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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 66

Date of Decision: 2017-06-12

IN THE MATTER OF A SECTION 45 PROCEEDING

Piasetzki Nenniger Kvas LLP

Requesting Party

and

Tubular Industries of Canada Ltd.

Registered Owner

TMA805,607 for ESSENTIAL

Registration

[1] At the request of Piasetzki Nenniger Kvas LLP (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 August 18, 2015 to Tubular Industries of Canada Ltd. (the Owner), the registered owner of registration No. TMA805,607 for the trade-mark ESSENTIAL (the Mark).

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

Faucets; plumbing fittings, namely, bibbs, cocks, traps, and valves; plumbing supplies, namely, sink strainers.

[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 August 18, 2012 and August 18, 2015.

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

[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. 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 [see *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.

[6] In response to the Registrar's notice, the Owner furnished an affidavit of its Executive Vice-President and General Manager Jean Bérubé, sworn on November 5, 2015. Neither party filed written representations or requested a hearing.

THE OWNER'S EVIDENCE

[7] In his affidavit, Mr. Bérubé states that the Owner designs and manufactures faucets and plumbing products, and has been marketing and selling its products under several brands including the Mark for five years. In particular, he asserts that the Owner used the Mark in Canada “in association with the manufacture and sale of faucets” during the relevant period.

[8] In support, Mr. Bérubé attaches the following exhibits to his affidavit:

- Exhibit B, which he describes as “a picture of the pod labels displayed with the faucets at point of sales”.
- Exhibit C, which he describes as “a picture of the packaging boxes of the faucets”.
- Exhibit D, which he describes as “a picture of the instruction manual accompanying the products”.
- Exhibit E, which he describes as “copies of invoices for the sale of ESSENTIAL branded faucets in Canada” for the relevant period.

ANALYSIS

[9] The sole issue in this case is whether the evidence demonstrates use of the Mark in association with *each* of the registered goods.

[10] In this respect, I first note that the evidence clearly demonstrates use of the Mark in association with the registered goods “faucets”. The specimens under Exhibits B to D, all relating to various types of faucets, such as kitchen faucets, bathtub/shower faucets, and lavatory sink faucets, prominently display the Mark, and the Exhibit E invoices clearly show sales of these goods by the Owner in Canada during the relevant period. For example, the invoices show sales of “ROBINET CUISINE 8” ESSENTIAL” and “TUB & SHOWER FAUCET ESSENTIAL”.

[11] However, the evidence is silent with respect to the other two categories of goods described as “plumbing fittings, namely, bibbs, cocks, traps, and valves” and “plumbing supplies, namely, sink strainers”. While the invoices under Exhibit E also show sales of various other products such as strainers, connectors and drainers, in contrast to the aforementioned faucets, none of these products are identified with the Mark. More importantly, nowhere in his affidavit does Mr. Bérubé attest to the use of the Mark in association with these remaining goods during the relevant period.

[12] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark only in association with “faucets” within the meaning of sections 4 and 45 of the Act.

Furthermore, with respect to the remaining goods, the Owner has provided no evidence of special circumstances excusing the absence of use. The registration will be amended accordingly.

DISPOSITION

[13] Accordingly, 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 following from the statement of goods:

..., plumbing fittings, namely, bibbs, cocks, traps, and valves; plumbing supplies, namely, sink strainers

[14] The amended statement of goods will read as follows: "Faucets".

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

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

No Hearing Held

AGENTS OF RECORD

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FOR THE REGISTERED OWNER

Piasetzki Nenniger Kvas LLP

FOR THE REQUESTING PARTY