

Federal Court



Cour fédérale

**Date: 20090626**

**Docket: T-1298-07**

**Citation: 2009 FC 669**

**Ottawa, Ontario, June 26, 2009**

**PRESENT: The Honourable Madam Justice Simpson**

**BETWEEN:**

**MIRANDA ALUMINUM INC.**

**Applicant**

**and**

**MIRANDA WINDOWS & DOORS INC.**

**Respondent**

**REASONS FOR JUDGMENT AND JUDGMENT**

[1] This case involves a dispute between Antonio Miranda (the Father) and one of his sons, Tony Miranda (the Son) over the use of their surname as a trademark. The Father's company is applying to have two trademarks registered by the Son's company expunged pursuant to section 57 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

## **THE PARTIES AND THEIR TRADEMARKS**

### **The Applicant**

[2] Miranda Aluminum Inc. (the Applicant) is the Father's current company. It was incorporated on March 23, 2000 and the Father alleges that, since then, it has carried on business selling and installing aluminum products such as windows and doors using both its corporate name and the trade name Miranda Direct. The latter was registered as a business name on January 5, 2006. There is no evidence showing when the trade name was first used.

[3] The Applicant has no registered trademarks.

### **The Respondent**

[4] Miranda Windows & Doors Inc. (the Respondent) is the Son's current company. It was incorporated on March 2, 2005 and, since then, has carried on business selling and installing aluminum products.

[5] On February 20, 2006, the Respondent filed applications for the registration of two trademarks. The first was for the name Miranda (the Word Mark) and the second was a design mark which shows the name Miranda surrounded by an outline which represents a house with a roof and chimney (the Design Mark). The applications for registration say that the first use of both marks was at least as early as August 31, 1991.

**TRADEMARK 683,429**

[6] The '429 trademark is for the Word Mark. It was registered by Miranda Windows & Doors on March 13, 2007 for use in association with services described as the “Custom design and installation of windows, doors, porch enclosures, sunrooms, siding, soffit, fascia, eavestroughs, patios, garden doors, aluminum railings and railings; home renovation”. This mark was advertised on October 11, 2006.

**TRADEMARK 683,558**

[7] The '558 trademark is for the Design Mark. It was registered by Miranda Windows & Doors on March 14, 2007 for use in association with the services described above. This mark was advertised on November 15, 2006.

[8] The identity of the creator of the Design Mark is in dispute. The Father says he created it in 1995 with the Son who was working for him at the time. However, there is no documentary evidence to show that the Son was in the Father's employ in 1995. In fact, the reverse was true. The Father worked for the Son for several months that year. The Son, on the other hand, says that, in 1990, he alone created the Design Mark. He provided drafts and printing order forms to support his claim. I have therefore accepted the Son's evidence and conclude that he created the Design Mark in 1990 without his Father's assistance.

## **PREVIOUS HISTORY**

[9] Both the Father and the Son were involved in businesses supplying and installing aluminum products prior to the incorporation of their current companies. Both their businesses operated at the retail level and primarily served members of the Portuguese community in the Toronto region.

[10] Although the Father's legal name is Antonio Miranda, the evidence suggests that he is sometimes referred to as "Tony" by the Son. The Father says that, in business, he was addressed as both "Tony" and "Antonio".

### **The Father**

[11] In 1976, the Father incorporated 339231 Ontario Limited (the Numbered Company). According to the Father, it carried on business using the unregistered trade name "Miranda Aluminum". The Numbered Company became inactive when the Father was imprisoned in connection with a conviction for cocaine trafficking. The Son's evidence is that the Father was convicted in November of 1989 and that his company became inactive in 1988. The Father refused to provide the dates of his imprisonment after undertaking to do so on his cross-examination. In the absence of his cooperation, I infer that he was in pre-trial custody starting sometime in 1988 and that the Numbered Company became inactive at that time.

[12] The Corporation Profile Report from the Ontario Ministry of Consumer and Business Services shows that the Numbered Company was cancelled on February 26, 1990. At this time, the Father was still in prison.

[13] After his release on day parole in July or September of 1990, the Father worked for the Son until 1994 as a commissioned salesman on a full-time basis. From 1994 until 2000, the Father worked only sporadically for the Son, in part because he was also involved in the operation of his own new company. It was Miranda Home Improvements Ltd. and it was incorporated in 1994.

[14] Three or four years later (in 1997 or 1998), the Father transferred Miranda Home Improvements Ltd. to his son Edward. Edward operated it until 2000. Thereafter, in 2007, the company was cancelled for its failure to file tax returns.

[15] The Father's next step was to incorporate his current company, Miranda Aluminum Inc., on March 23, 2000. As described above, it is the Applicant herein.

[16] For a short period in 2005 (from March to November), the Father again worked as a salesman for the Son. However, the evidence does not show whether this was a full time activity.

### **The Son**

[17] The Son's first company was called T.M. Renovations Inc. (TMR). He incorporated it on May 11, 1989 when he was sixteen years old. On November 2, 1990, he registered the trade name Miranda Aluminum and Vinyl Products as a division of TMR.

[18] Fifteen years later, on June 17, 2004, TMR was dissolved under section 240 of the *Ontario Business Corporations Act*, R.S.O. 1990, c. B. 16 (OBCA). However, the Son was unaware of the dissolution and evidence relating to his corporate insurance shows that he continued to carry on business as TMR and continued to use his registered trade name until he incorporated his current company on March 2, 2005. It is the Respondent in this proceeding.

### **John Miranda**

[19] The Father's brother and the Son's uncle is John Miranda. From the early 1970s until 1995, he carried on wholesale businesses using two corporate names which included his surname. They were Miranda Aluminum Products Limited and Miranda Aluminum Products Inc.

[20] In 1995, John Miranda changed the first name to a numbered company and, in 1999, he changed the second name to Miranda Vinyl Products Inc. These companies are currently in business.

[21] On January 3, 2008, John Miranda assigned to TMR on his own behalf and on behalf of his companies “any trade-name or trade mark rights that he may have in the name MIRANDA”. The effective date of this assignment is November 21, 1990.

### **THE ISSUES AND ANALYSIS**

[22] Against this background the issues are:

1. Are the Respondent’s registrations invalid because they consist of a word that is primarily merely the name or surname of an individual who is living or has died within the preceding thirty years?
2. Are the registrations invalid because the Respondent was not the person entitled to register them owing to the Father’s prior use in association with the sale and installation of aluminium products?
3. Are the Respondent’s registrations invalid because they falsely suggest a connection with a living individual, namely the Father?
4. Are the Respondent’s registrations invalid because they falsely misrepresent the date of first use of the Word and Design Marks?
5. Are the Respondent’s registrations invalid because the Word and Design Marks do not distinguish the Respondent’s wares from those of the Father and John Miranda?

## Issue 1      Paragraph 12(1)(a) of the Act – Primarily Merely a Surname

[23] The Applicant says that the Respondent's trademark registrations are contrary to paragraph 12(1)(a) of the Act because Miranda is primarily merely the surname of an individual.

[24] Paragraph 12(1)(a) provides that:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

(a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

12. (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :

a) elle est constituée d'un mot n'étant principalement que le nom ou le nom de famille d'un particulier vivant ou qui est décédé dans les trente années précédentes;

### *The Word Mark*

[25] With regard to the Word Mark, there is no question that Miranda is a surname. The question is whether it is primarily merely a surname. Although Miranda is used to describe the rights of an accused when arrested in the United States, I do not think that this meaning is well known in this country. In my view, the Word Mark would not be registrable under paragraph 12(1)(a). However, subsection 12(2) deals with acquired distinctiveness and reads as follows:

12. (2) A trade-mark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration.

12. (2) Une marque de commerce qui n'est pas enregistrable en raison de l'alinéa (1)a) ou b) peut être enregistrée si elle a été employée au Canada par le requérant ou son prédécesseur en titre de façon à être devenue distinctive à la date de la production d'une demande d'enregistrement la concernant.



[26] The Father submits that the Son's evidence of use is not meaningful because much of it refers to the Son personally and not to the Respondent corporation, which is the registered owner of the marks. The Father says that the Respondent's advertisements, customer testimonials, and evidence of use show that his customers associated the Word and Design Marks only "with Tony E. Miranda, personally" as of February 20, 2006, when the applications for trademark registration were filed. The Son, on the other hand, says that the fact that customers identify his wares and services with him personally proves the acquired meaning and distinctiveness of the marks and the fact that they actually distinguish his company's wares and services from those of others. I agree with the Respondent and have therefore concluded that the Word Mark had acquired distinctiveness by February 20, 2006.

[27] I have based this finding on: (i) evidence showing that the Respondent received the 2006/2007 Top Choice Award for "Home Improvement Company of the Year"; (ii) photographs which show prominent use of the Word and Design Marks on the Respondent's mobile showroom, its fleet of trucks and trailers, its booths, its banners and its promotional material at community events; and (iii) the Respondent's two English language television commercials which show the Son associated with the Respondent. I have also relied on thirty testimonials from clients and others showing that the public associates the Word and Design Marks with the products and services of the Son and his company, Miranda Windows & Doors Inc.

*The Design Mark*

[28] The Design Mark is not disqualified under paragraph 12(1)(a) of the Act because, in my view, the outline of the house with the chimney on the roof is sufficient to support a finding that the Design Mark is not primarily merely a surname. In any event, the evidence cited above also supports a finding of “acquired distinctiveness” for the Design Mark as of the date of filing the trademark applications.

**Issue 2 Was the Father the Prior User of a Confusing Mark?**

[29] The Father says that, the Son’s first company, TMR, lost its ownership of its Word and Design Marks in 2004 when it was dissolved. I agree that, pursuant to section 244 of the OBCA, the common law Word and Design Marks were forfeited to and vested in the Crown on the dissolution of TMR in June of 2004. The Father says that, at this date, he became the prior user under the Act based on his use since 1976.

[30] Subsection 17(1) of the Act reads as follows:

**17. (1)** No application for registration of a trade-mark that has been advertised in accordance with section 37 shall be refused and no registration of a trade-mark shall be expunged or amended or held invalid on the ground of any previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant for that registration or his predecessor in title, except at

**17. (1)** Aucune demande d’enregistrement d’une marque de commerce qui a été annoncée selon l’article 37 ne peut être refusée, et aucun enregistrement d’une marque de commerce ne peut être radié, modifié ou tenu pour invalide, du fait qu’une personne autre que l’auteur de la demande d’enregistrement ou son prédécesseur en titre a antérieurement employé ou révélé une marque de commerce ou un nom

the instance of that other person or his successor in title, and the burden lies on that other person or his successor to establish that he had not abandoned the confusing trade-mark or trade-name at the date of advertisement of the applicant's application.

commercial créant de la confusion, sauf à la demande de cette autre personne ou de son successeur en titre, et il incombe à cette autre personne ou à son successeur d'établir qu'il n'avait pas abandonné cette marque de commerce ou ce nom commercial créant de la confusion, à la date de l'annonce de la demande du requérant.

[31] On the issue of prior use it is helpful to start with a summary of the Father's use of the name Miranda:

- (a) 1976-1988 – The Father says that Miranda was used by his Numbered Company in its unregistered trade name, Miranda Aluminum. However, there is no supporting documentary evidence. There are no corporate or financial records, no advertisements and no yellow pages listings. The only purported evidence is a picture of a truck with a sign which reads “Miranda Aluminum”. The Father's evidence is that the truck was used in the 1970s. However, the license plate is dated March 1973 which was before the incorporation of the Numbered Company. This suggests that it was John Miranda's truck. He was the only member of the Miranda family in the aluminum business in 1973 and, at that time, both his corporate names began with the words Miranda Aluminum. I have therefore concluded that the Father's evidence that the truck showed his use is not credible.
- (b) 1988-1994 – The name Miranda was abandoned by the Father. He was in prison and the Numbered Company was cancelled. He also worked for his Son in this period.

- (c) 1994-1997/1998 – The name Miranda was allegedly used by the Father in connection with Miranda Home Improvements Ltd., but, in my view, he abandoned the name when he transferred the company to his son Edward. In any event, the only purported evidence of use before the transfer is based on a picture dated 1996 which shows the Father beside a truck bearing a sign which, although partly hidden by plants, clearly reads “Miranda Windows and Doors” and shows 974 as the final three digits of a telephone number. This is the Son’s corporate name and the Son’s telephone number ends in 974. I therefore accept the Son’s evidence that the truck in the photograph belonged to the Son and, again, find that the Father’s evidence is not credible.
- (d) 2000 to the present – The Father’s evidence of his use of the name Miranda name in this period shows that he used it in a manner that appears to have been intended to make his potential customers believe that his business was actually his Son’s business. The evidence is as follows:
- (i) Seven purchase orders dated between May 2000 and September 2004 which show the Son’s Design Mark altered by the Father to include the words Miranda Aluminum.
  - (ii) A lawn sign which shows the Son’s Design Mark without alteration accompanied by the words “windows and doors” so that the words, when read together, appear to be the Son’s corporate name. Approximately 100 such signs were allegedly displayed in the period from 1999 to the present. The Father’s phone number appears at bottom of the sign.

- (iii) The Father says he distributed thousands of flyers annually in this period. The flyers were apparently printed with three different headings: Miranda Aluminum Inc., Miranda Direct, and the Design Mark. The “representative” flyer in the Father’s evidence is headed Miranda Direct Ltd. and says in large print “call Tony Miranda”. It bears the Father’s phone number. Since Miranda Direct only became the Applicant’s registered trade name on January 5, 2006, I assume, in the absence of evidence about its actual use, that this flyer was not used before 2006. It is noteworthy that the pictures of installed windows and doors on the flyer are identical to the pictures on the Son’s flyer.
- (iv) A second version of the Father’s flyer was produced by the Son. It has the Design Mark at the top altered to say “Aluminum and Vinyl Products” under the name Miranda. This had been the Son’s registered trade name for TMR. It also says “call Tony Miranda” and shows the photos of installed windows and doors which appear on the Son’s flyer. The flyer does bear the Father’s telephone number.
- (v) The Father provided a DVD which played a television commercial in the Portuguese language. No translation was provided. The commercial aired during Portuguese programming on OMNI television in Toronto in 2006. It showed the Father and a lawn sign which read Miranda Direct, Vinyl Windows and Doors. It also included his phone number and said “call Tony Miranda”. The Son says, and I accept, that two of the windows featured in the commercial were, in fact, his installations. A report from Mr. Julio Peters, the Son’s private investigator, indicated that, at the time the commercial was being shown, a call to the telephone number displayed led to a

subsequent meeting during which the investigator was advised by the Father that the Son's company Miranda Windows and the Father's company Miranda Direct were the same company.

[32] In my view, the Father's evidence does not establish prior use of the name Miranda. Before 2000, the evidence of use is not credible and, even if the Miranda name was used, it was twice abandoned. Further, between 2000 and 2004, when TMR was dissolved, the Father's use of the name Miranda in the Design Mark was calculated to confuse customers. This is not prior use which entitles the Applicant to the benefit of subsection 17(1) of the Act.

**Issue 3 Paragraph 9(1)(k) of the Act – Falsely Suggesting a Connection with the Father**

[33] Paragraph 9(1)(k) provides that:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

[...]

(k) any matter that may falsely suggest a connection with any living individual;

9. (1) Nul ne peut adopter à l'égard d'une entreprise, comme marque de commerce ou autrement, une marque composée de ce qui suit, ou dont la ressemblance est telle qu'on pourrait vraisemblablement la confondre avec ce qui

suit :

[...]

k) toute matière qui peut faussement suggérer un rapport avec un particulier vivant;

[34] The Son adopted the name Miranda in November 1990 when he registered Miranda Aluminum and Vinyl Products as TMR's trade name. At that date: the Father was working for the Son as a salesman; the Father had been out of business since 1988; and the corporate registration for

his Numbered Company had been cancelled. Further, the Father's arrest and imprisonment was publicized. In these circumstances, it cannot be said that the Son adopted the name Miranda at a time when the public would falsely have made a connection with the Father in association with the supply and installation of aluminum products.

**Issue 4            Is there a False Claim of First Use?**

[35]    The Respondent claims first use at least as early as August 31, 1991. However, the earliest documentary evidence of use is a purchase order dated at Mississauga on October 5, 1991.

[36]    The Applicant relies on the decision of Mr. Justice Fred Gibson in *Unitel Communications Inc. c. Bell Canada*, 61 C.P.R. (3d) 12, in which two trademarks were found to be void *ab initio* because the declarations of use were false. In that case, applications for the proposed use of the trademarks Calling Card and Carte d'appel were applied for and thereafter declarations of use were filed. However, counsel for the Respondent admitted that the declarations were false and that the marks had, in fact, never been used.

[37]    In my view, this decision has no present application. There is no evidence in this case to suggest that the Respondent's declaration of first use is false. The Son's affidavit states that TMR used the marks before August 1991. In these circumstances, the fact that the first documentary evidence of use is dated two months after the first use stated in the trademark applications is not sufficient to justify expunging the Respondent's trademarks.

**Issue 5            Distinctiveness**

[38] Paragraph 18(1)(b) of the Act provides that a registration is invalid if a trademark is not distinctive at the time the proceedings bringing the validity of the mark into question are commenced.

[39] The Father commenced this application to expunge the Word and Design Marks on July 16, 2007. By that date the Father had incorporated Miranda Aluminum Inc. (on March 23, 2000) and had allegedly carried on business supplying aluminum products using the names Miranda Aluminum Inc. and Miranda Direct.

[40] The Father must convince me on a balance of probabilities that his use or use by John Miranda at July 16, 2007 was such that the Respondent's Word and Design Marks had lost the distinctiveness they had acquired by that date.

[41] Looking first at the Father, the evidence of his use is described above. For the most part, it indicates that the Father was carrying on business using altered versions of the Son's Design Mark. In these circumstances, he cannot rely on his evidence of use to show a lack of distinctiveness.

[42] However, by July 2007, the Father had also used the Miranda Direct flyer and had aired the OMNI television commercial. In my view, (i) the evidence of the Son's private investigator relating



to April 2000 and (ii) the evidence of Maria Valente, who provided an affidavit in which she said that the Father told her in April 2006 that Miranda Direct was the same company as Miranda Windows and Doors, show that the Father's use of the name Miranda as early as 2006 was not intended to present the Applicant as a distinct company. Given these facts and the clear evidence of the distinctiveness of the Respondent's Word and Design Marks, I am not persuaded that paragraph 18(1)(b) of the Act applies.

[43] Further, the evidence clearly shows that the Respondent's Word and Design Marks were widely used and well-known when this application was commenced.

[44] The Applicant's allegation of lack of distinctiveness also involves the business of John Miranda. However, his business has always been the manufacturing and sale of aluminum products at the wholesale level. Accordingly, I have concluded that his use of the Miranda name has no bearing on the distinctiveness of the Respondent's Word and Design Marks which are only used in retail sales.

### **JUDGMENT**

**THIS COURT ORDERS AND ADJUDGES that**, for the reasons given above, the application is hereby dismissed with costs.

“Sandra J. Simpson”

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Judge

**FEDERAL COURT**

**NAME OF COUNSEL AND SOLICITORS OF RECORD**

**DOCKET:** T-1298-07

**STYLE OF CAUSE:** MIRANDA ALUMINUM INC.  
APPLICANT  
and  
MIRANDA WINDOWS & DOORS INC.  
RESPONDENT

**PLACE OF HEARING:** Toronto, Ontario

**DATE OF HEARING:** NOVEMBER 24 AND 25, 2008

**REASONS FOR JUDGMENT  
AND JUDGMENT:** SIMPSON, J.

**DATED:** JUNE 26, 2009

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