



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

Citation: 2013 TMOB 76
Date of Decision: 2013-04-26

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Riches, McKenzie & Herbert LLP against
registration No. TMA469,166 for the trade-mark LIFE
SAFETY SYSTEMS in the name of Atlantica Mechanical
Contractors Incorporated**

[1] At the request of Riches, McKenzie & Herbert LLP the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 23, 2010 to Atlantica Mechanical Contractors Incorporated, the registered owner of registration No. TMA469,166 for the trade-mark LIFE SAFETY SYSTEMS (the Mark).

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

Wares:

Fire detection and prevention equipment, namely, sprinkler systems, pre action sprinkler systems, deluge systems, foam systems, fire pumps, standpipe systems, fire hydrants, portable extinguishers, fire alarm systems, voice communication systems, alarm monitoring systems, emergency lighting, halon systems, kitchen hood systems, CO2 systems and fire plans.

Services:

Sale, installation and maintenance of fire detection and prevention equipment.

[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 November 23, 2007 and November 23, 2010.

[4] For the purposes of this decision, the relevant definitions of “use” are set out in sections 4(1) and (2) 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.

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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], 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 wares or services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant filed the affidavit of Thomas G. Vincent, the President of the Registrant, sworn February 14, 2011. Only the Registrant filed a written argument; an oral hearing was not held.

Did the Registrant use the Mark in association with the Services during the Relevant Period?

[7] Mr. Vincent provides details on the nature of the business operations of the Registrant’s fire protection division. Specifically, Mr. Vincent explains that it contracts with companies to sell them fire protection systems; it also installs and maintains fire protection systems, designs and pre-fabricates systems, and provides service and maintenance for the systems that it designs and installs. Mr. Vincent confirms that all of these activities are carried out in association with the Mark. In support of this statement, Mr. Vincent attaches to his affidavit a copy of a sample bid which displays the Mark (Exhibit C).

[8] Mr. Vincent explains that the Registrant owns several vehicles upon which the Mark has been affixed and which are used for service-related calls. At Exhibit E, Mr. Vincent attaches to his affidavit photographs of these vehicles which he states were taken in 2009. I note that the trucks clearly display the Mark. Mr. Vincent states that the Registrant and its predecessors have used the Mark in this manner since 1991, including during the Relevant Period.

[9] At Exhibit F to his affidavit, Mr. Vincent attaches copies of business cards, administrative corporate stationery, corporate envelopes and packing slips, service work orders, material transfer lists and sample invoices. I note that all of these documents clearly display the Mark. Mr. Vincent makes the sworn statement that these documents are all used on a daily basis in the ordinary operations of the Registrant. Mr. Vincent confirms that these documents have been used by the Registrant in Canada since 2007.

[10] Mr. Vincent attaches as Exhibit A to his affidavit a marketing brochure which advertises the Registrant's services, including the Services offered in association with the Mark. The brochure clearly displays the Mark. Mr. Vincent states that the brochure has been available and distributed to the public since 2007.

[11] Mr. Vincent states that the Registrant also actively advertises both through its website (<http://www.atlanticamechanical.com>) and in the Yellow Pages for the Halifax Regional Municipality. In support of this statement, Mr. Vincent attaches as Exhibit D to his affidavit a copy of an advertisement which he states was placed in the 2009 and 2010 editions of the Halifax Regional Municipality Yellow Pages.

[12] Mr. Vincent provides sales figures for the Registrant's fire protection division during the Relevant Period. Mr. Vincent confirms that the sales relate to the provision of wares and services sold in association with the Mark. The sales figures are substantial. In further support of these sales figures, attached as Exhibit B to Mr. Vincent's affidavit are sample invoices dating from the Relevant Period which display the Mark.

[13] I am satisfied that the foregoing evidence supports a finding that the Registrant used the Mark in association with the Services during the Relevant Period.

Did the Registrant use the Mark in the normal course of trade in association with the Wares during the Relevant Period?

[14] As stated above, section 4(1) requires that the Mark appear on the Wares or their packaging or “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”. The evidence discussed above, while sufficient to satisfy section 4(2) of the Act, is insufficient to satisfy section 4(1).

[15] The only evidence which relates directly to the manner in which the Mark appears in relation to the Wares is found at Exhibit G which features “various types of stickers and inspection tags” that Mr. Vincent states are “attached to or left on or near system consoles at the completion of every system installation” (see paragraph 14). Mr. Vincent states that these stickers and tags have been used by the Registrant since 2007 and remained in use at the date of swearing his affidavit. Mr. Vincent explains that the Registrant sells and installs the fire detection and prevention systems described in the registration for the Mark. He explains that each system is comprised of a variety of component parts, including the ones specified in the registration. Based on a review of the evidence as a whole, it would appear that these systems are made up of component parts which are likely manufactured and branded by third parties and the Registrant is responsible for putting the component parts together, installing the system and maintaining and servicing the system after installation.

[16] Even if I were willing to accept these stickers and tags as satisfying section 4(1) of the Act, the evidence is ambiguous with respect to whether the Registrant actually sold any of the Wares during the Relevant Period. At paragraph 6 of his affidavit, Mr. Vincent describes the Exhibit B invoices as evidencing “sales of goods” and “sales of services”. However, there is no description or identification of the particular goods on the invoices. Rather, the invoices either do not provide any details of the nature of the wares and/or services covered or else they include descriptions of what is clearly the provision of services only (for example, “annual sprinkler inspection & BFP test as requested”; “annual sprinkler inspections, fire pump & hydrant testing”; “pre-action system testing”; “remove pump and reinstalled spare pump, send pump out to be repaired as requested”). Mr. Vincent makes no statements in his affidavit to clarify which, if any, of the Wares are covered by these invoices. I note that any ambiguity in an affidavit in the

context of a section 45 proceeding will generally be resolved against the affiant [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1979), 45 CPR (2d) 194 (FCTD), aff'd (1980), 53 CPR (2d) 62 (FCA)].

[17] Based on the foregoing, I am not satisfied that the Registrant has provided evidence of use of the Mark in association with the Wares during the Relevant Period.

Disposition

In view of the foregoing, 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 amended to delete the statement of Wares only. The registration will be maintained with respect to the Services.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office