



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 86**

**Date of Decision: 2021-05-07**

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

**Miller Thomson LLP**

**Requesting Party**

**and**

**CFS Concrete Forming Systems Inc.**

**Registered Owner**

**TMA583,617 for OCTAFORM**

**Registration**

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA583,617 for the trademark OCTAFORM (the Mark), owned by CFS Concrete Forming Systems Inc. (the Owner).

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

THE PROCEEDINGS

[3] At the request of Miller Thomson LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on December 19, 2017.

[4] The notice required the Owner to show whether the Mark had been used in Canada in association with each of the goods and services 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 December 19, 2014, to December 19, 2017.

[5] The Mark is registered for use in association with the following goods and services:

**GOODS**

Formwork for pouring concrete.

**SERVICES**

Building construction services.

[6] The relevant definitions of use in the present case are 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.

4(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 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)]. However, 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 and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of George David Richardson, sworn on June 29, 2018. Both parties submitted written representations; only the Owner was represented at an oral hearing.

## THE EVIDENCE

[9] Mr. Richardson is President of the Owner and of Octaform Systems Inc. [OSI]. He states that the Owner designs and develops concrete forming systems and products, while OSI is in the business of marketing and selling such systems and products, and providing related services, in Canada. He further states that during the relevant period, the Owner licensed OSI to use the Mark in Canada in association with the registered goods and services, and that the Owner has direct or indirect control over the character and quality of all such goods or services.

[10] Mr. Richardson explains that for any sale of the registered goods during the relevant period, OSI would generate a sales order listing the goods ordered by the customer, and would send that sales order to the customer, who would sign and return the order along with a deposit. As Exhibits 7 and 13, he attaches sales orders dated during the relevant period, addressed to buyers in Canada, and displaying the Mark in the header and product description section. Mr. Richardson states that once OSI receives a sales order and deposit, the registered goods are shipped to customers either in a wood crate or metal container bearing a label displaying the Mark (shown in Exhibits 5 and 9).

[11] Mr. Richardson further explains that along with the sales orders, OSI would provide a “construction guide” document displaying the Mark, a copy of which is attached as Exhibit 6. This document contains information on the assembly and installation of OSI’s formwork product, including instructions on how to pour concrete into it; the Mark is displayed on the cover and throughout the text of the document. He states that OSI would also send customers an invoice and various other documents relating to purchase or assembly, all displaying the Mark. I note that three sample invoices are attached showing sales of the goods to customers in Canada during the relevant period.

[12] With respect to the registered services, Mr. Richardson states that OSI provided technical field training and field services in relation to assembly and installation of its products at construction projects. He states that OSI’s personnel performed the services at construction sites during the relevant period, and that in the course of doing so, such personnel wore protective gloves, and sometimes headwear, displaying the Mark. As Exhibit 25, Mr. Richardson attaches photographs of gloves and headwear displaying the Mark, which he states are representative of

those worn by OSI personnel during the relevant period. As Exhibit 26, he attaches a photograph showing an individual wearing protective gloves displaying the Mark, and explains that this photograph shows OSI personnel performing the services at a customer's construction site in Ontario in January 2016. As Exhibits 27 and 28, Mr. Richardson attaches invoices to customers in Canada, dated during the relevant period and displaying the Mark, for technical field services and technical field training. In addition, Mr. Richardson attaches a number of archived screenshots from the Owner's and OSI's websites displaying the Mark and describing OSI's business and products.

#### REASONS FOR DECISION

[13] The Requesting Party raises the following issues: that any use of the Mark shown in evidence does not enure to the Owner, and that the goods and services shown in evidence are not the registered goods or services. Each issue will be addressed in turn.

[14] However, as a preliminary matter, I note that in its written representations, the Requesting Party refers to facts not in evidence; specifically, to a second trademark applied for by the Owner which, in the Requesting Party's view, more accurately encompasses the goods and services. However, I can only consider evidence submitted by the Owner in accordance with sections 45 and 47 of the Act. While the Registrar has the discretion to check records kept under its supervision, the Registrar will generally not exercise such discretion in a section 45 proceeding [*2001237 Ontario Ltd v Footstar Corp*, 2003 CanLII 71192, 2003 CarswellNat 6253 (TMOB)]. I see no reason to exercise such discretion in this case; in any event, the fact that the Owner may have applied for a differently worded trademark registration is of no consequence in this proceeding.

#### **Licensed Use**

[15] The Requesting Party submits that Mr. Richardson's statements regarding licensed use by OSI amount to "bare assertions", given that Mr. Richardson has not furnished a copy of the licence agreement nor described its terms and conditions. The Requesting Party further submits that Mr. Richardson's statements regarding licensing are contradicted by the documents shown in evidence in that such documents refer only to OSI and not to the Owner or any licence

agreement. In particular, the Requesting Party observes that certain webpage screenshots indicate that the products sold by OSI were developed by “OSI’s team led by Mr. Richardson”; the Requesting Party submits that “[t]his affirmative statement that the separate legal entity OSI developed the products and used the [Mark] is central and dispositive to the issue of licensed use.”

[16] In response, the Owner submits, and I agree, that Mr. Richardson’s clear, sworn statement that OSI uses the Mark pursuant to a licence under which the Owner controls the character and quality of the goods and services is sufficient to establish that such use enures to the Owner [see *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102 at para 84]. To the extent that the Requesting Party is submitting that OSI, rather than the Owner, is the proper owner of the Mark, I note that section 45 proceedings are not intended to provide an alternative to the usual *inter partes* attack on a trademark [*United Grain Growers Ltd v Lang Michener* (2001), 12 CPR (4th) 89 (FCA)], and the validity of the registration is not in dispute in such proceedings. As such, issues of ownership are more properly dealt with by way of application to the Federal Court pursuant to section 57 of the Act. In any event, there is no requirement in the Act that the Owner be identified as owner of the goods or services on the packaging or elsewhere, and for the purposes of this proceeding, it does not matter who the public would perceive to be the owner of the Mark [see *Michaels v Unitop Spolka Z Organizowana Odpowiedzialnoscia*, 2020 FC 937 at para 13].

### **The Registered Goods**

[17] The Requesting Party notes that the registered goods are described as “formwork for pouring concrete”, but contends that Mr. Richardson describes the goods shown as evidence as being for the purpose of protecting concrete. Further, the Requesting Party submits that the goods shown in the exhibits do not purport to function to pour concrete. Accordingly, the Requesting Party submits that because the purpose and function of the evidenced goods are different from the goods as registered, the Owner has not demonstrated use of the Mark in association with the registered goods.

[18] In response, the Owner submits that Mr. Richardson’s affidavit makes it clear that OSI’s goods are for pouring concrete, referring to diagrams and tables from the exhibited construction

guides entitled “CONCRETE POUR RATES” indicating the proper methods for pouring concrete through the Octaform system. In the Owner’s view, the Requesting Party’s submissions amount to an argument that “‘Formwork for pouring concrete’ must mean only something which concrete is poured out of, and would not include something which concrete is poured in” [emphasis in original], and that this interpretation “does not make sense given the presence of the word ‘Formwork’ within the description of the Goods.” In this respect, the Owner submits that the goods in a registration should be interpreted in accordance with common sense and given their ordinary meaning.

[19] Again, I agree with the Owner. The totality of the evidence, including the construction guides, clearly show that the goods sold by OSI are formwork into which concrete is poured. I have no difficulty concluding that these goods would fall within the ambit of “formwork for pouring concrete”. In reaching this conclusion, I am mindful of the principle that section 45 proceedings are not meant to be an exercise in meticulous verbal analysis [*Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17; *Canadian Council of Professional Engineers v ING LORO PIANA & C SPA*, 2009 FC 1096 at para 23].

[20] As the Owner’s evidence shows numerous instances of display of the Mark at the time of transfer of these goods, including on the packaging for the goods, as well as instances of transfer of such goods in the normal course of trade in Canada during the relevant period, I am satisfied that the Owner has established use of the Mark in association with the registered goods within the meaning of the Act.

### **The Registered Services**

[21] With respect to the registered services, the Requesting Party submits that the technical field services and field training services provided to the Owner are not “building construction services”, observing that the evidence indicates that the installation of the products is performed by the project’s construction crew, rather than OSI personnel.

[22] In response, the Owner submits that services are to be given a liberal interpretation in section 45 proceedings, and cites a number of cases where a liberal interpretation was given to construction services. Again, I agree. It is well established that services are to be construed

liberally and may include incidental or ancillary services [*Heenan Blaikie LLP v Sports Authority Michigan Inc*, 2011 FC 273; *Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express* (2000), 9 CPR (4th) 443 (FCTD)]. So long as members of the public receive a benefit from the activity in question, it is a service [*Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134]. In this case, the evidence establishes that OSI's services included providing assistance assembling and installing its goods, which in turn were used in the course of building construction. In view of the principles enumerated above, I am satisfied that such services would fall within the ambit of "building construction services".

[23] The Owner has provided evidence, including invoices, demonstrating that these services were performed in Canada during the relevant period. Further, it has furnished evidence showing that the Mark was displayed when these services were performed during the relevant period, namely, on garments worn by OSI personnel [for a similar conclusion, see *Titan Capital Ventures Inc v Titan Construction, Inc*, 2015 TMOB 83 at paras 24-25]. Accordingly, I am satisfied that the Owner has established that the Mark was used in association with the registered services within the meaning of the Act.

#### DISPOSITION

[24] In view of all of the foregoing, 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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G.M. Melchin  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2021-04-27

**APPEARANCES**

Craig A. Ash For the Registered Owner

No one appearing For the Requesting Party

**AGENTS OF RECORD**

Oyen Wiggs Green & Mutala LLP For the Registered Owner

Miller Thomson LLP For the Requesting Party