

OPIC



CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 270

Date of Decision: 2021-12-01

IN THE MATTER OF A SECTION 45 PROCEEDING

Aird & Berlis LLP

Requesting Party

and

Specialty Minerals (Michigan) Inc.

Registered Owner

TMA715,596 for MINERALS

Registration

MATTER

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. TMA715,596 for the trademark MINERALS MATTER (the Mark), currently owned by Specialty Minerals (Michigan) Inc.

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

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

(1) Technology consultation and research in the field of mineral products used in the manufacture of paper, plastics, rubber, adhesives, sealants, paints, coatings, building products, ceramics, foods, nutritional supplements, and pharmaceuticals (the Services).

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

THE PROCEEDINGS

[5] At the request of Aird & Berlis LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on September 6, 2018, to Specialty Minerals (Michigan) Inc. (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 each of the 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 September 6, 2015 to September 6, 2018 (the Relevant Period).

[7] The relevant definition of use is set out in section 4(2) of the Act as follows:

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.

[8] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 1980 CanLII 2739 (FCA), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in a section 45 proceeding is quite low [*Woods Canada Ltd v Lang Michener* (1996), 1996 CanLII 17297 (FC), 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 or services specified in the registration during the relevant period.

[9] In response to the Registrar’s notice, the Owner furnished an affidavit of Leon Nigohosian Jr., sworn on April 2, 2019 to which was attached Exhibit A.

[10] Both parties submitted written representations. Both parties attended an oral hearing.

THE EVIDENCE

[11] Mr. Nigohosian is the Assistant Secretary and Assistant General Counsel with Mineral Technologies Inc. (MTI) which he describes as a resource and technology-based company that develops, produces and markets a broad range of specialty mineral, mineral-based and synthetic mineral products and related systems and services worldwide.

[12] Mr. Nigohosian states that the Owner and Specialty Minerals Inc. (SMI) are both wholly-owned subsidiaries of MTI.

[13] Further to the above, he states that SMI is licensed to use the Mark “in association with precipitated calcium carbonate (“PCC”) products in Canada” pursuant to a license agreement. To expand, Mr. Nigohosian states that the Owner “has direct control and indirect control over the character and quality of the Services provided by SMI” pursuant to the license agreement.

[14] Lastly, Mr. Nigohosian attests that the Owner “advertised, and continues to advertise, the Consultation and Research Services in Canada through sales presentations provided by SMI employees to current and prospective customers”.

[15] In support of his above-noted assertions of use of the Mark, Mr. Nigohosian attaches under Exhibit A to his affidavit a PowerPoint slide deck displaying the words “Minerals Technologies Inc.” on its front cover, and a PowerPoint slide deck showing “fulfill™” on its front cover. Mr. Nigohosian states that these PowerPoint presentations were delivered to one of SMI’s Canadian customers on October 21, 2016 and October 27, 2016.

ANALYSIS AND REASONS FOR DECISION

[16] The following issues need to be discussed: 1) whether the Mark has been used by the licensee under subsection 50(1) of the Act to benefit the Owner; 2) whether the evidence satisfactorily establishes use of the Mark in association with the Services.

Licensed Use

[17] The Requesting Party submits that the statements made by Mr. Nigohosian in the affidavit contradict or raise ambiguities. They relate to 1) what is covered by the license agreement: goods or services or both; and 2) whether the user of the Mark is a licensee. According to the Requesting Party, the author of the PowerPoint presentations appears to be MTI and not the licensee SMI.

[18] As it pertains to ambiguities, I first note that although Mr. Nigohosian attests that the Owner has direct and indirect control over the character and quality of the services provided by SMI under the license agreement, he nevertheless alleges in contrast that “SMI is licensed to use SMMI’s trademarks in association with precipitated calcium carbonate (“PCC”) products in Canada” [para 2]. It turns out that it is unclear as to whether the license agreement relates to products or services. In any event, if the license covers both products and services, Mr. Nigohosian does not describe in paragraph 2 of his affidavit the nature of the services provided by SMI under such license.

[19] Second, Mr. Nigohosian’s reference to “my Company” in paragraph 11 of the affidavit is to the effect that the PowerPoint presentations were provided by the licensee SMI and consequently that it advertised the Services. However, the display of “Mineral Technologies Inc.” on the front cover of the PowerPoint slide deck dated October 21, 2016 and constant reference to MTI in the slides (see for example slide numbered 25 and second slide of the second PowerPoint deck) add ambiguity as to whether the PowerPoint presentations were provided by SMI or MTI.

[20] Since Mr. Nigohosian is silent on the role of MTI in the marketing of the Services in Canada, I am not prepared to infer that SMI is the author of the PowerPoint presentations even in light of the Owner’s argument that occurrence of the words “SMI CONFIDENTIAL” throughout the slides sustains such inference.

[21] Consequently, I am not satisfied that the affidavit establishes use of the Mark through the licensee SMI under subsection 50(1) of the *Act*. Even if I were wrong in concluding that there is no clear evidence of the existence of a license covering the Services, the evidence described

above does not establish use of the Mark within the meaning of section 4(2) of the Act for the reasons hereinafter set forth.

Use of the Mark in association with Services

[22] It has been held that where the trademark owner is offering and prepared to perform the services in Canada, the display of a trademark on advertising material to promote those services meets the requirements of section 4(2) of the Act [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)].

[23] As a preliminary comment, I note that the Owner acknowledged during the hearing that its evidence relates to use of the Mark in association with technology consultation and research in the field of mineral products used in the manufacture of paper only. Thus, the issue whether the evidence satisfactorily establishes use of the Mark in association with the remaining registered services needs not to be addressed. At best for the Owner, the registration would be amended accordingly as there is no evidence of facts excusing non-use of the Mark in association with those other services.

[24] That said, I note, upon review of Exhibit A, that the words “minerals matter” are displayed throughout the slides of the two PowerPoint presentations. However, no reference to technology consultation and research services in the field of mineral products used in the manufacture of paper is made.

[25] The Owner submits that reference to said services can be found at the third and fourth slide of the PowerPoint presentation delivered on October 27, 2016 where appear the following:

Third slide:

“Customer selects best fit cost performance based on quality, machine performance and cost saving goals.”

Fourth slide:

“Cold starch slurry is taken from the mill make down or storage or prepared for E325 skid.”

“Each starch will be evaluated for optimum treatment conditions which SMI E325 equipment will automatically control to the target.”

“The last step is to combine PCC flow with treated starch to form composite Fulfill® E325.”

[26] The Owner refers solely to these PowerPoint presentations as documentary evidence of advertising of the Services. Mr. Nigohosian clearly states in his affidavit that “[the licensee SMI] does not usually advertise its services in Canada” [para 13]. There is no specific reference in those slides to the services of technology consultation and research in the field of mineral products used in the manufacture of paper.

[27] I can draw an analogy with a business card filed as evidence of use of a trademark in association with services. In those instances, there must be indicia of the relevant services on the card itself [see 88766 *Canada Inc v RH Lea And Associates Ltd*, 2008 CarswellNat 4513 (TMOB)].

[28] The content of the PowerPoint presentation delivered on October 27, 2016 exclusively relates to the Fulfill® E325 technology. In the absence of any representations clarifying the nexus between said technology and the services of technology consultation and research in the field of mineral products used in the manufacture of paper, I find the evidence is at best ambiguous to establish use of the Mark in association with these services during the Relevant Period; an ambiguity that I must interpret against the interests of the Owner [*Aerosol Fillers, supra*].

[29] I conclude that the PowerPoint presentations (Exhibit A) were used to promote Fulfill Technology and the MTI equipment, and not to promote consultation and research in the field of mineral products used in the manufacture of paper.

[30] In view of all the foregoing, and since there is no evidence of special circumstances excusing the absence of use of the Mark, I am not satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the registered services.

DISPOSITION

[31] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-11-04

APPEARANCES

Nora Labbancz

For the Registered Owner

Benneth R. Clark

For the Requesting Party

AGENTS OF RECORD

Smart & Biggar LLP

For the Registered Owner

Aird & Berlis LLP

For the Requesting Party