



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

Citation: 2010 TMOB 121
Date of Decision: 2010-08-09

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Bereskin & Parr against registration
No. TMA310,816 for the trade-mark UNIVERSAL
POWER CANADA in the name of Kleen-Flo Tumbler
Industries Limited**

[1] On April 16, 2008, at the request of Bereskin & Parr (the Requesting Party), the Registrar forwarded a notice under s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Kleen-Flo Tumbler Industries Limited (the Registrant), the registered owner of the above-referenced trade-mark (the Mark).

[2] The Mark is registered for use in association with “pneumatic tools” (the Wares).

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or 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 use since that date. In this case, the relevant period for showing use is any time between April 16, 2005 and April 16, 2008 (the Relevant Period).

[4] “Use” in association with wares is set out in s. 4 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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, s. 4(1) of the Act applies.

[5] In response to the Registrar's notice, the Registrant furnished the affidavit of Kenneth Lawrence Watt, the Vice-President, Finance & Operations of the Registrant, together with Exhibits A to E, sworn July 16, 2008. Neither party filed written submissions or requested an oral hearing.

[6] 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 and as such, the threshold test is quite low. As stated by Mr. Justice Russell in *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270:

68. [...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must "show" how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade mark owners business and merchandising practices.

[7] I will now turn to the evidence introduced by the Registrant.

[8] Mr. Watt first goes over the history of the Registrant. The Registrant was incorporated in 1939. It provides a number of tools and products for automotive, manufacturing, construction and other heavy duty industries. Mr. Watt states that "Universal Power Canada is an operating division of [the Registrant], which imports, advertises, sells and distributes pneumatic tools".

[9] More particularly, Mr. Watts states that “[f]or many years, including years in the Relevant Period, [the Registrant], through its division Universal Power Canada, has used the [Mark] in Canada in association with the [W]ares”. Mr. Watt states that “the [Mark] has been used on, and continues to be used on, carton labels, cartons, invoices and letterhead used during the normal course of trade by [the Registrant] in the sale of pneumatic tools in Canada”. He further states that “the [Mark] has been and continues to be prominently displayed during the Relevant Period in product catalogues listing pneumatic tools of Universal Power Canada”.

[10] Mr. Watt attaches to his affidavit as Exhibit A, sample carton labels that have been affixed to the packaging of Universal Power Canada’s various pneumatic tools delivered to Canadian purchasers during the Relevant Period, which display the Mark. He further attaches as Exhibit B, a photograph of an end of a sample carton affixed with one of these carton labels. While the Mark displayed on these carton labels is followed underneath by the Registrant’s address, and as such, may arguably be perceived by the average consumer as identifying the name under which the Registrant’s business is carried on, the words “UNIVERSAL POWER CANADA” appear in much larger and bolder print than the Registrant’s address. As stated by Board Member Martin in *Consumers Distributing Company Limited v. Toy World Limited*, 1990 CarswellNat 1398 (T.M.O.B.), at paragraph 14, “trade-mark and trade-name usage are not necessarily mutually exclusive”. Whether the use of a trade-name may also be use as a trade-mark depends on the circumstances of each particular case [see *Road Runner Trailer Manufacturing Ltd. v. Road Runner Trailer Co.* (1984), 1 C.P.R. (3d) 443 (F.C.T.D.)]. This brings me to consider the other exhibits attached to Mr. Watt’s affidavit.

[11] Exhibit C consists of a sample 2007 catalogue that is currently still in use. Mr. Watt states that catalogues displaying the Mark were distributed by Universal Power Canada throughout Canada during the Relevant Period. Mr. Watt states that more than 1500 catalogues bearing the Mark were distributed to clients and potential clients throughout the Relevant Period.

[12] The expression “UNIVERSAL POWER CANADA” appears on the front and back covers of the catalogue filed as Exhibit C. The expression “UNIVERSAL POWER CANADA”

appearing on the back cover of the catalogue is followed underneath by the mention “A division of Kleen-Flo Tumbler Industries Limited”, which in turn is above Universal Power Canada’s distribution and sales offices addresses. As such, it may be perceived as a trade-name to identify and distinguish the Registrant’s business rather than as a trade-mark to identify and distinguish the Wares. However, the Mark does clearly appear on its own on the front cover of the catalogue. As stated by Board Member Cooke in *Timothy’s Coffees of the World Inc. v. Starbucks Corp.*, (1997), 79 C.P.R. (3d) 147 (T.M.O.B.) at p. 151, “mail order catalogues and similar order forms which show a trade-mark may be considered use of that mark when used in combination with other materials that show the trade-mark to the consumer at the time the wares are transferred, such as invoices. In this way, the mark is brought to the attention of the purchaser at the time the order is made, and at the time that the wares are received, satisfying the criterion in [s.] 4(1)”.

[13] In the present case, the Mark is marked on the carton labels that are affixed to the packaging for the Wares. It also appears on the invoices attached as Exhibit D to Mr. Watt’s affidavit, at the time of the transfer of the Wares.

[14] More particularly, Exhibit D consists of copies of invoices related to sales in Canada during the Relevant Period of the pneumatic tools advertised in the catalogue filed as Exhibit C. Mr. Watt states that these pneumatic tools would have been sold in cartons displaying a label bearing the Mark such as those shown in Exhibit A. Furthermore, any correspondence related to these sales would have been printed on the letterhead shown in Exhibit E attached to Mr. Watt’s affidavit. The expression “UNIVERSAL POWER CANADA” displayed on these invoices and letterhead is followed underneath by either the mention “Division of/de Kleen-Flo Tumbler Industries Limited” or “Head Office/Bureau administratif”, and Universal Power Canada’s address. As such, it may be perceived as a trade-name. However, the words “UNIVERSAL POWER CANADA” appear in much larger lettering than the Registrant’s address, in close proximity with two other logos (namely a circle with the initials UP presumably standing for “UNIVERSAL POWER”, and the word “AJAX” in bold stylised letters) displayed on the top right-hand corner of the invoices and letterhead, which logos would certainly be perceived as trade-marks of the Registrant, thus reinforcing the perception that the words “UNIVERSAL POWER CANADA” are also a trade-mark.

[15] To conclude my review of the evidence furnished, there is no question that Mr. Watt's affidavit clearly evidences the sale of the Wares during the Relevant Period in Canada by the Registrant through its division Universal Power Canada, the total sales of which were in excess of \$350,000 for the years 2005 to 2007. While the supporting exhibits of use may arguably evidence use of the expression "UNIVERSAL POWER CANADA" as a trade-name, I find that the use shown may also qualify as use of the Mark *per se* for the Wares themselves.

[16] Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained in compliance with the provisions of s. 45 of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office