



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 185

Date of Decision: 2021-08-19

IN THE MATTER OF A SECTION 45 PROCEEDING

Fetherstonhaugh & Co.

Requesting Party

and

Koroseal Interior Products, LLC

Registered Owner

UCA9263 for KOROSEAL

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. UCA9263 for the trademark KOROSEAL (the Mark), currently owned by Koroseal Interior Products, LLC.

[2] All references are to the Act as amended June 17, 2019 (the Act), unless otherwise noted.

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

- (1) Sheet packing embodying plasticized polymerized vinyl chloride.
- (2) Plasticized polymerized vinyl chlorides.
- (3) Calendered plasticized polymerized vinyl chlorides.
- (4) Extruded plasticized polymerized vinyl chlorides.
- (5) Moulded plasticized polymerized vinyl chlorides.

(6) Fabrics and woven felted cloth or paper, impregnated or coated with plasticized polymerized vinyl chlorides.

(7) Overshoes; hose pipes; rigid pipes, valves and fittings; tank lining; magnetic strips and waterstop.

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

THE PROCEEDINGS

[5] At the request of Fetherstonhaugh & Co. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on June 28, 2019, to Koroseal Interior Products, LLC (the Owner), the registered owner of the Mark.

[6] The notice required the Owner to show whether the trademark has been used in Canada in association with 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 June 28, 2016 to June 28, 2019 (the Relevant Period).

[7] The relevant definition of use in the present case is set out in section 4(1) 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.

[8] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[9] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[10] In response to the Registrar's notice, the Owner furnished the affidavit of Thomas C. Roche, Director of Architectural Products of the Owner, affirmed on March 24, 2020, to which were attached Exhibits A to E.

[11] Only the Requesting Party submitted written representations and no oral hearing was held.

THE EVIDENCE

[12] In his affidavit, Mr. Roche explains that the Owner specializes in the manufacture and sale of commercial wallcoverings, wall protection systems, dry erase presentation surfaces, digitally printed wallcoverings and other complementary specialty interior finish products [para 4].

[13] With respect to the registered goods, Mr. Roche states that the Owner has sold the following goods in Canada in association with the Mark during the Relevant Period [paras 6 and 7]:

- (2) Plasticized polymerized vinyl chlorides.
- (3) Calendered plasticized polymerized vinyl chlorides.
- (4) Extruded plasticized polymerized vinyl chlorides.
- (6) Fabrics and woven felted cloth or paper, impregnated or coated with plasticized polymerized vinyl chlorides.

[14] In support, Mr. Roche attaches the following exhibits to his affidavit:

- Exhibit A: four invoices from the Relevant Period relating to the sale by the Owner of wallcovering products to customers in Canada, specifically related to products containing plasticized polymerized vinyl chlorides; calendered plasticized polymerized vinyl chlorides; and fabrics and woven felted cloth or paper, impregnated or coated with plasticized polymerized vinyl chlorides [paras 9 and 10].

- Exhibit B: printouts from the Owner’s website providing product, pattern and colour codes for the aforementioned goods. The Mark appears on the printouts of the items “Koroseal AUTHENTICITY don quixote” and “Koroseal GALERIE smoke”, and these products correspond with some listings on the invoices provided in Exhibit A [para 11].
- Exhibit C: six invoices from the Relevant Period relating to the sale by the Owner of wall protection products to customers in Canada, specifically related to products containing extruded plasticized polymerized vinyl chlorides [paras 12 and 13].
- Exhibit D: printouts from the Owner’s website providing the G800 and H500 product series descriptions and specifications, and these products correspond with some listings on the invoices provided in Exhibit C [para 14].
- Exhibit E: three photographs of product packaging in which the goods were sold in Canada during the Relevant Period, showing how the Mark was displayed on the packaging [para 15].

[15] Mr. Roche adds that, being wallcovering and wall protection products, the Mark is not displayed on the product themselves, but is instead displayed on the packaging in which the goods were sold in Canada during the Relevant Period [para 15, Exhibit E].

ANALYSIS AND REASONS FOR DECISION

[16] As noted by the Requesting Party in its written representations, the Roche Affidavit alleges sales during the Relevant Period of only a subset of the registered goods, specifically, goods (2), (3), (4), and (6). The Roche Affidavit does not reference or exhibit sales in association with the remaining goods nor does it provide the date when the remaining goods were last sold in Canada or special circumstances which might excuse the absence of use. Accordingly, goods (1), (5) and (7) will be deleted from the registration.

[17] For goods (2), (3), (4), and (6), in view of the evidenced sales and display of the Mark described above, I am satisfied that the Owner has demonstrated use of the Mark in Canada in association with such goods within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[18] 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 goods (1), (5), and (7).

[19] Accordingly, the registration will be maintained in part and it now reads as follow:

- (2) Plasticized polymerized vinyl chlorides.
- (3) Calendered plasticized polymerized vinyl chlorides.
- (4) Extruded plasticized polymerized vinyl chlorides.
- (6) Fabrics and woven felted cloth or paper, impregnated or coated with plasticized polymerized vinyl chlorides.

Martin Béliveau
Chairperson
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

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L,s.r.l.	For the Registered Owner
Smart & Biggar IP Agency Co.	For the Requesting Party