



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 014

Date of Decision: 2024-01-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Deeth Williams Wall LLP

Registered Owner: Eaton Corporation

Registration: TMA445,667 for COMMANDER

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. TMA445,667 for the trademark COMMANDER (the Mark).

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

Electrical goods, namely, electrical circuit breakers, controls namely contactors, motor starters, motor control centers, pushbuttons, electronic adjustable frequency controls, vacuum interrupters, bus ways, electrical meter centers, panelboards, load centers, meter panels, switch boards, pump control panels, switches, switch gear, protectors, porcelain lamp holders, transformers, and assemblies and components thereof and parts therefor.

[3] For the reasons that follow, I conclude that the registration should be amended.

PROCEEDING

[4] At the request of Deeth Williams Wall LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 19, 2022, to the registered owner of the Mark, Eaton Corporation (the Owner).

[5] The notice required the Owner to show whether the Mark was 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 July 19, 2019, to July 19, 2022.

[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] Where the owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar’s notice, the Owner furnished the statutory declaration of Umesh Patel, marketing director of Eaton Industries (Canada) Company (Eaton Electrical), the Owner’s Canadian distributor and a wholly owned subsidiary.

[9] Both parties submitted written representations, but only the Owner requested and was represented at an oral hearing.

EVIDENCE

[10] Mr. Patel’s evidence is that he is the Marketing Director of Eaton Electrical, a wholly owned subsidiary of the Owner [paras 1 and 5-7]. He explains that “COMMANDER branded electrical goods” sold by Eaton Electrical to customers in Canada are manufactured by or for the Owner and shipped to Eaton Electrical’s

Canadian distribution centers. From there, they are shipped to customers and purchasers throughout Canada. Some purchasers are themselves distributors or retailers considered authorized distribution channel partners. Some of the larger distribution partners notably include Home Depot, Lowe's and BMR [paras 8-9].

[11] Mr. Patel goes on to specify that the electrical goods in association with which the Mark was used in Canada, including throughout the relevant period, are "electrical goods, namely, electrical circuit breakers" [para 11].

[12] Mr. Patel states that given the nature of the goods, the Mark does not appear directly on them. He explains that the goods "electrical circuit breakers" are "made available for sale through Eaton Electrical's catalogue which refers to them as 'replacement bolt-on breakers' for COMMANDER branded electrical goods" [para 12].

[13] He attaches a printout of the "current version of the [Owner's] catalogue", which he confirms is similar to the version available during the relevant period, and which states "Eaton supports many generations of loadcentres by offering aftermarket BQL and QBH replacement breakers for vintage CEP, Sylvania, Commander and bolt-on loadcentres" [Exhibit B-1]. He states that the goods "have been and are currently made available for sale through Eaton Electrical's catalogue" but provides no further details in this regard [para 12].

[14] He also states that "replacement bolt-on breakers" can be ordered online via transactional websites of various distribution channel partners. He explains that these websites contain shopping carts and "a 'clickable' Add to Cart button" and that on such websites, the Mark "appears in proximity to the associated product" [paras 13-14]. He attaches printouts of the websites of three distribution channel partners as "examples of electrical goods, namely, electrical circuit breakers that were made available durin[g] the relevant period [...]" [para 14, Exhibit B-2].

[15] He indicates that revenues from sales of electrical circuit breakers by Eaton Electrical in Canada during the relevant period are in excess of 6.8 million dollars [para 15].

[16] He attaches 2 representative invoices to distribution channel partners dated during the relevant period, specifying that they “accompanied the goods at the time of transfer to the purchaser” [para 16]. Both invoices show sales of goods described in the invoices as 1- or 2- “POLE COMMANDER BREAKER” [Exhibit C].

REASONS FOR DECISION

[17] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9].

[18] As noted in the written submissions of both parties and acknowledged by the Owner’s agent at the hearing, the evidence pertains only to “electrical goods, namely, electrical circuit breakers”. No evidence of use or of special circumstances excusing non-use of the Mark was furnished for any of the other goods listed in the registration. They will therefore be deleted accordingly.

[19] With regard to the goods “electrical circuit breakers”, the Requesting Party’s written representations allege several deficiencies in the Owner’s evidence, including lack of evidence of (i) use as a trademark as defined in section 2 of the Act given the presence of other trademarks, (ii) use in the normal course of trade; and (iii) use by Eaton Electrical enuring to the benefit of the Owner. At their core, these arguments all stem from the Requesting Party’s position that the evidence does not show use of the Mark in association with electrical circuit breakers, but rather, if anything, with the loadcentres for which they are replacement parts.

[20] Some of the Requesting Party’s submissions in this regard pertain to the distinctiveness of the Mark. This is, however, not at issue in section 45 proceedings, which require an Owner to demonstrate use within the meaning of section 4 of the Act [*United Grain Growers Ltd v Lang Michener*, 2001 FCA 66]. In this regard, Mr. Patel’s

evidence clearly attests to significant sales of replacement circuit breakers. As the Mark does not appear directly on the goods or their packaging, the crux of the matter is whether the evidence shows notice of association between the Mark and electrical circuit breakers at the time of transfer of property or possession.

[21] Mr. Patel has clearly stated that electrical circuit breakers are referred to and sold as replacement bolt-on breakers in Eaton Electrical's catalogue and by distribution channel partners. He has provided details and representative screenshots indicating how the Mark appeared on the websites of some of these partners during the relevant period, via which websites purchases could be made. In this regard, I note that the website of BMR, a "larger channel partner", identifies the product in large font as "TWO-POLE COMMANDER BREAKER". I accept that a Canadian consumer who purchased the product shown from this website would have associated the Mark with the product at the time of the online transaction [*Smart & Biggar v The Black & Decker Corporation* (2020), 2020 TMOB 93; *Law Office of Philip B Kerr v Face Stockholm Ltd* (2002), 16 CPR (4th) 105 (TMOB)].

[22] It is true that Mr. Patel does not expressly state that sales occurred via the BMR website during the relevant period, or that sales via distribution channel partners, including those whose websites are attached at Exhibit B-2, are included in the global sales figures provided. I nevertheless find it reasonable to infer that at least some of the total sales were transactions via such channels, including BMR, given notably Mr. Patel's clear statements regarding Eaton Electrical's normal course of trade and distribution chain including BMR as a "larger channel partner", the screenshots from BMR showing a cart purchase option which he states is representative of the relevant period, and the substantial sales figures provided. I am guided in this regard by the principle that evidence in section 45 proceedings need not be perfect [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], and that reasonable inferences can be made from the evidence provided as a whole [see *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64].

[23] In addition, I also find that the representative sample invoices establish notice of association between the Mark and the goods given the clear display of the Mark in the description portion of the invoices which lists either 1-pole or 2-pole “COMMANDER BREAKER” and Mr. Patel’s assertion that the invoices accompanied the goods at the time of transfer [see *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321; *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440 at para 32; and *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD)]. In the absence of submissions from the Requesting Party on this point, I accept that the terms 1-pole, 2-pole, and breakers are descriptive references. As such, I accept the identity of the Mark is preserved and the deviation would not, in, mislead an unaware purchaser [*Canada (Registrar of Trade Marks) v Cie International pour l’informatique CII Honeywell Bull, SA* (1985), 1985 CanLII 5537 (FCA), 4 CPR (3d) 523 (FCA)].

[24] Lastly, Mr. Patel’s evidence is clear that Eaton Electrical distributes electrical circuit breakers manufactured by or for the Owner and any subsequent transaction is a sale to a customer, retailer or other distributor. The Owner is therefore the unique source of the goods. As such, use of the Mark along the distribution chain, by Eaton Electrical or otherwise, enures to the benefit of the Owner without need for a license [*Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD); *Lin Trading Co v CBM Kabushiki Kaisha* (1988), 21 CPR (3d) 417 (FCA); *Osler, Hoskin & Harcourt v Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD)].

[25] As such, taken as a whole, I find Mr. Patel’s evidence sufficient to demonstrate a prima facie case of use of the Mark in association with “electrical goods, namely, electrical circuit breakers” within the meaning of sections 4(1) and 45 of the Act.

DISPOSITION

[26] 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 all goods except “Electrical goods, namely, electrical circuit breakers”.

Emilie Dubreuil
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-12-11

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Kathleen Lemieux

AGENTS OF RECORD

For the Requesting Party: Deeth Williams Wall LLP

For the Registered Owner: Borden Ladner Gervais LLP