



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 56

Date of Decision: 2021-03-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Fasken Martineau Dumoulin LLP

Requesting Party

and

**GENTEC, a partnership consisting of
901089 Ontario Limited and 2494979
Ontario Limited**

Registered Owner

TMA780,998 for iQ

Registration

INTRODUCTION

[1] At the request of Fasken Martineau Dumoulin LLP (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 December 13, 2017 to GENTEC, a partnership consisting of 901089 Ontario Limited and 2494979 Ontario Limited (the Owner), the registered owner of registration No. TMA780,998 for the trademark iQ (the Mark).

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

Accessories for personal music players, MP3 players, satellite radios, cell-phones and portable music devices, but excluding any use in association with global positioning system (GPS) products, namely cases, docking stations for playing recorded music or for downloading and displaying digital pictures, headphones, interconnect cabling, power

adaptors, and maintenance products, namely cleaners (liquid, cloth and synthetic) and screen protectors.

[3] The notice required the Owner to show that it had used the Mark in Canada in association with each of the goods 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 December 13, 2014 to December 13, 2017.

[4] The relevant definition of use with respect to goods in the present case is set out in section 4(1) 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.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68]. 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)], mere assertions of use are not sufficient to demonstrate use [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Rather, sufficient facts must 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)].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Dorothy Hayashi, the Owner’s Director of Finance, sworn July 11, 2018.

[7] Both parties submitted written representations and attended an oral hearing.

[8] I note that the Owner filed an application to extend the statement of goods in November 2016. That application remains pending and is not at issue in this proceeding.

THE EVIDENCE

[9] In her affidavit, Ms. Hayashi attests that the Owner manufactures, imports and sells a range of consumer products, including “a range of audio-visual and smartphone products and accessories” [para 7]. She explains that the Owner sells its iQ-branded products to retailers in Canada (*e.g.* London Drugs, Bell Mobility, Winners, and The Source), who then sell the products to end-user consumers. She confirms that, during the relevant period, the Owner consistently displayed the Mark on packaging for its iQ products, identifying the Mark with an adjacent ® or ™ symbol [para 6].

[10] In support, Ms. Hayashi attaches to her affidavit photographs of packaging or images which she confirms show how the Mark appeared on packaging during the relevant period. Such images include the following relevant products:

- iQ Power Case [Exhibit B];
- iQ Qi Wireless Charging Stand [Exhibit D];
- iQ Podz True Wireless Headphones [Exhibit F];
- iQ Charge & Sync Cable [Exhibit H];
- iQ Ultimate Charging Bundle [Exhibit J];
- iQ Crystal Clear Screen Protector [Exhibit N].

[11] With respect to Exhibit D, I note that Ms. Hayashi describes the “iQ Qi Wireless Charging Stand” products as “docking stations”.

[12] Regarding the Owner’s volume of sales of iQ products in Canada during the relevant period, Ms. Hayashi states that the total sales for the registered goods, namely “cases, docking stations, headphones, interconnect cabling, power adaptors, and maintenance products” exceeded \$1,000,000 CAD, with sales for each specific good exceeding \$5,000 [para 15].

[13] Ms. Hayashi also attaches to her affidavit sample invoices showing particulars of sales of products to customers in Canada [Exhibits C, E, G, I, K, M, O]. While I note that some of the invoices are dated outside the relevant period, it appears that the iQ products listed on the invoices dated within the relevant period correlate with the above-listed products identified on the packaging images. Such invoiced products are generally identified with “iQ” in the product description and product code columns. An exception to this are the invoices at Exhibit O, listing “iPhone 5/5s/5c Crystal Clear Scr Screen Protector”. However, Ms. Hayashi confirms that such products refer to the screen protectors bearing the Mark, as depicted in Exhibit N [para 14].

ANALYSIS

[14] To begin with, the Owner concedes that use of the Mark during the relevant period has not been shown in association with the registered goods “cleaners (liquid, cloth and synthetic)”. As there is no evidence of special circumstances excusing any non-use of the Mark, the registration will be amended accordingly.

[15] Otherwise, the Requesting Party submits that the Owner’s evidence does not show use of the Mark in association with each of the remaining registered goods during the relevant period, with the possible exception of one specific type of “interconnect cabling”. Its main submissions can be summarized as follows:

- The evidence with respect to the product “iQ Qi Wireless Charging Stand” does not show use in association with the more particular registered goods “docking stations for playing recorded music or for downloading and displaying digital pictures”.
- Of the headphones depicted in Exhibit F, not all are evidenced to have been sold in Canada during the relevant period. Moreover, the evidence specifically with respect to the product “iQ Podz True Wireless Headphones” does not show use in association with the registered goods “headphones”, as the exhibited goods are not headphones. Furthermore, the trademark used in association with the depicted “headphone” products does not constitute use of the Mark as registered.
- The statement of goods as registered should be understood to comprise 35 individual goods, with each of the seven specified goods being an accessory for each of the five

listed devices; therefore, the Owner has not shown use in association with each of the registered goods.

Docking stations

[16] With respect to the registered goods “docking stations for playing recorded music or for downloading and displaying digital pictures”, the Requesting Party submits that the functionality of the “iQ Qi Wireless Charging Stand” (as depicted in Exhibit D) is aimed at charging electronic devices, which is “strikingly” different from that of “playing recorded music and downloading and displaying digital pictures”.

[17] In response, the Owner argues that a statement of goods should be granted a generous interpretation [citing *Fetherstonhaugh & Co v ConAgra Inc* (2002), 23 CPR (4th) 49 (FCTD); and *Molson Canada v Kaiserdom-Privatbrauerei Bamberg Wörner KG* (2005), 43 CPR (4th) 313 (TMOB)]. In particular, the Owner submits that “the ordinary meaning of ‘docking station’ includes accessories that connect portable electronic devices to a power supply”, and that “providing power to a device is an essential aspect of ‘playing’ and of ‘downloading and displaying’”. At the hearing, the Owner further relied on *Legault Joly Thiffault SENCRL v Harman International Industries Inc*, 2019 TMOB 58. In that case, wireless speakers were found to correspond with a “complete” sound system since a consumer would expect that wireless speakers would feature the various elements listed in the statement of goods, being a “complete sound system and its elements namely, loudspeakers, power amplifiers, mixers, signal processors, microphones and cables”.

[18] However, even with a broad interpretation, I consider the present case to be different from the facts in the *Harman* decision. Specifically, I do not find that wireless charging stands fall within the ambit of the registered goods “docking stations for playing recorded music or for downloading and displaying digital pictures”. That is, even though Ms. Hayashi identifies the depicted “iQ Qi Wireless Charging Stand” products as “docking stations”, I note that she stops short of describing such stands/stations by the particular functions as specifically set out in the statement of goods, and I am unable to identify such functions as features in the evidence. Thus, I agree with the Requesting Party that, whether considered a “stand” or a “station”, this product

appears to have the sole function of charging electronic devices, which does not correspond to the goods as registered.

[19] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with “docking stations for playing recorded music or for downloading and displaying digital pictures” within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances, the registration will be amended accordingly.

Headphones

[20] The Owner concedes that, of the products shown in Exhibit F, only “iQ Podz True Wireless Headphones” are evidenced to have been sold in Canada during the relevant period. However, the Requesting Party argues that this product does not constitute “headphones” because it does not include any band or other means of joining over the head. In support, the Requesting Party provides several dictionary definitions for “headphones”, such as from *The Canadian Oxford Dictionary*, where “headphones” are defined as “a pair of earphones joined by a band placed on the head or around the neck, for listening to audio equipment etc.” The Requesting Party also submits that in order to determine the meaning of the word “headphones”, one has to ask what the shared understanding of the trademark owner and the consumer would be [citing *Hilton Worldwide Holding LLP v Miller Thomson*, 2018 FC 895 at para 72] and that, in this case, the consumer would not consider the depicted product to be “headphones”. In this respect, although the word “headphones” is displayed on the packaging, the Requesting Party notes that the Registrar has to look at the actual nature of the goods instead of going by the label and the Owner’s submissions [citing *Plough, supra*, at para 12, where the Court of Appeal stated that neither the Court nor the Registrar “is bound by or interested in the deponent's opinion or conclusion that what is going on is use of the trade mark within the meaning of the statute”].

[21] The Owner, on the other hand, submits that its “iQ Podz True Wireless Headphones” sold during the relevant period are indeed headphones, as illustrated by the inclusion of the descriptive word “headphones” in the name of the product and on the product packaging. In the Owner’s view, the shared understanding can be inferred from the description employed on the product packaging. Furthermore, the Owner notes that the meaning of terms in a registration is

influenced by developments in commerce [citing *Hilton, supra* at paras 80 and 82; also *Levi Strauss & Co v Canada (Registrar of Trade-Marks)*, 2006 FC 654], such that the Requesting Party's restrictive definition of "headphones" is, at best, no longer appropriate. In this regard, the Owner directs attention to *Merriam-Webster.com*, where the definition for "headphone" includes the following entry: "also: a small earphone inserted into the ear".

[22] I agree with the Owner's submissions and accept that its "iQ Podz True Wireless Headphones" fall within the scope of the registered goods "headphones". This is not a case where the correlation with the registered goods is merely in self-serving representations after the fact. Ms. Hayashi identifies such products as "headphones" in her affidavit and I disagree with the Requesting Party that there is any inconsistency in the evidence in this respect. In contrast to the charging stations discussed above, it is no stretch to consider the Owner's "iQ Podz True Wireless Headphones" to fall within the ambit of the registration.

[23] With respect to display of the Mark, the Requesting Party submits that the products identified as "iQ Podz True Wireless Headphones" do not show use of the Mark as registered since the consumer's first impression would not be "iQ" alone but the composite trademark "iQ Podz" as one expression. The Requesting Party further argues that the fact that "iQ" is depicted in red and "Podz" in grey colour is "insufficient to generate an independent impression". Moreover, the Requesting Party considers the ® symbol to the right of the letters "iQ" on the packaging as "so small" that it should be disregarded.

[24] First, I consider these submissions moot, as the exhibited packaging also depicts the storage case for the headphones – the depicted case is engraved with the Mark, without any additional wording.

[25] In any event, I consider that the public, when viewing the product name as displayed on the evidenced packaging, would perceive the Mark *per se* as being displayed since it clearly stands out from the additional material by the use of different colouring, lettering and size. Furthermore, the letters "iQ" are followed by the symbol ® - both in red colour - and the word "Podz" is followed by the symbol ™ - both in silver-grey colour [per *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) and *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. Furthermore, there is nothing in the Act that precludes a

trademark owner from using more than one trademark at the same time in association with the same goods [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD); and *Canadian Council of Professional Engineers v Ardex Inc* (2001), 13 CPR (4th) 554 (TMOB)].

[26] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “headphones” within the meaning of sections 4 and 45 of the Act.

Cases, interconnect cabling, power adaptors, screen protectors

[27] With respect to the registered goods “cases”, “interconnect cabling”, “power adaptors” and “screen protectors”, there is clear evidence of sales in Canada during the relevant period, and that such goods displayed the Mark at the time of transfer.

[28] However, the Requesting Party points out that the evidence only contains a single invoice from the relevant period for each of the products “iQ Ultimate Charging Bundle” [Exhibit K] and “iQ Crystal Clear Screen Protector” [Exhibit O], further noting that “override pricing” was applied in the evidenced sale for screen protectors. Nevertheless, evidence of a single sale can be sufficient for the purposes of section 45 expungement proceedings, so long as it follows the pattern of a genuine commercial transaction and is not seen as deliberately manufactured or contrived to protect the registration [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at para 12]. In the present case, the evidence as a whole shows that the Owner’s normal course of trade is to sell audio-visual and smartphone products and accessories to retailers. Despite the discounted pricing, there is nothing in the evidence to suggest that this is not a *bona fide* sale in the normal course of trade. Indeed, in view of Ms. Hayashi’s statement that sales for each specific good exceeded \$5,000 during the relevant period, I accept that these single invoices for each are simply representative of sales in the normal course of trade.

[29] The Requesting Party further submits that, on the invoice for screen protectors in Exhibit O, the absence of the letters “IQ” from the product description represents an ambiguity which should be interpreted against the Owner. Granted, in contrast to all the other iQ-branded products referred to in the evidence, “iPhone 5/5s/5c Crystal Clear Scr Screen Protector” appears to be the only product listed on an invoice without the letters “IQ”. However, given a fair

reading of the evidence as a whole, this absence is irrelevant as I accept that the invoiced screen protector products were sold in packaging bearing the Mark, as depicted in Exhibit N.

[30] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “cases”, “interconnect cabling”, “power adaptors” and “screen protectors” within the meaning of sections 4 and 45 of the Act.

“Matrix approach” versus “removing deadwood”

[31] Lastly, the Requesting Party argues that the registered statement of goods is “somewhat convoluted” and needs to be understood as a listing of seven specific goods (“cases”, “docking stations”, “headphones”, “interconnect cabling”, “power adaptors”, “cleaners”, and “screen protectors”), each being an accessory for five different electronic devices (“music players”, “MP3 players”, “satellite radios”, “cell-phones”, and “portable music devices”). In total, as the Requesting Party submits, the Owner was therefore required to show use of the Mark in association with 35 individual goods [citing *John Labatt* at para 14].

[32] As such, the Requesting Party further submits that, even if the evidence shows use in association with the registered goods “interconnect cabling”, this would only account for use in connection with one of the specified electronic devices set out in the registration, but not in connection with multiple or all of the devices.

[33] In response, the Owner argues that such a “matrix approach” is contrary to the scope and purpose of section 45 expungement proceedings as well as contrary to well-established jurisprudence. It reiterates that a statement of goods must be granted a generous interpretation in a section 45 proceeding, which includes taking into consideration the context of the description of the goods [citing *Molson, supra*; *ConAgra, supra*; *Gowling Lafleur Henderson LLP v Liwayway Marketing Corporation*, 2015 TMOB 194; and the *Canadian Trademarks Examination Manual*].

[34] In any event, at the hearing, the Owner noted that at least three of its accessory goods, namely “headphones”, “power adaptors” and “interconnect cabling”, can be used with all five devices listed in the statement of goods. The Owner also pointed out that some of the evidenced

products clearly indicate on their packaging that such accessories were made for usage with a variety of devices.

[35] As noted above, it is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register [*Performance Apparel, supra*; see also *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD); and *Wolfville Holland Bakery Ltd v Canada (Registrar of Trademarks)*, 1964 CarswellNat 4, 42 CPR 88 (Ex Ct)].

[36] This “deadwood” metaphor is quite apt and helps to explain why the Requesting Party’s approach to the statement of goods is inappropriate. In this case, the proper approach can be illustrated by taking the “deadwood” metaphor a step further. Rather than reinterpret the statement of goods as a matrix, the more appropriate approach is to conceive of the first portion of the statement as the “trunk” of a tree, with the specified goods after the word “namely” constituting the “branches”. In this case, the trunk of the tree is “accessories for personal music players, MP3 players, satellite radios, cell-phones and portable music devices, but excluding any use in association with global positioning system (GPS) products” – this is the general category of goods, providing context and “support” for the seven branches that complete this particular statement of goods.

[37] In this metaphor, any “leaves” on the branches can represent evidence of use. As noted above, even a single invoice can be sufficient to show that a particular branch is alive and not “deadwood”. In contrast, of the seven branches in this case, the two branches for which there is no evidence of use are properly removed as deadwood, as discussed above (*i.e.*, docking stations and cleaners).

[38] Otherwise, in this case, no part of the trunk is deadwood. Each portion of the trunk serves to support, at least in part, one of the remaining five branches. For purposes of section 45, this is sufficient. In some cases, it may be that some portion of the trunk is itself deadwood and can be removed from the statement. However, removing deadwood from the trunk of a statement, while possible, should be done with caution. In this respect, depending on the phrasing and context of the statement of goods, parts of the trunk may actually function to

provide context and limit the scope of the statement, and any removal may inadvertently and inappropriately result in the broadening of the scope of the registered goods.

[39] Of course, this “removal of deadwood from a tree” metaphor is open to different interpretations and should not necessarily be rigidly considered as apt in all cases. Not all statements need to be visualized in this manner. For example, in *John Labatt, supra*, the statement of goods was “beer, ale, porter, stout, malt beverages, malt syrup and malt extracts”. Whether that statement was best interpreted as seven trees or seven branches, it remained that use had to be shown for seven specified goods.

[40] In this case, however, the metaphor helps to illustrate why the “matrix approach” is inappropriate. That approach would require the dissection of the trunk and perhaps the re-planting of the remains. Depending on the complexity of a particular statement of goods, this immediately begins to erode the concept of section 45 proceedings as “simple, summary, and expeditious”. Complexity issues aside, it would otherwise be inappropriate to apply a matrix approach and interpret the present statement of goods as seven individual “trees”. While the Requesting Party or one’s own sense of semantics might prefer that approach, this would disregard the statement of goods as set out in the registration.

[41] Had the Owner chosen to articulate its statement of goods as seven separate “trees” (*e.g.*, “(1) Accessories for personal music players, namely cases, headphones, [etc...]; (2) Accessories for MP3 players, namely [etc...]”), the evidentiary requirements and analysis would necessarily differ, and be more akin to that in *John Labatt*. However, the simple fact is that the Owner chose to articulate the statement of goods as it did. It is important to note that, through examination, this statement was assessed by the Registrar for compliance with section 30 of the Act. The application, including this statement, was then exposed to potential opposition upon advertisement. Having been registered as such, the Registrar must accept the statement of goods as articulated, notwithstanding that there may be a view that the statement is “better” or “more accurately” articulated in another manner. It is well established that the validity of the registration is not at issue in a section 45 proceeding. Furthermore, an approach that would result in dissection or re-articulation of the statement of goods would not only be contrary to

well-established jurisprudence, but it would also risk stepping on the Federal Court’s exclusive jurisdiction pursuant to section 57 of the Act.

[42] In this respect, the Federal Court of Appeal has clearly stated that “analyzing the wording of the registration and the general class to which some specifically identified [goods] are associated” lies beyond the scope of section 45 of the Act [*Omega SA v Ridout & Maybee LLP*, 2005 FCA 306 at para 3]. Where a trademark owner shows use of a trademark in a manner that falls within a general class listed in the statement of goods, the general class should be upheld [*Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248 (FC) citing *Omega, supra*; see also *Graduate Management Admissions Council v Attachmate Corp*, 2015 TMOB 224 at para 18]. Furthermore, it is well established that the Registrar does not have the authority to redefine or amend the goods for which use has been shown [see, for example, *Carter-Wallace Inc v Wampole Canada Inc* (2000), 8 CPR (4th) 30 (FCTD); *Scott Paper Co, Re*, 1997 CarswellNat 3231 (TMOB); *Gowling, Strathy & Henderson v Multibond Inc*, 2000 CarswellNat 2474 (TMOB); and *Sim & McBurney v Huit Diffusion, société anonyme*, 2009 CarswellNat 5039 (TMOB)].

[43] As a result, I consider the Requesting Party’s asserted approach to be contrary to the guidance of the aforementioned jurisprudence. In this case, it is neither necessary nor appropriate to multiply the seven accessories across the five identified devices in the statement of goods. Use must be shown with respect to the seven specified accessories, within the context of the general category as stated.

[44] In this case, while the “docking stations” and “cleaners” branches appear to have become deadwood, the Owner has submitted evidence representing the branches for “cases”, “headphones”, “interconnect cabling”, “power adaptors”, and “screen protectors”. Furthermore, I accept that no part of the trunk (being the five identified devices) is itself deadwood. In this respect, the Owner’s evidence – if not simply a fair reading of the statement of goods and the application of common sense – shows that, for example, “headphones” are an accessory that can be used with any of the identified devices. In other words, there is “life” through all parts of the trunk leading to each of the five remaining branches. Again, for purposes of this proceeding, this is sufficient.

[45] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with “Accessories for personal music players, MP3 players, satellite radios, cell-phones and portable music devices, but excluding any use in association with global positioning system (GPS) products, namely cases, ... headphones, interconnect cabling, power adaptors, and maintenance products, namely ... screen protectors” within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[46] 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 “docking stations for playing recorded music or for downloading and displaying digital pictures” and “cleaners (liquid, cloth and synthetic)” from the statement of goods.

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

Accessories for personal music players, MP3 players, satellite radios, cell-phones and portable music devices, but excluding any use in association with global positioning system (GPS) products, namely cases, headphones, interconnect cabling, power adaptors, and maintenance products, namely screen protectors.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2021-03-09

APPEARANCES

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