



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 246

Date of Decision: 2022-12-06

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Wenbo Zhang

Registered Owner: Avago Technologies International Sales PTE. Limited

Registration: TMA556,696 for BROADCOM

INTRODUCTION

[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. TMA556,696 for the trademark BROADCOM (the Mark) registered for use in association with the following goods (the Goods):

Computer hardware; integrated circuits; and software for controlling and using integrated circuits.

[2] For the reasons that follow, I conclude that the registration ought to be maintained.

THE PROCEEDING

[3] At the request of Wenbo Zhang (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on May 13, 2021 to the registered owner of the Mark, Avago Technologies International Sales PTE. Limited (the Owner).

[4] The notice required the Owner to show whether the Mark was used in Canada in association with each of the 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 13, 2018 to May 13, 2021 (the Relevant Period).

[5] The relevant definition of use in the present case is set out in section 4(1) of the Act as follows:

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] In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances [section 45(3) of the Act].

[7] In response to the Registrar's notice, the Owner furnished the Affidavit of Amanda Swaim, sworn on December 7, 2021, to which were attached Exhibits A and B.

[8] Only the Owner submitted written representations. No hearing was held.

THE EVIDENCE

[9] Amanda Swaim is the Senior IP Counsel for the Owner. She has access to all of the Owner's company records and is familiar with the history, sales and marketing of the Owner's products and services.

[10] Ms. Swaim states that the Owner, a subsidiary of Broadcom Inc., is a provider of hardware, software, enterprise and network security and semiconductors (including integrated circuits, chips and switches) to markets in Canada and worldwide.

[11] Ms. Swaim asserts that the Mark was used in Canada within the Relevant Period in the normal course of trade in association with the Goods by the Owner and / or its subsidiaries and / or its affiliates.

[12] Ms. Swaim explains that integrated circuits, which are also referred to as “chips”, are built on semiconductor material and encompass both hardware and software components and that switches are a type of integrated circuit or chip.

[13] Ms. Swaim provides, as Exhibit A, representative images depicting the way in which the Mark was displayed in association with the Goods in Canada during the Relevant Period.

[14] Exhibit A consists of product sheets for the following products: AFBR-S20N1N256 Qneo NIR Industrial USB Spectrometer; AFBR-S4E001 Optical Sensor Development Tool; BCM87842 transceiver with direct drive capability; and, BCM89571 Automotive Ethernet Switch. The product sheets contain images of the products each of which displays the Mark.

[15] Ms. Swaim states that the Goods displaying the Marks were sold in the Relevant Period to numerous customers in Canada such as Nokia Canada Inc.

[16] Ms. Swaim provides, as Exhibit B, representative copies of invoices and related datasheets for sales of the Goods in Canada by the Owner during the Relevant Period.

[17] Exhibit B consists of the following datasheets and invoices (each invoice is from the Owner and addressed to Nokia Canada Inc. in Kanata, Ontario and is dated within the Relevant Period):

- a. Datasheet for the BCM88790 self-routing switching element (with an image of the product displaying the Mark) and five invoices for the sale of the BCM88790;

- a. Datasheet for the BCM5345X ethernet switch and one invoice for the sale of the BCM5345X;
- b. Datasheet for the BCM88790 self-routing switching element (with an image of the product displaying the Mark) and two invoices for the sale of the BCM88790;
- c. Datasheet for the BCM81356 chip and five invoices for the sale of the BCM81356; and,
- d. Datasheet for the BCM81724 chip and two invoices for the sale of the BCM81724.

[18] Each datasheet and invoice in Exhibit B displays the Mark.

ANALYSIS AND REASONS FOR DECISION

[19] The purpose of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register. The evidence in a section 45 proceeding need not be perfect; indeed, the Owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[20] Given the technical nature of the products shown in the exhibits and the nature of the Goods, it would have been helpful to have more of an explanation from the Owner as to how the products correlate to each of the Goods. That said, while it is not for the Registrar to speculate as to the nature of the registered goods [*Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135], reasonable inferences can be made from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64].

[21] Given the evidence of Ms. Swaim, in particular her explanation as to the nature of integrated circuits, I am satisfied that the products shown in the exhibits correlate to and encompass each of the Goods.

[22] Further, I am satisfied, based on the invoices in Exhibit B, that the Goods were sold in Canada in the normal course of trade during the Relevant Period and that, based on the images in the exhibits, when the Goods were sold, the Mark was displayed on the Goods themselves.

[23] Accordingly, I am satisfied that the Mark was used in Canada by the Owner in association with the Goods during the Relevant Period within the meaning of sections 4(1) and 45 of the Act.

DISPOSITION

[24] 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 maintained.

Robert A. MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Bayo Odutola (OLLIP P.C.)

For the Registered Owner: Amy Croll (Origins IP)