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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 96

Date of Decision: 2019-09-16

IN THE MATTER OF A SECTION 45 PROCEEDING

Haldex AB

Requesting Party

And

Hardex Brake Corp.

Registered Owner

**TMA807,975 for HARDEX PREMIUM
BRAKE PADS**

Registration

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA807,975 for the trademark HARDEX PREMIUM BRAKE PADS (the Mark), owned by Hardex Brake Corp.

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

GOODS

Brake pads (semi-metallic, ceramic and low metal) and brake shoes.

SERVICES

The retailing of brake pads and brake shoes (semi-metallic, ceramic, dynamic low metal and organic).

[3] For the reasons that follow, I conclude that the registration ought to be expunged.

INTRODUCTION

[4] At the request of Haldex AB (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on February 21, 2017, to Hardex Brake Corp. (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the goods and services specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is February 21, 2014 to February 21, 2017.

[6] The relevant definitions of use are set out in section 4 of the Act as follows:

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

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] Concerning services, the display of the trademark in the advertisement of the services is sufficient to satisfy the requirements of section 4(2) of the Act, from the time the owner of the trademark offers and is ready to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[8] It is well established that bare statements that a trademark is in 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 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 trademark in association with each of the goods and services

specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[9] On November 21, 2017, in response to the Registrar’s notice, the Owner furnished the affidavit of Alireza Rasekh, sworn on November 16, 2017. Only the Requesting Party filed written representations. No oral hearing was requested.

THE OWNER’S EVIDENCE

[10] Mr. Rasekh states that he is the General Manager (Export Office) of the Owner and has been since 2010. He explains that the Owner is a corporation incorporated in British Columbia in 2009. He states that the Owner used the Mark in association with brake pads (semi-metallic, ceramic and low metal) and brake shoes, and in association with the retailing of those goods. Mr. Rasekh attaches the following exhibits to his affidavit:

- Exhibit A: a copy of a brochure advertising brake pads and brake shoes. Mr. Rasekh states that the brochure has been sent to customers within and outside of Canada in the ordinary course of trade together with brake pads and brake shoes during the relevant period. I note that the phrase “HARDEX PREMIUM BRAKE PADS” does not appear anywhere in the brochure; instead, the brochure prominently displays the words “HARDEX PREMIUM BRAKES” in the following configuration [the Logo]:



In addition, several of the individual products are identified as “Hardex ® Premium Low-Metallic Brakes Pads”; “Hardex ® Premium Ceramic Brake Pads”; “Hardex ® Premium Brake Shoes”, and the like. Each such phrase occurs only once in the body of the text of the brochure. Further, I note that in each case where products are depicted in the brochure, they bear the Logo on the packaging and the products themselves.

- Exhibit B: copies of invoices dated August 1, 2014, July 23, 2015, and June 6, 2016, marked with the Logo in the top right corner. The recipients of the invoices

are redacted; however, the final page of each invoice reads “FOB VANCOUVER – CANADA”. While the nature of the products being sold is not clear from the invoices, Mr. Rasekh states that the invoices are for brakes, brake pads, brake shoes, and brake linings sold and shipped by the Owner to customers within and outside of Canada in the ordinary course of trade during the relevant period. Mr. Rasekh states that the packaging is marked with the Mark.

ANALYSIS

[11] The Requesting Party raises a number of issues with the Owner’s evidence. However, for the purposes of this decision, I need only address its two main arguments; namely, that the trademark or trademarks shown in its evidence are not the Mark, and that it has not established use of the Mark in association with each of the registered goods and services.

Mark not displayed as registered

[12] Where the mark as used deviates from the mark as registered, the question to be asked is whether the 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 internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) at 525]. In deciding this issue, one must look to see if the “dominant features” have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA) at 59]. Whether the differences between the marks are “so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences identify goods having the same origin” [*CII Honeywell Bull* at p 525], is a question of fact. Lastly, the use of a trademark in combination with additional words or features constitutes use of the registered mark if the public as a matter of first impression, would perceive the trademark *per se* as being used. This is a question of fact which is dependent on whether the trademark stands out from the additional material, for example by the use of different lettering or sizing or whether the additional material would be perceived as clearly descriptive matter or as a separate trademark or trade name [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[13] The Requesting Party argues that because both the brochure and invoices consistently display the Logo, the ordinary consumer would perceive the trademark to be either the composite trademark “HARDEX PREMIUM BRAKES and Design” or “Hardex and Design”, both of which differ significantly from the Mark as registered. In addition, in the Requesting Party’s view, the replacement of the elements “BRAKE” and “PADS” with the word “BRAKES” constitutes use of a substantially different trademark from the Mark as registered. In support, the Requesting Party cites the case of *Mendelsohn Rosentzveig Shacter v Parmalat Dairy & Bakery Inc* (2004), 40 CPR (4th) 443 (TMOB), in which the registrar found that the descriptive words “DU YOGOURT” formed a dominant and essential part of the trademark “LA CRÈME DU YOGOURT” such that their omission resulted in the use of a substantially different trademark.

[14] I concur with the Requesting Party on the latter point. Because the Logo depicts the words “HARDEX PREMIUM BRAKES” rather than “HARDEX PREMIUM BRAKE PADS”, the dominant features of the Mark as registered have not been preserved.

[15] To the extent that the brochure makes use of phrases such as “Hardex ® Premium Ceramic Brake Pads” to refer to its products, I note that these formulations consistently place the trademark symbol after the word “Hardex” and add other descriptive words such as “ceramic”. As such, I find that the public would perceive the trademark being used in these cases as “Hardex” rather than the Mark.

[16] Accordingly, I find that the Mark as registered does not appear in the brochure or invoice evidence furnished by the Owner.

Use with each of registered goods and services

[17] The Requesting Party argues that Mr. Rasekh’s statement that the items were sold and shipped in packaging bearing the Mark is an unsupported assertion that should not be given any weight. In addition, the Requesting Party argues that Mr. Rasekh does not explain whether the items described on the invoices refer to any of the registered goods, noting his statement that the invoices reflect sales of the registered goods in addition to brakes and brake linings. Additionally, the Requesting Party argues that the redactions to the invoices mean that they cannot support either sale in Canada or export from Canada.

[18] Absent evidence to the contrary, an affiant's sworn statement is to be accepted at face value, and statements in an affidavit must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25]. In this case, I accept that sales occurred with respect to each of the registered goods in view of Mr. Rasekh's sworn statements to that effect. However, the goods and the packaging shown in Mr. Rasekh's brochure evidence bear the Logo rather than the Mark as registered. In addition, the Logo is displayed consistently in both the brochure and invoice evidence. This consistent use of the Logo rather than the Mark as registered tends to cast doubt on Mr. Rasekh's sworn statement that the Owner displayed the words "HARDEX PREMIUM BRAKE PADS" on the packaging of its products.

[19] As such, I find that the Owner's evidence does not establish use of the Mark in association with the registered goods and services within the meaning of sections 4 and 45 of the Act. Further, the Owner has provided no special circumstances that would excuse non-use of the registered goods and services.

DISPOSITION

[20] 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.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Cameron IP

For the Registered Owner

Hicks Intellectual Property Law

For the Requesting Party