



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

Reference: 2014 TMOB 20
Date of Decision: 2014-01-27
TRANSLATION

**IN THE MATTER OF A SECTION 45 PROCEEDING,
requested by 88766 Canada Inc. against registration
No. TMA279,652 for the trade-mark ASPHALTE
LAURENTIEN in the name of Asphalte Desjardins Inc.**

[1] On September 19, 2011, at the request of 88766 Canada Inc. (the Applicant), the registrar sent the notice stipulated in Section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Asphalte Desjardins Inc. (the Registrant), enjoining the latter to prove use of the ASPHALTE LAURENTIEN trade-mark (the Mark) in association with: bituminous concrete production and placement services (the Services).

[2] Section 45 of the Act requires the Registrant to show that it has used its Mark in Canada in association with each of the Services specified in the registration at any given time during the three years preceding the date of the notice or, if not, provide the date on which it was last used and the reason for its absence of use since this date. The relevant period is therefore from September 19, 2008 to September 19, 2011 (the Relevant Period).

[3] The procedure pursuant to Section 45 is simple and expeditious, and serves to clear “deadwood” from the register. Accordingly, the threshold to establish use of the Mark, within the meaning of Section 4 of the Act, during the Relevant Period is not very high [see *Uvex Toko Canada Ltd v. Performance Apparel Corp* (2004), 31 CPR (4th) 270 (CF 1st inst.)].

[4] A simple claim of use of the Mark in association with the Services is not sufficient to establish its use within the meaning of Section 4(2) of the Act. There is no requirement to produce abundant evidence. However, any ambiguity in the evidence will be interpreted against the Registrant [see *Plough (Canada) Ltd v. Aerosol Fillers Inc* (1980) 53 CPR (4th) 62 (FCA)].

[5] In reply to the notice, the Registrant submitted an affidavit from its Vice-President, Finance, Mr. Michel Bélair. The Registrant alone submitted written representations. The Registrant had requested a hearing but subsequently withdrew its request. Accordingly, a hearing was not held.

[6] Before beginning analysis of this evidence, I would like to reproduce the text from Section 4(2) of the Act:

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] Mr. Bélair explains that he has been employed by the Registrant since April 22, 1991. He says that the Registrant has been active in the production and placement of bituminous concrete since September 1980. It has approximately 325 employees.

[8] Mr. Bélair claims the Registrant has rendered the Services to many well-known companies in Canada, including the Quebec Department of Transport and Pavage Jérémien Inc. He attached to his affidavit a price list for bituminous concrete produced under the Mark in effect in October 2011, i.e. after the Relevant Period.

[9] Mr. Bélair states that the Registrant owns its own production plants displaying the banner under the Mark. He submitted a list of the Registrant's plants displaying the Mark. He also submitted two representative photos (taken during the Relevant Period) of two banners displaying the Mark located at the production plant in Mirabel. He confirms that these banners showing the Mark have been displayed at the production plant since as early as 1995 and were still on display at the production plant in question on the signature date on his affidavit (December 14, 2011).

[10] Mr. Bélair submitted the Registrant's sales figures in association with the Services and the Mark for the period from September 19, 2008 to December 31, 2008, and for the years 2009

and 2010; and lastly for the period from January 1, 2011 to September 30, 2011. These figures total over \$4 million.

[11] Mr. Bélair submitted in bundle invoices relating to the Services rendered under the Mark. He claims that the services rendered and described in the invoices correspond to the bituminous concrete production and placement services rendered by the Registrant. Mr. Bélair also states that the Registrant participated in numerous requests for proposals issued by government entities to obtain contracts in order to provide the Services under the Mark. On this point, he submitted a copy of an excerpt of the Contract follow-up report issued by the Quebec Department of Transport listing contracts awarded to the Registrant on May 18, 2010 for the Services provided under the Mark.

[12] Lastly, Mr. Bélair submitted an excerpt from a procurement contract awarded by the Quebec Department of Transport, dated May 18, 2010, which refers to the Mark.

[13] In light of this evidence, I agree with the Registrant when it claims in its written representations that the evidence described above shows that there had been use of the Mark in Canada within the meaning of Section 4(2) of the Act in the normal course of business during the Relevant Period in association with the bituminous concrete production services. In effect, the Mark appears clearly on the banner located on the site of the Registrant's plant where the bituminous concrete is produced. This banner has been on the site since as early as at least the Relevant Period. Mr. Bélair submitted invoices issued during the Relevant Period for the delivery of bituminous concrete by the Registrant in association with the Mark. Mr. Bélair submitted excerpts of contracts awarded during the Relevant Period for the provision of bituminous concrete in association with the Mark.

[14] However, is there proof of use of the Mark in association with the bituminous concrete placement services? In his affidavit, Mr. Bélair uses the defined term "Services" to designate both the services of production and placement of bituminous concrete. However, nowhere in the documentary evidence submitted (price list, invoices, contracts) is there mention of bituminous concrete placement services.

[15] Clearly, reference is made to the delivery cost of bituminous concrete and to the delivery sites, but there is no mention of the specific commercial activity of the placement of bituminous concrete produced and delivered by the Registrant. The latter has not shown that the delivery of the bituminous concrete to a site constituted in itself, in the normal course of business, the placement of bituminous concrete. In the absence of evidence on this point, I can only infer that the delivery was the equivalent to placement.

[16] The Registrant provided no explanation that could constitute special circumstances within the meaning of Section 45(3) of the Act justifying the absence of use of the Mark in association with the bituminous concrete placement services during the Relevant Period. Under the circumstances, I conclude that the Registrant has not met its burden of proving the use of the Mark in association with the bituminous concrete placement services during the Relevant Period.

Disposal

[17] Accordingly, in exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, the registration TMA279,652 will therefore be amended such that the statement of services reads as follows:

Bituminous concrete production and placement services.

the whole pursuant to the provisions of Section 45 of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Alan Vickers