that these were distributed in Canada during the relevant period. However, Mr. Embray does

say that these are representative materials which showcase the Yellow Strand Design and 2 Yellow Strand Design.



- (d) While Mr. Embray does not state in his affidavit that either the Yellow Strand Design or 2 Yellow Strand Design were used in Canada during the relevant period, he does attach an invoice showing the sale of wire rope in Canada bearing the 2 Yellow Strand Design in October 2015 (para 6, Exhibit B).
- (e) While Mr. Embray provides sales of the 7-Flex wire products since 2009 (para 7), this evidence is not relevant as the sales figures are not specific for wire rope with a yellow strand or yellow strands. Further, as only one invoice has been provided, I cannot infer that a significant portion of these sales is attributable to sales of the Yellow Strand Design or 2 Yellow Strand Design.

Analysis

Deviation is Acceptable

[11] The Requesting Party argues that there is no evidence that a wire rope incorporating a single yellow strand has been sold in Canada. On the invoice provided which shows sales of a rope with a 2 Yellow Strand Design, the Requesting Party states:

The Exhibit B invoice is not relevant to the issues at hand. According to the Trademark Description, the Subject Mark is a single yellow strand running through a length of wire rope. By the affiant's own admission, the invoice pertains to a 2 YELLOW STRAND DESIGN. Neither further explanation nor

evidence regarding 2 YELLOW STRAND DESIGN has been provided. As the present challenge pertains to ROPE WITH YELLOW STRAND DESIGN only, the Requesting Party contends that the invoice ought to be given no weight.

On the photographs provided, the Requesting Party comments “The first photograph consists of two coloured strands which are arguably orange. The second photograph consists of what appears to be one coloured strand but it is arguably orange” (para 16).

[12] The question to be asked in cases like this where the trade-mark used (the 2 Yellow Strand Design) deviates from the trade-mark as registered (the Mark), is whether the mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Compagnie Internationale pour l’informatique CII Honeywell Bull*, (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see if the “dominant features” of the trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc*, (1992), 44 CPR (3d) 59 (FCA)].

[13] In my view, the dominant features are the colour yellow as applied to a distinct portion of the rope such that there is a block of yellow running throughout the length of the wire rope. With respect to the differences enumerated, the orange versus yellow colour and the single versus double strands of colour, in applying the principles as set out in *Honeywell Bull* and *Promafil Canada*, I consider these differences to be minor deviations as the 2 Yellow Stripe Rope Design retains the dominant features. In my opinion, a consumer would not be counting the precise number of coloured strands within the wire rope and the fact that there are two yellow strands in a block as opposed to one yellow strand is immaterial. Further, the coloured strands still fall into the range of colours which may be described as yellow (albeit towards the orange edge of the spectrum). As such, the identity of the Mark is preserved and it remained recognizable.

Proof of Sale Via a Single Invoice

[14] Although evidence of more sales would have been preferable, there is no minimum amount of commercial activity required in order to maintain the registration [*Vogue Brassiere Inc v Sim & McBurney* (2000), 5 CPR (4th) 537 at 549 (FCTD)]. The invoice shows a sale of

5000 FT of “yellow strand” rope to a customer in Edmonton, Alberta by WireCo WorldGroup, which Mr. Embray says had a 2 Yellow Strand Design (para 6). There is nothing to indicate that the transaction was not authentic or that it was deliberately fabricated or invented in order to protect the registration. I find that the Owner has demonstrated use at some point during the relevant period as required by section 45 [*Osler, Hoskin & Harcourt v United States Tobacco Co et al* (1997), 77 CPR (3d) 475 at para 20 (FCTD)].

Conclusion

[15] Having regard to the evidence as a whole, I am satisfied that the Owner has shown use of the Mark in accordance with sections 4(1) and 45 of the Act. The evidence clearly demonstrates sales of a wire rope with the Mark during the relevant period.

Disposition

[16] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2018-08-01

APPEARANCES

Robert A. MacDonald

FOR THE OWNER

No One Appearing

FOR THE REQUESTING PARTY

AGENT(S) OF RECORD

Gowling WLG (Canada) LLP

FOR THE OPPONENT

Ridout & Maybee LLP

FOR THE APPLICANT