

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 10

Date of Decision: 2025-01-23

IN THE MATTER OF A SECTION 45 PROCEEDING

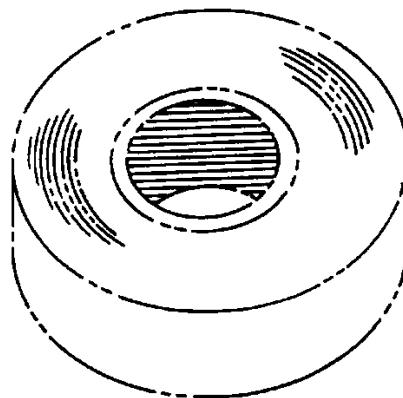
Requesting Party: BCF S.E.N.C.R.L./BCF LLP

Registered Owner: Scapa Tapes North America Ltd.

Registration: TMA486,335 for BLUECORE 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. TMA486,335 for the trademark BLUECORE DESIGN reproduced below (the Trademark), owned by Scapa Tapes North America Ltd. (the Owner).



[2] The Trademark registration includes the following colour claim:

The colour blue applied to the inner core surface of a roll of tape. Colour is claimed as a feature of the trade-mark.

[3] The Trademark is registered for use in association with athletic tape.

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

PROCEEDING

[5] On June 5, 2023, at the request of BCF S.E.N.C.R.L./BCF LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to the Owner.

[6] The notice required the Owner to show whether the Trademark was used in Canada in association with 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 Trademark was last in use and the reason for the absence of such use since that date. The relevant period for showing use is therefore between June 5, 2020, and June 5, 2023.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Krystyna deVries, sworn on November 21, 2023, with Exhibits A and B.

[8] Both parties filed written representations and were represented at the hearing.

EVIDENCE

[9] Ms. deVries is the Owner's Head of R&D/Product Manager. She describes the Owner as a bonding products and adhesive components manufacturer, located in Ontario [paras 1, 2 and 5].

[10] Ms. deVries describes the registered goods as a “white athletic tape wound around a cardboard paper roll with the blue colour comprising the BLUECORE DESIGN trademark applied to the entire interior surface of the cardboard roll”. She adds that an additional trademark appears on the goods, the RENFREW PRO & Design trademark, with the permission of its owner, Scapa Group Limited, the Owner’s parent company [paras 6 and 7].

[11] Ms. deVries explains that the Owner generally sells and ships the registered goods directly to their customers, but in some cases, the goods are shipped to a third-party, if requested by the customers [para 12].

[12] Attached to the deVries affidavit are the following exhibits:

- Exhibit A consists of an image of the Owner’s athletic tape. Ms. deVries confirms that the image is representative of the goods sold during the relevant period [para 6]. I note that in addition to the RENFREW PRO & Design trademark, the words *Athletic Tape / Ruban Athlétique* and *MADE IN CANADA / FABRIQUÉ AU CANADA* are written on the inner surface of the tape.
- Exhibit B consists of invoices showing sales of the Owner’s athletic tape during the relevant period by the Owner to Canadian customers. Ms. deVries confirms that these invoices are representative of the sales that have taken place during the relevant period [para 13].

REASONS FOR DECISION

[13] 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 evidence in a section 45 proceeding need not be perfect; indeed, a registered owner needs only to

establish a prima facie case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

Deviation

[14] The Requesting Party submits that the trademark depicted in Exhibit A is not the Trademark as registered, the identity of which is lost; the colour blue cannot be seen on the entire interior surface of the rolls, given that an additional trademark is also appearing. It argues that use of the evidenced trademark should not constitute use of the Trademark.

[15] The Owner submits that that the Trademark appears on the goods as registered without any modification, it is simply alongside an additional trademark. It adds that the additional trademark does not interfere with the identity of the Trademark, or impact the matter of its use.

[16] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)].

[17] Additionally, there is no restriction against multiple trademarks being used together in association with the same product [*AW Allen Ltd v Warner Lambert Canada Inc* (1985), 6 CPR (3d) 270 at 272 (FCTD)].

[18] I find that the colour blue is still applied to the inner core surface of a roll of tape, just as registered. I agree with the Requesting Party that the additional trademark also appearing on the inner core of the tape modified the appearance of the Trademark. However, I do not consider this an important modification to the Trademark. As the colour blue still appears on

the majority of the surface, I find that the Trademark remained recognizable and maintained its identity.

Display of the Trademark

[19] The Requesting Party submits that there's no evidence of a notice of association between the registered goods and the Trademark since it would not have been visible at the time of any transfer of possession, given that the Trademark appears on the inside of the goods and there is no information provided by the Owner of the goods' packaging and whether the Trademark is visible at the time of transfer. It adds that the evidence demonstrates that the goods are shipped to customers in large numbers, probably in opaque cardboard boxes.

[20] The Owner submits that the Trademark is displayed directly on the goods which is sufficient to establish use of the Trademark pursuant to section 4 of the Act. Moreover, it argues that the evidence does not indicate that the goods are sold in opaque cardboard boxes, adding that the goods could be shipped in boxes made from clear material or crates showing the products inside.

[21] I cannot conclude that the Trademark is not visible at the time of transfer of the goods. Indeed, the Exhibit A image demonstrates that the Trademark appears on the goods and Ms. deVries confirms that this image is representative of the Owner's goods sold and shipped during the relevant period in Canada. Nothing in the evidence permits me to determine that the purchaser did not see the Trademark while receiving the goods.

[22] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 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.

Ann-Laure Brouillette
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-10-29

APPEARANCES

For the Requesting Party: Pascal Lauzon

For the Registered Owner: Chantal Bertosa

AGENTS OF RECORD

For the Requesting Party: BCF S.E.N.C.R.L./BCF LLP

For the Registered Owner: AVENTUM IP LAW LLP