

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

**Citation: 2013 TMOB 147
Date of Decision: 2013-09-03**

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Cameron MacKendrick against
registration No. TMDA51,661 for the trade-mark
ARCTIC in the name of Phoenix Brands Canada
Laundry LLC.**

[1] On March 9, 2011 at the request of Cameron MacKendrick (the Requesting Party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* RCS 1985, c T-13 (the Act) to Phoenix Brands Canada Laundry LLC (the Registrant), the registered owner of registration No. TMDA51,661 for the trade-mark ARCTIC (the Mark).

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

- (1) Soaps of all kinds, including laundry and toilet soap, in the form of cakes, bars, flakes, chips, powder, granules or liquids.
- (2) All- purpose detergent and cleaner.

[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 9, 2008 and March 9, 2011.

[4] The relevant definition of “use” in association with wares is set out in section 4(1) 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.

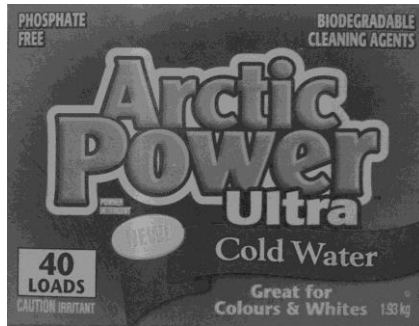
[5] In response to the notice, the Registrant furnished the affidavit of E. Mark Landry, President and Chief Executive Officer of the Registrant, sworn on October 10, 2011. Only the Registrant filed written representations; an oral hearing was not held.

[6] In his affidavit, Mr. Landry states that the Registrant is a manufacturer and distributor of consumer household products, focusing on “the manufacture and distribution of a portfolio of laundry care brands”. With regards to the registered wares, he attests only to the sale of “powdered laundry detergent and liquid laundry detergent” in association with the Mark and furnishes evidence limited in that respect.

[7] Mr. Landry specifies that since 2007, its laundry detergent products have been manufactured in the United States by “authorized licensees...in accordance with the standards and specifications set by [the Registrant]” and, subsequently, distributed by the Registrant to its Canadian customers who in turn resell to Canadian consumers. Mr. Landry attests to sales revenues exceeding \$24million per year during the relevant period, as well as to significant marketing expenditures. Attached to his affidavit are 11 invoices dating from the relevant period, which he attests are representative of sales made by the Registrant to customers in Canada during that time. I note that, based on the abbreviations “PWD” and “LQD” found in the product descriptions, the invoices demonstrate sales of both powdered and liquid laundry detergent.

[8] The issue in this case, however, is whether the evidenced sales of laundry detergent were made in association with the Mark as registered. In this respect, Mr. Landry states that the Mark appeared directly on the packaging of its laundry detergent and he provides photographs of the containers at Exhibits B and C. At Exhibits E and F,

he also provides sample consumer coupons distributed by the Registrant in Canada during the relevant period. Portions of Exhibits B and E are shown below, and are illustrative of the manner of display of the trade-mark during the relevant period:



(Exhibit B)



(Exhibit E)

[9] In its written representations, the Registrant submits that the Mark is used as registered, or in the alternative, the deviation is so minor as to be inconsequential.

[10] With respect to the first submission, it is my view that the public, as a matter of first impression, would perceive the trade-mark as “Arctic Power” in stylized font. As depicted on the containers, the words “Arctic” and “Power” are in the same font and colour, surrounded by a white border that unifies the two words into a single design. I note that the placement of the registered trade-mark symbol beside the word “Power” but outside of the white border reinforces this impression.

[11] Furthermore, even if I were to accept the coupons as likely being associated with the laundry detergent at the time of transfer, I note that the trade-mark displayed on the coupons is also “Arctic Power”, with the registered trade-mark symbol following the word “Power”, both in the depictions of the containers as above and in the coupon text.

[12] I would also note that the product descriptions in the exhibited invoices only contain variations of “Arctic Power” (such as “A/POWER”, “A/PWR” and “ARCTIC PWR”) and never “Arctic” in isolation.

[13] As such, I do not accept the Registrant’s submission that the Mark was used as registered. The question to be asked, then, in cases like this where the trade-mark used

deviates from the trade-mark as registered, is whether the mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [see *Canada (Registrar of Trade-marks) v Compagnie Internationale pour l'informatique CII Honeywell Bull*, (1985), 4 CPR (3d) 523 (FCA) (*Honeywell Bull*)]. In deciding this issue, one must look to see if the “dominant features” of the trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc*, (1992), 44 CPR (3d) 59 (FCA)]. Lastly, the use of a trade-mark in combination with additional words or features constitutes use of the registered mark if the public, as a matter of first impression, would perceive the trade-mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd*, (1984), 2 CPR (3d) 535 (TMOB)].

[14] In its written submissions, the Registrant submits that the addition of the word POWER is “so minor and unimportant that it is unlikely to lead to an inference...that the [laundry detergents] come from a source other than Phoenix Brands”. In support, the Registrant cites case law demonstrating that in certain circumstances, minor deviations of a trade-mark have been acceptable [*Hofbauer Associates v Toronto-Dominion Bank* (2001), 14 CPR (4th) 395 (TMOB); *Norman M Cameron Law Corporation v CMS Cameron McKenna*, 2009 CarswellNat 5044 (TMOB); *Aesus Systems Inc v Sleever International Company* (2009), 76 CPR (4th) 401 (TMOB)].

[15] However, it is a question of fact whether the differences between the marks are “so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences identify goods having the same origin” [*Honeywell Bull* at 525]. As such, the case law referenced by the Registrant is of limited value in the present circumstances. For example, in *CMS Cameron Mckenna*, the deviation consisted of a design element in addition to the trade-mark as registered and it was held that consumers, at first impression, would view the design as a separate trade-mark. As well, in *Sleever International*, it was found that the addition of the word “INTERNATIONAL” after the registered mark “SLEEVEVER” did not constitute a modification of the dominant component of the registered trade-mark and that consumers would not be misled. Similarly, in *Hofbauer*, additional descriptive elements and a minor spelling difference in

the trade-mark as used were not considered to be substantial deviations of the dominant features of the registered trade-mark “FUTURLINK”.

[16] In the present case, however, in my view the dominant feature of the trade-mark as registered has not been preserved by the addition of the word POWER. The addition of the word POWER substantially alters the dominant feature of the trade-mark as registered: visually, phonetically and in the idea suggested. There is no evidence before me to support the Registrant’s contention that the average consumer would perceive the word “Power” as merely being a “laudatory term”. Nor is there any evidence before me that the trade-mark as used is part of a family of ARCTIC brand laundry detergents, such that the average consumer would perceive the ARCTIC POWER laundry detergents as originating from the same source as other ARCTIC brand laundry detergents.

[17] Consequently, in view of the foregoing, I cannot conclude that the Registrant has demonstrated use of the Mark in association with the wares within the meaning of sections 4 and 45 of the Act. Furthermore, the Registrant has provided no evidence of special circumstances excusing the absence of use.

Disposition

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

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office