

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 8

Date of Decision: 2025-01-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Unifloor Trading Inc.

Registered Owner: Quickstyle Industries Inc.

Registration: TMA481,945 for UNIFLOOR

INTRODUCTION

[1] This decision involves a summary expungement proceeding brought under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA481,945 for the trademark UNIFLOOR (the Mark). The Mark is registered in association with the following goods (the Goods):

Pre-finished self-installed floating floors fabricated of medium density fibre board panels, consisting of a top resin layer and decorated with colors, for use in, and for the construction of interior residential and commercial floors

[2] For the reasons that follow, I conclude the registration ought to be expunged.

PROCEEDING

[3] At the request of Unifloor Trading Inc (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on November 1, 2023, to Quickstyle Industries Inc. (the Owner), who is the registered owner of the Mark.

[4] The notice required the Owner to show whether the Mark was used in Canada in association with Goods at any time within the three-year period preceding the notice's date. If not, the Owner had to provide the last date of use and the reason for the absence of use since that date.

[5] In this case, the relevant period for showing use is November 1, 2020, to November 1, 2023 (the Relevant Period).

[6] The pertinent definitions of use in association with goods is set out in section 4 of the Act:

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.

4(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.

[7] The Registrar, at the same time, issued a notice for a second registration held by the Owner, namely registration No. TMA1,052,331 for the trademark UNIFLOOR AQUA. This registration is the subject of a separately reported decision.

[8] The purpose of section 45 is to establish a summary procedure for clearing the register of marks that have fallen into disuse. This is often described as removing "deadwood" from the register [*Black & Decker Corp v*

Method Law Professional Corp, 2016 FC 1109 at para 12]. Evidentiary overkill is not necessary [*Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 at paras 9-10]. The registration of a trademark is liable to be expunged or amended if the owner fails to show use of the trademark unless there are special circumstances that excuse the absence of use.

[9] In response to the Registrar's notice, the Owner furnished the statutory declaration of Stephen Courey, President and Secretary of the Owner. Both parties filed written representations and attended an oral hearing.

SUMMARY OF EVIDENCE

[10] Mr. Courey is a director and officer who has been actively involved with the Owner since its incorporation in 1992. He attests that the Owner's principal business is the importation of flooring merchandise into Canada and subsequent distribution under various brand names to retailers for sale in Canada.

[11] In respect of the nature of the Goods and the timing of alleged use, Mr. Courey states at paragraph 7 of his affidavit that:

That use of the Trademark in Canada in association with the general class of goods recited in the aforesaid registration comprising *pre-finished self-installed floating floors fabricated of medium density fibre board panels, consisting of a top resin layer and decorated with colors, for use in, and for the construction of interior residential and commercial floors* commenced since at least as early as September 10, 1993 and which description of goods includes the goods commonly known as *vinyl flooring*,

[12] Mr. Courey then states that the Owner distributed vinyl flooring to retailers in Canada during the Relevant Period. Additionally, he explains that the Owner provided retailers with what he terms "promotional" materials such as racks and waterfall displays, hand board chain sets and information brochures displaying the trademark in association with vinyl flooring. He

goes on to describe that those retailers displayed these materials, making them available to consumers. Mr. Courey explains that during the Relevant Period, Canadian consumers “purchased UNIFLOOR brand vinyl flooring from various retailers...”.

[13] Mr. Courey states that the Owner used and continues to use the Mark in Canada in the normal course of trade. He concludes by stating that he had personal knowledge of the facts set out in his affidavit.

[14] The exhibits provided in support of Mr. Courey’s statements include depictions of:

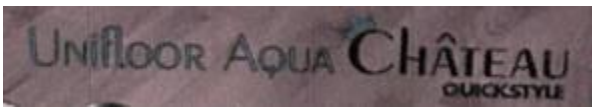
- Information sheets
- Waterfall display racks
- Reverse sides of sample panels from waterfall displays
- Reverse sides of chain set panels
- Invoices corresponding to sales to retailers during the Relevant Period

[15] I note the information sheets refer to the branded product as “vinyl flooring” and describe a vinyl layer over a DFC core with attached underlayment. The back of the sample panels describes the products as “Vinyle” Composite Flooring” specifying that it is a vinyl layer over a composite core with attached underlayment [Exhibit R-3].

[16] The materials in evidence generally show four manifestations of the Mark:

- 
1. **Vinyl Flooring - Plancher de vinyle**

2. 

3. 

4. As an invoice line item:

VINYL 7.5mm - UNIFLOOR AQUA	17	17	0
CHATEAU 6 X 48 in -IMPERIAL (23.33			
sqft/unit)			

PRELIMINARY MATTER – INVOICES

Invoices Generally

[17] The Owner relies on a number of invoices in support of its claim to having sold vinyl flooring branded with the Mark during the Relevant Period. Mr. Courey states at paragraph 15 of his affidavit:

...the Registered Owner sold and distributed UNIFLOOR brand vinyl flooring referred to in Exhibit R-1 en liasse, Exhibit R-2 en liasse, Exhibit R-3 and Exhibit R-4, to retailers for retail sale in various parts of Canada, the whole as more fully appears in copies of certain of the Registered Owner's invoices, (with pricing information redacted and removed), which invoices are attached to this my Statutory Declaration and which are now filed as the Registered Owner's Exhibit R-5 en liasse, such invoices being a sampling of UNIFLOOR brand vinyl flooring sold, shipped and distributed for retail sale in various parts of Canada.

[18] While attesting generally to the removal and redaction of the pricing information, Mr. Courey does not explain modifications to the documents, which appear to minimally include entering "\$0.00" in various places to replace sales values. The changes appear arbitrary since for some invoices GST, PST or HST values have been removed, while these values are retained

for others. The seeming manipulation of the invoices introduces uncertainty that complicates the understanding of the documents.

[19] When I enquired at the hearing about what the Owner refers to as “removal and redaction,” the Owner’s agent suggested that the “redaction method” involved printing invoices showing \$0.00. However, the facts surrounding the creation of the documents are, of course, not in evidence. Furthermore, the explanation provided does not facilitate understanding of the seemingly arbitrary nature of the modifications.

[20] Nonetheless, I note that for some invoices, GST and PST amounts have been retained. These values are of a magnitude that suggests sales in the normal course of trade rather than, for example, the provision of a free or minimal-cost sample. The June 8, 2023 invoice to Rona Inc shows GST and PST values suggesting goods with an extrapolated value of approximately \$1000. Similarly, the invoice to P.S. Atlantic Ltd reflects a 15% HST value of almost \$100, again suggesting a sale in the ordinary course of trade rather than for example the mere provision of samples.

[21] While I do so cautiously in light of the ambiguity introduced by unexplained revisions to the invoice documents, I am permitted to make reasonable inferences from the Owner’s evidence [*BCF SENCRL v Spirits International BV*, 2012 FCA 131]. Mr. Corey’s statements, considered in conjunction with the documentary evidence comprising the invoices with significant values of GST, HST or PST, support the Owner’s claim to sales in the normal course of trade during the Relevant Period.

[22] However, I cannot make the same inference regarding the invoices showing sales of zero dollars with no or no significant GST, HST or PST values. Similarly, I must disregard the invoices to US purchasers. Mr. Courey refers to sales “in Canada,” and provides no explanation regarding sales to

US purchasers. As such, I cannot make any reasonable inferences regarding this component of the evidence either.

The Mark Appearing on Invoices

[23] While invoices have in the past been accepted as proof of use of a trademark in association with the goods referenced in the invoice, in order for this to be so, it is necessary for the goods and trademark to be linked at the time of transfer of those goods to the purchaser [*Riches, McKenzie & Herbert v. Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD) at para 15 (*Pepper King*)].

[24] The Requesting Party has argued that the invoices are not proof of use of the Mark since the evidence does not show that they accompanied the Goods at the time of transfer to consumers. The Owner responded at the hearing that when an invoice indicates “bill to” and “ship to” it can be inferred that it accompanied the Goods. However, no jurisprudence was provided to support this statement.

[25] I note that in *Pepper King*, the Registrar initially held that unless there was clear evidence that the invoices do not accompany the goods, it is reasonable to assume this is the case. However, on appeal, the Court held that the Registrar had erred in shifting the burden to the requesting party when, in fact, the entire burden remains with the owner. It was found that the Registrar was not entitled to assume the goods were accompanied by the invoices at the time of their transfer.

[26] In the present case, while the invoices show the Mark as part of a line item, nothing in evidence allows me to infer that they accompanied the Goods when they were transferred to purchasers. Additionally, I note the invoices show separate shipping and billing addresses, suggesting the invoices might have been sent separately. Therefore, I cannot conclude that

the appearance of the Mark on invoices provides the requisite notice of association between the Mark and these Goods at the time of their transfer.

ANALYSIS AND REASONS FOR DECISION

[27] The Owner's burden is not a stringent one. Rather, it need only establish a *prima facie* case of use within the meaning of section 4 of the Act [*Brouillette Kosie Prince v Orange Cove-Sanger Citrus Association*, 2007 FC 1229 at para 7]. That said, bare assertions of use are not sufficient [*Plough (Canada) Ltd v Aerosol Fillers Inc*, 1980 CanLII 2739, 53 CPR (2d) 62 (FCA)]. Adequate facts must still be provided to permit the Registrar to conclude that the Mark was used during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[28] The evidence allegedly showing use of the Mark comprises various in-store displays in the form of waterfall display racks, hand boards, chain sets and information brochures, which Mr. Courey explains are available to customers at retail outlets supplied by the Owner.

[29] The Requesting Party submits that the evidence does not show use of the Mark as registered in association with the Goods as listed in the registration. It also submits that there is no use of the Mark as contemplated by section 4(1) of the Act as it does not appear on the Goods or their packaging, nor was there sufficient association with the Goods such that notice of association was given to the purchaser.

In-Store Displays

No Use in Association with the Goods

[30] The substance of this line of argument put forward by the Requesting Party involves the fact that vinyl flooring was sold whereas the description of Goods relies on the more particularised description involving flooring fabricated of medium-density fibre board panels with a top resin layer.

[31] The Requesting Party points to the wording of the Courey affidavit referencing the Goods as a general class of goods which includes vinyl flooring, arguing that there is no explanation as to why the Goods include “vinyl flooring” [Requesting Party written representations, paras 7 and 8].

[32] I agree that the wording of the Affidavit is convoluted, and the link between the defined Goods and vinyl flooring is not immediately obvious. That said, the Affidavit contains the statement that the description “pre-finished self-installed floating floors fabricated of medium density fibre board panels, consisting of a top resin layer and decorated with colors, for use in, and for the construction of interior residential and commercial floors” includes vinyl flooring. Beyond the statement itself, I note that the on the display materials the product is described as “vinyl layer over a composite core with attached underlayment” [Courey affidavit, Exhibit R-3].

[33] I am permitted to take judicial notice of ordinary dictionary meanings provided the source is of indisputable accuracy and shall do so in respect of the meaning of vinyl [see *R v Krymowski*, 2005 SCC 7 at para 22, citing *R. v. Find*, [2001] 1 S.C.R. 863 (S.C.C.), at para. 48 and J. Sopinka, S. N. Lederman and A. W. Bryant, *The Law of Evidence in Canada* (2nd ed. 1999), at §§19.13 and 19.22]. I note the pertinent *Merriam-Webster* online dictionary definition of “vinyl” is:

1: a monovalent radical $\text{CH}_2=\text{CH}$ derived from ethylene by removal of one hydrogen atom

2: a polymer of a vinyl compound or a product (such as a resin or a textile fiber) made from such a polymer —often used before another noun a house with vinyl siding

vinyl tiles/flooring

[34] The definition establishes that resin is a type of vinyl. Moreover, Mr. Courey has made a clear statement that the Goods, as specified, include

vinyl flooring. I find that the product shown in evidence may, therefore properly be considered “pre-finished self-installed floating floors fabricated of medium density fibre board panels, consisting of a top resin layer and decorated with colors, for use in, and for the construction of interior residential and commercial floors.” In reaching this conclusion, I am mindful that it is not necessary for me to be astutely meticulous when contemplating the language of a statement of goods [*Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 at para 17].

Was the Mark Used as Registered?

[35] When, as in this case, the trademark as utilized deviates from the trademark as registered, the question to be asked is whether the manner of use was such that the trademark did not lose its identity, remaining recognizable despite the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Compagnie Internationale pour l’informatique CII Honeywell Bull* (1985), 1985 CanLII 5537 (FCA), 4 CPR (3d) 523 (FCA) (*Honeywell Bull*)]. In deciding this issue, one must consider whether the differences between the marks are “so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin” [*Honeywell Bull* supra].

[36] Using a trademark in combination with additional words or features constitutes use of the registered mark if the public, as a matter of first impression, would perceive the trademark *per se* as being used. This is a question of fact which is dependent on whether the trademark stands out from the additional material, for example by the use of different lettering or sizing, or whether the additional material would be perceived as clearly descriptive matter or as a separate trademark or trade name [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]

(*Nightingale*); *PDM Parthian Distributer & Marketing Adviser GmbH v. Brewdog PLC* 2024 FC891 at paras 36 to 38].

[37] The Requesting Party submits that the evidence shows use of UNIFLOOR AQUA rather than the registered Mark UNIFLOOR. It argues that the two components UNIFLOOR and AQUA appear the same size, with the same stylized text and even the same colour, with nothing differentiating the two terms. The Requesting Party also submits that the appearance of the two terms differs from other surrounding wording such as CHATEAU.

[38] Additionally, relying on *Nightingale, supra*, the Requesting Party argues that AQUA would not be considered descriptive in respect of flooring.

[39] The Requesting Party also submits that it was relevant that the Owner owned a registration for UNIFLOOR AQUA and was defending this registration by relying on the same evidence as it has in respect of this proceeding. I am not persuaded that use of the same evidence for both proceedings is relevant to the question of whether the Mark was used as registered.

[40] The Owner argues that the “overwhelmingly distinctive feature of the Mark is the word UNIFLOOR”. It says that AQUA is descriptive and so unimportant it would not mislead ordinary consumers, relying on *Pain & Ceballos LLP v Diamond Foods, Inc, 2013 TMOB 143 (Diamond Foods)*, citing *Nightingale* and *Promafil Canada Ltée v Munsingwear Inc, 1992 CanLII 12831 (FCA)*.

[41] During the hearing, I asked the Owner why it considered the word “AQUA” to be descriptive of the Goods. The response was that the word alluded to quality.

[42] I presume the word AQUA references some aspect of the Goods that relates to water, for example perhaps water resistance. However, the term could reflect something else entirely, such as the colour aqua, or a pattern or appearance of the flooring, which suggests water. I consider the term, at best, suggestive rather than descriptive.

[43] I note that, as argued by the Requesting Party at the hearing, the *Diamond Foods* case relied upon by the Owner differs from the case at hand in that it involved the addition of, *inter alia*, the term “of California” which appears in smaller font, to a design mark comprising the term DIAMOND, encompassed by a simple design element. Not only did “of California” have an obvious descriptive connotation but its font and size differentiated it from DIAMOND. I therefore do not consider this case to provide compelling support for the Owner’s position.

[44] I agree with the Requesting Party that the appearance of UNIFLOOR AQUA suggests a unity of terms as both words appear in precisely the same font, size and colour. Nothing about the display of the terms or the meaning of the words themselves differentiates UNIFLOOR from AQUA or makes UNIFLOOR stand out in any way. I therefore find the facts at hand to be more akin to those in *Honeywell Bull*, wherein use of the registered trademark BULL was not supported by use of the composite trademark CII Honeywell Bull, as BULL lost its identity and was made unrecognizable amongst the surrounding terms.

[45] I conclude that the evidence relied upon by the Owner does not support its claim to use of the Mark, as UNIFLOOR does not stand out from surrounding material, primarily owing to the close association with, and identical appearance to, AQUA. In addition, I note that “aqua” does not convey an obvious descriptive meaning that might focus the consumer on UNIFLOOR, thereby differentiating it from AQUA.

Was the Mark Used in Accordance with Section 4 of the Act?

[46] The Requesting Party submits that there is no evidence to suggest that the Mark was applied to the Goods or their packaging at the time of their transfer in the normal course of trade pursuant to section 4(1) of the Act. It argues the display materials showing the Mark are promotional in nature. It claims that for sufficient association, the materials would have to be given to consumers at the time of transfer of property in or possession of the Goods. In this regard, it relies on *BMW Canada Inc v Nissan Canada Inc* 2007 FCA 255 (*BMW*). The Owner responded at the hearing by submitting that evidentiary overkill was unnecessary, relying on *Union Electric Supply Co Ltd v Registrar of Trade-Marks* (1982), 63 C.P.R. (2d) 56 for support.

[47] There is no evidence that the Mark appeared on the Goods themselves or their packaging. This is true of the initial transfer of the Goods from the Owner to its retailers, as well as the transfer from retailers to consumers. The issue in this case is, therefore, whether the evidence shows that the display materials sufficiently associated the Mark with the Goods at the time of transfer of the property in or possession of those Goods.

[48] The display of a trademark on signage in close proximity to the goods at the time of transfer of property or possession may, under some circumstances, satisfy the requirements of section 4(1) of the Act. While promotional in nature, the display materials in evidence are obviously also informational; for example, they reference available colour and size selections as well as provide facts involving texture and other characteristics of the flooring product.

[49] While it would have been preferable for Mr. Courey to provide a more comprehensive explanation of how the Goods were associated with the display materials when the property in or possession of the Goods was transferred to consumers, I will again make reasonable inferences about the

Owner's evidence. In doing so I find that the nature of the Owner's waterfall displays, hand boards and chain sets contemplates an interactive experience at the time of purchase, minimally to select amongst the various available colours and plank sizes.

[50] Noting that each case is unique and must be considered on its own merits, I find the Owner's reliance on waterfall displays and hand board chain sets suggests more engagement with the materials than would be the case in respect of many other types of promotional materials, such as pamphlets merely advertising the availability of goods. The situation is, therefore, less like that of *BMW* and more analogous to the appearance of a trademark on coupons used in association with "shelf-talkers" as was the case *General Mills Canada Ltd v Procter & Gamble Inc (1985)*, 6 C.P.R. (3d) 551 (TMOB)(*General Mills*) or on display cases containing the product that required unlocking for consumer purchase as was the situation in *Canadian Council of Professional Engineers v Randolph Engineering Inc (2001)*, 19 CPR (4th) 259 at 262 (TMOB) (*Randolph*). The facts associated with *General Mills* and *Randolph* suggest a degree of customer involvement with display materials that is similar to the present situation. Therefore, had the manner of use of the Mark not resulted in the loss of its identity as discussed above, I would have found that the manner of use satisfied the requirements of section 4(1) of the Act.

No Special Circumstances Excusing Non-Use

[51] There is no evidence of special circumstances that could excuse the non-use of the Mark in association the Goods, nor have the parties argued this.

DISPOSITION

[52] 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 expunged.

Coleen Morrison
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-10-28

APPEARANCES

For the Requesting Party: Lawrence Chan

For the Registered Owner: Mark Hanna

AGENTS OF RECORD

For the Requesting Party: Oyen, Wiggs & Mutala LLP

For the Registered Owner: Mark Hanna