



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

Citation: 2014 TMOB 232
Date of Decision: 2014-10-29

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Fraser Milner Casgrain LLP (now Dentons
Canada LLP) against registration No. TMA725,468 for
the trade-mark FLEXCOOK ADJUSTABLE ELEMENT
SIZE in the name of LG Electronics Inc.**

[1] At the request of Fraser Milner Casgrain LLP, now Dentons Canada LLP (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) on June 1, 2012 to LG Electronics Inc. (the Owner), the registered owner of registration No. TMA725,468 for the trade-mark FLEXCOOK ADJUSTABLE ELEMENT SIZE (the Mark).

[2] The Mark is registered for use in association with the following wares: Oven ranges; electric ranges; electric refrigerators; electric pressure rice cookers; electric fans; electric refrigerating showcases; microwave ovens; air conditioners; gas ranges; gas stoves; electric toasters.

[3] The notice required the Owner to show that the Mark was in use in Canada, in association with each of the wares specified in the registration, at any time between June 1, 2009 and June 1, 2012. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of “use” in association with wares is set out in section 4(1) of the Act:

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.

[5] It is well established that mere assertions of 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 quite 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)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Ron Kean, sworn on December 20, 2012 in North York, Ontario. Both parties filed written representations; an oral hearing was not held.

[7] For the reasons set out below, the registration will be expunged.

The Evidence

[8] In his affidavit, Mr. Kean identifies himself as the General Counsel of LG Electronics Canada, Inc. (LG Canada), a wholly owned subsidiary of the Owner. He states that in this position, he is responsible for intellectual property and legal matters of LG Canada and thus is familiar with the history and marketing of products marketed and distributed in Canada by the Owner and its related companies.

[9] With respect to the wares "oven ranges, electric ranges, gas ranges and gas stoves", Mr. Kean attests that the Owner has sold such ranges and stoves in association with the Mark in Canada since September 2008.

[10] He explains that the Owner manufactures the ranges and stoves, which LG Canada then distributes and sells to retailers across Canada, who in turn sell them to consumers. Mr. Kean

attests that, during the relevant period, LG Canada distributed “in excess of 85 units” to Canadian retailers amounting to sales “in excess of \$90,000 at retail”.

[11] Mr. Kean states that the Owner “provides marketing materials to Canadian retailers at the time of sales advising them about the features of its products”. He further attests that it is his “understanding” that the Owner “would have provided materials to its Canadian retailers bearing the [Mark] and other trade-marks at the time of its sales of the ranges to its retailers”. However, Mr. Kean explains that “LG Canada recently moved offices and many marketing materials were destroyed during the process. As such copies of the marketing materials ... could not be located from [the Owner’s] business records.”

[12] Nonetheless, Mr. Kean attests that it is his further “understanding” that during the relevant period some of the Owner’s Canadian retailers “would have used the marketing materials bearing the Mark in advertising [the ranges and stoves] to consumers”. Indeed, he states that he is “personally aware that a number of Canadian retailers display [the Mark] on their websites”.

[13] In support, Mr. Kean attaches two exhibits to his affidavit. Exhibit A consists of printouts from the websites of three Canadian retailers, each advertising the sale of one of the Owner’s ranges or stoves. On each of these webpages, “FLEXCOOK™ Adjustable Element” is displayed as a bulleted item in the product details and is accompanied by a picture of an electric stove top oven or range. Although the webpages are dated August 15, 2012, Mr. Kean attests that it is his “understanding” that these printouts “are representative of how [the Mark] has been displayed by [the Owner’s] retailers since at least June 1, 2009.”

[14] More importantly, Mr. Kean asserts that these webpages are representative of how the Mark was displayed on the above-mentioned “marketing materials” provided to retailers by the Owner. In particular, he states that the product information on the webpages “is likely cut and pasted from marketing material provided to the retailers by the Owner at the time of sale”.

[15] Exhibit B contains numerous LG Canada invoices from the relevant period. Mr. Kean attests that these are representative invoices of the sale of ranges and stoves from the Owner to its Canadian retailers. Indeed, the “Bill To” addresses are for various retailers located in Canada.

As indicated by Mr. Kean, the relevant products are underlined in each invoice. Although the Mark does not appear on the invoices, the Owner notes that the model numbers correspond to those of the ranges and stoves shown at Exhibit A.

Use of the Mark as Registered

[16] In its written representations, the Requesting Party submits that the Exhibit A webpages do not display the Mark as registered. It argues that the display of FLEXCOOK with a TM symbol distinguishes it such that the evidence supports display of the trade-mark FLEXCOOK only and not the Mark as registered.

[17] The Owner submits, however, that placement of the TM symbol is merely reflective of the presence of trade-mark rights in the word FLEXCOOK as well as the Mark as a whole [citing *Barbera 1870 SpA v Barbera Caffé SpA* (2012), 102 CPR (4th) 49 (TMOB)]. I agree with the Owner that the placement of the TM symbol in this case is not determinative. Although the placement of the TM symbol may indicate that the word FLEXCOOK is itself a trade-mark, the Mark as registered is displayed in its entirety as a bulleted item on the Exhibit A webpages. As such, a consumer may perceive both FLEXCOOK and FLEXCOOK ADJUSTABLE ELEMENT as trade-marks.

[18] In any event, it is well established that where the trade-mark as used deviates from the trade-mark as registered, the question to be asked is whether the trade-mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see if, as a question of fact, the “dominant features” of the registered trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[19] In the present case, in its position as the first element and as a coined term, the word FLEXCOOK is the dominant feature of the Mark. Even if I were to accept the Requesting Party’s submission that the Exhibit A webpages only display the trade-mark FLEXCOOK, the dominant feature of the Mark as registered is maintained.

The Owner's Evidence is Too Remote

[20] The real issue in this case is whether the evidence is sufficient to show that notice of association was provided between the Mark and the wares *at the time of transfer* as required by section 4(1) of the Act. It is clear that the Mark was not displayed on the ranges and stoves, or on their packaging. As such, it falls on the Owner to establish that the Mark was “in any other manner so associated” with the ranges and stoves at the time of transfer, either from the Owner to the Owner’s Canadian retailers or from the retailers to the consumer.

[21] With respect to transfers/sales to end consumers, it is well established that notice of association between a trade-mark and wares can be established when customers place orders by way of a catalogue that displays the trade-mark in close proximity to the wares, and that notice of association continues when the wares are delivered and invoices are received [see *Lapointe Rosenstein v Elegance Rolf Offergelt GmbH* (2005), 47 CPR (4th) 196 (TMOB) and *Swabey, Ogilvy Renault v Miss Mary Maxim Ltd* (2003), 28 CPR (4th) 543 (TMOB)]. In *Lapointe*, the Registrar made this conclusion notwithstanding that the Mark did not appear on certain wares or subsequent invoices, since consumers could compare the style/product number appearing on the invoices with the style/product number of the wares ordered from the catalogues.

[22] As well, generally, where a customer can order goods from a website which displays a trade-mark, there can be use of that trade-mark in association with the goods [*Law Office of Philip B Kerr v Face Stockholm Ltd* (2002), 16 CPR (4th) 105 (TMOB)].

[23] In this case, however, it is not clear from Mr. Kean’s affidavit if consumers could order the Owner’s ranges and stoves from the Canadian retailer websites during the relevant period. Although the Mark as registered is displayed on the Exhibit A webpages and I note that at least the first of these webpages shows an online cart option indicating the possibility for consumers to purchase the stove directly from the website, Mr. Kean’s affidavit is not clear on whether the exhibited webpages as a whole are representative of those accessible by consumers during the relevant period.

[24] In any event, this case differs from the aforementioned decisions as there is no evidence of actual transfers, *i.e.*, purchases made from these websites during the relevant period. There is,

for example, no evidence of shipment to any end consumers or of invoices that would have been received by consumers when the wares were delivered.

[25] Indeed, it does not appear that the Owner furnished the Exhibit A webpages for the purpose of evidencing transfers to end consumers. Instead, the webpages are submitted for the purpose of indirectly establishing that the Mark was displayed on “marketing materials” sent to the Owner’s retailers. Thus, without further evidence of sales to end consumers, at best I can accept the Exhibit A webpages as evidence of promotional material akin to advertising only.

[26] With respect to transfers of the ranges and stoves to the Owner’s retailers, the Exhibit B invoices do show sales to Canadian retailers during the relevant period. However, it is not clear that the Mark would have been associated with the wares at the time of transfer.

[27] Both parties agree that for use of a trade-mark in advertisement and promotional material to be sufficiently associated with a ware to constitute use, the material must be given at the time of transfer of the property in or possession of the wares [see *1459243 Ontario v Eva Gabor International Ltd et al* (2011), 90 CPR (4th) 277 (FC) and *BMW Canada Inc v Nissan Canada Inc* (2007), 60 CPR (4th) 181 (FCA)]. The parties differ, however, on the application of this principle to the present case.

[28] In its written representations, the Owner submits that notice of association was provided in the “marketing materials” bearing the Mark that accompanied the wares at the time of transfer of possession to the Owner’s Canadian retailers. In contrast, the Requesting Party argues that, at best, the Owner is asking the Registrar to rely on the mere speculation of Mr. Kean that since the Exhibit A webpages show material “likely cut and pasted” from the lost marketing materials, such marketing materials *actually* accompanied the ranges and stoves at the time of transfer to the retailers.

[29] Curiously, Mr. Kean is vague regarding the nature of these “marketing materials”. That the materials lend themselves towards being “cut and pasted” suggests that they were in electronic form, rather than physical documents. If in electronic form, it is not clear how or whether the materials would have accompanied the wares at the time of transfer in possession of the ranges and stoves.

[30] If the materials were in physical form and packaged with the wares, such as in the form of a user manual or the like, Mr. Kean does not simply state this in his affidavit. If the materials were not packaged with the wares, again, it is unclear whether the materials would have accompanied the ranges and stoves at the time of transfer in possession. Further, it is not clear that such materials would have displayed the Mark such that it formed the basis for the retailers' webpages. The webpages may have been based on different marketing materials sent to them at some point other than the time of transfer, including before the relevant period.

[31] As noted by the Requesting Party, it is unclear why samples of the materials could not be obtained from the Owner's retailers, notwithstanding the Owner's own move and destruction of its archive. Alternatively, it is not clear why more current marketing materials could not be provided as, at a minimum, representative of the form in which the materials took.

[32] Absent such evidence, Mr. Kean's affidavit raises more questions than it answers and I find the Owner's evidence lacking in necessary detail, especially in light of the atypical circumstances. As it is not clear what form the "marketing materials" took, I consider Mr. Kean's statement that such materials bore the Mark and were provided "at the time of sales" to be a mere assertion of use (as a matter of law), rather than assertions of fact demonstrating use [see *Mantha & Associés/Associates v Central Transport, Inc* (1995), 64 CPR (3d) 354 (FCA)].

[33] In the absence of additional supporting evidence as discussed above, I am not prepared to conclude that the Owner has demonstrated that the Mark was associated with the wares "oven ranges, electric ranges, gas ranges and gas stoves" at the time of transfer within the meaning of sections 4(1) and 45 of the Act.

[34] With regards to the other registered wares, namely "electric refrigerators, electric pressure rice cookers, electric fans, electric refrigerating showcases, microwave ovens, air conditioners, and electric toasters", Mr. Kean makes no assertion of use in his affidavit and no evidence of use was furnished by the Owner.

[35] In view of all of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the registered wares within the meaning of sections 4 and 45

of the Act. Furthermore, the Owner provided no evidence of special circumstances excusing the absence of such use.

Disposition

[36] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office