

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

**Citation: 2016 TMOB 170**  
**Date of Decision: 2016-10-18**

**IN THE MATTER OF AN OPPOSITION**

**Rab Design Lighting Inc.** **Opponent**

**and**

**Rab Lighting Inc.** **Applicant**

**1,533,996 for FLED** **Application**

Introduction

[1] Rab Design Lighting Inc. (the Opponent) opposes registration of the trade-mark FLED (the Mark) that is the subject of application No. 1,533,996 by Rab Lighting Inc. (the Applicant).

[2] The application filed on June 30, 2011 claims the priority of a United States application filed on June 22, 2011. It is based on proposed use of the Mark in Canada in association with “Lighting fixtures; Electric lighting fixtures; LED (light emitting diode) lighting fixtures” (the Goods).

[3] Generally speaking, the grounds of opposition raised under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) allege that the Applicant is not the person entitled to registration of the Mark in view of confusion with the Opponent’s previously used and made known FLED series of trade-marks for flood lights; the Mark is not registrable because it is clearly descriptive or deceptively misdescriptive of the character or quality of the Goods; the adoption of the Mark is prohibited because the Mark by ordinary and *bona fide* commercial usage has become

recognized in Canada as designating a kind or quality of lighting fixtures; and the Mark is not distinctive of the Goods.

[4] Although not related or affiliated companies, the parties are not strangers to one another. The record shows that the Opponent purchased lighting products from the Applicant in the United States for importation into Canada from 2002 to 2008. In addition, the parties are involved in an opposition proceeding pertaining to the Applicant's co-pending application No. 1,534,013 for the trade-mark VXLED and for which a separate decision will be issued.

[5] For the reasons discussed below, I find that the opposition ought to be rejected.

### The Record

[6] The Opponent filed its statement of opposition on March 4, 2014.

[7] The statement of opposition commences with a preamble consisting primarily of statements of facts. In particular, the Opponent states that it has sold in Canada a series of LED flood lights for commercial and industrial use under the designation FLED since at least as early as 2008. In addition, the Opponent defines its "FLED series of trade-marks" as the designations FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 [para 2 of the statement of opposition].

[8] What follows is a summary of the pleaded grounds of opposition:

- (a) Sections 38(2)(a) and 30 of the Act. The application does not comply with the requirements of section 30(i) of the Act in that the Applicant could not state that it was satisfied that it was entitled to use the Mark in Canada in association with the Goods in view of confusion with the Opponent's FLED series of trade-marks.
- (b) Under sections 38(2)(b) and 12(1)(b) of the Act. In the alternative to the section 38(2)(c) ground of opposition (summarized below), the Mark is not registrable since it is clearly descriptive or deceptively misdescriptive of the character or quality of the Goods. FLED is a descriptive acronym that describes the product as a "flood light emitting diode" lighting fixture. Each component of the FLED acronym

is descriptive and has a meaning: F means flood, and LED means light emitting diode.

- (c) Sections 38(2)(c) and 16(3)(a) of the Act. The Applicant is not the person entitled to registration of the Mark since the Mark is, and was at the date of filing, confusing with the FLED series of trade-marks previously used and made known in Canada by the Opponent since at least 2008 in association with its series of LED flood light commercial and industrial lighting fixtures.
- (d) Under section 38(2)(d) and 2 of the Act. The Mark cannot distinguish and is not adapted to distinguish the Goods from the LED flood light commercial and industrial lighting fixtures associated with the Opponent's FLED series of trade-marks. Alternatively, if the Opponent's use of FLED is not as a trade-mark but simply as a descriptive product designation, then the Mark is also not distinctive and cannot be registered.
- (e) Under sections 3 and 10 of the Act. In the further alternative, the Applicant is prohibited from adopting and using FLED as a trade-mark. FLED has by ordinary and *bona fide* commercial usage become recognized in Canada as designating a kind or quality of lighting fixtures, namely "flood light emitting diode" lighting fixtures. The Applicant is further prohibited from adopting and using FLED as a trade-mark as it is a mark that so nearly resembles the Opponent's FLED series of signs, devices, or marks as to be likely to be mistaken therefore.

[9] The Applicant filed and served its counter statement on May 13, 2014.

[10] The Opponent's evidence consists of an affidavit of David Beron. The Applicant's evidence consists of an affidavit of Ross Barna. None of the affiants was cross-examined.

[11] Each party filed a written argument and was represented at the hearing, where the Opponent withdrew the ground of opposition alleging that the application does not comply with the requirements of section 30(i) of the Act.

### The Material Dates

[12] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(b)/12(1)(b) of the Act - the filing date of the application [see *Fiesta Barbeques Limited v General Housewares Corporation*, 2003 FC 1021, 28 CPR (4th) 60];
- sections 38(2)(c)/16(3)(a) of the Act - the priority filing date of the application [see section 16(3) the Act];
- sections 38(2)(d)/2 of the Act – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317]; and
- sections 38(2)(b)/12(1)(e) and 10 of the Act - the date of my decision [see *Olympus Optical Company Ltd v Canadian Olympic Association* (1991), 38 CPR (3d) 1 (FCA)].

### The Parties' Respective Burden or Onus

[13] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

## The Evidence

[14] I will review the evidence filed by the parties. In doing so, I will disregard any assertions of an affiant equivalent to an opinion on questions of fact and law to be determined by the Registrar in the present proceeding.

### The Opponent's Evidence

#### Affidavit of David Beron, including its Exhibits 1 to 12

[15] At the time of his affidavit, sworn September 10, 2014, Mr. Beron was Vice-President Market Operations of the Opponent and had been since March 2008. His affidavit, which includes Exhibits 1 to 12, is divided into five parts.

[16] The first part of the affidavit provides background information. Mr. Beron states that the Opponent is a family-owned business. It designs, manufactures, assembles and distributes a broad line of commercial and industrial lighting and related products through a national network of over 700 Canadian electrical distributors and lighting showrooms [para 1].

[17] Based on information and belief, Mr. Beron makes a few assertions with respect to the business carried on by the Opponent's predecessors. Mr. Beron also states that the Opponent has carried on business in Canada "under the RAB brand" since December 2001 [para 3].

[18] Mr. Beron references Canadian trade-mark registration Nos. TMA234,450 for RAB and TMA753,611 for RAB DESIGN [para 4, Exhibits 1 and 2]. Each registration covers "electrical lighting fixtures and electrical lighting fixture parts for interior and exterior use"; the registration for the trade-mark RAB DESIGN also covers "the operation of a business which designs, manufactures, assembles, imports and distributes electrical lighting products".

[19] The second part of the affidavit, entitled "The Opponent and its series of LED flood lights", starts with Mr. Beron explaining that: a light-emitting diode (LED) is a semiconductor light source; since the first LED was developed in the 1960's, the technology has grown exponentially; today LED's are increasingly being used commercially as replacements for

incandescent, high intensity discharge (HID) and compact fluorescent (CFL) lights due to their long life and lower energy consumption [para 5].

[20] Mr. Beron states that the Opponent has been involved in the custom design and manufacture of LED lighting fixtures for commercial and industrial use since at least as early as 2003 [para 6].

[21] Mr. Beron goes on to introduce evidence with respect to the Opponent's LED flood lights for commercial and industrial use. For ease of reference, I will subsequently refer to these products of the Opponent as "LED flood lights". What follows is a summary of Mr. Beron's testimony with respect to the Opponent's series of LED flood lights [paras 7 to 15]:

- In 2008, the Opponent designed and commenced the manufacture of its first stock item LED lighting fixture: a small compact flood light under the product designation and brand FLED.
- Distribution and sale of the Opponent's FLED-OV-10 LED flood light commenced in September 2008. The product designation FLED-OV-10 LED was derived as follows: "F" for flood, "LED" for the type of light, "OV" for the oval shape and "10 LED" for the number of LED lights in the fixture.
- In 2009, the Opponent introduced additional items to its FLED brand of LED lighting fixtures, including its FLED-SQ-18 LED flood light, FLED-REC-36 LED flood light, and FLED-RND-18 LED flood light. The "SQ", "REC" and "RND" components of the product designations refer to the shape of the fixture: square, rectangular or round as the case may be.
- The FLED series of LED flood lights, including the FLED-OV-10 LED flood light, FLED-SQ-18 LED flood light, FLED-REC-36 LED flood light, and FLED-RND-18 LED flood light, have been advertised in the Opponent's product catalogue since late 2008 and in the Opponent's online catalogue, at *www.rabdesign.ca*. I note that while Mr. Beron states that the online catalogue "is updated regularly", he does not indicate the date on which the online catalogue became available.

- The Opponent provides the product spec sheets, product catalogue and samples of the FLED series of LED flood lights to its national network of Canadian electrical distributors and lighting showrooms, who in turn provide the spec sheets and catalogue to their customers and display samples of the Opponent's products at their premises.
- Both the Opponent's distributors and customers access the Opponent's online catalogue. The Opponent often receives telephone orders from its customers who order products based on the spec sheets or catalogue, either print or online version, referencing the product designation or product number. Some of the Opponent's distributors permit online ordering of the Opponent's FLED series of LED flood lights.
- At the time of the affidavit, the Opponent offered approximately 65 SKUs for its FLED series of LED flood lights. There is a different SKU depending on the shape of the flood light, the number of LED's, colour of LED, shape of beam, colour of housing etc.
- The FLED series of LED flood lights are sold in plain brown packaging bearing the product label for that SKU.
- From the launch of the FLED series of LED flood lights in September 2008 up to June 2011, the Opponent's sales in Canada of its FLED series of LED flood lights have totaled approximately \$196,000. From July 2011 through to the end of January 2014, the sales in Canada have exceeded \$250,000.
- Since 2009, the Opponent's FLED series of LED flood lights have been displayed at trade-shows held in Montreal and in Moncton, as well as numerous customer marketing events.

[22] In support of his testimony, Mr. Beron files the following as exhibits to his affidavit:

- Product spec sheets used since 2008 for the FLED-OV-10 LED flood light, the FLED-SQ-18 LED flood light, the FLED-REC-36 LED flood light, and the FLED-RND-18 LED flood light, said to be available on the Opponent's website since their introduction in 2008 [Exhibits 3 to 6].

- Copy of the product catalogue of September 2008 [Exhibit 7] and relevant pages of the online catalogue, as it existed in April 2011 [Exhibit 8].
- Representative examples of labels for the Opponent’s FLED series of LED flood lights, namely:
  - labels used on packaging since 2008 [Exhibit 9];
  - labels that appear on the base for the FLED series of LED flood lights and used since 2008 [Exhibit 10]; and
  - labels that appear on the base for the FLED series of FLED-HDR and FLED-R-10 flood lights and used since 2009 [Exhibit 10B].
- Representative sales invoices for the years 2008 to 2014, with the pricing information redacted [Exhibit 11].

[23] The third part of the affidavit concerns the parties’ past business relationship from 2002 through to the end of 2008. I will not summarize this part of the affidavit as the evidence appears to relate to the section 30(i) ground of opposition, which was withdrawn at the hearing.

[24] Finally, the fourth and fifth parts of the affidavit mostly contain assertions of Mr. Beron that I consider opinions on questions of fact and law to be determined in this case. Accordingly, I will not summarize these parts of the affidavit, except to note two aspects of Mr. Beron’s testimony.

[25] First, Mr. Beron states that the Applicant’s lighting products are sold in Canada by RC Lighting, a subsidiary of the Applicant, to many of the same distributors and lighting showrooms that purchase the Opponent’s products [para 19].

[26] Second, Mr. Beron states that the letter F in the acronym FLED means flood, and LED means light emitting diode; he files an extract from the *Webster’s Ninth Collegiate Dictionary* for the definition of “LED” as Exhibit 12 to his affidavit [para 22].



## The Applicant's Evidence

### Affidavit of Ross Barna

[27] At the time of his affidavit, sworn March 10, 2015, Mr. Barna was CEO of the Applicant and had been since 2009. Prior to that, he was Chief Operating Officer of the Applicant from approximately 2006 to 2009, although he has been employed by the Applicant in various capacities since 2001.

[28] Mr. Barna states that the Applicant is a leading manufacturer of sustainable outdoor lighting fixtures. Founded in 1946, the Applicant has been involved for many years in the sale and distribution of its lighting products in Canada and the United States [para 4].

[29] The remainder of Mr. Barna's testimony concerns the parties' past business relationship [paras 5 to 7]. I will not be summarizing this evidence as it appears to relate to the section 30(i) ground of opposition, which was withdrawn at the hearing.

### Analysis of the Issues Arising from the Grounds of Opposition

[30] The issues arising from the grounds of opposition, although not in their order of pleading, are:

1. Was the Mark clearly descriptive or deceptively misdescriptive of the character or quality of the Goods as of June 30, 2011?
2. Has the Mark by ordinary and *bone fide* commercial usage become recognized in Canada as designating a kind or quality of lighting fixtures?
3. Was the Applicant the person entitled to the registration of the Mark in Canada as of June 22, 2011?
4. Was the Mark distinctive of the Applicant's Goods as of March 4, 2014?

[31] I will analyze these issues in turn.

1. Was the Mark clearly descriptive or deceptively misdescriptive of the character or quality of the Goods as of June 30, 2011?

[32] This issue arises from the ground of opposition alleging that the Mark is not registrable under section 12(1)(b) of the Act and premised on the following allegations: “FLED is a descriptive acronym that describes the product as a ‘flood light emitting diode’ lighting fixture. Each component of the FLED acronym is descriptive and has a meaning: F means flood and LED means light emitting diode.”

[33] The test to be applied when assessing whether a trade-mark violates section 12(1)(b) of the Act has been summarized as follows by the Federal Court of Appeal in *Ontario Teachers’ Pension Plan Board v Canada*, 2012 FCA 60, 99 CPR (4th) 213:

[29] It is trite law that the proper test for a determination of whether a trade-mark is clearly descriptive is one of first impression in the mind of a normal or reasonable person. If such a person is unclear or uncertain as to the significance of the trade-mark in relation to the wares or services or if the trade-mark is suggestive of a meaning other than one describing the wares or services, then the word is not clearly descriptive. One should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the immediate impression created by the trade-mark in association with the wares or services with which it is used or proposed to be used. In other words, the trade-mark must not be considered in isolation, but rather in its full context in conjunction with the wares and services [...].

[34] The word “character” in section 12(1)(b) of the Act has been held to mean a feature, trait or characteristic of the goods or services and the word “clearly” has been held to mean “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[35] Further, it has been held that one must also have regard to common sense when assessing the first impression of the trade-mark having regard to the goods or services in question [see *Neptune SA v Canada (Attorney General)*, 2003 FCT 715, 29 CPR (4th) 497 (FCTD); *Ontario Teachers’ Pension Plan Board*, *supra*].

[36] Bearing the above in mind, I will summarize in turn both the oral and written submissions of the Opponent and the Applicant, and thereafter conclude with my findings on the issue.

[37] The Opponent basically submits that it has evidenced through the affidavit of Mr. Beron that FLED is an acronym that describes a “flood light emitting diode (LED)” lighting fixture. Besides pointing to the extract from the *Webster’s Ninth Collegiate Dictionary* for the definition of “LED”, the Opponent submits that the following testimony of Mr. Beron has not been challenged through cross-examination:

- the product designation FLED was derived by the Opponent as follows: “F” for flood, “LED” for the type of light [para 7 of the affidavit]; and
- each component of the FLED acronym is descriptive and has a meaning: F means flood, and LED means light emitting diode [para 22 of the affidavit].

[38] For its part, the Applicant first and foremost submits that there is no evidence that FLED as a whole is an acronym in and of itself. For this reason alone, the Applicant contends that the ground of opposition must be rejected.

[39] In the alternative, the Applicant invites me to reject the Opponent’s quantum leap that the Mark must be viewed as an acronym combining F and LED. The Applicant submits that the combination of F and LED “‘does not an acronym make’ simply because the Opponent is inviting the [Registrar] to incorrectly dissect the [Mark] into component elements which do not exist”.

[40] The Applicant appears not to dispute that LED means “light emitting diode”. However, the Applicant submits that the letter “F” has no discernable meaning nor is it a stand-alone element. The Applicant also disputes that the Opponent’s evidence supports the allegation that “F” means “flood”. The Applicant’s submissions in that regard may be best summarized by the following passage of its written argument:

54. [...] The only evidence adduced by the Opponent purporting to prove FLED is descriptive is at paragraph 22 of Mr. Biron’s *[sic]* affidavit and Exhibit 12 related thereto which is a dictionary definition of “LED” referring to LED as a noun for “light emitting diode”. There is no evidence whatsoever proving the letter “F” plainly and evidently means “flood”. Mr. Beron simply states at paragraph 7 of his affidavit that the *opponent itself has allegedly chosen to ascribe to the letter* “F” the meaning “flood” within the product designations FLED-OVE-10 LED (and the three other designations).

[41] Having considered the parties' submissions, I note at the outset that in my view the fate of the section 12(1)(b) ground of opposition in the present case does not rest on whether the Opponent has properly pleaded that FLED *is an acronym*. Rather, it rests on whether the Opponent first discharged its evidential burden of showing that the Mark clearly describes or deceptively misdescribes the Goods as flood light emitting diode lighting fixtures, and thus violates section 12(1)(b) of the Act. I find that the Opponent did not do so.

[42] Indeed, in my view the Opponent's evidence purportedly establishing the meaning of the letter F for lighting fixtures consists of self-serving statements of Mr. Beron, including statements as to the Opponent's self-attributed meaning of F for its series of LED flood lights. I do not consider such evidence as sufficient to reasonably conclude that the letter "F" when used in association with lighting fixtures *plainly* and *evidently* means "flood".

[43] Thus, considering the Mark as a whole, I find that it was not clearly descriptive or deceptively misdescriptive of the character or quality of the Goods as of June 30, 2011. At most, the Mark was suggestive of a type of lighting fixtures, in particular lighting fixtures having light emitting diodes. It is trite law that a suggestive trade-mark does not violate section 12(1)(b) of the Act.

[44] Accordingly, the section 12(1)(b) ground of opposition is unsuccessful.

2. Has the Mark by ordinary and *bone fide* commercial usage become recognized in Canada as designating a kind or quality of lighting fixtures?

[45] This issue arises from the two-pronged ground of opposition raised under sections 3 and 10 of the Act, the validity and sufficiency of which has been raised by the Applicant in its written argument.

[46] I agree with the Applicant that section 3 of the Act, which sets out the different circumstances when a person is deemed to have adopted a trade-mark, does not form the basis of a ground of opposition as defined in section 38(2) of the Act. I would add that the Opponent did not make any representations at the hearing to explain its reliance on section 3 of the Act. Therefore, to the extent that the ground of opposition is raised under section 3 of the Act, it is dismissed as an invalid ground of opposition.

[47] However, I disagree with the Applicant that the section 10 ground of opposition has been improperly pleaded because there is no reference to section 12(1)(e) of the Act. Clearly, the ground of opposition is set out in sufficient detail to enable the Applicant to reply, which is all that is required by section 38(3) of the Act.

[48] I now turn to the Applicant's contention that the second prong of the pleading does not form a proper ground of opposition under section 10 of the Act. The pleading alleges that the Applicant is prohibited from adopting and using FLED as a trade-mark as it is a mark that so nearly resembles the Opponent's FLED series of signs, devices, or marks as to be likely to be mistaken therefor.

[49] Section 10 of the Act reads as follows:

10 Where any mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, no person shall adopt it as a trade-mark in association with such goods or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

[50] To best reflect the Applicant's submissions in support of its contention, I reproduce the following passage of the Applicant's written argument:

102 [...] the Opponent has dissected section 10 of the Act into two sections but the prohibition is all encompassing in that it applies whether subject mark misleads or so nearly resembles *a mark used by others* such that through ordinary and bona fide commercial usage, that mark has become recognized in Canada as designating the kind or quality etc. of any goods and/or services. The Opponent cannot rely solely on its *own alleged use* of the alleged mark FLED to support this ground of opposition (even if the opponent considers having proven extensive use which is in any event categorically denied by the Applicant) as the reason for the [Mark] being a prohibited mark under section 10 of the Act.

[51] I am in substantial agreement with the Applicant's above submissions. I would add that based on a fair reading of the Opponent's written argument, it does not contain substantial submissions with respect to the second prong of the pleading.

[52] Accordingly, I dismiss the section 10 ground of opposition to the extent that it alleges that the adoption and use of FLED as a trade-mark is prohibited because it so nearly resembles the Opponent's FLED series of signs, devices, or marks as to be likely to be mistaken therefor.

[53] In view of all of the above, the issue under consideration solely arises from the first prong of the ground of opposition pleading that the Applicant is prohibited from adopting and using FLED as a trade-mark, in that FLED has by ordinary and *bona fide* commercial usage become recognized in Canada as designating a kind or quality of lighting fixtures, namely "flood light emitting diode" lighting fixtures. The pleading is premised on the allegations that the "F" prefix has by ordinary and commercial use become recognized as designating "flood light" lighting fixtures, and LED has by ordinary and commercial use become recognized as designating "light emitting diode" lighting fixtures.

[54] The Federal Court in *ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056, 29 CPR (4th) 182 discusses as follows the relevant test set out by section 10 of the Act:

[88] [...] Pursuant to section 10, a mark may become a prohibited mark if as a result of ordinary and bona fide commercial usage, it has become recognized in Canada as designating the kind, quality, quantity, destination, value, place or origin or date of production of any wares or services. The statutory prohibition requires that the use of the mark in question be in Canada and that the mark must have been commonly used in Canada at the relevant time as designating an aspect of the wares or services which are the subject of the mark [...].

[55] In turning to the parties' submissions, I stress that when reviewing the affidavit of Mr. Beron, I disregarded his statement that FLED has by ordinary and *bona fide* commercial usage become recognized in Canada as designating a kind or quality of lighting fixtures, namely "flood light light emitting diode (LED)" lighting fixtures. This statement amounts to an opinion on questions of fact and law to be determined by the Registrar in this case.

[56] The Opponent submits that even if the letters FLED are not considered descriptive, the letters FLED may still have been used in a manner that by ordinary and *bona fide* commercial usage they have become recognized in Canada as designating a kind or quality of lighting fixtures, namely "flood light light emitting diode (LED)" lighting fixtures. The Opponent submits that this is the case.

[57] Indeed, the Opponent submits that the evidence establishes that the Opponent has used the letters FLED in Canada since 2008 as a designation for its LED flood lights. The Opponent submits that by virtue of such use, the letters FLED have by ordinary and *bona fide* commercial usage become recognized in Canada as designating a kind or quality of lighting fixtures, namely flood light light emitting diode lighting fixtures.

[58] The Applicant submits that even if the Opponent considers having proven extensive use of the letters FLED to identify its LED flood lights (which is denied by the Applicant), the Opponent's own use of FLED is insufficient to support the ground of opposition. The Applicant submits that to discharge its evidential burden, the Opponent was required to prove that the Mark as a whole has been used by many Canadian lighting manufacturers and retailers for many years such that FLED has become recognized as designating a kind and/or quality of lighting fixtures.

[59] I conclude that the Opponent did not discharge its evidential burden to establish that the Mark falls within the prohibition of section 10 of the Act.

[60] Indeed, as indicated before, the statutory prohibition requires that the Mark *must have been commonly used* in Canada. Yet, the Opponent has only provided evidence of its own use in Canada of product designations including the letters FLED to identify its LED flood lights. In other words, the evidence falls short of what is required to establish that the average Canadian would recognize FLED as designating a kind or quality of lighting fixtures.

[61] Accordingly, the section 10 ground of opposition is unsuccessful.

3. Was the Applicant the person entitled to the registration of the Mark in Canada as of June 22, 2011?

[62] This issue arises from the ground of opposition raised under section 16(3)(a) of the Act and premised on an allegation of confusion between the Mark and the FLED series of trade-marks used and made known in Canada by the Opponent since at least 2008 in association with its series of LED flood lights.

[63] To begin, I note that throughout its written argument, the Opponent submitted that its evidence shows trade-mark use *of the letters FLED* in association with the Opponent's LED

flood lights since 2008. However, at the hearing, the Opponent acknowledged that its FLED series of trade-marks has been defined in the statement of opposition as the designations FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 [para 2 of the statement of opposition]. The Federal Court has directed that an opposition is to be assessed in view of the ground of opposition as pleaded [see *Le Massif Inc v Station Touristique Massif du Sud (1993) Inc*, 2011 FC 118, 95 CPR (4th) 249].

[64] Accordingly, in order to meet its evidential burden under the pleaded ground of opposition, the Opponent must show that the alleged trade-marks FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 were used and made known in Canada in association with its LED flood lights prior to June 22, 2011. Further, the Opponent must show that it had not abandoned these trade-marks at the date of advertisement of the application, namely January 8, 2014 [section 16(5) of the Act].

[65] I find from the outset that there is no evidence establishing that either one of the Opponent's alleged trade-marks has been made known in Canada pursuant to the definition of "made known" set out in section 5 of the Act. Thus, what remains to be considered is whether the Opponent has discharged its evidential burden of establishing that its alleged trade-marks were used in Canada prior to June 22, 2011 pursuant to the relevant definition of "use" set out in section 4(1) of the Act.

[66] I pause to point out that at the hearing the Opponent noted that the product designations displayed on the labels filed as Exhibits 9, 10 and 10B to the affidavit of Mr. Beron had been properly listed in the table incorporated in the Applicant's written argument [para 28 of the written argument]. For ease of reference, I have reproduced the table at Schedule "A" to my decision. Also reproduced at Schedule "A" to my decision is a table incorporated in the Applicant's written argument listing the product designations displayed on the invoices filed as Exhibit 11 to the affidavit of Mr. Beron [para 30 of the written argument].

[67] At the hearing, the Opponent submitted that the labels filed as Exhibits 9, 10 and 10B evidence the Opponent's prior use of the trade-marks FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 in association with its LED flood lights. The Opponent also reiterated its written representations with respect to the product spec sheets and catalogue filed as



Exhibits 3 to 8 to the affidavit of Mr. Beron. In this regard, the Opponent essentially submitted that the product spec sheets and catalogue, either print or online, establish prior use of the trade-marks FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 in association with LED flood lights.

[68] In turning to the Applicant's submissions, I first agree with the Applicant that the labels displaying the designations FLED-HDR-10-M and FLED-R-10SPOT are not relevant in the assessment of the section 16(3)(a) ground of opposition [Exhibit 10B]. Suffice it to say that neither of these designations is identified as part of the Opponent's FLED series of trade-marks defined at paragraph 2 of the statement of opposition.

[69] The Applicant submits that none of the labels filed as Exhibits 9 and 10 evidences use of FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 *per se*. Rather they all appear in combination with additional letters and/or numbers.

[70] As for the product spec sheets, the Applicant submits that Mr. Beron does not indicate that they accompany the Opponent's products at the time of transfer. Furthermore, the Applicant submits that paragraph 9 of Mr. Beron's affidavit, which refers to the product spec sheets and the catalogue, is worded in the present tense and Mr. Beron has not provided any indication as to how long it has been since telephone orders and/or on-line orders have been received by the Opponent. The Applicant submits that the mere availability to consumers of online orders does not equate to orders having in fact been placed by consumers prior to June 22, 2011.

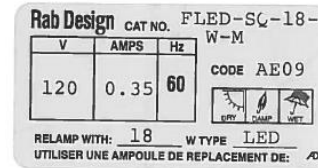
[71] In the event of a finding that the labels show *prior use* of FLED-OV-10, FLED-SQ-18, FLED-RND-18 and FLED-REC-36, the Applicant submits that the Opponent has not used FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 as trade-marks (i.e. source identifiers), but rather, simply as a component of various different alphanumeric combinations referring to particular model numbers associated with the Opponent's LED flood lights (i.e. product identifiers).

[72] To better understand the Applicant's alternative submissions, I reproduce below one example of the labels representative of those affixed on the plain box packaging [Exhibit 9] as

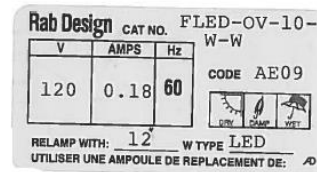
well as the labels representative of the labels that appear on the base for the FLED series of LED lighting fixtures [Exhibit 10]:



(Exhibit 9)



(Exhibit 10)



[73] Likewise, the Applicant submits there is nothing in the display of FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-REC-36 in the product spec sheets that allows consumers to identify the FLED series of trade-marks. The Applicant submits that this also holds true for the display of FLED-OV-10 in the catalogue. The Applicant’s submissions in that regard are reflected by the following passage of its written argument:

- 75 In the **spec sheets**, the alphanumeric combinations FLED-OV-10, FLED-SQ-18, FLED-REC-36 and FLED-RND-18 refer to a type of catalogue coding or product number for RAB branded lighting products. There is no indication or message conveyed to the purchaser that the alphanumeric combinations FLED-OV-10, FLED-SQ-18, FLED-REC-36 and FLED-RND-18 are trademarks. Similarly, this same message is absent in the Opponent’s **catalogues** wherein the alphanumeric combination FLED-OV-10 appears listed under the headings “SERIES”, “LENS” or “LED”. In addition, and notably, the “ordering information” contained in the opponent’s catalogues does not refer to the alphanumeric combination FLED-OV-10 but rather to this alphanumeric combination:
- FLED-OV-10-1W-R-W (page 33 of 2008 catalogue)

[74] It should be noted that while the Opponent at the hearing argued that its evidence does establish prior use of FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-REC-36, more

often than not, the Opponent throughout its oral representations referenced the use of product designations.

[75] I find it not necessary to discuss the parties' submissions as to whether the evidence satisfactorily establishes the Opponent's *prior use* of its alleged trade-marks because in my view the Applicant's alternative submissions are determinative of the issue arising from the section 16(3)(a) ground of opposition.

[76] Indeed, in the circumstances of this case, I agree with the Applicant that the Opponent's evidence does not establish trade-mark use of FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-REC-36 as of June 22, 2011.

[77] For one thing, none of the labels shows FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-REC-36 on its own. These always appear juxtaposed either with additional letters or with additional letters and numbers presented in the same manner (same font, same size).

Furthermore, I am of the view that the words RAB DESIGN appearing on the labels would be perceived as the trade-mark being used [see para 72 of my decision]. This conclusion is even more likely where the word RAB is followed by the ® symbol, as the use of such symbol draw the purchaser's attention to the fact that RAB DESIGN, if not RAB, is being used and is functioning as a trade-mark.

[78] With respect to the product spec sheets, I agree with the Opponent that FLED-OV-10, FLED-RND-18, FLED-SQ-18 or FLED-REC-36, in each case followed by LED FLOOD, displayed at the top of the corresponding spec sheet may serve as evidence of use of FLED-OV-10, FLED-RND-18, FLED-SQ-18 or FLED-REC-36 *per se*. As an example of such use, I have reproduced at Schedule "B" to my decision the front page of the spec sheet for the FLED-RND-18 flood light [Exhibit 6]. However, here also I find it may reasonably be concluded that RAB DESIGN, if not RAB, prominently displayed at the top left corner of the product spec sheets would be perceived as the trade-mark being used.

[79] Finally, I find it not necessary to discuss the parties' submissions as to whether the catalogue, either print or online, shows use of FLED-OV-10, FLED-RND-18, FLED-SQ-18 or FLED-REC-36. Suffice it to say that my review of the catalogue also leads me to conclude that

the message conveyed to the consumer is that RAB DESIGN, if not RAB, is being used and is functioning as a trade-mark.

[80] In view of the above, I find that the Opponent did not discharge its burden of evidencing use of any of its alleged trade-marks FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 prior to June 22, 2011.

[81] Accordingly, the section 16(3)(a) ground of opposition is unsuccessful.

4. Was the Mark distinctive of the Applicant's Goods as of March 4, 2014?

[82] This issue arises from the two-pronged ground of opposition raised under section 2 of the Act.

[83] The first prong of the ground of opposition revolves around the issue of confusion between the Mark and the Opponent's alleged FLED series of trade-marks as specifically defined in the statement of opposition, namely FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36.

[84] Because the difference in material dates does not have an impact on my findings with respect to the section 16(3)(a) ground of opposition, I conclude that the Opponent has failed to discharge its evidential burden to show that either of its alleged trade-marks FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 had a substantial, significant or sufficient reputation in Canada in association with LED flood lights, as of March 4, 2014, so as to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[85] Thus, what remains to be considered is the second prong of the ground of opposition reading as follows: "Alternatively, if the Opponent's use of FLED is not as a trade-mark but simply as a descriptive product designation, the Applicant's proposed mark FLED is also not distinctive and cannot be registered."

[86] To begin, I note that the Opponent in its written argument sets out the issue arising from the second prong of the ground of opposition as follows: Does the Opponent's prior use of the letters FLED render the Applicant's proposed mark FLED non-distinctive?

[87] I also note that the reason for the allegation "cannot be registered" as part of the pleading has been explained by the Opponent at the hearing. More particularly, the Opponent argued that allowing the Mark to proceed to registration would open the door to the Applicant claiming a monopoly in Canada on the letters FLED for the Goods to then unfairly challenge the Opponent's legitimate use of the letters FLED as product designations for its LED flood lights, for instance by bringing a trade-mark infringement action against the Opponent.

[88] The impact the registration of the Mark would ultimately have on the Opponent's entitlement to use FLED as a product designation for its LED flood lights in Canada is not what is at issue in the present proceeding. The issue to be decided under this ground and within the context of this opposition is whether the Mark, as of March 4, 2014, was distinctive of the Applicant's Goods pursuant to section 2 of the Act.

[89] Thus, I shall turn to the assessment of the second prong of the non-distinctiveness ground of opposition, starting with the Applicant's submissions as to the scope of the pleading.

[90] The Applicant first and foremost submits that the language of the pleading makes it clear that the Opponent is relying on the use of the term FLED *on its own* as a product designation for its LED flood lights and *not* some other use, including the term FLED as a component of alphanumeric arrangements or the FLED series of trade-marks as identified in the statement of opposition.

[91] Furthermore, the Applicant submits that the documentary evidence filed by Mr. Beron does not show the term FLED on its own. The term FLED only appears as part of overall product designations wherein the term FLED is consistently displayed in block letters and the additional alphanumeric elements are equally presented in the same font and same size. There is nothing in the evidence which allows consumers to identify the term FLED on its own as indicative of a product designation. For these reasons alone, the Applicant submits that the second prong of the ground of opposition must be rejected.

[92] In my view, the Applicant rightly submits that the evidence does not show use of the term FLED *per se* as a product designation for the Opponent's LED flood lights. The question becomes whether the Applicant rightly submits that the pleading is restricted to an allegation of the Opponent's use of the term FLED *per se* as a product designation, which is disputed by the Opponent.

[93] Indeed, at the hearing, the Opponent submitted that the second prong of the ground of opposition must be read as being based on the premise that the Mark cannot function as a source identifier for the Applicant's Goods in view of the Opponent's use in Canada of the term FLED *as a component* of product designations, without limitations, for its series of LED flood lights.

[94] With respect, I find that it is a stretch to infer that the pleading alleges that the Mark is not distinctive in view of the Opponent's use of the term FLED as a component of product designation for its series of LED flood lights.

[95] It is trite law that the sufficiency of the pleading should be assessed having regard to the evidence of record [see *Novopharm Ltd v Astrazeneca AB*, 2002 FCA 387, 21 CPR (4th) 289]. Considering the Opponent's evidence and the allegation in the statement of opposition with respect to the sales of the Opponent's FLED series of LED flood lights under the designations FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36, at best for the Opponent, I consider that the pleading could be read as encompassing an allegation of the Opponent's use of FLED as a component of those four product designations.

[96] I agree with the Applicant that the designations displayed on the labels [Exhibits 9 and 10] and referenced in the invoices [Exhibit 11] do not show use of FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 *per se* as product designations. As indicated before, these always appear juxtaposed either with additional letters or with additional letters and numbers.

[97] That said, as I mentioned, I accept the display of FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-REC-36 at the top of the product spec sheets as use of the product designations FLED-OV-10, FLED-RND-18, FLED-SQ-18 or FLED-REC-36 *per se*. However, this does little to assist the Opponent's case.

[98] Indeed, although Mr. Beron states that the spec sheets are provided to the Opponent's national network of Canadian electrical distributors and lighting showrooms, who in turn provide the spec sheets to their customers, no details have been provided concerning the volume of product spec sheets that would have been so distributed. Similarly, although Mr. Beron states that the product spec sheets are available on the Opponent's website, no information on the number of Canadians that would have accessed the website has been provided.

[99] I wish to add that even if I were wrong in finding that the labels and invoices do not show use of the product designations FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 *per se*, I would still have been unable to draw any inferences with respect to the extent of the Opponent's use of these product designations in Canada as of March 4, 2014. In this regard, I note that the labels and invoices provided by Mr. Beron show that the Opponent uses additional product designations, such as:

- FLED-HDR-10 (FLED-HDR-10-MED-UB; FLED-HDR-10-HYBRID-UB; FLED-HDR-10-M)
- FLED-R-10 (FLED-R-10SPOT; FLED-R-10 HYBRID; FLED-R-10 MEDIUM)
- FLED-OV-18 (SP-FLED-OV-18-CW)

[100] Because Mr. Beron provides evidence pertaining to the *total* sales of the Opponent's FLED series of LED flood lights, I have no information with respect to which portion of these sales is directly attributable to sales of the FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-RC-36 flood lights.

[101] To summarize, if the Applicant rightly argues that the pleading is restricted to an allegation of the Opponent's use of FLED on its own as a product designation, the ground of opposition must be dismissed for the Opponent's failure to establish the extent to which FLED on its own had become known in Canada as a product designations for its LED flood lights as of March 4, 2014.

[102] Alternatively, if the Opponent rightly submits that the pleading is not restricted as argued by the Applicant, at best the pleading would be based on an allegation of use of FLED as a component of the product designations FLED-OV-10, FLED-RND-18, FLED-SQ-18 and

FLED-RC-36 for the Opponent's LED flood lights. Still, the ground of opposition must be dismissed for the Opponent's failure to establish that its use of any of these product designations had been significant enough to negate the distinctiveness of the Mark as of March 4, 2014.

[103] Accordingly, the non-distinctiveness ground of opposition is unsuccessful.

Disposition

[104] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition to application No. 1,533,996 under section 38(8) of the Act.

---

Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office



**Schedule "A"**

Labels – Exhibits 9, 10 and 10B

<ul style="list-style-type: none"> <li>• FLED-OV-10-B-N</li> <li>• FLED-OV-10-G-N</li> <li>• FLED-OV-10-R-N</li> <li>• FLED-OV-10-R-W</li> <li>• FLED-OV-10-W-N</li> <li>• FLED-OV-10-700-B-N</li> <li>• FLED-OV-10-700-W-N</li> <li>• FLED-OV-10-700-W-M</li> <li>• FLED-OV-10-700-W-W</li> <li>• FLED-OV-10-W-M-277V</li> <li>• FLED-OV-10-W-N</li> <li>• FLED-OV-10-W-M</li> <li>• FLED-OV-10-W-W</li> <li>• FLED-REC-36-W-N</li> <li>• FLED-REC-36-W-M</li> <li>• FLED-REC-36-W-W</li> <li>• FLED-REC-36-B-N</li> <li>• FLED-REC-36-G-W</li> </ul>	<ul style="list-style-type: none"> <li>• FLED-SQ-18-W-W</li> <li>• FLED-SQ-18-W-N</li> <li>• FLED-SQ-18-W-M</li> <li>• FLED-SQ-18-W-W</li> <li>• FLED-SQ-18-B-N</li> <li>• FLED-SQ-18-W-M-24V</li> <li>• FLED-SQ-18-700-W-N</li> <li>• FLED-SQ-18-700-W-M</li> <li>• FLED-SQ-18-700-W-W</li> <li>• FLED-SQ-18-WW-W</li> <li>• FLED-SQ-18-W-M</li> <li>• FLED-SQ-18-W-M</li> <li>• FLED-RND-18-W-N</li> <li>• FLED-RND-18-W-W</li> <li>• FLED-RND-18-G-N</li> <li>• FLED-RND-18-B-W</li> <li>• FLED-HDR-10-MED-UB</li> <li>• FLED-HDR-10-HYBRID-UB</li> <li>• FLED-HDR-10-M</li> <li>• FLED-R-10SPOT</li> </ul>
--	--

Invoices for 2008-2014 – Exhibit 11

<ul style="list-style-type: none"> <li>• FLED-OV-10-W-N</li> <li>• FLED-OV-10-G-M</li> <li>• FLED-OV-10-R-M</li> <li>• FLED-OV-10-B-M</li> <li>• FLED-OV-10-R-N</li> <li>• FLED-OV-10-R-W</li> <li>• FLED-OV-10-W-N 277V</li> <li>• FLED-OV-10-700-W-N</li> <li>• FLED-OV-10-W-M</li> <li>• SP-FLED-OV-18-CW</li> <li>• FLED-REC-36-W-M</li> </ul>	<ul style="list-style-type: none"> <li>• FLED-SQ-18-W-N</li> <li>• FLED-SQ-18-B-M</li> <li>• FLED-SQ-18-W-M</li> <li>• FLED-SQ-18-W-W</li> <li>• FLED-SQ-18-W-M-277V</li> <li>• FLED-SQ-18-R-M</li> <li>• FLED-R-10 HYBRID</li> <li>• FLED-R-10 MEDIUM</li> <li>• FLED-R-10 SPOT</li> </ul>
--	---

Schedule B

Front page - Product spec sheet for the FLED-RND-18 flood light – Exhibit 6

TRUSTED QUALITY since 1968

# RAB<sup>®</sup> DESIGN

## FLED-RND-18 LED FLOOD

*The FLED-RND-18 is a medium size compact LED flood light. The FLED-RND-18 has a clear tempered glass lens, steel yoke mounted to the power supply base. The housing is made of extruded aluminum with a grey powder coat paint finish. Each LED is 1 watt and are available in white, red, blue, green and yellow. For other sizes and shapes please see FLED-OV-10, FLED-SQ-18 and FLED-RED-36. The FLED-RND-18 series can be used for indoor and outdoor applications and is ideal for use in illuminating statues, landscape features, building and security lighting.*

**HOUSING** Extruded aluminum with heat fins.

**BALLAST BOX** Die cast aluminum with a powder coat paint finish.


**DRIVER** 120 volts in, 12 volts out.

**LEDs** Eighteen 1 watt LEDs available in narrow, medium or wide distribution.

**LENS** Clear tempered glass with a continuous gasket.

**HARDWARE** Stainless steel.

**RATED IP65**



**BENEFITS OF LEDs**

**LEDs have a longer life than traditional HID lamp options.** HID lamps can vary in lamp life from 5,000 to 20,000 hours for Metal Halide and 20,000 to 24,000 for High Pressure Sodium. LEDs have a minimum life of 50,000 hours. This can represent a significant cost savings in lamp replacement costs and labour.

**LEDs consume less electricity than HID sources.** With the cost of electricity continually increasing this is a permanent savings year over year.

**LEDs are also offered in several colour sources** that can be used to enhance the look of a building or a feature that traditionally with HID require an expensive colour filter that may have to be replaced over time.

**LED fixtures offer a versatile option with a smaller foot print** than most traditional HID fixtures.

**LED fixtures offer a stronger punch in a smaller package** than their HID equivalents.

[www.rabdesign.ca](http://www.rabdesign.ca)

RAB DESIGN Lighting Inc. • 222 Islington Ave., Toronto, ON M6E 1V3W7 • TEL: 416-522-8454 / 800-768-0381 • FAX: 416-501-7322 • 800-665-5517

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

---

**HEARING DATE:** 2016-08-23

**APPEARANCES**

James W. Carson

FOR THE OPPONENT

Stella Syrianos

FOR THE APPLICANT

**AGENTS OF RECORD**

Blaney McMurtry LLP

FOR THE OPPONENT

ROBIC

FOR THE APPLICANT