



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 116

Date of Decision: 2019-10-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Budget Blinds, LLC

Requesting Party

And

Truth Hardware Corporation

Registered Owner

TMA813,830 for SIGNATURE

Registration

INTRODUCTION

[1] At the request of Budget Blinds, LLC (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on May 18, 2017, to Truth Hardware Corporation (the Owner), the registered owner of registration No. TMA813,830 for the trademark SIGNATURE (the Mark).

[2] The Mark is registered for use in association with the following goods:

Door and window hardware, made primarily of metal, namely brackets, tracks, latches, locks, knobs, handles, hinges, operators, leversets.

[3] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the goods specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in

use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is May 18, 2014 to May 18, 2017.

[4] The relevant definition of use for goods is set out in section 4 of the Act as follows:

4(1) A trademark 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of David J. Johnson, sworn on November 2, 2017. Only the Owner filed written representations. An oral hearing was not requested.

THE OWNER'S EVIDENCE

[7] In his affidavit, Mr. Johnson identifies himself as a manager of AmesburyTruth, a company related to the Owner. He further details the relevant corporate history of the Owner and AmesburyTruth. Suffice to say, he confirms that the Owner maintains control of the character and quality of all the goods and services sold in association with the companies' trademarks, which includes goods sold in association with the Mark during the relevant period.

[8] Mr. Johnson explains that the Owner "sells the Registered Goods to Canadian customers through original equipment manufacturers ("OEMs") as well through authorized Canadian

retailers and distributors.” He states that the Owner has sold approximately 58,312 “units of the respective Registered Goods associated with the SIGNATURE trademark in Canada”, with a total value of \$1,540,360 USD during the relevant period. Mr. Johnson explains that the goods are shipped and sold in bulk in Canada, rather than in individual packaging, and then incorporated into completed doors and windows. He further explains that “[p]urchasers of the Registered Goods... will order the SIGNATURE door or window handle kits by selection of the specific SIGNATURE Series Model Reference Numbers, which correspond to the specific sizing, spacing, and finishing for the door or window size.” These numbers, he explains, “correspond to specific locking, sizing, spacing and handle configuration requirements based on the size of the door or window” to be manufactured or installed by the customer. He states that the reference numbers are clearly listed on purchase orders and invoices which are provided with the goods at the time of delivery in Canada.

[9] In support, Mr. Johnson attaches the following exhibits to his affidavit:

- Exhibit A is a copy of the Owner’s product technical datasheet, which shows patio door handle sets corresponding to the Owner’s model numbers 40.90-40.93 and 40.94-40.97. The Mark is displayed numerous times throughout the datasheet, including in the top corner of the page. The datasheet provides a description of the patio door handle sets and includes references to locks, levers, handles, and decorative finishes involving brass and zinc bases.
- Exhibit B is a copy of an installation instructions document for model numbers 40.94-40.97, which provides instructions on how to install the patio door handles shown in Exhibit A. The Mark is displayed at the top of each page and numerous times throughout the text. Mr. Johnson attests that these instructions accompany the goods at the time of delivery in Canada, and that “this is representative of the delivery of the bulk shipments of the Registered Goods during the Relevant Period in Canada.”
- Exhibit C is a screenshot from the website of a Quebec-based window and door manufacturer called Fenplast, dated August 15, 2017. The screenshot advertises door handles under the category “Decorative Options”; the Mark is displayed next to pictures of these goods. The advertisement refers to various options for decorative finishes applied over solid brass.
- Exhibit D consists of four invoices showing sales of model numbers 40.85, 40.90, and 40.94. The invoices are dated August 6, 2014, April 30, 2015, January 13, 2016, and January 11, 2017, and show sales to retailers in Canada, including Fenplast. The Mark does not appear on these invoices.
- Exhibit E consists of promotional materials advertising the Owner’s patio door handles, model numbers 40.90-40.93 and 40.94-40.97. Although the Mark does not appear on the

depicted door handles themselves, it is displayed throughout the text of the materials. He states that this promotional material is “reflective of display of the SIGNATURE trademark in association with the goods in Canada as order of the Registered Goods is generally only made by way of model number”.

ANALYSIS

[10] In its written representations, the Owner acknowledges that the Mark was not displayed on the invoices or on the SIGNATURE goods themselves. Nevertheless, it submits that notice of association between a trademark and goods can be established when customers place orders by way of a catalogue that displays the trademark in close proximity to the goods, and that notice of association continues when the goods are delivered and invoices are received [citing *Rosenstein v Elegance Rolf Offergelt GmbH* (2005), 47 CPR (4th) 196 (TMOB) and *Swabey Ogilvy Renault v Mary Maxim Ltd* (2003), 28 CPR (4th) 543 (TMOB)]. I agree. I note that in *Rosenstein*, the Registrar concluded that, notwithstanding that the Mark did not appear on certain goods or subsequent invoices, consumers could compare the product number appearing on the invoices with the product number of the goods ordered from the catalogues.

[11] Similarly, in this case, the Owner has established that the Mark is displayed on the datasheets from which the OEMs and distributors order the Owner’s goods, and that the product codes in that datasheet correlate with the codes shown on the invoices.

[12] Indeed, with respect to the patio door handles evidenced to have been sold and transferred during the relevant period, I accept that the appearance of the Mark on datasheets used by customers to order such goods is sufficient to establish the requisite notice of association. As such, the main issue in this case is whether the Owner has established use of the Mark in association with *each* of the registered goods and, in particular, to what extent the goods as registered correlate to the patio door handles actually evidenced to have been sold during the relevant period.

[13] First, with respect to the registered door hardware components, namely “brackets, tracks, latches, locks, knobs, handles, hinges, operators, leversets”, it is not immediately clear which of these goods were actually components of the patio door handle sets referenced in the Owner’s

evidence. However, upon review of the exhibited documents, I accept that handles and locks are clearly referenced in Exhibits A, B, C, and E and levers are referenced in Exhibit A. Further, some of the locks depicted in Exhibit B appear to include latches.

[14] Furthermore, based on the reference to the patio door handles being made of brass in Exhibit C, I am satisfied that such door hardware components are “made primarily of metal” as specified in the registration.

[15] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered door hardware components “latches”, “locks”, “handles”, and “leversets” within the meaning of sections 4 and 45 of the Act.

[16] With respect to the remaining goods, I first note that there is no specific reference to the hardware components brackets, tracks, knobs, hinges or operators anywhere in the Owner’s evidence, including the exhibited technical datasheets and installation instructions. The Owner’s evidence provides no definitions for any of these goods, nor any explanation as to what role they might play as components of the Owner’s door hardware products. In this respect, having reviewed the exhibits attached to Mr. Johnson’s affidavit, I am unable to identify any instances of brackets, knobs, hinges, tracks, or operators being used as components of the patio door handle sets. As such, I cannot conclude that the Owner has demonstrated use of the Mark in association with these remaining door hardware components within the meaning of sections 4 and 45 of the Act.

[17] With respect to “window hardware”, I note that Mr. Johnson refers to the registered goods, including window handle kits, as: i) having been sold in bulk; ii) being used as components of finished doors and windows; and iii) corresponding to specific configurations for doors and windows manufactured by Canadian OEMs or sold by Canadian distributors. However, the evidence of actual transfers is limited to patio door handles. There is no evidence of a transfer of any “window hardware” goods or components in the normal course of trade during the relevant period or otherwise in the Owner’s evidence. Had Mr. Johnson furnished any evidence of such a transfer, or even provided an unambiguous statement that such a transfer of window hardware took place during the relevant period, I would conclude differently. However, due to the ambiguity of the evidence before me, I cannot conclude that the Owner has

demonstrated use of the Mark in association with window hardware within the meaning of sections 4 and 45 of the Act.

[18] In sum, I find that the Owner's evidence establishes use of the Mark only in association with the registered goods "Door [...] hardware, made primarily of metal, namely [...] latches, locks, [...] handles, [...] leversets" within the meaning of sections 4 and 45 of the Act.

[19] As there is no evidence before me of special circumstances excusing non-use of the Mark, the remaining goods will be expunged from the registration.

DISPOSITION

[20] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete "[...] and window [...] brackets, tracks, [...] knobs, [...] hinges, operators" from the registration.

[21] The amended statement of goods will be as follows:

Door hardware, made primarily of metal, namely latches, locks, handles, leversets.

Gregory Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No Hearing Held

AGENTS OF RECORD

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For the Registered Owner

Hoffer Adler LLP

For the Requesting Party