



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 158**

**Date of Decision: 2022-08-17**

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

**Bereskin & Parr LLP**

**Requesting Party**

**and**

**Old Dominion Freight Line, Inc.**

**Registered Owner**

**TMA620,440 for DELIVERING NEW  
SOLUTIONS**

**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. TMA620,440 for the trademark DELIVERING NEW SOLUTIONS (the Mark).

[2] The Mark is registered for use in association with the following services: Transportation services, namely transportation of freight for others by truck.

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

#### THE PROCEEDING

[4] On April 20, 2021, at the request of Bereskin & Parr LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to Old Dominion Freight Line, Inc. Inc. (the Owner). The notice required the Owner to show whether the Mark was used in Canada in association with 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 the Mark 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 between April 20, 2018 and April 20, 2021 (the Relevant Period).

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

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] In response to the Registrar's notice, the Owner submitted the affidavit of Mr. Richard Podiak, VP Marketing and Communication for the Owner, sworn on July 16, 2021.

[7] No party submitted written representations and no oral hearing was held.

#### THE OWNER'S EVIDENCE

[8] Mr. Podiak explains that the Owner is based in the USA and provides transportation services primarily across the border between Canada and the USA with typical customers being importing and exporting businesses [para 2].

[9] Mr. Podiak states that the services sold by the Owner for shipment to and from Canada exceeded USD \$55,000,000 per year in 2018, 2019 and 2020 [para 3]. He also explains that the Mark is displayed on truck trailers [para 4].

[10] In support, Mr. Podiak attaches the following relevant exhibits to his affidavit:

- Exhibit “A”: Seven invoices from the Owner from the Relevant Period billed to Canadian customers. Mr. Podiak explains that these are examples of invoices issued by the Owner to customers in Canada for the services provided in association with the Mark [para 3].
- Exhibit “B”: Nine photographs of truck trailers displaying the Mark alongside the name the Owner. Mr. Podiak explains that these are photographs of how the Mark is displayed on trucks delivering freight to and from Canada during the Relevant Period [para 4].

#### ANALYSIS AND REASONS FOR DECISION

[11] Although the threshold for establishing use in in the context of section 45 proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Canada (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 services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. In this case, the evidence establishes that the Mark has been used by the Owner during the Relevant Period with all services.

[12] Given that the Owner has shown sales of its services in Canada during the Relevant Period and that the Mark was displayed on its fleet of freight truck trailers when performing the services listed in the registration, I am satisfied that the Owner has shown use of the Mark in Canada within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[13] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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Martin Béliveau  
Chairperson  
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** No Hearing Held

**AGENTS OF RECORD**

Ridout & Maybee LLP

For the Registered Owner

Bereskin & Parr LLP

For the Requesting Party