

# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2023 TMOB 112

**Date of Decision:** 2023-07-04

## IN THE MATTER OF A SECTION 45 PROCEEDING

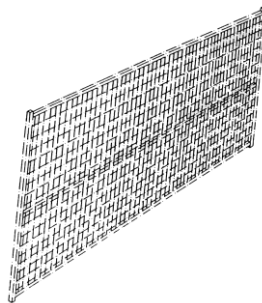
**Requesting Party:** Ted Urbanek

**Registered Owner:** Actton Super-Save Gas Stations Ltd.

**Registration:** TMA617,534 for Colour Blue as Applied to Fencing

### 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. TMA617,534 for the trademark Colour Blue as Applied to Fencing (the Mark) as shown below:



The Mark is described as “the colour blue as applied to the whole of the visible surface of the fencing shown in the drawing”.

[2] The Mark is registered for use in association with the following services (the Services): Fence rental services; assembly and disassembly of fences for others.

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

### **THE PROCEEDING**

[4] At the request of Ted Urbanek (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 30, 2021 to the registered owner of the Mark, Actton Super-Save Gas Stations Ltd. (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of 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 July 30, 2018 to July 30, 2021 (the Relevant Period).

[6] The relevant definition of use is set out in section 4(2) of the Act:

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.

[7] The purpose of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing deadwood from the register. The evidence need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[8] In response to the Registrar's notice, the Owner furnished the Affidavit of Danielle Johannes, sworn on February 23, 2022, together with Exhibits L-1 to L-2, Exhibits A-1 to A-11, Exhibits W-1 to W-5 and Exhibit I-1.

[9] Only the Owner submitted written representations and only the Owner attended a hearing.

## **THE EVIDENCE**

[10] Ms. Johannes is the Director of Sales, Government and Major Accounts for the Super Save Group of companies, a family owned and operated group of companies which includes the Owner and its licensee Super Save Fence Rentals Inc. (the Licensee).

[11] Ms. Johannes states that the Owner and the Licensee entered into a License Agreement in December 2002 (a copy of which is attached as Exhibit L-1 to her affidavit) pursuant to which the Licensee was licensed to use the Mark in British Columbia in association with the Services subject to the control of the Owner over the character and quality of the Services provided by the Licensee.

[12] Ms. Johannes states that, in March 2017, the territory of the License was extended to all of Canada and that, in April 2021, a Confirmation of License and License Agreement (a copy of which is attached as Exhibit L-2 to her affidavit) was signed confirming the license to use the Mark in Canada in association with the Services and that the use of the Mark by the Licensee was subject to the control of the Owner as to the character and quality of the Services.

[13] Ms. Johannes states that the whole of the visible surface of the fences used by the Licensee, in providing the Services, is painted blue. She goes on to state that the Licensee paints approximately 70,000 fence panels each year at a cost of over \$750,000 in paint and over \$1,000,000 in labour.

[14] Ms. Johannes states that, during the Relevant Period, the Licensee provided the Services in Canada to companies in the construction, restoration, industrial and special event industries as well as to homeowners and municipal, provincial and government sectors. She states that, in any given month during the Relevant Period, the Licensee had between 4,500 and 6,000 customers using the Services.

[15] Ms. Johannes states that the majority of the Licensee's fence rental customers also use the Licensee to assemble and disassemble the fencing, although a very small percentage of the customers assemble and disassemble the fences themselves.

[16] Ms. Johannes states that, during the Relevant Period, the Licensee spent in excess of \$300,000 on radio advertising, Google AdWords and fence signage (the fence signage is visible in the advertisements discussed below).

[17] Ms. Johannes states that the Licensee advertised the Services in association with the Mark in advertisements and promotional pieces targeted at customers and potential customers in Canada. In support, she provides the following advertisements each of which depicts fencing, the whole visible surface of which is coloured blue (*i.e.* the Mark), and promote fence rental services:

- (a) Exhibit A-1 is an advertisement placed in the Vancouver Regional Construction Association Member Directory in 2018-19 and 2019-20.
- (b) Exhibit A-2 to A-4 are advertisements placed in the Edmonton Construction Association Directory in 2018-19, 2019-20 and 2020-21 respectively.
- (c) Exhibit A-5 is an advertisement placed in the Edmonton Construction Association Magazine in May 2020.
- (d) Exhibit A-6 is a marketing brochure. Ms. Johannes states that 5,000 copies of the brochure were distributed to customers and potential customers across Canada starting in January 2020.
- (e) Exhibit A-7 is a marketing piece. Ms. Johannes states that 1,000 copies of the marketing piece were distributed across Canada starting in January 2020.
- (f) Exhibit A-8 is an advertisement placed in the Toronto Construction Association Directory in 2019-20 and 2020-21.
- (g) Exhibit A-9 is a marketing piece. Ms. Johannes states that the marketing piece was distributed in British Columbia starting in April 2021.
- (h) Exhibit A-10 is a marketing piece. Ms. Johannes states that the marketing piece was distributed across Canada starting in September 2020.

- (i) Exhibit A-11 is a marketing piece which promotes fence rental services, including setup and teardown. The piece promotes a special offer valid for fence set-up between April 1, 2020 and October 1, 2020. Ms. Johannes states that the marketing piece was distributed across Canada starting in April 2020 and that dozens of customers took advantage of the offer.

[18] Ms. Johannes states that, during the Relevant Period, the Services were advertised on the Licensee's website at *supersave.ca*. In support, she provides printouts obtained from the WayBack Machine which depict screenshots from the Licensee's website on August 11, 2018, January 19, 2019 and October 2, 2019 (Exhibits W-1 to W-3). The printouts, each of which depicts the Mark, promote the Licensee's fence rental services and state that "we have multiple options for customized set-ups and removals".

[19] Ms. Johannes also provides as Exhibits W-4 and W-5 copies of reports from Google Analytics to show that the fence rental page of the Licensee's website had in excess of 51,000 page views during the Relevant Period and that 86% of the visitors to the Licensee's website during the Relevant Period were from Canada.

[20] Finally, Ms. Johannes provides as Exhibit I-1 copies of representative, partially redacted invoices, issued by the Licensee to Canadian customers during the Relevant Period. The invoices include the reference "The Blue Fence Company", a trademark of the Owner included in the license agreements discussed above. The invoices refer to fence rental and to setup and teardown as separate line items. Ms. Johannes confirms that the invoiced services were provided using fences, the whole visible surface of which was coloured blue (*i.e.* the Mark).

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

[21] Based on my review of the evidence, I am satisfied that:

- (a) The Owner licensed the use of the Mark to the Licensee and, pursuant to the license, the Owner had the requisite control over the character and quality of the Services offered by the Licensee in Canada in association with the Mark

during the Relevant Period. Accordingly, I am satisfied that the use of the Mark by the Licensee enured to the Owner's benefit pursuant to section 50 of the Act.

- (b) The Licensee advertised the Services in Canada during the Relevant Period and the Mark was displayed in such advertisements. While not all of the advertisements refer to assembly and disassembly of fences for others, at least one advertisement refers to setup and teardown, as does the website. I am satisfied that setup and teardown services correlate to "assembly and disassembly of fences for others".
- (c) The Licensee performed the Services in Canada as evidenced by the invoices, which show charges for both fence rental services and setup and teardown services, and that the Services were provided using fences, the whole visible surface of which was coloured blue (*i.e.* the Mark).

[22] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the Services during the Relevant Period within the meaning of sections 4(2) and 45 of the Act.

**DISPOSITION**

[23] 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 maintained.

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

# Appearances and Agents of Record

**HEARING DATE:** 2023-06-22

## **APPEARANCES**

**For the Requesting Party:** No one appearing

**For the Registered Owner:** Garth Leslie

## **AGENTS OF RECORD**

**For the Requesting Party:** Ted B. Urbanek

**For the Registered Owner:** Oyen Wiggs Green & Mutala LLP