



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 44

Date of Decision: 2024-03-12

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Canada Lands Company Limited

Registered Owner: Artem Polukarov

Registration: TMA938,133 for TORONTO SIGNS

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA938,133 for the trademark TORONTO SIGNS (the Mark), which is reproduced below.



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

Goods: Signs

Services: Production, installation and design of signs

(the Goods and Services)

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

PROCEEDING

[4] At the request of Canada Lands Company Limited (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on June 30, 2023, to Artem Polukarov (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the goods and 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 such use since that date. In this case, the relevant period for showing use is June 30, 2020 to June 30, 2023.

[6] The relevant definitions of “use” in the present case are 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.

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

[7] In response to the Registrar’s notice, the Owner furnished his own affidavit, sworn on August 30, 2023, together with Exhibits A to H.

[8] Neither party filed written representations, and no oral hearing was held.

EVIDENCE AND ANALYSIS

[9] Although I have reviewed all of the evidence, this summary focuses on the portions which are relevant to my findings.

[10] In his affidavit, the Owner states that he is a partner of Toronto Signs, an Ontario General Partnership (the Partnership) registered in 2015. He states that he entered into a verbal license agreement with the Partnership, pursuant to which the Partnership is licensed to use the Mark. He further asserts that he directly exerts control over the quality of the Goods and Services associated with the Mark [paras 2 and 6].

[11] The Owner states that the Partnership offers a full range of customizable signages for businesses and other organizations. Among others, the Partnership offers storefront retail signs and outdoor advertising, banners for both indoor and outdoor use, window frosting applications and interior signs, all customizable to specific needs and preferences [para 13].

[12] With respect to the use of the Mark, the Owner asserts that it was used in association with the Goods and Services during the relevant period. In particular, he states that the Mark was displayed on business cards, on product packaging and in website content. Regarding the business cards, the Owner states that the Partnership affixes them to packed signs for pick up or delivery as a regular and consistent practice of its operations [paras 3, 5 and 11].

[13] In support to his statements of use of the Mark in association with the Goods and Services, the Owner provides, as Exhibit C, a 3-page printout of the website *www.toronto-signs.ca* (the Website), which he states is representative of how the Website appeared “over the past three years” [para 9]. The Mark is displayed on the top of the printout. On the second page, I read:

Can you ___? It is a question Toronto Signs gets asked all the time. The majority of the time, the answer is yes, we can. Are you capable of creating a professional reception sign? Yes, we can do it! Is it possible for you to produce custom graphics and pull-up banners? Yes, we can do it! Is it possible for you to cover all of the windows in our office to provide us with some privacy? Yes, we can do it!

[14] As Exhibit E, the Owner provides 11 photographs and excerpts of the Partnership's marketing and operational materials. One of the photographs shows business cards bearing the Mark in a box. Another photograph shows a business card bearing the Mark and a sign's mock-up design affixed to a kraft paper package. The Owner describes this package as being a "packaged signage" [para 11].

[15] Lastly, as Exhibit G, the Owner provides representative copies of invoices issued from 2020 to 2023 by the Partnership to Canadian customers. The Mark is displayed on the top of the invoices, followed by the Partnership's address. Under the description field, the invoice dated November 16, 2022 reads "[t]o design, supply and install a brushed aluminum plaque". The invoice dated May 8, 2023 details the delivery of two signs.

[16] 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. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9].

[17] In the present case, with respect to the Goods, the Owner states that affixing business cards bearing the Mark to the package of signs to be delivered is a regular and consistent practice of the Partnership. Taking this statement at face value [per *Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25], I accept that the photograph of the packed signage in evidence demonstrates how the Mark was displayed on the Goods during the relevant period. Further, as one of the invoices include the delivery of two signs, I conclude that these signs had the business card affixed to their packages at the time of delivery. Therefore, I am satisfied that the Owner, through the Partnership, has demonstrated use of the Mark in association with the Goods in Canada during the relevant period.

[18] As for the Services, the representative printouts of the Website displaying the Mark demonstrate use of the Mark in the advertising of the production, installation and design of signs for most of the relevant period. In addition, the invoice dated November 16, 2022 demonstrates that the Owner, through the Partnership, performed the Services in Canada during the relevant period.

[19] In view of all the above, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered Goods and Services within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[20] Accordingly, 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.

Maria Ledezma
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: Marks & Clerk

For the Registered Owner: No agent appointed