

SECTION 45 PROCEEDINGS
TRADE-MARK: TURBO TEAM
REGISTRATION NO.: TMA517,533

[1] At the request of BSH Home Appliances Corporation (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) on May 30, 2007 to H-P Products, Inc., the registered owner of the above-referenced trade-mark (the “registrant”).

[2] The trade-mark TURBO TEAM is registered for use in association with “vacuum cleaning kit comprised of a turbine-powered nozzle, wands, hoses, brushes, and attachment caddy”.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares and/or 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 any time between May 30, 2004 and May 30, 2007.

[4] “Use” in association with wares is set out in subsections 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, subsection 4(1) applies.

[5] In response to the Registrar's notice, the registrant furnished the affidavit of Amy J. Wesely, sworn on November 27, 2007, together with Exhibits "A1" through "C". Only the registrant filed written submissions; an oral hearing was not requested.

[6] Ms. Wesely states that she is the Marketing Manager of H-P Products, Inc. As such, she has knowledge of the matters set out in the affidavit, based on her personal knowledge and a review of the company's records.

[7] 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.) at 480], and evidentiary overkill is not required, 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/services specified in the registration during the relevant period.

[8] With respect to the manner in which the trade-mark is associated with the wares, Ms. Wesely provides a digital photograph of "a portion of the box in which the TURBO TEAM Products [previously defined as the wares specified in the registration] are sold in Canada" as Exhibit "C" to her affidavit. She adds that the photograph is "representative of the packaging used by H-P [the registrant] during the relevant time period to sell its TURBO TEAM Products in Canada". The photograph attached as Exhibit "C" depicts a cut out cardboard on which the trade-mark can be seen as well as the words DELUXE CLEANING KIT on a separate line underneath in a smaller size. Despite the additional wording, I am of the view that the trade-mark's identity remains recognizable in this case.

[9] Furthermore, the affiant states that the "vacuum cleaning kit comprised of a turbine-powered nozzle, wands, hoses, brushes, and attachment caddy" is sold in the packaging

shown in Exhibit “C”, thus I am satisfied that that the subject trade-mark was marked on the ware’s packaging during the relevant period.

[10] With respect to sales during the relevant period, Ms. Wesely attaches copies of invoices dated August 2004 and August 2005 issued by the registrant to Canadian distributors for the wares specified in the registration as Exhibits “A1” and “A2”. In addition, the affiant provides a document containing the shipping information of the wares to different Canadian cities between 2004 and 2005 as Exhibit “B”. I note that the invoices and the shipping summary contain entries for “TURBO TEAM-VF DELUXE CLNG KIT” and “TURBO TEAM-UNV DELUXE CLNG KIT”, along with corresponding item numbers. As for the normal course of trade, Ms. Wesely explains in her affidavit that the registrant manufactures the wares in United States, which are then sold and shipped to distributors and retailers in Canada. In addition, the registrant sells the wares directly to Canadian customers via Internet sales.

[11] The court has stated on several occasions that use of a trade-mark at any point along the chain of distribution is sufficient to demonstrate use as defined in section 4 of the Act and that use will enure to the benefit of the registrant provided that the wares bearing the trade-mark originate from the registrant [*Manhattan Industries Inc. v. Princeton Manufacturing Ltd.* (1971), 4 C.P.R. (2d) 6 (F.C.T.D.) and *Venice Simplon-Orient-Express, Inc. v. Société Nationale des Chemins de Fer Français SNCF* (2000), 9 C.P.R. (4th) 443 (F.C.T.D.)]. In the present case, I am satisfied that the registrant has shown sales of the wares bearing the trade-mark in Canada in the normal course of trade during the relevant period.

[10] In view of the foregoing, I am satisfied that there was use of the subject trade-mark within the meaning of section 45 and subsection 4(1) of the Act on “vacuum cleaning kit comprised of a turbine-powered nozzle, wands, hoses, brushes, and attachment caddy”. Accordingly, and pursuant to the authority delegated to me under subsection 63(3) of the Act, registration TMA517,533 for the trade-mark TURBO TEAM

will be maintained in compliance with the provisions of section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT MONTREAL, QUEBEC THIS 10TH DAY OF DECEMBER 2009.

P. Fung
Hearing Officer
Trade-marks Opposition Board