



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 009

**Date of Decision:** 2023-01-25

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

**Requesting Party:** The Ideas Law Firm, PLLC

**Registered Owner:** Paul Taschereau

**Registration:** TMA539,289 for STONECRAFT

### **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. TMA539,289, for the trademark STONECRAFT (the Mark).

[2] The Mark is registered for use in association with flooring/wall resurfacing products namely polymer modified cementitious grout used as a resurfacing product for floors and walls (the Goods).

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

## **THE PROCEEDING**

[4] On July 12, 2021, at the request of The Ideas Law Firm, PLLC, the Registrar of Trademarks issued a notice under section 45 of the Act to Paul Taschereau (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with the Goods 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 use since that date. In this case, the relevant period for showing the Mark was used is between July 12, 2018 and July 12, 2021 (the Relevant Period).

[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] In response to the Registrar’s notice, the Owner submitted the statutory declaration of Paul Taschereau, declared in Langley, British Columbia, dated February 7, 2022.

[8] Neither party submitted written representations. No hearing was held.

## **THE OWNER’S EVIDENCE**

[9] The Owner, Paul Taschereau, is also the owner and President of Aggressive Distributing Inc [paras 2 and 3]. He states:

“...[I] have used this trade mark since April 2, 1997 and I currently use the trade mark “STONECRAFT” in the sale of goods and services through my company AGGRESSIVE DISTRIBUTING INC...” [para 2].

[10] Mr. Taschereau provides the following relevant exhibits:

- Exhibit A1: undated photographs of bags of “Dry Mixture” with labels bearing the Mark. Mr. Taschereau states that these photographs “shows use of the Mark on goods/services in Class 19” [para 4].
- Exhibits B1 and B2: invoices from Aggressive Distributing Inc to consumers in Canada, dated outside the Relevant Period, specifically July 15 and November 18, 2021, showing sales of various “Stonecraft” products. Mr. Taschereau states the these “are sales invoices of the goods/services in Class 19 on which the mark is used” [para 5].

### **ANALYSIS AND REASONS FOR DECISION**

[11] 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, during the Relevant Period, within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. There is no particular type of evidence that must be provided in a section 45 proceeding and the evidence need not be perfect [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)].

#### ***Use under license***

[12] Section 50(1) of the Act requires the owner of a trademark to control, either directly or indirectly, the character or quality of the goods or services sold under that trademark. Furthermore, it is established that licensing agreements need not be in writing [*Well’s Dairy Inc v U L Canada Inc (2000)*, 2000 CanLII 15538 (FC), 7 CPR (4th) 77 (FCTD)].

[13] In this case, there is no mention of any licensing agreement in the evidence but the Owner of the Mark and the owner and President of Aggressive Distributing Inc. is the same person. Therefore, an inference may be drawn that a verbal license agreement exists [see *Well’s Dairy Inc*] and that the Owner exercises the requisite control [see *Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FCTD); *Lindy v Canada (Registrar of Trademarks)*, [1999] FCJ No 682 (FCA)].

[14] For these reasons, I find that any use of the Mark by Aggressive Distributing Inc., would properly be considered use by the Owner.

***Use of the Mark***

[15] Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [see *Lewis Thomson*], some evidence of transfer in the normal course of trade in Canada during the Relevant Period 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 or 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].

[16] In this case, the invoices provided in Exhibits B1 and B2 are dated outside the Relevant Period and there is no other evidence to support any commercial transaction in the normal course of trade during the Relevant Period, namely between July 12, 2018 and July 12, 2021. The affiant statement in paragraph 2 reproduced earlier is not sufficient for the Registrar to conclude there were any sales of the Goods during the Relevant Period; it is too broad and generic and amounts to a bare statement of use.

[17] Furthermore, while the Exhibit A1 has shown how the Mark is displayed on bags of “Dry Mixture”, there is no indication as to when the photographs were taken and if these are representative of how the Goods would have been sold to Canadian consumers during the Relevant Period.

[18] If Mr. Taschereau had provided invoices for the Goods dated between June 12, 2018 and June 12, 2021 and provided more information about the photograph in his statutory declaration, my decision might have been different.

[19] In view of the foregoing, I am not satisfied that the Owner has shown use of the Mark in Canada within the meaning of sections 4 and 45 of the Act. Further, the statutory declaration does not put forward any special circumstances to justify the absence of use.

**DISPOSITION**

[20] 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 expunged.

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Martin Béliveau  
Chairperson  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** None

**For the Registered Owner:** None