



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

**Citation: 2016 TMOB 37**  
**Date of Decision: 2016-02-29**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Marks & Clerk**

**Requesting Party**

**and**

**The Timken Company**

**Registered Owner**

**TMA527,361 for DT COMPONENTS**

**Registration**

[1] At the request of Marks & Clerk (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 November 25, 2013 to The Timken Company (the Owner), the registered owner of registration No. TMA527,361 for the trade-mark DT COMPONENTS (the Mark).

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

(1) Land motor vehicle parts, namely, transmission and differential parts, roller and ball bearings and parts thereof, namely, cups, cones, rollers, cages, bearing housings, covers, closures, enclosures and spacers; metallic seals and gaskets, snap rings, bushings and sleeves; clutch release and pilot bearings; driveshaft center support bearings; non-metallic seals and gaskets, o-rings; silicone gasket makers; gasket kits.

(2) Seals made primarily of non-metallic materials, non-metallic gaskets and o-rings, silicone sealants for forming gaskets and kits containing the foregoing for repairing transmissions and differentials of automotive vehicles.

[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 goods 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 25, 2010 and November 25, 2013.

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

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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of J. Barry Harris, sworn on June 19, 2014 in North Canton, Ohio. Only the Owner filed written representations; an oral hearing was not requested.

#### The Owner’s Evidence

[7] In his affidavit, Mr. Harris attests that he is the Manager – Global Strategy and Marketing of the Owner. He attests that the Owner is a global industrial technology leader offering goods used in machinery for a wide variety of industries. Specifically, he attests that the Owner produces anti-friction technology, such as bearings. He asserts that, during the relevant period, the Owner used the Mark in Canada with respect to each of the registered goods.

[8] With respect to the Owner’s normal course of trade, Mr. Harris attests that, in 1997, the Owner entered into a strategic alliance with North Coast Bearings, LLC (NCB) to market and distribute differential rebuild kits, transmission rebuild kits, and related goods bearing the Mark. He attests that in 2012 the Owner licensed NCB to market and sell goods bearing the Mark in

Canada. In support, attached as Exhibit A to his affidavit is copy of the 2012 license agreement with NCB, which he attests authorized NCB to use the Mark in Canada in association with the registered goods.

[9] Additionally, he attests that the Owner has a wholly-owned subsidiary, Timken Canada LP that is also licensed to sell goods bearing the Mark in Canada. In support, attached as Exhibit B to his affidavit is a copy of a 2011 “Trademark License agreement” between the Owner and Timken Canada LP.

[10] In view of Mr. Harris’ statements and the exhibited licensing agreements, for purposes of this proceeding, I am satisfied that any evidenced use of the Mark by the licensees enures to the benefit of the Owner.

[11] Mr. Harris attests that goods associated with the Mark are comprised of over 2000 rebuild kits and 22,000 “stock-keeping units”, which include products such as the following: differential, transmission and transfer case rebuild kits; tapered wheel bearings and matched wheel bearing sets; ball bearings; and seals. Furthermore, he attests that “given the mechanical nature and size” of the goods it is impractical to place the Mark directly on the goods themselves. He attests that, instead, the Mark appears prominently on product packaging and throughout the DT Components catalogue.

[12] Mr. Harris attests that, during the relevant period, customers in Canada could view the Owner’s products through an online catalogue at *catalogue.dtcomponents.com*, by downloading the digital 2012 DT Components Catalogue from *dtcomponents.com*, or by obtaining and using a hardcopy of the DT Components Catalogue. Mr. Harris confirms that customers used these catalogues when placing orders by telephone or email. He attests that the goods were shipped to any residence or office having a Canadian address.

[13] With respect to sales of DT Components parts in Canada during the relevant period, Mr. Harris attests that sales in 2010 were \$2,446,252; in 2011, sales were \$2,535,531; in 2012, sales were \$3,031,694; and in 2013, sales were \$2,484,726.

[14] In support of the foregoing, Mr. Harris provides the following exhibits attached to his affidavit:

- Exhibit C consists of screenshot printouts from *dtcomponents.com* that show various goods with a brief description of such goods. These displayed goods include axle shafts, ball bearings, roller bearings, and driveshaft center support bearings, which generally correspond to some of the registered goods. The Mark is prominently displayed at various locations on the webpages.
- Exhibit D consists of printouts of screenshots from *archive.org* which shows how *dtcomponents.com* appeared during the relevant period. As with the Exhibit C screenshots, the exhibited webpages show various parts products along with a brief description, generally corresponding with the registered goods. Again, the Mark is prominently displayed at various locations on the webpages.
- Exhibit E is a copy of the 2012 DT Components product catalogue that Mr. Harris attests is also available digitally via the website *dtcomponents.com*. The catalogue contains various categorized listings of goods and parts products. He explains that the goods are associated with certain codes used to identify the goods listed in the catalogue. The Mark is displayed throughout the catalogue.
- Exhibit F consists of screenshots of various search results performed on the online catalogue at *catalogue.dtcomponents.com*. The search results show particular goods, such as various bearings, o-rings, metallic seals, silicone sealants, and gaskets, as well as the goods' packaging. The packaging in each case prominently displays the Mark.
- Exhibits G consists of hundreds of pages of invoices for thousands of products that Mr. Harris attests were shipped to customers in Canada. The invoices are all dated within the relevant period and are invoiced to Canadian addresses. The invoices provide a brief description of the good, such as "BRG" and "CONE-SING" alongside the part number and product price. Mr. Harris attests that the invoices refer to part numbers that correspond to part number codes in the 2012 DT Components Catalogue. For example, the November 2013 invoice #18508127 shows sales of parts 580-2, 47686-2, DRK311-2 and DRK316A-2. These part numbers correspond to wheel bearings, axle differential bearings, and seal kits found in the 2012 DT Components Catalogue.

- Exhibits H and I consist of invoices for various goods that Mr. Harris attests were shipped to customers in Canada, followed by printouts of corresponding product descriptions from the printed and online DT Components catalogues. The invoices are all dated within the relevant period and are invoiced to Canadian addresses. Although the Mark does not appear on the invoices, it is prominently displayed in the exhibited catalogue excerpts.
- Exhibit J consists of three images of DT Components packaging, and the various parts that are contained within such packaging. Mr. Harris attests that this packaging is representative of packaging used to ship DT Components goods to customers in Canada during the relevant period. The Mark is prominently displayed on the front and sides of the packaging. Text on the packaging describes the contents; for example, one package indicates the contents as follows: “Tapered Roller Bearings, Ball Bearings, Cylindrical, Needle Roller Bearings, Seals, Silicone Gasket Makers, Gasket Kits, Snap Rings, O-Rings”. The parts displayed include various types of bearings, gaskets, sealants, cones and transmission and differential components.
- Lastly, Exhibit K consists of three documents each entitled “Product/Market Update” that Mr. Harris attests were accessible to Canadian customers via *dtcomponents.com*. The documents are dated within the relevant period and give information about new products. For example, the October 2012 Product/Market Update begins by stating that “The DT Components product line has expanded to include differential rebuild kits for the 14X Series Meritor Single and Tandem Axles”. The Update then identifies the associated part numbers along with photographs of the parts.

### Analysis

[15] In its written representations, the Owner submits that the evidence presented is beyond a mere assertion of use, and that the evidence as a whole supports use of the Mark in association with each registered good during the relevant period [citing *Borden Ladner Gervias v Momo Design Srl*, 2011 TMOB 168, CarswellNat 3843].

[16] Indeed, Mr. Harris clearly attests to use of the Mark in association with all of the registered goods and provides representative evidence of sales and product packaging. In this respect, the Owner has furnished hundreds of pages of invoices from the relevant period containing thousands of invoiced items addressed to customers in Canada.

[17] Although Mr. Harris does not specifically correlate all of the registered goods with particular items appearing in the invoices or in the DT Components catalogues, I am able to identify the registered goods in the exhibited invoices. For example, on the first page of the November 2013 invoice at Exhibit G, “DIF KIT” with product code DRK321-2 corresponds to a “differential rebuild kit” in the DT Components catalogue. The catalogue description shows that the kit contains various types of “bearings”, “sleeves”, “sealers”, and “o-rings”, corresponding to some of the registered goods.

[18] Similarly, page 63 of the December 2012 invoice at Exhibit G shows a sale of “CONE-SING” with product code L44649, which corresponds to a “tapered cone” in the catalogue and the registered good “transmission and differential parts, roller and ball bearings and parts thereof, namely, ... cones”.

[19] As the evidence shows that a customer would typically use the DT Components catalogue to order parts which would then be shipped in packaging displaying the Mark, I am satisfied that the requisite notice of association would have been given to purchasers of the registered goods in accordance with section 4(1) of the Act.

[20] 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 each of the registered goods within the meaning of sections 4(1) and 45 of the Act.

Disposition

[21] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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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**

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No Hearing Held

**AGENTS OF RECORD**

McMillan LLP

For the Registered Owner

Marks & Clerk

For the Requesting Party