



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

Citation: 2017 TMOB 16
Date of Decision: 2017-02-14

IN THE MATTER OF A SECTION 45 PROCEEDING

9158-1298 Quebec Inc.

Requesting Party

and

Caplan Industries Inc.

Registered Owner

TMA358452 for TASK & Design

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA358452 for the trade-mark TASK & Design as illustrated below, owned by Caplan Industries Inc. (the Owner):



(the Mark).

[2] The Mark is registered for use in association with hand tools (the Goods).

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

The Proceeding

[4] On January 20, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to the Owner of the Mark. The notice was sent at the request of 9158-1298 Quebec inc. (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between January 20, 2012 and January 20, 2015 (the Relevant Period), in association with each of the registered goods. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[6] Section 4(1) of the Act sets out the relevant definition of “use” in association with goods:

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.

[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 clearing the register of “deadwood”. Mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. The criteria for establishing use are not demanding [see *Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)] and an overabundance of evidence is not necessary [see *Union Electric Supply Co v Canada (Registrar of Trade-Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the Mark was used in association with each of the registered goods specified in the registration [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[8] In response to the Registrar’s notice, the Owner filed the affidavits of Christopher Waldner, director of product management and marketing for the Owner, sworn on August 19,

2015 and Dulce Campos, employed by the Owner's agent as a trade-mark researcher sworn on August 20, 2015.

[9] Only the Owner filed written representations and was present at the hearing.

The Evidence

[10] Ms. Campos conducted, at the request of an agent acting as the Owner's agent, an online search of the on-line WayBackMachine's Internet Archive for the address <http://www.task-tools.com> for the years 2012, 2013, 2014 and 2015. She attaches the results for 2012 as Exhibits 1 to her affidavit. The Mark appears on one of the pages attached to her affidavit.

[11] Mr. Waldner states that he has been employed by the Owner since 2006. He makes a bald statement that he believes that the Mark has been used by the Owner in Canada during the Relevant Period in association with the Goods. I may add that such statement is a conclusion in law. The Registrar must determine such issue in light of the evidence described below.

[12] Mr. Waldner attaches as Exhibit 2 a colour photograph showing hand tools, namely trowels on which appears the Mark on the handle, together with representative examples of copies of actual invoices taken from the years 2012 through 2014, which confirm trowels bearing the Mark have been sold by the Owner in Canada during the Relevant Period.

[13] Mr. Waldner produced similar evidence (photograph showing the particular hand tool and representative examples of copies of invoices) for other hand tools such as hand saw (Exhibit 3), taping knife (Exhibit 4), 'C' clamp (Exhibit 5) and tube cutters (Exhibit 6). The Mark appears on each of these hand tools.

[14] Mr. Waldner provides the annual cost for advertising expenses incurred by the Owner for all of its products and states that almost all of such funds were used for print advertising associated with the Mark. He adds that almost all the advertising is done on a co-op basis with its customers and he provides an example of such co-op advertising in the form of flyers published during the Relevant Period (Exhibit 7).

[15] Mr. Waldner concludes his affidavit by providing a list of trade shows held in Canada to which the Owner participated and during which the Mark had been displayed prominently.

Analysis

[16] As noted above, the Requesting Party did not file any written submissions nor was present at the hearing.

[17] I am satisfied that the evidence described above establishes use of the Mark by the Owner in Canada in association with the Goods during the Relevant Period.

Conclusion

[18] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration No. TMA358452 will be maintained on the register.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2017-02-09

APPEARANCES

Ms. Trisha A. Doré

FOR THE REGISTERED OWNER

No one appearing

FOR THE REQUESTING PARTY

AGENT(S) OF RECORD

Accupro Trademark Services

FOR THE REGISTERED OWNER

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FOR THE REQUESTING PARTY