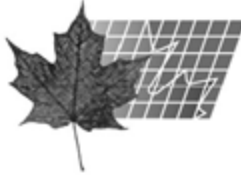


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 154

Date of Decision: 2017-11-22

IN THE MATTER OF A SECTION 45 PROCEEDING

Smart & Biggar

Requesting Party

and

Dustbane Holdings Inc.

Registered Owner

TMA157,457 for HURRICANE

Registration

INTRODUCTION

[1] At the request of Smart & Biggar (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 October 14, 2015 to Dustbane Holdings Inc. (the Owner), the registered owner of registration No. TMA157,457 for the trade-mark HURRICANE (the Mark).

[2] The Mark is registered for use in association with “Vacuum cleaners”.

[3] 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 goods 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 use since that date. In this case, the relevant period for showing use is October 14, 2012 to October 14, 2015.

[4] The relevant definition of use with respect to goods is set out in section 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 the purpose and scope of section 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 [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Benjamin Merkley, sworn on January 8, 2016 in Ottawa. Both parties filed written representations and were represented at an oral hearing.

THE OWNER’S EVIDENCE

[7] In his affidavit, Mr. Merkley attests that he is the President of the Owner and its licensee, Dustbane Products Limited, having been employed with Dustbane since 2002. He states that Dustbane is a “leading provider of a complete line of products and services in the sanitation industry”.

[8] Mr. Merkley confirms that Dustbane is licensed by the Owner to use the Mark in Canada in association with “floor cleaning machines” and that, under the licence, the Owner has control of the character and quality of such machines.

[9] Mr. Merkley attests that Dustbane’s floor cleaning machines “represent a comprehensive cleaning solution” that dispenses a cleaning liquid, scrubs the floor and then vacuums up any dirt and dirty water. As such, he explains that each HURRICANE floor cleaning machine “contains a powerful vacuum cleaner system that suctions dirt and dirty water into the recovery tank.” He attests that such machines are also known as “automatic floor scrubbers” or “automatic scrubbers”. He further explains that, by virtue of how such floor cleaning machines function, “it is commonly known in the sanitation industry that floor scrubbers are a type of vacuum cleaner”.

[10] With respect to sales, Mr. Merkley estimates that the value of HURRICANE-branded floor cleaning machines sold during the relevant period amounted to over \$5 million.

[11] In support, attached to Mr. Merkley's affidavit are the following exhibits:

- Exhibit B is a four page sales brochure for “Hurricane Series Compact Automatic Scrubbers” that Mr. Merkley attests was distributed to customers during the relevant period. The brochure depicts seven models of “Dustbane’s Hurricane Series” automatic scrubbers. The Mark is clearly displayed on the side of four of the larger models depicted. As for the remaining three models – the “Compact Series” – although the picture quality is poor, I am able to identify the Mark on the handle of each depicted model.

As noted by Mr. Merkley, the brochure includes “detailed specifications of the vacuum cleaner system contained within the HURRICANE branded floor cleaning machine.”

- Exhibit C consists of printouts of the *Wikipedia* entry for “Floor scrubber” from 2015. The entry includes subsections describing “Automatic floor scrubbers”, “Floor buffers and polishers” and “Floor-scrubbing robots”. The “See Also” subsection of the entry refers to “Floor cleaning”, “Janitor”, “Mop” and “Scrubber (brush)”.
- Exhibit D consists of printouts from the *Canadian Oxford Dictionary* (2nd ed., 2004), showing the definition for the term “vacuum cleaner”. The definition is given as “an electrical appliance for removing dust from carpets, other flooring, soft furnishings, *etc.*, by suction.”
- Exhibit E consists of three invoices, which Mr. Merkley attests are sample invoices representing sales of HURRICANE-branded floor cleaning machines during the relevant period. Although the names and addresses of the Owner’s customers have been redacted, the invoices show sales to customers in Ontario and Alberta. I note the “HURRICANE MAXI” and “HURRICANE 450 XTT” items listed on the invoices appear to correspond to the “Compact Series” automatic scrubbers depicted in the Exhibit B brochure.

ANALYSIS

[12] In this case, at a minimum, the exhibited invoices show sales to Canadian customers during the relevant period of the “Compact Series” automatic scrubbers/floor cleaning machines depicted in the exhibited brochure. As I accept that the Mark appeared on such machines, I am satisfied that, *prima facie*, the Owner has demonstrated use of the Mark in association with such machines within the meaning of sections 4 and 45 of the Act.

[13] As such, it is not necessary to consider whether display of “Hurricane” on the exhibited invoices constitutes use of the Mark or to what extent the general sales figures in evidence represent Canadian sales.

[14] The only remaining issue is whether such automatic scrubbers/floor cleaning machines correlate to the registered goods, “vacuum cleaners”.

[15] In its representations, the Requesting Party submits that such automatic scrubbers do not correlate with the commonly accepted meaning of the term “vacuum cleaner”. In this respect, the Requesting Party’s arguments can be summarized as follows:

- The exhibited dictionary definition does not suggest that “vacuum cleaner” is commonly understood as being or including floor scrubbers.
- The exhibited Wikipedia entry for “Floor scrubber” does not include a link to an entry for “vacuum cleaners” or the like.
- The exhibited sales brochure refers to the goods as “automatic scrubbers” or “auto-scrubbers”, and not as vacuum cleaners.
- The primary function of floor scrubbers relates to scrubbing, not to vacuuming.
- Floor scrubbers, even if they possess a vacuuming function, are not sold as vacuum cleaners.

- The Owner equating floor scrubbers to vacuum cleaners is akin to arguing that a motor vehicle is an “air conditioner” because a motor vehicle incorporates an air conditioner, or that a microwave is a “clock” because a microwave shows the time.

[16] Lastly, citing *Smart & Biggar v Constellation Brands Quebec, Inc*, 2015 TMOB 82, the Requesting Party submits that the Registrar need not take the affiant’s statement that “it is commonly known in the sanitation industry that floor scrubbers are a type of vacuum cleaner” at face value. Rather, the Requesting Party submits that this statement “defies the common sense understanding” of what the term “vacuum cleaner” means in ordinary commercial terms.

[17] While *Constellation Brands Quebec* may be an example of where it was appropriate to reject an affiant’s statement regarding the scope of registered goods, I note that, generally, statements in an affidavit must be accorded substantial credibility [*Ogilvy Renault v Compania Roca-Radiadores SA*, 2008 CarswellNat 776 (TMOB)]. Furthermore, the evidence as a whole must be considered; focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Ltd* (2005), 47 CPR (4th) 209 (TMOB)].

[18] In this case, I see no reason to reject Mr. Merkley’s statement equating the goods sold in association with the Mark to the registered goods. I accept that, as President of Dustbane and having worked with the company since 2002, Mr. Merkley would be knowledgeable of the industry. In any event, his statement is consistent with the function of the automatic scrubbers sold and is also consistent with the evidenced dictionary definition of “vacuum cleaner”, referring to a machine that cleans flooring “by suction”.

[19] Although the goods in evidence appear to be for commercial use, the registration is for “vacuum cleaners” and not limited to, for example, “household vacuum cleaners”. Ultimately, accepting the Requesting Party’s argument would be to take too narrow an interpretation of the statement of goods set out in the registration in this case. Rather, I accept that the “automatic scrubbers” sold by the Owner in association with the Mark can be considered specialized vacuum cleaners and thus correlate to the registered goods.

[20] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “vacuum cleaners” within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[21] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration 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 2017-10-24

APPEARANCES

Daphne Maravei

For the Registered Owner

Philip Lapin

For the Requesting Party

AGENTS OF RECORD

Ridout & Maybee LLP

For the Registered Owner

Smart & Biggar

For the Requesting Party