



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

Citation: 2017 TMOB 142

Date of Decision: 2017-10-18

IN THE MATTER OF A SECTION 45 PROCEEDING

Gowling Lafleur Henderson LLP

Requesting Party

and

Parkland Industries Ltd.

Registered Owner

**TMA760,963 for YOUR EXPRESS
MART**

Registration

[1] At the request of Gowling Lafleur Henderson LLP, 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 11, 2016 to Parkland Industries Ltd. (the Owner), the registered owner of registration No. TMA760,963 for the trade-mark YOUR EXPRESS MART (the Mark).

[2] The Mark is registered for use in association with the following services: “Operation of convenience stores”.

[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 services 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 use since that date.

[4] In this case, the relevant period for showing use is January 11, 2013 to January 11, 2016.

[5] The definition of use with respect to 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.

[6] 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].

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Tariq Remtulla, Legal Counsel for the Owner, sworn on April 7, 2016 in Calgary. Only the Owner filed written representations; a hearing was not requested.

[8] As part of its written representations, the Owner filed a second affidavit of Mr. Remtulla. However, as it was filed after the registered owner’s deadline for furnishing evidence, it was not made of record as evidence in this proceeding and will not be considered as such.

THE OWNER’S EVIDENCE

[9] In his original affidavit, Mr. Remtulla states that the Owner owns numerous gas stations in Canada and authorizes independent retail operators to operate the convenience stores located within these gas stations. He attests that the Mark is used under license by convenience store retail operators and that the Owner has direct or indirect control of the character or quality of the services in accordance with a written “Operator Agreement” between the Owner and the retail operator.

[10] Mr. Remtulla further attests that these convenience stores were branded with the Mark between the years 2007 to 2015 and that such convenience stores remain branded with the Mark. With respect to the registered services, Mr. Remtulla explains that the Owner’s licensees have generated significant sales in the operation of these convenience stores in Canada in association with the Mark during the relevant period. Mr. Remtualla states that from January 2013 to December 2015, total sales from the convenience store locations that had been branded or rebranded to “YOUR EXPRESS MART” by January 2013 was in excess of \$50,500,000.

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

- Exhibit A is an excerpt from the Operator Agreement, specifically the section addressing the “Occupation and Use of Licensed Premises”. As detailed by Mr. Remtulla, the Agreement sets out various provisions relating to the Owner’s control over convenience store services offered in association with the Mark, *e.g.*, that the Operator will pay license fees to the Owner and keep the licensed premises clean in accordance with standards of cleanliness as determined by the Owner.
- Exhibit B consists of 17 photographs of YOUR EXPRESS MART convenience stores located in or alongside Esso and Chevron gas stations. Each photograph is identified by a store number and location in Canada. Mr. Remtulla confirms that the depicted gas stations are owned by the Owner and that the convenience stores are operated by licensees of the Owner. In each case, the Mark is displayed on external signage.
- Exhibit C is a table that lists each convenience store displaying the Mark. As attested by Mr. Remtulla, the table indicates the date when each location was branded with the Mark alongside other identifying information, including site descriptions and addresses. All of the dates indicated are prior to or during the relevant period.

ANALYSIS

[12] In this case, the evidence shows that, during the relevant period, the Owner’s licensees operated convenience stores in Canada displaying the Mark as registered. In the absence of written representations from the Requesting Party, I accept Mr. Remtulla’s statements and supporting exhibits as demonstrating that the registered services were offered in association with the Mark during the relevant period by the Owner’s licensees.

[13] With respect to such licensed use, pursuant to section 50(1) of the Act, for the licensees’ use of the Mark to enure to the benefit of the Owner, the Owner must maintain “direct or indirect control of the character or quality of the goods or services” sold in association with the Mark.

[14] In its written representations, the Owner submits that it has direct or indirect control over the operation of the convenience stores as set out in the “Occupation and Use of Licensed Premises” section of the Operator Agreement.

[15] It has been held that there are three main methods by which a trade-mark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the license agreement that provides the requisite control [see *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248 at paragraph 84].

[16] In this case, Mr. Remtulla provides a clear statement that the owner exercised the requisite control, which is supplemented by the Operator Agreement excerpt in evidence. For purposes of this proceeding, that is sufficient to satisfy section 50(1) of the Act. As such, the demonstrated use of the Mark by the Owner’s licensees constitutes use of the Mark enuring to the benefit of the Owner.

[17] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the services as registered within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[18] 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

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

No Hearing Held

AGENTS OF RECORD

Bennett Jones LLP

For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party