

January 14, 2025

File No.: 558117-14

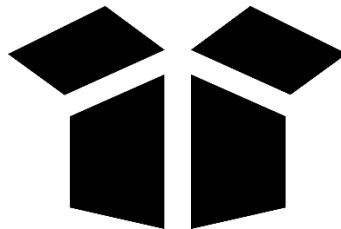
Delivered Via Email

www.partstowncanada.ca
oemhvacpartscanada@gmail.com

To Whom It May Concern:

Re: Infringement of Parts Town's Intellectual Property

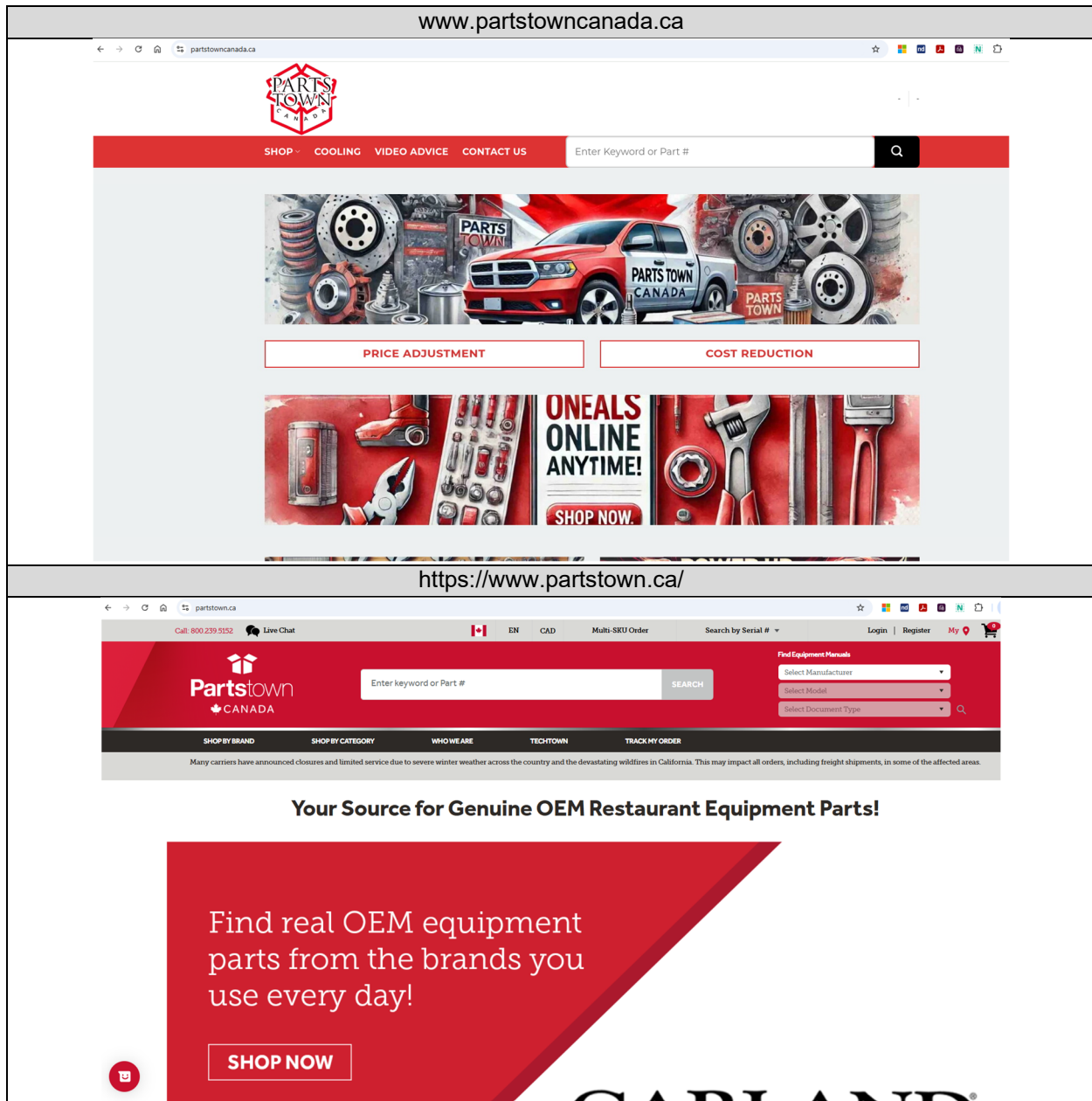
This firm represents Parts Town, LLC ("**Parts Town**") with respect to intellectual property matters. As we believe you are aware, Parts Town is a well-known retailer of commercial and industrial parts and equipment, and several wraparound services including technical support, warehousing and delivery services associated with same. For over twenty years, Parts Town has continuously used the mark PARTSTOWN (the "**PARTSTOWN Mark**"), both alone, and in combination with certain other words and/or designs, including the "open box logo" shown immediately below (the "**Open Box Logo**"), in Canada (and internationally) to signify its goods and services (collectively, the "**Parts Town Branding**").



In connection with its longstanding and continuous use of the Parts Town Branding in Canada, Parts Town has expended invested substantial time, effort, and resources over the course of many years in growing its business under the Parts Town Branding, and thus has developed a valuable portfolio of intellectual property surrounding same, the goodwill in which rightfully belongs exclusively to Parts Town. Among other Canadian trademark registrations, Parts Town is the owner of Canadian Trademark Reg. No. TMA893182 for the mark PARTSTOWN, which was registered on January 5, 2015. A copy is enclosed for your reference.

Thus, Parts Town was very surprised to discover your website, <https://partstowncanada.ca/>, which appears to replicate, nearly identically, all of the primary components of the Parts Town Branding, including the PARTSTOWN Mark and the Open Box Logo, purportedly to sell directly competitive products and services. The matter is made considerably more concerning because of your use of many elements of the Parts Town Branding in combination, including Parts Town's black, white and red color scheme, because your website appears to have been launched very recently, evidently with full knowledge of the valuable brand recognition that Parts Town has accumulated in the Parts Town

Branding, and because of the fact that your website uses a nearly (and recently registered) identical URL to Parts Town's Canadian website, www.partstown.ca. The similarities are so striking that it is difficult for us to see this as anything other than deliberate copying, to attempt to drive confused consumers to your website. Viewed side by side, it's difficult in a glance to tell that these are different websites:



Our investigation has revealed that you appear to have changed your name, and website, <https://www.oemhvapartscanada.ca/>, fairly recently. Whereas your prior branding included the term “parts”, your new website and branding has migrated directly into the brand identity occupied by Parts

Town. Whatever trademark rights you may have accrued by your prior use of the brand “OemHvacPartsCanada”, these do not translate to your current use of the name Parts Town or Parts Town Canada.

As you may know, in Canada, the owner of a trademark, in this case, Parts Town, has the right to the exclusive use of that mark across the entire country. This right is infringed and passed off by any third party who sells, distributes or advertises goods or services in association with a confusingly similar trademark. The use of a trademark causes confusion with another trademark if the use of both would be likely to lead to the inference that the goods or services associated with the marks are manufactured, sold, leased, hired or performed by the same person or company, whether or not the goods or services are of the same general class.

Your use of the PARTSTOWN Mark undoubtedly will result in consumer confusion and cause Canadian consumers to associate the Parts Town Branding with the marketing and provision of your goods and services. In short, your act of adopting the PARTSTOWN Mark, Open Box Logo, and other aspects of Parts Town’s Branding is wrongful conduct which constitutes trademark infringement, unfair competition, passing off, and dilution in violation of applicable trademark laws. This conduct dilutes and tarnishes the distinctive quality of the well-established Parts Town Branding, which undermines the years of work that Parts Town has invested into building its brand.

Your company’s actions have been undertaken notwithstanding Parts Town’s well-known and prior established rights in the Parts Town Branding. Thus, it appears that your infringing acts are deliberate and willful.

In light of the foregoing, Parts Town demands that you **immediately** do the following:

1. Cease and desist from advertising, offering for sale, or selling any related goods or services under or in conjunction with the PARTSTOWN Mark, the Open Box Logo, any portion of the Parts Town Branding, or any other mark confusingly similar to the Parts Town Branding or which incorporates or otherwise contains the term “town”;
2. Surrender the domain name www.partstowncanada.ca;
3. Delete any and all advertising containing the Parts Town Branding or any other mark confusingly similar to the Parts Town Branding from all websites, social media pages, and/or other platforms with which you are affiliated;
4. Remove all uses of the PARTSTOWN Mark or any other mark confusingly similar to the PARTSTOWN Mark from any and all Google Ads, websites, social media pages, and/or other platforms with which your company is affiliated;
5. Provide Parts Town with a full and complete accounting of all revenues received by your company as a result of its infringement of the Parts Town Branding; and
6. Provide Parts Town with adequate written assurance that your company will hereafter not engage, directly or indirectly, in any other acts of infringement relating to the Parts Town Branding or any other intellectual property belonging to Parts Town.

We require your written agreement to the above demands by no later than the close of business on **January 21, 2025**. In the event that your agreement to same is not secured by that date, Parts Town is willing to pursue legal action to obtain all available remedies. Such action may include, without limitation, a lawsuit for trademark infringement and passing off, including relief for damages, disgorgement and payment to Parts Town of all of your profits, an immediate injunction to cease your use of the Parts Town Branding and any confusingly similar trademarks and/or a proceeding under the Uniform Domain-Name Dispute-Resolution Policy (UDRP) to recapture the domain name www.partstowncanada.ca.

Should the initiation of legal proceedings prove necessary, we will present this letter to the court and seek full compensation from you with respect to the expenses incurred by Parts Town in pursuit of such proceedings, including for costs on an enhanced basis.

This letter is sent without waiver of any claims, causes of action, damages, equitable relief, lawyers' fees, and defenses available to protect Parts Town's intellectual property rights, all of which are hereby fully reserved.

Please direct all future correspondence on this matter to me.

Best regards,

Dentons Canada LLP



Chris B. Zelyas
Partner

CBZ/jt



PARTSTOWN – 1649314

Application number

1649314

Registration number

TMA893182

Type(s)

Word

Category

Trademark

CIPO Status

REGISTERED

TM5 status

LIVE/REGISTRATION/Issued and Active



The trademark application has been registered with the Office.

Filed

2013-10-25

Registered

2015-01-05

Registration Expiry Date

2030-01-05

Registrant**Index headings**

PARTSTOWN

PARTS TOWN

Services (Nice class & Statement)

(1) Computerized on-line ordering services in the field of restaurant equipment parts; Facsimile ordering services in the field of restaurant equipment parts; Providing a website used to place on-line commercial orders in the field of restaurant equipment parts; Retail services through direct solicitation by salespersons directed to end-users featuring restaurant equipment parts; Telephone ordering services in the field of restaurant equipment parts.

(2) Technical support services, namely, technical advice related to the installation of restaurant equipment parts; Technical support services, namely, technical advice related to the repair of restaurant equipment parts.

(3) Distribution services, namely, delivery of restaurant equipment parts; Warehousing services, namely, storage, distribution, pick-up, packing, and shipping of restaurant equipment parts.

Classification data**Disclaimer**

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1150A N. Swift Rd.
Addison, IL 60101
UNITED STATES OF
AMERICA

Agent
MILTONS IP/P.I.
#200-15 Fitzgerald
Road,
Ottawa,
ONTARIO K2H9G1

Documents
[View documents](#)

The classification data is provided for information
and searching purposes only. CIPO does not warrant
the accuracy of the classes assigned to the
trademark. This data has no legal value of any kind.

- 35 - Advertising, marketing, promotional
and business
- 39 - Transportation and storage
- 42 - Computer and scientific

Claims

Used in CANADA since at least as early as February
2003

Action History

Action	Action date	Due date	Comments
Filed	2013-10-25		
Created	2013-10-25		
Formalized	2013-10-29		
Search Recorded	2014-06-27		
Approval Notice Sent	2014-06-27	2014-07-25	
Approved	2014-08-14		APPROVED BY PROGRAM EX200M1
Advertised	2014-09-03		Vol.61 Issue 3123
Allowed	2014-12-19		
Allowance Notice Sent	2014-12-19	2015-06-19	
Registered	2015-01-05	2030-01-05	

Date modified: 2024-12-12