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

Citation: 2018 TMOB 65

Date of Decision: 2018-06-29

IN THE MATTER OF A SECTION 45 PROCEEDING

McMillan LLP

Requesting Party

and

UR-CAN Inc.

Registered Owner

TMA783,419 for ECO PUMP

Registration

[1] At the request of McMillan 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 January 22, 2016 to Eco-Cop Inc. (the Registrant), who was at that time the registered owner of registration No. TMA783,419 for the trade-mark ECO PUMP (the Mark).

[2] The Mark is registered for use in association with the following goods: “portable electric or manually operated pump, used for filling liquids into a pressurized can”.

[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 January 22, 2013 and January 22, 2016**.

[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 mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*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* (1996), 1996 CanLII 17297 (FC), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd 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 goods specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant furnished the statutory declaration of Bruce Dawson, declared on September 15, 2016. I note that subsequent to the filing of evidence, the registration was assigned to UR-CAN Inc. (the current Owner); the assignment is not at issue in this proceeding.

[7] Neither of the parties filed written representations, and only the Owner was represented at an oral hearing.

SUMMARY OF THE EVIDENCE – THE DECLARATION OF BRUCE DAWSON

[8] Mr. Dawson identifies himself as the President of Eco-Cop Inc. (paragraph 1).

[9] Mr. Dawson states that UFILL Systems is the marketing arm of Eco-Cop Inc., and that the Mark has been used by UFILL Systems and Eco-Cop Inc (paragraph 2).

[10] Mr. Dawson states that attached as Exhibits A, B, and C are “pictures of the two current versions of the Eco Pump that we sell and lease, as well as a picture of a group of four Eco Pumps that are used in actual filling of the Eco Cans” (paragraph 3).

[11] I note that Exhibits A and B are slightly blurry, but appear to be pictures of two different apparatus, each of which includes on its base the words ECO PUMP separated by what appears to be a hyphen. Applying the principles set out by the Federal Court of Appeal [per *Canada (Registrar of Trade Marks) v Cie Internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)], I am satisfied that despite the inclusion of a hyphen, the dominant features of the trade-mark as registered (the words ECO and PUMP) have been retained such that any evidenced use of the trade-mark ECO-PUMP would constitute use of the Mark.

[12] With respect to Exhibit C, the pumps shown in this photograph are too far away to identify whether the Mark appears on the goods.

[13] I further note that all of the photographs in Exhibits A through C are undated.

ANALYSIS

[14] For the following reasons, I am of the view that the Registrant has failed to demonstrate use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act during the relevant period:

No evidence of display of the Mark in association with the registered goods during the relevant period

- a) While Mr. Dawson indicates that the Mark “has been used” and provides pictures of “the two *current* versions of the Eco Pump that we sell and lease” (emphasis added), his declaration is silent regarding use of the Mark during the relevant period. Absent further details regarding the Registrant’s normal course of trade or activities during the relevant period, I am not prepared to make any inferences favourable to the Owner in that respect.

No evidence of transfer of the registered goods in the normal course of trade

- b) With respect to any transfer of the registered goods in the normal course of trade, while Mr. Dawson indicates that “we sell and lease”, there is no evidence of actual sale or transfer of the registered goods during the relevant period in Canada.
- c) Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD), some evidence of transfers in the normal course of trade in Canada is necessary [*John Labatt Ltd v Rainer Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements. However, as in this case, it is insufficient to merely make broad assertions about “selling and leasing” [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB); and *Riches, McKenzie & Herbert LLP v Cleaner’s Supply Inc*, 2012 TMOB 211, CarswellNat 5229].

DISPOSITION

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

Jennifer Galeano
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2018-05-31

APPEARANCES

Stephen Walters

FOR THE REGISTERED OWNER

No one appearing

FOR THE REQUESTING PARTY

AGENT(S) OF RECORD

Stephen Walters Professional Corporation

FOR THE REGISTERED OWNER

McMillan LLP

FOR THE REQUESTING PARTY

