



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 184

Date of Decision: 2022-09-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar LLP

Requesting Party

And

Dorfin Inc.

Registered Owner

TMA740,363 for SOHO

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. TMA740,363 for the trademark SOHO (the Mark).

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

(1) Office stationary namely, clipboards, kraft paper rolls, labels, binders, clips, magnifying glasses, scissors, rulers, eraser boards, markers, glue sticks, correction fluids, correction pen, hole punches, staple removers, staplers, erasers, sharpeners, sticky notes, index cards, pencils, mechanical pencils, mechanical pencil leads, highlighters, sticky tack, push pins, paper clips, tape, rubber bands, sheet protectors, receipt books and sales books; school supplies, namely, math sets, school glue, pencil cases, magnetic locker

mirrors, crayons, clipboards, kraft paper rolls, labels, binders, clips, magnifying glasses, scissors, rulers, eraser boards, markers, glue sticks, correction fluids, correction pen, hole punches, staple removers, staplers, erasers, sharpeners, sticky notes, index cards, pencils, mechanical pencils, mechanical pencil leads, highlighters, sticky tack, push pins, paper clips, tape, rubber bands, sheet protectors.

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

THE PROCEEDING

[4] On July 8, 2021, at the request of Smart & Biggar LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to Dorfin Inc. (the Owner). The notice required the Owner to show whether the Mark was used in Canada in association with 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 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 July 8, 2018 and July 8, 2021 (the Relevant Period).

[5] 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.

[6] In response to the Registrar's notice, the Owner submitted the affidavit of Mr. Stanley Aranoff, President and Chief Executive Officer for the Owner, sworn on December 14, 2021.

[7] Neither party submitted written representations and no hearing was held.

THE OWNER'S EVIDENCE

[8] Mr. Aranoff explains that the Owner is a Canadian supplier of retail and industrial packaging and food service products, with a retail product line of everyday household products, including stationeries and school supplies [para 3].

[9] At paragraph 7 of his affidavit, Mr. Aranoff states as follows:

“[The Owner] will not be providing evidence of use of the SOHO Mark in connection with the following goods listed in the SOHO Registration: Office stationary namely, clipboards, kraft paper rolls, labels, binders, clips, magnifying glasses, scissors, rulers, eraser boards, markers, glue sticks, correction fluids, correction pen, hole punches, staple removers, staplers, erasers, sharpeners, sticky notes, index cards, pencils, mechanical pencils, mechanical pencil leads, highlighters, sticky tack, push pins, paper clips, rubber bands, sheet protectors; school supplies, namely, math sets, school glue, pencil cases, magnetic locker mirrors, crayons, clipboards, kraft paper rolls, labels, binders, clips, magnifying glasses, scissors, rulers, eraser boards, markers, glue sticks, correction fluids, correction pen, hole punches, staple removers, staplers, erasers, sharpeners, sticky notes, index cards, pencils, mechanical pencils, mechanical pencil leads, highlighters, sticky tack, push pins, paper clips, rubber bands, sheet protectors.”

[10] He adds that the Owner “has used and continues to use the SOHO Mark in Canada in the normal course of trade in association with the following goods: “Office stationary namely, tape, receipt books and sales books; school supplies, namely, tape” [para 8].

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

- Exhibit B: photographs of three products described as “Transparent Tape”, “Receipts 50”, and “Sales Book” all bearing the Mark. Mr. Aranoff states that these photographs are representative of how the Mark was used in Canada with these goods during the Relevant Period [para 10].
- Exhibit D: Copies of three invoices from the Relevant Period from the Owner to Canadian customers displaying the Mark in association the following products: “carnet de vent.”, “Book Sales”, “Book Receipt” and “Ruban Transprt.” Mr. Aranoff explains that these are representative of following goods in the registration: sales books, receipt books and tape [para 14].

ANALYSIS AND REASONS FOR DECISION

[12] At the outset, in paragraph 7 of his affidavit, Mr. Aranoff specifically says that the Owner will not be providing evidence for any goods in the registration other than “Office stationary namely, tape, receipt books and sales books; school supplies, namely, tape”; accordingly, the remaining goods will be deleted from the registration.

[13] 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)], but 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 specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) (*John Labatt*)]. In this case, the photographs in Exhibit B and the invoices evidenced in Exhibit D establish that the Mark has been used in Canada by the Owner during the Relevant Period with sales books, receipt books and tape.

[14] While evidentiary overkill is not required in a section 45 proceeding, it is nonetheless well-established that use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration. Having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [*John Labatt*]. In this case, the registration lists “Office stationary namely, [...] tape” and “school supplies, namely [...] tape”, but the evidence has shown sales of only one tape product in association with the Mark. As there are no written arguments from neither parties or any evidence in the affidavit that clearly indicates whether the tape can more readily be categorized as “office stationary” or “school supplies”, I find it more likely than not that the tape falls in the same category as the sales books and receipt books, namely “office stationary”. For these reasons, I am not satisfied that the Owner has shown use of the Mark within the meaning of sections 4 and 45 of the Act for “school supplies, namely, tape.” Accordingly, this good will be deleted from the registration.

DISPOSITION

[15] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following goods in compliance with the provisions of section 45 of the Act:

(1) clipboards, kraft paper rolls, labels, binders, clips, magnifying glasses, scissors, rulers, eraser boards, markers, glue sticks, correction fluids, correction pen, hole punches, staple removers, staplers, erasers, sharpeners, sticky notes, index cards, pencils, mechanical pencils, mechanical pencil leads, highlighters, sticky tack, push pins, paper clips, tape, rubber bands, sheet protectors, receipt books and sales books; school supplies, namely, math sets, school glue, pencil cases, magnetic locker mirrors, crayons, clipboards, kraft paper rolls, labels, binders, clips, magnifying glasses, scissors, rulers, eraser boards, markers, glue sticks, correction fluids, correction pen, hole punches, staple removers, staplers, erasers, sharpeners, sticky notes, index cards, pencils, mechanical pencils, mechanical pencil leads, highlighters, sticky tack, push pins, paper clips, tape, rubber bands, sheet protectors.

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

(1) Office stationary namely, tape, receipt books and sales books

Martin Béliveau
Chairperson
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Borden Ladner Gervais LLP

For the Registered Owner

Smart & Biggar LLP

For the Requesting Party