



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 105

Date of Decision: 2021-05-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Tracklok Limited

Requesting Party

and

Custom EPS Inc.

Registered Owner

TMA928,869 for THE GRIDLOCK

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. TMA928,869 for the trademark THE GRIDLOCK (the Mark), owned by Custom EPS Inc. (the Owner).

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

THE PROCEEDING

[3] At the request of Tracklok Limited (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on March 4, 2019.

[4] The notice required the Owner to show whether the Mark had 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 March 4, 2016, to March 4, 2019.

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

Fasteners for connecting expanded polystyrene used as underlay in flooring applications.

[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.

(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[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 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 Madison Daniels, a Director and Officer of the Owner, sworn on May 30, 2019. Both parties submitted written representations. No oral hearing was held.

THE EVIDENCE

[9] The affiant states that the Owner is a business based in Alberta that sells custom and pre-fabricated shower pans to contractors and end consumers. The affiant states that the registered goods are fasteners that are sold as part of an assembly kit for all of the Owner's custom shower pans. The affiant attaches the following exhibits:

- Exhibit A: a copy of installation instructions, which the affiant states are included with all of the Owner's custom shower pans. The instructions show how to install the Owner's shower pan product on a floor or substrate. In the top left corner of the page, there is a heading entitled "ASSEMBLY KIT"; listed below the heading are "Instruction sheet" and "GRIDLOCKS™". The instructions also include the line "Insert a GRIDLOCK™ mechanical fastening device into each and every corresponding location."
- Exhibit B: an item displaying the Mark which the affiant describes as an example of the fasteners that form part of the assembly kit accompanying the custom shower pans.
- Exhibits C1 through C12 and D1 through D12: representative invoices for the years 2016 and 2017, each of which shows sales of the Owner's custom shower pan product. While the names and addresses of the buyers are redacted, I note that several of the invoices refer to delivery or pickup in Edmonton or customer pickup. The affiant states that "[a]s detailed in Exhibit 'A', in order to install a Custom EPS shower pan, THE GRIDLOCK fasteners are required and sold with each shower pan." Finally, the affiant states that the Owner's shower pan sales for the year 2018 amounted to approximately \$210,000.

REASONS FOR DECISION

[10] The Requesting Party submits that the evidence does not establish use of the Mark within the meaning of the Act. In particular, with respect to Exhibit A, the Requesting Party submits that the instruction manual does not provide notice of association between the Mark and the

registered goods at the time of transfer, and that the use of the word “GRIDLOCK” or “GRIDLOCKS” does not amount to use of the Mark as registered.

[11] With respect to Exhibit B, the Requesting Party submits that the affiant fails to establish that the fastener in the photograph corresponds to the registered goods. Further, the Requesting Party submits that the affidavit does not establish that goods referenced in Exhibit A and the item shown in Exhibit B were ever sold in Canada in the normal course of trade.

[12] Finally, with respect to the Exhibit C invoices, the Requesting Party submits that there is no evidence that these transactions occurred in Canada, and that the affiant’s statements that the Exhibit A instructions and Exhibit B fasteners accompanied the shower pans in these transactions amount to “bare assertions”.

[13] It is well established that an overly technical dissection of an owner’s evidence is inconsistent with the purpose of section 45 proceedings [see *Dundee Corp v GAM Ltd*, 2014 TMOB 152 at para 21; *Reckitt Benckiser (Canada) Inc v Tritap Food Broker*, 2013 TMOB 65 at para 27]. It is the evidence as a whole that must be considered, and it must be remembered that exhibits should be read in conjunction with the information provided in the affidavit. Further, absent evidence to the contrary, an affiant’s sworn statement is to be accepted at face value, and statements in an affidavit must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25].

[14] With respect to use in association with the registered goods, the affiant specifically correlates the registered goods with the fasteners referenced in the instruction manual and shown in Exhibit B. This is supported by the instruction manual, which shows that the fasteners are used as a component of flooring applications. Accordingly, I accept that the fastener shown in Exhibit B is an example of “Fasteners for connecting expanded polystyrene used as underlay in flooring applications”. Further, in view of the totality of the evidence, including the affiant’s sworn statements, I accept that such fasteners and the instruction manuals would have accompanied the sales of shower pans shown in the invoices.

[15] Moreover, I concur with the Owner that the use of the word “GRIDLOCK” and “GRIDLOCKS” in the instruction manual would amount to use of the Mark as registered, given

that “GRIDLOCK” is the dominant element of the Mark and the omission of “THE” or the addition of “S” does not cause the Mark to lose its identity [see *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[16] With respect to notice of association between the Mark and the goods at the time of transfer, the display of a trademark on a product manual provided at the time of transfer can establish use of the Mark within the meaning of section 4 of the Act [*Billi R & D Pty Ltd v Culligan International Company*, 2020 TMOB 20 at para 14; *BCF LLP v THAT Corp*, 2016 TMOB 190 at paras 31-33; *Ogilvy v Clarke Industries Inc*, 2006 CarswellNat 2059 at para 8]. In any event, the Mark is displayed on the goods themselves, as confirmed by the Exhibit B photograph of the fasteners that were included in the assembly kits accompanying all sales of the Owner’s custom shower pans.

[17] Finally, based on the references to “customer pickup” and “pickup in Edmonton” on certain invoices, I am satisfied that at least some of the transfers occurred in Canada. Accordingly, given that the invoices show a pattern of commercial transactions in the normal course of trade during the relevant period, and given that the affiant attested that the registered goods and instruction manuals displaying the Mark were transferred in the course of all such transactions, I am satisfied that the Owner has used the Mark in association with the registered goods within the meaning of sections 4(1) and 45 of the Act. I further note that any export of goods displaying the Mark from the Owner’s location in Canada to a buyer in the United States would similarly amount to use within the meaning of section 4(3) of the Act.

DISPOSITION

[18] 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.

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

Thompson Cooper LLP

For the Registered Owner

Ridout & Maybee LLP

For the Requesting Party