



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 206

Date of Decision: 2021-09-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Thermission AG

Requesting Party

and

GH International Sealants ULC

Registered Owner

TMA399,828 for EXCEL

Registration

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA399,828 for the trademark EXCEL (the Mark), owned by GH International Sealants ULC (the Owner).

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

- (1) Waterproofing sealer for cementitious, wood and metal surfaces.
- (2) Waterproofing stains.
- (3) Bituminous mixtures, bituminous driveway and roadway paving materials, driveway sealers, and driveway and roadway repair products namely pothole patching materials, crack fillers, and depression levelers.

(collectively the “Goods”)

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

THE PROCEEDING

[4] On May 9, 2019, the Registrar of Trademarks sent a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to the Owner. The notice was sent at the request of Thermission AG (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 May 9, 2016 and May 9, 2019 (the Relevant Period), with respect to each of the goods specified in registration No. TMA399,828. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used in Canada 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 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.

[7] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trademarks. The expression “clearing deadwood” has often been used to describe these proceedings. The threshold for establishing use in section 45 proceedings 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)]. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the trademark was used in association with each of the registered goods and services at any time during the relevant period [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270 (FCTD)]. Mere assertions of use are insufficient to prove use of the trademark [*Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 45 CPR (2d) 194 (FCTD), *aff’d* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar’s notice, the Owner filed the affidavit of Sean Poole, sworn on December 9, 2019, to which were attached Exhibits A to G.

[9] Only the Owner filed written representations. No hearing was held.

THE EVIDENCE

[10] In his affidavit, Mr. Poole identifies himself as Chief Financial Officer of Gardner-Gibson. Mr. Poole explains that the Owner was acquired by Gardner-Gibson as of 2011. Copy of a publication providing details on the acquisition of the Owner by Gardner Gibson is attached as Exhibit A to the affidavit. Mr. Poole attests to having personal knowledge of all the facts deposed to in his affidavit.

[11] Mr. Poole states that all of the Goods are sold in association with the Mark in Canada, and the Mark has been in use in Canada in association with all of the Goods, including during the Relevant Period.

[12] In support, Mr. Poole attaches copies of the following materials as exhibits to his affidavit:

- Exhibit B: “representative sample of invoices dated between May 2016 and late April 2019 for the sale of EXCEL products in Canada”.
- Exhibit C: “product specifications for products” referred to by item numbers in the exhibited invoices.
- Exhibit D: “product specifications and advertisements for EXCEL products sold in the normal course of trade in Canada during the Relevant Period, including: [the Goods]”.
- Exhibit E: “advertisements depicting displays of EXCEL products which were sold in the normal course of trade in Canada during the Relevant Period”.
- Exhibit F: “advertisements for EXCEL products publicly disseminated to consumers in Canada during the Relevant Period, including for [the Goods]”.
- Exhibit G: documentation pertaining to “guides for use of EXCEL products disseminated to consumers in Canada during the Relevant Period, including for [the Goods]”.

ANALYSIS AND REASONS FOR DECISION

[13] The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner needs only to 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].

[14] Absent representations from the Requesting Party, I agree with the Owner that it has met its burden under section 45 of the Act. Indeed, when considering the affidavit of Mr. Poole in its entirety, I find that the evidence is sufficient to show use of the Mark in Canada in association with each of the Goods during the Relevant Period.

[15] Mr. Poole clearly and specifically states that the Mark has been used in Canada during the Relevant Period in association with all of the Goods.

[16] The 15 representative invoices at Exhibit B, which are dated between May 25, 2016 and April 24, 2019, show sales of various products by the Owner to companies in Canada. At paragraph 9 of his affidavit, Mr. Poole clearly correlates item numbers in several invoices with the specification sheets at Exhibit C for products that can be simply described as elastomer-based sealants, and wet/dry surface plastic cement. These specification sheets clearly show the Mark displayed on the product containers.

[17] Likewise, the specification sheet at Exhibit D for the asphalt roof and concrete primer product clearly shows the Mark displayed on the product container.

[18] Finally, the advertisements at Exhibits D to F also clearly show the Mark displayed on product containers. These advertisements show several and different kinds of EXCEL products that can be simply described as: specialty coatings and sealers; roof and foundation products; protective coatings; and driveway and road repair products.

[19] Mr. Poole clearly states that the exhibited specification sheets and advertisements referred to above relate to the Goods. Further, I find that sufficient information can be gleaned from these specification sheets and advertisements to correlate the products shown with all of the Goods. In making such correlations, I am mindful of the principle that when interpreting a statement of goods, one is not to be “astutely meticulous when dealing with [the] language used” [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17].

[20] In addition, I find that the specification sheets and advertisements at Exhibits D to F are corroborative evidence of Mr. Poole statements as to the use of the Mark in association with the Goods during the Relevant Period. More particularly, I accept these specification sheets and advertisements as evidence to show the manner the Mark was associated with the Goods at the time of their sale in Canada during the Relevant Period, namely that the Mark appeared on containers for all of the Goods.

[21] To be clear, I do not accept the display of the Mark on specification sheets and in advertisements for the Goods as evidence of use of the Mark. Indeed, it is trite law that use of a trademark in advertising and promotional material is not in itself sufficient to constitute use in association with goods under section 4(1) of the Act [see *BMW Canada Inc v Nissan Canada Inc*, 2007 FCA 255].

[22] As for the requirement to provide some evidence of transfer of each of the Goods in the normal course of trade, I note that the sampling of invoices show sales of some of the Goods in Canada. Since these invoices do not show sale of each of the Goods, I also note that invoices are not mandatory to satisfactorily evidence transfer in the normal course of trade; such evidence can also be through clear sworn statements [see *Lavery, De Billy, LLP v Dimatt Investments Inc.*, *Carrying on Business as Genesis*, 2021 TMOB 152].

[23] In this case, Mr. Poole clearly and specifically states that the Mark has been used in association with all of the Goods during the Relevant Period. The affiant's clear sworn statements are supported by representative invoices, and by exhibited specification sheets and advertisements relating to the Goods and clearly showing the Mark displayed on containers for the Goods. Thus, I consider that there is sufficient evidence in this case for me to infer transfers of each of the Goods during the Relevant Period.

[24] Accordingly, I am satisfied that the facts presented by Mr. Poole are sufficient to establish use of the Mark, pursuant to sections 4(1) and 45 of the Act, in association with each of the registered goods.

DISPOSITION

[25] In view 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 maintained.

Céline Tremblay
Member
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

Miller Thompson LLP

FOR THE REGISTERED OWNER

Miltons IP/P.I

FOR THE REQUESTING PARTY