



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 130
Date of Decision: 2016-07-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Beauvais, Truchon S.E.N.C.R.L.

Requesting Party

and

Tarkett Inc.

Registered Owner

TMA769,971 for EXPRESSIONS

Registration

[1] At the request of Beauvais, Truchon s.e.n.c.r.l. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on December 12, 2014 to Tarkett Inc. (the Owner), the registered owner of registration No. TMA769,971 for the trade-mark EXPRESSIONS (the Mark).

[2] The Mark is registered for use in association with the following goods: “Flooring, namely, vinyl composition tiles.”

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of 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 such use since that date. In this case, the relevant period for showing use is between December 12, 2011 and December 12, 2014.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act:

4(1) A trade-mark 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.

[5] 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar’s notice, the Owner furnished the declaration of Joseph Jared, sworn on March 3, 2015 in Houston, Texas. Only the Owner filed written representations; an oral hearing was not requested.

The Owner’s Evidence

[7] In his declaration, Mr. Jared attests that he is the Vice President Business Development of Tarkett USA Inc., a subsidiary of the Owner. He attests that the Owner designs, manufactures, and sells flooring products in Canada. Specifically, he attests that the Owner produces, among other products, vinyl composition tiles for use in flooring. He attests that, during the relevant period, the Owner sold such tiles to customers in association with the Mark. In this respect, Mr. Jared states that the Mark is displayed on labels attached to the vinyl tiles when sold.

[8] Mr. Jared further attests that, during the relevant period, customers in Canada were able to view and order the Owner’s products through a catalogue and online, including via the Owner’s website, www.tarkettna.com/expressions.

[9] In support of the foregoing, Mr. Jared provides the following exhibits attached to his declaration:

- Exhibit 1 consists of pages from a 2013 catalogue produced by the Owner. Mr. Jared attests that this catalogue was used by the Owner during the relevant period to sell its vinyl tiles to prospective purchasers in Canada, specifying that customers used these

catalogues when placing orders to choose colours, finishes, and technical specifications. The Mark is displayed prominently throughout the catalogue.

- Exhibit 2 is a picture of what Mr. Jared attests is a sample vinyl composition tile sold by the Owner. A label on the top of the tile displays the Mark prominently. Mr. Jared attests that this is representative of how the Mark was displayed on the registered goods in Canada during the relevant period.
- Exhibit 3 consists of 28 screenshots of webpages from various websites, including the Owner’s website. The screenshots display advertisements and consumer information regarding the Owner’s tiles, as well as online order forms. The Mark is prominently displayed throughout the exhibited webpages. Mr. Jared confirms that these webpages were available for access in Canada during the relevant period.
- Exhibit 4 consists of a copy of an invoice which Mr. Jared states is for products sold in association with the Mark. It is dated within the relevant period and invoiced to a Canadian address. The invoice provides a brief description of the good sold, namely “TKT EXPRESS REF WHT/MULTI/1320” alongside the quantity sold and the product price. Although the Mark is not displayed in its entirety on the invoice, I note that the product description corresponds to a particular EXPRESSIONS floor tile appearing in the catalogue pages at Exhibit 1.

Analysis

[10] In its representations, the Owner submits that the evidence of Mr. Jared clearly demonstrates use of the Mark in association with the Owner’s vinyl composition tiles through the exhibited advertising, order forms, catalogues, invoices, and labeling.

[11] Generally, display of a trade-mark on catalogues and other order forms may be considered use for the purposes of section 4(1) of the Act when the evidence also shows that the trade-mark was brought to the attention of the consumer at the time the goods are transferred [see, for example, *Timothy’s Coffees of the World Inc v Starbucks Corp* (1997), 79 CPR (3d) 147 (TMOB)]. In this case, the product description in the exhibited invoice corresponds to a

particular EXPRESSIONS tile shown in the exhibited webpages and catalogue, which customers used for ordering.

[12] In any event, the evidence shows that the Mark appeared on the registered goods at the time of transfer by way of labels on the tiles. The representative evidence of transfers provided by the exhibited invoice is sufficient to demonstrate that transfers of such goods bearing the Mark occurred in Canada during the relevant period.

[13] As such, 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

[14] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Simon Lemay

For the Registered Owner

Beauvais, Truchon s.e.n.c.r.l.

For the Requesting Party