



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2022 TMOB 220

**Date of Decision:** 2022-11-15

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Sanuvaire, LLC

**Applicant:** Sanuvox Technologies Inc.

**Application:** 1,864,270 for SANUVAIR

### **INTRODUCTION**

[1] Sanuvaire, LLC (the Opponent) opposes registration of the trademark SANUVAIR (the Mark), which is the subject of application No. 1,864,270 filed by Sanuvox Technologies Inc. (the Applicant).

[2] For the reasons that follow, the opposition is rejected.

### **RECORD**

[3] The application was filed on October 24, 2017 and is based on use of the Mark in Canada since at least as early as October 22, 2017. The statement of goods for this application is reproduced below, together with the associated Nice class (CI):

CI 11 (1) Air purifier for commercial use; Air sterilizer for commercial use.

[4] The application was advertised in the *Trademarks Journal* of February 13, 2019 and on March 29, 2019 the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[5] Numerous amendments to the Act came into force on June 17, 2019. As the application in this case was advertised before that coming into force, per the transitional provisions in section 70 of the Act, the grounds of opposition will be assessed in accordance with the Act as it read before amendment.

[6] The Opponent is opposing the application on the basis that it does not conform to the requirements of section 30 of the Act; that the Applicant is not the person entitled to registration of the Mark; and that the Mark is not distinctive.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavits of Keliann M. Argy, COO and counsel of the Opponent, along with Exhibits 1 to 34 thereto (the Argy affidavit) and Chad Sleiman, CEO of the Opponent (the Sleiman affidavit), both dated September 23, 2019. Ms. Argy provides some background information on the Opponent and on its relied upon trademark and trade name. Mr. Sleiman makes his affidavit essentially to support that adduced by Ms. Argy. As such, while it references the exhibits adduced by Ms. Argy, the affidavit of Mr. Sleiman does not introduce any exhibits.

[9] In support of its application, the Applicant filed the declaration of Jocelyn Dame, president of the Applicant, dated January 27, 2020, along with Exhibits 1 to 7 thereto (the Dame declaration). Mr. Dame provides some information on the Applicant and its application for the Mark.

[10] Neither deponent was cross-examined.

[11] Both parties filed written representations and attended a hearing.

### **PARTIES' RESPECTIVE BURDEN OR ONUS**

[12] There is an initial evidential burden on the Opponent to adduce sufficient evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)]. If this burden is met, the Applicant then bears the legal onus of establishing, on a balance of probabilities, that no grounds of opposition prevent the registration of the Mark.

### **NON-ENTITLEMENT GROUNDS OF OPPOSITION**

[13] Having regard to the provisions of sections 16(1)(a) and (c) of the Act, the Opponent pleads that the Applicant was not the person entitled to the registration of the Mark in view of the Opponent's prior use or making known of its trademark and its trade name SANUVAIRE.

[14] To meet its evidential burden in respect of this ground, the Opponent must show that, as of October 22, 2017, it had used or made known its relied upon trademark or trade name in Canada and that, as of February 13, 2019, this trademark or trade name had not been abandoned.

[15] I will start by noting that the evidence submitted in this respect by the Opponent fails to demonstrate that its trademark was made known in Canada in accordance with the requirements of section 5 of the Act. More specifically, it does not establish that the Opponent's trademark had become *well known* in Canada by reason of goods distribution *in Canada* or by reason of advertising be it in printed publications circulated *in Canada* or radio broadcasting. I am also not satisfied—on a fair reading of the Opponent's evidence as a whole—that it is sufficient to meet the Opponent's initial evidential burden with respect to use and non-abandonment of its relied upon trademark or trade name in Canada. As indicated above, the Opponent's evidence is comprised of the Argy and Sleiman affidavits. It notably includes the following:

- The Opponent is a United States limited liability corporation that was formed on February 18, 2016 pursuant to New York State rules [Argy affidavit, paras 4 and 10, Exhibit 3; Sleiman affidavit, para 5].
- The Opponent is a manufacturer of air purification, surface sanitization, and safety solution products designed specifically for the transit industry. Ms. Argy states that the Opponent has provided these goods and services in Canada in association with the trademark SANUVAIRE since 2016 [Argy affidavit, para 5].
- A Canadian trademark application No. 1,882,381 for SanUVAire was applied for on February 9, 2018 by the Opponent in association with “air cleaning units” (the Opponent’s goods) [Argy affidavit, para 6, Exhibit 1; Sleiman affidavit, para 3]. While this application of the Opponent is not in question in the present proceeding, I nevertheless find it interesting to note that it includes amongst other claims one of proposed use in Canada.
- Mr. Sleiman states that the Opponent began conducting business in Canada “in the very beginning of 2016” by way of servicing a Canadian customer the Opponent obtained through an asset purchase of another UVGI technology-based company [Sleiman affidavit, para 8].
- Specifically, Ms. Argy explains that on or about February 28, 2016, the Opponent purchased all of the assets of the business JKA Co., including client lists, purchase orders, pending orders and agreements [Argy affidavit, para 11].
- By March 2, 2016, the Opponent sent correspondence to its industry contacts announcing its legal formation (name and legal entity) which included Canadian customers, vendors, and potential new business. According to Ms. Argy the purpose of this announcement was to begin the establishment of the Opponent’s trademark in the industry, to direct attention to the website, to have all contact information updated, and update clients on new goods and services offered by the Opponent. Ms. Argy attaches correspondence (mostly emails) sent to prospective customers and the Canadian customers of JKA Co. “to promote the Opponent’s trademark and trade name SANUVAIRE, the announcement, as well as representative letterhead and signature lines that are sent to all customers of the Opponent in the course of business”. She also attaches a screenshot dated

December 15, 2017 of “the ZoomInfo online advertising from March 21, 2016 example showing the Opponent’s use of [the trademark and trade name SANUVAIRE] online”. [Argy affidavit, para 13, Exhibits 4-5; Sleiman affidavit, para 17] I note that no traffic information is provided with respect to the *ZoomInfo* website. As for the email announcement, while the Opponent provides a redacted list of email contacts, it is not broken down by territory to indicate the number of Canadians amongst them.

- The Opponent’s customers are primarily bus manufacturers that provide buses to transit authorities. The Opponent also sells the Opponent’s goods as replacement parts directly to transit agencies. [Argy affidavit, para 14]
- Selling the Opponent’s goods to the Opponent’s customers is a process that typically takes 18 months. According to Ms. Argy, the Opponent has been “involved in the process” with a Canadian bus manufacturer since its legal inception in February 2016. [Argy affidavit, paras 15-18]
- Ms. Argy states that the Opponent has used and made known the Opponent’s trademark and trade name SANUVAIRE in Canada as early as 2016 by way of: 1) servicing customers located in Canada; 2) advertising the trademark in Canada; and 3) soliciting customers in Canada, including public transportation authorities. [Argy affidavit, para 19]

1) Servicing customers in Canada

- Ms. Argy states that the Opponent sold the Opponent’s goods “bearing the Opponent’s [trademark and trade name SANUVAIRE]” to New Flyer Industries, a transit vehicle manufacturer, beginning in 2016 [Argy affidavit, para 20]. Ms. Argy states that New Flyer Industries is a Canadian company headquartered in Winnipeg, Manitoba, that New Flyer NFI Group Inc. is a Canadian company and the parent company of New Flyer Industries Canada ULC and New Flyer of America Inc [Argy affidavit, para 21] and proceeds to collectively refer to all of these entities as New Flyer. I note that Ms. Argy fails to mention whether New Flyer of America Inc is a Canadian or a US entity.

- Ms. Argy states that she was involved in discussions with New Flyer and introduced a new, upgraded product component part to be used in association with the Opponent's goods being supplied to the end customer. She attaches what she describes as email communications with New Flyer personnel and executives regarding this new bus build. [Argy affidavit, para 22, Exhibit 7]
- Ms. Argy states that the Opponent was selected by New Flyer through bid selection process to supply the Opponent's goods to a mutual end-customer transit authority's new bus build purchase, which consisted of supplying an end-customer transit authority with the Opponent's goods to be standardized and used on its fleet of buses. Ms. Argy attaches a copy of a 2016 "Breathe-Safe Systems UVGI Installation and Maintenance Manual" of the Opponent she states was provided to the end-customer along with the Opponent's goods upon their purchase. She also attaches what she describes as a photo of the Opponent's goods bearing the trademark SANUVAIRE and the data sheet that was sold and supplied to the end customer in Canada. [Argy affidavit, paras 23-24, Exhibits 8-9] First, I note that Ms. Argy does not indicate when the Opponent was selected by New Flyer through bid selection process or when, how and to what extent the goods depicted in Exhibit 9 were "sold and supplied ... in Canada". In any event, while it displays the trade name SanUVAire, LLC, I also note that the referenced data sheet document appears to be for a "Lamp Inverter" and lists "SANUVAire/New York" in its "Customer Name" section.
- Ms. Argy states that all of the Opponent's goods provided to New Flyer and other customers "use the Opponent's [trademark and trade name SANUVAIRE] in a similar manner" [Argy affidavit, para 25].
- Ms. Argy states that the Opponent also supplied "the [Opponent's goods]" to New Flyer for the purpose of replacement parts throughout 2016. She explains that vendors, such as Opponent, mostly sell to New Flyer who resells to the end customers and that it is typical industry course of conduct for New Flyer's After-Market Parts division to process most vendor replacement part orders to end customers. She states that all of the Opponent's goods provided to New Flyer "had the Opponent's [trademark and trade name SANUVAIRE] affixed to them and were

provided with an Installation Manual also bearing the Opponent's [trademark and trade name SANUVAIRE]". Ms. Argy attaches what she describes as evidence of Canadian replacement part sales in the form of New Flyer purchase orders and corresponding invoices (redacted) from 2016, 2017 and 2018. [Argy affidavit, paras 26 and 55, Exhibits 10 and 30] I note that the referenced exhibits do not include any invoices and only contain New Flyer purchase orders listing the Opponent as a vendor for parts such as brake lights, UV lamps, harnesses, ballasts and safety switches that were billed to New Flyer Industries Canada ULC at a Canadian address but were all shipped to a New Flyer Parts And Distribution Center in the United States. Ms. Argy does not provide further documents or explanation on how the replacement parts are "processed" to end consumers. I also note that New Flyer Parts And Distribution Center is not part of the entities she collectively designates with the qualifying term "New Flyer", which is not helpful in dissipating the ambiguity surrounding the question of whether such term is used by Ms. Argy to designate different entities in different jurisdictions.

- Ms. Argy also attaches other purchase orders from 2019 for "sales of Opponent's [g]oods to Canadian purchasers" [Argy affidavit, para 57, Exhibit 31]. Again, I note that the attached "nfi.parts" purchase orders list the Opponent as a vendor for parts such as harnesses, ballasts and safety switches that were billed to New Flyer Industries Canada ULC at a Canadian address but were all shipped to a NFI Parts And Distribution Center in the United States.
- Ms. Argy states that the Opponent uses the Opponent's [trademark and trade name SANUVAIRE] on all of the Opponent's goods product packaging, has done so since 2016 and attaches what she describes as "a sample of the packaging used on Opponent's [g]oods along with product private labeling with the Opponent's [trademark and trade name SANUVAIRE]" [Argy affidavit, para 57, Exhibit 24].
- Ms. Argy states that, as of the date of her affidavit, the Opponent has earned \$783 882.43 worth of revenue relating to the sale of the Opponent's goods under its "trademark name/mark 'SanUVAire'" and attaches a sales analysis spreadsheet she prepared on September 13, 2019 (reproduced below) disclosing the Opponent's

revenue generated from sales of the Opponent’s goods to Canadian customers [Argy affidavit, para 58, Exhibit 33].

2:35 PM  
07/23/19

**SanUVAire, LLC**  
**Job Profitability Summary**  
All Transactions

CANADIAN CUSTOMER	Act. Cost	Act. Revenue	(\$) Diff.
[REDACTED] Co., LLC [REDACTED]	38,414.11	179,987.72	141,573.61
[REDACTED]	14,450.01	37,764.58	23,314.57
[REDACTED]	23,592.75	113,193.80	89,601.05
[REDACTED] Inc.	17,876.40	40,890.30	23,013.90
<b>TOTAL</b>	<b>94,333.27</b>	<b>371,836.40</b>	<b>277,503.13</b>

I note that the spreadsheet in question is partially redacted and contains no yearly breakdown of the figures provided. It is also unclear whether the figures are in US or in Canadian dollars.

2) Advertisement of the Opponent’s trademark and trade name SANUVAIRE in Canada

- Both Ms. Argy and Mr. Sleiman state that, since 2016, the Opponent’s advertising efforts include advertisements in industry trade magazines (both digitally and in print) and published roundtable discussions that are circulated across Canada. Ms. Argy attaches what she describes as “copies of publications displaying the Opponent’s [trademark and trade name SANUVAIRE] along with dates identified magazines, and any corresponding collected statistical information”. [Argy affidavit, paras 27 and 43-45, Exhibits 11 and 22-23; Sleiman affidavit, paras 16-18] I note that most if not all of the exhibited advertisements were published at events held in the US or in US publications for which Canada-related statistical information is not provided, save for the following two exceptions:
  - The Traffic Overview for *Mass Transit* magazine’s website listing traffic by countries including Canada (with 1.99%). That said, this document titled “July 2019 Overview” only provides website traffic information for February-July 2019.



- The “lead generation report” for *BUSRide Maintenance* magazine’s Roundtable of Experts discussion “show[ing] Canadian interest therein”. That said, this report dates from December 2017 and includes a listing for only one Canadian individual. The manner in which this individual might have “shown interest” in the magazine or roundtable discussion is also unclear.
- Ms. Argy states that the Opponent purchased its domain name on March 16, 2016 and launched its website *sanuvaire.com* on or about June 21, 2016. She states that this website has had substantial traffic since its launch and attaches traffic statistics. [Argy affidavit, paras 40-41, Exhibits 20-21] I note that the provided statistical information was generated on March 19, 2018 and on September 9, 2019 and includes a monthly usage summary. It does not however include a breakdown by territory and therefore does not provide insight as to how many, if any, of the visits may have originated from Canada.
- Ms. Argy states that the Opponent uploaded several informational pamphlets onto its website to advertise the Opponent’s goods in association with the trademark and trade name SANUVAIRE and attaches a pamphlet for the Opponent’s product Sanuvaire 500-CX she states was uploaded onto the Opponent’s website on or about June 21, 2016. She also attaches 2018 screenshots of the Opponent’s website obtained using the Internet Archive Wayback Machine. [Argy affidavit, paras 28 and 48, Exhibits 12 and 25]. I note that there is no indication as to the number of Canadians that have visited the Opponent’s website and viewed the uploaded advertisements at any time.
- Ms. Argy states that the Opponent operates a Facebook page as well as a Twitter account launched in August 2016 that advertise the Opponent’s goods and attaches corresponding screenshots [Argy affidavit, paras 49-50, Exhibits 26-27]. Again, I note that there is no indication as to the number of Canadians that may have accessed the Opponent’s social media pages at any time.
- Ms. Argy also states that the Opponent has attended and actively promoted the Opponent’s [trademark and trade name SANUVAIRE] in association with the Opponent’s goods at various transit industry tradeshow, most notably at the

American Public Transportation Association (APTA) International Expo. More specifically, in October 2017, the Opponent operated an informational booth at this expo held in Atlanta, GA where a number of Canadian transit authority professionals attended. Ms. Argy provides a spreadsheet prepared by the APTA that the Opponent received on November 14, 2017 showing Canadian attendees of the 2017 tradeshow. [Argy affidavit, paras 51-54, Exhibits 11, 28-29]

- Ms. Argy states that, as of the date of her affidavit, the Opponent has invested \$63 249.93 relating to the advertisement of the Opponent's goods in Canada and attaches an advertising analysis spreadsheet she prepared on September 13, 2019 [Argy affidavit, para 59, Exhibit 34]. I note that the exhibited document titled "SanUVAire, LLC 1099 Summary January through December 2018" is partially redacted and contains no yearly breakdown of the figures provided. Again, it is also unclear whether the figures are in US or in Canadian dollars.

### 3) Solicitation of Canadian clients

- Ms. Argy states that the Opponent began soliciting Canadian transit authorities in 2016 through various methods including identified contact sales calls, maintenance personnel reach out, registration communications, and ascertaining qualified and routine supplier processes. She states that each of these solicitations was conducted in association with the Opponent's trademark and trade name SANUVAIRE and attaches copies of email solicitations with customers and a copy of a questionnaire for becoming a registered vendor submitted with a Canadian transit authority. [Argy affidavit, para 29, Exhibit 13] I note that the exhibited emails here are the same ones as those attached in Ms. Argy's Exhibit 4.

[16] While the Opponent's evidence outlined above is voluminous, the Applicant pleads that it contains deficiencies such that it does not support a finding that the Opponent has met its burden under its non-entitlement grounds of opposition. I cannot help but agree.

[17] First, with respect to servicing Canadian customers, the Opponent's evidence does not meet the requirements of section 4(1) of the Act as there is no evidence of

transfer of goods ever happening in Canada. The Opponent has not provided any invoices. As for the exhibited purchase orders, there is no evidence of receipt or delivery in Canada of the goods listed therein and no explanation as to the manner in which the ordered goods are eventually supplied, shipped or “processed” to Canadian consumers. I find it curious that Ms. Argy offers no information in this regard, especially in contrast to the detail provided with respect to some other aspects of her testimony. In any event, absent further explanation in this regard or of supporting documentation (such as, for example, shipping documents), I do not find that the Opponent’s evidence—even taken as a whole—necessarily beckons the conclusion that “goods were eventually delivered in Canada” as submitted by the Opponent at the hearing.

[18] With respect to advertisement, as indicated above, there is also no evidence of circulation for the Opponent’s advertisements in Canada as of the material date for these grounds of opposition. At the hearing, the Opponent submitted that the Registrar should take judicial notice of the fact that both *Mass Transit* and *BUSRide Maintenance* magazines circulate in Canada and would be viewed by the relevant customer. I am disinclined to take judicial notice of such facts as they are neither notorious or generally accepted or ones capable of immediate and accurate demonstration by resort to readily accessible sources of indisputable accuracy. Moreover, even were I inclined to do so, this would not be helpful in determining the extent of the circulation of these publications in Canada at any relevant time.

[19] Lastly, with respect to solicitation of Canadian clients, even were I to consider the Opponent’s announcement/solicitation email exchange of March 10-11, 2016 and its submission of October 2016 to become a registered vendor with the Toronto transit authority as regards use of the Opponent’s trade name—in light of the above review of the evidence—one of the things that strikes me is the apparent lack of follow-through, that is, the absence of clear and unambiguous evidence of the Opponent actually *carrying on business in Canada*. There is ample evidence that speaks to the Opponent conducting business under its relied upon trade name in the United States; the Opponent’s evidence does not however speak to the same in Canada. In this regard, it

should be reminded that mere assertions remain without probative value absent supporting documentation contemporaneous to the relevant date.

[20] Consequently, the sections 16(1)(a) and (c) grounds of opposition are rejected as I find that the Opponent has not met its initial evidential burden.

#### **NON-DISTINCTIVENESS GROUND OF OPPOSITION**

[21] Having regard to the provisions of section 2 of the Act, the Opponent pleads that the Mark is not distinctive in view of the Opponent's prior use and advertisement of its trademark and trade name SANUVAIRE.

[22] To meet its burden with respect to this ground, the Opponent must show that its trademark and trade name had become known sufficiently in Canada, as of the filing date of the statement of opposition, so as to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553 (TMOB), affirmed, (2006), 48 CPR (4th) 427 (FCTD)].

[23] The Opponent's evidence discussed above does not allow me to draw a meaningful conclusion regarding the extent of use, advertising or reputation of its relied upon trademark or trade name *in Canada*. For example, the bulk of Ms. Argy's statements deal with the Opponent's "trademark and trade-name SANUVAIRE" collectively rather than individually, the Opponent's sales and advertising figures are not broken down in any way (be it annually, by volume or Canadian region) and it is difficult to ascertain how many Canadians have been exposed to its advertising or solicitation efforts as of the material date.

[24] Consequently, the section 2 ground of opposition is rejected as I find that the Opponent has not met its initial evidential burden.

#### **NON-CONFORMANCE GROUND OF OPPOSITION**

[25] The Opponent pleads that the application for the Mark does not conform to the requirements of section 30(i) of the Act in that the Applicant could not have been

satisfied that it was entitled to use the Mark as the use and filing of such mark constituted bad faith and the Applicant's use of the Mark does not comply with a federal statute. More specifically, the Opponent alleges that:

- a. The Applicant knew or was aware of the Opponent's trademark and tradename SANUVAIRE and that the Mark was confusingly similar with same;
- b. The use of the applied for Mark is misleading advertising under sections 7(b) and (d) of the Act; and
- c. The use of the applied for Mark is misleading advertising and constitutes unfair competition under section 52(1) of the *Competition Act*.

[26] The relevant date for considering this ground of opposition is the date of filing the application, namely October 24, 2017 [*Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB)].

[27] Section 30(i) of the Act requires that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith or of a violation of a federal statute. I will start by noting that the application here includes the required statement.

[28] With respect to its allegation of non-compliance with federal statutes, the Opponent notably submits that it has demonstrated that it has goodwill in the trademark and trade name SANUVAIRE in association with its goods in Canada, that the applicant misrepresented itself to the public by adopting and using a mark which is likely to be confused with the Opponent's mark, which could result in a loss of potential profits for the Opponent. The Opponent further submits that the Applicant made use of a description that was false that mislead the public as to the character, quality, composition or the mode of manufacture of the goods. Specifically, the Applicant used the name SANUVAIR which falsely suggests the goods are the Opponent's, with an advertisement nearly identical to the Opponent's, which would have the effect of misleading the public to believe that the goods are manufactured or distributed by the Opponent. For the same reason, the Opponent submits that the application for the Mark

also does not comply with section 52(1) of the *Competition Act*. Namely, the Applicant used a misleading advertisement that made a representation to the public that is literally false or misleading that is material. Specifically, the Applicant misrepresented that the products sold were the products of the Opponent in its advertisements. Moreover, this statement was made knowingly and recklessly in light of the Opponent's use of the SANUVAIRE trademark and subsequent to the exchange between the parties.

[29] With respect to its allegation of bad faith, the Opponent mainly submits that: the Applicant was aware of the Opponent's prior use of the trademark and trade name SANUVAIRE; the Applicant then engaged in a pattern of copying the Opponent's advertisements and trademarks; the Applicant had no intention of using the Mark prior to its exchange with the Opponent in September 2017, and subsequently filed the application with the sole intention of preventing the Opponent from filing its own application and registering its trademark SANUVAIRE.

[30] The Opponent's evidence in this respect is that:

- On or about May 2017, the Opponent became aware of the Applicant and reviewed the contents of the Applicant's website [Argy affidavit, para 30; Sleiman affidavit, para 9].
- Sometime in May 2017, Mr. Sleiman conducted a telephone conversation with a sales member of the Applicant, to inquire about the Applicant's products and a potential, mutually beneficial or collaborative endeavor [Argy affidavit, para 31; Sleiman affidavit, para 10]. I note that the referenced "sales member" contacted by Mr. Sleiman is not identified and that the content of the telephone conversation is not further described.
- On or about July 20, 2017, the Opponent received a cease and desist letter from the Applicant, claiming that the use of the Opponent's trademark was infringing upon the Applicant's mark SANUVOX. On or about July 31, 2017, Ms. Argy responded to the Applicant acknowledging receipt of the July 20, 2017 correspondence and advising the claim was under review [Argy affidavit, para 32, Exhibit 15; Sleiman affidavit, para 11].

- On or about August 16, 2017, the Opponent responded to the Applicant with a denial of the claim but, regardless, requested further documentation in support of the claim of infringement. Then, on or about September 26, 2017, the Applicant sent another letter to the Opponent demanding confirmation of Opponent's discontinued use of relied upon trademark. [Argy affidavit, para 33, Exhibit 16] I note that both cease and desist letters from the Applicant were sent by its US representative and exclusively reference US law and jurisprudence.
- During the correspondence between July and September 2017, the Opponent reviewed Applicant's website at various times and found no use of the names or marks SANUVAIRE and SANUVAIR [Sleiman affidavit, para 12].
- Since receiving Applicant's allegations in its correspondence between July and September 2017, no infringement claim was presented in writing to the Opponent [Argy affidavit, para 34; Sleiman affidavit, para 13].
- On or about November 25, 2017 the Opponent again reviewed Applicant's website and discovered an online advertisement showing use of the Mark in association with a product nearly identical to a product of the Opponent associated with its relied upon trademark [Argy affidavit, para 36, Exhibit 17; Sleiman affidavit, para 14].
- To the Opponent's knowledge, prior to the filing date for the Mark, the Applicant had not used the Mark in any capacity and/or in association with any of its goods or services in Canada [Argy affidavit, para 37].
- Ms. Argy conducted searches of Applicant's website in support of her statements that the Applicant did not have any SANUVAIR products from the beginning of its website, up through and including October 2017. She attaches archived screenshots of the Applicant's website obtained using the Internet Archive Wayback Machine. [Argy affidavit, para 38, Exhibit 18]
- Finally, Ms. Argy states that the Applicant's online advertisement for the SANUVAIR product incorporates product names and descriptions nearly identical to online advertisements of the Opponent first used on or about February 2016 and published with the launch of Opponent's website in June 2016. Comparing the Opponent's SANUVAIRE 500-CX line card with electronic copies of

advertising that she found of the Applicant's product, Ms. Argy notes similarities including:

- That the Applicant identifies the product as "SANUVAIR 500-GX" compared to the Opponent's "SanUVAire 500-CX";
- That the Applicant's advertisement uses identical product specifications to the Opponent's;
- That the Applicant states the product is the "ideal solution" for what is known as "Sick Building syndrome" in the same manner as the Opponent; and
- That the Applicant lists identical system features in an identical order as the Opponent, including being ideal for schools and day care centers, eliminating bacteria, having a patented design and being ETL certified.

[Argy affidavit, para 39, Exhibits 12 and 19]

Ms. Argy does not indicate when she retrieved the electronic copy advertising the Applicant's SANUVAIR 500-GX product. I however note that the second page of her Exhibit 19, in its top right corner, bears a date of July 28, 2015.

[31] The Applicant for its part submits that: the parties' correspondence between July and September 2017 related to a matter in a different country (*i.e.* the United States) and so it wasn't required to account for its Canadian trademarks at this occasion; that availability searches are not a requirement to the filing of a Canadian trademark application; that in the last years and in any case before the beginning of 2017, the Applicant created and used the SANUVAIR brand for its products functioning with particle filters; and that such brand only started being showcased on the Applicant's website after the filing of its application for the Mark. In this regard, the Applicant relies on the Dame declaration which includes the following:

- The Applicant is a corporation founded in 1995 under the laws of Canada where it has been doing business since that date in the field of air purifying apparatus. Its mission has been to design and manufacture residential, commercial, institutional and medical air and surface disinfection units. The Applicant's



products designed and sold in Canada over the years reproduce the natural purification process of the sun in the upper atmosphere. [paras 7-9, Exhibit JD-1]

- For almost 25 years, the Applicant has designed and commercialised in Canada a range of residential and commercial air purifying systems and air conditioner coils [para 10].
- The Applicant owns and has been using SANUVOX-formative marks in association with goods sold in Canada and attaches corresponding 2006, 2010 and 2014 representative invoices (partially redacted) [paras 11-15, Exhibits JD-2 and JD-3].
- During the last years but certainly before the beginning of 2017 (*“au cours des dernières années mais certainement avant le début de l’année 2017”*), in the idea of the continuity of its SANUVOX brand, the Applicant created the Mark for its products functioning with particle filters. Mr. Dame states that the Mark was created by the Applicant and attaches promotional materials—used by the Applicant throughout the years (*“au cours des ans”*)—for air sterilization and purification systems and air purification units commercialized and sold in Canada by the Applicant since at least as early as the beginning of 2017 (*“depuis au moins aussi tôt que le début de 2017”*) in association with the Mark. [paras 16-17, Exhibit JD-4]
- The Applicant’s customers for the goods sold in association with the Mark in Canada are, for example, businesses operating in the cannabis industry, the medical industry, or that are involved in waste rooms management [para 23].
- Mr. Dame states that all promotional materials used by the Applicant result from its own effort to create the clearest product descriptions possible. In addition, he states that certain expressions used in the documents submitted under Exhibit JD-4 were already used by the Applicant from 2009 (*“dès 2009”*). He attaches in this respect excerpts from a 2009 SANUVOX promotional brochure including the following language in its section pertaining to stand-alone and/or ducted models of air purifiers: “... the ideal solution for the problems associated with Sick Building Syndrome”; “Ideal for ... schools, daycare centers ...”; “Destroys ... bacteria”; and “Patented Design”. [para 18, Exhibit JD-5]

- The Applicant has throughout the years (“*au cours des ans*”) sold goods in association with the Mark including those depicted in Mr. Dame’s Exhibit JD-4. Mr. Dame attaches representative 2017 and 2018 invoices (partially redacted) showing sales of such goods in Canada by the Applicant. He states that the sales identified on these invoices relate to goods on which the Mark was affixed (as per the attached representative photograph), and that were sold and delivered to customers in Canada. Mr. Dame points out that the oldest invoice tracked is dated of January 13, 2017 and features the Mark. He also states that that the Applicant’s number of units sold in association with the Mark in Canada has gone from at least 150 units in 2017 to at least 250 units in 2019. Mr. Dame goes on to state that the Applicant’s yearly sales of goods in association with the Mark in Canada total at least \$300 000 for at least (“*pour au moins les années*”) 2018 and 2019. [paras 19-22, Exhibits JD-6 and JD-7] I indeed note that one of the exhibited invoices is dated of January 13, 2017. I also note that all of the exhibited invoices display bill to and shipped to Canadian addresses (for example, in Nova Scotia, Ontario, Alberta and Quebec) and all include the SANUVAIR moniker in the body of the invoices (for example, in descriptions such as “MB500-GX Model SANUVAIR 500 Air Purificateur UV-C/UV-V”, “S300FX-GX Model SANUVAIR S300 UV-C/UV-V purifier ...” or “S1000FX-GX Model SANUVAIR S1000 air purifier UV-C/UV-V ...”).

[32] First, the mere fact that the Opponent has alleged prior use or making known of its trademark and trade name in association with the same or the same type of goods as those of the Applicant is not by itself sufficient to put into question section 30(i) of the Act [*SALT Branding, LLC Limited Liability Company California v Salt Creative Group, Inc*, 2015 TMOB 207].

[33] Similarly, while it has been established that the Applicant here knew of the Opponent and of its adoption and use of SANUVAIRE in the United States prior to filing its application for the Mark, mere knowledge of the existence of an opponent’s trademark or trade name does not in and of itself support the allegation that an applicant could not have been satisfied of its entitlement to use its mark [*Woot, Inc v*

*WootRestaurants Inc Les Restaurants Woot Inc*, 2012 TMOB 197]. Mere awareness of an opponent's prior rights also does not preclude an applicant from truthfully providing the statement required by section 30(i) of the Act [*Effigi Inc v ZAM Urban Dynamics Inc*, 2010 TMOB 214; *Bousquet v Barmish Inc* (1991), 37 CPR (3d) 516 (FCTD), affirmed (1993), 46 CPR (3d) 510 (FCA)].

[34] Even applying to register a trademark in Canada while knowing that it has been used in another country does not in and of itself constitute bad faith [*Taverniti SARL v DGGM Bitton Holdings Inc* (1986), 8 CPR (3d) 400 (TMOB) at 404-405; *Viper Room Development, LLC v 672661 Alberta Ltd*, 2014 TMOB 201 at para 4; *Restaurant Development Group LLC v Vescio Group Inc*, 2016 TMOB 82 at para 43]. There may in fact be a legitimate basis to obtain a registration in Canada for the same trademark that is registered and used by a party elsewhere, where there is no reputation for said party's trademark in Canada [*Beijing Judian Restaurant Co Ltd v Meng*, 2022 FC 743, at para 42; *Bousquet v Barmish Inc*, *supra*].

[35] In the case at hand, as already discussed, the Opponent's evidence does not establish that it benefited from a reputation *in Canada* at the time of filing the application to register the Mark. There is also no evidence of negotiations between the parties or of a prior relationship beyond their correspondence between July and September 2017, which I find more likely than not pertained exclusively to the United States.

[36] Moreover, I find that the Applicant has sufficiently rebutted the Opponent's allegations with respect to copying its advertising. I note in this regard the names and models of the Applicant's products featured in the body of the exhibited invoices (such as "MB500-GX Model SANUVAIR 500 Air Purificateur UV-C/UV-V" listed in invoice No. CO00040400 of January 13, 2017) as well as the Applicant's example of its previous advertising from 2009 (incorporating language similar to that used in its later material promoting goods in association with the Mark).

[37] I also find that the Applicant has sufficiently rebutted the Opponent's allegations that the Applicant only began using the Mark after its interaction with the Opponent in the summer of 2017. First, with respect to the Opponent's reviews of the Applicant's

website, given the nature of the Applicant's business and the goods in the instant proceeding, I do not find that the absence of online advertising in itself evidences non-use of the Mark. In addition, I agree with the Applicant's submissions that whether the Dame declaration establishes use of the Mark in accordance with the requirements of section 4 of the Act or not, it nevertheless shows the SANUVAIR moniker appearing on the Applicant's invoices as early as January 13, 2017 as well as in promotional materials for air sterilization systems, air purification systems and air purification units stated to have been commercialized and sold in Canada by the Applicant since at least as early as the beginning of 2017. The Opponent's allegations that the Applicant's date is false and misleading and that its materials are unfinished drafts or have been tampered with are unsubstantiated by the evidence on file. I would add that allegations that the Applicant was engaged in a pattern of altering and fabricating evidence of use and had not actually used the Mark perhaps should have more appropriately been raised under section 30(b) of the Act.

[38] Lastly, in view of the evidence discussed above, I am not satisfied that the Opponent has made out a *prima facie* case of a violation of any of the relied upon federal statutes. For example, the Opponent has not demonstrated that it has acquired goodwill in the trademark and trade name SANUVAIRE in Canada, nor that the Applicant made false and/or misleading representations to the Canadian public, including that the average consumer of the Applicant's goods in Canada would wrongfully assume that such goods are the Opponent's.

[39] Consequently, the section 30(i) ground of opposition, in its entirety, is also rejected.

**DISPOSITION**

[40] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Iana Alexova  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2022-08-23

## **APPEARANCES**

**For the Opponent:** Andriy M. Holuk

**For the Applicant:** Barry Gamache

## **AGENTS OF RECORD**

**For the Opponent:** Wises Professional Corporation

**For the Applicant:** Robic