



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 63

Date of Decision: 2024-03-27

[UNREVISED ENGLISH CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Bennett Jones LLP

Registered Owner: For-Net Inc.

Registration: TMA254,778 for FOR-NET; Design

INTRODUCTION

[1] On June 23, 2022, at the request of Bennett Jones LLP (the Requesting Party), the Registrar issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to For-Net Inc. (the Owner), the registered owner of registration No. TMA254,778 for the trademark FOR-NET; Design (the Mark), reproduced below:



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

[TRANSLATION]

(1) Liquid soap, hard soap, and wax.

(1) All maintenance and cleaning services for buildings and public buildings of all kinds, as well as the distribution and sales services of maintenance and cleaning products used for the maintenance and cleaning of such buildings and structures.

[3] The Section 45 notice required the Owner to provide an affidavit or sworn statement showing that the Mark was used in association with each of the goods and services specified in the registration in Canada at any time between June 23, 2019 and June 23, 2022 (the relevant period), and, if not, indicating the date when the Mark was last in use and the reason for the absence of such use since that date.

[4] 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.

(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.

[5] It is well established that bare assertions of 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)]. It is true that the evidentiary threshold is quite low [*Woods Canada Ltd v Lang Michener et al.* (1996), 71 CPR (3d) 477 (FCTD)] and evidentiary overkill is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, 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 and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar’s notice, the Owner furnished an affidavit from its President, CEO, and majority shareholder Annie Fortin, sworn on January 20, 2023, together with Exhibits AF-1 to AF-10 (the Fortin Affidavit).

[7] Only the Owner submitted written representations; no oral hearing was held.

THE EVIDENCE

[8] In the first part of her affidavit, Ms. Fortin concedes at the outset that the Mark was not used in association with [TRANSLATION] “hard soaps.” As there are no exceptional circumstances in the evidence excusing non-use of the Mark in association with such goods, the goods described as [TRANSLATION] “hard soap” in the registration will be deleted from it, without the need for further discussion.

[9] In the second part of her affidavit, Ms. Fortin provides a history of the Owner’s business and “Groupe Fortin.” Suffice it to note that the Owner is a family business established in Quebec for more than 60 years and whose structure has evolved over the years to include the subsidiary For-Net Québec Inc. and the sub-subsidiary For-Net Montréal Inc., both duly authorized by the Owner to use the Mark. As Ms. Fortin refers to these two companies collectively as For-Net, I will do the same in my review of her affidavit.

[10] Ms. Fortin goes on to explain the history of the “visual” aspect of the Mark. She states that the Mark has:

[TRANSLATION]

“... evolved slightly over time to remain modern but has always included the same elements that distinguish it, namely, the syllables “FOR” and “NET,” separated by a hyphen with a feather above the letter “N,” whose right leg is slightly truncated as shown below:

Marque version originale

Marque version actuelle



[11] I agree with the Owner that this is a minor variant of no consequence. That said, I note at this point in my decision that several of the exhibits attached in support of the Fortin Affidavit also show the Mark as presented in the example reproduced below, that is, with the addition of the phrase “*Notre force: la propreté*” preceded by the letter “F” embedded in a red square, all appearing in smaller characters of different fonts and colours and below the Mark:



[12] By virtue of the different positioning and presentation of this addition, I consider that such a variant also does not affect the identity of the Mark, which remains recognizable in the context of its use [according to *Registrar of Trade-marks v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 1985 CanLII 5537, 4 CPR (3d) 523 (FCA); and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. Therefore, in my review of the evidence below, I will not distinguish between any of these variants of the Mark. I would add on this point that if I am wrong in concluding that any use of the second variant applies to the use of the Mark, this does not change the ultimate outcome of my decision as many of the exhibits also show the Mark in its [TRANSLATION] “original” or “current” version, as described by Ms. Fortin.

[13] Considering now more specifically the nature of the Owner's business and the use of the Mark in association with the registered goods and services, Ms. Fortin essentially states the following in the third part of her affidavit:

- For-Net's primary business activity is the provision of commercial, industrial, and institutional cleaning services. In this context, during the relevant period, For-Net maintained and cleaned office buildings, factories, and institutional buildings such as schools [para 19];
- as part of this service offering, For-Net also sells exclusive liquid soaps and waxes that it uses for cleaning. These goods are typically invoiced as part of the integrated service offering but are occasionally invoiced separately. In the case of these exclusive soaps and waxes, these are not third-party soaps and waxes but rather in-house products manufactured by a member company of the Fortin Group under the direction of Ms. Fortin [para 20];
- For-Net advertises its goods and services provided under the Mark in different ways, including brochures, advertisements in magazines, and on Facebook [para 21];
- during the relevant period, For-Net sold over \$20,000,000 annually in maintenance and cleaning services, soaps, and waxes [para 23];
- exclusive soaps and waxes sold by For-Net are not delivered to clients in containers for their own use. Rather, these exclusive soaps and waxes are used by For-Net employees when performing maintenance and cleaning services and are normally (but not always) invoiced in the overall offer, which also includes maintenance and cleaning services [para 24];
- while For-Net employees provide maintenance and cleaning services and apply exclusive soaps and waxes on surfaces to be cleaned and waxed, they consistently wear (and this was equally true during the relevant period) uniforms bearing the Mark [para 25];
- For-Net employees who provide maintenance and cleaning services visit (and this was equally true during the relevant period) For-Net clients in trucks bearing the Mark [para 28]; and

- the Mark appears (and this was also true during the relevant period) in the signature block of emails sent by For-Net employees, particularly when they negotiate contracts for the provision of maintenance and cleaning services and related goods (soaps and waxes) [para 29].

[14] In support of her assertions, Ms. Fortin reproduces, in the relevant paragraphs of her affidavit, photographs of the exterior signs of For-Net offices, uniforms and For-Net employees wearing such uniforms, trucks of For-Net, and the signature block of For-Net emails, all of which showing the Mark. She also attaches to her affidavit the following relevant exhibits, all of which also show the Mark:

- Exhibit AF-4: copy of the home page of the For-Net website describing the cleaning services the company offers and mentioning [TRANSLATION] “environmentally friendly products of its sister company FORKEM R&D”;
- Exhibit AF-5: copy of an advertising flyer [TRANSLATION] “widely distributed in 2021 to various companies and public organizations, including schools and school boards,” describing the cleaning services offered by For-Net and referring, under the heading “BIO-f,” reproduced below, to ecological products made in Quebec:

 **AVANTAGE :**
Solutions **environnementales**, efficaces et intégrées

- Respect de l'environnement au coeur de nos actions
- Produits écologiques fabriqués au Québec
- Méthodes **innovatrices** et équipements à la fine pointe

- Exhibit AF-6: copy of [TRANSLATION] “an advertisement that appeared in *Gestion immobilière* magazine in winter 2022,” referring to For-Net’s cleaning services and containing the following statement:

- Fabricant de produits de désinfection et de produits écologiques 

- Exhibit AF-7: copy of Facebook pages including [TRANSLATION] “two advertisements published in 2021,” referring to For-Net’s cleaning services. The following is written in the margin of one of these advertisements: [TRANSLATION] “We use environmentally friendly products while taking a customized approach to our clients’ needs”;
- Exhibit AF-8: [TRANSLATION] “an excerpt from a typical example of a service and product offering sent by [For-Net] to a potential client” in January 2022. In addition to For-Net’s cleaning services described therein, I note the following excerpts regarding the provision of [TRANSLATION] “products, supplies, equipment” and “the manufacture and distribution of products and equipment”:

Produits, fournitures, équipements :

Savon à mains :

Notre proposition inclut le coût du savon à mains.

Désinfectants :

Le désinfectant à mains, présents dans plusieurs espaces communs n’est pas inclus également. Si le client désire s’en procurer, nous proposons de lui vendre ces produits.

Produits :

Notre proposition inclue tous les produits requis pour l’entretien ménager. Nous fournissons des dilueurs pour les produits utilisés par For-Net.

Fabrication et distribution de produits et d'équipements

For-Net est la seule entreprise sur le marché au Québec à combiner le service d'entretien ménager et la fabrication des produits d'entretien ménager par l'entremise de sa filiale Forkem. La fabrication de nos produits se fait à notre laboratoire de notre bureau de Québec. Notre personnel scientifique et technique est disponible en tout temps pour résoudre des problèmes particuliers ou encore pour adapter nos produits existants aux besoins spécifiques de nos clients.

Nous croyons que la souplesse que nous procure le fait de pouvoir fabriquer et/ou adapter des produits existants nous confèrent un avantage concurrentiel certain en nous permettant d'être proactif et innovateur.

Nous distribuons également des lignes de produits les plus réputées du domaine sanitaire (Tomcat, 3M, Chemspec, Armstrong, Rubbermaid, etc.)

Solutions **environnementales**, efficaces et intégrées



- Respect de l'environnement au cœur de nos actions
- Produits écologiques fabriqués au Québec
- Méthodes **innovatrices** et équipements à la fine pointe

Notre responsabilité sociale à cet égard ainsi que le respect des exigences particulières de nos clients sont à la base de chacun des produits que nous développons. Constattement en quête d'amélioration et à l'affût des plus récentes réglementations environnementales, **FORKEM R&D** aborde la formulation de chacun de ses produits avec le souci d'y introduire des composantes écologiques et dans l'optique de favoriser le développement durable.

Nous avons mis en place une politique environnementale détaillée ainsi qu'un processus de recherche et d'implantation des solutions écologiques. Cette approche, qui repose sur l'« Éco-conception », a notamment mené au développement de la gamme environnementale de produits écologiques, assurant une qualité irréprochable à la clientèle tout en favorisant la protection de l'écosystème et la réduction de la pollution.

Les produits de FORKEM R&D répondent aux critères de santé et de sécurité SIMDUT et TMD en matière d'étiquetage, de documentation et de formation.

- Exhibit AF-9: copy of representative invoices issued [TRANSLATION] “for maintenance and cleaning services and exclusive liquid soaps and waxes sold by For-Net during the relevant period”; and
- Exhibit AF-10: copy of an article on For-Net published in the March 22, 2020 edition of *La Presse*.

ANALYSIS

[15] Considering the Fortin Affidavit as a whole, I have no difficulty concluding that the Mark was used within the meaning of section 4(2) of the Act in association with all the registered services.

[16] However, with respect to the remaining goods described in the registration as [TRANSLATION] “liquid soap, and wax,” I find the evidence insufficient to conclude that the Mark was used within the meaning of section 4(1) of the Act during the relevant period.

[17] I first note that Ms. Fortin states the following in paragraph 24 of her affidavit:

[TRANSLATION]

I very deliberately do not show images of exclusive soaps and waxes sold by For-Net (some of which appear in the AF-9 invoices) because the Mark does not appear on their containers or packages. The exclusive soaps and waxes sold by For-Net are not delivered to clients in containers for their own use. Rather, these exclusive soaps and waxes are used by For-Net employees when performing maintenance and cleaning services and normally (but not always) invoiced in the overall offer that also includes maintenance and cleaning services. In this context, exclusive soaps and waxes are delivered (i.e., ownership of the products is transferred) when they are applied to the surfaces to be cleaned and waxed. In other words, For-Net’s clients do not become owners of the exclusive soap and wax containers or packages.

[18] Second, while the Owner argues in its written representations that [TRANSLATION] “the situation is a little more complicated” with respect to the goods, but the Mark is not necessarily “deadwood,” the parallels it makes between the facts of this case and those in *Timothy’s Coffees of the World Inc v Starbucks Corp* (1997), 79 CPR (3d) 147 (TMOB) and *Central Soya of Canada Ltd v 88766 Canada Inc* (1993), 51 CPR (3d) 509 (FC) are not persuasive.

[19] In *Timothy’s Coffees of the World*, the display of the trademark at issue in catalogues and other purchase orders used to order the goods, combined with the appearance of the trademark on the invoices accompanying the goods at the time of transfer of the property, was considered sufficient to establish use of the trademark within the meaning of section 4(1) of the Act.

[20] In *Central Soya of Canada*, the goods associated with the trademark at issue were sold in bulk. The evidence established that the owner of the trademark provided truck drivers who were picking up its goods at the factory with a tare slip indicating the weight of the vehicle in unloaded and loaded state and the weight of the loaded good. The owner provided a copy of the tare slip to the driver, who in turn presented it to the

farmer at the time of delivery. The trademark was clearly displayed on the tare slip. The trademark was also displayed on price signs in the owner's premises.

[21] In the present case, although the Mark appears in the offer of services and products in Exhibit AF-8, these goods are rather described in association with the trademark "BIO-f" or other trademarks of third-party companies (such as 3M and Rubbermaid), the trademark "BIO-f" also appearing prominently elsewhere in the evidence, as noted above.

[22] In addition, although the Mark appears in the header of the invoices in Exhibit AF-9 and/or as a watermark in some of them, and that some of the invoices indicate the sale of [TRANSLATION] "Disinfectants for disinfectant dispensers," "Products – Wax 1100-Plus," or a "flat rate" for the "cleaning and waxing of the surface" of premises, "including labour, products, equipment necessary for the work," I find such evidence insufficient to conclude that the requisite notice of association within the meaning of section 4(1) of the Act exists. Suffice it to say that there is no indication that such invoices were given to the client when the cleaning products sometimes mentioned in them were supposedly [TRANSLATION] "transferred" to the client, so as to give notice of association between the Mark and such products. On the contrary, a majority of these invoices show that they were invoiced for a particular period or month or, if they relate to a single day, are dated after the date when the invoiced cleaning services were rendered. In closing on the issue of invoices, I would add that the mere fact that For-Net may invoice clients for cleaning products used in the performance of its services does not in itself mean that such products are necessarily used in association with the Mark within the meaning of section 4(1) of the Act.

[23] Similarly, the fact that Ms. Fortin states that For-Net's goods were [TRANSLATION] "applied to the surfaces to be cleaned and waxed" at the client's premises by employees wearing uniforms bearing the Mark, and travelling to the client's premises in trucks bearing the Mark, is not sufficient to demonstrate use of the Mark in association with the goods described in the registration as [TRANSLATION] "liquid soap, and wax." In the present context, such evidence rather demonstrates the performance of For-Net's

maintenance and cleaning services offered in association with the Mark, not notice of association between the Mark and the goods used in the performance of those services, let alone necessarily [TRANSLATION] “transfer” of the property or possession of those goods per se within the meaning of section 4(1) of the Act. Similarly, the mere presence of the Mark on the signs outside For-Net offices and in the example of the For-Net email signature block reproduced by Ms. Fortin does not demonstrate in itself, or when considered in light of the evidence as a whole, use of the Mark in association with the goods [TRANSLATION] “liquid soap, and wax.”

[24] In these circumstances, considering the evidence as a whole, I find it insufficient to enable me to reasonably conclude that the Mark was used with the goods described in the registration as [TRANSLATION] “liquid soap, and wax” within the meaning of sections 4(1) and 45 of the Act.

DECISION:

[25] As there is no evidence of special circumstances excusing non-use of the Mark in association with all the registered goods, these will be deleted from the registration.

[26] Therefore, 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 in respect of the services only, namely:

[TRANSLATION]

(1) All maintenance and cleaning services for buildings and public buildings of all kinds, as well as the distribution and sales services of maintenance and cleaning products used for the maintenance and cleaning of such buildings and structures.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified Translation
Daniel Lépine, Lisa Hannaford-Wong, Beau Brock

Appearances and Agents of Record

No hearing held

AGENTS OF RECORD

For the Requesting Party: Bennett Jones LLP

For the Registered Owner: BCF S.E.N.C.R.L./BCF LLP