



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

Citation: 2015 TMOB 98
Date of Decision: 2015-05-29

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Anderson Instrument Company against
registration No. TMA594,237 for the trade-mark
ANDERSON CONTROLS in the name of 3402983
Canada Inc.**

[1] At the request of Anderson Instrument Company (the Requesting Party), the Registrar of Trade-marks forwarded a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on June 5, 2013 to 3402983 Canada Inc. (the Owner), the registered owner of registration No. TMA594,237 for the trade-mark ANDERSON CONTROLS (the Mark).

[2] The Mark is registered for use in association with the following services: retail sales, distributorship and repair of process measuring, sensing, recording and controlling instrumentation for temperature, pressure, level and flow applications.

[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 services 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 June 5, 2010 and June 5, 2013.

[4] The definition of “use” in association with services is set out in section 4(2) of the Act:

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)]. With respect to services, the display of the trade-mark in advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)]. Furthermore, the evidence as a whole must be considered and focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)].

[6] In response to the section 45 notice, the Owner furnished the affidavits of David Reed, President of the Owner, and Kelsey Boyd, an employee of the Owner, both sworn on August 8, 2013. Only the Requesting Party filed written representations; an oral hearing was not requested.

[7] In his affidavit, Mr. Reed attests that he is the sole director and president of the Owner and its licensee, ITM Instruments Inc. He explains that ITM is a subsidiary of and controlled by the Owner, and that the Owner has licensed use of the Mark to ITM pursuant to a license agreement dated January 1, 2006.

[8] Mr. Reed attests that ITM is in the general business of selling, distributing, calibrating, certifying and repairing measurement instrumentation, with offices in Quebec, Ontario and Alberta. He states that ITM advertises its measurement instrumentation to customers via its published catalogue, the Internet, and through its salespeople. Further, he attests that orders for instrumentation sold by ITM are primarily placed over the telephone, but that orders can also be placed through its salespeople, via the Internet or by walk-in sales.

[9] More specifically, Mr. Reed attests that ITM sold and distributed “process measuring, sensing and controlling instrumentation for temperature applications” in Canada during the relevant period and that such instrumentation was tagged or labelled with the Mark. He provides that such instrumentation included temperature sensors, thermosensors, industrial thermocouples and thermocouple sensors, which are used by manufacturers to “measure, regulate and monitor

and control temperatures in various industrial applications and processes, such as steel production, food production and metal wire production”.

[10] Attached as Exhibit 2 to Mr. Reed’s affidavit is a copy of ITM’s catalogue, published in 2009, that Mr. Reed attests “is still ITM’s current general catalogue in use by ITM and its customers.” Mr. Reed attests that the instrumentation for temperature applications are shown on pages 275 to 284 of the catalogue. He explains that the instrumentation can be ordered in a variety of configurations depending on the customer’s needs, which must be specified when ordering. Once an order is received by ITM, it is then transmitted by ITM to its manufacturer which manufactures the instrumentation according to the customer specifications.

[11] With respect to sales and distribution during the relevant period, Mr. Reed states that approximately five hundred units of instrumentation for temperature applications were sold each year by ITM in Canada. He attests that all such instrumentation was tagged with a yellow tag bearing the Mark and that some instrumentation additionally had a silver and blue label bearing the Mark attached directly to the instrumentation. Attached as Exhibits 3 and 4 to Mr. Reed’s affidavit are representative examples of such tags and labels, respectively.

[12] As attested by Mr. Reed, in addition to the Mark, the tags and labels include contact information for ITM. Mr. Reed attests that the purpose of attaching a tag or label was in part to allow a customer to easily reorder such instrumentation from ITM.

[13] As proof of sales during the relevant period, attached as Exhibits 11 to 15 are representative invoices from ITM that Mr. Reed attests show sales of instrumentation bearing the aforementioned tags or labels to various customers in Canada.

[14] Mr. Reed also attests that instrumentation bearing the Mark is on display in ITM’s head office in Quebec. Attached as Exhibits 5 to 9 of his affidavit are photographs of various products that Mr. Reed attests were displayed at ITM’s office during the relevant period. All of the products shown bear an aforementioned label or tag displaying the Mark and contact information for ITM.

[15] As well, attached as Exhibit 10 to Mr. Reed’s affidavit are three photographs of sample instrumentation that also bear the aforementioned labels. Mr. Reed explains that these samples

are representative of those used by ITM's salespeople to demonstrate the instrumentation to potential customers in Canada during the relevant period.

[16] As for the affidavit of Ms. Boyd, I do not consider that it substantively adds to the evidence of use in this case. For the most part, her affidavit simply confirms that she took some of the photographs appearing in Mr. Reed's affidavit.

Analysis

[17] In its written representations, the Requesting Party submits that the Owner did not show any use of the Mark in association with the registered services as the evidence shows that, at best, the services were performed by ITM under its name. In this respect, it notes that "ITM" appears in the exhibited catalogue and invoices rather than the Mark. It further argues that "the sole fact of affixing or attaching a tag or a label to [a] few products cannot be considered as being the use of a trade-mark in association with services."

[18] However, the Requesting Party does not support this argument with any relevant jurisprudence. Indeed, the display of a retailer's trade-mark on price tags, labels and the like is often considered sufficient to demonstrate use of a trade-mark in association with retail services [see, for example, *Smart & Biggar v Swede Can Group* (2003), 23 CPR (4th) 117 at para 15 (TMOB); *Swabey, Ogilvey & Renault v Miss Mary Maxim Ltd* (2004), 28 CPR (4th) 543 at 547 (TMOB); and *Coastal Trademark Services v Edward Chapman Ladies Shop Ltd*, 2014 TMOB 80 at para 10].

[19] Furthermore, it has been held that the use of a mark on a finished product can serve to support use in association with services ancillary to such goods [see *Lidl Stiftung & Co KG v Thornbury Grandview Farms Ltd* (2005), 48 CPR (4th) 147 at para 17 (TMOB)]. Indeed, the Federal Court of Appeal has held that nothing in section 4(2) restricts services to those that are independently offered to the public or that are not ancillary or connected with goods [*Gesco Industries Inc v Sim & McBurney* (2000), 9 CPR (4th) 480 at 484]. While the "sale" of such finished products, as in this case, may be considered a bland application of this principle, it is apt nonetheless. In my view, at a minimum, the goods themselves (in this case, bearing the Mark

and ITM's contact information on attached tags and labels), constitutes advertisement of further sales and distribution of such goods.

[20] Although "ITM" may be perceived by customers as the primary trade-mark with respect to ITM's business, the Act only requires that a trade-mark be displayed in the advertisement or performance of services and nothing prevents the display of more than one trade-mark during the performance or advertisement of such services.

[21] In this case, the evidence shows that the Mark is displayed in ITM's offices, when its salespeople demonstrate the instrumentation for sale and when the instrumentation is actually shipped to the customer. That the Mark is displayed on attached tags and labels does not preclude it from constituting display in the advertisement and performance of ITM's sales and distribution services. As attested to by Mr. Reed, the purpose of displaying ITM's contact information on the labels and tags is to facilitate further customer orders. In particular given the nature of ITM's business as attested to by Mr. Reed, I see no reason why display of the Mark on such labels cannot be considered both use in association with the goods themselves, but also use in association with ITM's sales and distributorship services with respect to such goods.

[22] The Requesting Party also emphasized that any sales shown in the evidence do not constitute *retail* sale of ITM's instrumentation. While the sales in this case were not made through a retail store, the Requesting Party submitted no jurisprudence to support its suggestion that the exhibited invoices cannot in any sense be considered "retail" sales. In this respect, I note that the sales evidenced in this case are of small quantities and appear to be made directly to end consumers. Absent jurisprudence to the contrary, I see no reason that such sales cannot be considered "retail" sales.

[23] I do agree, however, that the Mark would not be associated with ITM's "repair" services or any sales and distributorship of instrumentation for "pressure, level and flow". Indeed, aside from referencing ITM's business generally, Mr. Reed makes no reference to "repair" services in his affidavit and he consistently describes the instrumentation at issue as relating to temperature applications only.

[24] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the following services only within the meaning of sections 4 and 45 of the Act: “retail sales, distributorship ... of process measuring, sensing, recording and controlling instrumentation for temperature ... applications”.

Disposition

[25] Accordingly, and 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 “repair” and “pressure, level and flow” from the statement of services.

[26] The amended statement of services will be as follows:

Retail sales and distributorship of process measuring, sensing, recording and controlling instrumentation for temperature applications.

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