

TRADUCTION/TRANSLATION

SECTION 45 PROCEEDINGS
TRADE-MARK: NORDIQUES
REGISTRATION NO.: 367,415

On January 25, 2002, at the request of Messrs. Cassels, Brock & Blackwell, the Registrar forwarded a Section 45 notice to Accessoires d'Autos Nordiques Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark NORDIQUES is registered for use in association with the following wares:

“Outillage et accessoires d'auto, nommément: clés, étau, perceuse, meule, planeur, rouleau, table pour planeur, extension de table, corroyeur, scie, banc de scie, disques et tables à scie, tour à bois, collecteur de poussière, sableuse, chalumeau, tour à fer, perceuse-fraiseuse, coffre, mèches, ruban à mesurer, fusil à peinture, tire-fort, miroir, verin, support, douilles, coffre à bougies, compas, pince, coffre d'outils, ciseaux, riveteuse, rivets, tournevis, extracteur, cadenas, croix pour roue, charriot, couteaux, attache-mortaise, lame, guide à ongle, mandrin, mâchoire en V, brosse, affûteuse, fusil à souder, fusil à graisser, huilier, casier en plastique emboitable, câble de nylon, projecteur, vérificateur électrique, vérificateur d'haleine, boule d'attache-remorque, catalogues, éponge, régulateur, compte-tour, antenne, analyseur de mise au point, enjoliveur de roue, guide à refente sur roulements, balai d'essuie-glace, vérificateur de compression, tuyau à air, cliquet, boyau, clé anglaise, raclor en caoutchouc, zip gun, polisseuse, douille électrique, terminal pour phare, lumière de vérificateur.”

[TRANSLATION]

“Tools and automobile accessories, namely: wrenches, vice, drill, grinding wheel, planer, roller stand, surfacer bench, side extension, currier, saw, saw bench, disc and table saws, wood turning lathe, dust collector, sandblast, torch, metal lathe, rotary tool, box, drills, tape measure, spray gun, hand winch, mirror, jack, rest, pin holders, spark plugs box, compass, jaw, tool box, chisels, riveter, rivets, screwdriver, screw extractor, padlock, 3-way lug wrench, cart, cutter, mortising attachment, blade, adjustable fence, mandrel, v-jaw, brush, saw blade sharpening machine, soldering gun, grease gun, oil lube can, stackable plastic crate, nylon rope, nozzle combination, electrical tester, breathalyzer,

hitch ball, catalogues, sponge, regulator, tachometer, antenna, tune-up analyzer, wheel cover, miter gauge, wiper blade, compression tester, air hose, pawl, air hose, monkey wrench, squeegee, zip gun, brushing machine, socket, headlight socket, test light.”

Section 45 of the Trade-marks 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 and/or services listed on 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 use since that date. The relevant period in this case is any time between January 25, 1999 and January 25, 2002.

In response to the notice, the affidavit of Denis Bérubé together with exhibits has been furnished. Each party filed a written argument and was represented at the oral hearing.

In his affidavit, Mr. Bérubé states that the registered owner is a merchant who sells tools, automobile parts and accessories and whose primary activities consist in selling, at wholesale or retail, tools, automobile parts and accessories intended for consumers and businesses. He adds that the sales related to the commercial operations of the registered owner are divided in half between the tool sector and the automobile parts and accessories sector.

He explains that the registered owner has continuously used the trade-mark in Canada since 1986 in association with the wares described in the registration.

At paragraphs 15 and 16 of the affidavit he states:

“Lorsque je dis que la Marque est utilisée au Canada et y a été continuellement utilisée, par la Répondante, dans le cours normal de son commerce en liaison avec les marchandises décrites au paragraphe 13 des présentes, j’entends que les marchandises liés à la Marque sont vendues par la Répondante dans son établissement situé au 613, 1ère Avenue, dans la ville de Québec, province de Québec, G1L 3J6, de même qu’à travers le Canada par son catalogue destiné aux consommateurs, par des agents distributeurs ou via le site Internet de la Répondante à l’adresse www.nordiques.com, par ailleurs, je joins un exemplaire du catalogue de la Répondante dont la version est similaire quant à la description des produits offerts pour les années 1999, 2000, 2001 et 2002, pour faire partie intégrante des présentes en annexe III;

Les clients de la Répondante peuvent se procurer les marchandises de la Répondante soit en se présentant à son établissement situé au 613, 1ère Avenue, dans la ville de Québec, province de Québec, G1L 3J6, soit en les commandant par la poste, par téléphone, par télécopieur ou via son site Internet.”

[TRANSLATION]

“When I say that the trade-mark is used in Canada and has been used there continuously, by the Respondent, in the normal course of its business in association with the wares described in paragraph 13 above, I mean that the wares related to the trade-mark are sold by the Respondent in its establishment located at 613, 1ère Avenue, in the city of Quebec, province of Quebec, G1L 3J6, and across Canada through its consumer catalogue, through distribution agents or through the Respondent’s Internet site at www.nordiques.com, furthermore, I am attaching a copy of the Respondent’s catalogue which is similar with regard to the description of the products offered for 1999, 2000, 2001 and 2002, which forms an integral part of this document in Appendix III;

The Respondent’s clients may obtain wares from the Respondent either by going to its establishment located at 613, 1ère Avenue, in the city of Quebec, province of Quebec, G1L 3J6, or by ordering them through the mail, by telephone, by fax or through its Internet site.”

Mr. Bérubé has provided copies of invoices showing sales during the relevant period of the following tools (see paragraph 18 of the affidavit):

“Perçeuse, meule, planeur (raboteuse), table pour planeur, corroyeur (dégauchisseuse), scie, banc de scie, collecteur de poussière, sableuse, support, couteau, attache-mortaise, guide à refente sur roulements.”

[TRANSLATION]

“drill, grinding wheel, planer, surfacer bench, currier (surfacer), saw, saw bench, dust collector, sandblast, rest, cutter, mortising attachment, miting gauge.”

Concerning such wares he states that they bore the trade-mark as can be seen from the catalogue he furnished or as shown in the photographs he furnished as Exhibit V.

Mr. Bérubé also provided photocopies of invoices showing sales of the following tools and automobile parts and accessories during the relevant period (see paragraphs 20 and 21 of the affidavit:

Tools:

“Mèches, ruban à mesurer, vérin, compas, croix pour roue, guide à onglet, mandrin (chuck), brosse, affûteuse, fusil à graisser, huilier, éponge, tuyau à air, cliquet, boyau, zip gun (marteau à air avec couteaux), polisseuse, douille électrique, lumière de vérificateur.”

[TRANSLATION]

“drill, tape measure, jack, compass, 3-way lug wrench, adjustable fence, mandrel (chuck), brush, saw blade sharpening machine, grease gun, oil lube can, sponge, air hose, pawl, air hose, zip gun (air hammer with knives), brushing machine, socket, test light.”

Automobile parts and accessories:

“Régulateur, terminal pour phare (electrical socket).”

[TRANSLATION]

“regulator, headlight socket (electrical socket).”

Concerning such wares Mr. Bérubé indicates that they are sold in bulk and that they do not bear any trade-mark. However, he adds that the trade-mark appears in front of the shelves or display units where these wares are displayed (see Exhibit 8 to his affidavit). Further, Mr. Bérubé indicates that when these wares are sold to customers they are packed in bags or boxes bearing the trade-mark (Exhibit 9 to his affidavit).

Mr. Bérubé also provided invoices showing sales during the relevant period for the following wares (see paragraphs 24 and 25 of the affidavit):

Tools:

“Clés, étau, disque à scie, table à scie, tour à bois, fusil à peinture, douilles, pince, tournevis, extracteur, lame, câble de nylon, vérificateur électrique, clé anglaise.”

[TRANSLATION]

“Wrenches, vice, disc saw, table saw, wood turning lathe, spray gun, pin holders, jaw, screwdriver, screw extractor, saw blade, nylon rope, electrical tester, monkey wrench.”

Automobile parts and accessories:

“Boule d’attache remorque, enjoliveurs de roues, balais d’essuie-glace.”

[TRANSLATION]

“hitch ball, wheel covers, wiper blades.”

Mr. Bérubé submits that all of the wares for which he has shown sales can be purchased at the registrant’s establishment where the trade-mark is displayed on signage outside of the

establishment (Exhibit 12 to his affidavit). Further, he submits that all clients are given an invoice bearing the trade-mark and that bags or boxes bearing the trade-mark are used at the time of sale for carrying or shipping the wares that have been purchased.

The requesting party's main argument is that the evidence at best only shows use of the trade-mark in a manner complying with the requirements of subsection 4(1) of the Trade-marks Act in association with some tooling namely "perçeuse, planeur, corroyeur, scie et sableuse" [TRANSLATION] "drill, planer, currier, saw and sandblast." It submits that the remaining tools covered by the trade-mark registration ought to be deleted. Concerning "automobile accessories" the requesting party submits that the evidence fails to show use of the trade-mark with any of these wares. It adds that in the opposition case involving the present registrant (as opponent) namely *Accessoires d'autos Nordiques Inc. v. Canadian Tire Corporation Limited*, decision rendered March 21, 2005, with respect to Trade-Mark Application No. 860710 for the trade-mark NORDIC & SNOWFLAKE Design, the Member of the Trade-Marks Opposition Board found that during cross-examination Mr. Bérubé did admit that the trade-marks NORDIQUES and NORDIQUES and N Design do not appear on the automobiles parts and accessories sold by the registrant (the opponent therein). Consequently, it submits that all wares covered by "automobile accessories" also ought to be deleted.

The registrant, on the other hand, submits that the evidence is sufficient to arrive at a conclusion of use with all of the registered wares. It points out that it is not necessary to show use with each item of wares, and that as long as use has been shown with a few items of each category of wares,

that is sufficient to maintain the registration. It relies on several cases including *Westinghouse Air Brake Co. v. Moffat & Co.*, 14 C.P.R. (4th) 257.

Subsection 4(1) of the Act sets out:

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.

In my view the evidence furnished is sufficient to permit me to conclude that the trade-mark was in use during the relevant period in association with some of the “tooling” and “automobile accessories” covered by the registration in a manner complying with the requirements of subsection 4(1) of the Act. Concerning the “automobile accessories” the evidence appears to confirm the finding of the Member of the Trade-Marks Opposition Board in the case *Accessoires d’Autos Nordiques Inc. v. Canadian Tire Corporation Limited*, supra, in that none of the automobile accessories being sold by the registrant is marked with the trade-mark. However, the evidence shows that the trade-mark is used in some other manner in association with some “automobile accessories”.

In my view the evidence shows use of the trade-mark in association with the following tools listed in paragraph 18 of the Bérubé affidavit namely “perçuse, meule, planeur (raboteuse), table pour planeur, corroyeur (dégauchisseuse), scie, banc de scie, collecteur de poussière, sableuse, support, couteau, attache mortaise et guide à refente sur roulements” [TRANSLATION] “drill,

grinding wheel, planer, surfacer bench, currier (surfacier), saw, saw bench, dust collector, sandblast, rest, cutter, mortising attachment and miting gauge.”

Mr. Bérubé has indicated that the trade-mark appeared on these wares in the manner shown in the catalogue or in the photographs furnished. This satisfies me that these wares were marked with the trade-mark NORDIQUES or a mark constituting use of the trade-mark NORDIQUES and as the invoices (Exhibit IV to the affidavit) show that sales of these wares were made during the relevant period, I conclude that these wares ought to be maintained on the trade-mark registration.

Further, I am satisfied that use has been shown in association with certain of the tools and automobile parts and accessories listed in paragraphs 20 and 21 of the affidavit namely “mèches, ruban à mesurer, vérin, compas, guide à onglet, brosse, affûteuse, fusil à graisser, huilier, tuyau à air, cliquet, boyau, zip gun (marteau à air avec couteaux), douille électrique, lumière de vérificateur, régulateur, terminal pour phare (electrical socket)” [TRANSLATION] “wrenches, tape measure, jack, compass, adjustable fence, brush, saw blade sharpening machine, grease gun, oil lube can, air hose, pawl, air hose, zip gun (air hammer with knives), socket, test light, regulator, headlight socket (electrical socket).”

Mr. Bérubé has indicated that these wares are sold in bulk and do not bear any trade-mark. However, he clearly stated that the trade-mark is posted in front of the shelves and stands displaying these wares. Exhibit VIII to the affidavit shows the manner the trade-mark is so displayed. The requesting party has argued that the evidence does not show that this was the case

during the relevant period. Although I agree that Mr. Bérubé could have been more specific I am prepared to accept on a fair reading of the affidavit that the trade-mark was so displayed during the relevant period. I also accept that such display would have provided the required notice of association between the trade-mark and these wares sold in bulk and not bearing any trade-mark.

Regarding the other wares listed in paragraph 20 of the affidavit namely “croix pour roue, mandrin (chuck), éponge et polisseuse”, they appear to be associated with trade-marks of third parties. In this regard, Invoice No. 479832 (see paragraph 20(v) of the affidavit) shows “croix 14" SAE”; Invoice No. 410319 (paragraph 20(vii) shows “CHUCK 0-5/8", JT3"; Invoice No. 454618 (paragraph 20(xii) shows “EPONGE “PEANUT””; Invoice No. 485414 (paragraph 20(xvii) shows “POLISSEUSE 11"/37798 BONN T”.

In my view, as the terms “SAE, JT3, PEANUT and BONN T” appear to be trade-marks, I conclude that it is these particular trade-marks that the purchasers would probably associate with these wares and not the trade-mark NORDIQUES of the registrant.

Consequently, concerning the wares “croix pour roue, mandrin (chuck), éponge et polisseuse” [TRANSLATION] “3-way lug wrench, mandrel (chuck), sponge and brushing machine” I conclude that the evidence fails to show use of the trade-mark in a manner complying with ss.4(1) of the Act. Accordingly, I conclude that these wares ought to be deleted from the trade-mark registration.

Concerning the specific tools and automobile accessories listed in paragraphs 24 and 25 of the affidavit namely “clés, étau, disque à scie, table à scie, tour à bois, fusil à peinture, douilles, pince, tournevis, extracteur, lame, câble de nylon, vérificateur électrique, clé anglaise et boule d’attache remorque, enjoliveurs de roues, balais d’essuie-glace” [TRANSLATION] “wrenches, vice, disc saw, table saw, wood turning lathe, spray gun, pin holders, jaw, screwdriver, screw extractor, blade, nylon rope, electrical tester, monkey wrench and hitch ball, wheel covers, wiper blades” although the evidence shows these wares were sold during the relevant period, Mr. Bérubé does not clearly indicate how the trade-mark was associated with these wares at the time of their transfer in the normal course of trade.

The fact that the trade-mark appears at the top of the invoices, or on a sign in front of the registrant’s business or on bags used to insert one or more items being purchased by a customer does not in this case serve to provide the type of association required between the trade-mark and these wares pursuant to ss.4(1). In this regard, it is clear from the evidence that some of the tools and automobile accessories sold at the registrant’s place of business bear the trade-mark of others and taking into consideration that the registrant’s business is operated under the trade-mark NORDIQUES it seems most likely that the use or display of the trade-mark on store signs, on bags and on the invoices would be considered a use of the mark in association with the registrant’s business. Accordingly, I conclude that the use shown of the trade-mark NORDIQUES in association with such wares is not a use that satisfies the requirements of ss.4(1) of the Act.

Concerning the remaining registered wares namely “rouleau, extension de table, chalumeau, tour à fer, perceuse-fraiseuse, coffre, tire-fort, miroir, coffre à bougies, coffre d’outils, ciseaux, riveteuse, rivets, cadenas, charriot, mâchoire en V, fusil à souder, casier en plastique emboitable, projecteur, vérificateur d’haleine, catalogues, compte-tour, antenne, analyseur de mise au point, vérificateur de compression, et racleur en caoutchouc”, we only have Mr. Bérubé’s statement to the effect that the trade-mark has been used continuously in association with all of the wares since December 15, 1986 (paragraph 14 of the affidavit). However, such a bare statement is clearly insufficient to permit me to conclude that the trade-mark was in use in association with all of the wares during the relevant period and in a manner complying with the requirements of ss.4(1) of the Act.

The registrant submits that the threshold of use in a Section 45 proceeding is relatively very low and that if use is found with some items belonging to a category then such use is sufficient to maintain all registered wares belonging to that category. It relies on several cases including *Saks & Co. v. RTM et al.*, 24 C.P.R. (3d) 49 and *Westinghouse*, supra.

I agree that evidentiary overkill is not required in a proceeding based on Section 45 (*Union Electric Supply Co. Ltd. v. Registrar of Trade Marks*, 63 C.P.R. (2d) 56). A trade-mark holder is therefore not required to furnish “either direct evidence or documentary proof” regarding every item in a given category. However, in my opinion, that assumes that the Registrar can infer from the evidence provided that there was use, in other words business transactions took place involving each of the wares, at some time during the three-year period immediately preceding the

date of the notice and that the trade-mark was associated with the wares in a manner complying with the requirements of ss.4(1) of the Act. In contrast to *Saks* and *Westinghouse*, there is nothing in the affidavit in this case that would allow me to make such inference. I therefore believe that the precedent applicable to this case is *John Labatt Ltd. v. Rainier Brewing Co.*, 80 C.P.R. (2d) 228 (FCA).

As I have concluded that the use of the trade-mark in the manner complying with the requirements of ss.4(1) of the Act has only been shown in association with the wares “perçuse, meule, planeur (raboteuse), table pour planeur, corroyeur (dégauchisseuse), scie, banc de scie, collecteur de poussière, sableuse, support, couteau, attache mortaise et guide à refente sur roulements, mèche, ruban à mesurer, verin, compas, guide à onglet, brosse, affûteuse, fusil à graisser, huilier, tuyau à air, cliquet, boyau, zip gun, douille électrique et lumière de vérificateur” [TRANSLATION] “drill, grinding wheel, planer, surfacer bench, currier (surfacer), saw, saw bench, dust collector, sandblast, rest, cutter, mortising attachment and miting gauge, drills, tape measure, jack, compass, adjustable fence, brush, saw blade sharpening machine, grease gun, oil lube can, air hose, pawl, air hose, zip gun, socket and test light” then only these wares will remain on the trade-mark registration.

Registration No. 367,415 will be amended accordingly in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 24TH DAY OF NOVEMBER 2005.

D. Savard
Senior Hearing Officer
Section 45 Division