



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 109

Date of Decision: 2025-05-13

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Cabinet Juridique St. Lawrence SENCRL St. Lawrence
Law Firm LLP

Registered Owner: Sherwin-Williams Canada Inc.

Registration: TMA102,457 for WOODCRAFT

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. TMA102,457 for the trademark WOODCRAFT (the Mark), owned by Sherwin-Williams Canada Inc. (the Owner).

[2] The Mark is registered for use in association with “stain finish and shake and sidewall finish” (the Registered Goods).

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

PROCEEDING

[4] At the request of Cabinet Juridique St. Lawrence SENCRL St. Lawrence Law Firm LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on June 14, 2024.

[5] The notice required the Owner to show whether the Mark had been 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 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 June 14, 2021, to June 14, 2024.

[6] The relevant definition of “use” in the present case is set out in section 4(1) 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.

[7] 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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448]. The evidence need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act, by supplying facts from which a conclusion of use may follow as a logical inference [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at paras 2, 9, 11].

[8] Where a registered owner does not show use of the trademark, the registration is liable to be expunged or amended pursuant to section 45(3)

of the Act, unless the absence of use was due to special circumstances that excuse it.

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Kaleigh McKinnon, Customer Marketing Manager at the Owner, sworn on November 8, 2024.

[10] Only the Owner filed written representations. No hearing was held.

EVIDENCE AND ANALYSIS

[11] Ms. McKinnon explains that the Owner has several divisions, each operating under a different trade name. The Diversified Brands division of the Owner is responsible for the production, marketing, and sale of the WOODCRAFT Goods [para 6].

[12] Ms. McKinnon defines "the WOODCRAFT Goods", referred to throughout her affidavit, as corresponding to the Registered Goods [para 2].

[13] Ms. McKinnon states that the Owner has used the Mark during the relevant period in association with the WOODCRAFT Goods by displaying the Mark on the labelling; on invoices accompanying the shipment of these goods to customers and distributors in Canada; at point of sale; on informational literature and instruction guides [para 7].

[14] Ms. McKinnon provides photographs of a product showing the Mark displayed on the label. She explains that the product shown is "a self priming stain and sealer for use on new or previously stained wood [sic] surfaces". The product "is recommended for use on wood siding, fences, decks, trim and outdoor furniture, but is also suitable and often used on, exterior wood shake surfaces, including walls and roofs". Ms. McKinnon confirms that the photographs are representative of how the Mark was used

on the labels of the WOODCRAFT Goods during the relevant period [paras 8-9, Exhibits A1-A2].

[15] Ms. McKinnon also provides copies of invoices which she attests pertains to the sales and shipments of WOODCRAFT Goods to customers in Canada during the relevant period [para 11, Exhibit B]. I note that both exhibited invoices, respectively dated August 9, 2023 and August 23, 2022, were issued by the Owner to customers in Canada.

[16] I find the evidence is sufficient for the Owner to meet its burden in this proceeding. I am therefore satisfied that the evidence establishes use of the Mark, within the meaning of sections 4(1) and 45, in association with the Registered Goods.

DISPOSITION

[17] 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.

Céline Tremblay
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

No hearing held.

AGENTS OF RECORD

For the Requesting Party: Cabinet Juridique St. Lawrence S.E.N.C.R.L.

For the Registered Owner: Osler, Hoskin & Harcourt LLP