



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 106

Date of Decision: 2024-06-03

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Canada Lands Company Limited

Registered Owner: City Clean, a division of Franconia Enterprises Limited

Registration: TMA905,241 for City Clean & 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. TMA905,241 for the trademark City Clean & Design (the Mark), shown below, owned by City Clean, a division of Franconia Enterprises Limited (the Owner):



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

Rental of floor mats; sale of washroom supplies.

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

THE RECORD

[4] At the request of Canada Lands Company Limited, the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on June 30, 2023. The notice required the Owner to show whether the Mark had been used in Canada in association with each of the services 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 such use since that date. In this case, the relevant period for showing use is June 30, 2020 to June 30, 2023.

[5] The relevant definition of use in the present case is set out in section 4 of the Act as follows:

(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.

[6] It is well established that 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 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 the services specified in the registration during the relevant period.

[7] In response to the Registrar’s notice, the Owner furnished an affidavit of its President, Sean Jirgens, sworn on October 24, 2023. No written representations were submitted and no hearing was held.

EVIDENCE AND ANALYSIS

[8] The affidavit of Mr. Jirgens first provides a background of the Owner company and then goes on to focus on the use and advertising of the Mark in association with the registered services. As Mr. Jirgens collectively refers to the registered services as the “Services” and further explains that the Owner uses the term “Facility Management Services” or “Facility Services” to refer to the “sale of washroom supplies”, I will do the same in my review of his affidavit.

[9] Mr. Jirgens attests to the continuous use of the Mark in Canada by the Owner in association with the Services since at least as early as January 2014. More particularly, he attests that the Owner provides floor mat rental services and sale of washroom supplies including paper towels, toilet paper, soap, hand sanitizer, disinfecting wipes, air fresheners, cotton or microfiber towels, garbage bags, soap, and urinal products in association with the Mark. In support of his assertions of use of the Mark, Mr. Jirgens attaches the following exhibits, all of which display the Mark (except for two invoices):

- Exhibit A: archived screen captures from the washroom “Facility Services”, “Mat Rentals” and “Floor Mat Products” webpages of the Owner’s website at <https://www.cityclean.ca> (the Company Website) dated December 2, 2021, and May 19, 2022, which feature a list of the various options offered in connection with the Services and are representative of how the Mark was displayed on the Company Website during the relevant period;
- Exhibits B and C: other archived screen captures from the Company Website dated during the relevant period, which are representative of how the Mark was prominently displayed to customers. In this respect, Mr. Jirgens explains that when Canadian consumers visit the Company Website to place an order for the Services, they complete a consultation request form or an order request form and are provided access to a Client Login Platform for order management, inventory tracking, and service scheduling to manage the Services;
- Exhibit D: a picture of the branded overhead sign located outside above the front door of the Owner’s brick and mortar store in Mississauga, Ontario, which is

representative of the outdoor signage that was displayed in that location throughout the relevant period;

- Exhibits E to G: representative samples of flyers, newsletter and business card, all of which were provided to customers during the relevant period;
- Exhibits H and I: sample pictures of the Owner's commercial delivery trucks and vans and branded uniforms for employees to wear while performing the Services;
- Exhibits J to K: representative samples of online advertising of the Services on the Company Website and social media platforms (Twitter and LinkedIn); and
- Exhibit M: representative examples of invoices relating to rental of floor mats and sale of washroom supplies to customers during the relevant period.

[10] I am satisfied that the Owner's evidence shows that the Mark was in use during the relevant period in association with the registered services. It is well established that the display of a trademark in an advertisement of services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark is willing and able to perform the services in Canada [see *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. In this case, the evidence not only establishes that the Owner's registered services were advertised in association with the Mark during the relevant period, but that the Owner was willing and able to perform its services during the relevant period, and did in fact provide its services.

[11] I am therefore satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[12] In view of all 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 maintained.

Annie Robitaille
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: Marks & Clerk

For the Registered Owner: Bereskin & Parr