



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 118

Date of Decision: 2021-06-03

IN THE MATTER OF AN OPPOSITION

LG Electronics Inc.

Opponent

and

Samsung Electronics Co., Ltd.

Applicant

1,788,429 for SAMSUNG QLED

Application

INTRODUCTION

[1] LG Electronics Inc. (the Opponent) opposes registration of the trademark SAMSUNG QLED (the Mark), the subject of application No. 1,788,429 (the Application), that was filed by Samsung Electronics Co., Ltd. (the Applicant).

[2] Filed on June 23, 2016, the Application is based on proposed use of the Mark in Canada in association with the following goods (the Goods):

Television set; television receivers; display panel for television; monitors, namely, computer, television, video, and touchscreen monitors; television software, namely, software for the operation and control of quantum dots; mobile phone display screens; smart phones.

[3] The Application was advertised in the *Trademarks Journal* of March 29, 2017.

[4] The Opponent alleges that (i) the Mark is not registrable pursuant to section 12(1)(b) of the *Trademarks Act*, RSC 1985, c T-13 (the Act); and (ii) the Mark is not distinctive pursuant to section 2 of the Act. To provide some context to these grounds, in addition to its pleadings, the Opponent provides the following information in its statement of opposition:

- i) As the Applicant has stated in a pending proceeding in the European Union Intellectual Property Office, “[t]he abbreviation “QLED” is a generic term that has established itself as the internationally used designation for a particular [display] technology called ‘Quantum dot light-emitting diode’ or simply ‘Quantum dot LED’”; and
- ii) The QLED technology, as applied to display panels or screens for such things as television sets, monitors and mobile phones, means that each quantum-dot light emitting diode element in the panels or screens emits its own light. Such technology is considered to be the next generation of display technology because of its superiority over existing technologies such as LCD-LED technology. As a result of this superiority, the QLED technology has already gained wide public awareness and publicity, in Canada and elsewhere, in terms of the science behind such technology, its potential applications and its advantages over existing display technologies for consumer electronics.

[5] As a preliminary matter, I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[6] For the reasons that follow, I reject the opposition.

THE RECORD

[7] The Opponent filed its statement of opposition on August 15, 2017. The Applicant filed and served its counter statement on December 21, 2017, denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Joo Jeung Lee. The Applicant requested to cross-examine Mr. Lee on his affidavit. Mr. Lee however, did not attend cross-examination, and, as a result, it was communicated via letter from the Board that his affidavit would not be deemed to form part of the evidence in this opposition proceeding pursuant to Rule 44(5) of the *Trademarks Regulations*.

[9] The Applicant then advised by letter dated February 25, 2019 that it did not wish to submit Rule 42 evidence.

[10] Only the Applicant filed written representations.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities that the Application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. 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].

ANALYSIS

Section 12(1)(b) Ground of Opposition

[12] The Opponent has plead that the Mark is not registrable for use in association with the Applicant's goods pursuant to section 12(1)(b) of the Act because, having "regard to the above-noted wide public awareness of and publicity for the QLED technology among Canadians":

- a) To the extent that the Applicant has commenced use of the Applicant's Mark in Canada in association with some or all of the Applicant's Goods, ordinary consumers would be misled by the Applicant's Mark into believing that such goods are equipped with a display panel or screen to which QLED technology has been applied, when that is not the case. As a result, the Applicant's Mark is deceptively misdescriptive of the character or quality of the Applicant's Goods; and
- b) To the extent that the display panels or screens of the Applicant's Goods do eventually incorporate the QLED technology, the Applicant's Mark, when used in association with such goods, would be clearly descriptive of the character or quality of such goods, notwithstanding the reference to the Applicant's name in the Applicant's Mark.

[13] The material date under this ground of opposition is the filing date of the application, namely, June 23, 2016 [see *Fiesta Barbeques Ltd v General Housewares Corp*, 2003 FC 1021, 28 CPR (4th) 60].

[14] The purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment Ltd v Canada (Registrar of Trade-marks)* (1990), 34 CPR (3d) 154 (FCTD)].

[15] In deciding the issue as to whether the Mark is clearly descriptive, it must be considered from the point of view of the average purchaser of the associated goods. The Mark must be considered as a matter of first impression within the context of the goods to which it is associated [see *John Labatt Ltd v Carling Breweries Ltd* (1974), 18 CPR (2d) 15 at 19 (FCTD)].

“Character” means a feature, trait or characteristic of the goods and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 34]. These guiding principles to be applied when assessing whether a trademark is clearly descriptive have also been summarized in *Ontario Teachers' Pension Plan Board v Canada* 2012 FCA 60, 99 CPR (4th) 213 at para. 29.

[16] With respect to assessing whether a mark is deceptively misdescriptive, the proper test that needs to be applied is whether the deceptively misdescriptive words “so dominate the applied for trade-mark as a whole such that ... the trade-mark would thereby be precluded from registration” [see *Canadian Council of Professional Engineers v John Brooks Co* (2004), 35 CPR (4th) 507 (FC) at para 21; *Chocosuisse Union des Fabricants – Suisses de Chocolate v*

Hiram Walker & Sons Ltd (1983), 77 CPR (2d) 246 (TMOB); and *Lake Ontario Cement Ltd v Registrar of Trade-marks* (1976), 31 CPR (2d) 103 (FCTD)].

[17] An opponent's initial burden with respect to a section 12(1)(b) ground may be met simply by reference to the ordinary dictionary meaning of words in an applicant's mark [see *Flowers Canada/Fleurs Canada Inc v Maple Ridge Florist Ltd* (1998), 86 CPR (3d) 110 (TMOB)].

[18] In addition to the above principles, it has also been held that when assessing whether a trade-mark is clearly descriptive or deceptively misdescriptive under section 12(1)(b) of the Act, the Registrar must not only consider the evidence at their disposal, but must also apply common sense in the assessment of the facts [*Neptune SA v Attorney General of Canada* (2003), 29 CPR (4th) 497 (FCTD) at para 11].

[19] In the present case, the Opponent has not provided any evidence in support of this ground of opposition. It has only provided argument within its pleadings with respect to the meaning of the term QLED, as being a generic term meaning 'Quantum dot light-emitting diode' (or 'Quantum dot LED') which as applied to display panels or screens for such things as television sets [as in the Applicant's goods], means that each quantum dot light-emitting diode element in the panels or screens emits its own light.

[20] However, in the absence of evidence or a dictionary definition to support the Opponent's allegation, I agree with the Applicant that the Opponent has failed to meet its initial evidentiary burden under this ground. Even if I were to take judicial notice of the term, QLED, I would still conclude that the Opponent has failed to meet its initial burden, as section 12(1)(b) of the Act does not preclude descriptive terms, but clearly descriptive marks *as a whole*. The Mark as a whole is not clearly descriptive, being a combination of the terms SAMSUNG and QLED.

[21] As to whether the Mark as a whole is deceptively misdescriptive, again, for the reasons above, I find that the Opponent has failed to meet its initial evidential burden. Furthermore, there is no evidence that the Applicant's goods do not or would not incorporate QLED technology, nor does the term QLED, "so dominate" the Mark such that "as a whole that [the Mark] would thereby be precluded from registration" [see *Chocosuisse, supra*; and *Lake Ontario Cement, supra*].

[22] Consequently, the ground of opposition based on section 12(1)(b) of the Act is rejected.

Section 2 Ground of Opposition

[23] The Opponent has plead that the Mark, when used in association with the Applicant's goods, is not distinctive within the meaning of Section 2 of the Act because being clearly descriptive or deceptively misdescriptive of such goods, it neither distinguishes nor is adapted to distinguish such goods from those of others, notwithstanding the reference to the Applicant's name in the Mark.

[24] The material date under this ground of opposition is the date of filing of the statement of opposition, namely, August 15, 2017 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317 (FCTD)].

[25] When a non-distinctiveness ground of opposition is based on an allegation that a trademark is clearly descriptive or deceptively misdescriptive, it is sufficient for an opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support the non-distinctiveness ground of opposition exist.

[26] The difference in material date under this ground is immaterial; thus, I find again, for the reasons outlined in the section 12(1)(b) ground of opposition above, that the Opponent has failed to meet its evidential burden under this ground as well.

[27] Consequently, the ground of opposition based on section 2 of the Act is also rejected.

DISPOSITION

[28] 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(12) of the Act.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No hearing held.

AGENTS OF RECORD

Osler, Hoskin & Harcourt LLP

For the Opponent

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

For the Applicant