

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 68

Date of Decision: 2020-05-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Marks & Clerk

Requesting Party

and

**Lawson Products Inc., an Illinois
corporation**

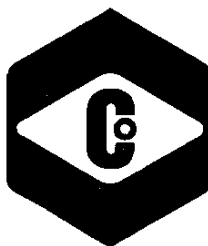
Registered Owner

TMA208,744 for C & Design

Registration

INTRODUCTION

[1] At the request of Marks & Clerk (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on January 4, 2018, to Lawson Products Inc., an Illinois corporation (the Owner), the registered owner of Registration No. 208,744 for trademark C & Design (the Mark), shown below:



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

(1) Welding rods; welding electrodes; brazing and soldering wire and rods; fluxes for welding, brazing and soldering; liquid surface cleaners for metals to be welded; liquid masking compound for protecting metal surfaces from welding spatter and heat discoloration; and a heat barrier compound in the form of a heat-resistant plastic putty.

(2) Welding rods; welding electrodes; brazing and soldering wire and rods; fluxes for welding, brazing and soldering; liquid surface coatings for surfaces to be welded; liquid masking compound for protecting metal surfaces from welding spatter and heat discoloration; and a heat barrier compound in the form of a heat-resistant plastic putty.

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

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with the goods 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 January 4, 2015, to January 4, 2018.

[5] The relevant definition of use for goods is set out in section 4 of the Act as follows:

4(1) A trademark 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.

[6] It is well established that bare statements that a trademark is in 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) (*Plough*)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 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 trademark in association with *each* of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) (*John Labatt*)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Nick Sturino, sworn August 10, 2018. Only the Owner filed written representations. No oral hearing was held.

THE OWNER'S EVIDENCE

[8] Mr. Sturino is the Manager, Product Management Fasteners, Cutting Tools & Abrasives, Automotive, Welding, Safety, Material Handling & Storage Equipment for the Owner. He states that the Owner is an industrial distributor of maintenance and repair supplies. He explains that, in the normal course of trade, a corporate customer will contact the Owner and place hundreds of small orders for parts from a physical or electronic catalog or through a direct sales agent or phone representative. As Exhibit A, he attaches screenshots from *www.lawsonproducts.ca*, from which the Owner sells goods in Canada. The Mark does not appear on the page.

[9] As Exhibits C and D, Mr. Sturino attaches pages from the Owner's catalogs for the years 2013-2015, and 2015-2017, respectively. I note that the Mark and the word CERTANIUM appear next to a number of items relating to welding, brazing, and soldering in these catalogs. In particular, in the Exhibit D catalog, covering the relevant period, the Mark appears next to the following goods: electrodes (pp 920-921, 932), stainless steel alloys in the form of rods, electrodes, and wires (p 933), aluminum electrodes and wires (p 942), dissimilar steel stick electrodes (p 947), brazing alloys in rod and wire form (pp 951-952), various other alloys in wire and electrode form (pp 950, 959-960, 965), other wires (pp 963-965), and a base metal cleaner (p 969). I note that on page 954, a category is shown for "Fluxes for Brazing and Soldering"; while it is difficult to tell for certain due to the quality of the copy, the packaging for certain fluxes appears to display the Mark.

[10] Mr. Sturino refers to Exhibit E as being four pages from the Lawson Products Welding Technical Guide. No such pages are attached to the affidavit as submitted to the Registrar; however, a portion of this guide appears to be reproduced in the body of the affidavit, showing the Mark alongside a reference to stick electrodes. As Exhibit F, he attaches an image from the Owner's website showing electrodes in packaging displaying the Mark; he includes further pictures in his affidavit of packaging for unspecified products displaying the Mark. He states that these examples illustrate how the Mark is displayed on the packaging of the goods shown in the catalog in association with the Mark. He affirms that the Owner "brands boxes, bags, and all sorts of other containers for all these goods with the [Mark] and has done so for decades".

[11] Mr. Sturino provides combined sales figures for “invoiced products under the CERTANIUM®/C & Design® marks” in Canada, showing sales in excess of \$200,000 per year in 2015, 2016, and 2017. He affirms that the Owner has used the Mark during the relevant period “in respect to each of the wares specified in the registration.” Finally, as Exhibit H, Mr. Sturino attaches two invoices, both dated after the relevant period, showing sales of items identified with product codes that correspond with electrodes displayed in the Exhibit C and D catalogs.

ANALYSIS

[12] At the outset, I note that several of the goods are duplicated in the registration; however, I am satisfied that such duplication is not at issue in this proceeding.

[13] In its brief written representations, the Owner submits that it has established use of the Mark in association with all of the registered goods by showing that the Mark was displayed on packaging for the goods, as well as being displayed next to certain goods in the Owner’s catalogs and website. However, such evidence on its own is not sufficient to establish use in association with all the goods in the registration within the meaning of sections 4(1) and 45 of the Act; a trademark owner must show that the Mark was displayed in association with *each* of the goods during the relevant period, and that each such good was sold or transferred in the normal course of trade during the relevant period in association with the Mark.

[14] In this case, the Owner has provided evidence showing that the Mark was displayed in association with certain items by way of the Exhibit D catalog, and also that the Mark was displayed on the packaging for such items during the relevant period. It is well established that notice of association between a trademark and goods can be established when customers place orders by way of a catalog or brochure that displays the trademark in close association with those goods, and that notice of association continues when the goods are delivered [see, for example, *Swabey Ogilvy Renault v Mary Maxim Ltd* (2003), 28 CPR (4th) 543 (TMOB) at para 12; *Rosenstein v Elegance Rolf Offergelt GmbH* (2005), 47 CPR (4th) 196 (TMOB) at para 15; *Fraser Milner Casgrain LLP v LG Electronics Inc*, 2014 TMOB 232 at para 21]. As the Mark is prominently displayed next to the goods in the catalog used by customers when purchasing the goods contained therein, and as Mr. Sturino has affirmed that the Mark is displayed on the

packaging for such goods, I find that the Owner has established notice of association between the Mark and those goods at the time of transfer of property and possession.

[15] However, it is not clear that the items appearing in the Exhibit D catalog and elsewhere in evidence encompass the entirety of the goods as registered. In this respect, I note that the Owner does not correlate these items with the goods as registered. It is not for the Registrar to speculate as to the nature of the registered goods [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13; *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 at para 12 (TMOB)]. However, in this case, I am satisfied that the items depicted in the Owner's evidence correspond to certain registered goods.

[16] In particular, I am satisfied that the stainless steel alloy rods shown at page 933 correspond to the registered good "welding rods"; that the electrodes shown at pages 920-921 and 932 correspond to the registered good "welding electrodes"; that the brazing alloys shown at pages 951-952 correspond to the registered good "brazing and soldering wire and rods"; that the fluxes shown at page 954 correspond to the registered good "fluxes for welding, brazing and soldering"; and that the base metal cleaner shown at page 969 corresponds to the registered good "liquid surface cleaners for metals to be welded".

[17] With respect to the registered goods "liquid surface coatings for surfaces to be welded", while the aforementioned fluxes might be considered as falling into this category, I note that where use in association with a specific good could potentially support two goods in a registration, the more specific good will be maintained over the more generalized [*Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD) at paras 14-16]. As such, insofar as the fluxes displaying the Mark shown at page 954 correspond to the registered good "fluxes for welding, brazing and soldering", they cannot also support use of the Mark in association with "liquid surface coatings for surfaces to be welded". As the Owner chose to list these goods separately in the registration, the implication is that the latter registration refers to liquid surface coatings other than fluxes. Moreover, I can identify no other instance in evidence where the Mark appears in association with a good that might fall within the ambit of this more general registered good.

[18] Similarly, there do not appear to be any products shown in association with the Mark in the catalog or elsewhere in evidence corresponding to the goods “liquid masking compound for protecting metal surfaces from welding spatter and heat discoloration; and a heat barrier compound in the form of a heat-resistant plastic putty”.

[19] As to the issue of whether the Owner has shown that each of the goods was transferred in Canada in the normal course of trade during the relevant period, I note that the sales figures provided by Mr. Sturino refer to “products under the CERTANIUM®/C & Design® marks” in aggregate and are not broken down by item. No invoices dated during the relevant period showing transfers of specific registered goods are provided.

[20] It is well established that invoices are not mandatory in section 45 proceedings [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. However, in the absence of invoices, a registered owner should be prepared to furnish evidence regarding volumes of sales, dollar value of sales, or equivalent factual particulars, to allow the Registrar to conclude that transfers in the normal course of trade actually occurred in Canada during the relevant period [see *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79; and *Gowling Lafleur Henderson LLP v Wertex Hosiery Inc*, 2014 TMOB 193]. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements.

[21] In this case, the Owner has provided a catalog dated during the relevant period showing how the Mark was displayed in association with a number of registered goods, and also illustrating that the Owner was offering such items for sale. The Owner has also provided evidence of substantial sales of such items (in aggregate) during the relevant period, along with detailed evidence regarding its normal course of trade and a clear sworn statement that the Owner used the Mark in association with each of the registered goods during the relevant period. On a fair reading of the affidavit as a whole, and bearing in mind that the Owner need only establish a *prima facie* case of use, I am prepared to infer that the aggregate sales during the relevant period included the specific types of products depicted in the Exhibit D catalog [for similar conclusions, see *Gowling Lafleur Henderson LLP v Neutrogena Corp* (2009), 74 CPR

(4th) 153 at para 16; *Osler, Hoskin & Harcourt LLP v Esprit International*, 2018 TMOB 9 at para 22].

[22] Accordingly, I am satisfied that the Owner has established use of the Mark in association with the registered goods “Welding rods; welding electrodes; brazing and soldering wire and rods; fluxes for welding, brazing and soldering; liquid surface cleaners for metals to be welded” within the meaning of sections 4 and 45 of the Act.

[23] As for the aforementioned goods not evidenced in Mr. Sturino’s affidavit or attached exhibits, namely, “liquid surface coatings for surfaces to be welded”, “liquid masking compound for protecting metal surfaces from welding spatter and heat discoloration”, and “a heat barrier compound in the form of a heat-resistant plastic putty”, there is no evidence to suggest that the Owner sold these items in association with the Mark during the relevant period aside from Mr. Sturino’s general statement of use in association with each of the goods. As noted in *Plough*, a mere assertion of use is not sufficient to establish use in a section 45 proceeding. What is required is that an affidavit “show use by describing facts from which the Registrar or the Court can form an opinion or can logically infer use within the meaning of section 4 of the Act” [*Guido Belucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245 at para 18]. Accordingly, I am not prepared to infer that the aggregate sales figures included these aforementioned goods or that they were sold in association with the Mark.

[24] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered goods “liquid surface coatings for surfaces to be welded; liquid masking compound for protecting metal surfaces from welding spatter and heat discoloration; and a heat barrier compound in the form of a heat-resistant plastic putty”, within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances before me which would excuse non-use of the Mark in association with these goods, the registration will be amended accordingly.

DISPOSITION

[25] In view of all of the foregoing, 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 registered goods:

liquid surface coatings for surfaces to be welded; liquid masking compound for protecting metal surfaces from welding spatter and heat discoloration; and a heat barrier compound in the form of a heat-resistant plastic putty.

[26] The amended statement of goods will be as follows:

(1) Welding rods; welding electrodes; brazing and soldering wire and rods; fluxes for welding, brazing and soldering; liquid surface cleaners for metals to be welded.

(2) Welding rods; welding electrodes; brazing and soldering wire and rods; fluxes for welding, brazing and soldering.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENTS OF RECORD

Osler, Hoskin & Harcourt LLP

For the Registered Owner

Marks & Clerk

For the Requesting Party