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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 93

Date of Decision: 2020-07-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar

Requesting Party

and

The Black & Decker Corporation

Registered Owner

TMA632,160 for PROTOUCH

Registration

[1] At the request of Smart & Biggar (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on March 20, 2018 to Irwin Industrial Tool Company (the Owner), the registered owner, at that time, of registration No. TMA632,160 for the trademark PROTOUCH (the Mark).

[2] The Mark is registered for use in association with the goods “Hand held tools namely, chisels.”

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the goods specified in the registration, at any time between March 20, 2015 and March 20, 2018 (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 reason for the absence of such use since that date.

[4] The relevant definition of “use” in association with goods, in the present case, is set out in section 4(1) of the Act as follows:

4(1) A trademark 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 the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. A registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428 at paragraph 2].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Gabriel A. Haboubi, sworn on June 18, 2018. Only the Owner filed written representations; an oral hearing was not requested.

[7] On September 10, 2019, the Registrar recorded a December 3, 2018 assignment of the registration from the Owner to The Black & Decker Corporation. That assignment is not at issue in this proceeding.

THE OWNER’S EVIDENCE

[8] In his affidavit, Mr. Haboubi identifies himself as Senior Group Patent Counsel for the Owner’s parent company Stanley Black & Decker, Inc. (SBD), a “diversified global provider of hand tools, power tools and related accessories, mechanical access and electronic security solutions, healthcare solutions, engineered fastening systems and more”.

[9] Mr. Haboubi explains that SBD acquired the Owner in March 2017. According to Mr. Haboubi, SBD has, since the acquisition, owned the right to use the Mark throughout North America, including in Canada, in association with hand tools and specifically chisels. He attests that SBD has control over the character and quality of these hand tools, including the chisels. He

further states that, through its subsidiary the Owner, SBD owns the registration at issue in this proceeding.

[10] With respect to use of the Mark, Mr. Haboubi asserts that it has been used in Canada in association with chisels for many years through to the present day—including specifically the relevant period—and that such use has been continuous from at least the beginning of 2016 up until the present time.

[11] Mr. Haboubi explains that the Mark, sometimes depicted as “ProTouch”, denotes the specific handle or “grip” on the construction chisels “bearing the brand”, and signifies an ergonomic design that makes the handle comfortable, and sufficiently durable, to use during jobsite construction work that requires repeated strikes of the tool. He states that the PROTOUCH range of chisels and chisel sets in Canada includes 27 specific products, and he lists the item number and product name abbreviation for each one. As Exhibit A to his affidavit, he attaches copies of the Owner’s catalogue pages that depict the Owner’s construction chisels featuring the PROTOUCH chisel handle. He identifies 11 specific item numbers on the catalogue pages as chisels with the PROTOUCH handle that were sold in Canada in 2016 and 2017.

[12] The exhibited catalogue pages consist of a title page—with “IRWIN® Marples®” and “Chisels” in the header—and three product pages. The product pages are subtitled “High Impact Chisels”, “Construction Chisels”, and “Woodworking Chisels” respectively, and each lists some of the item numbers identified by Mr. Haboubi. The pages do not show the Mark displayed on any of the depicted chisels or chisel sets or on any of the depicted packaging. However, the descriptive text advertises the High Impact Chisel as featuring “a ProTouch™ over-mold grip for added ergonomic comfort” and the Construction Chisel as being comfortable to hold with its “ProTouch™ grip” and having an “[e]rgonomic handle design with ProTouch™ Grip [which] is durable enough to withstand jobsite abuse”. The Mark is not mentioned on the Woodworking Chisels page.

[13] Finally, Mr. Haboubi provides net sales figures for PROTOUCH chisels in Canada, in the order of tens of thousands of dollars, for each of 2016 and 2017. He specifies that these chisels were sold to a number of stores, including Lowes, Home Hardware, and Amazon.ca, but does not break down the sales figures either by store or by product. As Exhibit B to his affidavit, he

attaches webpages from Canadian retailer websites that he states sold PROTOUCH chisels during the relevant period. As Exhibit C to his affidavit, he attaches sample invoices from 2016 and 2017 documenting such sales.

[14] The exhibited webpages are from Lowes, Home Hardware, Amazon.ca, and KMS Tools. Each set of webpages features a small image of a packaged product. Owing to the size of the images, it is not possible to determine whether the Mark appears on the products or packaging featured on the first two websites; however, the Mark does clearly appear on the packaging of the product featured on the last two websites, as described below. I note the following:

- An April 6, 2018 printout from *lowes.ca* advertising an IRWIN Marples 4-Pack Construction Chisels Set (Mfr Part # 1819361), with an option to “Add to Cart”. The product description includes the following: “Ergonomic handle design with ProTouch® Grip is durable enough to withstand jobsite abuse”.
- An April 6, 2018 printout from *homehardware.ca* advertising an IRWIN 3 Piece Marples Wood High Impact Chisel Set (Model #1819362). The product description does not reference the Mark.
- A June 18, 2018 printout from *amazon.ca* advertising a chisel with the product description “IRWIN Tools Marples Construction Chisel 1-Inch (1768777)”, with an option to “Add to Cart”. The product details include the following: “Protouch grip for comfort, reduced fatigue and better grip”. The advertisement notes, “Only 1 left in stock (more on the way)”.
- Another June 18, 2018 printout from *amazon.ca*, featuring an enlargement of the aforementioned chisel. In this image, it can be seen that the product’s packaging clearly displays the Mark in the form of a logo (PROTOUCH GRIPS Logo). The logo consists of the word “ProTouch” above and touching the word “GRIPS”, all in a thick lettering style, with the “ProTouch” element being slightly italicized and embellished by a horizon stroke through each of the letters P and T. I note that “Pro” is the same shade of blue and “Touch” is the same shade of yellow as in the blue-and-yellow colour scheme applied to the rest of the packaging and to the chisel’s handle, whereas “GRIPS” is white. (Although the packaging of the products depicted on the aforementioned *lowes.ca* and

homehardware.ca webpages is of a similar style, the details of those packages are too small to make out and none of their markings appear to be consistent with the PROTOUCH GRIPS Logo.)

- An April 6, 2018 printout from *kmstools.com* advertising various Irwin Marples construction and woodworking chisels and chisel sets, including a more detailed advertisement for an Irwin 1" Marples Construction Chisel (Model: 1768777). This appears to be the same product as on *amazon.ca*, in the same packaging. The product description includes the following: “Ergonomic handle design with ProTouch Grip is durable enough to withstand jobsite abuse”. The advertisement provides an option to “ADD TO CART” and also notes the product’s availability in 11 KMS Tools stores in British Columbia and Alberta; some of these stores have up to three of the items in stock and others only have “More Coming”.

[15] As for the invoices, one is for a “4PC CONSTRUCTION CHISEL SET QP12” (item no. 1885165) sold to Lowes in Ontario and the remaining five are for products that include a “CHISEL HIGHT IMPACT CLAM 3PC” (item no. 1819362) sold to Home Hardware in Ontario and Alberta. Each invoice is for between one hundred and several hundred units of the respective chisel sets. I note that the item sold to Lowes is indicated to have been discontinued and, indeed, is not represented in the exhibited catalogue pages. However, the item sold to Home Hardware is one that *is* listed in the catalogue. The invoices appear to be from Irwin Tools Canada ULC, but indicate that cheques are to be remitted to IRWIN Industrial Tool-Canada, and provide a Customer Service telephone number that matches the telephone number printed in the footer of the Exhibit A catalogue pages. The Mark is not referenced on the invoices.

ANALYSIS

[16] As noted above, the burden of proof in section 45 proceedings is a light one. Section 45 proceedings are not intended to try contested issues of fact or to provide an alternative to the usual *inter partes* attack on a trade-mark envisaged by section 57 of the Act [*Meredith & Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)]. The evidence need not be perfect; a registered owner need only establish a *prima facie* case of use and the Registrar may draw reasonable inferences from the facts provided [see *Diamant Elinor Inc v*

88766 Canada Inc, 2010 FC 1184, 90 CPR (4th) 428; and *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64, 48 CPR (4th) 223]. In this respect, the evidence must be considered as a whole and the exhibits interpreted in conjunction with the statements made in the affidavit [see, for example, *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[17] In the present case, it is clear from the invoices at Exhibit C that the Owner's chisels were sold in Canada during the relevant period. Although Mr. Haboubi does not explain the relationship between the Owner and Irwin Tools Canada ULC, whose name is displayed at the top of the invoices, or Irwin Industrial Tool Canada, whose name appears in the "Remit Checks To" box, I note that the Customer Service telephone number provided on the invoices is the same as the telephone number in the Exhibit A catalogue. In his affidavit, after defining the Owner as "Irwin", Mr. Haboubi identifies Exhibit A as being "Irwin catalogue pages that depict the Irwin construction chisel that features the PROTOUCH chisel handle" (para 7, emphasis added). In view of the foregoing, I accept that the Owner is the source of the invoiced products and that Irwin Tools Canada ULC and Irwin Industrial Tool Canada merely act as the Owner's distributors in Canada.

[18] I reach this conclusion not only for the three invoices dated before March 2017 but also for the three invoices dated after. In this respect, Mr. Haboubi states in his affidavit that SBD has, since its March 2017 acquisition of the Owner, owned the right to use the Mark in Canada and, through its subsidiary the Owner, owns the registration for the Mark. Since the Register indicates that, throughout that time, it was the *Owner* who owned the registration, I interpret Mr. Haboubi's statement to mean simply that, from March 2017 to the time of his affidavit, SBD owned the company that owned the registration and right to use the Mark.

[19] With respect to Mr. Haboubi's statement that SBD has control over the character and quality of the chisels with which the Mark is used, it is not clear whether such control is by SBD itself or, again, "through its subsidiary". However, it is not necessary to answer this question, as it will not change my conclusion that the aforementioned invoiced sales enure to the Owner's benefit. Although section 50 of the Act provides that, in certain circumstances, use of a trademark enures to the benefit of the entity that controls the character or quality of the goods or

services, section 50 only applies in cases where that control is exercised by the *owner* of the Mark. In the present case, it has not been established that anyone other than the Owner owned the Mark during the relevant period.

[20] The determinative question in this case is whether the evidence is sufficient to show that, at the time of the transfer of the goods—either from the Owner to its Canadian retailers or from the retailers to the ultimate consumer—the Mark was marked on the goods themselves or on the package in which they were distributed, or otherwise so associated with the goods that notice of the association was then given.

[21] In this respect, it is well established that a trademark owner’s ordinary course of trade will often involve distributors, wholesalers and/or retailers, and that use of a trademark at any point along the chain of distribution enures to the benefit of the owner, provided that the marked goods originate from the owner [see *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD); *Lin Trading Co v CBM Kabushiki Kaisha* (1988), 21 CPR (3d) 417 (FCA); and *Osler, Hoskin & Harcourt v Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD)].

[22] In its written representations (at para 14), the Owner submits that,

Catalogue information, sku information, and sample invoices all combine to reinforce the [Owner’s] position that use in the normal course of trade has been shown during the relevant period, by way of the Mark being displayed on the Goods themselves, on their packaging and on materials that accompany the Goods at the time of transfer of possession of the Goods in the normal course of the [Owner’s] trade.

[23] However, as noted above, the exhibited catalogue pages do not show the Mark displayed on chisels or their packaging. At best, the catalogue displays the Mark in describing the High Impact and Construction chisels as having a “ProTouch™ over-mold grip”, “ProTouch™ grip” or “ProTouch™ Grip”. However, there is no evidence that such catalogues accompanied the chisels sold at the time of their delivery or transfer. Indeed, the exhibited catalogue pages are undated and Mr. Haboubi does not provide any information on how such catalogues were distributed or made available, during the relevant period or otherwise. Accordingly, neither the catalogues nor the information they contain demonstrates use of the Mark, even when considered in combination with Mr. Haboubi’s item number information and the sample invoices.

[24] The only other evidence of the Mark's display is on the webpages from Canadian retailer websites advertising the Owner's chisels (Exhibit B). Mr. Haboubi confirms that these retailer websites sold PROTOUCH chisels during the relevant period; indeed, the *lowes.ca*, *amazon.ca*, and *kmstools.com* websites sites show an online cart option, indicating the possibility for consumers to purchase chisels directly from the site.

[25] Generally, where a customer can order goods from a website that displays a trademark, there can be use of that trademark in association with the goods [*Law Office of Philip B Kerr v Face Stockholm Ltd* (2001), 16 CPR (4th) 105 (TMOB); see also *Fraser Milner Casgrain LLP v LG Electronics Inc* 2014 TMOB 232, 130 CPR (4th) 273]. However, merely "offering for sale" is not the same as "selling" [*Michaels & Associates v WL Smith & Associates Ltd.* (2006), 51 CPR (4th) 303 (TMOB); *Riches, McKenzie & Herbert LLP v Cleaner's Supply Inc.*, 2012 TMOB 211, 2012 CarswellNat 5229]. Some evidence of transfers in the normal course of trade in Canada is necessary. Otherwise, webpages offering goods for sale only demonstrate advertising of the goods, which does not meet the requirements of section 4 of the Act.

[26] In the present case, there is no direct evidence of transfers from the retailers to consumers. It may be reasonable to infer that a large retailer having acquired hundreds of units of a type of chisel or chisel set in 2016 would have sold at least some of those units by March 2018. However, Mr. Haboubi provides only a total sales figure for PROTOUCH chisels in Canada for each of 2016 and 2017, without specifying whether the retailers represented at Exhibit B purchased *the specific items on the depicted webpages* during the relevant period. Nevertheless, he does provides substantial net sales figures, in the tens of thousands of dollars, for the Owner's sales of PROTOUCH chisels in Canada to retailers including Lowes, Home Hardware, and Amazon.ca during the relevant period. Moreover, for reasons that will be discussed below, I find his evidence sufficient for a conclusion that at least one of the depicted models of chisel would have been among those sold in Canada during the relevant period.

[27] Most of the webpages at Exhibit B indicate a print date less than three weeks after the end of the relevant period (the *amazon.ca* pages indicate a print date three months after the end of the relevant period), and there is therefore a question as to whether the exhibited webpages would have appeared substantially similar *during* the relevant period. However, given the

relatively short time elapsed, I am prepared to infer that the *product packaging* depicted on the retailers' websites would have been the same during the relevant period. Moreover, any display of the Mark on product packaging would be present at the time of transfer, either from the Owner to its Canadian retailers, or from the retailers to the ultimate consumer.

[28] In this respect, the exhibited printouts from *amazon.ca* include an image of a chisel's packaging displaying the PROTOUCH GRIPS Logo, which I accept constitutes display of the Mark. In applying the principles set out in *Canada (Registrar of Trade Marks) v Cie Internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB), I am satisfied the Mark stands out from the descriptive word GRIPS, which is on a separate line, in a different style of lettering, and in white rather than the blue and yellow colours of the Owner's get-up.

[29] The packaging on which the PROTOUCH GRIPS Logo is displayed is for the 1" Marples Construction Chisel, item no. 1768777. Although no sample invoices are provided for this product, Mr. Haboubi states that it is in the PROTOUCH range of chisels and chisel sets in Canada and I note that it is listed in the Exhibit A catalogue. Although Mr. Haboubi does not identify this product among the 11 catalogue products sold in 2016 and 2017, the relevant period ends in 2018. Exhibit B shows that this item was available on at least one Canadian retailer's website and in several of its stores less than three weeks after the end of the relevant period.

[30] Furthermore, I accept that Mr. Haboubi's affidavit establishes the following:

- The Canadian retailers that sold the Owner's PROTOUCH chisels to consumers during the relevant period include Amazon.ca and KMS Tool (para 10, Exhibit B).
- Chisel item no. 1768777 displays the Mark on its packaging and this chisel was being shown and made available for purchase on the *kmstools.ca* website and in KMS Tools stores in Canada as of April 6, 2018. At that time, the site indicated that the item was in stock online; that four stores had between 1 and 3 of the items in stock, and that seven stores were out of stock but had "More Coming" (Exhibit B).
- Chisel item no. 1768777 was also being shown (with the Mark clearly displayed on its packaging) and made available for purchase on the *amazon.ca* website as of June 18,

2018. At that time, the site claimed to have only one such item left in stock but more “on the way” (Exhibit B).

[31] In my view, it can reasonably be inferred that the retail sites or stores that indicated having only a few items left in stock, but more “coming” or “on the way”, were, at least at that time, keeping the item in stock, and, as such, would have both purchased from the Owner and sold to consumers at least some such stock in the weeks leading up to the date the printouts were made. The printouts from the KMS Tools website were made less than three weeks after the end of the relevant period.

[32] Accordingly, bearing in mind the purpose of section 45 and the low burden of proof, I find the foregoing evidence sufficient for an inference that the Owner had, at least, sold some chisels in packaging bearing the Mark to KMS Tools in Canada during the relevant period.

DISPOSITION

[33] On balance, although the evidence is not as precise as it could have been, I am satisfied that it is sufficient for a *prima facie* case of use of the Mark in association with the goods “hand held tools namely, chisels”.

[34] In view of all the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

[35] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be maintained.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Jane Steinberg
(Gowling WLG (Canada) LLP)

FOR THE REGISTERED OWNER

Smart & Biggar LLP

FOR THE REQUESTING PARTY