

TRANSLATION/TRADUCTION



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

Citation: 2012 TMOB 53
Date of Decision: 2012-03-07

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by 88766 Canada Inc. against registration
No. TMA143936 for the trade-mark CORESHIELD in
the name of Alloy Rods Global, Inc.**

[1] On August 31, 2009, at the request of 88766 Canada Inc. (the Applicant), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Alloy Rods Global, Inc. (the Registrant), registered owner of registration No. TMA143936 for the trade-mark CORESHIELD (the Mark) in association with the following wares: “welding wire” (the Wares).

[2] 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 the present case, the relevant period for establishing use is from August 31, 2006, to August 31, 2009.

[3] Use in association with wares is described as follows at section 4 of the Act:

4.(1) A trade-mark is deemed to be used in association with wares if, at the time of 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 package 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] Section 45 proceedings are summary and administrative in nature [*Saks & Co. v. Canada (Registrar of Trade-marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.); and *Ridout & Maybee LLP v. Omega SA* (2005), 39 C.P.R. (4th) 261 (F.C.A.)], and the purpose of the proceedings is to remove registrations which have fallen into disuse [*Burke-Robertson v. Carhartt Canada Ltd.* (1994), 56 C.P.R. (3d) 353 (F.C.T.D.)], in other words, to clear the “dead wood” from the register [*Philip Morris Inc v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289 (F.C.T.D.)]. In *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.T.D.), Justice Russell speaks of the balance between evidentiary overkill and the statutory requirement to show use such that the Registrar is able to form an opinion on the “use” within the context of section 45. In such proceedings, the burden of proof is not a heavy one, and no specific type of evidence is required [*Cinnabon v. Yoo-hoo of Florida Corp.* (1998), 82 C.P.R. (3d) 513 (F.C.A.); and *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289 (F.C.T.D.)]. In these circumstances, an affidavit must contain a clear statement of use of the trade-mark within the relevant period in association with each of the wares and must provide sufficient facts to permit the Registrar to conclude that the trade mark is in use in association with each ware [*Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270 (F.C.T.D.)].

[5] In reply to the Registrar’s notice, the Registrant provided the affidavit of Richard Kershner, the Registrant’s president, treasurer and assistant secretary, dated February 26, 2010. Exhibits “A” to “D” were attached to the affidavit to show use of the Mark. Both parties filed written representations; neither party requested an oral hearing.

The Mark is marked on the Wares

[6] In his affidavit, Mr. Kershner attests that the Registrant used the Mark by marking it on packages containing the Wares during the relevant period. In support of this, he has appended Exhibit “B”, photographs of one of the packages in question. From these photographs, I can see that the Mark is marked on the package and that the package appears to contain the Wares described on the package.

[7] It should be noted that the Mark is followed by a number and two letters, “8 AR”. The case law indicates that a trade-mark may be used with other words if an unaware consumer, as a matter of first impression, would perceive the additional words as purely descriptive [*Nightingale Interloc Ltd. c. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (C.O.M.C.)].

[8] In the present case, I am of the opinion that an unaware consumer’s first impression would be that the essential element of the Mark is preserved, since the word “CORESHIELD” appears unchanged on the package.

[9] As regards the addition after the Mark, I conclude that it is purely descriptive. Indeed, my review of Exhibit “D” of Mr. Kershner’s affidavit (described further on in my decision) leads me to find that the number “8” refers to the gauge of the welding wire and that the letters “AR” refer to the Registrant, since this is probably an abbreviation of “Alloy Rods”.

[10] The Applicant notes at paragraph 6 of its representations that the label on which the Mark is marked shows that the source of the Wares is in fact Alloy Rods Corporation and not the Registrant.

[11] Mr. Kershner has attached to his affidavit as Exhibit “A” a copy of the contract transferring the rights of Alloy Rods Corporation to the Registrant. The contract states that the Registrant is a wholly owned subsidiary of Alloy Rods Corporation and that Alloy Rods Corporation transferred all of its trade-mark rights to the Registrant before the relevant period.

[12] Furthermore, Mr. Kershner explains at paragraph 8 of his affidavit that this reference to Alloy Rods Corporation reflects the fact that these packages were used in the past and that the Registrant is simply trying to use up its old packaging stock.

[13] I therefore find that the Mark is marked on the Wares in accordance with one of the requirements of subsection 4(1) of the Act.

Sale of the Wares in Canada during the relevant period

[14] As I mentioned above, subsection 4(1) of the Act provides that the use must occur at the time of the transfer of the property in or possession of the wares, in the normal course of trade.

[15] At paragraph 7 of his affidavit, Mr. Kershner states that the Registrant sold its Wares with the Mark marked on their packaging and that this was done during the relevant period.

[16] At paragraph 4 of its representations, the Registrant submits that this statement is not enough to show use of the Mark in Canada in association with the wares during the relevant period and cites *Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1981), 53 C.P.R. (2d) 62 (F.C.A.).

[17] In that judgment, the registrant had merely stated that it was using the mark and had not filed any evidence in support of that statement. However, such is not the case here.

[18] At paragraphs 9 and 10 of his affidavit, Mr. Kershner states that during the relevant period, the Registrant sold its Wares with the Mark marked on their packaging to Canadian distributors and that these distributors resold the Wares directly to Canadian consumers.

[19] In support of his statements, Mr. Kershner has attached as Exhibits “C” and “D”, respectively, a partial list of the Canadian distributors in question and a table of sales in Canada for the Wares sold in association with the Mark during the relevant period.

[20] The fact that no invoices attesting to the sales in question were filed in support of Mr. Kershner’s affidavit is not fatal to the Registrant’s case. The nature of a section 45 proceeding is such that the Registrant is only required to establish a *prima facie* case of use of the Mark, and that that is all that is expected of the Registrant [*Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 22 CPR (3d) 561 (F.C.T.D.)].

[21] To sum up, considering the Registrant’s evidence as a whole, I am of the opinion that this evidence is sufficient to persuade me that, in the normal course of trade, the Registrant sold the

Wares in association with Mark during the relevant period within the meaning of subsection 4(1) of the Act.

Decision

[22] In view of the foregoing and pursuant to the authority delegated to me under subsection 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Michael Palles, Translator/Language Adviser