



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

Citation: 2015 TMOB 226
Date of Decision: 2015-12-21

IN THE MATTER OF SECTION 45 PROCEEDINGS

| | |
|--|-------------------------|
| Method Law Professional Corporation | Requesting Party |
| and | |
| The Black & Decker Corporation | Registered Owner |
| TMA330,223 for PIRANHA & DESIGN | Registrations |
| TMA452,371 for PIRANHA & DESIGN | |

[1] At the request of Method Law Professional Corporation (the Requesting Party), the Registrar of Trade-marks issued notices 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 Nos. TMA330,223 and TMA452,371 for two PIRANHA & Design trademarks, reproduced below:



(TMA330,223 PIRANHA & Design; Predecessor Mark)



(TMA452,371 PIRANHA & Design; Successor Mark)

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

[3] The Successor Mark is registered for use in association with “saw blades for power saws” only.

[4] The notices required the Owner to furnish evidence showing that the registered trade-marks were used in Canada, in association with each of the goods specified in the registrations, at any time between April 3, 2011 and April 3, 2014. If the trade-marks had not been so used, the Owner was required to furnish evidence providing the date when the trade-marks were last used and the reasons for the absence of use since that date.

[5] 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.

[6] 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-marks in association with each of the goods specified in the registrations during the relevant period.

[7] In response to the Registrar’s notices, the Owner furnished affidavits of Greg C. Weston, both sworn on June 3, 2014 in Mississauga, Ontario. With the exceptions described below, the affidavits furnished in response to each notice are substantially similar.

[8] Both parties filed written representations and were represented at an oral hearing, which also pertained to the summary expungement proceeding for registration No. TMA330,222 for the trade-mark PIRANHA. A separate decision will issue for that registration.

The Owner's Evidence

[9] In his affidavits, 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. Mr. Weston 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”.

[10] Mr. Weston attests that SBD Canada is licensed by the Owner to use the subject trade-marks 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 trade-marks were prominently displayed on the front of each saw blade and on the associated packaging.

[11] Accordingly, Mr. Weston asserts that the trade-marks have 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 trade-marks were “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”.

[12] Mr. Weston attests that the normal course of trade for PIRANHA-branded “circular saw blades” and “jigsaw 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.

[13] Mr. Weston notes that all “circular saw blades and jigsaw blades sold are for use in power saws”.

[14] With respect to transfers in the normal course of trade, Mr. Weston provides sales figures for “PIRANHA®-branded circular saw blades and jigsaw blades” 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.

[15] I note that Mr. Weston makes no distinction regarding the number of “circular saw blades” and “jigsaw blades” sold within those total “units”. I further note that even though the statement of goods for the Successor Mark is simply “saw blades for power saws”, Mr. Weston provides the same sales figures for “circular saw blades and jigsaw blades, both for power saws” in that affidavit as well.

[16] In support of his assertions of use, Mr. Weston attaches the following exhibits to his affidavits:

- Exhibit B (for the Predecessor Mark) consists of photocopies of a PIRANHA-branded circular saw blade, and its associated packaging. I note that the packaging bears product numbers “67-770” and “77-770”. As depicted below, the flat surface of the blade has various design elements printed on it, including “BLACK&DECKER” and, below that, the word PIRANHA displayed next to a stylized piranha (the Piranha Design). Mr. Weston attests that this shows how the Predecessor Mark was prominently displayed on circular saw blades sold in Canada during the relevant period:



- Exhibit B (for the Successor Mark) consists of a PIRANHA-branded circular saw blade, and its associated packaging. I note that this appears to be the same circular saw blade depicted in Exhibit B for the Predecessor Mark. The packaging bears the same product numbers and the surface of the blade has the same design elements printed on it, including the Piranha Design. Again, Mr. Weston attests that the exhibit shows how the Successor 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. The packaging bears the product numbers “BDA28160C” and “BDA28170C”. Mr. Weston attests that each blade within these sets bears the subject trade-mark. As depicted below, the same Piranha Design as displayed on the Exhibit B blade is displayed on the side of each jigsaw blade. I note that the phrase “BLACK&DECKER” does not appear on these individual 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 saw 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 these jigsaw blade products. I also note that the “BDA” product numbers corresponding to 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 “jigsaw blades”, 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. I note that the same Piranha Design as displayed on the exhibited blades is displayed on the surface of a number 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 same Piranha Design as displayed on the Exhibit B, C and D blades is displayed on the bottle wrap.

Analysis

[17] 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 trade-marks is disputable and/or hearsay; (ii) the licensed use by SBD Canada or any other company identified by Mr. Weston in his affidavits is not supported by way of documentation or the invoices submitted; and (iii) the trade-marks are not used as registered.

[18] Although not raised by the Requesting Party, as discussed below, a further issue with respect to use of the Predecessor Mark 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

[19] 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 with SBD Canada, and having reviewed relevant business records, he has personal knowledge of the matters set out in

his affidavits. As such, I am satisfied that his position allowed him to be familiar with the licensee's normal course of trade and to have access to its sales records from the relevant period.

Licensing

[20] 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 affidavits 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 affidavits do not state that the parent company, Stanley Black & Decker, Inc., is also licensed to use the trade-marks. As such, the Requesting Party submits that it is unclear if the goods originated from SBD Canada or if they originated from the Owner.

[21] 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 the former Stanley Canada Corporation – are and always have 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.

[22] 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.

[23] 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)].

[24] In the present case, Mr. Weston clearly attests that SBD Canada is licensed by the Owner to use the trade-marks and that, under such license, the Owner controls the character and quality of the registered goods sold in Canada in association with the trade-marks. 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 trade-marks by SBD Canada enures to the Owner's benefit.

Marks Used As Registered – Separate Trade-marks

[25] With respect to whether the subject trade-marks were displayed as registered, first, the Requesting Party submits that the Piranha Design 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 Piranha Design 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 Piranha Design 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 a stylized piranha.

[26] In support, the Requesting Party cites *88766 Canada Inc v Coca-Cola* (2006), 52 CPR (4th) 50 (TMOB), where the subject trade-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.

[27] The Owner, however, submits that "the trade-marks BLACK&DECKER® and PIRANHA & Design® 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.

[28] Although both the Piranha Design 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)].

[29] 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]

[30] 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.

[31] 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 BLACK&DECKER and the Piranha Design as displayed on the Exhibit B circular saw blade as forming two separate trade-marks.

Marks Used As Registered – No Deviation

[32] The Requesting Party further submits that the design component of the trade-mark as used, namely the Piranha Design as displayed on the Exhibit B, C and D blades, is not the same as the Predecessor or Successor Marks as registered. Given “numerous” differences between the registered marks and the trade-mark as used, the Requesting Party submits that the registered marks have lost their identity and are not recognizable.

[33] The test for deviation, as articulated by the Federal Court of Appeal, is as follows:

The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two 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. [*Canada (Registrar of Trade-marks) v Compagnie Internationale pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) at 525]

[34] As the Court of Appeal noted, “That question must be answered in the negative unless the mark was used in such a way that the mark 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” [at 525].

[35] In deciding the issue of deviation, the Federal Court of Appeal has stated that one must look to see if, as a question of fact, the “dominant features” of the trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough so as to permit a finding of use of the trade-mark as registered is a question of fact to be determined on a case-by-case basis.

[36] During the oral hearing, both parties referenced a recent Federal Court decision that dealt with a claim for infringement brought under section 19 of the Act involving the same parties and the same trade-marks that are at issue in this case [*The Black & Decker Corporation and Stanley Black & Decker Canada Corporation v Piranha Abrasives Inc*, 2015 FC 185, CarswellNat 384]. In that case, the Owner brought an action for infringement against the Requesting Party. In its decision, the Court stated that there was no evidence of use of the Predecessor Mark before it and

noted that, during the hearing, counsel for the Owner agreed that it was prepared to rely on the PIRANHA word mark and the Successor Mark only. Consequently, the Court stated, “in my opinion, that is a prudent choice, as the argument that the successor PIRANHA Design mark constitutes use of the predecessor PIRANHA Design has no merit” [at paragraph 3].

[37] As such, the Requesting Party submitted that the Federal Court’s finding with respect to the alleged non-use of the Predecessor Mark should be followed in this proceeding. The Owner, however, explained that it withdrew reliance on the Predecessor Mark in the Federal Court case as a “litigation strategy” to secure the relief that the Owner sought based on the reputation and goodwill acquired through use of its other PIRANHA marks. As such, the Owner submitted that the issue was not dealt with on its merits and that the Federal Court’s comments in this respect are not binding on the Registrar.

[38] Indeed, I note that the Federal Court was not explicit in its reasons on the issue of deviation. Given the Owner’s concession during the hearing, it would appear that the Court did not have reason to consider the applicable jurisprudence, namely *Honeywell BULL, supra* and *Promafil, supra*.

[39] Even if I were to read that the Federal Court’s comments as binding, strictly speaking, they do not address the issue before me. The issue in this case is whether the trade-mark as displayed in the evidence, namely the Piranha Design shown on the exhibited blades, constitutes use of the registered Predecessor and Successor Marks. The issue is *not* whether the Successor Mark constitutes use of the Predecessor Mark.

[40] In any event, the conclusions and findings in the Federal Court decision are not binding on me to the extent that the evidence in that proceeding differs from that before me in this proceeding [see *Vibe Ventures LLC v CTV Limited*, 2010 TMOB 166, CarswellNat 4273 at paragraphs 59-60; and *McCallum Industries Ltd v HJ Heinz Co Australia Ltd*, 2014 TMOB 284, CarswellNat 6273 at paragraph 10]. Given that there is no indication that the evidence before the Court was the same as the evidence presently before the Registrar, I am left to apply the general test for deviation as articulated above.

[41] The Requesting Party submits that the actual design component of the trade-mark as used is not the same as the Predecessor and Successor Marks as registered. In its written representations, the Requesting Party details lengthy lists of differences between the Piranha Design and the design marks as registered, such as “the eye of the fish is smaller” and “the teeth of the fish are longer, narrower and more pronounced”.

[42] As well, noting that the exhibits in Mr. Weston’s affidavits are the same for the Predecessor and Successor Marks, the Requesting Party submitted during the oral hearing that the exact same exhibits cannot be used to support use of two different registered marks.

[43] The Owner, on the other hand, submits that any deviation in no way changes the identity of the trade-marks as registered, alters their distinctive character or otherwise deceives the public. Although it acknowledges that there are differences in the trade-mark as used, the Owner submits that these differences are “miniscule” and would not be noticeable to an average consumer on first impression.

[44] In support, the Owner cited *Aird & Berlis LLP v Sonaco SARL*, 2014 TMOB 37, 119 CPR (4th) 374, where it was held that the dominant elements of a design mark were preserved, even though the design actually used displayed elements in a different configuration and with an additional border.

[45] Overall, I find that this case would appear to be on all fours with, or – in light of the relevant trade-marks – on all fours with the decision in *Promafil, supra*. That decision involved the case of the “corpulent penguin” as used in contrast to the “slim penguin” as registered. In that case, the trade-marks at issue did not have the benefit of additional text, such as PENGUIN. Regardless, the Federal Court of Appeal found in favour of the registered owner, notwithstanding that the dominant feature of the trade-mark was the image of a penguin only. Although many differences between the two designs were articulated, the Court of Appeal found that use of the “slim penguin” constituted use of the “corpulent penguin”.

[46] It would appear, then, that a similar finding should be made in this case, that display of the “slim piranha” in the trade-mark as used constitutes display of the registered “corpulent piranha” in the Predecessor Mark.

[47] During the oral hearing, however, the Requesting Party submitted that the present case should be distinguished from *Promafil*. In this respect, it notes that the Owner in this case filed and registered the Successor Mark, whereas in *Promafil*, the Owner did not benefit from a “new” registration.

[48] However, a registered owner’s filing of a new trade-mark application has no bearing in the determination of whether or not evidence furnished shows use of a registered trade-mark [in this respect, see *Oyen Wiggs Green & Mutala v Rubicon Products Ltd* (2007), 65 CPR (4th) 54 (TMOB) at paragraph 9]. While administratively convenient to deal with related registrations such as this, generally, each registration subject to a section 45 notice must be dealt with on its own merits. As such, the fact that the Owner subsequently applied for and registered the Successor Mark is irrelevant to the question of whether the trade-mark as used shown in the evidence constitutes use of the registered Predecessor Mark.

[49] In any event, the facts in this case seem to be stronger than in *Promafil* given that there is more than one element at play. Here, the dominant feature is not necessarily limited to a particular stylized fish but, rather, the combination of a stylized fish with the word PIRANHA.

[50] In applying the test for deviation here, while the Piranha Design as displayed has a greater resemblance to the Successor Mark, it cannot be said that it does not maintain the dominant features of the Predecessor Mark as well. In this respect, the word PIRANHA is displayed next to a stylized piranha with lines emanating from the piranha itself.

[51] Although the Requesting Party details in minutiae the differences between the marks, in my view, the fact that the stylized piranha itself is not the dominant feature of the design marks means that the differences between the piranhas are less important than if the piranha was unaccompanied by the word PIRANHA. Furthermore, while the streaks or lines are not identical, that element is also preserved. As such, in my view, the dominant features of both the Predecessor and Successor Marks are preserved.

[52] Accordingly, I consider display of the Piranha Design in the evidence to constitute display of the registered trade-marks for purposes of these proceedings.

Evidence of Transfers

[53] 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 Predecessor and Successor Marks in Canada during the relevant period.

[54] With respect to the registered good “saw blades for power saws”, as noted above, Mr. Weston explains that “all circular saw blades and jigsaw blades sold are for use in power saws”.

[55] In the case of the Successor Mark, “saw blades for power saws” is the only good listed in the Owner’s statement of goods. Thus, I am satisfied that Mr. Weston’s explanation, along with his assertions of use, allow me to consider the reference to “circular saw blades” in the evidence for that registration to be reference to “saw blades for power saws”.

[56] As such, I am satisfied that the Owner has demonstrated use of the Successor Mark in association with “saw blades for power saws” within the meaning of sections 4 and 45 of the Act.

[57] In the case of the Predecessor Mark, 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]

[58] Given that use evidenced in association with one specific good cannot serve to maintain multiple goods within a 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”.

[59] 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.

[60] In this respect, Mr. Weston asserts that the Owner “sold in Canada throughout the [relevant period], jigsaw blades for power saws under the PIRANHA & Design® 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.

[61] 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, “PIRANHA” does not appear in any of the product descriptions for jigsaw blades in the above-mentioned invoices or the Exhibit E and F price lists.

[62] Moreover, Mr. Weston only attests to overall sales figures for “PIRANHA®-branded circular saw blades and jigsaw 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.

[63] 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].

[64] 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” bearing the Predecessor Mark in Canada during the relevant period.

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

Disposition for Registration No. TMA330,223 (PIRANHA & Design)

[66] 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, registration No. TMA330,223 will be amended to delete goods (1), “saw blades for power saws”.

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

Disposition for Registration No. TMA452,371 (PIRANHA & Design)

[68] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, registration No. TMA452,371 will be maintained.

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

APPEARANCES

Jane Steinberg For the Registered Owner

Michelle L. Wassenaar For the Requesting Party

AGENTS OF RECORD

Gowling Lafleur Henderson LLP For the Registered Owner

Method Law Professional Corporation For the Requesting Party