



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 291

Date of Decision: 2021-12-23

IN THE MATTER OF A SECTION 45 PROCEEDING

Fetherstonhaugh & Co

Requesting Party

and

El Paso Trading Corp.

Registered Owner

TMA919,563 for EMAXX

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. TMA919,563 for the trademark EMAXX (the Mark).

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

THE PROCEEDINGS

[3] At the request of Fetherstonhaugh & Co (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 27, 2018 to El Paso Trading Corp. (the Owner), the registered owner of the Mark.

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

Smoker's accessories, namely personal inhalers and vaporizers, electronic cigarettes, parts, fittings and liquid for all the aforementioned goods; inhalers for therapeutic use

[5] The notice required the Owner to show whether the trademark has been used in Canada, in association with each of the registered goods, 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 November 27, 2015 to November 27, 2018.

[6] 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.

[7] 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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448] and "evidentiary overkill" is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the mark was used in association with the registered goods.

[8] In the absence of use, 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 that excuse the absence of use.

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Guillaume Boulianne, sworn on January 17, 2019, with Exhibits A to F.

[10] Only the Requesting Party submitted written representations, but both parties were represented at a hearing.

THE EVIDENCE

[11] Mr. Boulianne is the General Manager of 9311-1565 Québec Inc. (GYB), doing business under the name GYB Distribution. According to him, GYB is the “exclusive distributor of products sold under the trademark EMAXX” in Canada.

[12] Mr. Boulianne states that GYB purchases “smoker’s accessories, namely vaporizers, electronic cigarettes, parts, fittings and liquid for all the aforementioned goods” from the Owner and that it distributes these goods to Canadian tobacco shops and convenience stores.

Mr. Boulianne explains that the retailers can purchase the products directly through GYB’s website.

[13] In support, the following relevant exhibits are attached to Mr. Boulianne’s affidavit:

- Exhibit A consists of a printout from the internet archive WayBack Machine of the homepage of the Owner’s website (*www.emaxx.ca*) archived on July 2, 2016. This homepage also refers to GYB’s website (*www.gybdistribution.com*).
- Exhibit B consists of two photographs taken by Mr. Boulianne in 2017 of products displayed in two convenience stores located in the province of Québec. The Mark appears on the packaging of at least two different products shown in the photographs.
- Exhibit C consists of three invoices from GYB, all dated during the relevant period, and a copy of GYB’s price list from May 2016. On each invoice, the GYB’s business name and contact information appear next to “[authorized] distributor of eMaxx and Spike products”. The products appearing on the first four pages of the price list are identified as eMaxx products, each accompanied by a photograph, a name, and redacted prices. These products are divided into the following categories: Vaporizers, eJuice, Disposable Products, and Premium Products. The following pages contain products sold under other trademarks, such as Spike, Duracell, and Colgate.
- Exhibit D is described as “pictures of the Goods as they appeared in the relevant three year period” by Mr. Boulianne. Mr. Boulianne did not correlate the products depicted in this exhibit, however, these products appear to be the same as the products in the price list. I note that the Mark appears directly on the goods or on their packaging. GYB’s business name also appears on some of the packaging.

ANALYSIS AND REASONS FOR DECISION

[14] In its representations, the Requesting Party first notes that there is no evidence regarding “personal inhalers” and “inhalers for therapeutic use”, with not even a bare assertion of use

regarding such goods by Mr. Boulianne in his affidavit. Indeed, as there is no evidence of use of the Mark in association with these goods, and no evidence of special circumstances excusing non-use of the Mark before me, the registration will be amended accordingly.

[15] As for the remaining goods, noting that GYB sells products under other trademarks, the Requesting Party submits that the Exhibit C invoices are ambiguous as to which products were sold to the retailers. Moreover, the Requesting Party submits that Mr. Boulianne does not correlate the products listed on the invoices and the products shown in the photographs with the registered goods. As such, it argues that the Registrar cannot confirm which of the registered goods, if any, are depicted in the evidence. In response, the Owner submits that the evidence is not exhaustive and is sufficient to demonstrate use of the Mark.

[16] It is not for the Registrar to speculate as to the nature of the registered goods [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13; *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 (TMOB) at para 12]. However, reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)]. Even though Mr. Boulianne did not clearly correlate the products listed in the invoices with any of the registered goods, I am prepared to accept that some of the registered goods are listed in the invoices.

[17] As noted by the Requesting Party, the evidence does show that GYB sold products associated with other trademarks, such as Spike, Duracell and Colgate, and that such products are also listed in the exhibited price list. However, as stated above, each product on the price list is named and accompanied by a photograph of that product. The products sold under other trademarks are not in the same categories of products as the registered goods. For example, products sold under the Spike trademark are e-lighters, charging cables, and USB wall plugs, and products sold under the Duracell trademark are batteries. Moreover, Mr. Boulianne clearly states in his affidavit that the Exhibit C invoices concern “Goods bearing the Mark”, and this is consistent with the information contained in the Exhibit C price list. For example, the first product depicted in the price list is “eMaxx Personal Vaporizer Blister Pack”, and on the invoices, a product sold is listed as “Vaporisateur – Trousse blister”. I accept that these are the same products and correlate with the registered goods “personal vaporizers”. Similarly, I

consider that the different flavours of “eLiquides” listed in the invoices correlate with the registered goods “liquid for all the aforementioned goods”.

[18] Therefore, I accept that the Exhibit C invoices demonstrate that some of the registered goods, namely “personal vaporizers” and “liquid for all the aforementioned goods” were transferred in Canada during the relevant period in association with the Mark.

[19] Nevertheless, the Requesting Party further argues that GYB is not a mere distributor of the registered goods but, rather, “the evidence shows that a consumer would conclude that GYB is the source of the goods”. In this respect, the Requesting Party submits that, in order for any use of the Mark by GYB to enure to the benefit of the Owner, the evidence must demonstrate the Owner’s requisite control of the character or quality of the goods pursuant to section 50(1) of the Act either by attesting to the fact that it exerts the requisite control or by providing evidence that demonstrates that it exerts the requisite control. Moreover, the Requesting Party argues that “the chain between the products and the manufacturer has been broken by the markings on the products and in the advertisements which convey to the consumer that GYB is the owner of [the Mark]”, relying on *Mayborn Products Ltd v Canada (Registrar of Trade Marks)* (1984), 70 CPR (2d) 1 (*Mayborn*). In response, the Owner submits that GYB purchased the goods directly from the Owner, and that at all time, GYB was an authorized distributor, and that information appeared on the invoices.

[20] I do not agree with the Requesting Party’s submission. In *Mayborn*, the Court expunged the trademark due to the complete absence of a reference to the registered owner or any indication that the goods were sold by a distributor. In the present case, Mr. Boulianne clearly states that GYB is the distributor of the registered goods and that it purchased these goods directly from the Owner and then sells them to retailers. Although GYB’s name appears on the goods, it is preceded by “imported and distributed by”. Moreover, I note that the exhibited invoices indicate that GYB is an authorized distributor of eMaxx products. Accordingly, as I am satisfied that the evidence shows that GYB was merely a distributor of the Owner’s goods rather than a licensee, the provisions of section 50 of the Act are not applicable in this case.

[21] In view of the foregoing, I am satisfied that the Owner has shown use of the Mark in association with “smoker's accessories, namely personal ... vaporizers” and “liquid for all the aforementioned goods” within the meaning of sections 4 and 45 of the Act.

[22] With respect to the remaining goods, “electronic cigarettes, parts [and] fittings” although Mr. Boulianne includes these goods in his assertion of use, there is no evidence of transfers of such goods in Canada during the relevant period or otherwise. At the hearing, the Owner submitted that the evidence is not exhaustive. However, to maintain these goods in the registration, some evidence of transfer in the normal course of trade in Canada is necessary. As such, I am not satisfied that the Owner has shown use of the Mark in association with such goods. As there is no evidence of special circumstances in this case, these goods will be deleted from the registration.

DISPOSITION

[23] 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 the following from the statement of goods: “...inhalers and ... electronic cigarettes, parts, fittings ...; inhalers for therapeutic use”.

[24] The statement of goods will now read as follows:

Smoker's accessories, namely personal vaporizers, and liquid for all the aforementioned goods.

Ann-Laure Brouillette
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: October 4, 2021

APPEARANCES

Caroline Guy	For the Registered Owner
Jamie-Lynn Kraft	For the Requesting Party

AGENTS OF RECORD

Therrien Couture Joli-Coeur S.E.N.C.R.L.	For the Registered Owner
Smart & Biggar IP Agency Co.	For the Requesting Party