



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 007

Date of Decision: 2022-01-25

IN THE MATTER OF THREE SECTION 45 PROCEEDINGS

Chris Hale IP Law

Requesting Party

and

Canadian Tire Corporation, Limited

Registered Owner

**TMA571,145 for TITAN,
TMA610,544 for TITAN DESIGN, and
TMA610,576 for TITAN DESIGN (COLOUR)**

Registrations

INTRODUCTION

[1] This is a decision involving summary expungement proceedings regarding the following registrations: No. TMA571,145 for the word mark TITAN; No. TMA610,544 for the mark TITAN DESIGN (reproduced below); and No. TMA610,576 for the mark TITAN DESIGN (COLOUR), consisting of the below design mark with a colour claim, namely “[t]he left side of the circle is black; the right side of the circle and background to the letters ITAN is green”.



[2] The three subject trademarks, to which I will sometimes refer to as “the TITAN Marks”, are all registered for use in association with “[a]utomotive parts, namely brass fittings and fuel line hoses”.

[3] For the reasons that follow, I conclude that the registrations ought to be expunged.

THE PROCEEDINGS

[4] On October 9, 2018, at the request of Chris Hale IP Law (the Requesting Party), the Registrar of Trademarks issued three notices pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Canadian Tire Corporation, Limited (the Owner). The notices required the Owner to show whether each of the subject trademarks was used in Canada in association with the goods specified in the registrations at any time within the three-year period immediately preceding the date of the notices and, if not, the date when the trademarks were 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 between October 9, 2015 and October 9, 2018.

[5] The relevant definition of “use” in the present case is set out in section 4 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.

[6] 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. That being said, bare statements that a trademark is in use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)] and sufficient facts must be provided to allow the Registrar to conclude that a mark was used in association with the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] When considering the purpose of section 45 proceedings, the description of goods is to be given a broad interpretation and “one is not to be astutely meticulous” when dealing with language used in a statement of goods [*Molson Canada v Kaiserdom-Privatbrauerei Bamberg Wörner KG* (2005), 43 CPR (4th) 313 (TMOB); *Gowling Lafleur Henderson LLP v Liwayway Marketing Corp*, 2015 TMOB 194 at para 19; *Levi Strauss & Co v Canada (Registrar of Trade-marks)*, 2006 FC 654 at para 17].

[8] In response to each of the Registrar’s notices, the Owner submitted the affidavit of Filippo Paolo Miliucci, Associate Vice President, Auto Parts Division of the Owner, sworn on May 9, 2019 (the Miliucci Affidavit).

[9] Both parties submitted written representations. Only the Owner was represented at an oral hearing.

SUMMARY OF THE MILIUCCI AFFIDAVIT

[10] The Owner is a Canadian retailer, selling thousands of different products including automotive products, hardware products and sporting goods. The Owner sells products to Canadian Tire Associate Stores (Associate Stores) which in turn sell those products to Canadian consumers.

[11] According to Mr. Miliucci, each of the TITAN Marks “have been used by [the Owner] in association with fuel line hoses for automotive and other automotive parts during the Relevant Period” and there “have been significant sales of automotive products bearing the TITAN Marks, including fuel line hoses, during the Relevant Period”.

[12] The Miliucci Affidavit provides a table of estimated annual sales figures for the years 2016, 2017, 2018 and 2019. These figures represent sales of “particular automotive products” by Associate Stores to the public, and are broken down by product type, namely products identified as HOSE, VINYL as well as products identified as WINDSHIELD WASHER TUBING, both available in various dimensions. The affidavit also provides a similar table containing sales figures of products identified as FUEL LINE REPAIR UNIT.

[13] The average annual sales figures for the years 2016, 2017 and 2018 are almost 150,000 units of HOSE, VINYL, but only about 100 units of FUEL LINE REPAIR UNIT.

[14] Each of the products featured in the aforementioned tables are depicted in photographs provided as Exhibits A to J. According to Mr. Miliucci, the product packaging depicted in those photographs is “identical or highly similar to” packaging in which those products were sold during the relevant period. Mr. Miliucci also states that the clear vinyl tubing products shown in the Exhibit E to I photographs are “used for a variety of automotive applications for fluid transfer or as protective tubing” and the product shown in the Exhibit J photograph is a “fuel line repair hose for use in automobiles”. I note that Mr. Miliucci does not identify any of the evidenced products as “fuel line hoses” *per se* nor does he specifically indicate that such products could be used to transfer fuel.

[15] Based on my review of the exhibited photographs, I note that the labels describe the photographed products, in English and in French, as “windshield washer tubing”/“*boyau pour lave-glace*”, “clear vinyl tubing”/“*boyau en vinyle transparent*”, and “fuel line repair”/“*nécessaire de réparation de tuyau a carburant [sic]*”. The TITAN DESIGN (COLOUR) trademark reproduced above is displayed on each of the labels.

[16] Finally, Mr. Miliucci provides, as Exhibit M to his affidavit, a spreadsheet listing sales of the aforementioned windshield washer tubing, vinyl hose and fuel line repair products. These sales represent those from Canadian Tire to Associate Stores during the relevant period.

SUBMISSIONS OF THE PARTIES AND ANALYSIS

[17] At the hearing, the Owner conceded that there is no evidence relating to “brass fittings” and confirmed that the Owner is not asserting use of the subject trademarks in association with those goods. As the Owner has not demonstrated use of the subject trademarks in association with “brass fittings” within the meaning of sections 4 and 45 of the Act and as there is no evidence before me of special circumstances excusing non-use of the trademarks, those goods will be deleted from the registrations.

[18] As for the remaining goods, the Requesting Party essentially argues that the evidence is inconsistent with Mr. Miliucci's assertions of use in association with fuel line hoses. To begin, the Requesting Party argues that the evidenced windshield washer tubing and vinyl hose products are not fuel line hoses, and that there is no evidence establishing that they could be used as such. The Requesting Party also submits that because Mr. Miliucci did not state that the products could be used as fuel line hoses, the Board should infer that they cannot.

[19] In addition, the Requesting Party questions Mr. Miliucci's characterization of the fuel line repair product as a "fuel line repair hose". Based on a close inspection of the Exhibit J photograph of that product, it submits that the package contains "something which appears to be a short piece of silver-coloured metal, with a 90 degree bend" which could "conceivably be a tube", but does not contain a hose of any kind. In the alternative, the Requesting Party argues that even if the Board concludes that the product corresponds to a fuel line hose, transfers of this product were not in the normal course of trade within the meaning of section 4 of the Act, given the relatively low sales figures as well as the condition of the photographed product packaging (which the Requesting Party submits is wrinkled, dirty and faded).

[20] In response, the Owner submits that Mr. Miliucci has provided clear assertions of use in association with fuel line hoses, as well as evidence in support of those assertions. The Owner specifically relies on the sales of two evidenced products, namely vinyl hoses and fuel line repair products.

[21] With respect to the correlation between the products sold and the registered goods, the Owner points to: (i) Mr. Miliucci's statement that the evidenced vinyl hoses are "used for a variety of automotive applications for fluid transfer" as well as product labels indicating that they can be used as "siphon" hoses, and (ii) Mr. Miliucci's characterization of the fuel line repair product as a "fuel line repair hose". At the hearing, the Owner also submitted that an inquiry as to whether "fuel line repair hoses" are "fuel line hoses" involves an astutely meticulous analysis of the goods, an approach that has been held to be inconsistent with the purpose of section 45 of the Act.

[22] For the reasons that follow, I find that the Owner has not provided sufficiently clear evidence for me to conclude that the TITAN Marks have been used in association with fuel line hoses.

[23] As previously noted, the Owner does not provide any statements that the evidenced products are fuel line hoses, or that they could be used as such. On this point, it is unclear why Mr. Miliucci would describe the evidenced vinyl hoses generically as having a “variety of automotive applications for fluid transfer” if these products are in fact the registered goods. Moreover, even if I were to consider the applications described on the product packaging, there is no evidence which allows me to conclude that a siphon hose is a fuel line hose.

[24] As such, while I am not prepared to infer that the evidenced hoses *cannot* be used as fuel line hoses, there is no evidence establishing that they can. I am therefore unable to correlate the evidenced vinyl hoses without improperly speculating as to their nature.

[25] The remaining product in evidence is identified as a FUEL LINE REPAIR UNIT in the affidavit and characterized as a “fuel line repair hose” by Mr. Miliucci. However, this product appears to be some kind of fuel line repair kit, rather than a type of replacement hose for a fuel line. Such a finding is consistent with the description on the product packaging, specifically “*nécessaire de réparation de tuyau a carburant*”, as I note that the French word “*nécessaire*” can translate to “outfit”, “set” or “kit” in English (and so, the aforementioned product description would in my view more accurately be referred to as a “fuel line repair kit”). Such a finding is also consistent with the Owner’s explanation that the photograph of this product shows a “short metal tube that has a 90 degree bend and is for repairing a fuel line hose in such a manner that it becomes part of the fuel line hose”.

[26] I also note that the Owner’s explanation regarding the purpose and fate of the fuel line repair product is not in evidence. Nevertheless, even if I accept that this product becomes “part of the fuel line hose”, I am not convinced that use of a trademark in association with a product that ultimately becomes part of registered goods necessarily establishes use of that trademark in association with the registered goods. For instance, in a recent case before the Board, the

Registrar refused to consider pizza dough as corresponding to the registered goods “pizza” [Gowling WLG (Canada) LLP v MiMi Food Products Inc, 2019 TMOB 4], despite the fact that pizza dough ultimately becomes part of a pizza once it is prepared.

[27] In my view, this reasoning is particularly relevant in a case such as this one, where the registered goods are not sold together with the product in question [see, in contrast, *Kirby Eades Gale Baker v Endress+Hauser Group Services AG*, 2021 TMOB 284 where the Registrar accepted that a consumer would associate the subject trademark not only with an optional monitoring package, but also to the entire flowmeter apparatus that included the package and with which the package was sold].

[28] Having regard to the foregoing, I am not satisfied that the Owner has demonstrated use of the subject trademarks in association with fuel line hoses within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances, these goods will also be deleted.

[29] Consequently, there is no need to address the question of the Owner’s sales in the normal course of trade.

DISPOSITION

[30] 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, all three registrations will be expunged.

Eve Heafey
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: December 15, 2021

APPEARANCES

Alison Hayman For the Registered Owner

No one appearing For the Requesting Party

AGENTS OF RECORD

Cassels Brock & Blackwell LLP For the Registered Owner

Christopher C. Hale (Chris Hale IP Law) For the Requesting Party