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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 81

Date of Decision: 2020-06-30

IN THE MATTER OF A SECTION 45 PROCEEDING

iboss, Inc.	**Requesting Party**
and	
Waystream AB	**Registered Owner**
TMA813,115 for IBOS	**Registration**

INTRODUCTION

[1] At the request of iboss, Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on May 2, 2017, to Waystream AB (the Owner), the registered owner of Registration No. TMA813,115 for the trademark IBOS (the Mark).

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

> Electrical apparatus for the provision and control of broadband networks, network installations and telecommunications apparatus and installations, namely, computer hardware, computer software for the provision and control of broadband networks, routers, switches and cable television equipment; downloadable instructional materials namely, manuals, guides and test materials, in the fields of network communications, and managing, operating and using local, wide and global networks, and cable television systems; interfaces for interconnecting computers; computer hardware containing network security functionality, namely firewalls, data encryption, and interoperability

> with network security protocols; computer hardware and software for interconnecting, managing, securing and operating local and wide area computer networks; network switches and routers; cable television receivers; computer hardware and software for use in cable television systems namely, for the provision and control of such systems; computer hardware and software for the provision and control of broadband internet services; network cards; computer connection cables and computer network adapters; fibre optic cable, feeder cable, coaxial cable; optical fibres; cable jump leads, cable jump access leads, parts and fittings for all the aforesaid goods.

[3] For the reasons that follow, I conclude that the registration ought to be maintained only with respect to "Computer software for interconnecting, managing, securing and operating local and wide area computer networks".

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with the registered goods 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 May 2, 2014, to May 2, 2017.

[5] The relevant definition of use for goods is 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.

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

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Mats Öberg, the CEO of the Owner, sworn November 28, 2017. Both parties filed written representations and were represented at an oral hearing.

THE OWNER'S EVIDENCE

[8] Mr. Öberg states that the Mark was owned by PacketFront International AB, followed by PacketFront Network Products AB, and was assigned to the Owner on October 5, 2015. He explains that the Owner is a Swedish company that provides products and services for computer networking and data communication, including various types of hardware and software. The Owner's hardware products are operated using the Owner's proprietary operating system or firmware software called iBOS.

[9] Mr. Öberg states that the Mark was used during the relevant period in association with the sale of the registered goods in Canada to Canadian customers, by way of being featured directly on the Owner's goods, on the packaging for the goods, or on printed materials such as user guides, instruction manuals, or technical data sheets which accompanied the registered goods at the time of sale. In particular, he attests that the Mark "has been featured on products or printed materials (such as data sheets, user guides, and instructional manuals) accompanying Waystream's computer hardware Goods and seen by our customers at the time of their sale in Canada", including each of the non-software goods listed in the registration. In support, he attaches the following exhibits:

- Exhibit 4: a datasheet for an ASR6000 Ethernet access switch router, which he states was distributed in association with this router in Canada during the relevant period. The only appearance of the Mark in the document is in a table entitled "Order items"; I note that this table lists "iBOS included" in the technical specifications for a product called "ASR6026-AC", identified as part of the "ASR6000 family".
- Exhibit 5: datasheets for a different router, which refers to the router's iBOS operating system several times.
- Exhibits 6 and 7: a user guide and installation manual, respectively, for the router depicted in Exhibit 4. Mr. Öberg states that these materials were provided along with that system to customers in Canada during the relevant period. There are numerous references throughout both documents to the product's iBOS operating system; I note that the word "iBOS" appears at least six times in the thirteen-page

document attached as Exhibit 6, and at least 30 times in the 38-page document attached as Exhibit 7. Further, the first pages of Exhibit 6 and Exhibit 7 state that iBOS is a registered trademark of the Owner.

- Exhibit 8: a copy of the graphical user interface which would have appeared on users' computer screens while setting up, configuring, and operating the router depicted in Exhibit 4. The first line of this user interface reads "Intelligent Broadband Operating System (iBOS)".

[10] Mr. Öberg states that these exhibits are representative of how the Mark has appeared on the Owner's "products, product packaging, and on printed materials (such as data sheets, user guides, and instruction manuals) which have accompanied [the Owner]'s products and have been seen by our customers at their time of sale in Canada during the Relevant Period" for all of the hardware goods appearing in the registration. I note that images of the two routers appear throughout the materials and that the Mark does not appear on the routers themselves. No images of product packaging appear in the materials.

[11] With respect to the user guide and instruction manual attached as Exhibits 6 and 7, respectively, Mr. Öberg states that in addition to being provided to customers at the time of sale, such documents were "otherwise made available by download to those who had purchased such systems", and are representative of how the Mark appeared in association with the registered goods "downloadable instructional materials namely, manuals, guides and test materials, in the fields of network communications, and managing, operating and using local, wide and global networks, and cable television systems" in Canada during the relevant period.

[12] As Exhibits 9 and 10, respectively, Mr. Öberg attaches a spreadsheet and invoices showing sales of the ASR6000 routers to a Canadian customer during the relevant period. The Mark does not appear on these documents. I note that the item listed as "ASR6026-AC", indicated in Exhibits 4 and 7 to be one of the ASR6000 series of routers, has a price in excess of $2,000 USD, and that the total purchase is in excess of $16,000. Mr. Öberg states that the router comprises computer hardware and software, including the iBOS operating system, as indicated in Exhibits 4 through 8. He states that the exhibits provided are intended to be "representative and illustrative" of the Owner's use of the Mark in association with the registered goods in Canada during the relevant period.

ANALYSIS

[13] The Requesting Party submits that the Owner's evidence shows that the Mark is not being used as a trademark in association with any of the registered goods, and that it does not demonstrate that the Mark is associated with the registered goods at the time of transfer. Each submission will be considered in turn.

Use in Association with Registered Goods

[14] The Requesting Party submits that the Mark is only used in the exhibited documents to describe the operating system used by some of the Owner's devices, and that its appearance in this manner could be considered to be a descriptive acronym rather than a trademark, given that it stands for "Intelligent Broadband Operating System". On this point, I note that it is well established that section 45 proceedings are not intended to determine substantive rights such as ownership, distinctiveness, descriptiveness or abandonment of a registered trademark [see *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66 (*United Grain Growers*); *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. In *United Grain Growers* at para 14, the Federal Court of Appeal wrote as follows:

> No words in section 45 direct the Registrar to re-examine whether the registered trade-mark is used for the purpose of distinguishing, or so as to distinguish, wares. Rather, the Registrar's duty under section 45 is only to determine, with respect to the wares specified in the registration, whether the trade-mark, as it appears in the Register, has been used in the three years prior to the request.

[15] Accordingly, I cannot consider the Requesting Party's arguments concerning whether the Mark is being used as a descriptive acronym.

[16] The Requesting Party further submits that the name of a software application in a guide or manual for a physical product does not constitute use of a trademark in association with that physical product, and provides the example of a MacBook computer which contains the iTunes program, but is not an iTunes computer. Instead, the Requesting Party submits that the Owner's evidence could, at best, support use in association with operating system software; however, as the registered goods do not include operating system software, the Requesting Party submits that the Owner's evidence cannot support use in association with any of the registered goods.

[17] Although the routers shown in evidence comprise both hardware and software components, it is clear from the evidence that the Mark is being used only in association with the software element of these products, insofar as iBOS is the name of the pre-loaded operating system used by the routers. I note that in *Altos, Re* (2003), 30 CPR (4th) 562 (*Altos*), relied upon by the Owner for the proposition that notice of association can be established where a trademark appears on a guide or manual seen by purchasers of pre-loaded computer software at the time of transfer, the Registrar drew a distinction between use in association with the hardware and pre-loaded software elements of an integrated product comprising both. In that case, as in the present case, computer hardware and computer software were differentiated in the registration, and use in association with the hardware element was not considered to be sufficient to maintain use in association with the software element [see *Altos* at paras 7-8].

[18] Thus, I concur with the Requesting Party that the Owner's evidence demonstrates use of the Mark in association with operating system software only; however, I disagree with the Requesting Party's contention that such a product cannot be correlated with any of the registered goods. In this respect, the Owner submits that its evidence of use in association with the router operating system establishes use in association with the following registered goods:

- Electrical apparatus for the provision and control of broadband networks, network installations and telecommunications apparatus and installations, namely, computer hardware, computer software for the provision and control of broadband networks, routers, switches and cable television equipment;
- interfaces for interconnecting computers;
- computer hardware containing network security functionality, namely firewalls, data encryption, and interoperability with network security protocols;
- computer hardware and software for interconnecting, managing, securing and operating local and wide area computer networks; and
- network switches and routers.

[19] However, it is well-established that use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration; having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [per *John Labatt*]. Bearing this principle in mind, I find that the evidenced operating system correlates most readily with the registered good "computer […] software for

interconnecting, managing, securing and operating local and wide area computer networks", given that the other registered goods appear to refer primarily to computer hardware.

[20] While the Requesting Party submits that the Owner's evidence is ambiguous as to which goods were sold during the relevant period, Mr. Öberg is clear that one of the items listed the Exhibit 10 invoice is the ASR6026-AC router shown in Exhibits 4, 6, and 7. Because that invoice shows sales of the router in Canada during the relevant period, and because the evidence, including the Exhibit 4 datasheet, indicates that the iBOS operating system was pre-loaded on that router, I am satisfied that the Owner has established transfers of the operating system software during the relevant period. In reaching this conclusion, I am mindful that nothing in the Act requires a trademark to be used in association with a "stand-alone" product; use within the meaning of the Act may be established where a Mark is used in association with a component of a complete product [see *Gowling, Strathy & Henderson v Tundra Knitwear Ltd* (2001), 13 CPR (4th) 559 at para 7; *Gowling WLG (Canada) LLP v Pelican International Inc*, 2016 TMOB 144 at paras 16-18; *Altos* at para 13].

[21] The Owner further submits that its evidence establishes use of the Mark in association with the registered goods "downloadable instructional materials namely, manuals, guides and test materials, in the fields of network communications, and managing, operating and using local, wide and global networks, and cable television systems". However, Mr. Öberg states only that the exhibited user guide and information manual were provided to customers at the time of sale of the aforementioned routers, or were "otherwise made available by download to those who had purchased such systems". As Mr. Öberg clearly states that the exhibited guides and manuals are "printed materials", they cannot be considered to be "*downloadable* instructional materials". Further, Mr. Öberg's statement that the materials were "made available by download" does not establish that such materials were transferred in the normal course of trade during the relevant period [see, *e.g.*, *Riches, McKenzie & Herbert LLP v Cleaner's Supply Inc*, 2012 TMOB 211 at para 13; *Davis LLP v Office of the Commissioner of Baseball*, 2015 TMOB 107 at para 9]. As such, I cannot conclude that the Owner has established use of the Mark in association with these goods within the meaning of sections 4 and 45 of the Act.

[22] With respect to the remaining goods, the Owner submits that because all of the registered goods are closely related types of computer hardware, software, systems of such hardware and software, and related instructional materials, it can be inferred from the representative sales shown in Mr. Öberg's affidavit that the Mark has been used in association with all of the registered goods, citing *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FCTD) (*Saks*); *Re Sukul*, 2011 TMOB 35 at para 6; and *Matthew S George v Dr's Own, Inc*, 2018 TMOB 147 at paras 71-72 (*Dr's Own*).

[23] While evidentiary overkill is not required and representative evidence can be furnished in section 45 proceedings, the registered owner must still establish a *prima facie* case of use of the trademark in association with *each* of the goods specified in the registration [*John Labatt*; see also *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. In other words, the Registrar must be able to "rely on an inference from proven facts rather than on speculation" to satisfy every element required by the Act [*Diamant Elinor* at para 11; see also *Smart & Biggar v Curb*, 2009 FC 47]. I note that in *Dr's Own*, cited by the Owner in oral submissions, the Registrar observed that the applicability of the *Saks* principle "depends on the degree of detail that the registered owner provides and the clarity with which it explains the representative evidence"; further, because the evidence in that case included neither invoices nor images of certain registered goods, there was no factual basis upon which the Registrar could conclude that all the registered goods were sold during the relevant period (see *Dr's Own* at paras 71-74). Similarly, in the absence of clear evidence showing that goods other than the aforementioned routers were sold during the relevant period, there is no factual basis on which I could conclude that the Owner sold each of the registered goods during the relevant period beyond the computer software good noted above.

Association with Goods at Time of Transfer

[24] Turning to the question of whether the Owner's evidence demonstrates the requisite notice of association between the Mark and the aforementioned registered goods at the time of transfer, I note that with respect to goods such as computer software, there are inherent difficulties involved in associating a trademark with a product that is not a physical object. Accordingly, notice of association between a trademark and computer software has been

accepted where the trademark appeared on a license agreement which purchasers must read prior to loading the software, as well as appearing on the computer screen at the time of loading [see *BMB Compuscience Canada Ltd v Bramalea Ltd* (1988), 22 CPR (3d) 561 (FCTD)*; Clark Wilson LLP v Genesistems, Inc*, 2014 TMOB 64; and *Fasken Martineau DuMoulin LLP v Open Solutions DTS Inc*, 2013 TMOB 68]. Other examples involved the appearance of a trademark in training manuals that consumers were made aware of and shown prior to and after the transfer of the software [*Gowling Lafleur Henderson v IBM Canada Ltd* (2004), 38 CPR (4th) 475 (TMOB); *Altos* at para 11]. Nevertheless, the evidence must demonstrate that the trademark was associated with the goods at the time of transfer [see *Heenan Blaikie LLP v AlphaGlobal-IT Inc*, 2012 TMOB 166].

[25] In this case, the Requesting Party submits that despite Mr. Öberg's statements that the Mark appears on the goods and their packaging and on materials seen by purchasers at the time of transfer, the images of the Owner's product in evidence do not display the Mark. As such, the Requesting Party contends that Mr. Öberg's statement that the Mark appears on the goods and their packaging is "demonstrably false and undermines the credibility of the evidence", thereby calling into question his statement that customers would have seen the instructional materials before and at the time of transfer of the routers. I note that 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]. That being said, I concur with the Requesting Party that the images of the Owner's products in evidence do not support Mr. Öberg's statement that the Mark was displayed on the goods or their packaging; even if I were to accept that the Mark was displayed on some products, there is no way for me to determine which of the registered goods would have displayed the Mark in such a manner.

[26] However, I am not prepared to conclude that such statements undermine Mr. Öberg's credibility. Accordingly, I accept his sworn statements that the data sheets, user guides, and instruction manuals would have been seen by the Owner's customers at the time of transfer, particularly given that the routers are expensive items which would probably be carefully scrutinized by prospective purchasers [see *Altos* at para 12]. As such, based on Mr. Öberg's

sworn statements, I accept that purchasers would have seen the data sheets, user guides, and instruction manuals before and at the time of transfer of the goods.

[27] At the oral hearing, the Requesting Party contended that the computer software cases listed above are distinguishable from the present case because the Mark does not appear prominently on the materials accompanying the products, but instead, appears sporadically throughout the materials, while other trademarks are featured much more prominently. As such, according to the Requesting Party, a customer would not draw the requisite notice of association between the Mark and the registered goods even if that customer saw the instructional materials before and at the time of transfer, in contrast to the computer software cases cited above. In particular, with respect to the *Altos* case relied upon by the Owner, the Requesting Party notes that the trademark appeared "on" the instructional manual in that case, whereas it appears "in" the manual in the present case. However, I am not prepared to draw such a distinction. While it is true that the Mark does not appear as prominently as other trademarks within the materials, there is nothing to prevent multiple trademarks from being used at the same time [*AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (FCTD)]. In this case, I am satisfied that a prospective buyer would draw the requisite notice of association between the Mark and the operating system software, given the frequency with which the Mark appears throughout the materials, and given that such a buyer would be likely to carefully scrutinize such materials prior to purchase, as discussed above.

[28] Accordingly, I am satisfied that the Owner has established use of the Mark in association with the registered goods "computer software for interconnecting, managing, securing and operating local and wide area computer networks" within the meaning of sections 4 and 45 of the Act. I am not satisfied that the Owner has established use of any of the other registered goods within the meaning of sections 4 and 45 Act. I agree with the Requesting Party that there has been no evidence of special circumstances which would excuse non-use of the Mark in association with any of these registered goods.

DISPOSITION

[29] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the following registered goods:

> Electrical apparatus for the provision and control of broadband networks, network installations and telecommunications apparatus and installations, namely, computer hardware, computer software for the provision and control of broadband networks, routers, switches and cable television equipment; downloadable instructional materials namely, manuals, guides and test materials, in the fields of network communications, and managing, operating and using local, wide and global networks, and cable television systems; interfaces for interconnecting computers; computer hardware containing network security functionality, namely firewalls, data encryption, and interoperability with network security protocols; […] hardware and […] network switches and routers; cable television receivers; computer hardware and software for use in cable television systems namely, for the provision and control of such systems; computer hardware and software for the provision and control of broadband internet services; network cards; computer connection cables and computer network adapters; fibre optic cable, feeder cable, coaxial cable; optical fibres; cable jump leads, cable jump access leads, parts and fittings for all the aforesaid goods.

[30] The amended statement of goods will be as follows:

> Computer software for interconnecting, managing, securing and operating local and wide area computer networks.

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

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

HEARING DATE 2020-06-09

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