

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 102

Date of Decision: 2023-06-16

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Fasken Martineau DuMoulin, LLP

Registered Owner: P.E. Printech Equipment Inc.

Registration: TMA400,362 for PE PRINTECH EQUIPMENT INC. & Design

INTRODUCTION

[1] This is a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA400,362 for the trademark PE PRINTECH EQUIPMENT INC. & Design (the Mark), as shown below:



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

- CI 07 Envelope feeds for printing presses and conveyors for small printing presses.
- CI 09 Press packing gauges.
(the Goods)

CI 35 Operation of a business dealing in offset printing presses and bindery equipment, including cutters, folders, stitchers, paper collating equipment, paper drills.

CI 37 Paper cutter computer retrofits including the servicing thereof.

(the Services)

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

THE PROCEEDING

[4] At the request of Fasken Martineau DuMoulin, LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on October 8, 2021 to the registered owner of the Mark, P.E. Printech Equipment Inc. (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the Goods and the Services 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 October 8, 2018 to October 8, 2021 (the Relevant Period). In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[6] The relevant definitions of use are 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.

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.

4(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[7] 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)]. Although the threshold for establishing use in these 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 Mark in association with each of the Goods and the Services during the Relevant Period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

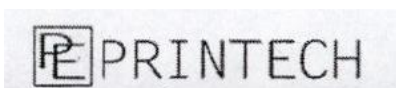
[8] In response to the Registrar's notice, the Owner furnished the Statutory Declaration of John C. Cheng, an officer and director of the Owner, together with Schedules A to G (the Declaration). While the Declaration was filed on May 24, 2022, the jurat states that it was declared on May 24, 2021 (*i.e.* prior to the date of the notice). The Requesting Party would have me treat this as a fatal flaw. I will address the Requesting Party's submissions in my reasons below.

[9] Only the Requesting Party submitted written representations. No hearing was held.

THE EVIDENCE

[10] Mr. Cheng asserts that the Mark has been used on the Goods and Services in Canada during the Relevant Period as a house mark for the Owner's subsidiary brands BRAUSSE and ETERNA. He provides the following material which he states support the sales, promotion and advertisement of the Mark:

- (a) Schedule A consists of a printout from the Whois Lookup database showing that *peprintech.com* (the Owner's website) was registered in March 2018.
- (b) Schedule B consists of printouts from the WayBack Machine showing extracts from the Owner's website on August 4, 2018, February 5, 2019 and December 2021. But for references to BRAUSSE, the content of the printouts is blacked out. Schedule B also contains printouts from the Owner's website as of the date of the Declaration showing various machine parts but without any explanation as to the nature of the parts. All of the printouts in Schedule B display a variation of the Mark, as shown below:



- (c) Schedule C consists of what Mr. Cheng describes as “representative copies of invoices from 2019 to customers for press packing gauges, envelop[e] feeds for printing press and conveyors for small printing presses”. There are three invoices, each of which displays the Mark. On each invoice, the invoice address and the “ship to” address are in the United States. The invoices are for “parts purchase” and the parts purchased are described as follows: the invoice of July 23, 2019 is for a “1 pc, Adj. Shaft” and a “1 pc, Adjusting Knob” for use with a “BRAUSSE 1050SE (Used)” and totals US \$124.71; the invoice of September 3, 2019 is for a “1 pc, Shaft” for a “PE-2100S” and totals US \$1,143.55; and, the invoice of October 7, 2019 is for “2 pcs, Brush” for a “TA 1100-II C6 A3” and totals US \$125.43.
- (d) Schedule D consists of what Mr. Cheng describes as “representative copies of invoices from 2019 to customers [for] services rendered in the servicing of equipment”. There are three invoices, each of which displays the Mark. The invoices, which are all addressed to customers in the United States, are for “service labour” and the services are described as follows: the invoice of June 27, 2019 is for “inspect and fine tune the machine” for a “BF750E” and totals US \$690; the invoice of May 10, 2019 is for “check feeding issue” and “check machine timing” for a “Max Cut” and totals US \$1,978.28; and, the invoice of September 26, 2019 is for “replace the chain guides and misc. parts” for a “Brausse 106CE Tornado” and totals US \$1,635.00. As each invoice includes travel time, it would appear that the services were rendered at the customers’ facilities in the United States.
- (e) Schedule E consists of what Mr. Cheng describes as “representative copies of invoices from 2020 to customers for press packing gauges, envelop[e] feeds for printing press and conveyors for small printing presses”. There are three invoices, each of which displays the Mark. On each invoice, the invoice address and the “ship to” address are in the United States. The invoices are for “parts purchase” and the parts purchased are described as follows: the invoice dated April 21, 2020 is for “6 pcs Side Guide Bearing” for a

“BRAUSSE 1050SE (Used)” and totals US \$288.85; the invoice dated June 5, 2020 is for “2 pcs, 16/6 Round - Bar Guide” for a “TA 1100-II C6 A3” and totals US \$402.96; and, the invoice dated October 5, 2020 is for “1 pc, AC220 To DC110 Power Adapter” for a “BRAUSSE 1050SE” and totals US \$159.10.

- (f) Schedule F consists of what Mr. Cheng describes as “representative copies of invoices from 2020 to customers [for] services rendered in the servicing of equipment”. There are three invoices, each of which displays the Mark. The services are described as follows: the invoice dated March 11, 2020 is to a customer in the United States and is for “machine services” namely “Check safety doors for the 1050SE” and “Service Brausse 1050SE diecutter” and totals US \$2,000; the invoice dated January 31, 2020 is to a customer in the United States and is for “service labour” namely “Provide training on running special boxes” and “Training on a TC2100 C6 II Gluer” and totals US \$1,200; and the invoice dated October 19, 2020 is to a Canadian customer and is for “service labour” namely “Major Repair” for a “PE1620SA Extra” and totals CDN \$8,226.26.
- (g) Schedule G is a photograph of “a representative sample of a label” which displays the Mark. Mr. Cheng states “that such labels prominently displaying [the Mark] are attached to all of the machinery sold which is affixed to either the actual machinery or packaging that the machinery and/or parts are sold”.

REASONS FOR DECISION

Technical Deficiencies

[11] As noted above, the jurat to the Declaration states that it was declared on May 24, 2021 (*i.e.* a date prior to the issuance of the notice on October 8, 2021). The Requesting Party would have me treat this as a fatal flaw and hold that the Declaration is null and irrelevant. I decline to do so.

[12] It is clear that the reference to May 24, 2021 is a typographical error given that Mr. Cheng refers to the Relevant Period in his Declaration and provides a printout from the WayBack machine dated in December 2021. It seems to me more likely than not that the Declaration was declared on May 24, 2022, the date the Declaration was filed.

[13] I should also note that none of the Schedules to the Declaration have been properly endorsed. However, each Schedule was referenced in the Declaration and described by Mr. Cheng.

[14] Especially in the context of section 45 proceedings—which are intended to be summary and expeditious—the Registrar has considered certain deficiencies in affidavits to be mere technicalities [see, *88766 Canada Inc v Tootsie Roll Industries Inc* (2006), 56 CPR (4th) 76 (TMOB) at para 10 where the Registrar determined that a discrepancy between the date on the affidavit and the date on the exhibits was due to an error and was a “mere technicality”; and *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB) at para 11 where the Registrar accepted exhibited evidence that was not properly endorsed where the exhibited evidence was clearly identified and explained in the body of the affidavit].

[15] Applying the principles outlined above to the present case, and given the technical nature of the deficiencies, I conclude that the Declaration as a whole is admissible.

Goods

[16] The Requesting Party submits that the evidenced invoices do not show use of the Mark in association with the Goods. I agree.

[17] While Mr. Cheng states that the invoices in Schedules C and E are for press packing gauges, envelope feeds for printing press and conveyors for small printing presses (*i.e.* the Goods), the invoices themselves tell a different story – they all relate to parts as described above. No effort has been made to correlate the invoiced goods to the Goods themselves and I am not prepared to speculate that there is a correlation.

[18] Although invoices are not mandatory in order to reply to a section 45 notice, some evidence of a transfer of the Goods in the normal course of trade in Canada is necessary to meet the criteria of section 4(1) of the Act. Similarly, some evidence of an export of the Goods from Canada is necessary to meet the criteria of section 4(3). Such evidence is lacking in this case given the lack of correlation between the invoiced goods and the Goods themselves.

[19] Accordingly, I am not satisfied that the Owner has established use of the Mark in association with the Goods, within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances to justify non-use, the registration will be amended accordingly.

Services

[20] I am also not satisfied that the Owner has shown use of the Mark in association with the Services in Canada during the Relevant Period.

[21] As noted at the outset, the Services are:

Operation of a business dealing in offset printing presses and bindery equipment, including cutters, folders, stitchers, paper collating equipment, paper drills.

Paper cutter computer retrofits including the servicing thereof.

[22] Unfortunately, Mr. Cheng has provided no information about the Owner or its business.

[23] The printouts in Schedule B are of no assistance in this proceeding other than to establish that the Owner had a website during the Relevant Period. The printouts from August 4, 2018 (prior to the Relevant Period), February 5, 2019 (within the Relevant Period) and December 2021 (after the Relevant Period) have been blacked out and provide me with no information about the Owner, the Goods or the Services. The printouts contemporaneous to the signing of the Declaration are obviously after the Relevant Period. In any event, they contain a listing of parts without any explanation as to the nature of the parts or how they relate to the Services.

[24] The invoices in Schedules C and E show that the Owner sold “parts” to customers in the United States but do not provide any information as to the nature of the parts or of the machines in which the parts were to be used. The same is true with the invoices in Schedules D and F. Clearly services were provided but one is left to speculate as to the nature of the services and whether they correlate to the Services themselves. I am not prepared to do so.

[25] Accordingly, I am not satisfied that the Owner has established use of the Mark in association with the Services, within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances to justify non-use, the registration will be amended accordingly.

[26] As I have concluded that the Owner has failed to establish use of the Mark in association with the Goods and the Services, within the meaning of sections 4 and 45 of the Act, I need not address the Requesting Party’s additional submissions.

Disposition

[27] 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.

Robert A. MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Fasken Martineau DuMoulin, LLP

For the Registered Owner: Accupro Trademarks Services LLP