



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

Citation: 2011 TMOB 200
Date of Decision: 2011-10-26

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Blue Steel Chemicals Inc. against
registration No. TMA543,995 for the trade-mark
CLEAN-IT in the name of Swish Maintenance Limited.**

[1] At the request of Blue Steel Chemicals Inc. (the Requesting Party), the Registrar of Trade-marks issued a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on February 24, 2009 to Swish Maintenance Limited, the registered owner (the Registrant) in respect of registration No. TMA543,995 for the trade-mark CLEAN-IT (the Mark).

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

All purpose cleaning preparations; degreasing preparations for use on floors, walls; toilet bowl cleaners; solvents; hand lotions; laundry soaps and detergents; floor and wall wax strippers; sweeping compounds; waxes and floor finishes; furniture and floor polishes; carpet and fabric cleaners and restorers; metal cleaners and restorers; sewage conditioners, drain conditioners and cleaners; cleaning preparations for laundries, tubs, and kitchenware (the Wares).

[3] The Mark is also registered for use in association with the following services:

Consulting on janitorial and custodian services to industry and institutions; conducting classes and demonstrations in fire prevention equipment; renting and leasing equipment pertaining to janitorial and custodian services; servicing and repairing institutional, janitorial and custodian equipment and supplies (the Services).

[4] 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 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 February 24, 2006 and February 24, 2009 (the Relevant Period).

[5] The definition of “use” is set out in section 4 of the *Trade-marks 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.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

(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.

[6] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and as such, the evidentiary threshold that the registered owner must meet is quite low. As stated by Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4th) 270 (F.C.) at 282:

[...] We know that the purpose of s. 45 proceedings is to clean up the "dead wood" on the register. We know that the mere assertion by the owner that the trade mark is in use is not sufficient and that the owner must “show” how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owners’ business and merchandising practices.

[7] In response to the Registrar's notice, the Registrant filed the affidavit of Ken Hilder, Vice-President of Marketing and Corporate Sales of the Registrant, sworn on September 28, 2009. Only the Registrant filed written arguments; an oral hearing was not requested.

[8] In his affidavit, Mr. Hilder states the Registrant is a manufacturer and distributor of cleaning products and equipment; these products are manufactured by the Registrant or through third-party contract manufacturers, and the Registrant sells these products directly to large industrial and institutional customers, as well as to smaller corporate clients and the general public through department stores, retailers, and the Registrant's own chain of company-owned stores. Mr. Hilder asserts that the Registrant has used the Mark in association with all the Wares and Services, as registered, continuously since at least as early as 1998.

[9] In support of the Registrant's assertion of use with respect to the Wares, attached to Mr. Hilder's affidavit as Exhibit A are copies of representative labels and photographs of actual cleaning products manufactured and sold by the Registrant. Mr. Hilder attests that these labels and photographs reflect the appearance of the Wares sold in Canada during the Relevant Period. I note that the Mark appears prominently on the labels of the following products (as identified on their respective labels): laundry detergent, fabric softener, lotion soap, tile sealer, floor finish, carpet defoamer, scale remover, vehicle wash, dishwasher detergent, floor cleaner and crème cleanser.

[10] As proof of sales, Mr. Hilder attaches as Exhibit D sample invoices and aggregate sales data for the Wares from 2001 to 2009. Exhibit D consists of thousands of pages of superfluous and redundant and poorly organized sales records; nevertheless, I am able to confirm sales during the Relevant Period for the abovementioned cleaning products shown in Exhibit A as well as for "all purpose cleaning preparations".

[11] Although the Registrant has not provided sales records for each of the Wares, I would observe that in some circumstances direct documentary evidence is not required to demonstrate use in association with each ware in a section 45 proceeding [*Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.)]. Further, the case law is clear that the

absence of invoices is not fatal in a section 45 proceeding [*Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988) 21 C.P.R. (3d) 483 (F.C.T.D.); *Gowling Lafleur Henderson LLP v. Neutrogena Corp.* (2009) 74 C.P.R. (4th) 153 (T.M.O.B.)]. In the present case, although it would have been preferable if the Registrant had provided sales figures or sample invoices for each of the Wares, there is more than a mere bald assertion of use with respect to those wares for which there are no sales records. The Registrant has provided representative labels and photographs showing how the Mark was displayed in association with the Wares and has made clear statements that each was sold in Canada during the Relevant Period. Furthermore, Mr. Hilder provides examples of cross-use of the Registrant's cleaning products, indicating that some products are used for more purposes than specified by the product name on the label. He also attests that the Registrant's sales for CLEAN-IT wares and services have been in the range of millions of dollars Canadian per year for each of the five years prior to the issuance of the section 45 notice. Accordingly, considering the evidence as a whole, keeping in mind the intent and purpose of s.45 of the Act, I am willing to conclude that there was use of the Mark within the meaning of s. 2 of the Act in association with all of the Wares.

[12] Mr. Hilder also asserts use of the Mark in association with the Services. Mr. Hilder states that consulting and training services are provided to large industrial and institutional clients as part of standing orders for the Registrant's CLEAN-IT wares. The affiant explains that training and consultation is provided on how to use the wares and that payment for these services is included in the price for the wares.

[13] Mr. Hilder provides sample brochures and promotional materials describing the Registrant's products and services offered through its retail *Swish Clean-It™* Centres (Exhibit E). As with the evidence in relation to the Wares, much of the evidence in relation to the Services is superfluous, irrelevant, redundant and poorly organized. Most of the advertisements and promotional materials are undated; however, I am able to infer that the advertisements span the years from 1998 to 2010 and that services were offered during the Relevant Period. For example, with respect to the services "consulting on janitorial and custodian services to industry and institutions", I note an Exhibit E flier entitled "*Swish Clean-It™* Centre 2008 Calendar of

Events” that shows the dates and store locations of various “Meet the Expert” events in association with “cleaning hardware”, “enviro-solutions”, “material handling” and other subject matters. Another flier advertises a specific “Meet the Expert” event on February 18, 2009 in relation to floor care and cleaning.

[14] With respect to the services “renting and leasing equipment pertaining to janitorial and custodian services” and “servicing and repairing institutional, janitorial and custodian equipment and supplies”, the Registrant provides *Swish Clean-It™* Centre fliers advertising equipment rental and repair services. I am able to conclude that in addition to consulting services in the field of janitorial and cleaning services, the Registrant generally offered equipment rental and repair services.

[15] With respect to the services “conducting classes and demonstrations in fire prevention equipment”, I note that none of the advertisements or brochures refer to such services. Since none of the Wares can be considered fire prevention equipment, the Registrant’s explanation that the Services were ancillary to the sale of Wares does not appear applicable in the case of these particular services.

[16] As noted above, where the Mark appears on the brochures, it often but not always appears in the advertisement of *Swish Clean-It™* Centres. In any event, as the Mark is displayed in a different size and font so as to distinguish it from the word *Swish*, I find the present case similar to *A.W. Allen Ltd. v. Canada (Registrar of Trade Marks)* (1985), 6 C.P.R. (3d) 270 (F.C.T.D.). In that case, the court considered whether evidence of use of the trade-mark COOLMINT in conjunction with the trade-mark HALLS (displayed as HALLS COOLMINT) was sufficient to maintain the mark COOLMINT in the section 44 (now section 45) proceeding. The court upheld the Registrar’s decision to maintain the mark on the Register, noting that “the law is also quite clear that there is nothing to prevent two registered trade marks being used at the same time”.

[17] Given all of the foregoing, I am satisfied that the Registrant has evidenced use of the Mark in association with all of the Wares and the following Services within the meaning of s. 45

and s. 4 of the Act during the Relevant Period: “Consulting on janitorial and custodian services to industry and institutions; ...; renting and leasing equipment pertaining to janitorial and custodian services; servicing and repairing institutional, janitorial and custodian equipment and supplies”.

[18] Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registrations will be amended to delete the following from the statement of services in compliance with the provisions of s. 45 of the Act: “conducting classes and demonstrations in fire prevention equipment”.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office