



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

**Citation: 2010 TMOB 220**  
**Date of Decision: 2010-12-20**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Fetherstonhaugh & Co. against registration  
No. TMA256,653 for the trade-mark TORFLEX in the  
name of Abacus Hydraulics Ltd.**

[1] At the request of Fetherstonhaugh & Co. (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on February 4, 2009 to Abacus Hydraulics Ltd. (the Registrant), the registered owner of the above-referenced trade-mark (the Mark).

[2] The Mark is registered for use in association with the following wares and services:

Couplings for the transmission of torque (the Wares)

Designing, manufacturing and overhauling of hydraulic machinery (the Services)

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and services 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 between February 4, 2006 and February 4, 2009 (the Relevant Period).

[4] “Use” in association with wares and services is set out in s. 4 of the Act:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(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.

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and as such, the evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice Russell in *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owners' business and merchandising practices.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of its President E.A. Tirschler, sworn April 29, 2009, together with Exhibits “A” through “C”.

[7] In the affidavit, Mr. Tirschler states that the Mark has been used since at least as early as October 1969 in association with the Services, and at least as early as January 14, 1981 in association with the Wares. Exhibits to the affidavit are an extract of the trade-mark registration at issue, invoices and a prospectus.

[8] Both parties filed written representations; an oral hearing was not requested.

## Wares

[9] The prospectus, which shows the mark, contains pictures of mill inching drives and some of their parts, including the Wares. It appears that the Mark is not marked on the Wares. In any event, it is settled law that use on advertising and informational literature is not use within the meaning of s. 4(1) of the Act unless it can be shown that advertising and informational literature accompany the wares (*BMW Canada Inc. v. Nissan Canada Inc.* (2007), 60 C.P.R. (4th) 181 (F.C.A.), *Grapha-Holding AG v. Illinois Tool Works Inc.* (2008), 68 C.P.R. (4th) 180 (F.C.)). The affidavit makes no reference in this regard, and as such, with regards to the prospectus, it is not evidence that there has been use of the Mark in association with the Wares during the relevant period according to s. 4(1) of the Act.

[10] Three invoices were also provided by the Registrant. The wares “shifter gear” appear in one invoice in association with the Mark, and “gear hubs” are included in all three invoices, also in association with the Mark, but nowhere can we find the wares “couplings”. It may be that “shifter gear” and “gear hubs” are more specific descriptions of couplings (see *Aird & Berlis LLP v. Levi Strauss & Co.*, 2006 FC 654, 51 C.P.R. (4th) 434, 293 F.T.R. 292), however no evidence in this regard was brought before me, and as such I am unable to conclude that “shifter gear” and “gear hubs” are couplings.

[11] In addition, all three invoices indicate addresses in the United States of America, with two of them having shipping addresses in Canada. It appears that the shifter gear and gear hubs were purchased by American companies but shipped to locations in Canada. In some circumstances, invoices can be accepted as evidence of the association of the mark with the wares pursuant to s. 4(1) (*Gordon A. Maceachern Ltd. v. National Rubber Co. Ltd.* (1963) 41 C.P.R. 149 (Ex. Ct.)). However, in *Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000) 8 C.P.R. (4th) 471 (F.C.T.D.) it was held that it cannot be assumed that invoices follow the wares, and the evidentiary onus is on the registrant to show that the invoices accompanied the wares at the time of transfer. In the present case, the Mark is seen in the body of the invoices, next to a description of the Wares, but it appears that the Wares were purchased by American companies but shipped to locations in Canada. Accordingly, I am unable to conclude that the invoices accompanied the wares.

[12] The third invoice, also dated during the relevant period, was addressed to a location in the United States of America, with an identical shipping address. Since it appears that these wares were shipped to the United States of America, I must consider whether s. 4(3) of the Act applies. Section 4(3), as set out above, requires that the trade-mark be marked in Canada on the wares or their packaging when the wares are exported from Canada (*Molson Companies Ltd. V. Moosehead Breweries Ltd.* (1990), 32 C.P.R. (3rd) 363 at 372-373 (F.C.T.D)). As set out previously, there is no evidence before me demonstrating that the mark was displayed on the Wares, and no evidence was provided regarding the packaging of the Wares. Accordingly, I am unable to conclude that there has been use of the Mark during the relevant period according to s. 4(3) of the Act.

### **Services**

[13] I note that there is no reference to designing, manufacturing and overhauling of hydraulic machinery anywhere on the invoices, and I do not consider that Exhibit C evidences use on those services. Although there is some indication on the prospectus of custom design, there is no indication in the affidavit that the prospectus has been distributed in Canada, nor to whom it was distributed, or how many were distributed, if any. Therefore, I am unable to conclude that there has been use on the Services during the relevant period according to s. 4(2) of the Act.

[14] Accordingly, and pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be expunged in compliance with the provisions of s. 45 of the Act.

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Darlene Carreau  
Chairperson  
Trade-marks Opposition Board  
Canadian Intellectual Property Office