



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

**Citation: 2014 TMOB 205**  
**Date of Decision: 2014-09-25**

**IN THE MATTER OF AN OPPOSITION  
by RAB DESIGN LIGHTING INC. to  
application No. 1,533,995 for the trade-  
mark FFLED in the name of RAB  
LIGHTING INC.**

[1] On June 30, 2011, RAB LIGHTING INC. (the Applicant) filed application No. 1,533,995 to register the trade-mark FFLED (the Mark). The application is based upon proposed use in Canada in association with lighting fixtures, electric lighting fixtures and LED (light emitting diode) lighting fixtures and claims a June 22, 2011 priority filing date based upon the Applicant's corresponding United States of America application No. 85352617.

[2] RAB DESIGN LIGHTING INC. (the Opponent) has opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based upon sections 30(i), 16(2)(a), 16(3)(a) and 2 of the Act.

[3] In support of its opposition, the Opponent filed the affidavit of David Beron, sworn October 9, 2012 (the Beron affidavit). In support of its application, the Applicant filed the affidavit of Ross Barna, sworn February 7, 2013 (the Barna affidavit). The affiants were not cross-examined.

[4] Both parties submitted a written argument and attended an oral hearing.

## Onus

[5] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

## Grounds of Opposition Withdrawn

[6] At the hearing, the Opponent withdrew the grounds of opposition based upon sections 30(i) and 16(2)(a). It is therefore no longer necessary to consider these grounds.

## Analysis of the Remaining Grounds of Opposition

### Background

[7] Although the parties in this proceeding are not related or affiliated companies, they are not strangers to one another [first Beron affidavit, para 18].

[8] The evidence establishes that the Opponent purchased products from the Applicant in the United States for importation into Canada from 2002 to 2008 [Beron affidavit, para 16; Barna affidavit, paras 6 and 7]. It is not clear from the evidence what trade-mark these products were sold under in Canada by the Opponent.

[9] The Opponent asserts that it began selling its own products under the product designation and brand FLED in Canada in September of 2008 [Beron affidavit, para 7]. In November of 2008, the Applicant stopped selling its products to the Opponent in the United States for distribution in Canada [Barna affidavit, para 7].

[10] There may or may not have been a brief period of overlap in time where the Opponent was selling both its own products under the product designation and brand FLED and those of the Applicant in Canada (in association with a trade-mark which may or may not have been similar to the Mark or to the Opponent's trade-mark).

[11] According to the Opponent, in January of 2010, a subsidiary of the Applicant began selling the Applicant's lighting products in Canada [Beron affidavit, para 19]. The evidence does not specify which trade-mark these products are sold under. Thus, it is unclear whether they have been sold under the Mark or a trade-mark which is similar to that of the Opponent.

[12] The main issues to be determined are whether the Applicant is the person entitled to register the Mark in Canada and whether or not the Mark is distinctive.

#### Non-Entitlement – Section 16(3)(a)

[13] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act, in view of the Opponent's prior use and making known in Canada of its "FLED series of trade-marks" since at least 2008 in association with a series of LED flood light commercial and industrial lighting fixtures. The Opponent's "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-REC-36".

[14] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks, the Opponent has the initial onus of proving that at least one of its trade-marks was in use or had been made known prior to the June 22, 2011 priority filing date of the application for the Mark and had not been abandoned as of the February 8, 2012 date of advertisement for the Mark [section 16(5) of the Act].

[15] The definition of "made known" is set out in section 5 of the Act and the Opponent's evidence is insufficient to show that its trade-marks have been "made known" within such definition. Therefore, we are left with the question of whether the Opponent's evidence shows that its trade-marks were previously used in Canada pursuant to section 4 of the Act.

[16] The word "use" is a legal term which is specifically defined in section 4 of the Act and one must look at the evidence filed in order to determine if in fact there has been use of a trade-mark in association with wares within the meaning of section 4. I have reproduced the wording of section 4 of the Act below:

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.

[17] In its written arguments and at the oral hearing, the Applicant submitted that: i) the use shown by the Opponent does not constitute “use” within the meaning of section 4; and ii) even if “use” within the meaning of section 4 of the Act has been shown, the Opponent has not used FLED as a trade-mark (i.e. as a source identifier), but rather, it has used it as part of an alphanumeric sequence to designate particular product models (i.e. as a product identifier).

[18] The Beron affidavit provides us with information regarding the Opponent, its business and its trade-marks.

[19] Mr. Beron is the Vice-President Market Operations of the Opponent and states that he has held this position since 2008 [Beron affidavit, para 1]. He explains that the Opponent is a family owned business that designs, manufactures, assembles and distributes commercial and industrial lighting and related products through a national network of over 700 Canadian electrical distributors and lighting showrooms [Beron affidavit, para 1]. The Opponent acquired its business from a predecessor in December of 2001 [Beron affidavit, para 3].

[20] 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 [Beron affidavit, para 6].

[21] According to Mr. Beron, in 2008, the Opponent designed and began manufacturing its first LED lighting fixture, namely, a small compact flood light under the product designation and brand FLED [Beron affidavit, para 7]. Mr. Beron states that the distribution and sale of this item (FLED-OV-10 LED) commenced in September of 2008 [Beron affidavit, para 7]. According to Mr. Beron, 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 [Beron affidavit, para 7].

[22] Attached as Exhibits “3”-“6” are product specification sheets for the Opponent’s FLED-OV-10 LED, FLED-SQ-18 LED, FLED-REC-36 LED and FLED-RND-18 LED flood lights.

[23] Mr. Beron states that these product specification sheets are available on the Opponent's website [Beron affidavit, para 7].

[24] Notably, the term FLED does not appear anywhere on its own in Exhibits "3" to "6". Rather, it only appears as part of the overall designations for the Opponent's products (for example, FLED-OV-10 LED [Exhibit "3"], FLED-SQ-18 LED [Exhibit "4"], FLED-REC-36 LED [Exhibit "5"] and FLED-RND-18 LED [Exhibit "6"]).

[25] In paragraph 8, Mr. Beron states that the Opponent's FLED brand series of LED lighting fixtures (FLED-OV-10 LED, FLED-SQ-18 LED, FLED-REC-36 LED and FLED-RND-18 LED), have been advertised in the Opponent's product catalogue since late 2008 and in its on-line catalogue on its website which is updated regularly. Attached as Exhibit "7" is a copy of the Opponent's product catalogue from September 2008. Attached as Exhibit "8" is a copy of pages from the Opponent's on-line catalogue as it existed in April of 2011, showing its FLED brand series of LED lighting fixtures.

[26] Again, the term FLED does not appear anywhere on its own in Exhibits "7" and "8". It appears only as part of overall product designations for the Opponent's products or in the forms FLED-SQ, FLED-REC and FLED-OV.

[27] According to Mr. Beron, the product specification sheets (Exhibits "3" to "6") and its catalogue (Exhibit "7") together with samples of its FLED brand series of lighting fixtures are provided to its national network of Canadian electrical distributors and lighting showrooms who provide the product specification sheets and catalogues to customers for the products as well as display the samples on their premises. Mr. Beron states that the Opponent's distributors and its customers access the Opponent's on-line catalogue [Beron affidavit, para 9].

[28] Mr. Beron has not indicated how and when the printed product specification sheets and catalogues are distributed to customers. In particular, Mr. Beron does not indicate that the catalogues and specification sheets have been used by customers to order the Opponent's products or that they accompany the products at the time of transfer. In the absence of any clear evidence in this regard, I cannot infer that any use of the Opponent's trade-marks which may be shown in those materials would constitute "use" within the meaning of section 4 of the Act in

association with wares. At the hearing, the agent for the Opponent conceded this point and instead relied upon other aspects of Mr. Beron's affidavit to assert that "use" has been shown. In particular, the Opponent relied upon paragraphs 10 and 11 and Exhibit "9" of the Beron affidavit.

[29] In paragraph 10 of the Beron affidavit, Mr. Beron states that the Opponent "currently" offers approximately 65 SKU's for its FLED brand series of LED lighting fixtures. According to Mr. Beron, there is a different SKU depending on the shape of the flood light, the number of LEDs, the colour of LED (white, amber, blue, green, red, warm white), the shape of the beam (narrow, medium, wide), the colour of the housing, etc. [Beron affidavit, para 10]. Mr. Beron states that the Opponent's FLED brand series of LED lighting fixtures are sold in plain brown box packaging bearing the product label for that SKU [Beron affidavit, para 11]. Attached as Exhibit "9" is a representation of some of the labels that Mr. Beron states appear on the packaging for some of the different SKUs in the Opponent's FLED brand series of LED lighting fixtures.

[30] All of the labels shown in Exhibit "9" feature FLED as part of an overall designation (i.e. FLED-OV-10-B-N, FLED-OV-10-G-N, FLED-OV-10-R-N, FLED-OV-10-R-W, FLED-OV-10-W-N, FLED-SQ-18-W-W, FLED-SQ-18-W-N, FLED-SQ-18-W-M, FLED-SQ-18-B-N, FLED-REC-36-W-N, FLED-REC-36-W-M, FLED-REC-36-W-W, FLED-REC-36-B-N, FLED-REC-36-G-W, FLED-HDR-10-MED-UB, FLED-HDR-10-HYBRID-UB, FLED-SQ-18-W-M-24V, FLED-OV-10-700-B-N, FLED-OV-10-700-W-N, FLED-OV-10-700-W-M, FLED-OV-10-700-W-W, FLED-SQ-18-700-W-N, FLED-SQ-18-700-W-M, FLED-SQ-18-700-W-W, FLED-SQ-18-WW-W, FLED-OV-10-W-M-277V, FLED-SQ-18-W-M, FLED-SQ-18-W-M, FLED-RND-18-W-N, FLED-RND-18-W-W, FLED-RND-18-G-N, FLED-RND-18-B-W, FLED-OV-10-W-N, FLED-OV-10-W-M and FLED-OV-10-W-W).

[31] The designations FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-REC-36, which are collectively referred to as the Opponent's "FLED series of trade-marks" in the statement of opposition, do not appear on their own on the labels in Exhibit "9". Rather, they all appear in combination with additional letters and/or numbers.

[32] Notably, paragraphs 10 and 11 of the Beron affidavit are worded in the present tense and Mr. Beron has not provided any indication as to how long the labels shown in Exhibit “9” have appeared in this manner on boxes.

[33] In paragraph 12 of his affidavit, Mr. Beron states that since the Opponent launched its FLED brand series of LED lighting fixtures in September of 2008 to June of 2011, the Opponent’s sales in Canada have totaled about \$196,000 and that sales in Canada from July 2011 thru to the end of August 2012 were in excess of \$200,000. No breakdown has been provided with respect to which portion of these sales is attributable to which trade-mark in the Opponent’s “FLED series of trade-marks”.

[34] Attached as Exhibit “10” are representative invoices for the Opponent’s FLED brand series of lighting fixtures for 2008, 2009, 2010 and 2011. The invoices cover sales of FLED-OV-10-W-N, FLED-OV-10-G-M, FLED-OV-1-R-M, SP-FLED-OV-18-CW, FLED-SQ-18-W-N, FLED-OV-10-B-M, FLED-OV-10-R-N, FLED-OV-10-R-W, FLED-R-10, FLED-SQ-18-R-M, FLED-SQ-18-B-M, FLED-SQ-18-W-M and FLED-HDR-10-HYBRID-UB products. The designations FLED-OV-10, FLED-RND-18, FLED-SQ-18 and FLED-REC-36, which are collectively referred to as the Opponent’s “FLED series of trade-marks” in the statement of opposition, do not appear on their own on the invoices in Exhibit “10”. Rather, they all appear in combination with additional letters and/or numbers. There is also no indication that the invoices accompany the goods at the time of transfer.

[35] As mentioned previously, under its section 16(3)(a) ground of opposition, the Opponent has the initial onus of proving that at least one of its trade-marks was in use prior to the June 22, 2011 priority filing date of the application for the Mark and had not been abandoned as of the February 8, 2012 date of advertisement for the Mark [section 16(5) of the Act].

[36] It is possible that the labels attached as Exhibit “9” to the Beron affidavit, when taken into account in conjunction with the invoices (Beron affidavit, Exhibit “10”) and sales figures (Beron affidavit, para 12), could have been considered to show “use” in association with wares within the meaning of section 4 of the Act. However, as mentioned previously, Mr. Beron has provided no indication as to when the Opponent began using the labels which are shown therein.

[37] In my view, dates are of critical importance here, as the Opponent is attempting to prevent the Applicant's registration of the Mark based upon *prior use* of its own trade-marks. I am not prepared to draw an inference regarding that prior use based upon the evidence before me. The Opponent must establish the facts upon which it relies [see *Provigo Distribution Inc v Max Mara Fashion Group SRL*, 2005 FC 1550 at para 27(CanLII)] and it has failed to do so here.

[38] As I am unable to conclude that the Opponent has shown use of its trade-marks within the meaning of section 4 of the Act prior to the material date, I therefore conclude that the Opponent has not discharged its initial evidential burden in support of its section 16(3)(a) ground of opposition.

[39] In light of this conclusion, I do not consider it necessary to assess whether what is shown on the labels and in the other exhibits would be considered to be the trade-marks which have been identified as being in the Opponent's "FLED series of trade-marks" in the statement of opposition. I also consider it unnecessary to address the second aspect of the Applicant's submissions, namely, that the Opponent has not used its trade-marks as trade-marks (i.e. as source indicators), but rather, simply as a component of various different alphanumeric arrangements which refer to a particular product (i.e. product identifiers).

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

#### Non-distinctiveness – Section 2

[41] The Opponent has pleaded that the Mark is not distinctive in that it cannot distinguish and is not adapted to distinguish the Applicant's wares from the wares associated with its "FLED series of trade-marks".

[42] The material date to assess this ground of opposition is the filing date of the statement of opposition, namely, April 5, 2012 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[43] In order to meet its initial evidentiary burden in respect of this ground, the Opponent must establish that at least one of its trade-marks had become known sufficiently in Canada as of



April 5, 2012, to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[44] At the hearing, the Opponent submitted that even if I were to find that it has not met its initial burden in respect of its section 16(3)(a) ground of opposition, I am not precluded from finding in favour of the Opponent under its non-distinctiveness ground of opposition.

[45] Pursuant to section 2 of the Act, “distinctive”, in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted to so to distinguish them.

[46] The Opponent argues that there is no requirement under section 2 of the Act that a trade-mark be non-distinctive as a result of “use” within the meaning of section 4 or as a result of trade-mark use at all. Section 2 of the Act simply provides that a trade-mark will be “distinctive” as long as it distinguishes or is adapted to distinguish the wares and/or services of the applicant from those of others. The Opponent submits that it is therefore open to it to rely upon the use that it has shown of its trade-marks to negate the distinctiveness of the Mark, regardless of whether that use constituted “use” within the meaning of section 4 of the Act or whether it was in fact use in a trade-mark sense, rather than in some other product designation sense.

[47] However, the Opponent is restricted to what it has pleaded and in this particular case, the Opponent has pleaded non-distinctiveness as a result of its own use of its “FLED series of trade-marks” and those trade-marks have been specifically identified. In my view, this language makes it clear that the Opponent is relying on *trade-mark* use and not some other more general or descriptive type of use. If the Opponent wished to rely on something other than its trade-mark use to support its non-distinctiveness ground of opposition, it should have clearly set this out in its pleading.

[48] Section 38(3)(a) of the Act requires that grounds of opposition be set out in sufficient detail to enable the applicant to reply thereto and it is an elementary condition of fairness that each party be adequately informed of the case it has to meet [*Carling Breweries Ltd. v Molson Cos* (1984), 1 CPR (3d) 191 at 194 (FCTD); affirmed (1988), 19 CPR (3d) 129 (FCA)].

[49] It is true that the sufficiency of pleadings should be assessed having reference to the evidence of record [see *Novopharm Ltd v Astra AB* (2002), 21 CPR (4th) 289 (FCA)]. However, in the present case, it is not, in my view, reasonable to expect that the Applicant would have assumed from the evidence of record that the Opponent intended to rely upon anything other than its own trade-mark use in support of its non-distinctiveness ground of opposition. Even the Opponent's written argument is devoid of any clear indication of this. In my view, the Opponent's non-distinctiveness ground cannot therefore be broadened at the oral hearing and decision stage so as to enable the Opponent to rely on something other than its use of its "FLED series of trade-marks", as pleaded.

[50] My findings with respect to the Opponent's section 16(3)(a) ground of opposition are therefore equally applicable at this later material date (i.e. April 5, 2012).

[51] Accordingly, this ground of opposition is also unsuccessful.

#### Disposition

[52] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Lisa Reynolds  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office