



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

Citation: 2016 TMOB 143
Date of Decision: 2016-08-22

IN THE MATTER OF A SECTION 45 PROCEEDING

**Norton Rose Fulbright Canada
LLP/S.E.N.C.R.L., s.r.l.**
and

Requesting Party

Sika AG

Registered Owner

TMA135,190 for PLASTOCRETE

Registration

[1] At the request of Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., s.r.l., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on July 17, 2014 to Sika AG (the Owner), the registered owner of registration No. TMA135,190 for the trade-mark PLASTOCRETE (the Mark).

[2] The Mark is registered for use in association with the following goods: “Preparations for improving the binding and setting properties of cement, mortar, concrete, plaster and other similar construction materials, when added thereto”.

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the goods specified in the registration, at any time between July 17, 2011 and July 17, 2014. If the Mark had not been so used, the registered owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark 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 the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register. As such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Michael P. Hardman, sworn on February 12, 2015 in Niagara-on-the-Lake, Ontario. Only the Owner filed written representations; a hearing was not requested.

The Owner’s Evidence

[7] In his affidavit, Mr. Hardman identifies himself as President of Sika Canada Inc., which he describes as a fully-owned subsidiary of the Owner. He explains that, under the oversight and direction of the Owner, Sika Canada is responsible for “research and development, sales, administration, marketing and production activities relating to the PLASTOCRETE products in Canada” and operates as the main distribution center of the Owner’s products in Canada.

[8] Mr. Hardman attests that the Mark is used in association with “admixtures for cement, mortar, concrete, plaster and other similar construction materials”, corresponding with the registered goods. He states that such products are manufactured by Sika Canada “in strict accordance” with parameters set out by the Owner and then sold through various Canadian distributors or directly to Canadian customers, such as retailers, ready-mix plants, contractors and homeowners.

[9] With respect to the manner of display of the Mark, attached as Exhibit B to Mr. Hardman’s affidavit are five photographs that he attests show how the Mark was used on packaging during the relevant period. The photographs show various labels for “Water-Reducing Admixture”, both in isolation and on a large metal container. The Mark appears on the labels, followed by the registered trade-mark symbol.

[10] With respect to transfers of such goods, attached as Exhibit A to Mr. Hardman's affidavit are over 30 representative invoices, all dated within the relevant period, showing sales of various quantities of "Sika Plastocrete" to Canadian customers. Mr. Hardman also attests to total sales in Canada during the relevant period of approximately \$6-million, amounting to over 5-million litres of the aforementioned PLASTOCRETE admixtures.

[11] In view of the foregoing, and in the absence of representations from the requesting party, I am satisfied that the Owner has demonstrated use of the Mark in association with the goods as registered within the meaning of sections 4 and 45 of the Act.

Disposition

[12] Accordingly, 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 maintained.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No hearing held

AGENTS OF RECORD

Marks & Clerk

For the Registered Owner

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., s.r.l.

For the Requesting Party