



LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 44

Date of Decision: 2017-04-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Hicks Intellectual Property Law

Requesting Party

and

Soundtrap, Inc.

Registered Owner

TMA416,412 for SOUNDSEAL

Registration

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA416,412 for the trade-mark SOUNDSEAL (the Mark), presently owned by Soundtrap, Inc. (the Owner).

[2] The Mark is registered for use in association with: silicone and vibration plugs (the Goods) and installation of isolation material that separates all plumbing and electrical pipes and cables and includes the process of controlling flanking noise between floors and walls by the filling of small cavities, particularly in the plumbing and electrical system (the Services).

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete the Goods.

THE PROCEEDING

[4] On March 31, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Canadian Home Acoustics Inc. (Acoustics), then registered as owner of the Mark. The notice was sent at the request of Hicks Intellectual Property Law (the Requesting Party).

[5] The section 45 notice required Acoustics to furnish evidence showing that it had used the Mark in Canada, at any time between March 31, 2012 and March 31, 2015 (the Relevant Period), in association with the registered goods and services. If the Mark had not been so used, Acoustics 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.

[6] The relevant definitions of “use” in association with goods and services are set out in section 4 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.

(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] 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. The criteria for establishing use are not demanding and an overabundance of evidence is unnecessary. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the goods or services specified in the registration at any time during the relevant period [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use of the trade-mark [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 53 CPR (2d) 62 (FCA)].

[8] As it appears on the register, there is a recordal of an assignment from Acoustics to the Owner effective March 4, 2015. It was not recorded on the register until May 8, 2015. As such,

the owner of the Mark through most of the Relevant Period, up to March 4, 2015 was Acoustics and the Owner thereafter.

[9] Accordingly, in response to the Registrar's notice, the Owner filed the affidavit of Roger Foulds, sworn on June 15, 2015 with references to Attachment A to E inclusive.

[10] On November 19, 2015 the Requesting Party filed its written representations in which it alleged several deficiencies in Mr. Foulds' affidavit, including representations that the affidavit filed was incomplete, as certain exhibits referred thereto were not attached to Mr. Foulds' affidavit.

[11] In response on March 31, 2016 the Owner requested permission to either replace Mr. Foulds' affidavit with a complete version of it or to obtain a retroactive extension of time under section 47(2) of the Act to file this complete version. For reasons detailed in a letter dated April 12, 2016 the Registrar refused both requests. Consequently, for the purpose of this decision, I shall only consider the affidavit of Mr. Foulds and its attachments as furnished on June 18, 2015.

[12] Only the Requesting Party filed written representations and a hearing was not held.

THE OWNER'S EVIDENCE

[13] In his affidavit, Mr. Foulds identifies himself as the Owner's President and the former President of Acoustics. He provides some information concerning the registration of the Mark and its renewal over time. He explains that the Mark and the brand name SOUNDSEAL have been used "on an ongoing and continuous basis as part of engineered products and noise control systems to control commercial, architectural and residential applications".

[14] Mr. Foulds makes reference to the assignment of the Mark from Acoustics to Soundtrap and refers to such assignment as Attachment A to his affidavit. As mentioned by the Requesting Party in its written representations, there is no Attachment A annexed to Mr. Foulds' affidavit. However, such omission will have no consequence on the outcome of this decision as the details provided by Mr. Foulds about the assignment appear on the register subsequent to its recordal.

[15] Mr. Foulds states that the Goods “are part of a family of custom products and systems designed to control unwanted noise in many noise reduction applications”. He adds that these products and systems have been used since the early 1990’s and “represent the [Services]”. He then explains the purpose of the Goods and Services.

[16] Mr. Foulds makes reference to other registered trade-marks owned by Acoustics and also transferred to the Owner on March 4, 2005. He states that “SOUNDSEAL and all associated marks are integral for the ultimate noise control system”.

[17] To demonstrate use of the Mark in association with the Goods and Services in Canada during the Relevant Period, Mr. Foulds attaches the following exhibits:

- Invoice from the Owner to G.E.S. Construction Limited dated February 3, 2015 (Attachment B);
- “Sales literature used with goods and services and associated marks in the advertising of those goods and services, consistently over the past 10 years.... featuring SOUNDSEAL as a critical component of a specialized system to reduce plumbing noise by up to 75%, and wall and floor ceiling systems, for quiet rooms” (Attachments C and D);
- A quotation to Mazenga Building Group dated July 7, 2014 (Attachment E).

[18] Finally, Mr. Foulds makes reference to the Owner’s website featuring the Mark but no printout(s) have been furnished to substantiate such statement.

ANALYSIS OF THE EVIDENCE

[19] As noted by the Requesting Party in its written representations, Mr. Foulds did not explicitly describe the normal course of trade of the Owner or its predecessor-in-title, Acoustics. In this respect, it adds that Mr. Foulds did not identify the nature or identity of any customers.

[20] The Requesting Party notes that Mr. Foulds does not make any statement that silicone and vibration plugs were sold during the Relevant Period or that the registered installation services were performed in association with the Mark or otherwise.

[21] Furthermore, the Requesting Party submits that there is no evidence of how the Mark was used in association with the Goods. The Requesting Party raises the following questions: Is the Mark marked on the Goods? Is it on the packaging of the Goods? Is the Mark otherwise associated with the Goods at the time that possession of the Goods is transferred to a customer?

[22] Finally, the Requesting Party contends that Mr. Foulds does not describe how the Mark was used in association with the performance or advertising of the registered installation services.

[23] While I agree that Mr. Foulds statements are somewhat lacking in these respects, as discussed below, the evidence includes the aforementioned Attachments, from which I can derive or infer some of these particulars of use.

The normal course of trade

[24] With respect to the normal course of trade, Mr. Foulds states that the Goods are used to treat and control structural vibrations and adds that “the installation of SOUNDSEAL controls flanking noise between floor and wall assemblies”. In addition, Attachment B is an invoice dated March 2, 2015 addressed to G.E.S. Construction Limited. It has a job location address and includes in the description portion of the invoice, “Sound treated 3 outlets with SOUNDSEAL”.

[25] I conclude from this information that the Owner’s normal course of trade in this case is to sell the goods and services to construction companies with the performance of services occurring on job sites.

Use of the Mark in association with the Services

[26] The customer quote, Attachment E, contains the following description: “The SOUNDSEAL® system utilizes the installation of isolation materials that separate all plumbing pipes and includes the process of controlling flanking noise between floors and walls”. As such, this customer quote refers to the Services.

[27] The Requesting Party argues that there is no evidence that such services were performed and therefore there is no evidence of use of the Mark in association with the Services. However,

in so far as services are concerned, as per section 4(2) of the Act, advertising of services is sufficient to constitute use of a trade-mark, where the registered owner is offering and prepared to perform such services in Canada.

[28] I consider that this customer quote constitutes evidence of use of the Mark in association with the Services within the meaning of sections 4(2) and 45 of the Act as it is an offer to perform the Services in association with the Mark.

Use of the Mark in association with the Goods

[29] As pointed out by the Requesting Party and as reproduced in the first quote above in paragraph 24, Mr. Foulds uses “SOUNDSEAL” as a noun and it is unclear if it refers to the Goods and/or the Services.

[30] With respect to the exhibited invoice, Attachment B, the Requesting Party notes that there is no indication that such invoice accompanied any goods at the time of delivery on the job site. As alluded to above, it further notes that there is no reproduction of the Goods or their packaging in the evidence, which would illustrate the manner in which the Mark has been associated with the Goods.

[31] With respect to the sales literature at Attachments C and D, despite the Requesting Party’s submissions that Attachment C does not contain a reference to the Mark, I note the following inscription “...and SOUNDSEAL systems to pipes”. However, Mr. Foulds does not state specifically that Attachments C and D were distributed in Canada during the Relevant Period and even if they were, whether they were distributed with the Goods at the time of their delivery. In this respect, brochures themselves, on which appears a trade-mark do not constitute use of that mark in association with goods within the meaning of section 4(1) of the Act.

[32] At last the customer quote, Attachment E, makes reference to “SOUNDSEAL® system”. It is not clear if it refers to the Goods and/or Services. This customer quote, in absence of any additional information or documents which would establish that the Owner sold Goods to this customer, is not evidence of the sale of Goods within the meaning of section 4(1) of the Act.

[33] As noted above, there is no evidence that there was any transfer or sales of the Goods in association with the Mark or otherwise during the Relevant Period. Consequently, the Owner has failed to demonstrate use of the Mark in association with the Goods. Furthermore, there is no evidence of “special circumstances” within the meaning of section 45 of the Act, which would justify such non-use of the Mark in association with the Goods during the Relevant Period.

DISPOSITION

[34] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration TMA416,412 will be amended to delete the following goods: “silicone and vibration plugs”.

Jean Carrière,
Member
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

No Agent

FOR THE REGISTERED OWNER

Hicks Intellectual Property Law

FOR THE REQUESTING PARTY