

Federal Court



Cour fédérale

Date: 20161005

Docket: T-310-16

Citation: 2016 FC 1109

Ottawa, Ontario, October 5, 2016

PRESENT: The Honourable Mr. Justice Diner

BETWEEN:

THE BLACK & DECKER CORPORATION

Applicant

And

**METHOD LAW PROFESSIONAL
CORPORATION**

Respondent

JUDGMENT AND REASONS

(Delivered from the Bench at Ottawa, Ontario, on September 27, 2016)

[1] The Applicant appeals, pursuant to section 45 of the Trade-marks Act, a decision of the Registrar of Trade-marks [Registrar], dated December 21, 2015 [Decision]. The Decision amended PIRANHA trade-mark TMA330,222 [the Registration], which was originally registered for use in association with “saw blades for power saws” [power saw blades] and “circular saw blades” [the Registered Wares] on July 17, 1987. The Registrar’s Decision found that the Applicant’s evidence with respect to use of the Mark in association with power saw blades was ambiguous, and as a result, ordered that part of the registration be deleted.

I. Background

[2] PIRANHA branded circular saw blades are offered in a range of sizes and material compositions and designed to be used with circular power saws.

[3] There was a significant amount of evidence regarding these saw blades that was tendered before the Registrar, as contained in a 2014 Affidavit of Greg C. Weston [the 2014 Weston Affidavit]. Mr. Weston was, at the time, a Commercial Marketing Manager with Stanley Black & Decker Canada. This evidence was tendered to establish use by the Applicant of its trade-mark in Canada of the Registered Wares in the preceding three years, namely April 3, 2011 through April 3, 2014 [the Relevant Period].

[4] Mr. Weston attested that during the Relevant Period, the Mark had been in use by the Applicant in the normal course of trade and in association with the Registered Wares. Evidence of use of the power saw blades presented along with his Affidavit included:

- Representative copies of jigsaw blade sets for use on power saws, with the Mark displayed on the individual blades, the blade set case, and packaging;
- Sample Canadian Price Lists, effective January 1, 2011 and January 1, 2014, listing PIRANHA branded wares for sale;
- Sales figures for PIRANHA circular and power saws from the Relevant Period;
- Copies of representative invoices showing sales of the Registered Wares to various Canadian retailers for the Relevant Period, specifically for the circular saws;
- Printouts from the retail websites www.amazon.ca and www.walmart.ca displaying the jigsaw and circular power saw blades available for purchase in Canada;

[5] The Registrar accepted that the Applicant had, with respect to the rescinded Mark (for power saw blades), (i) shown use of it on the Wares themselves, and (ii) made the Wares available for purchase to Canadians from the online retailers. However, the Registrar nonetheless concluded that there was no proof of sale, and therefore no actual use of the Mark in Canada with respect to power saw blades. The Registrar ordered the deletion for power saw blades from the Mark.

II. New Evidence

[6] Mr. Weston, the affiant before the Registrar, has provided new evidence for this application, once again in the form of an Affidavit [2016 Weston Affidavit]. Mr. Weston is now the Director of Product and Brand Marketing for the Applicant.

[7] The 2016 Weston Affidavit attaches Canadian sales invoices for eighteen new power saw blades from the Relevant Period. These sales exceed \$70,000.

III. Legislation

[8] The relevant legislative provisions relating to the Decision are as follows:

Registrar may request evidence of user

45 (1) The Registrar may at any time and, at the written request made after three years from the date of the registration of a trade-mark by any person... give notice to the registered owner of the trade-mark requiring the registered owner to furnish ... an affidavit or a statutory declaration showing, with respect to each of the goods or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three year period immediately preceding the date of the notice and, if not, the date

when it was last so in use and the reason for the absence of such use since that date.

...

Effect of non-use

(3) Where, by reason of the evidence furnished ... it appears to the Registrar that a trade-mark, either with respect to all of the goods or services specified in the registration or with respect to any of those goods or services, was not used in Canada at any time during the three year period immediately preceding the date of the notice and that the absence of use has not been due to special circumstances that excuse the absence of use, the registration of the trade-mark is liable to be expunged or amended accordingly.

[9] Section 2 of the Act defines “use” as follows:

use, in relation to a trade-mark, means any use that by section 4 is deemed to be a use in association with goods or services;

[10] Finally, subsection 4(1) of the Act reads as follows:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

IV. Analysis

[11] While the deferential “reasonableness” standard applies to s. 45 decisions, where additional evidence is adduced before the Federal Court on appeal that would have materially affected the Registrar’s findings of fact or the exercise of discretion, the standard of correctness applies (*Molson Breweries v John Labatt Ltd*, [2000] 3 FCR 145 at para 51).

[12] The purpose of s. 45 is to clear deadwood. It is not to expunge or amend the scope of rights accorded to trade-marks known and in use (*Guido Berlucchi & C Srl's v Brouillette Kosie Prince*, [2007] FC J No 319 at para 15 [*Prince*]). The owner of a mark must simply establish a *prima facie* case of use to satisfy use as defined under the Act [*Prince* at para 18]. In other words, its burden of proof is not an onerous one. As this Court has said, evidentiary overkill is to be avoided.

[13] In my view, the 2014 Weston Affidavit provided sufficient evidentiary support to establish a *prima facie* case that the Mark was in use in association with power saw blades in Canada during the Relevant Period, namely:

- I. representative copies showing that the Mark was used on the jigsaw blades sets and associated packaging;
- II. copies of major retailer websites offering PIRANHA jigsaw (power) blade sets for purchase in Canada;
- III. total sales figures from the Relevant Period which Mr. Weston attested captured both the sales of the PIRANHA circular saw blades as well as power saw blades.

[14] The above evidence provided in 2014 showed that the Mark was indeed use in association with all the Registered Wares during the Relevant Period. The Federal Court has clearly stated that it is not necessary to provide invoices in section 45 proceedings. Therefore, the failure to provide those invoices should not have been determinative. The evidence provided above, given the low threshold of proof required, and given the purpose of s. 45, should have sufficed as proof of use (*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, at para 6).

[15] Furthermore, any ambiguity as to use, should there have indeed been any, should have been resolved in favour of the registered owner, given the evidence that was provided by Mr. Weston in his 2014 Affidavit (*Fraser Sea Food Corp v Fasken Martineau Dumoulin LLP*, 2011 FC 893 at para 19).

[16] Finally, to the extent that there was indeed any legitimate ambiguity – which I do not feel that there was - that has been cured by the new evidence, namely the 2016 Weston Affidavit, has now provided sales through invoices exceeding \$70,000, itemizing the power saw blades. Those sales all took place during the Relevant Period.

[17] While use was impugned when the Registrar rescinded the Mark, I find that this new evidence clarifies any ambiguity as to whether the Registered Wares were actually sold in Canada during the Relevant Period. On this basis, I find that the registration “saw blades for power saws” (TMA330,222) should be reinstated.

V. Conclusion

[18] The evidence before the Registrar clearly established a *prima facie* case of use in association with “saw blades for power saws”. I find the Registrar’s decision to have been unreasonable based on the evidence presented at the hearing. Furthermore, the new evidence presented to this Court for this application clearly establishes use under the Act, without any ambiguity whatsoever.

JUDGMENT

THIS COURT'S JUDGMENT is that:

- a. This appeal be allowed. The Applicant's Trade-mark that is the subject of the Registration is in use by the Applicant within the meaning of the *Trade-marks Act* in association with the goods: (1) Saw blades for power saws. (2) Circular saw blades;
- b. The Registrar shall amend the statement of goods for trade-mark registration no. TMA330222 to include "Saw blades for power saws".

"Alan S. Diner"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-310-16

STYLE OF CAUSE: THE BLACK & DECKER CORPORATION v
METHOD LAW PROFESSIONAL CORPORATION

PLACE OF HEARING: OTTAWA, ONTARIO

DATE OF HEARING: SEPTEMBER 27, 2016

JUDGMENT AND REASONS: DINER J.

DATED: OCTOBER 5, 2016

APPEARANCES:

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