



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

Citation: 2015 TMOB 100
Date of Decision: 2015-06-03

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Daubert Chemical Company, Inc. against
registration No. TMA162,708 for the trade-mark SACI in
the name of Stoney Creek Technologies L.L.C.**

[1] At the request of Daubert Chemical Company, Inc., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on June 10, 2013, to Stoney Creek Technologies L.L.C. (the Owner), the registered owner of registration No. TMA162,708 for the trade-mark SACI (the Mark).

[2] The Mark is registered for use in association with the goods “rustproofing compound”.

[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 June 10, 2010 and June 10, 2013.

[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), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Owner filed the affidavit of Samuel C. Thomas, President of the Owner, sworn on December 6, 2013. Neither party furnished written representations; an oral hearing was not held.

[7] In his affidavit, Mr. Thomas attests that, during the relevant period, the Owner commercialized SACI rustproofing compound through its sole licensee, SCT Additives. He explains that SACI rustproofing compound was sold in 55 gallon and 255 gallon containers, referred to as “totes”. Canadian customers would place orders for the compound through SCT Additives, which would then contact its manufacturer, TRU Custom Blends, to manufacture the necessary quantity. The manufacturer would apply labels bearing the Mark and the Owner’s name and then ship the compound from the U.S. to the customer in Canada.

[8] Mr. Thomas confirms that, as President of both the Owner and its licensee, he ensured that all SACI rustproofing compound manufactured by TRU Custom Blends and marketed by SCT Additives was made pursuant to and according to the Owner’s proprietary formula and specifications. He attests that, for each lot of compound produced during the relevant period, the manufacturer was required to provide a certificate of analysis to both the Owner and the ultimate customer.

[9] As for actual sales of SACI rustproofing compound, Mr. Thomas estimates that SCT Additives’ gross Canadian sales totalled approximately \$100,000USD during the relevant period.

[10] In support of the foregoing, Mr. Thomas attaches the following exhibits to his affidavit:

- Exhibit ST-1 is a sample label that Mr. Thomas attests is representative of labels used on totes of SACI rustproofing compound during the relevant period. The Mark appears prominently on the label.
- Exhibit ST-2 consists of photographs of SACI totes that are representative of how the aforementioned label was applied to the totes during the relevant period.
- Exhibit ST-3 are seven representative bills of lading that Mr. Thomas attests show shipments of SACI rustproofing compound from TRU Custom Blends to customers in Canada. The bills are all dated within the relevant period.
- Exhibit ST-4 consists of representative North American Free Trade Agreement Certificate of Origin documents for SACI rustproofing compound for the years 2012 and 2013. Consistent with Mr. Thomas' description of the compound's marketing and manufacture, SCT Additives is identified as the exporter, TRU Custom Blends is identified as the producer and a Canadian customer is identified as the importer of the compound.
- Exhibit ST-5 consists of three representative invoices that Mr. Thomas attests show sales of SACI rustproofing compound from SCT Additives to customers located in Canada during the relevant period.
- Exhibit ST-6 consists of various certificates of analysis that Mr. Thomas attests are representative of certificates issued by TRU Custom Blends for batches of SACI rustproofing compound sold in Canada during the relevant period.

[11] In view of the evidence of display of the Mark combined with the evidence of sales and transfers in Canada in the normal course of trade, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods during the relevant period within the meaning of sections 4(1) and 45 of the Act.

Disposition

[12] Accordingly, 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.

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