

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 205

Date of Decision: 2023-12-07

IN THE MATTER OF SECTION 45 PROCEEDINGS

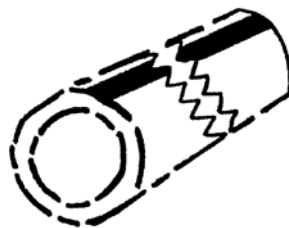
Requesting Party: The Toro Company

Registered Owner: Ipex Branding Inc.

Registration: TMA430,592 for STRIPE ON A PIPE DESIGN

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. TMA430,592 for the trademark STRIPE ON A PIPE DESIGN (the Mark), owned by Ipex Branding Inc. (the Owner), and shown below.



[2] The Mark is registered for use in association with the following goods: “Piping and tubing”.

[3] For the reasons below, I conclude that the registration should be maintained.

PROCEEDING

[4] At the request of The Toro Company (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on May 27, 2022, to the registered owner of the Mark, Ipex Branding 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 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. The relevant period for showing use is from May 27, 2019, to May 27, 2022.

[6] In response to the notice, the Owner furnished the affidavit of Trevor Johnston, its President and CEO.

[7] Only the Owner submitted written representations and attended an oral hearing.

OVERVIEW OF THE OWNER’S EVIDENCE

[8] In Mr. Johnston’s affidavit, he identifies himself as the President and CEO of the Owner from at least January 2019 to August 2022. His evidence pertaining to the Relevant Period is as follows:

- (a) The Mark appeared directly on piping and tubing as it is co-extruded at the time of manufacture or otherwise stamped or printed directly thereon [para 5];
- (b) The Owner licensed Ipex Inc., a company related to the Owner and commonly owned, to commercialize products in association with the Mark. The Owner has, at all times during the relevant period, maintained

care and control over the nature, character and quality of the products commercialized by Ipex Inc. [paras 8-9];

(c) Ipex Inc. manufactured and sold licensed products in Canada in its normal course of trade, which is sales to distributors, retailers such as Home Depot and Rona, as well as users [paras 10-13]. Mr. Johnston includes :

- i. Sample invoices issued during the relevant period to Canadian customers showing sales of products identified as “pipe with the stripe” [para 13, Exhibits A1-A4];
- ii. Photographs of various sample products displaying the Mark, i.e. different color stripes along their length [para 14, Exhibits B1-B7];
- iii. Specific correlation between the products shown in Exhibit B and the invoices provided at Exhibit A [para 15];

(d) The products sold by Ipex Inc. were “polyethylene cold water pressure piping” which is a type of “piping and tubing” [para 16];

(e) Annual sales in Canada by Ipex Inc. of licensed products bearing the Mark, i.e. a stripe along their length, exceeded three million dollars, broken down per year during the relevant period [para 17].

ANALYSIS AND REASONS FOR DECISION

[9] The relevant definition of “use” in the present case is 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.

[10] 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; the 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].

[11] Mr. Johnston's statements and documentary evidence clearly show (i) the Mark appeared directly on the goods listed in the registration; (ii) the normal course of trade of such goods; and (iii) the sale of such goods to Canadian clients in such normal course of trade during the relevant period. This evidence clearly demonstrates use of the Mark.

[12] Mr. Johnston clearly states that the goods listed in the registration were sold under license and that the Owner controlled the character and quality of the goods. This evidence is sufficient to show that a license was in place and that the requisite control was exercised [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102]. Accordingly, I am satisfied that use by the licensees enures to the Owner's benefit pursuant to section 50 of the Act.

[13] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4(1) and 45 of the Act in association with the goods in the registration.

DISPOSITION

[14] 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.

Emilie Dubreuil
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-10-26

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Marta Tandori Cheng and Jeff Pervanas

AGENTS OF RECORD

For the Requesting Party: Fogler, Rubinoff LLP

For the Registered Owner: Riches, Mckenzie & Herbert LLP