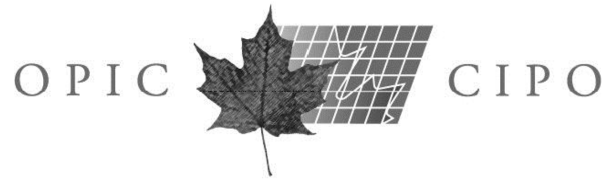

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 131
Date of Decision: 2012-07-19

IN THE MATTER OF A SECTION 45 PROCEEDING requested by CleanBrands LLC against registration No. TMA678,030 for the trade-mark CLEANSLEEP in the name of Marshall Ventilated Mattress Company Limited

[1] At the request of CleanBrands LLC (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 15, 2010, to Marshall Ventilated Mattress Company Limited, the registered owner (the Registrant) of registration No. TMA678,030 for the trade-mark CLEANSLEEP (the Mark):

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

> Mattresses, box springs and mattress related accessories, namely mattress pads and mattress protectors.

[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 use since that date. In this case, the relevant period for showing use is between April 15, 2007 and April 15, 2010 (the Relevant Period).

[4] The relevant definition of "use" in the present case 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 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] It is settled law that evidentiary overkill is not required in order to properly reply to a section 45 notice [*Union Electric Supply Co Ltd v Registrar of Trade-marks* (1982), 63 CPR (2d) 56 (FCTD)]. The test that has to be met by a registrant under section 45 is not a heavy one. All the registrant has to do is establish a *prima facie* case of use [*Cinnabon, Inc v Yoo-Hoo of Florida Corp* (1998), 82 CPR (3d) 513 (FCA)]. However, sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the registered wares and services during the relevant period.

[6] In response to the Registrar's notice, the Registrant furnished the affidavit of Brad Warner, the Managing Partner – Sales of the Registrant. Both parties filed written submissions and were represented at an oral hearing.

[7] In his affidavit, Mr. Warner provides that the Registrant is a manufacturer of mattresses and box springs. He explains that the Registrant primarily sells mattresses and box springs in association with the Mark to wholesale customers in Canada, including The Bay department stores, various department stores, mattress specialty stores, and bedroom furniture stores. These stores then resell the mattresses and box springs to retail consumers for residential use.

[8] With respect to the manner in which the Mark is associated with mattresses and box springs, Mr. Warner provides Exhibits A, B, C, and D. Exhibit A consists of copies of printed

product information sheets which Mr. Warner states are displayed in stands located next to mattresses and box springs when displayed in a store for purchasers to examine and test during a purchase. I note that the Mark clearly appears on the product information sheets together with a description of various features of the product.

[9] Exhibits B and C consist of product labels which Mr. Warner states are inserted under a transparent plastic sleeve that covers a foot portion of the mattresses and box springs when displayed in a store for purchasers to examine and test during a purchase. Again, I note that the Mark clearly appears on these labels together with a description of various features of the product.

[10] Lastly, Exhibit D consists of a letter sized brochure page which Mr. Warner states is displayed near a mattress and box spring in a store display area, is given to potential purchasers during discussions with sales staff, and is given to purchasers as an aid in understanding various features of the wares. As in the other exhibits, the Mark clearly appears on the brochure page together with a description of various features of the product.

[11] Further evidence consists of brochures given to retail store staff as a selling aid to educate sales staff of the various CLEANSLEEP features of the wares (see Exhibits E and F). This documentation appears to relate to mattress and box spring sleep sets. While the documentation is not directed for use by end consumers, it corroborates Mr. Warner's statements indicating that such wares are sold at The Bay department stores, as one of the brochures indicates that the particular mattress featured, which includes CLEANSLEEP features, is available exclusively at The Bay.

[12] Mr. Warner then concludes his affidavit by stating that "the revenue generated by sales of wares marked with the CLEANSLEEP trade-mark … have been in the range of $150,000 Canadian dollars annually between 2005 and 2010."

[13] Based on the evidence provided, I am satisfied that the Registrant has met its *prima facie* burden to show use of the Mark in association with "mattresses and box springs" during the Relevant Period in Canada. The evidence demonstrates that the Mark was associated with these wares at the time of transfer through the use of labels clearly bearing the Mark affixed to these

wares (Exhibits B and C). Furthermore, the display of a trade-mark on in-store materials shown within close proximity to the wares so as to bring the trade mark to the attention of consumers as of the time of transfer of possession of the wares to the consumer has been held to provide sufficient notice of association of a trade-mark with those wares [see *Riches, McKenzie & Herbert LLP v Parissa Laboratories* (2006), 59 CPR (4th) 219 (TMOB)]. Such is the case with the printed product information sheets furnished under Exhibit A.

[14] The Requesting Party argues that the Registrant has not furnished evidence of a commercial transaction involving the wares or expressly described a single sale of mattresses and box springs. Furthermore, the Requesting Party argues that as Mr. Warner has not provided a breakdown by wares of the Canadian annual sales figures, it is impossible to determine that the sales figures represent sales of each of the wares covered by the trade-mark registration [citing as support, *Financial Models Co v FMC Corp*, 2006 CarswellNat 2099 (TMOB)].

[15] While it is true that the Registrant has not provided invoices, there is no requirement to do so [*Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 at 486 (FCTD)]. Furthermore, the fact situation in *Financial Models, supra*, is distinguishable, as there was no evidence other than a bare statement of use tying the general sales figures to *each* of the registered wares. In the present case, the Registrant has provided several pieces of evidence showing how the Mark was associated with "mattresses" and "box springs", as well as evidence that corroborates Mr. Warner's sworn statement that sales of these goods are conducted through wholesale customers such as The Bay. Together with the substantial sales figures quoted, I find the evidence as a whole sufficient to show that sales of "mattresses" and "box springs" associated with the Mark took place in Canada during the Relevant Period.

[16] However, the Requesting Party argues, and I agree, that there is no evidence of use of the Mark with respect to the wares described as "mattress related accessories, namely mattress pads and mattress protectors". At the oral hearing, the Registrant argued that the Warner affidavit speaks to the wares generally and since "mattress related accessories" are integral parts of mattresses and box springs, a reasonable inference should be drawn that such wares are sold as well. In this regard, the Registrant referred to the decision in *Moffat & Co v Westinghouse Air Brake Co* (2001), 14 CPR (4th) 257 (FCTD), where the Court found that evidence of use of the

mark in association with some of the wares was sufficient to maintain the registrations in respect of the remaining wares, as it was concluded that the registered wares comprised a broad category of wares.

[17] In the *Westinghouse* case, the Registrant filed evidence that established that the registered wares comprised a broad category of wares, namely "parts used in railway equipment construction", and that some of the wares were constituent parts of the devices comprised in this category. In the present case, there is no comparable evidence. Furthermore, when viewing the Warner affidavit in its entirety, I cannot infer that "mattress related accessories…" were sold in association with the Mark at any time. Indeed, Mr. Warner consistently refers specifically to "mattresses" and "box springs" throughout his affidavit, from his description of the Registrant as a manufacturer of such goods, to the identification of various exhibits (A, B, C, and D) as pertaining to use of the Mark with "mattresses" and "box springs". Nowhere in the affidavit does Mr. Warner refer specifically to "mattress related accessories…" other than in his recitation of the wares as they appear in the registration. While Mr. Warner vaguely refers to the brochures in Exhibits E and F as aids in understanding the "eco-friendly features of the *wares*", it is clear from a review of these brochures that they too refer solely to mattresses and box springs.

[18] Lastly, as previously discussed, while Mr. Warner's statement regarding sales revenue refers generally to "*wares* marked with the CLEANSLEEP trade-mark", I find in view of the affidavit as a whole, that this statement reasonably refers to "mattresses" and "box springs". At best, his statement regarding sales revenue is ambiguous, and ambiguities in evidence are to be interpreted against the interests of the registered owner [*Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 45 CPR (2d) 194 at 198; aff'd 53 CPR (3d) 62 (FCA)]. In any event, even if I were to accept Mr. Warner's statement as referring to each of the registered wares, the evidence would still be insufficient to maintain the "mattress related accessories…" on the registration, as there is no evidence showing how the Mark was associated with these wares at the time of transfer.

Disposition

[19] Accordingly, having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following wares:

"mattress related accessories, namely mattress pads and mattress protectors" in compliance with the provisions of section 45 of the Act.

____

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office