



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 96
Date of Decision: 2013-05-24

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Monster Daddy LLC against registration
No. TMA463,392 for the trade-mark MONSTER in the
name of Monster Cable Products, Inc.**

[1] On July 29, 2009, at the request of Monster Daddy LLC (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Monster Cable Products, Inc (MCPI). The notice required MCPI to show that its trade-mark, MONSTER (registration No. TMA463,392) had been used in Canada in association with each of the registered wares within the previous three years.

[2] Section 4 of the Act sets out the meaning of use. In this case, the following subsection applies:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[3] The trade-mark is registered for use in association with the following wares:

- 1) Electrical signal transmitting cable and wires, and connectors therefor; electrical signal transmitting cables and wires, and connectors for musical instruments; electrical power products for vehicles, namely power distribution blocks, capacitors, fuse blocks, fuse holders, circuit breakers,

battery terminals and connectors for battery cables; clothing, namely t-shirts, jackets and pants.

- 2) Audio signal cable and connectors; video signal cable and connectors; electric cables for audio equipment; speaker wire; musical and voice signal transmitting cable and connectors therefor; computer cables.
- 3) Newsletters, magazines and newspapers providing entertainment industry and cable industry news.

[4] In response to the Registrar's notice, MCPI filed an affidavit of Mr. David Tognotti, General Counsel and Vice-President of Administration of MCPI. Neither party filed written representations; however, both parties were represented at an oral hearing.

[5] The Requesting Party's main arguments are the following:

- The trade-mark has not been used in association with *each* of the registered wares.
- There is inadequate evidence of sales of the registered wares as:
 - No invoices or purchase orders have been provided; and
 - The spreadsheet of alleged sales refers to "sample accounts", and as such, there is uncertainty as to whether these were sales made in the normal course of trade.
- The spreadsheet of alleged sales in the evidence does not show sales made by MCPI, and there is no evidence of licensed use of the trade-mark.

[6] I will address each of these issues in turn.

Has the trade-mark been used in association with each of the registered wares?

[7] In his affidavit, Mr. Tognotti collectively refers to the registered wares as the "Monster Products" and he states that MCPI has used the trade-mark in Canada during the relevant period in association with the Monster Products.

[8] Mr. Tognotti then describes the manner in which the trade-mark was associated with the Monster Products sold by MCPI in Canada during the relevant period. In this regard, he states that the trade-mark was applied directly on the Monster Products, it was applied to labels affixed to the Monster Products, and it was applied to packaging for the Monster Products. In support, he attaches as Exhibit B, photographs of a variety of Monster Products and associated packaging,

which he states are representative of the packaging and labels for the Monster Products that were sold in Canada by MCPI during the relevant period. The exhibit includes photographs of products and packaging with respect to the following Monster Products:

- Electrical signal transmitting cable and wires, and connectors therefore;
- Clothing, namely t-shirts, jackets.
- Audio signal cable and connectors; video signal cable and connectors; electric cables for audio equipment; musical and voice signal transmitting cable and connectors therefore; computer cables.

[9] Mr. Tognotti also provides, as Exhibit C, a copy of MCPI's 2007 dealer product catalogue. He states that Monster Products are ordered through this catalogue, and then resold to Canadian consumers by third party retailers. Mr. Tognotti states that there are over 1200 third party retail outlets throughout Canada and provides a sample list of such retailers (Exhibit A); although the list was printed from MCPI's website on January 14, 2010, Mr. Tognotti states that it reflects the same list of Canadian retail outlets which sold Monster Products during the relevant period.

[10] I note that the dealer catalogue in Exhibit C displays the trade-mark on nearly every page of the catalogue and in some cases directly on the products represented in the catalogue. As Mr. Tognotti has attested that the catalogues were used when ordering Monster Products, I accept that the third party retailer purchasers would have been given notice of association of the trade-mark with the Monster Products through the catalogue at the time of purchase [see *Philip Morris Products SA v Marlboro Canada Ltd* (2010), 90 CPR (4th) 1 (FC)]. In addition to the Monster Products shown in the Exhibit B photographs, the catalogue includes the following Monster Products:

- Electrical signal transmitting cables and wires, and connectors for musical instruments;
- Electrical power products for vehicles, namely power distribution blocks, capacitors, fuse blocks, fuse holders, circuit breakers, battery terminals and connectors for battery cables; and
- Speaker wire.

[11] I note that the following Monster Products do not appear to be represented anywhere in the evidence: clothing, namely, pants; Newsletters, magazines and newspapers providing entertainment industry and cable industry news. Consequently, I find that MCPI has failed to show use of its trade-mark in association with these particular Monster Products in Canada during the relevant period. Furthermore, as no special circumstances have been put forth that would excuse the absence of such use, these wares will be deleted from the registration.

[12] With respect to sales of the Monster Products, Mr. Tognotti provides a sales summary spreadsheet under Exhibit D. He attests that the spreadsheet summarizes representative invoices to representative customers with respect to the sale of Monster Products in Canada. He also explains that the Exhibit C catalogue and the Exhibit D spreadsheet can be read together in order to cross-reference product numbers and model names. Mr. Tognotti cross-references this information from the Exhibit C catalogue to the Exhibit D spreadsheet in paragraphs 11 to 18 of his affidavit to provide representative examples of sales of Monster Products, “including products related to musical instruments, vehicles, audio-video equipment, speakers, musical and voice equipment, computers and jackets”. The specific products cross-referenced are: video cables, jackets, t-shirts, power distribution blocks for vehicles, speaker cables and cables for musical instruments.

[13] The sales specifically cross-referenced by Mr. Tognotti in his affidavit with respect to t-shirts, jackets, and power distribution blocks in the spreadsheet are listed as sales to “sample accounts”. Mr Tognotti states in his affidavit that the term “Sample Account” is a reference to accounts used for promotions under the trade-mark MONSTER and/or to provide samples of new products to various customers.” While I note that there are sales of power distribution blocks to retailers other than those listed as “sample accounts” in the spreadsheet, in the 429 pages of spreadsheet sales data I do not see any other sales of t-shirts and jackets other than those referred to as “sample account” or “training sample account” sales. In fact, much of the data in the spreadsheet appears to relate to such “sales”, including promotional accounts and products described in a product category description column as “mktng pop signage” or “mktng premiums”.

[14] The Requesting Party questions whether the above-described evidence constitutes adequate evidence of sales of *each* of the registered wares.

Is there adequate evidence of sales with respect to each of the registered wares?

[15] In this regard, the Requesting Party questions the value of the sales summary spreadsheet, and highlights the fact that no invoices or purchase orders clearly demonstrating sales of the Monster Products have been provided in the evidence. However, I agree with MCPI that the case law has established that there is no particular type of evidence that is required in response to a section 45 notice, and that the lack of invoices is not necessarily fatal to a registrant's case [see *Lewis Thomson & Sons Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 at 486 (FCTD)].

[16] In the present case, the sales summary spreadsheet details a large volume of sales transactions. Details of these transactions include: product and model numbers, customer names, invoice dates and invoice numbers, the name of the country the product was shipped to, and further product description information. In my view, this information, in combination with Mr. Tognotti's sworn statements, is sufficient to establish that sales of the Monster Products, with the exception of t-shirts and jackets, were made in the normal course of trade [see *Dimock Stratton v. Sunburst Products* (2009), 73 CPR (4th) 451 (TMOB)].

[17] With respect to "t-shirts" and "jackets", as indicated above, the spreadsheet shows that these transactions involved "sample accounts" only. Given Mr. Tognotti's explanation of "sample accounts" in his affidavit, I find it ambiguous as to whether the spreadsheet entries reflect transfers of such items in the normal course of trade. The evidence is ambiguous as to whether any consideration was given in respect of these items, and Mr. Tognotti makes no statements to the effect that sample t-shirts and jackets were given with the prospect of securing future sales of these items [88766 *Canada Inc v Spinnakers Brew Pub Inc* (2005), 48 CPR (4th) 70 (TMOB)]. Indeed, there are no further sales in evidence of these items and the information on the spreadsheet does not remedy this ambiguity. Consequently, I find that the evidence does not show that sales of t-shirts and jackets were made in the normal course of trade in Canada during the relevant period.

[18] However, in view of the above, I accept that use of the trade-mark has been shown in Canada during the relevant period in association with the following wares:

- (1) Electrical signal transmitting cable and wires, and connectors therefore; Electrical signal transmitting cables and wires, and connectors for musical instruments; Electrical power products for vehicles, namely power distribution blocks, capacitors, fuse blocks, fuse holders, circuit breakers, battery terminals and connectors for battery cables;
- (2) Audio signal cable and connectors; video signal cable and connectors; electric cables for audio equipment; speaker wire; musical and voice signal transmitting cable and connectors therefore; computer cables.

[19] While use of the trade-mark has been shown in association with most of the Monster Products, the Requesting Party's last concern is whether the use shown is use by MCPI or licensed use that enures to MCPI's benefit under section 50 of the Act.

Does the evidence show use of the trade-mark by MCPI or licensed use that enures to MCPI's benefit?

[20] The Requesting Party argues that the spreadsheet of alleged sales in the evidence shows that the sales were made by either an entity listed as "MCIL" or "MTIL". Furthermore, the Requesting Party submits that MCPI has not explained who these entities are or their relationship to MCPI. Lastly, the Requesting Party submits that there is no evidence that MCPI had a license agreement with these entities regarding use of its trade-mark in accordance with section 50 of the Act.

[21] I note, however, that Mr. Tognotti clearly attests in his affidavit that MCPI sold the Monster Products in Canada during the relevant period. Sworn statements are to be accorded substantial credibility [see *Rubicon Corp v Comalog Inc* (1990), 33 CPR (3d) 58 (TMOB)]. Furthermore, the spreadsheet does not indicate that MCIL or MTIL *sold* the Monster Products, it simply lists these entities under a column entitled "Monster Company". In view of the evidence as a whole, I find it reasonable to conclude that MCIL and MTIL were merely part of MCPI's supply and/or distribution chain during the relevant period. Accordingly, I accept Mr. Tognotti's sworn statements at face value and am satisfied that the use shown was that of MCPI.

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, registration No. TMA463,392 will be amended to delete the following from the statement of wares:

- 1) [...]; clothing, namely t-shirts, jackets and pants.
- 3) Newsletters, magazines and newspapers providing entertainment industry and cable industry news.

[23] Accordingly, the amended statement of wares will be as follows:

1) Electrical signal transmitting cable and wires, and connectors therefor; electrical signal transmitting cables and wires, and connectors for musical instruments; electrical power products for vehicles, namely power distribution blocks, capacitors, fuse blocks, fuse holders, circuit breakers, battery terminals and connectors for battery cables.

2) Audio signal cable and connectors; video signal cable and connectors; electric cables for audio equipment; speaker wire; musical and voice signal transmitting cable and connectors therefor; computer cables.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office