



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 190

Date of Decision: 2023-11-10

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Wilson Lue LLP

Registered Owner: Milton Roy, LLC

Registration: TMA882,208 for DTEX

INTRODUCTION

[1] This decision involves a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA882,208 for the trademark DTEX (the Mark).

[2] The Mark is registered for use in association with “Odorant detection system, namely, detecting instruments for analyzing odorant concentration and odor intensity in natural gas”.

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

PROCEEDING

[4] On January 11, 2022, at the request of Wilson Lue LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act to the registered owner of the Mark, Milton Roy, LLC (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with 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 January 11, 2019 to January 11, 2022.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Steven Hoffmann, the Owner's Managing Director, who held Product, R&D and Engineering Management positions with the Owner for most of the relevant period.

Only the Owner submitted written representations. No oral hearing was held.

EVIDENCE AND ANALYSIS

[7] Steven Hoffmann's evidence is:

- a. The Owner manufactures and sells specialty equipment for pipeline and refinery operators that helps ensure safety of people and the environment, including odorant detection systems [para 4].
- b. The Owner sold the registered goods in association with the Mark in Canada during the relevant period in its normal course of trade, which is by shipping the goods from the Owner's factory located in the USA to purchasers [paras 5, 7, 10 and 11].
- c. Representative photographs illustrating how the Mark was displayed on the registered goods sold in Canada during the relevant period, and more particularly, on what Mr. Hoffmann describes as being "the outer case of the odorant detection system" and its "interior panel" [para 6; Exhibit A].
- d. A "sampling" of three invoices dated within the relevant period and issued by the Owner to Wika Instruments Ltd in Edmonton, Alberta, Canada. The

invoices reference, among other products, “DX-1000G DTEX ODORANT DETECTION SYSTEM” and “MDX-1000G DTEX ODORANT DETECTION SYSTE[M]” [para 9, Exhibit B].

[8] The relevant definition of “use” in association with goods is set out in section 4 of the Act as follows:

4(1) A trademark 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.

[9] Where the Owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[10] 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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 38].

[11] In the present case, the Owner provides three invoices from the relevant period evidencing sales and transfers of odorant detection systems to customers in Canada in the Owner’s normal course of trade. The Owner also provides representative photographs which it correlates with the registered goods, demonstrating how the Mark was displayed on the goods at the time of transfer during the relevant period.

[12] Therefore, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[13] In view of all the above, 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.

Simone Oberacher
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: WILSON LUE LLP

For the Registered Owner: MOFFAT & CO.