



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 218

Date of Decision: 2023-12-18

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Gowling WLG (Canada) LLP

Registered Owner: Edward Law

Registration: TMA892,138 for ONE WHEEL COMPANY

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. TMA892,138 for the trademark ONE WHEEL COMPANY (the Mark), owned by Edward Law (the Owner).

[2] For the reasons that follow, I conclude that the registration should be maintained in part.

THE RECORD

[3] At the request of Gowling WLG (Canada) LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on July 15, 2022. The notice required the Owner to show whether the Mark had been 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 it was last in use and the reason for the absence of use since that date. In this case, the relevant period for showing use is from July 15, 2019 to July 15, 2022.

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

(1) Skateboards, skateboard wheels, skateboard trucks, skateboard hardware, skateboard T-shirts, long sleeve t-shirts, sweatshirts (crew and hooded), zipper sweatshirts, shirts, jerseys, jackets, windbreakers, baseball caps, beanies, jeans, cargo pants, shorts, socks, lingerie, skirts, dresses, sweatbands, wristbands, belts, gloves, bandanas, backpacks, wallets, skateboard tools, skateboard shoes, grip tape, stickers, patches, key chains, snowboards, snowboard boots and bindings.

[5] 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 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 whom the property or possession is transferred.

[6] It is well accepted that 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 Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. However, 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.

[7] In response to the Registrar's notice, the Owner furnished his own affidavit, dated February 15, 2023, together with Exhibits A through D. While both parties filed written representations, no oral hearing was held.

THE EVIDENCE

[8] Mr. Law states that in addition to being the Owner of the Mark, he is also the President of Distinct Supply Inc., the supplier, distributor, and licensee of the Owner's skateboards and related products since the year 2000.

[9] Mr. Law states that he is involved in the daily operation of Distinct Supply Inc., either directly or through subordinates that he oversees, wherein he makes all final decisions with respect to the character and quality of the goods manufactured and/or sold by Distinct Supply. He further states that he also has controlling ownership of Distinct Supply and is its sole director.

[10] With respect to use of the Mark, he attests that the Mark is primarily used in association with "skateboard wheels" and "skateboard t-shirts". He states that sometimes a minor variation of the Mark is marked or invoiced as ONE WHEEL CO., with CO. being the abbreviated form for COMPANY. In support, he provides the following:

- Exhibit A - a collection of 10 invoices, which he describes as a sampling of actual sales invoices from the relevant period which include sales of skateboard wheels and skateboard t-shirts sold with the Mark either affixed to these goods and/or their packaging;
- Exhibit B - what he describes as photos of the Mark as it would be affixed to the "non-design side" of skateboard wheels sold in the relevant period. He explains that in addition to the Mark in word format, a design version of the Mark also appears on this label (the Logo). He states that these photographs are an accurate representation of how those skateboard wheels would have been sold in the relevant period, including those listed in the Exhibit A invoices;
- Exhibit C – what he describes are photos of the "design side" of the skateboard wheels, which he states are an accurate representation of those sold during the relevant period, including those in the Exhibit A invoices. He explains that "due to space constraints", an abbreviated version of the Logo without the word elements

“WHEEL COMPANY” appears on the design side of the skateboard wheels. He states that the unmodified Logo on the label affixed to the packaging ensures that consumers understand that the abbreviated version of the Logo affixed to the skateboard wheels themselves, is a reference to the Logo; and

- Exhibit D – what he describes are photos of display versions of skateboard t-shirts, the associated tags, and the skateboard t-shirts wrapped in clear plastic with the tags as they would appear to customers at the time of sale. He states that these photos are an accurate representation of how the skateboard t-shirts would have been sold in the relevant period including those on the Exhibit A invoices. The t-shirts display “Onewheelco.” (wherein the term “one” is differentiated by a distinct colour), and the affixed tags clearly display the Mark, both in word format and in the form of the Logo.

ANALYSIS

[11] The Requesting Party’s submissions are brief, noting that the Owner only alleges use of the Mark in association with the goods “skateboard wheels” and “skateboard t-shirts”, and makes no allegation that it has used or that there are special circumstances excusing non-use of the Mark in association with the balance of the goods claimed in the registration.

[12] The Requesting Party submits that as the Owner is the only party who can file evidence and has the onus of demonstrating that it has used its Mark in commerce, it must be assumed that the Owner does not have any better evidence of its alleged use of its Mark during the relevant period. Thus, the Requesting Party submits, the Owner has not met its burden of showing use of the Mark in association with the registered goods.

[13] The Owner submits that the evidence is absolutely clear that the Mark has been used in association with “skateboard wheels” and “skateboard t-shirts” within the relevant period and that the registration should at a minimum be maintained with those

goods. Furthermore, the Owner submits that by way of inference, it has also established that its use extends to “skateboard hardware” and “shirts”.

[14] I agree that the Owner’s evidence shows that the Owner used the Mark in association with the goods “skateboard wheels” and “skateboard t-shirts” during the relevant period in Canada. Any representations that the Owner has made with respect to whether the Logo, or its abbreviation without the words “WHEEL COMPANY” are unnecessary and moot, because the Mark as registered clearly appears on the labels or tags affixed to these goods [Exhibits B and D]. Furthermore, the evidence clearly shows that such goods were sold in Canada during the relevant period [Exhibit A invoices].

[15] However, with respect to the remaining registered goods, I am not satisfied that the Owner has established use, nor have special circumstances been demonstrated that would excuse the absence of such use. Despite the Owner’s invitation to infer use, there is nothing in the evidence that would permit me to infer that such use extends to goods other than skateboard wheels and t-shirts. While “t-shirts” are a type of “shirt”, the good “shirt” is broader in scope, and the goods “t-shirt” and “shirt” have been separately listed in the registration. It is well established that use evidenced with respect to one specific good generally 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 [see *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

DISPOSITION

[16] In view of the foregoing, 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 amended to delete the following goods:

(1) Skateboards, [...], skateboard trucks, skateboard hardware, [...], long sleeve t-shirts, sweatshirts (crew and hooded), zipper sweatshirts, shirts, jerseys, jackets, windbreakers, baseball caps, beanies, jeans, cargo pants, shorts, socks, lingerie, skirts, dresses, sweatbands, wristbands, belts, gloves, bandanas, backpacks, wallets, skateboard tools, skateboard shoes, grip tape, stickers, patches, key chains, snowboards, snowboard boots and bindings.

[17] The registration will now read as follows:

(1) Skateboard wheels, skateboard T-shirts.

Kathryn Barnett
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: Gowling WLG (Canada) LLP

For the Registered Owner: Andrews Robichaud