



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

Citation: 2010 TMOB 134
Date of Decision: 2010-08-12

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by The Stanley Works against registration
No. TMA623,309 for the trade-mark XTREME in the
name of Disston Company**

[1] At the request of The Stanley Works, the Registrar of Trade-marks forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on March 14, 2008 to Disston Company (the Registrant), the registered owner of the above referenced trade-mark.

[2] The trade-mark XTREME (the Mark) is registered for use in association with “power saw blades (excluding circular saw blades)” (the Wares).

[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 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 March 14, 2005 and March 14, 2008 (the Relevant Period).

[4] Use in association with wares is set out in s. 4(1) and 4(3) 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) applies.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. Ltd. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares and services specified in the registration, during the relevant period.

[6] In response to the Registrar's notice, the Registrant furnished the statutory declaration of Holly O. Reilly, sworn on August 29, 2008, together with Exhibits A through D. Only the Registrant filed written submissions; an oral hearing was not requested.

[7] Ms. Reilly states that she is the Vice President of Marketing for Disston Company, and as such she has knowledge of the matters to which she deposed. She further states that the rights to the Mark were assigned on January 7, 2003 from Kennametal Inc. to South Deerfield Industrial Inc., which later changed its name to Disston Company.

[8] Ms. Reilly's evidence demonstrates that during the Relevant Period, power saw blades bearing the Mark were sold by the Registrant and delivered to retailers in Canada in the normal course of trade.

[9] Attached as Exhibit A is a photograph of the XTREME power saw blades that were sold by the Registrant, or its predecessor, during the Relevant Period, mounted on a display. I note

that the Mark is prominently displayed in large, bold letters on the power saw blades and the display shown in the photographs.

[10] As evidence of sales of the Wares, Ms. Reilly states that 126,380 units of XTREME power saw blades were sold in Canada in 2005, 138,040 in 2006 and 157,880 in 2007. She provides three invoices dated within the Relevant Period demonstrating sales of the Wares in Canada, and identifying Disston Company as the vendor. The invoices attached as Exhibits B and C, dated December 7, 2005 and July 12, 2006, show the sale of forty “XTREME RECIP BLADE METAL”, twenty “XTREME RECIP BLADE –WOOD” and twenty “EXTREME RECIP BLADE – METAL” to Home Depot – Canada, with shipments to store locations in Toronto, Ontario and Coquitlam, British Columbia. Ms. Reilly explains that these descriptions are the product descriptions for types of XTREME power saw blades. The invoice attached as Exhibit D, dated August 31, 2007, details the sale and shipment of 1940 products bearing the descriptions “Xtrm Rcp-Wd” and “Xtrm Rcp-Mtl”, which Ms. Reilly explains are also product descriptions for types of XTREME power saw blades, to MiniCut International Inc. in Montreal, Quebec. Ms. Reilly states that the types of XTREME power saw blades itemized in these invoices are depicted in the photograph of XTREME power saw blades provided in Exhibit A.

[11] In view of all of the above, I find that the Registrant’s evidence clearly demonstrates that there was use of the Mark during the Relevant Period in association with “power saw blades (excluding circular saw blades)” in the manner required by the Act. Accordingly, and 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.

Ronnie Shore
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office