



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

Citation: 2013 TMOB 65
Date of Decision: 2013-03-09

**IN THE MATTER OF A SECTION 45
PROCEEDING requested by Reckitt Benckiser
(Canada) Inc. against registration
No. TMA437,374 for the trade-mark
SCENTSATION in the name of Tritap Food
Broker, a Division of 676166 Ontario Limited**

[1] At the request of Reckitt Benckiser (Canada) Inc., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 to Tritap Food Broker, a division of 676166 Ontario Limited (the Registrant), the registered owner of registration No. TMA437,374 for the trade-mark SCENTSATION.

[2] The section 45 notice required the Registrant to file evidence showing use of its trade-mark in Canada within the time period of July 20, 2007 to July 20, 2010 (the Relevant Period) with respect to each of the wares specified in the registration. In this case, the registered wares are: pot pourri, air fresheners and furniture polish.

[3] Section 4 of the Act sets out the meaning of use. In this case, the following subsection applies:

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.

[4] In response to the Registrar's notice, the Registrant furnished the affidavit of Joel Usher. Both parties filed written submissions and were represented at an oral hearing.

[5] In response to the Registrant's evidence, the main submissions of Reckitt Benckiser (Canada) Inc. (the Requesting Party) were the following:

- (a) The use shown is not by the Registrant, nor is it use that inures to the Registrant's benefit;
- (b) The trade-mark used is not the trade-mark *as registered*; and
- (c) The trade-mark has not been used with the *registered wares*.

[6] I will now discuss the evidence and arguments with respect to each of these issues in turn.

Does the evidence show use of the trade-mark by the Registrant or use that inures to the Registrant's benefit?

[7] The evidence must show use of the trade-mark by the Registrant, or use by a proper licensee satisfying the requirements of section 50 of the Act. In the present case, for reasons that follow, I do not find it necessary for the Registrant to rely on use by a licensee.

[8] In his affidavit, Mr. Usher identifies himself as both the Secretary-Treasurer of the Registrant and the General Manager of U-Buy Discount Foods Limited (U-Buy), a related company. He explains that U-Buy sells products marked with the trade-mark, and that U-Buy carries on the business of grocery sales under the name Worldwide Food Dist.

[9] With respect to the Registrant's ordinary course of trade, Mr. Usher indicates that during the Relevant Period, the Registrant sold air fresheners bearing the trade-mark *either* directly to Canadian retail stores or to distributors who would then sell to Canadian retail stores, for sale to consumers. In support, he attaches a photograph of a can of aerosol air freshener as Exhibit A, which he states is representative of the way the trade-mark appeared on products sold in Canada during the Relevant Period. Additionally, with respect to such sales, he attaches representative invoices under Exhibit B.

[10] The Requesting party argues that there is no use of the trade-mark directly by the Registrant as it is U-Buy that appears to be selling the products. Furthermore, there is no evidence that U-Buy is a licensee under section 50 of the Act. This is so, the Requesting Party contends, as none of the invoices under Exhibit B clearly identify the seller; however, each invoice includes reference to U-Buy's trading name Worldwide Foods Dist. with respect to customer claims submissions. The Requesting Party argues that this demonstrates that it is U-Buy, and not the Registrant that issued the invoices; an inference further supported by Mr. Usher's statement that U-Buy sells products marked with the trade-mark.

[11] Further to this, the Requesting Party argues that if it was the Registrant that was using the trade-mark and selling the goods, this information would presumably have appeared on the product itself. In this respect, the image of the air freshener in Exhibit A only shows one perspective of the aerosol can, which does not include product source information. The Requesting Party contends that as the Registrant has declined to provide an image of the back of the product, the only inference that can be drawn is that it is not the Registrant's name that appears on the product, but rather U-Buy, Worldwide Foods, or another third party.

[12] However, I agree with the Registrant that nowhere in his affidavit does Mr. Usher claim that a licensee or any other entity aside from the Registrant is using the trade-mark or that the wares originate from anyone other than the Registrant. Furthermore, the Registrant is not required to provide evidence of use of the trade-mark along with its name [see *Gowling Lafleur Henderson LLP v Classical Remedia Ltd* (2008), CarswellNat

4604 (TMOB); *Novopharm Ltd v. Monsanto Canada, Inc* (1997), 80 CPR (3d) 287 (TMOB); and *Vogue Brassiere Inc v Sim & McBurney* (2000), 5 CPR (4th) 537 (FCTD)].

[13] While I agree with the Requesting Party that the invoices appear to have been issued by U-Buy, I find it reasonable to infer that U-Buy was merely acting as the Registrant's distributor. In my view, as Mr. Usher has clearly sworn that the Registrant's normal course of trade *also* involves sales to distributors, U-Buy's trade-name "Worldwide Distributors" reasonably implies such a relationship. As such, I find that U-Buy is merely an intermediary along the chain of transactions between the Registrant and the ultimate consumer [see *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD)].

[14] Moreover, a distributor of goods does not require a license from the trade-mark owner to distribute them [see *A & A Jewellers Ltd v Malcolm Johnston & Associates* (2000), 8 CPR (4th) 56 (FCTD)].

[15] Accordingly, I am satisfied that the use shown is that of the Registrant.

Does the evidence show use of the trade-mark as registered?

[16] The air freshener depicted in Exhibit A shows the trade-mark in fanciful lettering, with a hyphen following the word SCENT and the portion SATION appearing on a separate line beneath; each portion beginning with a large fanciful letter S.

[17] The Requesting Party submits that all of these factors create the overall impression of two separate words, namely, "Scent" and "Sation"; the first word being a dictionary word meaning odour, with the second word having no dictionary meaning. In contrast, the Requesting Party submits, the registered mark is one word and is a synonym for the dictionary word "sensation", meaning a feeling.

[18] As such, the Requesting Party argues that the appearance, sound and ideas suggested by the mark as used differ from the mark as registered to the extent that consumers would not identify the trade-mark as used as being the registered mark *per se*.

[19] Where the mark as used deviates from the mark as registered, the question to be asked is whether the mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 at 525 (FCA)]. In deciding this issue, one must look to see if the “dominant features” have been preserved [*Promafil Canada Ltée v Munsingwear Inc*, 44 CPR (3d) at 59 (FCA)]. It is a question of fact whether the differences between the marks are “so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences identify goods having the same origin” [*Honeywell Bull, supra* at p. 525]. Lastly, the use of a trade-mark in combination with additional words or features constitutes use of the registered mark if the public as a matter of first impression, would perceive the trade-mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[20] In my view, the trade-mark has not lost its identity and remains recognizable. In this vein, I agree with the Registrant that the addition of a hyphen is insignificant. The visual separation between the elements SCENT and SATION through the use of a hyphen and fanciful lettering does not change the overall impression of the mark. More particularly, these differences do not affect the way the mark is pronounced. Furthermore, the dictionary word SCENT is also readily discernable within the registered trade-mark. As such, either way the trade-mark is presented, the idea suggested remains the same.

[21] Accordingly, I am satisfied that the evidence shows use of the registered trade-mark *per se*.

Does the evidence show use of the trade-mark with the registered wares?

[22] Although the trade-mark in question is registered for use in association with several wares, insofar as the *registered wares* are concerned, there is no dispute that the Registrant’s evidence and submissions only pertain to “air fresheners”. Consequently,

the following analysis will focus on whether the evidence shows use of the trade-mark in association with “air fresheners”.

[23] In his affidavit, Mr. Usher states that the Registrant has used and continues to use the trade-mark on packaging for air fresheners in spray and solid form as well as with scented candles. While he acknowledges that scented candles are “not covered” by the registration, he asserts that they are a “natural expansion” of air fresheners.

[24] As previously indicated, Exhibit A is a photograph which shows the trade-mark affixed to a can of aerosol air freshener. Mr. Usher states that this photograph is representative of the way the trade-mark appeared on products sold in Canada during the Relevant Period and continues to appear on both air fresheners and candles.

[25] Furthermore, although Mr. Usher describes the invoices attached under Exhibit B as representative with respect to air fresheners sold in Canada during the Relevant Period in association with the trade-mark, I note that the invoices also show sales of “SCENTSATION scented candles”.

[26] At the oral hearing, the Requesting Party cast the evidence as ambiguous with respect to air fresheners, submitting that such ambiguous evidence should be construed against the Registrant [per *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 45 CPR (2d) 194 at 198; aff’d 53 CPR (3d) 62 (FCA)]. In particular, the Requesting Party drew attention to the fact that the air fresheners on the invoices do not refer to the trade-mark, whereas the candles listed on the invoices include the complete trade-mark in their descriptions. Indeed, in the Requesting Party’s view, it is unclear why the Usher affidavit refers to candles at all if there truly were sales of SCENTSATION air fresheners. This is even further unclear, the Requesting Party contended, as there is no connection between the air freshener in the Exhibit A photograph and the air fresheners in the Exhibit B invoices. For example, none of the weights of the products in the invoice descriptions correspond with the air freshener in the photograph.

[27] The Registrant, on the other hand, submitted that the Requesting Party is overanalyzing and dissecting the evidence, in an overly technical approach that is

inconsistent with the purpose of section 45 proceedings. The Registrant stressed that the evidence must be viewed as a whole rather than focusing on individual pieces [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 at 213 (TMOB)]. I agree.

[28] With respect to the inclusion of “scented candles” in the evidence, the Registrant submitted that the commercial reality of today is that candles are air fresheners.

[29] Nevertheless, as for why the entire trade-mark does not appear in association with air fresheners on the invoices, the Registrant remarked that it is not always possible to do so. As such, it is common for invoices to include abbreviations. I find this explanation reasonable in view of the limited space on the evidenced invoices.

[30] With respect to why Mr. Usher refers to candles at all in his affidavit, as the invoices also show sales of scented candles in association with the trade-mark, I find it reasonable that Mr. Usher would provide some context for those listings.

[31] Lastly, as for the apparent lack of connection between the air freshener depicted in the Exhibit A photograph and the air fresheners listed in the Exhibit B invoices, Mr. Usher clearly states in his affidavit that the exhibits are *representative*. Furthermore, although the air fresheners listed on the invoices are not aerosol based, I find nothing inconsistent with the evidence. In this regard, Mr. Usher has clearly stated that the trade-mark is used on packaging for air fresheners in both spray *and* solid form.

[32] Having regard to the foregoing, in view of the evidence as a whole, I conclude that the evidence is sufficient to show use of the trade-mark with in association with “air fresheners”.

Disposition

[33] Accordingly, I have concluded that the Registrant has shown use of the registered trade-mark in association with “*air fresheners*”; however, use has not been shown for the remaining wares in the registration and there is no evidence of any special circumstances excusing the absence of use.

[34] Consequently, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA437,374 will be amended to delete the wares “*furniture polish*” and “*pot pourri*” in compliance with the provisions of section 45 of the Act:

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office