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

Citation: 2016 TMOB 68
Date of Decision: 2016-04-27

IN THE MATTER OF A SECTION 45 PROCEEDING

NORTON ROSE FULBRIGHT CANADA	**Requesting Party**
and	
VSL CANADA LTD.	**Registered Owner**
TMA239,757 for VSL	**Registration**

[1] At the request of NORTON ROSE FULBRIGHT CANADA (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on June 9, 2014 to VSL CANADA LTD. (VSL Canada), the registered owner of registration No. TMA239,757 for the trade-mark VSL (the Mark).

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

- Post-tensioning cables and tendons; rock and soil anchors; grouting.

- Design, supply and placement of reinforcing steel; lifting and jacking services for the construction industry; the design, supply and placement of post tensioning components and materials.

[3] The notice required VSL Canada to furnish evidence showing that the Mark was in use in Canada, in association with the goods and services specified in the registration, at any time between June 9, 2011 and June 9, 2014 (the relevant period). If the Mark had not been so used,

VSL Canada 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] 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. While mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1979), 45 CPR (2d) 194, aff'd (1980), 53 CPR (2d) 63 (FCA)], the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v Woods Canada Ltd* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [see *Union Electric Supply Co v Canada (Registrar of Trade-marks)* (1982), 63 CPR (2d) 56 (FCTD)]. However, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods or services specified in the registration during the relevant period.

[5] In response to the Registrar's notice, VSL Canada furnished an affidavit of its President, Kevin Sawchyn, sworn on June 7, 2015 (the Sawchyn affidavit). Both parties filed written submissions and attended an oral hearing.

[6] Section 4 of the Act sets out the meaning of "use". In the present case, VSL Canada has conceded non-use of the Mark with respect to all of the registered goods. Furthermore, VSL Canada has not brought forth any special circumstances to excuse such non-use. Thus, the only applicable definition of "use" in the present case is with respect to the registered services. Specifically, it is section 4(2) of the Act that applies:

> 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] This brings me to review the evidence filed by VSL Canada by way of the Sawchyn affidavit.

[8] Mr. Sawchyn states that VSL Canada offers "rebar placing services and installation of post-tensioning cables". VSL Canada is based in Stoney Creek, Ontario and operates as a subsidiary of Harris Steel Group Inc., a steel fabricator and processor in Canada [para 1].

[9] Mr. Sawchyn states that VSL Canada has used the Mark "in association with the operation of its business and the [s]ervices covered by the registration, all of which are part of its rebar placing and post-tensioning cable installation services." He further states that VSL Canada "has been operating using VSL since at least as early as October 1968 and during the [relevant period] in Canada in the ordinary course of its business" [para 4].

[10] Mr. Sawchyn states that since at least as early as October 1968, and during and after the relevant period, the Mark has consistently appeared on corporate printed materials such as letterhead, invoices, cheques and payments. He states that VSL Canada is the largest single employer of ironworkers in Canada and often employs up to 800 unionized ironworker employees "who generally refer to their employer as 'VSL' and who receive cheques that include the [Mark]." He goes on to state that: "Consequently, it is [his] belief that ironworkers know of and refer to VSL Canada as 'VSL'" [para 5].

[11] Mr. Sawchyn states that VSL Canada uses the Mark "in connection with rebar placing services and installation of post-tensioning cables all of which are provided to the construction contracting community as part of construction projects in the provinces of Alberta, British Columbia, Manitoba, New Brunswick, Newfoundland and Labrador, Nova Scotia, Ontario, Prince Edward Island, Quebec and Saskatchewan."

[12] In support of his assertions of use, Mr. Sawchyn attaches the following exhibits to his affidavit:

- Exhibit "B": which Mr. Sawchyn describes as consisting of "a copy of the August 2010 issue of *The Ironworker* referencing VSL Canada as 'VSL' and highlighting its significant involvement in the Port Mann Bridge Project, a project in which VSL Canada was involved during the [r]elevant [p]eriod and is currently involved";

- Exhibit "C-1": which Mr. Sawchyn describes as consisting of a representative sample of "VSL Canada Ltd. Letterhead";

- Exhibit "C-2": which Mr. Sawchyn describes as consisting of a representative sample of "VSL Canada Ltd. Invoices";

- Exhibit “C-3”: which Mr. Sawchyn describes as consisting of a representative sample of “vendor payments”; and

- Exhibit “C-4”: which Mr. Sawchyn describes as consisting of a representative sample of “employee paycheques”.

[13] The Requesting Party made numerous submissions with respect to the Sawchyn affidavit and accompanying exhibits. Its two main arguments are that VSL Canada has not filed any evidence of use of “VSL” *as a trade-mark* during the relevant period – rather, the Requesting Party submits that the evidence merely shows that VSL Canada has been using “VSL” solely as part of its corporate name; and that no evidence has been provided to demonstrate use in association with *any of the registered services*.

[14] Commenting on Exhibit “B”, the Requesting Party points out that:

- *The Ironworker* magazine is described as an official publication of the *International Association of Bridge, Structural, Ornamental and Reinforcing Iron Workers* based in Washington, D.C.;

- no information is provided as to the circulation of this publication in Canada;

- the August 2010 issue predates the relevant period by almost a year; and

- the one and only mention made of “VSL” in the article referred to therein is to refer to the business entity “VSL Canada Ltd.” rather than as a trade-mark to identify any of the services listed in the registration.

[15] Thus, the Requesting Party submits that it is of no assistance to VSL Canada in the present case.

[16] I agree.

[17] The article merely leads support to some of Mr. Sawchyn’s statements regarding the scale of VSL Canada’s operations in Canada. It by no means establishes use of the Mark pursuant to

section 4(2) of the Act in association with any of the services listed in the registration during the relevant period. Suffice it to reproduce the following excerpts:

> In 2009, VSL Canada, part of the Harris Rebar Group, was awarded a contract to supply and install 50,000 tons of reinforcing steel on the Port Mann Bridge Project, a new 10-lane crossing over the Fraser River near Vancouver in British Columbia.
>
> […]
>
> Local 97 (British Columbia, Vancouver) is the only building trades union on the job, with over 150 reinforcing ironworkers at the peak performing more than a ½ million man-hours of work. These reinforcing ironworkers are being led by VSL's placing manager, long-time Local 97 member Roger Lussier and Ray Dosworth, superintendent, also a long-time Local 97 member.
>
> […]
>
> This project, which is the largest ever undertaken in British Columbia by VSL Canada, will replace a 40 year-old bridge that now faces an amazing 13 hours a day of heavy congestion.
>
> VSL Canada, which is British Columbia's largest rebar placing company, attributes its success to its people.

[18] Turning to Exhibits "C-1", "C-3" and "C-4", relying among others on the cases of *Road Runner Trailer Mfg v Road Runner Trailer Co* (1985) 1 CPR (3d) 443 (FCTD); *1082205 Ontario Ltd (R.E.M. Inc) (Re)* (2001), 19 CPR (4th) 103 (TMOB); and *Sunny Fresh Foods Inc v Sunfresh Ltd* (2003), 30 CPR (4th) 118 (TMOB), the Requesting Party submits that they no more establish use of "VSL" as a trade-mark in association with any of the registered services. Rather, "VSL" always appears in association with the words "CANADA LTD." in a unified font and size as well as an address. In all cases, "VSL" is not presented in a manner which sets it apart from the corporate name "VSL CANADA LTD." or in such manner that it would be perceived as a distinct trade-mark in itself and not merely identification of a legal entity.

[19] Moreover, relying on the case of *Smith, Lyons, Torrance, Stevenson & Mayer v Pharmaglobe Laboratories Ltd* (1996), 75 CPR (3d) 85 (TMOB), the Requesting Party further submits that the blank sheet of "VSL Canada Ltd. Letterhead" filed under Exhibit "C-1" is insufficient to show the Mark being used during the relevant period in the advertising or performance of any of the registered services. In the same vein, the Requesting Party submits

that the blacked out samples of "vendor payments" and "employee paycheques" filed under Exhibits "C3" and "C-4" by no means evidence use of the Mark in association with any of the registered services as, among other things, no information is provided about the nature of the services paid for, not to mention that it is also unclear how the mere display of the Mark on employee paycheques and vendor payments would constitute advertising or use in the performance of the registered services.

[20] Thus, the Requesting Party submits that Exhibits "C-1", "C-3" and "C-4" are of no assistance to VSL Canada in the present case.

[21] I agree.

[22] In *Road Runner*, the Federal Court, Trial Division held that: "When a mark is part of a corporate name it does not constitute a bar. One must be reluctant in maintaining such a mark but there are circumstances when it can be sustained." The Court went on to hold that the presumption that a company name is a trade-name rather than a trade-mark had in fact been rebutted in that case because the mark appeared in greater prominence, it created a distinctive element of the corporate name, and it appeared on the goods.

[23] As set out by the Requesting Party, this presumption has not been rebutted by Exhibits "C-1", "C-3" and "C-4", which merely establish use of the corporate name "VSL CANADA LTD." on blank or blacked out samples of VSL Canada's letterhead, employee paycheques and vendor payments. Despite the emphasis placed by VSL Canada's representative during the hearing on the long-established business of VSL Canada, the issue at stake is not whether VSL Canada is a well-established business and employer in Canada, but whether it has shown use of "VSL" as a trade-mark (and not merely as part of a corporate name or as a corporate identifier) in association with each of the registered services during the relevant period.

[24] This leaves us with Exhibit C-2, which VSL Canada submits is the crux of the evidence in the present case. For the ease of discussion, I am reproducing in the schedule hereto one of the representative sample invoices filed under this exhibit.

[25] Relying on the two main arguments set out above, the Requesting Party submits that Exhibit C-2 is of no more assistance to VSL Canada.

[26] I agree.

[27] Despite the fact that "VSL" appears in capital letters in the top of the invoices, it is always followed by the words "Canada Ltd." appearing in the exact same style of font and size. "VSL" is not presented in a manner which sets it apart from the corporate name "VSL Canada Ltd." or in such manner that it would be perceived as a distinct trade-mark in itself. My finding is reinforced when considering the fact that the same mention of "VSL Canada Ltd." also appears at the bottom left-hand corner of the invoice together with the mention "Remit To:" and corporate contact information. While I acknowledge that trade-mark and trade-name usage are not necessarily mutually exclusive [see *Consumers Distributing Company Limited v Toy World Limited*, 1990 CarswellNat 1398 (TMOB)], I find that the name "VSL Canada Ltd.", as shown in the invoices, would be perceived as the corporate name of VSL Canada and therefore as identifying VSL Canada. In other words, it would not be perceived as use of the trade-mark "VSL" *per se*. The presumption that "VSL Canada Ltd." is a company name rather than a trade-mark has not been rebutted.

[28] Moreover, on all three copies of invoices filed under Exhibit "C-2", the dates have been blacked out without any reason. It is also unclear what each of the invoices relates to. On the first two invoices, the "contract details" merely mention one item described as "Rebar Placing", whereas the third one mentions: "Placing Rebar – Black"; "Placing Rebar – Epoxy"; and "Placing Rebar – Stainless". As mentioned above, Mr. Sawchyn baldly states in paragraph 4 of his affidavit "that VSL Canada has used the [Mark] in association with the operation of its business and the [s]ervices covered by the registration, all of which are part of its rebar placing and post-tensioning cable installation services". However, as stressed by the Requesting Party, no correlation is made between the invoices and each of the three specific categories of services listed in the registration, an ambiguity that I must interpret against the interests of VSL Canada [see *Plough*, *supra*].

[29] Although evidentiary overkill is not required in section 45 proceedings, section 45 nonetheless imposes an onus on the registrant to provide sufficient facts from which the Registrar can determine that the trade-mark was in use during the relevant period in association with the registered goods and services. The evidence in this case does not meet that threshold. In

addition, the Sawchyn affidavit indicates apparent confusion on VSL Canada's part as to the difference between a trade-mark and a trade-name. Hearsay deficiencies aside, the fact that "ironworkers know of and refer to VSL Canada as 'VSL'", is not pertinent. Again, the issue at stake is whether VSL Canada has shown use of "VSL" as a trade-mark in association with each of the registered services during the relevant period.

[30] Before closing, I will note that VSL Canada's representative made submissions both in its written representations and at the hearing concerning the Requesting Party's motivation in the present proceeding. However, the motivation of a requesting party is not a consideration in reaching a decision under section 45 of the Act [see *Consorzio Del Prosciutto Di Parma v Maple Leaf Foods Inc* 2010 TMOB 52].

[31] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA239,757 will be expunged in compliance with the provisions of section 45 of the Act.

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Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule

VSL Canada Ltd.

INVOICE

Page: 1

Invoice No.:
Application No.:
Invoice Date:
Bill Thru Date:

GST/HST# 10569 3805 RT0001

Mail-To:

Cust No:
Terms: Net 30 Days
Cust PO No.:
Cust. Job No.:

Job No.:

CONTRACT SUMMARY

Summary Line Item	Quantity	UM	CONTRACT Rate	CONTRACT Amount	TOTAL TO DATE Quantity	TOTAL TO DATE Amount	PREVIOUS TO DATE Quantity	PREVIOUS TO DATE Amount	THIS INVOICE Quantity	THIS INVOICE Amount
Original Contract										
Tax: Ontario - HST - Extra									13.00%	
Sub-Total										
Less: Previously Invoiced										
AMOUNT DUE & PAYABLE										

CONTRACT DETAILS

Bid Item	Description	Cust. Ref. #	Quantity	UM	CONTRACT Rate	CONTRACT Amount	TOTAL TO DATE Quantity	TOTAL TO DATE Amount	PREVIOUS TO DATE Quantity	PREVIOUS TO DATE Amount	THIS INVOICE Quantity	THIS INVOICE Amount
1	Rober Pfeding											
	Total Original Contract											

VENDOR:
P.O.: GL DATE:

R/U	GL ACCT	JOB NUMBER	GENERAL DESC	AMOUNT	UNITS	UOM
	230GSD - GST					
	230GSD - HST					

PREPARED:

EXTENSION CHECKED:

NO STATEMENTS ISSUED - PLEASE PAY FROM INVOICE

A SERVICE CHARGE OF 18% PER ANNUM WILL BE CHARGED ON OVERDUE ACCOUNTS

Remit To: VSL Canada Ltd.
316 Arvin Avenue Stoney Creek, ON L8E 2M2 Canada

*Denotes taxable line items for the current billing.

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

HEARING DATE: 2016-04-12

APPEARANCES

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Catherine Daigle	FOR THE REQUESTING PARTY

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