



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

Citation: 2015 TMOB 225
Date of Decision: 2015-12-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Method Law Professional Corporation	Requesting Party
and	
The Black & Decker Corporation	Registered Owner
TMA330,222 for PIRANHA	Registration

[1] At the request of Method Law Professional Corporation (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 3, 2014 to The Black & Decker Corporation (the Owner), the registered owner of registration No. TMA330,222 for the trade-mark PIRANHA (the Mark).

[2] The Mark is registered for use in association with the following goods: “(1) Saw blades for power saws. (2) Circular saw blades.”

[3] The notice required the Owner to furnish evidence showing that the Mark was used in Canada, in association with each of the goods specified in the registration, at any time between April 3, 2011 and April 3, 2014. 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 sections 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 quite 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.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Greg C. Weston, sworn on June 3, 2014 in Mississauga, Ontario. Both parties filed written representations and were represented at an oral hearing, which was held jointly with hearings for summary expungement proceedings in regards to two other registrations by the Owner. A separate decision will be issued for these other proceedings, which pertain to registration Nos. TMA330,223 and TMA452,371.

The Owner's Evidence

[7] In his affidavit, Mr. Weston attests that he is a Commercial Marketing Manager with Stanley Black & Decker Canada Corporation (SBD Canada). Mr. Weston states that SBD Canada was formed from an amalgamation of the former Black & Decker Canada Inc. and the former Stanley Canada Corporation. He explains that SBD Canada and the Owner are both subsidiaries of Stanley Black & Decker, Inc., which he attests is "a diversified global provider of hand tools, power tools and related accessories".

[8] Mr. Weston attests that SBD Canada is licensed by the Owner to use the Mark in Canada. He further attests that under such license, PIRANHA-branded saw blades are manufactured in accordance with specifications set or approved by the Owner and that quality control checks are in place during the manufacture of the saw blades to ensure that the specifications are met. As well, Mr. Weston attests that the manner of trade-mark usage is also subject to specifications set

by the Owner. In this respect, he attests that the Mark was prominently displayed on the front of each saw blade and on the associated packaging.

[9] Accordingly, Mr. Weston asserts that the Mark has been “used by the Owner, either directly and/or through its licensees, in the normal course of trade, in Canada” in association with the registered goods. In particular, he attests that the Mark was “used by the Owner and/or ... SBD Canada, in the normal course of trade in Canada, in association with B&D circular saw blades.” As well, he attests that “SBD Canada also sells ... and has sold in Canada throughout the [relevant period], jigsaw blades for power saws under the PIRANHA® Mark”.

[10] Mr. Weston attests that the normal course of trade for PIRANHA-branded “circular saw blades” and “saw blades for power saws” involves their sale to independent distributors located across Canada, such as Home Depot, Lowes, Walmart, and Rona. He attests that PIRANHA-branded saw blade products are also advertised and sold online in Canada. Mr. Weston notes that all PIRANHA-branded circular saw blades sold are for use in power saws.

[11] With respect to transfers in the normal course of trade, Mr. Weston provides sales figures for “PIRANHA®-branded circular saw blades and saw blades for power saws” sold in Canada during the relevant period. For example, with respect to 2013, he attests that there were 9,758 “units sold”, with sales revenues of approximately \$54,000. I note that Mr. Weston makes no distinction regarding the number of “circular saw blades” and “saw blades for power saws” sold within those total units.

[12] In support of his assertion of use, Mr. Weston attaches the following exhibits to his affidavit:

- Exhibit B consists of a PIRANHA-branded circular saw blade and its associated packaging. The packaging bears the product numbers “67-757” and “77-757”. As shown below, “PIRANHA®” is clearly displayed below “BLACK&DECKER®” on the flat surface of the blade. Mr. Weston attests that this shows how the Mark was prominently displayed on circular saw blades sold in Canada during the relevant period:



- Exhibits C and D consist of representative photographs of PIRANHA-branded jigsaw blade sets and their associated packaging, as well as photographs of individual blades within these sets. I note that the packaging bears product numbers “BDA28160C” and “BDA28170C”. Mr. Weston attests that each blade within these sets bear the Mark. As depicted below, the word PIRANHA is displayed next to a stylized piranha on the side of the blades:



- Exhibits E and F consist of sample SBD Canada price lists, dated January 1, 2014 and January 1, 2011, respectively. Mr. Weston makes no attestations regarding the distribution of these price lists. However, both price lists reference a number of “PIRANHA® Circular Saw Blades” products that correspond to the Exhibit B circular blade, and are identified by product numbers beginning with “67” or “77”. Both price lists also reference a number of “Jig Saw Blades” products identified by product numbers beginning with “75”. Unlike the circular saw blade products, however, I note that PIRANHA does not appear in the description of the jigsaw blade products. I also note that the “BDA” product numbers from the Exhibit C and D PIRANHA-branded jigsaw blades do not appear on these price lists.
- Exhibit G consists of 11 representative invoices, which Mr. Weston attests show sales of PIRANHA-branded “circular saw blades” and “saw blades for power saws”, to authorized independent distributors located in Canada. I note that the seven invoices dated within the relevant period show sales of “Piranha Circ Saw”, “Piranha Bld Pack 77”, and/or “Piranha 7 1/4” 24 T Bulk”, which are all identified by product numbers beginning with “67” or “77”. Although there is one invoice dated after the relevant period that shows sales of a “Jigsaw Kit” with the product number “BDA28170C”, none of the

seven invoices dated within the relevant period show product numbers that correspond to the Exhibit C and D PIRANHA-branded jigsaw blades. There is, however, one invoice dated within the relevant period that shows sales of “10 PC T-Shank Jig Saw Blade” and “10 PC U-Shank Jig Saw Blade”, which are identified by product numbers beginning with “DW”.

- Exhibit H consists of printouts of webpages from *www.amazon.ca* and *www.walmart.ca* featuring PIRANHA-branded saw blade products available for sale. The featured products include various circular saw blades and jigsaw blade sets similar to those shown at Exhibits B, C, and D. As with the Exhibit B blade, I note that the word PIRANHA is clearly displayed on the surface of the circular blades depicted. Mr. Weston attests that these products are sold through such websites and that the exhibited webpages are representative of those available in Canada throughout the relevant period.
- Exhibit I depicts a PIRANHA-branded bottle wrap, which Mr. Weston attests was used as a promotion on water bottles available in Canada during the relevant period. The word PIRANHA is displayed next to a stylized piranha in the same manner as shown on the Exhibit C and D blades.

Analysis

[13] In its written representations, the Requesting Party submits that (i) Mr. Weston is not an officer of his company and therefore his qualifications for attesting to the use of the Mark is disputable and/or hearsay; (ii) the licensed use by SBD Canada or any other company identified by Mr. Weston in his affidavit is not supported by way of documentation or the invoices submitted; and (iii) the Mark is not used as registered.

[14] However, although not raised by the Requesting Party, the real issue in this case is whether the Owner has furnished sufficient evidence of transfers in the normal course of trade during the relevant period with respect to both “circular saw blades” and “saw blades for power saws”.

Qualifications of the Affiant

[15] First, with respect to the “qualifications” of the affiant, although Mr. Weston is not an officer of the Owner, he clearly attests that, by virtue of his position and having reviewed relevant business records, he has personal knowledge of the matters set out in his affidavit. As such, I am satisfied that his position allowed him to be familiar with SBD Canada’s normal course of trade and to have access to its sales records from the relevant period.

Licensing

[16] With respect to the issue of licensing, the Requesting Party submits that Mr. Weston’s description of the licensing arrangement at paragraph 4 of his affidavit is contradicted by the supporting exhibits. For example, it notes that the Exhibit G invoices are in the names of “Black & Decker” and “Stanley Black & Decker”, rather than in the name of SBD Canada or one of its predecessors. Yet, the Requesting Party further notes that Mr. Weston’s affidavit does not state that the parent company, Stanley Black & Decker, Inc., is also licensed to use the Mark. As such, the Requesting Party submits that it is unclear if the goods originate from SBD Canada or if they originate from the Owner.

[17] The Owner, on the other hand, submits that “Black & Decker” and “Stanley Black & Decker” would be recognized as trading styles of Black & Decker Canada Inc., one of the predecessors of SBD Canada. The Owner submits that since a company which is formed from the amalgamation of two or more companies is and always has been recognized as the continuation of one company, SBD Canada – as well as the former Black & Decker Canada Inc. and former Stanley Canada Corporation – are and always has been one company. Therefore, when Mr. Weston attests that SBD Canada is licensed by the Owner, he is referring to SBD Canada pre- and post-amalgamation.

[18] Indeed, the Owner submits that the exhibited invoices “show a time line of ... amalgamation, and therefore might rightly be identified with the licensee, SBD Canada”. It notes that the invoices identify “Black & Decker” and “Stanley Black & Decker” at Canadian addresses.

[19] In any event, it is well-established that trade-mark owners are not required to evidence written license agreements *per se* in a section 45 proceeding; a clear statement of control can be

sufficient [see *Gowling, Strathy & Henderson v Samsonite Corp* (1996), 66 CPR (3d) 560 (TMOB)].

[20] In the present case, Mr. Weston clearly attests that SBD Canada is licensed by the Owner to use the Mark and that, under such license, the Owner controls the character and quality of the registered goods sold in Canada in association with the Mark. Mr. Weston further provides particular terms of the license with regards to the Owner's specifications and with regards to quality control checks. In my view, Mr. Weston's explanation of the licensing arrangement and statement of control satisfies any requirements of section 50(1) of the Act; as such, I am satisfied that any evidenced use of the Mark by SBD Canada enures to the Owner's benefit.

Mark Used As Registered

[21] With respect to whether the Mark was displayed as registered, first, the Requesting Party submits that the Mark never appears on its own in the exhibits, but rather always appears with the equally or more prominent phrase "BLACK&DECKER" above it. The Requesting Party thus submits that, as a matter of first impression, the public would not perceive the word PIRANHA as forming a distinct trade-mark, even considering the difference in size and font of the words BLACK&DECKER and PIRANHA. It argues that the word PIRANHA does not stand out and therefore it would not create a separate impression in the minds of the public. As such, the Requesting Party submits that the trade-mark in use was a composite trade-mark consisting of BLACK&DECKER, PIRANHA and various design elements.

[22] In support, the Requesting Party cites *88766 Canada Inc v Coca-Cola* (2006), 52 CPR (4th) 50 (TMOB), where the subject mark CLASSIC was expunged even though CLASSIC stood out in terms of font and size from the words COCA-COLA. In that case, the Registrar found that CLASSIC would not form a separate impression in the minds of the public and would be seen as tied to the words COCA-COLA.

[23] The Owner, however, submits that "the trade-marks BLACK&DECKER® and PIRANHA® are at all times distinguishable from each other both by the placement of those trade-marks (one above the other), the differences in the fonts used ... and the use of separate ®

symbols beside both trade-marks”. Accordingly, the Owner submits that it is “inconceivable” that the two trade-marks would be perceived as a single, composite trade-mark.

[24] Although both the Mark and BLACK&DECKER appear on the Exhibit B circular saw blade, it is well established that there is nothing to prevent two trade-marks from being used simultaneously in relation to the same goods [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

[25] Furthermore, I note that, in the aforementioned *Coca-Cola* decision cited by the Requesting Party, the Registrar acknowledged that his finding was notwithstanding the general principle enunciated in *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) concerning trade-marks used with additional matter. Moreover, the only jurisprudence cited by the Registrar in support was the opposition decision *Coca-Cola Ltd v Southland Corp* (2001), 20 CPR (4th) 537 (TMOB); a key point in that case was the Registrar’s finding that:

... use of the trade-mark COCA-COLA CLASSIC & Design does not constitute use of the trade-mark CLASSIC “per se” as the average consumer would not view that component as being used as a separate trade-mark. Consumers would view the non-distinctive component CLASSIC as referring to a character, quality or type of the opponent’s COCA-COLA brand product: see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB), at 538 and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA). [at paragraph 9]

[26] Even if I were to agree with the Registrar’s findings in those cases, the Registrar considered CLASSIC to be a non-distinctive component in relation to the goods in question. In this case, PIRANHA is not descriptive of saw blades. Presumably the name was chosen because of the imagery of sharp teeth associated with piranhas, but PIRANHA as displayed is not itself descriptive of saw blades.

[27] Moreover, while display of a trade-mark on invoices may not in itself be sufficient to constitute use, it can provide context informing the Registrar as to what the public would perceive. In the *Coca-Cola* decisions, the Registrar did not refer to any evidence of display of CLASSIC separate and apart from COCA-COLA. In this case, however, BLACK&DECKER is prominently displayed at the top of the exhibited invoices and price lists, separate and apart from any appearance of PIRANHA. As such, I find that, as a matter of first impression, the public

would perceive the words BLACK&DECKER and PIRANHA as displayed on the Exhibit B saw blade as forming two separate trade-marks.

[28] Accordingly, I am satisfied that the Mark as registered was displayed on the Owner's "circular saw blades" during the relevant period.

[29] With respect to the jigsaw blades at Exhibits C and D, the Mark appears with a stylized piranha. Nevertheless, the jurisprudence has held that use of a word mark can be supported by the use of a composite mark featuring the word mark and other elements [see *Nightingale*, *supra*]. As well, in *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB), the Registrar stated:

As clearly pointed out by the registrant, the trade-mark as registered is a word mark. No particular design or font size was registered. Consequently, in the case of a word mark, use of the trade-mark word or words in any stylized form and in any colour can be considered as use of the registered mark. [at 395]

[30] Furthermore, it is well established that a registration for a word mark is not jeopardized by the use of a design, provided that the registered word mark remains recognizable [see, for example, *Mercure v Alpine Joe Sportswear Ltd*, 1999 CarswellNat 3663 (TMOB) and *McMillan LLP v Good-O Beverage Co*, 2013 TMOB 137, CarswellNat 3210].

[31] In this case, since the Mark is registered as a word mark, the word PIRANHA as displayed in an italicized, bolded font can be considered display of the Mark as registered. I am also satisfied that the Mark remains recognizable next to the stylized piranha, as displayed on the Exhibit C and D blades.

[32] In any event, in applying the principles as 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 *Promafil Canda Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I find that the dominant feature of the Mark as registered, namely the word PIRANHA, has been maintained and the addition of the stylized piranha is a minor deviation.

[33] Accordingly, I am satisfied that the Mark as registered is displayed on the exhibited jigsaw blades. The issue, however, is whether the evidence is sufficient to demonstrate that such

jigsaw blades were transferred in the normal course of trade during the relevant period to constitute use of the Mark in association with “saw blades for power saws”.

Evidence of Transfers

[34] With respect to the transfer and sale of the registered goods, it is clear that the product descriptions on the Exhibit G invoices dated within the relevant period correspond to the Exhibit B circular saw blade. As such, I am satisfied that the Owner sold “circular saw blades” bearing the Mark in Canada during the relevant period.

[35] With respect to the registered good “saw blades for power saws”, I again note that Mr. Weston attests that “all circular saw blades sold are for use in power saws”. However, the Owner clearly made a distinction between “circular saw blades” and “saw blades for power saws” in its statement of goods. In *Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD), the Court noted the following:

... manufacturers have an interest in widening the scope of the trademark protection offered by the Act ... and the use to which their products can be put multiply. However, in so doing, they are specifying different uses. [at paragraph 16]

[36] Given that use evidenced in association with one specific good cannot serve to maintain multiple goods within the statement of goods, the Owner is required to provide evidence of use for *each* of the registered goods [see *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA); *Sharp, supra*; and *Fogler, Rubinoff LLP v Canada Safeway Ltd*, 2013 TMOB 227, CarswellNat 5446]. As such, for the Owner to maintain its registration for the broader category of goods “saw blades for power saws”, it had to show transfer and sales of such goods otherwise than by reference to “circular saw blades”.

[37] Although the Requesting Party did not take issue with the evidence of sales provided by the Owner, in reviewing the evidence as a whole, I find it ambiguous whether the Owner in fact sold PIRANHA-branded jigsaw blades for power saws in Canada during the relevant period.

[38] In this respect, Mr. Weston asserts that the Owner “sold in Canada throughout the [relevant period], jigsaw blades for power saws under the PIRANHA® Mark”. In support, Mr. Weston provides “representative invoices” at Exhibit G to his affidavit. Although there is one

invoice showing sales of two “Jig Saw Blade” products within the relevant period, I note that the product numbers identifying these jigsaw blades do not correspond with the product numbers on the packaging of the Exhibit C and D PIRANHA-branded jigsaw blades, nor do these product numbers appear in the Exhibit E and F price lists.

[39] There is one invoice, albeit from after the relevant period, showing the sale of a “Jigsaw Kit” that corresponds to the Exhibit C and D jigsaw blades. However, if such blades were actually sold during the relevant period, it is odd that the Owner chose to furnish an invoice from after the relevant period to demonstrate such transfers. As well, unlike the product descriptions for PIRANHA-branded circular saw blade products, I note that “PIRANHA” does not appear in any of the product descriptions of the jigsaw blades identified in the above-mentioned invoices or the Exhibit E and F price lists.

[40] Moreover, Mr. Weston only attests to overall sales figures for “PIRANHA®-branded circular saw blades and saw blades for power saws”. However, he makes no distinction in these figures between sales of circular saw blades and sales of jigsaw blades, if any.

[41] Lastly, although Mr. Weston attests that “PIRANHA®-branded saw blade products are also sold online ... [and] have also been advertised in Canada”, the Exhibit H website printouts merely indicate that PIRANHA-branded jigsaw blade sets may have appeared on such websites during the relevant period. However, it has been held that “offering for sale” is not the same as “selling” [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)], and that advertising alone is insufficient to establish use of a trade-mark in accordance with section 4(1) of the Act [see *Riches, McKenzie & Herbert LLP v Cleaner’s Supply Inc*, 2012 TMOB 211, CarswellNat 5229].

[42] In view of the foregoing, I consider the evidence ambiguous as to whether the Owner in fact sold PIRANHA-branded jigsaw blades for power saws in Canada during the relevant period. Per *Plough, supra*, such ambiguity must be resolved against the interests of the Owner. As such, I am not satisfied that the evidence demonstrates transfers in the normal course of trade of “saw blades for power saws” in Canada during the relevant period.

[43] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark only in association with “circular saw blades” within the meaning of sections 4 and 45 of the Act.

Disposition

[44] In view of all of the foregoing, 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 amended to delete goods (1), “Saw blades for power saws”.

[45] The amended statement of goods will be as follows: “Circular saw blades”.

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

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

HEARING DATE: 2015-08-10

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AGENTS OF RECORD

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