

Federal Court



Cour fédérale

Date: 20170317

Docket: T-1617-16

Citation: 2017 FC 289

Ottawa, Ontario, March 17, 2017

PRESENT: The Honourable Mr. Justice Fothergill

BETWEEN:

LUCITE INTERNATIONAL, INC.

Applicant

and

CROLL & CO.

Respondent

JUDGMENT AND REASONS

UPON the appeal of Lucite International Inc [Lucite] pursuant to s 56(1) of the *Trade-marks Act*, RSC 1985, c T-13 of a decision of the Trade-marks Opposition Board of the Canadian Intellectual Property Office on behalf of the Registrar of Trade-marks [the Registrar], dated July 20, 2016 and recorded as 2016 TMOB 127;

AND UPON reading the Application Record of Lucite filed on January 27, 2017;

AND CONSIDERING that Croll & Co, the party that requested that Notice be issued to Lucite pursuant to s 45 of the *Trade-marks Act*, does not contest the appeal;

AND UPON being satisfied that the appeal is suitable for determination on the basis of the written record and without personal appearance of counsel;

AND CONSIDERING the following:

[1] Lucite describes itself as the global leader in the design, development and manufacture of acrylic-based products. It claims to be the world's largest supplier of methyl methacrylate, the essential building block for all acrylics. Lucite manufactures and sells methyl methacrylate, acrylic resins in both unprocessed and bead forms and acrylic sheets in association with the trade-mark LUCITE, Registration No. TMA667,621 [the Mark]. These goods are subsequently sold to third party industrial processors that manufacture finished consumer products.

[2] The Mark was registered in Canada on July 14, 2006 in connection with a broad range of goods [the Registered Goods]. On January 31, 2014, the Registrar issued Notice pursuant to s 45 of the *Trade-marks Act* requiring Lucite to provide evidence of use of the Mark in Canada in association with the Registered Goods in the preceding three years, namely from January 31, 2011 to January 31, 2014 [the Relevant Period].

[3] Following receipt of the Notice, Lucite voluntarily amended the registration of the Mark to restrict the statement of Registered Goods.

[4] The Hearings Officer was satisfied that Lucite had demonstrated use of the Mark during the Relevant Period in association with “unprocessed acrylic resin for use in manufacturing of solid shapes”. However, the Hearings Officer was not satisfied that Lucite had demonstrated use of the Mark in association with “moulding powders for use in industry” or “resin beads”. The Hearings Officer considered these goods to be broader than “unprocessed acrylic resin for use in manufacturing solid shapes”, and to potentially encompass products that are not acrylic-based.

[5] The Hearings Officer found that Lucite had provided no evidence relating to any of the “other identified “end products”, such as aquariums, signs and dental implants”. The Hearings Officer held that Lucite had not demonstrated use of the Mark in association with any of the remaining goods, nor submitted any evidence of special circumstances excusing the absence of such use.

[6] The Hearings Officer therefore amended the registration of the Mark to restrict the statement of Registered Goods to the following:

- (1) Unprocessed acrylic resin for use in manufacturing of solid shapes; chemical reagents namely methyl methacrylate.
- (2) Acrylic sheets.
- (3) Baths, showers, shower cubicles, shower trays.

[7] In this appeal, Lucite seeks to restore only “resin beads” to the list of Registered Goods.

[8] Lucite has submitted new evidence pursuant to s 56(5) of the *Trade-marks Act*, specifically the affidavit of Brent Long, Lucite’s Business Director for Sheet and Resins.

Mr. Long attests that Lucite sold resin beads to Canadian customers throughout the Relevant Period. He includes as exhibits to his affidavit a photograph of a label bearing the Mark affixed to a drum containing resin beads; a Safety Data Sheet from the Relevant Period bearing the Mark and the resin bead grade shown in the photograph; and an invoice from the Relevant Period demonstrating sale of the product in Canada.

[9] Section 45 of the *Trade-marks Act* is a housekeeping measure that is intended to rid “deadwood” from registration (*Mcdowell v Laverana GmbH & Co KG*, 2016 FC 1276 at para 19 [*Mcdowell*]; *Saks & Co v Canada (Registrar of Trade Marks)*, [1989] FCJ No 28 (TD) at para 44). The evidentiary threshold to demonstrate use of a trade-mark is therefore low (*Union Electric Supply Co Ltd v Canada (Registrar of Trade Marks)*, [1982] 2 FC 263 at para 3 (TD).

[10] Where new evidence filed in support of an appeal from a decision of the Registrar under s 45 of the *Trade-marks Act* is material, the decision must be reviewed in light of all the evidence and the Court must come to its own conclusion (*Mövenpick Holding AG v Exxon Mobil Corp*, 2011 FC 1397 at para 10; *Shell Canada Ltd v PT Sari Incofood Corp*, 2008 FCA 279 at para 22; *Mcdowell* at para 13). The deference owed to a Hearings Officer’s expertise is reduced but not eliminated (*Mcdowell* at para 12; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 37).

[11] I am satisfied that the new evidence is material to the appeal and demonstrates use of the Mark during the Relevant Period in association with “resin beads”. The appeal is therefore allowed, and the Registrar is directed to amend the registration to include “resin beads”.

JUDGMENT

THIS COURT'S JUDGMENT is that:

1. The appeal is allowed without costs to any party.
2. The Registrar shall amend Registration No. TMA667,621 for the trade-mark LUCITE to restore "resin beads" to the statement of goods.
3. The hearing date previously scheduled for March 20, 2017 in Ottawa is vacated.

"Simon Fothergill"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1617-16

STYLE OF CAUSE: LUCITE INTERNATIONAL, INC. v CROLL & CO.

JUDGMENT AND REASONS: FOTHERGILL J.

DATED: MARCH 17, 2017

BY WRITTEN SUBMISSIONS:

Robert A. MacDonald

FOR THE APPLICANT

SOLICITORS OF RECORD:

Gowling WLG (Canada) LLP
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Ottawa, Ontario

FOR THE APPLICANT