



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

Citation: 2015 TMOB 48
Date of Decision: 2015-03-19

**IN THE MATTER OF A SECTION 45
PROCEEDING requested by H&M, Patent and
Trade-mark Agents against registration
No. TMA445,369 for the trade-mark K DESIGN in
the name of Kinedyne Canada Limited**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA445,369 for the trade-mark K DESIGN shown below (the Mark), owned by Kinedyne Canada Limited.



[2] The Mark is registered in association with the following goods (the Goods) and services (the Services):

Goods:

Metal shoring beams; metal shoring bars; metal winch tracks used for cargo control; metal fastening anchor fittings for securing tie-down straps; metal cargo control tracks for use with tie-down straps; metal slings; metal fittings; and metal strap tie-down hardware, namely buckles; cargo control apparatus, namely mandrel winches, webbing winches, tie-down straps, and spring fittings sold as a unit; wheelchair securement restraint system comprising metal buckles, tie-down straps,

metal fittings, and metal track used in transporting handicapped persons; cargo sling triangles made of fabric; ratchet buckles and tie-down straps sold as a unit.

Services:

Cargo restraint services relating to the design of cargo restraining apparatus, consisting of webs, hooks, buckles, winches, metal track and straps.

[3] On December 31, 2012, at the request of H&M, Patent and Trade-mark Agents (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) to Kinedyne Canada Limited (KCL). The notice required KCL to provide evidence showing that it had used the Mark in Canada at any time between December 31, 2009 and December 31, 2012, in association with each of the Goods and Services. If the Mark had not been so used, KCL was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[4] The relevant definitions of use in the present case are set out in sections 4(1) and 4(2) 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.

(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.

[5] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. However, sufficient evidence must nevertheless be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered goods and services during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Furthermore, mere

statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[6] In response to the Registrar's notice, KCL furnished the affidavit of James M. Klausmann II, sworn June 29, 2013, together with Exhibits A through I. While both parties filed written representations, only KCL was represented at an oral hearing.

[7] For the reasons that follow, I conclude that the registration ought to be maintained.

[8] Before discussing the reasons for my decision, I will begin with a brief summary of the evidence.

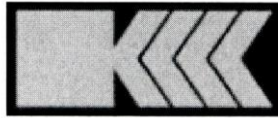
The Evidence

[9] In his affidavit, Mr. Klausmann indicates that he is the president of both KCL and its parent company Kinedyne Corporation (KC). He states that he has held these positions since November 2012 and May 2013 respectively, and that prior to May, 2013, he was the vice president of KC. He states that as a result of his positions, he has personal knowledge of the matters to which he deposes or has obtained such knowledge from documents and records maintained by KC and KCL in the normal course of business, to which he has access.

[10] Mr. Klausmann explains that KC, headquartered in the United States, was founded in 1968 with the primary mission of selling cargo securement products used in and by the transportation industry. He explains that with a growing customer base in the Canadian market, a facility was opened in Toronto, ON to support KC's worldwide operations in 1973. Further to this, he explains that KCL was created in 1996, as an Ontario company, resulting from the amalgamation of Kinedyne Canada Limited (incorporated in 1962) and Harmil Associates Inc. (incorporated in 1960).

[11] Mr. Klausmann states that KCL continuously used the Mark in Canada during the relevant period, in association with all of the Goods and Services. He explains that while the registration was filed in black and white, over the years, the shaded portions of the

letter “K” have filled out and the Mark is now and has been occasionally used throughout the years as follows:



I note that although the depiction above is illustrated in black and white, the letter “K” and the three chevrons following most often appear in orange throughout the evidence.

[12] With respect to such use, Mr. Klausmann explains that KCL has extensively advertised, and continues to advertise its products and services on its websites *www.kinedyne.com*, *www.kinedynecanada.com* (no longer active), and *www.steadymate.com*. He explains that while once an active website, the *www.kinedynecanada.com* website now redirects to the *www.kinedyne.com* website, which since at least 2007 has served consumers in both Canada and the United States. He provides as Exhibit C, excerpts from its websites *www.kinedyne.com* and *www.steadymate.com* including archived versions, which he states are representative of the websites as they existed during the relevant period, having not changed significantly or substantially over the years. Mr. Klausmann explains that these websites were designed and operated to provide consumers with information on all of the goods sold by KC and KCL, including those bearing the Mark.

[13] In terms of purchases, Mr. Klausmann attests that consumers are able to purchase each of the Goods directly from the *www.steadymate.com* website. In addition, he explains, products can be purchased by telephone through KC and KCL’s dedicated 1-800 numbers (as listed on the *www.kinedyne.com* and *www.kinedynecanada.com* websites), or through KCL’s network of representatives, dealers and distributors located across Canada. Mr. Klausmann attests that KC and KCL deal with over 1000 active distributors and dealers across Canada, including well-known companies such as Acklands Grainger, Princess Auto, Manac Inc., and Lode King.

[14] Mr. Klausmann states that the Mark appears prominently on all boxes and packaging containing the products when sold, and that in addition, most products have labels or tags bearing the Mark. He provides as Exhibit D, examples of such packaging and labels used in association with the Goods and Services. He states that these examples are generally representative of the manner in which the Mark has appeared and been used in association with products and advertising materials throughout the relevant period and since 1990. Additionally, he explains that the Mark appears prominently on the exterior of the above-mentioned Toronto, ON facility, as well as on letterhead, business cards, websites, product catalogues, brochures and signage. In support, he attaches as Exhibit E a non-exhaustive sampling of such signage and materials showing the Mark, representative of the manner in which the Mark was used in association with the Goods and Services during the relevant period.

[15] As evidence of sales of the Goods and Services bearing the Mark in Canada during the relevant period, Mr. Klausmann provides substantial annual “understated” sales figures for the years 2010 to 2012, as well as invoices (Exhibit F). He states that the sales figures provided pertain to sales of all of the goods and services covered by the registration in Canada during the relevant period. The invoices also show sales in Canada and display the Mark at the top of the invoices alongside the corporate name of the company. Mr. Klausmann indicates that the invoices accompanied the Goods at the time they were shipped.

[16] Lastly, Mr. Klausmann states that KCL has invested substantial time and resources in promoting the Mark in Canada through various media, including print media, trade shows, banner stands, promotional items, as well as displays on trucks. In support, he provides the following:

- Exhibit G – samples of catalogues, brochures and other promotional materials used and distributed in Canada between 2009 and 2012, and in 2013. Mr. Klausmann states that in most cases these materials, which feature the Mark, were available on the *kinedyne.com* website.

- Exhibit H – a list of dealer meetings, trade shows and vendor fairs that took place in Canada during the relevant period, together with product promotional materials which feature the Mark, that Mr. Klausmann states are typically distributed or made available for distribution at these meetings. Included are images of trucks and trailers used by KCL when attending these meetings, as well as trade show and vendor fair booth/kiosk materials which feature the Mark.
- Exhibit I – examples of promotional items featuring the Mark that Mr. Klausmann states are typical of those occasionally distributed to Canadian customers or prospective during the relevant period. Included are images of a hat, pens, a lanyard, a box, and various articles of clothing.

Summary of Submissions, Analysis, and Reasons for Decision

[17] The Requesting Party's submissions are summarized as follows:

- The evidence shows use of a substantially different variant of the Mark, with no evidence of use of the Mark as registered. Therefore, the Mark has been abandoned in Canada and the registration should be expunged.
- In any event, the evidence does not show that KCL sells or provides any of the Services; and
- The evidence does not show that KCL sells or provides any of the following Goods:
 - (1) Metal slings;
 - (2) Cargo control apparatus, namely mandrel winches, webbing winches, tie-down straps, and spring fittings sold as a unit;
 - (3) Wheelchair securement restraint system comprising metal buckles, tie-down straps, metal fittings, and metal track used in transporting handicapped persons; and
 - (4) Cargo slings made of fabric.

[18] I will consider each of these submissions in turn.

Deviation of the Mark

[19] With respect to the variation of the Mark shown in evidence, KCL submits, and I agree, that the dominant features of the Mark are the element K together with the three additional chevrons. The variant of the Mark as shown in the evidence clearly maintains these dominant features.

[20] The difference between the marks, namely, the shading and contrast of the chevrons, constitutes a minor, insignificant deviation, such that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin [see *Canada (Registrar of Trade-marks) v Cie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 at 525 (FCA)]. Once again, the dominant features of the Mark have been maintained; thus, the identity of the Mark is preserved and the deviation would not, in my opinion, mislead an unaware purchaser [per *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

Use with Respect to Services

[21] A trade-mark is deemed to be used in association with services if it is used or displayed in the performance of those services. Alternatively, where the trade-mark owner is offering and prepared to perform its services in Canada, use of the trade-mark on advertising of those services also meets the requirements of section 4(2) of the Act [see *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)]. In other words, advertising in Canada alone is insufficient to demonstrate use; at the very least, the services have to be available to be performed in Canada without the Canadian customer having to leave Canada [*Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct); *Bedwell v Mayflower* (1999), 2 CPR (4th) 543 (TMOB); and *Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express, Inc* (2000), 9 CPR (4th) 443 (FCTD) aff'g 64 CPR (3d) 87 (TMOB)].

[22] With respect to the Requesting Party's submission that there is no evidence showing that KCL sells or provides the Services, KCL submits that sections of its website refer to the ability of KCL to provide customers with custom made assemblies. Visitors

to the website, KCL submits, are given detailed descriptions of KCL's ability to provide these services, services that are of benefit to Canadian consumers and that are ancillary to both KCL's Goods and to its retail and wholesale services of those Goods [citing *TSA Stores, Inc v Canada (Registrar of Trade-marks)* (2011), 91 CPR (4th) 324 (FC); and *Kraft Ltd v Registrar of Trade-marks* (1984), 1 CPR (3d) 457 at paras 8-9 (FC)]. At the oral hearing, KCL additionally pointed to several pages of the catalogue furnished under Exhibit G, which it submitted shows that KCL provides special orders and customization of its products; services, which in its view, fall within the scope of the Services. One such excerpt (page 294 of the catalogue) advertises the availability of custom orders. Additionally, I note that there are references in the catalogue to engineering services provided by Kinedyne, with the following description:

Kinedyne conducts a full-scale, on-going program of research and development of new products for the cargo control industry. This is supported by an engineering staff with over 100 years of combined design experience which has produced many innovations in the industry. The staff, working with Kinedyne Sales and Customer Service Representatives, is available to solve customer cargo control problems.

[23] I have no difficulty accepting in view of the evidence as a whole that the Mark was used in association with the Services within the meaning of section 4(2) of the Act. The evidence clearly shows, as KCL has submitted, that KCL offers custom design of cargo restraint systems available upon request, and that the Mark is displayed in catalogues distributed in Canada when advertising these services. Furthermore, it is clear from the evidence that sales of Goods bearing the Mark were made during the relevant period, and it has been held that the use of a Mark on a finished product can serve to support use with services ancillary to such goods [*Lidl Stiftung & Co KG v Thornbury Grandview Farms Ltd* (2005), 48 CPR (4th) 147 (TMOB)].

Use with Respect to Each of the Goods

[24] As previously detailed, the Requesting Party has identified specific Goods to which it submits there is no evidence that KCL sells or provides these Goods. For ease of reference, I reproduce these Goods once again as follows:

- (a) Metal slings;
- (b) Cargo control apparatus, namely mandrel winches, webbing winches, tie-down straps, and spring fittings sold as a unit;
- (c) Wheelchair securement restraint system comprising metal buckles, tie-down straps, metal fittings, and metal track used in transporting handicapped persons; and
- (d) Cargo slings made of fabric.

[25] KCL submits that the burden on a registered owner in section 45 proceedings is light, and that evidentiary overkill is not required. Further to this, KCL submits that a general statement of use coupled with some evidence of use will support the registration intact. KCL submits that such a statement has been provided by Mr. Klausmann at paragraph 10 of his affidavit, and that ample examples of use of the Mark have been provided. Pursuant to this simple, summary and expeditious procedure, KCL submits that it has provided clear and reliable evidence of use and that the registration should not be expunged as it is not “dead wood”. Lastly, at the oral hearing, KCL directed attention to countless examples in the evidence of each good questioned by the Requesting Party. More specifically, KCL referred to excerpts from the catalogue in Exhibit G, which it then cross-referenced with each of the disputed goods, in addition to examples of sales of many, but not all of these goods as demonstrated through the invoices in Exhibit F.

[26] Although KCL has not provided sample invoices for each of the Goods, direct documentary evidence is not always required to demonstrate use in association with each good in a section 45 proceeding [*Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)]. In particular, 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 CPR (3d) 483 (FCTD); *Gowling Lafleur Henderson LLP v Neutrogena Corp* (2009) 74 CPR (4th) 153 (TMOB)].

[27] In the present case, although it would have been preferable if KCL had provided sales figures broken down by Good or sample invoices for each of the Goods, there is more than a mere bald assertion of use with respect to those Goods for which there are no invoices. Mr. Klausmann has provided examples of representative packaging and labels showing how the Mark was displayed in association with each of the Goods, has made clear statements that each of the Goods were sold in Canada during the relevant period, in

addition to providing substantial sales figures and a clear sworn statement that these figures reflect sales of each of the Goods. The catalogue, while not in itself evidence of use within the meaning of section 4(1) of the Act, lends support to Mr. Klausmann's statements regarding the sale of each of the Goods during the Relevant Period.

Accordingly, considering the evidence as a whole, I find it reasonable to conclude that there was use of the Mark within the meaning of section 45 of the Act in association with all of the Goods.

Disposition

[28] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA445,369 will be maintained in compliance with the provisions of section 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office