



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

Citation: 2016 TMOB 178
Date of Decision: 2016-10-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Eveready Battery Company, Inc.	Requesting Party
and	
Les Outillages King Canada Inc.	Registered Owner
TMA731,540 for TRU-CUT Design	Registration

[1] At the request of Eveready Battery Company Inc. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on April 23, 2015 to Les Outillages King Canada Inc. (the Owner), the registered owner of registration No. TMA731,540 for the trade-mark TRU-CUT Design (the Mark) as illustrated below:



[2] The Mark is registered for use in association with:

Circular saws (with or without lasers), metal cutting circular saws (with or without lasers), tile and marble cutting circular saws (with or without lasers), jigsaws (with or without lasers), reciprocating saws, mitre saws (with or without lasers), tile saws (with or without lasers), table saws, scroll saws, abrasive cut-off saws, band saws (for wood or metal), planers, moulding machines, jointers, shapers, router tables, radial arm saws, scroll saw blades, tile saw blades, band saw blades, reciprocating saw blades, jigsaw blades, hole saws, router bits, shaper cutters, helical cutterheads for planers and jointers, wood chisels, lathe chisels, mortising chisels, drill bits, drill bit sharpening devices, zero clearance table and dado inserts for table saws, hold-downs and feather boards and over-arm table saw blade guards (the Goods).

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the Goods, at any time between April 23, 2012 and April 23, 2015 (the Relevant Period). If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of use with respect to goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods 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 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 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v 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 goods specified in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Reuben Richman sworn on June 9, 2015. Both parties filed written representations. A hearing was not held.

The Owner's Evidence

[7] Mr. Richman describes himself as the Director of the Owner and as such he claims to have knowledge of the facts to which he deposed. The relevant portions of his affidavit can be summarized in the following terms:

- He makes an assertion of use of the Mark during the Relevant Period in association with the general category of 'saw goods' by means of marking on the cardboard packaging for such goods;
- He admits that he was unable to locate evidence showing use of the Mark during the Relevant Period in association with the following registered goods: planers, moulding machines, jointers, shapers, router tables, hole saws, router bits, shaper cutters, helical cutter heads for planers and jointers, wood chisels, lathe chisels, mortising chisels, drill bits, drill bit sharpening devices and zero clearance table inserts for table saws;
- He states that the sales of the Goods by the Owner during the Relevant Period were made in the ordinary course of trade.

[8] Mr. Richman attaches to his affidavit the following exhibits to substantiate his allegation of use of the Mark in Canada during the Relevant Period:

- For 'circular saw, with or without lasers', packaging as Exhibit A and sales invoice as Exhibit A1;
- For 'jigsaws, with or without lasers', packaging as Exhibit B and sales invoice as Exhibit B1;
- For 'mitre saws, with or without lasers', packaging as Exhibit C and sales invoice as Exhibit C1;

- For ‘tile and marble cutting circular saws’ including tile saws, packaging as Exhibit D and sales invoice as Exhibit D1;
- For ‘band saws’, packaging as Exhibit E and sales invoice as Exhibit E1;
- For ‘saw blades’, packaging as Exhibit F and sales invoice as Exhibit F1;
- For ‘dado inserts for table saws’, packaging as Exhibit G and a sales invoice as Exhibit G1.

[9] In addition, with respect to some of the Goods, Mr. Richman attests that he has been informed and verily believes that:

- A ‘jigsaw’ may also be referred to as a ‘reciprocating saw’ and as such he considers the use of the Mark in association with jigsaws to also be use of the Mark in association with the registered good ‘reciprocating saws’;
- ‘metal cutting circular saws, with or without lasers’ and ‘abrasive cutoff saws’ functionally differ from mitre saws solely in terms of the type of saw blade used. Consequently, he considers use of the Mark in association with mitre saws to also be use of the Mark in association with the registered goods ‘metal cutting circular saws and abrasive cutoff saws’;
- Various types of hold-downs, and feather boards and blade guards were included as accessories with the saw goods sold.

Analysis

[10] In its written representations, the Requesting Party raised several issues in light of the evidence filed. They are:

- Mr. Richman’s status with the Owner during the Relevant Period is unclear;
- The evidence of the Owner’s trade is lacking such that it is ‘impossible’ to determine if the exhibited invoices represent sales ‘in the normal course of trade’;

- The source of the goods is unclear as the invoices are all in the name of ‘Les Outillages King Canada Tools’ and the packaging refers to either ‘KING CANADA’ or ‘KING CANADA INC’, none of which are the Owner;
- There is no evidence or allegation of a licence agreement between the Owner and any of the entities identified on the furnished invoices and packaging;
- The exhibits furnished are not illustrations of actual packaging for the Goods but rather screenshots from a computer program;
- The furnished screenshots depict composite trade-marks that are not the Mark as registered;
- There is no evidence of use with respect to some of the Goods.

[11] I shall review each of these arguments in the context of this summary administrative proceeding using the guidelines outlined above.

Status of Mr. Richman with the Owner

[12] The Requesting Party submits that the entirety of Mr. Richman’s evidence is unreliable. In this respect the Requesting Party notes that there is no indication in Mr. Richman’s affidavit that he was a director with the Owner during the Relevant Period. It further points out there is no indication in his affidavit of any of the following: i) when he became a director of the Owner; ii) whether he was a director during the Relevant Period; iii) whether he held previous positions with the Owner or, iv) whether he had access to the business records of the Owner.

[13] However, as noted above, Mr. Richman clearly states in his affidavit that he has knowledge of the facts described in his affidavit. In any event, by virtue of his position and given the nature of the evidence, I am satisfied that Mr. Richman would be knowledgeable of the facts attested and, consequently, I do not consider the affiant’s evidence to be inadmissible as hearsay.

Absence of evidence on ‘normal course of trade’

[14] The Requesting Party submits that there is no evidence of what constitutes the Owner’s normal course of trade as required under section 4(1) of the Act. The Requesting Party submits that it has been ruled in the past that the lack of evidence on this issue can be fatal to a registered owner [citing *Sim & McBurney v Majdell Manufacturing Co. Ltd* (1986), 11 CPR (3d) (FCTD) and *S.C. Johnson & Son, Inc v The Registrar of Trade Marks* (1981), 55 CPR (2d) 34 (FCTD)].

[15] However, those cases can be distinguished from the present case. In *Majdell*, the deponent did not allege that the sales were made in the normal course of trade. Absent such a statement, the Court did not take into consideration the two invoices at issue in that case.

[16] In *S.C. Johnson*, the opponent in that case furnished no invoices and simply reproduced the wording of section 4(1) of the Act by stating that ‘...at the time of the transfer of the property in or possession of such wares, in the normal course of trade, the said trade mark was marked on the wares themselves or on the packages in which they were distributed.’

[17] In the present case, Mr. Richman plainly states that the sales were made in the ordinary course of trade. As noted by the Owner in its representations, at least two invoices were issued to Rona [Exhibits B1 and F1] during the Relevant Period. Under these circumstances, I am satisfied that the evidenced sales were made in the normal course of trade as required by section 4(1) of the Act.

Different names appears on the invoices as the seller

[18] The Requesting Party notes that all of the exhibited invoices are in the name of ‘Les Outillages King Canada Tools’ while all of the packaging indicates ‘King Canada’, except in Exhibit G which shows the inscription ‘imported by King Canada Inc’. The Requesting Party submits that none of these names is the actual name of the Owner appearing on the register. Since there is no allegation in Mr. Richman’s affidavit concerning those names, the Requesting Party argues that if the exhibits establish use of the Mark, such use cannot benefit the Owner.

[19] First, I note that the address appearing below the inscription ‘Outillages King Canada Tool’ on the invoices is the same as the address of the Owner.

[20] In *LIDL Stiftung & Co KG v Joseph Rutigliano & Sons Inc* 2005 CarswellNat 4743 (TMOB), the Registrar disposed of a similar issue in the following terms:

In the present case, given that the registered address accompanies the abbreviated form of the registrant's name, for the purposes of s. 45 it seems appropriate to accept that J. Rutigliano & Sons, Inc. is not a separate legal entity from Joseph Rutigliano & Sons, Inc.

[21] Furthermore, I note that, in his affidavit, Mr. Richman defines the Owner as ‘King Canada’.

[22] In view of this finding, as in *Joseph Rutigliano*, it seems appropriate to accept that King Canada and Les Outillages King Canada Tools are simply trade names of the Owner.

[23] In view of my finding, it is not necessary to address the issue of lack of evidence of a licence agreement between the Owner and any ‘entities’ referred above.

Packaging

[24] The Requesting Party notes that, while Mr. Richman attests that the furnished exhibits are examples of ‘packaging’, with the exception of Exhibit F, rather appear ‘to be a printout from an illustrator program that purports to show what the packaging looks like’. In other words, the Requesting Party submits that the packaging depicted as Exhibits A through E and G do not actually depict the packaging used during the Relevant Period.

[25] However, I accept that these exhibits are screenshots from a computer program depicting the various packaging. Although the depictions are not photographs, they appear to be accurate two-dimensional mock-ups of the packaging used for the large products in question. Each packaging displays a model number coinciding with the model number identified on the

corresponding invoice. Portions of the bar code are also visible on some of the depicted packaging.

[26] To be fair to the Requesting Party, Mr. Richman does state that Exhibits A to G are ‘packaging’. However, given the summary nature of a section 45 proceeding, one should not be overly zealous in dissecting the wording used by Mr. Richman concerning the exhibits in the file. Without being specimen or photographs of the actual packaging, I accept that these exhibits accurately depict what the packaging looked like during the Relevant Period.

Display of the Mark as registered

[27] The Requesting Party contends that, in any event, it is not the Mark that appears on the depicted packaging furnished, but rather design marks it identifies as TRU-CUT LASER GUIDE SYSTEM & Design (per Exhibits A, B, D and E), TRU-CUT TWIN LASER GUIDE SYSTEM & Design (per Exhibit C) or TRU-CUT série HARD PLATE series & Design (per Exhibit G).

[28] With respect to Exhibit F, there is no doubt that it constitutes a representation of the Mark on a packaging of saw blades. There are no additional terms in proximity to the Mark.

[29] As for Exhibit G, while ‘série HARD PLATE series’ appears below the Mark, I agree with the Owner that this constitutes descriptive matter that is also separate from the Mark on the displayed packaging.

[30] On the packaging depicted at Exhibits A to E inclusive, the inscriptions ‘LASER GUIDE SYSTEM’ or ‘TWIN LASER GUIDE SYSTEM’ are printed just below the Mark. However, the Mark appears either in yellow or orange while this additional text is mainly in red. As argued by the Owner, in the context of the subject goods, I accept that additional text constitutes descriptive matter. In *Nightingale Interloc Ltd v Prodesign Ltd* 1984, 2 CPR (3d) 535 (TMOB), the Registrar concluded that use of a trade-mark in combination with additional material constitutes use of that mark if the public, as a matter of first impression, would perceive the mark *per se* as being used as a trade-mark. This principle is applicable to Exhibits A to E inclusive.

[31] Consequently, I am satisfied that the furnished exhibits are representative packaging depicting the Mark as registered.

No evidence of use regarding some of the Goods

[32] As noted above, Mr. Richman admits that he was unable to find evidence of use of the Mark in association with the following registered goods:

planers, moulding machines, jointers, shapers, router tables, hole saws, router bits, shaper cutters, helical cutter heads for planers and jointers, wood chisels, lathe chisels, mortising chisels, drill bits, drill bit sharpening devices and zero clearance table inserts for table saws.

[33] Notwithstanding his general assertion of use, Mr. Richman's affidavit is otherwise silent with respect to 'tile saws (with or without lasers)', 'table saws', 'scroll saws', 'radial arm saws' and 'over-arm table saw blade guards'.

[34] The Owner furnished no evidence of special circumstances justifying non-use of the Mark during the Relevant Period within the meaning of section 45(3) of the Act, and as such the registration will be amended accordingly.

Jigsaws and reciprocating saws and their corresponding blades

[35] As for 'jigsaws', the Requesting Party argues that the statement made by Mr. Richman that 'jigsaws' may also be referred to as 'reciprocating saw' is clearly hearsay evidence since Mr. Richman made this statement based on 'information and belief' without providing his source and without providing facts to prove the necessity of that statement.

[36] As pointed out by the Registrar in *GMAX World Realty Inc v RE/Max, LLC* 2015 TMOB 169, given the summary nature of section 45 proceedings, concerns regarding hearsay evidence should generally only go to the weight given to evidence rather than admissibility.

[37] However, the Owner decided to specifically identify ‘jigsaws’ and ‘reciprocating saws’ in the list of registered goods. Therefore, it had to prove use of the Mark in association with each of them. As the only relevant packaging at Exhibit B clearly identifies the product as ‘jigsaws’, there is no evidence of use of the Mark in association with ‘reciprocating saws’ before me. The registration will be amended accordingly.

[38] I note, with respect to ‘jigsaw blades’, that the same packaging makes reference to blades being included in the package. As such, I am satisfied that the evidence shows use of the Mark in association with ‘jigsaw blades’. However, for the same reasons as above, I am not satisfied that the evidence shows use of the Mark in association with ‘reciprocating saw blades’.

Metal cutting circular saws and abrasive cut-off saws

[39] Similarly, based on information and belief, Mr. Richman states that ‘metal cutting circular saws, with or without lasers’ and ‘abrasive cut-off saws’ functionally differ from ‘mitre saws’ solely in terms of the type of saw blade used. As such he considers use of the Mark in association with ‘mitre saws’ to also be use of the Mark in association with ‘metal cutting circular saws’ and ‘abrasive cut-off saws’.

[40] The Requesting Party points out that, by his statement, Mr. Richman actually concedes that the products are functionally different and that they use different types of blades. Consequently, they would be different products with different blades and different functions. As such, use of the Mark in association with one type of product should not extend to the other types of products.

[41] I agree with the Requesting Party’s position. In any event, again, the Owner chose to specifically identify each of these goods in the registration. Therefore, it had to establish use of the Mark in association with each of them. However, the relevant evidence at Exhibit C only depicts the packaging for a ‘mitre saw’.

[42] Consequently, I am satisfied the Owner has demonstrated use of the Mark in association with ‘mitre saws (with or without lasers)’. However, it failed to show use of the Mark in association with ‘metal cutting circular saws’ and ‘abrasive cut-off saws’. As such, the registration will be amended to delete ‘metal cutting circular saws (with or without lasers)’ and ‘abrasive cut-off saws’.

Dado inserts for table saws, hold-downs and feather boards

[43] Exhibit G depicts a packaging identified as ‘dado blade set’. Mr. Richman describes such exhibit as being ‘dado inserts for table saws’. I am therefore satisfied that there is evidence of use with respect to such goods.

[44] I note that a ‘hold-down’ is part of the ‘mitre saw’ equipment identified on the packaging depicted on Exhibit C. Therefore, I am satisfied that the Owner has demonstrated use of the Mark in association with “hold-downs”. However, none of the packages refer to “feather boards” or “blade guards”. Consequently, I am not satisfied that the evidence shows use of the Mark in association with such goods. The registration will be amended accordingly.

Use of the Mark in association with various types of blades

[45] The depicted packaging for ‘tile saw’ (Exhibit D) and ‘band saw’ (Exhibit E) make reference to blades included in the package. As such, I am satisfied that there is use of the Mark in association with ‘tile saw blades’ and ‘band saw blades’.

[46] However, as mentioned before, there is no evidence of use of the Mark in association with ‘scroll saws’. I note that there is also no evidence of use of the Mark in association with ‘scroll saw blades’. The registration will be amended accordingly.

Summary

[47] In summary, I conclude that the Owner has discharged its burden to prove that it has used the Mark in Canada during the Relevant Period, within the meaning of section 4(1) of the Act, in association with the following goods only:

Circular saws (with or without lasers), tile and marble cutting circular saws (with or without lasers), jigsaws (with or without lasers), mitre saws (with or without lasers), band saws (for wood or metal), tile saw blades, band saw blades, jigsaw blades, dado inserts for table saws and hold-downs.

[48] With respect to the remaining goods, I am not satisfied that the Owner has demonstrated use of the Mark within the meaning of section 45 of the Act.

[49] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to read:

Circular saws (with or without lasers), tile and marble cutting circular saws (with or without lasers), jigsaws (with or without lasers), mitre saws (with or without lasers), band saws (for wood or metal), tile saw blades, band saw blades, jigsaw blades, dado inserts for table saws and hold-downs.

in compliance with the provisions of section 45 of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENT(S) OF RECORD

Anissimoff & Associates

FOR THE REGISTERED OWNER

Perley-Robertson, Hill & McDougall LLP

FOR THE REQUESTING PARTY