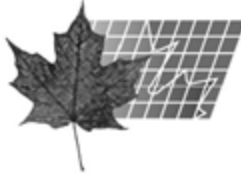


OPIC



CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 75

Date of Decision: 2017-06-25

IN THE MATTER OF A SECTION 45 PROCEEDING

Osler, Hoskin & Harcourt LLP

Requesting Party

and

Multibond Inc.

Registered Owner

TMA340,280 for MULTI-BOND

Registration

[1] At the request of Osler, Hoskin & Harcourt LLP (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 October 9, 2014 to Multibond Inc. (the Owner), the registered owner of registration No. TMA340,280 for the trade-mark MULTI-BOND (the Mark).

[2] The Mark is registered for use in association with the following goods:

Floor tile cement and adhesives, namely: roofing cements, wood adhesives, flooring adhesives, ceramic tile adhesives, fabric adhesives, epoxy, bonding agents for concrete and plaster and resins.

[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 October 9, 2011 and October 9, 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].

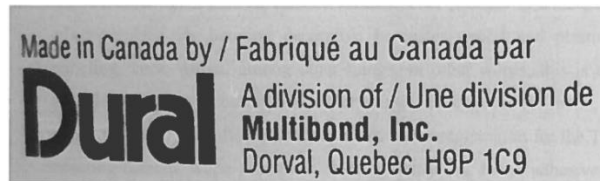
[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Domenic Scozzafava, sworn on July 8, 2015. Both parties filed written representations. A hearing was not requested.

THE OWNER’S EVIDENCE

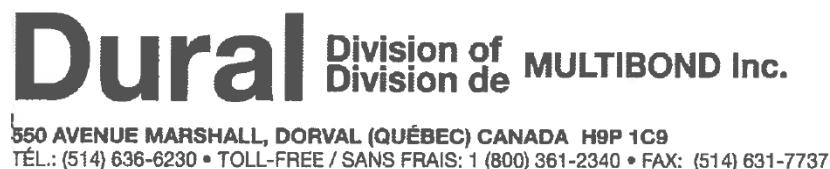
[7] In his affidavit, Mr. Scozzafava states that he is the Chief Financial Officer and Secretary, as well as a Director, of the Owner. He states that the Owner or a predecessor-in-title has continuously used the Mark in association with the registered goods in Canada since 1983. With respect to the relevant period, he attests that the Owner sold its goods bearing the Mark to independent retailers or wholesalers in Canada, including Canadian Tire, Rona and Réno-Dépôt. In support of his statements, Mr. Scozzafava attaches to his affidavit the following exhibits:

- Exhibit B consists of a photocopy of a receipt showing the purchase of goods identified as “adhesive, multi” and “adhesive, cerme” from a Canadian Tire store located in Ontario on February 20, 2014. Mr. Scozzafava identifies these products as DURA PRO AF 0044 a ceramic tile adhesive and DURA PRO AF 0036 a soft floor covering adhesive.

Exhibits C and D consist of several photographs depicting front and back views of a ceramic tile adhesive (DURA PRO AF 0044) and a soft floor covering adhesive (DURA PRO AF 0036). At the bottom of the label on the back of the packaging, Multibond, Inc. appears as part of the text Made in Canada by / Fabriqué au Canada par Dural A division of / Une division de Multibond, Inc. as set out below this paragraph. With respect to such labels, Mr. Scozzafava asserts that “Multibond, Inc.” is bolded and set apart from the text “above and below”. With the exception of private label packaging, he confirms that this information, in this format, appears on every Multibond good sold in Canada.



- Exhibit E consists of Invoice No. 259721 dated September 24, 2014 showing sales of various cements and adhesives from the Owner to a Rona store in Quebec which was to be picked up on September 23, 2014. One of these adhesives is DURA PRO AC2839 which is a latex contact cement and can be used as a fabric adhesive. Further information about some of these cements and adhesives is found in Exhibits F through I, described below. The following is displayed at the top of each invoice page:



- Exhibits F and G consists of excerpts from technical documents entitled “Work Instruction. Retail Product.” The documents are dated October 7, 2014 and provide photographs as well as information relating to the products described as woodworker glue (DURA PRO AW 2300) and concrete weld (DURA PRO AC 0616). Mr. Scozzafava correlates the concrete weld with the registered good “bonding agent for concrete”. As well, both products are described as a type of “resin” on their respective labels. Moreover, the products display the portion of the label reproduced above and appearing in Exhibits C and D.

- Exhibits H and I consist of several photographs of front and back views of the products woodworker’s glue (DURA PRO AW 2300) and contact cement (DURA PRO AC 1920), respectively. Mr Scozzafava describes the contact cement as a “multi-use adhesive that can be used on wood, plywood, particle boards or metal”. As such, he correlates this product to the registered goods “roofing cements, wood adhesives, flooring adhesives” and “fabric adhesives”. Again, both products display the portion of the label reproduced above.
- Exhibit J consists of Invoice No. 258248 dated July 25, 2014 showing sales of three goods that Mr Scozzafava describes as “floor adhesives”. The invoice shows sales from the Owner to a Rona store located in Quebec with the products being shipped to a different address in Quebec. In particular, the invoice identifies each good as a DURA PRO product and provides, for each, the product codes AF 0032, AF 8839 and AF 2130. The same text appearing at the top of the invoice at Exhibit F, reproduced above, is also displayed on this invoice in the same format.
- Exhibits K and L consist of several photographs of front and back views of two DURA PRO products identified with product codes AC 0055 and AC 0054. Mr. Scozzafava states that these products may be described as a “construction and panel adhesive which may be used [as] a wood adhesive or flooring adhesive”, and as “a foamboard adhesive which can be used as a wood adhesive” He confirms that both products were sold in Canada during the relevant period. Again, the products display the label reproduced above.

ANALYSIS

[8] In a section 45 proceeding, sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

No Use of the Mark With Epoxy and Bonding Agents for Plaster

[9] Although Mr. Scozzafava asserts use of the Mark with respect to all of the registered goods, the exhibits are silent with respect to the registered goods “epoxy” and “bonding agents ... for plaster”. Furthermore, Mr. Scozzafava does not correlate any of the products appearing in the exhibits with these two goods. As such, there does not appear to be any evidence of transfers of these goods in the normal course of trade during the relevant period. Finally, the Owner’s written representations do not address these goods. As there is no evidence of special circumstances excusing non use of the Mark before me with respect to these goods, they will be deleted from the registration.

Use of the MULTI-BOND INC. With the Remaining Goods

[10] With respect to the remaining goods, Mr. Scozzafava provides evidence of sales of products bearing “MUTLI-BOND, INC.” on their packaging. While the description of the goods on the labels does not correlate precisely with the statement of goods, given the context of section 45 proceedings and in the absence of representations of the requesting party on this point, I accept that Mr. Scozzafava’s statements in combination with the exhibits featuring each of the products (as particularized in brackets) as sufficient proof of use of the following registered goods: roofing cements (Exhibit I; DURA PRO AC 1920;) wood adhesives (Exhibit K; DURA PRO AC 0055) flooring adhesives (Exhibit D; DURA PRO AF0036); ceramic tile adhesives (Exhibit C; DURA PRO AF0044); fabric adhesives (Exhibit E; DURA PRO AC 2389); bonding agents for concrete (Exhibit F; DURA PRO AC0616) and resins (Exhibit H; AW 2300).

[11] Therefore, it follows that if I accept that use of MUTLI-BOND INC. as it appears in the evidence is use of the Mark, the registration will be maintained with respect to the registered goods (with the exception of epoxy and binding agents for plaster).

The Requesting Party’s Submissions

[12] The Requesting Party submits that any display of “Multibond” on the labels and invoices, as reproduced above, constitutes use of the trade-name of the Owner rather than use of a trade-mark. In this respect, it submits the following:

- (a) “Multibond” is presumed use as a trade-name because it is part of the company name “Multibond Inc”.
- (b) “Multibond” does not stand out from the abbreviation “Inc.” or any other information relating to the company address of the Owner.
- (c) The significantly larger, stylized and more distinct element “Dural” supports the position that the average person would perceive “Multibond” as a trade-name and “Dural” as a trade-mark. In support, the Requesting Party refers to and cites *Blake Cassels & Graydon v Seanix Technology Inc*, 2007 CarswellNat 2168 (TMOB).

[13] The Requesting Party further submits that even if I accept that the Mark appears on the invoices, there is no evidence that the invoices were received by the buyers or accompanied the goods at the time of transfer.

The Owner’s Submissions

[14] In response, the Owner submits that “Multibond”, as displayed on the goods and invoices, is set apart from the surrounding corporate information by appearing on a separate line in bold or in upper case characters. Furthermore, the Owner notes that nothing prohibits the simultaneous appearance of multiple trade-marks on a single product [*AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (FCTD)].

[15] While the DURAL trade-mark is clearly the most prominent trade-mark appearing on the back of the label, I agree with the Owner. In this case, with respect to the appearance of “Multibond, Inc.” on the labels, there is no prohibition against multiple trade-marks and I accept that customers would perceive Multibond Inc. as both a trade-name and a trade-mark [see *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB) at para 14 which confirms trade-mark and trade name usage are not necessarily mutually exclusive]. In this respect, “Multibond, Inc” appears in bold, is set apart from the address and appears in a portion of the label which is visually interesting (in that it is set apart from the rest of the label which is largely a single block of continuous text).

[16] Indeed, especially in the limited context of a section 45 proceeding, it is hard to conclude that the Owner's name was not used for the purpose of "distinguishing ... goods manufactured by him from those ... manufactured by others" within the meaning of "trade-mark" per section 2 of the Act.

[17] As such, the issue in this case is whether display of "Multibond, Inc" constitutes display of the Mark as registered. In applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear* (1992), 44 CPR (3d) 59 (FCA), I consider the addition of the descriptive matter "Inc." and the absence of a hyphen between MULTI and BOND, to be only minor deviations from the Mark as registered.

[18] With respect to *Seanix, supra*, relied upon by the Requesting Party in support of its submissions that MULTIBOND Inc. would be perceived as a trade-name, I do not find that the Registrar's determination that use of the phrase "Design and Assembled by SEANIX IN CANADA" alongside another trade-mark did not support that SEANIX was being used as a trade-mark to be determinative as *Consumers Distributing Co/Cie Distribution aux Consommateurs, supra* confirms that trade-mark and trade-name is not necessarily mutually exclusive.

[19] With respect to the invoices, I do not find that these are evidence of use of the Mark in association with the goods pursuant to section 4(1) of the Act because it is not clear that they were shipped or otherwise accompanied the goods at the time of transfer. In this respect, Invoice No. 259721 was printed after the pick up date and Invoice No. 258248 shows the goods as being shipped to a different address than the purchaser (leaving me in a state of doubt as to who would have received the invoice).

[20] Accordingly, in view of the labels and evidence of sales provided by the Owner, I am satisfied that the Owner has demonstrated use of the Mark in association with the following goods within the meaning of sections 4 and 45 of the Act:

Floor tile cement and adhesives, namely: roofing cements, wood adhesives, flooring adhesives, ceramic tile adhesives, fabric adhesives, bonding agents for concrete and resins.

DISPOSITION

[21] In view of all of the foregoing, 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 amended to delete the registered goods “epoxy” and “[bonding agents for] ... plaster”.

[22] The amended statement of goods will read as follows:

Floor tile cement and adhesives, namely: roofing cements, wood adhesives, flooring adhesives, ceramic tile adhesives, fabric adhesives, bonding agents for concrete and resins.

Natalie de Paulsen
Member
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

Dimock Stratton LLP

FOR THE REGISTERED OWNER

Osler, Hoskin & Harcourt LLP

FOR THE REQUESTING PARTY