



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 053

Date of Decision: 2023-03-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Alora Imports Inc.

Registered Owner: Hubbell Lighting, Inc.

Registration: TMA853,561 for ALERA LIGHTING

INTRODUCTION

[1] This is a decision in respect of a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA853,561, for the trademark ALERA LIGHTING (the Mark).

[2] The Mark is registered for use in association with lighting fixtures.

[3] In this proceeding, Hubbell Lighting, Inc. (the Owner) was required to show that the Mark was in use in Canada at any point during the three year period ending April 29, 2021 (the Relevant Period). For the reasons that follow, I conclude that the Owner has failed to show use, and that the registration ought to be expunged pursuant to section 45 of the Act.

THE PROCEEDING

[4] On April 29, 2021, at the request of Alora Imports Inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act to the Owner.

[5] The notice required the Owner to furnish evidence showing that the Mark had been used in Canada in association with lighting fixtures at any time within the Relevant Period. If the Mark had not been so used, the Owner was required to provide evidence demonstrating the date when the Mark was last in use and the reason for the absence of use since that date.

[6] The relevant definition of “use” 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.

[7] In response to the Registrar’s notice, the Owner submitted the affidavit of Prem Kumar, solemnly affirmed on November 23, 2021.

[8] Only the Requesting Party submitted written representations. A hearing was not requested.

THE EVIDENCE OF USE

[9] Mr. Kumar is the technical marketing manager of Hubbell Canada ULC (Hubbell Canada). Hubbell Canada is an “affiliated company” of an entity called Hubbell Incorporated. The Owner is a subsidiary of Hubbell Incorporated [Kumar Affidavit, para 1].

[10] Mr. Kumar states that the Owner is (among other things) “one of the largest manufacturers of residential lighting fixtures in North America”. The Owner’s lighting products are sold under various brand names, one of which is the Mark [para 5].

[11] In Canada, the Owner sells its products to agents, who then re-sell the products to installers and retailers [para 8]. In the ordinary course of the Owner's business, the Owner receives purchase orders from agents, and fulfills these purchase orders "through Hubbell Canada". Hubbell Canada ships the ordered product either directly to the installer or retailer, or to a destination designated by them [para 9].

[12] Mr. Kumar states that the Mark was "used" in Canada in association with the products "lighting fixtures" during the Relevant Period [para 12]. In support, he provides the following documentary evidence:

- samples of purchase orders received by the Owner from its agents during the Relevant Period, requesting goods for shipment to Canada [para 13 and Exhibit B];
- sample invoices issued by Hubbell Canada during the Relevant Period, for goods shipped to Canada [para 14 and Exhibit C]; and
- documents Mr. Kumar describes as "specification sheets", which bear the Mark and describe lighting fixture products having product numbers that correspond to those on the purchase orders and invoices [paras 13 and 14, and Exhibits B and C].

[13] The exhibited invoices do not display the Mark, and Mr. Kumar's affidavit does not state that the Mark appeared on any invoices. The documents described as "specification sheets" do display the Mark, however the evidence is silent as to whether these documents accompany the products at the time of transfer.

[14] In his affidavit, Mr. Kumar also refers to additional documents which he calls "product descriptions" [para 10] and "shipping documents" [para 14]. Mr. Kumar states that these documents accompany the goods when they are shipped to buyers. No samples of these documents are provided, and Mr. Kumar does not state whether the Mark appears on these documents.

[15] Mr. Kumar does not provide photographs or other visual representations of the lighting fixtures or their packaging that show the Mark applied to them. Mr. Kumar also does not state whether the Mark appears on the lighting fixtures or their packaging.

ANALYSIS AND REASONS FOR DECISION

[16] In this proceeding, the Owner bears the burden of demonstrating “use” in order to maintain the registration of the mark. This burden is not a stringent one. The Owner must only establish a *prima facie* case of use within the meaning of section 4 of the Act [*Brouillette Kosie Prince v Orange Cove-Sanger Citrus Association*, 2007 FC 1229 at para 7]. That being said, bare assertions of use are not sufficient to demonstrate use [*Plough (Canada) Ltd v Aerosol Fillers Inc*, 1980 CanLII 2739, 53 CPR (2d) 62 (FCA)]. Sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

Goods Were Transferred During the Relevant Period

[17] The definition of “use” in section 4 requires that a transfer of property in or possession of goods take place, in the ordinary course of trade.

[18] Exhibits B and C to Mr. Kumar’s affidavit include purchase orders for the purchase of certain products, and invoices to Canadian purchasers for the sale of said products. The products ordered and purchased are identified using part numbers that correspond to those of the lighting fixture products shown in the specification sheets, also in Exhibits B and C. On this basis, I am satisfied that sales of the lighting fixture products shown in the specification sheets took place in Canada, during the Relevant Period.

[19] The Requesting Party notes that the invoices in Exhibit C are issued by Hubbell Canada, not the Owner. The Requesting Party argues that Mr. Kumar’s statement that the Owner fulfills purchase orders “through Hubbell Canada” is not sufficiently clear to establish the existence of a licence between Hubbell Canada and the Owner, such that

use by Hubbell Canada would inure to the benefit of the Owner pursuant to section 50 of the Act [see Requesting Party's written representations at paras 19 to 26].

[20] In my view, when considering Mr. Kumar's affidavit as a whole, it is reasonably clear that the Owner manufactures the lighting fixture products in question, and Hubbell Canada resells them in Canada. Mr. Kumar has solemnly affirmed that the Owner is one of the largest *manufacturers* of residential lighting fixtures in North America [para 5], and that Hubbell Canada *sells* lighting products in Canada [para 7]. As well, purchase orders for the products are sent to the Owner, not Hubbell Canada. In view of the light evidential burden in proceedings under section 45 of the Act, the foregoing is sufficient to establish that the Owner is the source of the products, and Hubbell Canada is distributing the products in Canada. In such scenarios, trademark use inures to the benefit of the source of the goods, without the need for a licence [see *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 at 16-17 (FCTD)].

[21] The Requesting Party also argues that, because certain information in the sample invoices is redacted, such as the prices of the goods and the quantity sold, there is no way to determine if the Owner's sales were commercial transactions in the normal course of trade [Requesting Party's written representations, para 35]. I disagree. The evidence includes Mr. Kumar's solemn declaration that describes the Owner's ordinary course of business [para 9 of the Kumar Affidavit]. Furthermore, the documentary evidence of use includes purchase orders from the Owner's agents and invoices from Hubbell Canada, all of which is consistent with Mr. Kumar's description of the Owner's ordinary course of business. Given the light evidential burden in proceedings under section 45 of the Act, this evidence is sufficient to establish that the transactions shown occurred in the ordinary course of the Owner's business.

The Mark Was Not Associated With the Transferred Goods

[22] Section 4 of the Act requires that the Mark be associated with the goods in at least one of three ways:

- it is marked on the goods themselves;
- it is marked on the packaging in which the goods are distributed; or

- it is associated with the goods in any other manner such that notice of the association is given to the person to whom property or possession is transferred.

[23] The association between the Mark and the goods must be present at the time property in or possession of the goods is transferred.

[24] The Requesting Party argues that the evidence does not establish an association of the Mark with the goods, in any of the ways required by section 4 of the Act. In particular, the Requesting Party argues the following:

- there is no evidence that the Mark appears on the goods themselves, or the packaging in which they are distributed [Requesting Party's written representations, para 14];
- the evidence suggests that the Mark does not appear on the invoices provided to customers, and it is unclear when such invoices are provided to customers [para 15];
- Mr. Kumar's affidavit refers to types of documents that he describes as "product documentation", "shipping documents" and "specification sheets". The affidavit establishes that two of these types of documents accompany the goods upon shipment to the customer, and that the third type bears the Mark. However, the evidence does not establish that any one of these types of documents both accompany the goods and bear the Mark [paras 16 and 18].

[25] I agree with the Requesting Party's submissions in respect of the absence of association. There is nothing in either the text or exhibits of Mr. Kumar's affidavit that would suggest that the Mark is on the lighting fixtures themselves, or on the packaging in which they are distributed. As well, there is no evidence of any other form of association between the Mark and the goods that is present at the time of transfer of the goods to the buyer.

[26] The evidence does show that the Mark appears on documents Mr. Kumar describes as "specification sheets". Had these documents accompanied the goods upon transfer to their buyer, they may have constituted sufficient association of the Mark with

the goods. However, Mr. Kumar does not state that the “specification sheets” are provided with the goods upon transfer to their buyer. The omission of such a statement is notable, since Mr. Kumar does specifically state that other types of documents are provided with the goods upon transfer (namely, those described by Mr. Kumar as “product descriptions” and “shipping documents”). In this regard, the Requesting Party is correct to note that affidavits in section 45 proceedings must be considered from the perspective of what they do not say [*Plough (Canada) Ltd* at para 13].

[27] Accordingly, the evidence of record does not establish a *prima facie* case that the Mark was associated with the lighting fixtures sold by the Owner, at the time of transfer of property in or possession of the fixtures, as required by section 4 of the Act. For this reason, I find that the Owner has failed to meet its burden to show use of the Mark in Canada during the Relevant Period.

DISPOSITION

[28] 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 expunged.

Jaimie Bordman
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: Perley-Robertson, Hill & McDougall LLP

For the Registered Owner: Ridout & Maybee LLP