



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 286**

**Date of Decision: 2021-12-20**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Gowling WLG (Canada) LLP**

**Requesting Party**

**and**

**Northern Tool & Equipment  
Company, Inc.**

**Registered Owner**

**TMA824,283 for ROUGHNECK**

**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. TMA824,283 for the trademark ROUGHNECK (the Mark), currently owned by Northern Tool & Equipment Company, 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 goods:

- (1) Fuel transfer pumps; fuel meters; battery-powered and air-powered grease guns; power-operated fuel hose reels; power-operated grease and fuel pumps; dispensers, valves and nozzles for grease, oil and fuels; cement equipment and accessories, namely, cement vibrators.
- (2) Hand-operated grease, oil and fuel pumps; hand-operated grease guns; hand-operated grease and fuel hose reels; oil drains; trowels; cement equipment and accessories, namely, cement mixers, cement vibrators and plate compactors; fuel carts (the Goods).

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

#### THE PROCEEDINGS

[5] At the request of Gowling WLG (Canada) LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on January 11, 2019, to Northern Tool & Equipment Company, 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 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 January 11, 2016 to January 11, 2019 (the Relevant Period).

[7] 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.

[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, the registration of 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 an affidavit of Al Kotula, sworn on June 26, 2019 to which were attached Exhibits A to E.

[11] Both parties submitted written representations. Only the Owner attended an oral hearing.

#### THE EVIDENCE

[12] Mr. Kotula is the Senior Vice President for the Owner which he identifies as a manufacturer and retailer of industrial equipment, hand tools, and do-it-yourself equipment and supplies.

[13] Mr. Kotula declares that the Owner sells its products directly to Canadian consumers, through an online retail store located on its website, then the products sold are shipped to the consumers in Canada. He adds that the Owner continues to make sales of the Goods bearing the Mark in this fashion in the Canadian marketplace.

[14] Mr. Kotula attests that the Mark was displayed on the products sold in Canada or on the shipping documents that are affixed to packaging in which the products are distributed in Canada. He further states that the wholesale sales revenue of goods bearing the Mark in Canada during the Relevant Period was \$203,441, representing the sales of approximately 1255 units.

[15] In support, the following relevant exhibits are attached to Mr. Kotula's affidavit:

- Exhibit B consists of printouts from the Owner's website that depict the products available for sale online in Canada. According to Mr. Kotula's statements, these printouts are representative of the Owner's active website content during the Relevant Period.
- Exhibit C consists of a sales report. Mr. Kotula attests that said sales report represents "ROUGHNECK goods in Canada during the Relevant Period" and that the items highlighted in yellow therein relate to the goods which are contained in registration No. TMA824,283. I note that the billing or shipping addresses are located in Canada.

- Exhibit E consists of “numerous photographs and printouts of the Registered Goods displaying the trademark ROUGHNECK”. Mr. Kotula confirms that the description of the goods in the photographs and printouts correlates with the description of the goods listed in the sales report attached as Exhibit C.

#### ANALYSIS AND REASONS FOR DECISION

[16] The Requesting Party submits that the Owner’s evidence does not show use of the Mark in association with the Goods during the Relevant Period. Its main submissions can be summarized as follows:

- the sales report attached as Exhibit C is of limited evidentiary value as there is no invoices or other documentary evidence to support the sales alleged therein;
- there is ambiguity as to how the highlighted items in Exhibit C sales report and the goods shown in Exhibit B and Exhibit E printouts correspond to the Goods.

#### **Invoices or other documentary evidence**

[17] Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], some evidence of transfer in the normal course of trade in Canada is necessary [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Such evidence can be in the form of documentation like invoices, sales reports, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[18] Given clear statements made by Mr. Kotula that sales were made of the highlighted items contained in registration No. TMA824,283 in association with the Mark in Canada during the Relevant Period and the presence of a sales report, I conclude that there is evidence of transfer of goods during the Relevant Period in the present case.

#### **Correlation With the Registered Goods**

[19] At outset, I note that certain items of Exhibit C including *lift tables portable, scales and platform carts, trucks* are not contained in registration No. TMA824,283 but are somehow highlighted in yellow; such contradictions or ambiguities with regard to Mr. Kotula’s statements in paragraph 11 of his affidavit could support the issue of absence of correlation of goods

between those listed in the registration and those highlighted in Exhibit C as argued by the Requesting Party.

[20] At its benefit, the Requesting Party submits that ambiguities or inconsistencies in goods corroboration in the present case makes it impossible to determine which of the highlighted items in Exhibit C sales report and the goods shown in Exhibit B and Exhibit E printouts correspond to the registered goods.

[21] While 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 at para 12 (TMOB)], reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005), 48 CPR (4th) 223 (FCA)]. In making such correlations, I am mindful of the principle that when interpreting a statement of goods in a section 45 proceeding, 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].

[22] While Mr. Kotula’s characterization of the highlighted items in Exhibit C sales report would have been helpful, sufficient information can be gleaned from the item numbers appearing in Exhibit C sales report and in Exhibit B and Exhibit E printouts to correlate certain items with specific registered goods. Furthermore, I accept that page 1 of Exhibit C alone is not representative of the entire scope of sales of the registered goods for the Relevant Period as pointed out by the Owner in paragraph 10 of its written representations and at the hearing. It is in this context that additional information can also be found on other pages of Exhibit C.

[23] Therefore, I am prepared to accept that the following registered goods are represented in Exhibit C sales report, Exhibit B and / or Exhibit E printouts and in the following manner:

- fuel transfer pumps – item No. 24925 (at page 1 of Exhibit C and page 16 of Exhibit B);
- fuel meters – item No. 24924 (at page 5 of Exhibit C, page 27 of Exhibit B and page 17 of Exhibit E);
- power-operated fuel hose reels – item No. 28533 (at page 1 of Exhibit C, page 20 of Exhibit B and page 10 of Exhibit E);

- power-operated grease and fuel pumps – item No. 25329 (at page 1 of Exhibit C and page 34 of Exhibit B);
- dispensers for grease, oil and fuels – item No. 42611 (at page 1 of Exhibit C and page 17 of Exhibit B);
- valves for grease, oil and fuels – item No. 28481 (at page 1 of Exhibit C and page 16 of Exhibit B);
- nozzles for grease, oil and fuels – item No. 37657 (at page 3 of Exhibit C and page 25 of Exhibit B);
- hand-operated grease, oil and fuel pumps – item No. 41360 (at page 1 of Exhibit C and page 26 of Exhibit B);
- hand-operated grease and fuel hose reels – item No. 28811 (at page 1 of Exhibit C and page 10 of Exhibit E);
- oil drains – item No. 42735 (at page 1 of Exhibit C, page 16 of Exhibit B and page 30 of Exhibit E) and
- fuel carts – item Nos. 20632 (at page 1 of Exhibit C, page 17 of Exhibit B and page 3 of Exhibit E).

[24] With respect to ‘fuel carts’, I am prepared to accept the reference to ‘fuel caddy’ on page 1 of Exhibit C to be equivalent to ‘fuel carts’ as argued by the Owner at the hearing.

[25] Since most of the photographs of the goods illustrated in Exhibits B and E demonstrate how the Mark was displayed during the Relevant Period directly on the goods and the sales report provides evidence of sales in the normal course of trade during that period and also refer to the Mark, I am satisfied that the Owner has shown use of the Mark in association with the above-referenced registered goods pursuant to section 4(1) of the Act.

[26] As for *battery-powered and air-powered grease guns, hand-operated grease guns*, the Owner submitted at the hearing that the sworn affidavit shall be enough to show use in relation to those goods. However, there is no specific allegation with respect to this category of goods nor documentary evidence establishing use of any of these goods.

[27] As for *cement equipment and accessories, namely, cement vibrators, trowels and cement equipment and accessories, namely, cement mixers, cement vibrators and plate compactors*, the

Owner submitted at the hearing that the evidence is silent regarding those goods. Indeed, I must conclude that use of the Mark during the Relevant Period has not been shown for both of these categories of goods. There is also no evidence before me of special circumstances excusing non-use of the Mark. Accordingly, all these goods will be deleted from the registration.

#### DISPOSITION

[28] 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 registered goods shown struck out below:

- (1) Fuel transfer pumps; fuel meters; ~~battery powered and air powered grease guns;~~ power-operated fuel hose reels; power-operated grease and fuel pumps; dispensers, valves and nozzles for grease, oil and fuels; ~~cement equipment and accessories, namely, cement vibrators.~~
- (2) Hand-operated grease, oil and fuel pumps; ~~hand-operated grease guns;~~ hand-operated grease and fuel hose reels; oil drains; ~~trowels; cement equipment and accessories, namely, cement mixers, cement vibrators and plate compactors;~~ fuel carts.

in compliance with the provisions of section 45 of the Act.

[29] Consequently, the amended registration shall now read as follows:

- (1) Fuel transfer pumps; fuel meters; power-operated fuel hose reels; power-operated grease and fuel pumps; dispensers, valves and nozzles for grease, oil and fuels.
- (2) Hand-operated grease, oil and fuel pumps; hand-operated grease and fuel hose reels; oil drains; fuel carts.

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Jean Carrière  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2021-12-02

**APPEARANCES**

Mihaela Dumitrean

For the Registered Owner

No one appearing

For the Requesting Party

**AGENTS OF RECORD**

MLT Aikins LLP

For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party