



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

Citation: 2015 TMOB 130
Date of Decision: 2015-07-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Sim & McBurney

Requesting Party

and

Anipet Animal Supplies Inc.

Registered Owner

TMA687,198 for UNLEASHED

Registration

[1] At the request of Sim & McBurney, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on September 26, 2013 to Anipet Animal Supplies Inc. (the Owner) the registered owner of registration No. TMA687,198 for the trade-mark UNLEASHED (the Mark).

[2] The Mark is registered in association with the following goods:

- (1) Plastic bags for disposing of pet waste.
- (2) Disposable housebreaking pads for pets.
- (3) Pet collars and leashes.
- (4) Pet clothing.
- (5) Animal crates and carriers.
- (6) Mats and pads made of fabric for use with animals.
- (7) Beds for household pets.
- (8) Bowls for use with pets.
- (9) Pet toys.

[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 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 between September 26, 2010 and September 26, 2013.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act:

4(1) A trade-mark 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Owner filed the affidavit of Troy Firth, Chief Executive Officer of the Owner, sworn on April 16, 2014 in Vancouver. Only the Owner filed written representations, but both parties were represented at an oral hearing held on July 27, 2015.

The Owner’s Evidence

[7] In his affidavit, Mr. Firth attests that the Owner sells pet specialty products through distributors and retailers servicing the Canadian market. He explains that the Owner sold

UNLEASHED pet products during the relevant period to numerous Canadian retailers and distributors, such as Cowtown, Western Drug Distribution and Pawsitively Natural.

[8] Although he asserts use of the Mark in association with all of the registered goods, as described below, Mr. Firth's affidavit focuses on the following registered goods only: (2) Disposable housebreaking pads for pets; (5) Animal crates and carriers; (6) Mats and pads made of fabric for use with animals; (7) Beds for household pets; and (8) Bowls for use with pets.

[9] In this respect, Mr. Firth attests that sales of UNLEASHED products during the relevant period in Canada were in excess of \$2.4 million. This total corresponds to the breakdown of sales figures by product during the relevant period that he provides, as follows: disposable housebreaking pads for pets (\$50,000); animal crates & carriers (\$1.34 million); mats & pads (\$80,000); beds for pets (\$660,000); bowls for pets (\$298,500).

[10] With respect to goods (5), "Animal crates and carriers", Mr. Firth explains that the crates sold by the Owner include a detachable handle that allows pet owners to carry the crates with ease. He asserts that, as a result, the Owner's UNLEASHED crates also operate as carriers.

[11] In support, attached to Mr. Firth's affidavit are the following exhibits:

- Exhibit B consists of several invoices showing sales of various products by the Owner to customers in Canada during the relevant period. Although the invoices appear to include a variety of goods sold in association with a variety of trade-marks, Mr. Firth specifically highlights item descriptions that he identifies as UNLEASHED products, namely "crates/carriers", "beds for pets", "mats for pets", "pads for pets", "bowls for pets" and "disposable housebreaking pads for pets".
- Exhibit C consists of photographs of various products that Mr. Firth attests are representative of various UNLEASHED branded products that feature the Mark "on the product, the packaging and/or product tags". The exhibit includes photographs of an "Animal Crate/Carrier" (Exhibit C-1), "Beds for Pets" (Exhibit C-2), "Bowls for Pets" (Exhibit C-3), "Disposable Housebreaking Pads for Pets" (Exhibit C-4), "Pet Mats" (Exhibit C-5) and "Pet Pads" (Exhibit C-6). With the exception of "Bowls for Pets", the

Mark appears on the packaging or on a tag attached to the particular product.

With respect to the bowl depicted at Exhibit C-3, the photograph does not show the Mark. Instead, a sticker appears on the side of the bowl, displaying the UPC code and the following description: “ITEM #09377 Premium Rubberized SS Bowl 13cm”.

- Exhibit D consists of examples of promotional materials that Mr. Firth attests were used by the Owner to promote the Owner’s UNLEASHED pet products. Contrary to Mr. Firth’s assertion, however, “pet bowls” are not depicted or referenced in any of these exhibited materials.

Analysis

[12] At the oral hearing, the Owner conceded that the evidence does not show use of the Mark in association with the registered goods “(1) Plastic bags for disposing of pet waste”, “(4) Pet clothing” and “(9) Pet toys”. Indeed, notwithstanding Mr. Firth’s general assertion of use of the Mark in association with all of the registered goods, these particular goods are not otherwise referenced in the evidence and there is no indication that the evidence furnished is intended to be representative of a general category of goods. The registration will be amended accordingly.

Goods (2) - Disposable housebreaking pads for pets

[13] With respect to goods (2), “disposable housebreaking pads for pets”, at the oral hearing, the Requesting Party conceded that use of the Mark has been demonstrated by the Owner. In this respect, Mr. Firth clearly attests to significant sales and transfers of disposable pads during the relevant period in Canada and provides a representative photograph of such goods at Exhibit C-4 to his affidavit. The Mark is prominently displayed on the packaging.

Goods (3) – Pet collars and leashes

[14] With respect to goods (3), “pet collars and leashes”, the Owner noted that at least one of the Exhibit B invoices shows sales of “K9 Explorer” collars and leashes. However, while this may constitute evidence of transfers of “collars and leashes” by the Owner during the relevant

period, there is no evidence before me that such transfers were in association with the Mark. Indeed, in his breakdown of sales of goods that he identifies as being in association with the Mark, Mr. Firth does not reference collars and leashes; furthermore, no photographs of collars and leashes are provided at Exhibits C or D. The registration will be amended accordingly.

Goods (5) – Animal crates and carriers

[15] With respect to goods (5), “animal crates and carriers”, the Requesting Party submitted that the evidence was sufficient to show evidence of use with respect to “animal crates” only. In this respect, it argued that goods (5) lists two separate goods, namely “crates” and “carriers”, and that the same evidence cannot be used to support the registration for these two separate goods. It notes that Exhibit C-1, for example, identifies the product as “Basic Crate”.

[16] In support, the Requesting Party cited *Tolaini SRL v Segura Viudas, SA* (2005), 50 CPR (4th) 158 (TMOB). In that case, as “sparkling wines” was listed as a good separate and apart from “wines and other fermented alcoholic beverages”, the Registrar found that, in order to support use with respect to the latter goods, the registrant had to show use with respect to wines other than “sparkling wines”.

[17] In response, the Owner asserted that goods (5) lists one good, rather than two separate goods, and would be interpreted as such by the average consumer. In support, the Owner noted Mr. Firth’s explanation of the dual function of the Owner’s crates, namely that they also function as carriers for travel. This function is referenced on the exhibited packaging, and the crates depicted include a handle for carrying purposes.

[18] I would first note that this case does not present the same dilemma as in the case cited by the Requesting Party, *Tolaini*. In that case, “sparkling wines” is clearly a more specific good in the broader category of “wines”. As the evidence in that case reflected only the narrower good, that registration was amended accordingly. In this case, the same analysis is not applicable; “carriers” are not necessarily a narrower subset of the category “crates” and not all “crates” would necessarily fall under the category of “carriers”.

[19] The issue, then, is not whether the evidence shows sales of two different goods, but rather whether goods (5), “Animal crates and carriers” should be interpreted as listing one good or two goods.

[20] Per section 30 of the Act, goods must be stated in ordinary commercial terms; whether a trade-mark has been used in association with the registered goods is to be determined on a case-by-case basis [see *Express File Inc v HRB Royalty Inc*, 2005 FC 542, 39 CPR (4th) 59 (FC)]. Accordingly, registered goods should be interpreted in accordance with common sense and given their ordinary meaning. While it could have been phrased differently, I agree with the Owner and consider it reasonable to interpret goods (5), “Animal crates and carriers”, as reflecting one good – paraphrased as “animal crates that are also carriers”. Indeed, this interpretation is supported by Mr. Firth’s statements in his affidavit and in the evidence furnished.

[21] I would further note that amending the registration to delete “and carriers” from the registration as suggested by the Requesting Party would arguably result in a broader statement of goods than that registered. In this respect, “Animal crates” without the modifier “and carriers”, would notionally result in a registration that could include goods paraphrased as “animal crates that are not also carriers”. The Registrar has no authority in a section 45 proceeding to make such an amendment.

[22] Accordingly, for purposes of this proceeding, I agree with the Owner that goods (5) should be interpreted as one good. As such, I note that Mr. Firth clearly asserts to significant sales and transfers of “crates/carriers” during the relevant period in Canada and provides a representative photograph of such goods at Exhibit C-1 to his affidavit. The Mark is prominently displayed on the packaging.

Goods (6) – Mats and pads made of fabric for use with animals

[23] With respect to goods (6), “mats and pads made of fabric for use with animals”, the Requesting Party noted that Mr. Firth’s affidavit often omits the modifier “...made of fabric for use with animals”, suggesting that this ambiguity in the evidence should be interpreted against the Owner’s interests. However, the photographs at Exhibits C-5 and C-6 show UNLEASHED mats and pads made of some type of fabric, and the labels show that such mats and pads are

intended for animals. In combination with the evidence of sales attested to by Mr. Firth, this is more than sufficient with respect to goods (6).

Goods (7) – Beds for household pets

[24] With respect to goods (7), “beds for household pets”, although Mr. Firth clearly identifies the products shown at Exhibit C-2 as “beds for pets”, the Requesting Party questioned whether the product depicted at Exhibit C-2 was, in fact, a bed.

[25] However, the Requesting Party did not cite any jurisprudence or definitions of “beds” as they relate to animals such that goods (7) should be interpreted narrowly. Indeed, the product labels shown at Exhibit C-2 reference “bedding”, and the advertisements at Exhibit D show what appear to be beds in various styles and sizes. The slogan that appears in the advertisement, “Play Hard – Sleep Softer” further supports the inference that these advertised products (that include the products depicted at Exhibit C-2) are, in fact, beds for household pets.

[26] In any event, given the nature of the product and the affiant’s position, I am prepared to accept Mr. Firth’s assertion that such products are “beds for pets” at face value. I further note that the Mark is prominently displayed on tags attached to the beds, for which there is ample evidence of sales during the relevant period

Goods (8) – Bowls for use with pets

[27] With respect to goods (8), “bowls for use with pets”, the Requesting Party concedes that the evidence shows sales of bowls, but questions whether such sales were in association with the Mark. In this respect, it notes that the only furnished photograph of a bowl, at Exhibit C-3, does not depict the Mark at all. It notes that this is inconsistent with the other product photographs in evidence.

[28] Indeed, notwithstanding Mr. Firth’s assertion of use of the Mark with respect to all of the registered goods, the evidence does not actually show use with respect to all such goods and the Owner conceded as much at the oral hearing. Accordingly, while Mr. Firth asserts use of the Mark in association with “bowls”, the bowl depicted at Exhibit C-2 does not actually show the Mark “on the product, the packaging and/or product tags”. Furthermore, I note that the Exhibit

B invoices do not identify any “bowls” using the Mark in the product descriptions. For example, although highlighted by the Owner, the first invoice lists “DB-320 Stainless Steel Bowl 1 quart”. Further, if the UPC code or item number on the depicted bowl are meant to correspond with invoices, advertising, catalogues or other means of depicting the Mark, that evidence is not before me.

[29] In the absence of a representative photograph depicting a bowl with the Mark, it is not clear that the bowls sold by the Owner during the relevant period were, in fact, sold in association with the Mark. At best, the evidence is ambiguous in this respect and such ambiguities must be resolved contrary to the interests of the Owner [per *Plough, supra*].

[30] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark only in association with the registered goods (2), (5), (6) and (7) within the meaning of sections 4 and 45 of the Act. With respect to goods (1), (3), (4), (8) and (9), I am not satisfied that the Owner has demonstrated use of the Mark in association with such goods, and there is no evidence of special circumstances excusing such non-use of the Mark before me.

Disposition

[31] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended in compliance with the provisions of section 45 of the Act to delete “plastic bags for disposing of pet waste”, “pet collars and leashes”, “pet clothing” “bowls for use with pets” and “pet toys”.

[32] The amended statement of goods will be as follows:

- (1) Disposable housebreaking pads for pets.
- (2) Animal crates and carriers.
- (3) Mats and pads made of fabric for use with animals.
- (4) Beds for household pets.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-07-27

Appearances

Eric Macramalla

For the Registered Owner

Philip Lapin

For the Requesting Party

Agents of Record

Gowling Lafleur Henderson LLP

For the Registered Owner

Smart & Biggar

For the Requesting Party