



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 057

Date of Decision: 2023-03-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Ronald S. Ade

Registered Owner: Federal Mogul Motorparts Corporation

Registration: TMA366,223 for CHAMPION & Design

INTRODUCTION

[1] This is a decision involving summary expungement proceedings under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA366,223 for the trademark CHAMPION & Design (the Mark), reproduced below.



[2] The statement of goods is reproduced below, together with the associated Nice classes (CI):

CI 1 (1) Detergent additives to gasoline or petrol; detergents for use in manufacturing processors; degreasing preparations for use in manufacturing processors; brake fluid; anti-freeze; anti-knock substances for internal combustion engines; fluids for hydraulic circuits; fuel-saving preparations; oil-purifying chemicals; acidulated water for re-charging batteries; anti-frothing solutions for batteries; liquids for removing sulphates from batteries; salts for galvanic batteries; distilled water; filtering materials being chemical preparations, mineral substances, vegetable substances, or unprocessed plastics, or ceramic materials in particulate form; silicone spray; chemical additives to fuels; lead substitutes for gasoline engines; transmission sealers and conditioners and radiator sealers and conditioners, being chemical additives; power steering fluid; marine gasoline or diesel fuel stabilizer; marine diesel fuel additives; marine engine lead substitute; air brake antifreeze and conditioner; diesel fuel chemical additive; diesel fuel smoke suppressor; diesel fuel-saving preparations.

CI 3 (2) Solvents for fuel injection and carburettor systems; windscreen cleaning fluids; windshield cleaning liquids; cleaning preparations namely hand cleaners; brake and electric parts cleaner; carburettor (*sic*) cleaner; carburettor and choke cleaner; engine cleaner and degreaser; fuel injection cleaner.

CI 4 (3) Marine multi-purpose lubricating spray; non-chemical additives to motor fuel; grease for belts; nonslipping preparations for belts; oils and greases; lubricants; general purpose lubricant spray; marine white lithium grease; marine lower unit lubricant; marine storage fogging oil; 2-cycle motor oil; marine multipurpose lubricating spray; penetrating oil and fuels.

[3] For the reasons that follow, I conclude that the registration ought to be amended.

PROCEEDING

[4] At the request of Ronald S. Ade (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on March 20, 2019, to Federal-Mogul Motorparts Corporation, the registered owner of the Mark at the time.

[5] I note that the Registrar updated the subject registration to record a change of name from the registered owner to Federal-Mogul Motorparts LLC (the Owner) on November 8, 2019, with an effective date of April 12, 2017. This change of name is not an issue in this proceeding.

[6] The notice required the Owner to show whether the Mark was used 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 March 20, 2016 to March 20, 2019.

[7] The relevant definition of “use” in the present case 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.

[8] Where the owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[9] In response to the Registrar’s notice, the Owner furnished the affidavit of Rebecca Mahan, sworn on October 21, 2019, to which were attached Exhibits A1 to C2. Only the Owner submitted written representations and was represented at an oral hearing.

[10] The Owner filed separate but similar affidavits and written representations in the section 45 proceedings involving Registration No. TMA754,289 for the trademark CHAMPION, and Registration No. TMA694,862 for the trademark CHAMPION & bow tie Design. These proceedings are the subject of separate decisions.

EVIDENCE

[11] In her affidavit, Ms. Mahan states that she has been the Owner’s Marketing Communications Director since February 2018 and that she previously held the position of Global Brand Manager. She also states that the Owner provides vehicle manufacturers and customers in the automotive after-market business with maintenance, service and performance enhancing parts and products. The Owner also supplies parts and supplies for small engine applications including lawn and garden equipment [paras 1 to 3].

[12] Ms. Mahan attests that the Owner has used the Mark in association with “*chemical additives to fuels; carburettor cleaner, fuel injection cleaner, oils and greases; lubricants; 2-cycle motor oil*” (the Goods). In this respect, Ms. Mahan states that the Owner sold lawnmower maintenance kits (the Kits) containing the Goods and other items to consumers in Canada during the relevant period [para 8].

[13] Ms. Mahan explains that the Kits include a sparkplug, an air filter, a 594 ml bottle of lawnmower oil and a 74 ml bottle of fuel stabilizer. She also explains that the Kit’s plastic packaging can be used as an oil funnel and drain pan. She describes the fuel stabilizer as a chemical additive that, when added to fuel, prevents the oxidization and degradation of the fuel which can occur when the fuel sits in an engine for an extended period of time. According to Ms. Mahan, the Owner’s fuel stabilizer cleans carburetors and fuel injectors and also serves to assist in engine starting after periods of inactivity [paras 8 to 9, 16 and 21].

[14] In support to her statements concerning the Goods, Ms. Mahan provides three photographs of one Kit including the packaging and components thereof [Exhibits A.1 and A.2], two photographs of the lawnmower oil bottle included in the Kit shown in Exhibits A.1 and A.2 [Exhibit A.3], and one photograph of the fuel stabilizer bottle also included in the Kit [Exhibit A.4]. Ms. Mahan states that the photographs are representative of the Kits and components thereof sold by the Owner in Canada during the relevant period [paras 9 to 15]. I note that a variation of the Mark is displayed on the front and back of the Kit’s packaging and on the bottles of lawnmower oil and fuel stabilizer.

[15] Ms. Mahan states that the Kits were sold through authorized distributors and retailers, as well as on the sites of various Canadian hardware and automotive parts retailers. In particular, she states that the Owner sold around 3,100 Kits for nearly USD 20,000.00 in Canada during the relevant period [para 20].

[16] As further support of sales during the relevant period, Ms. Mahan provides three copies of invoices issued by the Owner to distributors and retailers in Canada between June 2016 and May 2018 showing sales of the Kits [Exhibits B.1 to B3]. Ms. Mahan

confirms that the items identified with part numbers in the invoices are the Kits shown in exhibits A.1 to A.4 [paras 16 to 19].

PRELIMINARY REMARK: THE OWNER'S CONCESSION

[17] At the hearing, the counsel for the Owner conceded that the evidence is limited to the Goods indicated at paragraph 8 of the Mahan affidavit. As for the remaining goods specified in the registration, the evidence is silent with respect to use or any special circumstance excusing the absence of use of the Mark in association with them. Consequently, the registration will be amended to delete the following goods:

CI 1 (1) Detergent additives to gasoline or petrol; detergents for use in manufacturing processors; degreasing preparations for use in manufacturing processors; brake fluid; anti-freeze; anti-knock substances for internal combustion engines; fluids for hydraulic circuits; fuel-saving preparations; oil-purifying chemicals; acidulated water for re-charging batteries; anti-frothing solutions for batteries; liquids for removing sulphates from batteries; salts for galvanic batteries; distilled water; filtering materials being chemical preparations, mineral substances, vegetable substances, or unprocessed plastics, or ceramic materials in particulate form; silicone spray; [...] lead substitutes for gasoline engines; transmission sealers and conditioners and radiator sealers and conditioners, being chemical additives; power steering fluid; marine gasoline or diesel fuel stabilizer; marine diesel fuel additives; marine engine lead substitute; air brake antifreeze and conditioner; diesel fuel chemical additive; diesel fuel smoke suppressor; diesel fuel-saving preparations.

CI 3 (2) Solvents for fuel injection and carburettor systems; windscreen cleaning fluids; windshield cleaning liquids; cleaning preparations namely hand cleaners; brake and electric parts cleaner; [...] carburettor and choke cleaner; engine cleaner and degreaser; [...].

CI 4 (3) Marine multi-purpose lubricating spray; non-chemical additives to motor fuel; grease for belts; nonslipping (sic) preparations for belts; [...] general purpose lubricant spray; marine white lithium grease; marine lower unit lubricant; marine storage fogging oil; [...] marine multipurpose lubricating spray; penetrating oil and fuels.

PRELIMINARY REMARK: THE TRADEMARK IN EVIDENCE

[18] I reproduce below the manner in which the Mark appears throughout the evidence along with the Mark:



[19] In comparing the logo in evidence with the Mark, I find that the Mark did not lose its identity and remains recognizable. In my view, the vertical line dividing the rectangle do not change the identity of the Mark; the dominant feature of the Mark, being the word CHAMPION, is preserved. Furthermore, the ® symbol merely provides the message that certain portions of the Mark, namely, the word CHAMPION, is also a trademark on its own [for similar findings see *Aramark Canada Ltd v 637870 Ontario Ltd* (2002), 22 CPR (4th) 409 (TMOB) and *Barrette Legal inc v Casella Wines Pty Ltd.*, 2015 TMOB 206]. Thus, I find the variation shown throughout the evidence to constitute display of the Mark as registered for the purpose of this proceeding [see *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltée v Munsingwear Inc*, 1992 CanLII 12831, 44 CPR (3d) 59 (FCA); and *Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc*, 2016 FCA 265].

[20] Therefore, the sole issue to consider in this proceeding is whether, pursuant to section 4(1) of the Act, the evidence demonstrates use of the Mark in association with the Goods.

REASONS FOR DECISION

[21] In assessing the evidence, I have kept in mind that evidence in a section 45 proceeding must be considered as a whole [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB) at para 10] and that a registered 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 [per *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9].

[22] In the present case, Ms. Mahan correlates the Kit's components, and specifically the oil and fuel additive, with the Goods. With respect to the oil, in view of her correlation and the Owner's business, I find that the oil in evidence reasonably corresponds to "greases", "lubricants" and to "2-cycle motor oil". As for the fuel

stabilizer, I find that the Owner has provided sufficient facts from which I can conclude that its function and nature is such that the remaining Goods can be maintained. Indeed, Ms. Mahan describes the fuel stabilizer as both a cleaner and a chemical additive to be added to fuel, and confirms that its functions are to clean carburetors and fuel injectors and also to assist in starting the engine. In this respect, it has been established that an affiant's statements are to be accepted at face value and 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]. Therefore, I accept that the oil and the fuel stabilizer shown in Exhibits A1 to A4 correlate to the Goods.

[23] Further, in view of the invoices in evidence, I am satisfied that the Goods were transferred in the Owner's normal course of trade to its distributors and retailers in Canada during the relevant period. Moreover, based on the representative photographs in evidence, I am satisfied the Mark was displayed on the Goods themselves when they were sold.

[24] 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

[25] 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 goods:

CI 1 (1) Detergent additives to gasoline or petrol; detergents for use in manufacturing processors; degreasing preparations for use in manufacturing processors; brake fluid; anti-freeze; anti-knock substances for internal combustion engines; fluids for hydraulic circuits; fuel-saving preparations; oil-purifying chemicals; acidulated water for re-charging batteries; anti-frothing solutions for batteries; liquids for removing sulphates from batteries; salts for galvanic batteries; distilled water; filtering materials being chemical preparations, mineral substances, vegetable substances, or unprocessed plastics, or ceramic materials in particulate form; silicone spray; [...] lead substitutes for gasoline engines; transmission sealers and conditioners and radiator sealers and conditioners, being chemical additives; power steering fluid; marine gasoline or diesel fuel stabilizer; marine diesel fuel additives; marine engine lead substitute; air brake

antifreeze and conditioner; diesel fuel chemical additive; diesel fuel smoke suppressor; diesel fuel-saving preparations.

CI 3 (2) Solvents for fuel injection and carburettor systems; windscreen cleaning fluids; windshield cleaning liquids; cleaning preparations namely hand cleaners; brake and electric parts cleaner; [...] ; carburettor and choke cleaner; engine cleaner and degreaser; [...].

CI 4 (3) Marine multi-purpose lubricating spray; non-chemical additives to motor fuel; grease for belts; nonslipping preparations for belts; [...] general purpose lubricant spray; marine white lithium grease; marine lower unit lubricant; marine storage fogging oil; [...] marine multipurpose lubricating spray; penetrating oil and fuels.

[26] Consequently, the amended statement of goods will read as follows:

CI 1 (1) Chemical additives to fuels.

CI 3 (2) Carburettor cleaner; fuel injection cleaner.

CI 4 (3) Oils and greases; lubricants; 2-cycle motor oil.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-03-08

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Erin Creber

AGENTS OF RECORD

For the Requesting Party: Ronald S. Ade

For the Registered Owner: Gowling WLG (Canada) LLP