



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 123

Date of Decision: 2023-07-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Pelton Crane Inc.

Registered Owner: KaVo Dental Technologies, LLC

Registration: TMA896,796 for PELTON & CRANE

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. TMA896,796 for the trademark PELTON & CRANE (the Mark), owned by KaVo Dental Technologies, LLC, an Illinois limited liability company doing business as Pelton & Crane (the Owner).

[2] For the reasons that follow, I conclude that the registration ought to be amended.

THE RECORD

[3] At the request of Pelton Crane Inc. (the Requesting Party), the Registrar of Trademarks issued a notice to Dental Equipment, LLC a Delaware limited liability company doing business as Pelton & Crane under section 45 of the Act on October 8,

2021. On May 9, 2022, the Registrar recorded a change in title from this entity to the Owner, due to a merger effective December 31, 2014. I am satisfied that this change in title is not at issue in this proceeding.

[4] The notice required the Owner to show whether the Mark had 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 October 8, 2018, to October 8, 2021.

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

Dental operatory furniture and equipment, namely: - dental cabinetry; dental chairs; dental stools; dental delivery systems consisting of dental irrigators; apparatus for providing compressed air and water, namely, air and water regulators, air and water flow control valves, air logic control valves, and air and water distribution blocks and manifolds, all for use in the field of dentistry; holders and trays for dental instruments; furniture for holding dental instruments; autoclaves for dental use; lamps for medical use in the field of dentistry; electric lighting fixtures, namely, intra-oral dental light system for medical use in the field of dentistry; water filtration systems for use in the field of dentistry; back upholstery and seat upholstery for dental chairs and stools; and seals and gaskets for autoclaves.

[6] The relevant definition of use in the present case is set out in section 4 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] It is well accepted that 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 Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. However, 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.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Stephanie Yonce, Vice President of the Owner, sworn on May 6, 2022. Only the Owner submitted written representations; no oral hearing was held.

EVIDENCE AND ANALYSIS

[9] Ms. Yonce explains that the Owner manufactures dental core equipment and furniture including dental chairs, operatory lights, delivery systems, and dental cabinetry for use by dental professionals. She states that such goods are primarily sold through a worldwide network of dental distributor partners, and directly to dental practitioners and universities.

[10] Ms. Yonce states that during the relevant period, the Mark was displayed directly on the Owner's goods, their packaging, on sales invoices, or on other printed materials such as manuals which accompanied the goods at the time they were sold. As Exhibits C and D, she attaches images of the Mark displayed on certain goods and on manuals, respectively, and confirms that these images are representative of how the Mark was displayed on such goods or manuals in Canada during the relevant period.

[11] As Exhibit A, Ms. Yonce attaches a spreadsheet showing sales in Canada in the years 2018 through 2021 for "P&C Cabinets", "P&C Chairs", "P&C Dental Delivery Units," "P&C Operatory Lights", "P&C Stools", and "P&C Service/Spare Parts, Other Products". The sales figures range from hundreds to millions of dollars.

[12] As Exhibit B, Ms. Yonce attaches a number of invoices, all issued by the Owner and addressed to Canadian purchasers. One of these invoices is dated after the relevant period; however, there are no products listed on that invoice that do not also appear on other invoices, the rest of which are dated during the relevant period. Ms. Yonce explains that these invoices reflect sales in the ordinary course of trade to various representatives and dealers in Canada for resale to Canadian customers, and that the Mark was displayed on the goods themselves, on their packaging, and/or on manuals that accompanied the goods at the time of transfer. She further explains that the goods referenced in these invoices are included in the Exhibit A sales figures.

[13] Ms. Yonce also includes a chart correlating the registered goods with the products on specific invoices, which are identified by numbers and short-form names. Ms. Yonce indicates that where no invoice number is indicated in the chart, no sales of the corresponding goods were made during the relevant period. The registered goods she correlates with invoiced products include “dental cabinetry”, “dental chairs”, “dental stools”, “dental delivery systems consisting of dental irrigators”, “apparatus for providing compressed air and water, namely, [...] air and water flow control valves, [...] all for use in the field of dentistry”, “lamps for medical use in the field of dentistry”, “back upholstery and seat upholstery for dental chairs and stools”, and “seals and gaskets for autoclaves”. Given that Ms. Yonce has demonstrated how the Mark would have been displayed at the time of transfer of these goods, and has shown that they have been sold in Canada in the normal course of trade, I am satisfied that the Owner has shown use of the Mark in association with these goods within the meaning of sections 4 and 45 of the Act.

[14] I note that the goods “furniture for holding dental instruments” are listed in the chart as “Not sold separately”, and Ms. Yonce does not specifically discuss these goods elsewhere in her affidavit. While I accept that a number of the goods sold by the Owner could be considered “furniture for holding dental instruments”, it is settled law that generally, use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration. Having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [per *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. As such, I do not accept that the sale of the goods listed in the previous paragraph would also constitute sales of “furniture for holding dental instruments”, and it is not clear that other items listed in the invoices would correspond to this registered good. In the absence of special circumstances excusing non-use of this good, the registration will be amended to delete “furniture for holding dental instruments”.

[15] As for the goods “holders and trays for dental instruments”, Ms. Yonce explains that there are two types of dental delivery systems sold by the Owner, one for a doctor/dentist and one for a dentist’s assistant, and while a tray is almost always

included in the former system, one might also be sold separately or included as part of the assistant's system on request. As an example of the product sold separately, she refers to an invoice showing a system with a "STAINLESS STEEL TRAY & PAD" option, listed under "Brand PELTON & CRANE". I concur with the Owner that nothing in the Act requires a trademark to be used in association with a "stand-alone" product; use within the meaning of the Act may be established where a Mark is used in association with a component of a complete product [see *Gowling, Strathy & Henderson v Tundra Knitwear Ltd* (2001), 13 CPR (4th) 559 (TMOB) at para 7; *Gowling WLG (Canada) LLP v Pelican International Inc*, 2016 TMOB 144 at paras 16-18].

[16] While the Owner has distinguished "dental delivery systems consisting of dental irrigators" and "holders and trays for dental instruments" in its registration and may not rely on a single product in support of maintaining both registered goods, I note that in this case, the Owner has correlated the former registered good with several invoiced items including "SPIRIT ELLIPSE MT DEL SYS" [Exhibit B, invoice 8010.8015151130], and the latter registered good with "SWING MOUNT UNIT W/O ASSTS." whose features include "STAINLESS STEEL TRAY & PAD" [Exhibit B, invoice 8010.127612856]. Given that the product description for this swing mount unit in the invoice includes both the Mark and a specific reference to the steel tray component, I am satisfied that the Mark would be associated with the tray component at the time of transfer. Since the Owner has shown that this product has been sold in Canada in the normal course of trade, I am satisfied that the Owner has shown use of the Mark in association with "holders and trays for dental instruments" within the meaning of sections 4 and 45 of the Act.

[17] With respect to the goods "apparatus for providing compressed air and water, namely, air and water regulators [...], air logic control valves, air and water distribution blocks and manifolds" and "electric lighting fixtures, namely, intra-oral dental light system for medical use in the field of dentistry", Ms. Yonce states that these are component parts of "dental delivery systems consisting of dental irrigators" and are sold as replacement parts as needed. However, she explains that there were no sales of these goods during the relevant period, stating that "It is believed that with the

restrictions and closures of many dental offices due to the COVID-19 pandemic, demand for the goods which were not sold decreased significantly.”

[18] Despite Ms. Yonce’s statement that these apparatus goods are component parts of “dental delivery systems consisting of dental irrigators”, she has not indicated which, if any, of the invoiced items would have contained such components. In this respect, I note that it is not for the Registrar to speculate as to the nature of the goods or the trade; it is the responsibility of the registered owner to show the connection between the goods registered and those included in the evidence [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13]. In the absence of such evidence, I am not satisfied that the Owner has established use of the Mark within the meaning of sections 4 and 45 of the Act in association with “apparatus for providing compressed air and water, namely, air and water regulators [...], air logic control valves, air and water distribution blocks and manifolds” and “electric lighting fixtures, namely, intra-oral dental light system for medical use in the field of dentistry”.

[19] As for the Owner’s submission that the COVID-19 pandemic amounts to special circumstances excusing non-use of these goods, I note that the Registrar considered similar submissions in *The Wonderful Company LLC and Fresh Trading Limited*, 2023 TMOB 8 at paras 36-37:

36 Regarding the Owner's submission that the COVID-19 pandemic is a special circumstance excusing non-use, I acknowledge that the pandemic has been a uniquely disruptive event for businesses in Canada and around the world. Because of its scope and magnitude, it is a circumstance with no clear parallel in prior jurisprudence; accordingly, when assessing whether non-use of a trademark will be excused for reasons relating to the pandemic, it is necessary to consider the unique realities of the pandemic.

37 Still, while the pandemic may be an "uncommon, unusual or exceptional" circumstance, it will not automatically excuse non-use of a trademark. It is still necessary to demonstrate that non-use of a trademark is excused because of special circumstances within the framework set out by the Federal Court in *Harris Knitting*. Thus, where an owner submits that the pandemic amounts to special circumstances excusing non-use of its trademark, that owner must first show that non-use of a trademark is in fact due to the pandemic; in other words, it must provide sufficient evidence demonstrating that if not for the pandemic, it would have used the trademark. Then, if an owner can show that the pandemic was the reason for non-use, the owner must still satisfy the Registrar that such non-use is excusable considering the length of time of

non-use, whether such non-use was in fact beyond the owner's control, and whether a resumption of use is imminent [see *Harris Knitting*]. As the second factor will be essential for a finding of special circumstances excusing non-use, it will be incumbent on an owner to provide concrete evidence demonstrating that pandemic-related non-use, and non-use for any other reasons, were in fact beyond the owner's control. In other words, it is not sufficient for an owner to refer to the pandemic generally without providing sufficient details regarding its impact on the owner's operations. [emphasis added]

[20] In this case, the Owner has not provided any specific evidence to demonstrate that if not for the pandemic, it would have used the Mark in association with the aforementioned goods, other than Ms. Yonce's statement regarding a belief that dental offices were closed during the pandemic, thereby reducing demand for replacement parts. As noted in *Wonderful Company*, it is not sufficient for an owner to refer to the pandemic generally without providing sufficient details regarding its impact on the owner's operations. In any event, the pandemic only began in the second half of the relevant period; furthermore, the Owner has not provided a date of last use or any evidence demonstrating a serious intention to shortly resume use [see *NTD Apparel Inc v Ryan*, 2003 FCT 780 at paras 22-23]. In the absence of such detail, I am not satisfied that the Owner has established special circumstances excusing non-use; as such, the registration will be amended to delete the goods "air and water regulators [...], air logic control valves, air and water distribution blocks and manifolds" and "electric lighting fixtures, namely, intra-oral dental light system for medical use in the field of dentistry".

[21] As for the goods "autoclaves for dental use", Ms. Yonce states that although these goods have not been sold since before 2018, the Owner provides support for these goods through the sale of the related goods "seals and gaskets for autoclaves". While I accept that the Mark was used in association with "seals and gaskets for autoclaves", as discussed above, I am not satisfied that such use would also suffice to maintain the registration for the discontinued goods "autoclaves for dental use". Ms. Yonce further states that the goods "water filtration systems for use in the field of dentistry" have been discontinued. In the absence of special circumstances excusing non-use of these goods, the registration will be amended to delete the goods "autoclaves for dental use" and "water filtration systems for use in the field of dentistry".

DISPOSITION

[22] In view of all of the foregoing, 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 “furniture for holding dental instruments”, “air and water regulators”, “air logic control valves, and air and water distribution blocks and manifolds,” “electric lighting fixtures, namely, intra-oral dental light system for medical use in the field of dentistry”, “autoclaves for dental use”; and “water filtration systems for use in the field of dentistry”.

[23] The amended registration will be as follows:

Dental operatory furniture and equipment, namely: - dental cabinetry; dental chairs; dental stools; dental delivery systems consisting of dental irrigators; apparatus for providing compressed air and water, namely, air and water flow control valves, all for use in the field of dentistry; holders and trays for dental instruments; lamps for medical use in the field of dentistry; back upholstery and seat upholstery for dental chairs and stools; and seals and gaskets for autoclaves.

G.M. Melchin
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

For the Registered Owner: Macrae & Co.