



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

**Citation: 2012 TMOB 211**  
**Date of Decision: 2012-11-21**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Riches, McKenzie & Herbert LLP against  
registration No. TMA577,508 for the trade-mark  
CLEANER'S SUPPLY in the name of Cleaner's Supply,  
Inc.**

[1] On April 13, 2010, at the request of Riches, McKenzie & Herbert LLP, the Registrar forwarded a notice under section 45 of the *Trade-marks Act* RCS 1985, c T-13 (the Act) to Cleaner's Supply, Inc. (the Registrant), the registered owner of registration No. TMA577,508 for the trade-mark CLEANER'S SUPPLY (the Mark).

[2] The Mark is registered for use in association with the following wares (the Wares):

(1) Packaging supplies, namely, cardboard boxes, plastic bags, paper accessory bags, printed paper labels, paper tags and stickers, cardboard boards and forms;

(2) Packaging supplies for use in the garment care industry, namely, cardboard boxes, plastic bags, paper accessory bags, printed paper labels, paper tags and stickers, cardboard boards and forms.

[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 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. Thus, in this case, the relevant period in which use must be shown is between April 13, 2007 and April 13, 2010 (the Relevant Period).

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

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] In response to the section 45 notice, the Registrant furnished the affidavit of Jeffrey Schapiro, President of the Registrant, sworn October 12, 2010. Both parties filed written representations; an oral hearing was not held.

[6] In his affidavit, Mr. Schapiro attests that the Registrant’s Canadian customers order CLEANER’S SUPPLY products by using the Registrant’s CLEANER’S SUPPLY catalogue or via the Registrant’s website. Attached as Exhibit B to the affidavit is the Registrant’s first Canadian catalogue issued in January 2006. Attached as Exhibit C are the Registrant’s subsequent catalogues from June 2008, October 2009 and March 2010. I note that each catalogue is approximately 140 pages, and offers for sale a wide variety of products for use in the garment care/dry cleaning industry. I note that while some of the products offered appear to be those of third parties, the majority of the products display the Mark or are described in the catalogue as being CLEANER’S SUPPLY brand products.

[7] Similarly, attached as Exhibit D are various printouts of cached web pages taken from the Registrant’s Canadian website, *www.cleanersupply.com/ca*, from various dates, including from the Relevant Period. Pages for each of the Wares are furnished, and explicitly identify the Wares as being CLEANER’S SUPPLY brand products.

[8] Furthermore, attached as Exhibits E through M are copies or specimens of each of the Wares. For example, Exhibit G is a specimen of a paper accessory bag. I note that the Mark appears at the bottom of the bag with the Registrant’s 1-800 phone number.

[9] Although the Requesting Party raises various objections to the evidence submitted, the main issue is with respect to the evidence of sales in Canada during the Relevant Period. The Registrant’s evidence of sales in Canada is attached as Exhibit M to the affidavit and consists of five invoices showing sales to Canadian customers of various products by the Registrant.

Having reviewed the item descriptions and the corresponding item numbers along with the exhibited catalogues, I can only identify the wares “paper accessory bags” as actually having been sold in Canada during the Relevant Period. In this regard, the exhibited March 12, 2010 invoice includes the following: “SS2 ... SAFE SECURE BAG (Orange)”, which corresponds to page 31 of the Registrant’s 2010 catalogue. As noted above, although differing in colour, a similar paper accessory bag specimen is provided as Exhibit G.

[10] Accordingly, I am satisfied that the Registrant has demonstrated use of the Mark during the Relevant Period in association with “packaging supplies for use in the garment care industry, namely, paper accessory bags” within the meaning of sections 4 and 45 of the Act.

[11] With respect to the remaining Wares, however, it is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*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 v Canada (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 wares specified in the registration during the relevant period.

[12] Although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD); *Gowling Lafleur Henderson LLP v Neutrogena Corporation* (2009) 74 CPR (4th) 153 (TMOB)], use must be shown in association with all of the wares as registered [*John Labatt Ltd v Rainier Brewing Co et al* (1984) 80 CPR (2d) 228 (FCA)]. Some evidence of sales in the normal course of trade in Canada is necessary. Such evidence can be in the form of invoices, but can also be satisfied by clear sworn statements. Although not relied on by the Registrant, I do not consider *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD) applicable in the present case. In *Saks*, there were 28 distinct categories of wares and services, furnishing evidence for all of which would have placed an unreasonable burden on the registered owner. In the present case, there are only a handful of wares, for which the Registrant has already provided

specimens of each. Thus, I do not find it unreasonable to expect the Registrant to furnish some evidence of sales in the normal course of trade with respect to each of the Wares.

[13] Furthermore, I note that Mr. Schapiro makes no clear assertion of use of the Mark in association with each of the registered Wares. His assertion of use in the third paragraph of his affidavit is only with respect to the Mark generally. As well, the Registrant furnishes neither overall sales figures nor sales figures with respect to any of the registered Wares in particular. In paragraph 6 of his affidavit, Mr. Schapiro merely states that “[a]ll of the goods set out in the Registration can be ordered on [the Registrant’s] website” and that “each of the goods in the Registration has been for sale to Canadians in association with the Trade-mark”. While it is clear that the Registrant made its catalogue available to Canadians and generally took some orders from Canadians during the Relevant Period, it has previously been held that “offering for sale” is not the same as “selling” [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)]. It is insufficient, for purposes of section 4(1) of the Act, that the Wares were merely available for sale in Canada.

[14] As such, in spite of the large volume of exhibits furnished, whether the Registrant has satisfied its evidentiary burden turns on whether the invoices in Exhibit M show any actual sales of each of the remaining registered Wares; in this respect, Mr. Schapiro simply states that “[a]ttached as Exhibit M are various invoices from the past three years showing the sale of these products in Canada”. In my view, however, they do not. As noted above, with respect to the registered Wares, I am only able to identify one sale of “paper accessory bags” in the exhibited invoices. I further note that the Registrant’s written representations are silent with respect to whether the invoices actually correspond to any of the registered Wares. As the invoices themselves do not show any such sales and there are no statements in the affidavit that would permit me to infer the requisite use with respect to such Wares, I find Mr. Schapiro’s affidavit ambiguous in this respect.

[15] Accordingly, I cannot conclude that the Registrant has demonstrated use of the Mark during the Relevant Period in association with any of the remaining Wares within the meaning of sections 4 and 45 of the Act. Furthermore, no evidence of special circumstances excusing such non-use is before me.

Disposition

[16] In view of all of the foregoing, 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 all of the Wares with the exception of the following: “packaging supplies for use in the garment care industry, namely, paper accessory bags”.

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