LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 3
Date of Decision: 2012-01-19

IN THE MATTER OF A SECTION 45 PROCEEDING requested by Smart & Biggar against registration No. TMA132,393 for the trade-mark COMPLETE in the name of Diversey, Inc.

[1] At the request of Smart & Biggar (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on November 12, 2009, to Diversey, Inc., the registered owner (the Registrant) of registration No. TMA132,393 for the trade-mark COMPLETE (the Mark).

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

1) A general purpose detergent, disinfectant and deodorant for household and industrial uses.

2) Household cleaning compounds namely a cleaner for sinks and windows, a detergent for dishes, disinfectants, and analogous surface coatings namely a liquid varnish (permanent type) for floors, a liquid polymer (water emulsion type) and waxes and polymers.

[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 wares and/or services listed on 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 use since that date. In this case, the relevant period for showing use is any time between November 12, 2006 and November 12, 2009.

[4] The relevant definition of "use" in the present case is set out in s. 4(1) of the Act 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.

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing deadwood from the register. Assertions of use as a matter of law are insufficient to demonstrate use [see *Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1979), 45 C.P.R. (2d) 194 (F.C.T.D.)]. A recipient of a s. 45 notice must put forward evidence showing how it has used the trade-mark in order that the Registrar may assess if the facts qualify as use of the trade-mark pursuant to s. 4 of the Act. However, it has also been held that evidentiary overkill is not required when use can be shown in a simple, straightforward fashion [see *Union Electric Supply Co. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)].

[6] In response to the Registrar's notice, the Registrant furnished the affidavit of Nicole Goulet, together with Exhibits A through F. Both parties filed written submissions; however, only the Registrant was represented at an oral hearing.

[7] As a preliminary matter, I note that the Registrant's evidence and submissions are limited to the ware described as "*analogous surface coatings namely a liquid varnish (permanent type) for floors*". Accordingly, the remaining wares will be deleted from the registration. I will now turn to the evidence.

[8] In her affidavit, Ms. Goulet identifies her position within the Registrant as that of Senior Product Manager – Floorcare, having held this position for about two years, prior to which she was employed in various capacities by the Registrant since 1995.

[9] Ms. Goulet then explains that the Registrant is engaged in the sale and manufacture of cleaning and sanitation products. As evidence of use of the Mark in association with "*analogous*

surface coatings namely a liquid varnish (permanent type) for floors", she provides excerpts from product guides and catalogues (Exhibit A), copies of sell sheets (Exhibit B), representative product labels (Exhibit C), a representative material safety data sheet (Exhibit D), a collection of customs documents/invoices (Exhibit E), and representative invoices (Exhibit F). I note that the Mark is clearly visible on the product labels, and the chain of sale is clearly evidenced from the Registrant to its distributor to the end consumer.

[10] The Requesting Party argues that the documentary evidence is inconsistent with statements made by Ms. Goulet in her affidavit, as it is clear from the exhibits that the product being sold by the Registrant is not "permanent type". By way of example, it cites the first page of Exhibit B, which includes the following descriptions of the product:

- "A durable finish that reduces the need to strip and refinish – responds beautifully when spray buffed";
- "Lasts longer in tough traffic situations".

It submits that it is clear that a product that "reduces the need to strip and refinish" is not permanent, and that similarly, the description that the product "lasts longer…" also confirms that the product is not "permanent". Thus, it argues that the product sold by the Registrant is not "permanent type" and therefore, as the evidence does not support maintaining the registration for "analogous surface coatings… ", the registration ought to be expunged.

[11] However, I agree with the Registrant that such descriptive phrases (as noted above) are not necessarily inconsistent with the description of wares in the registration. Furthermore, I note that Ms. Goulet clearly swears in her affidavit that the evidence is in respect of "*analogous surface coatings namely a liquid varnish (permanent type) for floors*". Absent evidence to the contrary, I accept the affiant's sworn statements at face value [*Rubicon Corp. v. Comalog Inc.* (1990), 33 C.P.R. (3d) 58 (T.M.O.B.)].

[12] It would appear simply that there is a difference in opinion as to what constitutes a "permanent type" coating for floors. In my view, the Registrant is correct in that this is precisely the type of meticulous analysis of the wares that the Court has repeatedly discouraged, an approach held not to be consistent with the purpose of s. 45 to be a simple, summary, expeditious

procedure for removing "deadwood" from the register [see *Levi Strauss & Co. v. Canada (Registrar of Trade-Marks)* (2006), 51 C.P.R. (4th) 434 (F.C.)].

Disposition

[13] Having regard to the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained solely in respect of "*Household cleaning compounds, namely, analogous surface coatings namely a liquid varnish (permanent type) for floors*" in compliance with the provisions of s. 45 of the Act.

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