



LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 72

Date of Decision: 2017-06-21

IN THE MATTER OF A SECTION 45 PROCEEDING

McDougall Gauley LLP

Requesting Party

and

Titan Freight Systems

Registered Owner

TMA738,477 for

Registration

TITAN FREIGHT SYSTEMS

[1] At the request of McDougall Gauley 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 January 2, 2015 to Titan Freight Systems (the Owner), the registered owner of registration No. TMA738,477 for the trade-mark TITAN FREIGHT SYSTEMS (the Mark).

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

- (1) Freight transportation by truck and air.
- (2) Freight transportation by truck.

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the services specified in the registration, at any time between January 2, 2012 and January 2, 2015. 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.

[4] The relevant definition of “use” in association with services is set out in section 4(2) of the Act as follows:

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], the registered owner must still establish a *prima facie* case [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428]. In this respect, 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 and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of its President, Keith D. Wilson, sworn on May 26, 2015, in Clackamas, Oregon. Only the Owner filed written representations; a hearing was not requested.

THE OWNER’S EVIDENCE

[7] In his affidavit, Mr. Wilson states that the Owner is a “shipping and transportation solutions company with roots dating back to 1968 in Portland, Oregon.” He states that the Owner provides the registered services in the normal course of its trade, which includes shipping goods to and from Canada “on a regular basis”. He states that the Owner has used the Mark in association with the registered services in the United States since 1998 and in Canada since 2009.

[8] With respect to the relevant period, Mr. Wilson explains that the Owner used the Mark in association with the registered services by displaying the Mark “on trucks that delivered goods into Canada”. In support, Mr. Wilson attaches the following exhibits to his affidavit:

- Exhibit B consists of three photographs, which Mr. Wilson attests are representative of the Owner’s trucks “operating in Canada”. He states that the photographs were taken in British Columbia during the relevant period. Each photograph depicts a portion of a truck approaching a highway sign that reads “Vancouver”. Two of the photographs show the Mark displayed on the truck’s cab; the third photograph shows the Mark displayed on the side wall of the truck’s cargo area.
- Exhibit C is a spreadsheet, which Mr. Wilson attests shows “exemplary” dates of delivery of goods into Canada in trucks bearing the Mark as depicted in Exhibit B. Mr. Wilson explains that the spreadsheet identifies dates on which the Owner transported goods for an Oregon client to a company located in Surrey, British Columbia. The spreadsheet contains dozens of entries, all dated during the relevant period, providing various shipping particulars for a “consignee” in Surrey.
- Exhibit D consists of two bills of lading and one shipping order, which Mr. Wilson states “corroborate some of the information” in the spreadsheet at Exhibit C. All three documents are dated during the relevant period and reference the delivery of various paint products to an address in Surrey. The “delivering carrier” is identified as “Titan”, which Mr. Wilson confirms refers to the Owner.

ANALYSIS

[9] Mr. Wilson makes a clear assertion of use of the Mark in Canada in association with the transportation of goods by truck, supported by representative photographs of the Mark displayed on such a truck, and corroborated by documentation for Canadian deliveries during the relevant period. In view of Mr. Wilson’s statements and the supporting exhibits, I am satisfied that the Owner has demonstrated use of the Mark in Canada in association with “freight transportation by truck” during the relevant period.

[10] However, I consider the evidence insufficient to demonstrate use of the Mark in association with “freight transportation by ... air”. In this respect, Mr. Wilson specifically states that the Mark was used by having it “appear on trucks that delivered goods”. Mr. Wilson does not mention display of the Mark on aircraft or otherwise in connection with delivery by air. Indeed, other than listing the registered services, Mr. Wilson makes no reference to transportation by air whatsoever. The logical inference from Mr. Wilson’s silence on this point is that the Owner did not actually offer freight transportation by air in Canada during the relevant period.

[11] In its written representations, the Owner “invites the Registrar to request supplementary evidence” from the Owner, in the event that the Registrar “is of the view that the evidence is unclear or insufficient”. The Owner submits that “such additional evidence may assist in ensuring that a trade-mark that is clearly and properly used by the Registered Owner is properly maintained on the Register in association with all relevant services”. In support, the Owner cites three instances where the Registrar purportedly gave a registered owner the opportunity to supplement “deficient” evidence prior to the submission of written representations: *Re Lipton’s Fashion Wear Ltd* (1974), 29 CPR (2d) 141 (TMOB); *John Labatt Ltd v The Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD); and *Dennison Associates v Mundo Enterprises Ltd*, 1993 CarswellNat 2601 (TMOB).

[12] However, section 45 of the Act does not contemplate the filing of “reply” evidence or requesting leave to file “further” evidence [see *GMAX World Realty Inc v RE/MAX, LLC*, 2015 TMOB 169, 2015 CarswellNat 4605]. Rather, section 45 proceedings are intended to be simple, summary and expeditious in nature [see *Burke-Robertson v Carhartt Canada Ltd* (1994), 56 CPR (3d) 353 (FCTD); *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. Permitting a registered owner to split its case in the manner proposed by the Owner would be contrary to the intent and scope of a section 45 proceeding. Accordingly, it is not the Registrar’s practice to request “supplementary evidence” from an owner before rendering a decision, and no such request will issue in the present case.

[13] In view of the foregoing, I am only satisfied that the Owner has demonstrated use of the Mark in association with the registered service “freight transportation by truck” within the

meaning of sections 4(2) and 45 of the Act. As the Owner has provided no evidence of special circumstances excusing non-use of the Mark in association with “freight transportation by ... air”, the registration will be amended accordingly.

DISPOSITION

[14] In view of all 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 “...and air” from services (1).

[15] The amended statement of services will read as follows:

- (1) Freight transportation by truck.
- (2) Freight transportation by truck.

Oksana Osadchuk
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No Hearing Held

AGENT(S) OF RECORD

Norton Rose Fulbright Canada

FOR THE REGISTERED OWNER

McDougall Gauley LLP

FOR THE REQUESTING PARTY