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

**Citation: 2018 TMOB 136**

**Date of Decision: 2018-11-08**

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

**CAMERON IP**

**Requesting Party**

**and**

**LEHIGH HANSON MATERIALS  
LIMITED**

**Registered Owner**

**TMA689,541 for CONCREATE**

**Registration**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA689,541 for the trade-mark CONCREATE (the Mark), owned by Lehigh Hanson Materials Limited.

[2] The Mark is currently registered in association with the following goods (the Goods):

(1) Ready mix concrete and coloured ready mix concrete.

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

## THE PROCEEDING

[4] On January 24, 2017, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Lehigh Hanson Materials Limited (the Owner). The notice was sent at the request of Cameron IP (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between January 24, 2014 and January 24, 2017, in association with each of the Goods specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use 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.

[7] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression “clearing deadwood” has often been used to describe such proceedings [*Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. While it is true that the threshold for establishing use in a section 45 proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD); *Austin Nichols & Co v Cinnabon, Inc* (1998), 82 CPR (3d) 513 (FCA)], 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 registered goods during the relevant period [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]; nonetheless, evidence in a section 45 proceeding is to be read as a whole, including statements of fact as well as supporting documentation [*Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB); *Kvas Miller Everitt v Compute (Bridgend) Ltd* (2005), 47 CPR (4th) 209 (TMOB)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Randy Gifford, sworn April 21, 2017, together with Exhibits A to D.

[9] Only the Owner filed written submissions. An oral hearing was not requested.

#### THE EVIDENCE

[10] Mr. Gifford identifies himself as a Manager of the Owner, since 2011.

[11] Mr. Gifford explains that the Owner's ready mix concrete is mixed at a batch plant before being delivered by truck to a job site. He attests that the delivery trucks in some cases bear the Mark; however, in each case, the driver gives the customer a delivery ticket bearing the Mark. In support, he provides as Exhibits A and C respectively, representative copies of delivery tickets bearing the Mark, dated between May 2016 and January 2017, and a photograph of a concrete truck bearing the Mark used to deliver the Owner's Goods to Canadian job sites during the relevant period.

[12] In addition, Mr. Gifford attests that the Mark appears on invoices sent to customers following the purchase of the Goods. In support, he provides as Exhibit B, representative invoices dated between January and August 2016. I note that the Mark appears in the body of the invoices as part of the product description. According to Mr. Gifford, hundreds of similar invoices were delivered to customers during the relevant period, reflecting sales of the Goods in excess of \$20 million annually.

[13] Lastly, Mr. Gifford states that each of the Owner's divisions has a website to promote the Owner's products, including the Goods. In support, he provides, as Exhibit D to his affidavit, screen shots from several such websites. Each page displays the Mark with photographs of concrete applications and other product information, as well as the name and contact information of the relevant division and the name of the Owner. Mr. Gifford attests that these divisions operate as business units of the Owner and are not separate legal entities. Furthermore, while the screen shots are from March 2017, Mr. Gifford attests that he is familiar with the content of the websites and that their appearance was the same during the relevant period.

## ANALYSIS AND REASONS FOR DECISION

[14] The Owner submits that the Mark is used if notice of association is given to purchasers at the point of sale [citing *Lang Michener, Lawrence & Shaw v Woods Canada* (1996), 71 CPR (3d) 477 (FCTD) at para 9]. In this regard, the Owner relies on the display of the Mark on the delivery tickets, delivery trucks, invoices, and the websites of the Owner's divisions, as providing the requisite notice of association of the Mark with the Goods "in any other manner" per section 4(1) of the Act.

[15] The Owner submits that, due to the nature of the Goods, the Mark cannot be displayed on the Goods themselves, and the Goods cannot be packaged outside of a concrete truck. In such circumstances, the Owner submits, the display of a trade-mark on delivery trucks and on documentation such as invoices has been held to establish use of a trade-mark in association with goods [citing *Diversified Marketing Solutions, LLC v Real Food for Real Kids Inc*, 2014 TMOB 159, 127 CPR (4th) 312]. Further to this, the Owner submits that it is well established that the display of a trade-mark on invoices can be evidence of use, where, as in the present case, it would be reasonable that the trade-mark did not appear on the goods themselves [citing *Smart & Biggar v Ocean Ceramics Ltd*, 2014 TMOB 190 at para 11, 128 CPR (4th) 212 at para 11].

[16] Lastly, the Owner submits that the display of a trade-mark on a website is sufficient to establish use in association with goods when corroborated by evidence of sales, such as invoices, even where the goods are not purchased directly through the website [citing *Barrette Legal Inc v Southbrook Farms Limited*, 2015 TMOB 179, 2015 CarswellNat 5243 at para 11; and *Sim & McBurney v Les Espaces Memoria Inc*, 2016 TMOB 24, 2016 CarswellNat 540, at paras 32-34].

[17] With respect to the delivery tickets, having regard to Mr. Gifford's sworn statements, I accept that the delivery tickets were provided to customers at the time of transfer of the Goods during the relevant period. Furthermore, given the presence of the Mark in the body of these tickets, I accept that the purchaser would have been provided the requisite notice of association between the Mark and the Goods [see *Central Soya of Canada Ltd v 88766 Canada Inc* (1993) 51 CPR (3d) 509 (FCTD); and *Norton Rose Fulbright LLP/SENCRL, SRL v Lehigh Hanson Materials Ltd*, 2016 TMOB 45 at paras 10-11 for similar conclusions].

[18] While the delivery tickets do not indicate the precise nature of the goods transferred; namely, whether they were issued in association with ready mix concrete or coloured mix concrete, the remaining evidence furnished by the Owner, while not indicative in itself of use of the Mark in association with goods, illustrates the nature of the Goods at issue. For instance, while the mere advertising of goods in association with a trade-mark on a website would be insufficient to demonstrate use in Canada [*BMW Canada Inc v Nissan Canada Inc*, 2007 FCA 255, 60 CPR (4th) 181], in this case, the website provides further evidence in support of Mr. Gifford's statements that the Goods sold during the relevant period include both coloured and non-coloured ready mix concrete. In addition, I note that in some of the invoices, the Mark appears in the product description column with reference to various colours, which I accept is reference to coloured ready mix concrete.

[19] With respect to the display of the Mark on the delivery trucks, generally, this does not constitute use of a trade-mark in association with goods *in the absence* of evidence that the trade-mark is brought to the attention of the purchaser at the time of transfer of possession [*Riches, McKenzie & Herbert v 783234 Ontario Ltd* (2000), 6 CPR (4th) 535 at paras 14-15], even where those goods are delivered directly to a customer in a marked delivery vehicle [*Cassels Brock & Blackwell LLP v Ultimate Garage Inc*, 2010 TMOB 101 at paras 15-19, 2010 CarswellNat 3545]. In this case, the Owner submits that the Goods cannot be packaged outside of a concrete truck and must be delivered directly to customers on site. In any event, as previously noted, the the Mark is brought to the attention of the purchaser at the time of transfer on the delivery tickets; thus, the presence of the Mark on the delivery trucks, in conjunction with the totality of the evidence, and particularly in view of the nature of the Goods, provides further support of notice of association between the Mark and the Goods [see *Real Food, supra* at para 17].

[20] Lastly, with respect to the invoices provided by the Owner, while it cannot be assumed that invoices accompany goods at the time of transfer in the absence of evidence to that effect [*Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD)], in this case, at least one of the invoices appears to have been issued to the same delivery address as a delivery ticket for the same product on the same date. Accordingly, I am prepared to infer that the Mark, which appears in the body of the invoice, would have been brought to the attention of the same party who received the Goods, thus giving the requisite notice of association of the Mark per

section 4(1) of the Act [see *Lehigh Hanson, supra* at para 12; and *Riches, McKenzie & Herbert LLP v KOM Networks Inc* (2005), 51 CPR (4th) 65 at para 11, for similar conclusions].

[21] In view of all the foregoing, I am satisfied that the Owner has shown use of the Mark in association with both ready mix concrete and coloured ready mix concrete within the meaning of sections 4(1) and 45 of the Act.

DISPOSITION

[22] 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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Kathryn Barnett  
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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**HEARING DATE** No hearing held

**AGENTS OF RECORD**

Bennett Jones LLP

FOR THE REGISTERED OWNER

Cameron IP

FOR THE REQUESTING PARTY