

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 163

Date of Decision: 2021-02-09

IN THE MATTER OF A SECTION 45 PROCEEDING

753146 Alberta Ltd.

Requesting Party

and

Premier Tech Ltée/Premier Tech Ltd.

Registered Owner

TMA888,451 for WipeOut

Registration

INTRODUCTION

[1] At the request of 753146 Alberta Ltd. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on January 15, 2018 to Premier Tech Ltée/Premier Tech Ltd. (the Owner), the registered owner of registration No. TMA888,451 for the trademark WipeOut (the Mark).

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

(1) Herbicides.

(2) Fungicides, insecticides and fumigants.

(Sometimes hereinafter collectively referred to as the Goods)

[3] Section 45 of the Act requires the registered owner of a trademark to show whether the trademark 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 such use since that date. In this case, the relevant period for showing use is between January 15, 2015 and January 15, 2018.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act as follows:

4(1) A trademark 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] In the absence of use, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[6] In response to the Registrar’s notice, the Owner submitted the affidavit of Louis Carrier, sworn April 11, 2018.

[7] Both parties submitted written representations. No oral hearing was held.

SUMMARY OF THE OWNER’S EVIDENCE

[8] Mr. Carrier is the President of Premier Tech Home & Garden Inc. (PTHG) and has held this position since he joined PTHG on May 9, 2016 [para 1]. Mr. Carrier is responsible for PTHG’s branding, advertising, innovation, promotions and go-to market strategies and has knowledge of all aspects of the business, marketing, and sales of PTHG, including the Goods sold under the Mark. In this regard, Mr. Carrier states that he has knowledge of the facts contained in his affidavit either from personal knowledge or from knowledge derived from the records and files of PTHG [para 4].

[9] Mr. Carrier explains that PTHG is a wholly-owned subsidiary of the Owner [para 6]. PTHG is also the licensee of the Owner and was the licensee of the Owner's predecessor in title Sure-Gro IP Inc. (Sure-Gro) [para 2]. The Owner and its predecessor merged on December 3, 2017 and as a result of the merger, the Mark is now owned by the Owner [para 7].

[10] With regard to use of the Mark, Mr. Carrier provides aggregated annual sales figures for the Goods sold by PTHG in association with the Mark [para 18] and states that during the relevant period:

- the Mark “was used in Canada (and is still being used) in association with a line of herbicide products intended to kill weeds and grass, including poison ivy and thistles” [para 12];
- the “Goods were sold in Canada (and are still being sold) under the brand WILSON” [para 13];
- the Goods were sold in Canada in bottles or plastic containers on which the Mark was affixed [para 13]; and
- when the Goods were not sold individually in bottles or containers, they were packaged in boxes bearing the Mark [para 15].

[11] Mr. Carrier states that each product sold by PTHG is identified by a SKU number and that the Goods sold in the normal course of trade by PTHG during the relevant period were identified, among others, by the following four product names (with each product name having its corresponding SKU number): “WipeOut Ready-to-use Ultra Liquid Herbicide”, “WipeOut Ultra Herbicide”, “WipeOut Ultra Battery Sprayer” and “WipeOut Max Club Pack” [para 16]. However, I note that the precise nature of these two latter products is nowhere indicated or explained in the evidence. I will return to this point later.

[12] In support of his assertions of use with respect to the Mark, Mr. Carrier attaches the following exhibits to his affidavit:

- Exhibit 1 consists of a copy of the subject registration.

- Exhibit 2 consists of “the artwork used to print the labels that are affixed to the Goods” which Mr. Carrier attests is an illustrative example of how the Mark was used in Canada during the relevant period [para 14]. Mr. Carrier points out that since this artwork is dated November 2, 2015, the Registrant’s predecessor in title Sure-Gro and its licensee PTHG are identified on said label on the bottom left side.
- Exhibit 3 consists of a photograph of boxes which Mr. Carrier states is an illustrative example of how the Mark was used in Canada during the relevant period. Mr. Carrier adds that the photograph “also illustrates how the Goods were sold during the Relevant Period to end consumers in one of PTHG client’s retail store” [para 15].
- Exhibit 4 consists of copies of invoices issued by PTHG to retail store customers in Canada during the relevant period which Mr. Carrier states are “illustrative and certainly not exhaustive examples of the sales in Canada by PTHG of Goods bearing the [Mark] during the Relevant Period” [para 17].

ANALYSIS AND REASONS FOR DECISION

[13] In its written representations, the Requesting Party raises essentially five main issues. First, it submits that Mr. Carrier’s affidavit is deficient and unreliable because the affiant appears to be unrelated in any way with the Owner and/or its predecessor in title and appears to have no personal knowledge of the facts which arose in the period before he joined PTHG. Second, it submits that any evidenced use of the Mark does not enure to the benefit of the Owner. Third, it submits that the Owner’s normal course of trade is not explained. Fourth, it submits that the Mark as registered is not the trademark that appears in the evidence. Fifth, it submits that, at best, the evidence relates only to “herbicides”.

Reliability of Mr. Carrier’s affidavit

[14] The Requesting Party argues that Mr. Carrier’s affidavit is deficient and unreliable because the affiant could not have personal knowledge of the facts which arose in the period before he joined PTHG on May 9, 2016 and because the affiant is not related to the Owner or to its predecessor in title. In this regard, the Requesting Party makes reference to facts not in

evidence regarding the identity of PTHG's president and submits search results from the *Registraire des entreprises du Québec* as a schedule to its written representations.

[15] First, I note that in a section 45 proceeding the Registrar may only receive evidence tendered by or on behalf of the registered owner [see *Meredith & Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)]. As the Requesting Party refers to certain alleged facts in its written representations that are not in evidence in this proceeding, I am disregarding all such references [see *Ridout & Maybee LLP v Encore Marketing International Inc* (2009), 72 CPR (4th) 204 (TMOB)].

[16] Second, while Mr. Carrier may not have direct, firsthand knowledge of the facts which arose before he joined PTHG, an affiant's position may put them in a position to have personal knowledge of facts without being a direct witness to the event [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289]. In this case, Mr. Carrier attests that he has the relevant knowledge of PTHG's activities during the entire relevant period, whether it be personal knowledge or knowledge derived from PTHG's records. Having regard to Mr. Carrier's description of his position and responsibilities at PTHG, I accept Mr. Carrier's sworn statement that he has the required knowledge. As such, there is no reason to disregard his affidavit as deficient or unreliable [see *Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25 for the well-established principle that an affiant's statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding].

[17] In any event, as stressed by the Owner in its written representations, evidence of a single sale made in the normal course of trade during the relevant period may be sufficient to establish use so long as it is a genuine commercial transaction. Therefore, even if Mr. Carrier could not attest to use of the Mark before he joined PTHG in May 2016, he would nevertheless be qualified to attest to use of the Mark during the remainder of the relevant period, after he joined PTHG.

Use enuring to the benefit of the Owner

[18] The Requesting Party argues that use of the Mark by PTHG does not enure to the benefit of the Owner because the Owner has not provided a copy of the licence agreement with PTHG,

or details thereof, nor evidence of actual control by the Owner over the character or quality of the Goods.

[19] A trademark owner need not furnish a written licence agreement to establish licensed use of a trademark [see *Wells' Dairy Inc v UL Canada Inc* (2000), 7 CPR (4th) 77 (FCTD)]. Rather, the owner can demonstrate the requisite control of the character or quality of the goods sold under licence pursuant to section 50(1) of the Act either by clearly attesting to the fact that it exerts the requisite control, by providing evidence demonstrating that it exerts the requisite control, or by providing a copy of the licence agreement that provides for the requisite control [see *Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84]. Furthermore, when considering whether the evidence demonstrates the requisite control, an inference may be drawn that such control exists, for example, where an individual is a director or an officer of both the registered owner and the alleged licensee [see *Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FCTD); and *Lindy v Canada (Registrar of Trade Marks)*, [1999] FCJ No 682 (FCA)].

[20] In this case, PTHG is a wholly-owned subsidiary of the Owner and PTHG and the Owner (including its predecessor in title) had at all material times a common officer [para 6]. Furthermore, Mr. Carrier explicitly states that the Owner (including its predecessor in title) had control of the character and quality of the Goods sold by PTHG in association with the Mark and, in particular, that the Owner was able to monitor and veto decisions made by PTHG with respect to the Mark and the quality of the Goods sold under the Mark [para 10]. Mr. Carrier also attests that “a legal notice indicating that [Sure-Gro] (now Premier Tech Ltd.) is the owner of the [Mark] and that [PTHG] is using it under license, is featured on all of the Goods” [para 10] and I note that the Exhibit 2 product label does indeed identify Sure-Gro and PTHG as such so as to give public notice of the said licensed use within the meaning of section 50(2) of the Act.

The Owner's normal course of trade

[21] The Requesting Party argues that, while Mr. Carrier references the “normal course of trade”, such mere assertions are insufficient and the Owner's evidence fails to adequately explain or discuss the normal course of trade.

[22] However, I note that there is no particular type of evidence that must be provided to show the normal course of trade in a section 45 proceeding and that the evidence need not be perfect [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)].

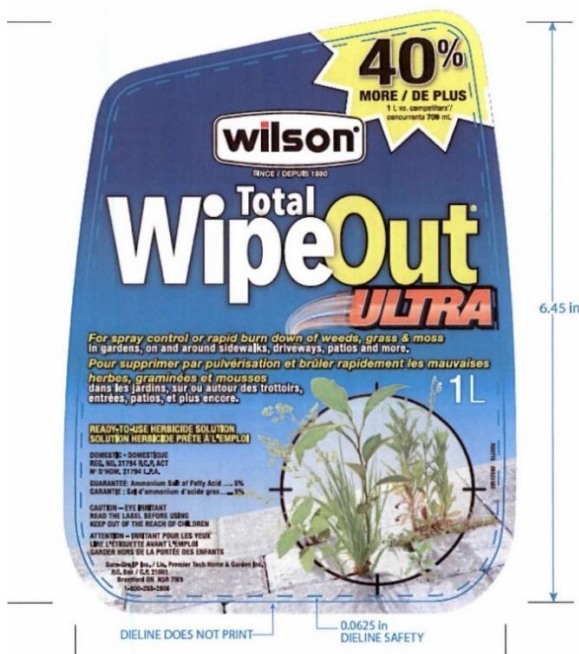
[23] In this case, I agree with the Owner that it has sufficiently explained its normal course of trade, namely that PTHG manufactures, sells and distributes the Goods under licence to retail stores, such as Home Depot, Canadian Tire, Walmart, Rona and Home Hardware [para 11], which in turn sell the Goods to end consumers [para 15].

Display of the Mark as registered

[24] The Requesting Party argues that the evidence provided by the Owner does not display the Mark as registered.

[25] As indicated above, Mr. Carrier has attached to his affidavit two examples showing how the Mark was displayed on the Goods, namely the Exhibit 2 product label and the Exhibit 3 photograph of product boxes. For the ease of discussion, I reproduce both of these examples below.

Product Label of Exhibit 2



Product Boxes of Exhibit 3



[26] Considering first the product label, the Requesting Party argues that it does not constitute display of the Mark as registered in view of the addition of the words “wilson”, “Total” and “ULTRA” to the Mark which caused the Mark to lose its identity.

[27] For the reasons that follow, I find 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 displayed [see *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA); *Registrar of Trade-marks v Cie internationale pour l’informatique CII Honeywell Bull*, (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc Ltd v Prodesign Ltd*, (1984) 2 CPR (3d) 535 (TMOB), for a thorough discussion of the general principles that govern the test for deviation].

[28] First, the word “wilson” is visually disconnected from the rest of the material, notably by its position against a white frame at the top of the label, as well as the different font type and size. I therefore accept the Owner’s submission that “wilson” would be perceived by the public as a separate trademark. In this regard, I note that the words “wilson” and “WipeOut” are both superscripted with what appears to be the symbol ®, which is consistent with my finding that the public would perceive “wilson” and the Mark as separate trademarks.

[29] In this regard, there is nothing in the Act that precludes a trademark owner from using more than one trademark at the same time in association with the same goods [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)] and in this case, Mr. Carrier explains that the Goods are in fact sold under the brand WILSON. In view of the foregoing, I do not accept the Requesting Party’s submission that the appearance of “wilson” on the product label suggests that a different entity is using the Mark.

[30] Second, the presence of the words “Total” and “ULTRA” does not cause the Mark to lose its identity or become unrecognizable. Indeed, the Mark stands out significantly not only from the separate trademark “wilson”, but also from the words “Total” and “ULTRA” which are printed in smaller, less prominent fonts than the Mark. In this regard, I agree with the Owner that these laudatory words would be perceived as adjectives used as marketing puffery to describe the Mark, rather than changing the idea conveyed by the Mark [see by analogy, *Crash Dummy Movie, LLC v Mattel Inc* (2007) 60 CPR (4th) 473 (TMOB), where the Registrar held that the

word “incredible”, in a less prominent font and in a less dominant position than the trademark at issue in that case, would not be perceived as an element of the trademark because its presence did not create a new idea and “incredible” would be perceived merely as an adjective used as marketing puffery to describe the trademark].

[31] In view of the foregoing, I accept that the Exhibit 2 product label displayed the Mark as registered.

[32] With respect to use of the Mark as shown in Exhibit 3, the Requesting Party argues that the photograph is blurred and indistinguishable and that it fails to show whether the use of the Mark is related to the Goods.

[33] While the photograph is slightly blurred and the view of the product box is partially obstructed by metal caging, it is apparent that the labelling closely resembles that of Exhibit 2, including the Mark in very large font between the words “MAX” (rather than “ULTRA” as in Exhibit 2) and “Total”. As such, I find that my analysis above with respect to the Exhibit 2 product label equally applies to the Exhibit 3 product box. However, I agree with the Requesting Party that it is not possible to determine the precise nature of the goods sold in these product boxes, which brings me to the last issue raised by the Requesting Party.

Evidence provided only relates to herbicides

[34] The Requesting Party argues that the Owner has only provided evidence relating to herbicides. I agree.

[35] First, as noted above, Mr. Carrier identifies four products in the exhibited invoices. While two of these products are clearly “herbicides”, neither Mr. Carrier nor the evidence otherwise explains the nature of the remaining two products.

[36] Second, while Mr. Carrier states that sales amounted to approximately \$2 million annually [para 18], he does not provide a breakdown of sales for each of the Goods. The sales figures as presented could therefore be associated to sales of only one or some of the Goods, such as “herbicides” in this case.

[37] Third, while Mr. Carrier indicates that the evidenced product label and boxes are examples of how the Mark was used in association with the Goods, I am only satisfied that they show how the Mark was used during the relevant period in association with herbicides, but not with the remaining Goods.

[38] In fact, it is worth noting that while Mr. Carrier expressly specifies that the Mark was used in association with a line of herbicides, nowhere in his affidavit does he make reference to fungicides, insecticides or fumigants, other than by including them in his definition of “the Goods”. Similarly, the Owner’s written representations do not specifically address the question of use of the Mark in association with fungicides, insecticides and fumigants, or how the evidence submitted shows use in association with these specific goods.

[39] In view of the foregoing, I am only satisfied that the Owner has shown use of the Mark in association with the goods (1), “herbicides”, within the meaning of sections 4 and 45 of the Act. As the Owner has not provided evidence of special circumstances that would excuse non-use of the Mark in association with the goods (2), “fungicides, insecticides and fumigants”, I conclude that these goods ought to be deleted from the registration.

DISPOSITION

[40] 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 amended to delete goods (2).

[42] Accordingly, the registration will be maintained in association with the following goods only:

(1) Herbicides.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No hearing held

AGENTS OF RECORD

Norton Rose Fulbright Canada LLP /
S.E.N.C.R.L., S.R.L.

For the Registered Owner

Flansberry, Menard & Associates / Associés

For the Requesting Party