



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 087

Date of Decision: 2022-04-27

IN THE MATTER OF A SECTION 45 PROCEEDING

Marks & Clerk

Requesting Party

and

Maxtech Consumer Products Limited

Registered Owner

TMA776,106 for BLACK MAX

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA776,106 for the trademark BLACK MAX (the Mark).

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

Hand tools, namely, hex keys, screwdrivers, ratchet drivers, drive bits, wrenches, socket wrenches, impact wrenches, sockets, socket extensions, universal-type adapters and socket drive adapters, bit sockets, cold chisels, nail sets, multi-tools, center punch, pliers, handsaws and blades therefore, hacksaws and blades therefore, utility knives and blades therefore, lock installation templates, carrying cases for any of the preceding, sold separately or together as a unit; power tool accessories, namely, router bits, auger bits, drill bits, namely, masonry cutting and wood cutting and metal cutting and glass cutting and ceramic cutting, flat bits, wood boring bits, spade bits, screw guides, double ended holders for combination drill and driver, locking tool holders, forstner bits, screwdriver bits, nutsetters, plug cutters, screw drivers, nut drivers, mandrels, deburring tools, wire

brushes, hole saws, power bit extensions, drill depth stops, countersinks; carrying cases for any of the preceding, sold separately or together as a unit.

[3] For the reasons that follow, I conclude that the registration ought to be maintained with respect to “Hand tools, namely, hex keys, wrenches”.

THE PROCEEDING

[4] At the request of Marks & Clerk (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on October 13, 2020 to the registered owner of the Mark, Maxtech Consumer Products Limited (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the Goods 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 October 13, 2017 to October 13, 2020 (the Relevant Period).

[6] The relevant definition of use in the present case 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.

[7] Bare statements that a trademark is in 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 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 Canada (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 trademark in association with each of the goods specified in

the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co.* (1984), 80 CPR (2d) 228 (FCA)].

[8] In the absence of use, pursuant to section 45(3) of the Act, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[9] In response to the Registrar's notice, the Owner furnished a Statutory Declaration of Kailash C. Vasudeva, declared on February 17, 2021, to which were attached three website printouts and three invoices (the Declaration).

[10] Only the Requesting Party submitted written representations. No oral hearing was held.

THE EVIDENCE

[11] Mr. Vasudeva is a director of the Owner. Aside from providing a general assertion of use of the Mark "in association with goods", he states the following:

2. I am satisfied that there are reasonable grounds for believing that:
3. a) Products are continuedly sold in retail store, such as Canadian Tire. Attached [is an image of a] 32 Piece Wrench Set under BLACK MAX trademark at Canadian Tire. The website is: <https://www.canadiantire.ca/en/pdp/black-max-wrench-set-32-pc-2997702p.html>. Representative photos showing the mark of Black Max displayed on Wrenches set and webpage are also enclosed.
- b) Products are also sold online. The Link below is the product at Amazon.com under Black Max. <https://www.amazon.com/dp/B01MDMSV63>. The downloaded webpage is enclosed.
- c) Invoices of sale of Black Max products (various products) to customers by Maxtech Consumer Products Limited. Invoice #s 118788, 118963 and 119200 are also enclosed. This includes different products under [the] Black Max Trademark.

[12] Attached to the Declaration are copies of three website printouts, two from www.canadiantire.ca and one from www.amazon.com, each of which shows a 32 piece combination wrench set displaying the Mark (the printout from www.amazon.com states that the product is "currently unavailable").

[13] Also attached to the Declaration are copies of three invoices issued by the Owner to Canadian customers:

- (a) Invoice No. 118788 dated August 15, 2019 addressed to 1066626 Ont Ltd for goods described as: “BLACK MAX 32 pc Wrench Set”, “BLACK MAX 10 pc Metric T Handle Coinjected Hex Set”, “BLACK MAX 10 pc Hex Key Torque Handle” and “BLACK MAX 13 pc SAE Hex Key Torque Handle”.
- (b) Invoice No. 118963 dated May 20, 2020 addressed to Ultra Form Mfg Co Ltd for the same goods as those described in Invoice No. 118788.
- (c) Invoice No. 119200 dated January 21, 2021 (outside the Relevant Period) addressed to Elam M. Martin Machine Shop Inc. for goods described as: “BLACK MAX 75 pc Titanium Drill Bit Set”, “BLACK MAX 11 pc Spade Bit Set with 2 stubbies”, “BLACK MAX 10 pc Hex Key Torque Handle”, and “BLACK MAX 13 pc SAE Hex Key Torque Handle”.

PRELIMINARY ISSUES

[14] The Requesting Party submits that the Declaration should be deemed inadmissible and repeats the submissions made in its letter to the Registrar dated April 19, 2021.

[15] First, the Requesting Party submits that the Declaration was not served in accordance with the *Trademarks Regulations*. This issue was addressed in the Registrar’s letter of May 12, 2021 and the Owner’s evidence was deemed to have been properly served pursuant to section 71(10) of the *Trademarks Regulations*.

[16] Secondly, the Requesting Party submits that the documents that accompanied the Declaration were not properly notarized nor were they properly identified in the Declaration such that it is not clear which document pertains to which comments in the Declaration. In the Registrar’s letter of May 12, 2021, it was noted that any rulings concerning the evidence would be made at the decision stage and, accordingly, I will address the issue now.

[17] There are three website printouts attached to the Declaration. Two of them are identified by a specific web address in the Declaration itself (see paragraphs 3a and 3b). The third printout is not so identified but it seems obvious from the context that it relates to paragraph 3a as well.

As for the three invoices, all are identified by their invoice number in the Declaration (see paragraph 3c).

[18] In the context of section 45 proceedings—which are intended to be summary and expeditious—the Registrar has frequently considered certain deficiencies in affidavits to be mere technicalities [see, for example, *Brouillette, Kosie v Luxo Laboratories Ltd* (1997), 80 CPR (3d) 312 (TMOB); and *88766 Canada Inc v Tootsie Roll Industries Inc* (2006), 56 CPR (4th) 76 (TMOB)]. In particular, the Registrar has accepted exhibits that were neither clearly identified as such nor properly endorsed where the exhibits were instead identified or explained in the body of the affidavit, without reducing the weight of the exhibits or of the affiant’s statements [see, for example, *Borden & Elliot v Raphaël Inc* (2001), 16 CPR (4th) 96 (TMOB)].

[19] The documents attached to the Declaration were neither clearly identified as exhibits nor properly endorsed. However, taking into consideration the purpose and intent of section 45 and the fact that Mr. Vasudeva referenced and explained the documents in the Declaration, I conclude that the documents attached to the Declaration form part of the evidence of record.

ANALYSIS AND REASONS FOR DECISION

[20] The Requesting Party submits that the Declaration does not show use of the Mark in Canada in association with any of the Goods during the Relevant Period. In particular, the Requesting Party submits that:

- (a) The Declaration does not include information pertaining to the type of business carried on by the Owner with the result that there is no basis upon which to conclude that any use of the Mark was in the normal course of trade.
- (b) There is no evidence that the goods listed in the two invoices issued within the Relevant Period correspond with any of the Goods with the result that there is no evidence of use with respect to any of the Goods.
- (c) The Declaration does not state that the product photographs shown in the website printouts demonstrate how the Mark was displayed on the Goods during the Relevant Period and that there is no evidence that the two invoices issued within the Relevant

Period were associated with the Goods at the time of transfer of the property in or possession of the Goods.

Normal Course of Trade

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

[22] From the Declaration, taken as a whole, it is evident that the Owner sells tools through retailers such as Canadian Tire, online through Amazon and directly to customers. Accordingly, I am satisfied that the two invoices issued within the Relevant Period evidence sales that occurred in the normal course of trade.

Statement of Goods

[23] While it is not for the Registrar to speculate as to the nature of the registered goods [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135; *Wrangler Apparel Corp v Pacific Rim Sportswear Co* (2000), 10 CPR (4th) 568 (TMOB)], reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64].

[24] The two invoices issued within the Relevant Period describe the following goods: “BLACK MAX 32 pc Wrench Set”, “BLACK MAX 10 pc Metric T Handle Coinjected Hex Set”, “BLACK MAX 10 pc Hex Key Torque Handle” and “BLACK MAX 13 pc SAE Hex Key Torque Handle”. The Owner has made no attempt to relate “wrench set”, “hex set” and “hex key torque handle” to the Goods but it is reasonable to conclude that “wrench set” and “hex set” equate to “wrenches” and “hex keys” as listed in the Goods. There is no reference to “hex key torque handle” in the Goods.

[25] There is no evidence of use, or special circumstances justifying non-use, in relation to any of the remaining Goods and they will be deleted from the registration.

Display of the Mark

[26] The Mark is displayed on the 32 piece combination wrench set depicted on the website printouts attached to the Declaration. While the printouts are dated after the Relevant Period, Mr. Vasudeva attests that they are “representative” and it is reasonable to infer from that statement that they are representative of how the Mark was displayed, at least in association with “wrenches”, during the Relevant Period.

[27] In any event, the Mark is referenced in the body of the two invoices issued within the Relevant Period in association with “wrench set” and “hex set”: i.e. “BLACK MAX 32 pc Wrench Set” and “BLACK MAX 10 pc Metric T Handle Coinjected Hex Set”.

[28] The display of a trademark on an invoice that accompanies the goods at the time of transfer may satisfy the requirements of section 4(1) of the Act, if it provides the requisite notice of association between the Mark and the goods [see *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321; and *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD)].

[29] As well, it has been accepted that, where the billing address on the invoice is the same as the shipping address on the invoice and the invoice is dated the same day as the shipment, the invoice would be viewed by the same party who received the goods, thus providing the notice of association between the trademark and the goods [see *Heenan Blaikie, LLP v LVD Acquisitions, LLC*, 2012 TMOB 25 at para 15].

[30] In this case, the Goods do not appear to have been shipped. Each invoice, under the heading “ship via” states “PKUP CUSTOMER PICK UP”. Although Mr. Vasudeva does not explain what this means, a reasonable inference based on the plain meaning of the words “customer pick up” is that the goods would have been picked up by the customers on or about the dates of the invoices which, in relation to Invoice No. 118788 and Invoice No. 118963, was within the Relevant Period.

[31] In my opinion, and consistent with *Heenan Blaikie*, where the goods were for customer pick up, it is reasonable to conclude that the invoices would have been viewed by the customer

picking up the goods, thereby providing the notice of association between “wrenches” (i.e. “wrench set”) and “hex keys” (i.e. “hex set”) and the Mark.

Conclusion

[32] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in Canada in association with “Hand tools, namely, hex keys, wrenches” within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[33] 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 the following goods:

... screwdrivers, ratchet drivers, drive bits ... socket wrenches, impact wrenches, sockets, socket extensions, universal-type adapters and socket drive adapters, bit sockets, cold chisels, nail sets, multi-tools, center punch, pliers, handsaws and blades therefore, hacksaws and blades therefore, utility knives and blades therefore, lock installation templates, carrying cases for any of the preceding, sold separately or together as a unit; power tool accessories, namely, router bits, auger bits, drill bits, namely, masonry cutting and wood cutting and metal cutting and glass cutting and ceramic cutting, flat bits, wood boring bits, spade bits, screw guides, double ended holders for combination drill and driver, locking tool holders, forstner bits, screwdriver bits, nutsetters, plug cutters, screw drivers, nut drivers, mandrels, deburring tools, wire brushes, hole saws, power bit extensions, drill depth stops, countersinks; carrying cases for any of the preceding, sold separately or together as a unit.

[34] Accordingly, 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 read as follows:

Hand tools, namely, hex keys, wrenches.

Robert A. MacDonald
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

No Agent Appointed

For the Registered Owner

Marks & Clerk

For the Requesting Party