



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 146

**Date of Decision:** 2023-08-21

## **IN THE MATTER OF A SECTION 45 PROCEEDING**

**Requesting Party:** Fasken Martineau Dumoulin LLP

**Registered Owner:** Schneider Electric SE

**Registration:** TMA855404 for ECOSTRUXURE

### **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 8, 2020, to Schneider Electric SE (the Owner), the registered owner of registration No. TMA855404 for the trademark ECOSTRUXURE (the Mark).

[2] The Mark is registered for use in association with the goods and services listed below. For purposes of this decision, and reflecting the evidence submitted by the Owner, the goods and services have been organized into the 14 groups indicated:

*Goods:*

Group 1: Software for management, availability, reliability and optimization of electric

power in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes;

Group 2: software for improving energy efficiency and energy sustainability in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes;

Group 3: software for process management, security management, access control, video surveillance in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes;

Group 4: control, measurement, monitoring and supervision systems, namely video monitors, electronic computers, electric presence, fault current, pressure, pollutant and temperature sensors, electrical controlling devices, namely electrical power consumption controllers, electric switches, electric actuators, electric regulators, protection relays, electric converters, electric control panels, computer interface boards and electric power supplies for management, availability, reliability and optimization of electric power in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes;

Group 5: control, measurement, monitoring and supervision systems, namely video monitors, electronic computers, electric presence, fault current, pressure, pollutant and temperature sensors, electrical controlling devices, namely electrical power consumption controllers, electric switches, electric actuators, electric regulators, protection relays, electric converters, electric control panels, computer interface boards and electric power supplies for improving energy efficiency and energy sustainability in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes;

Group 6: control, measurement, monitoring and supervision systems, namely video monitors, electronic computers, electric presence, fault current, pressure, pollutant and temperature sensors, electrical controlling devices, namely electrical power consumption controllers, electric switches, electric actuators, electric regulators, protection relays, electric converters, electric control panels, computer interface boards and electric power supplies for process management, security management, access control, video surveillance in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes;

Group 7: internet and intranet servers for providing data and software applied to energy efficiency, to energy sustainability and to management, availability, reliability and optimization of electric power;

Group 8: internet and intranet servers for providing data and software applied to process management, to security management, to access control and to video surveillance;

Group 9: databases in the fields of power management, process management and security management in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes.

*Services:*

Group 10: Setting up of electric and electronic apparatus, maintenance and repair services.

Group 11: Design, development, analyse, consultancy, measurement, monitoring services in the field of management, availability, reliability and optimization of electric power in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes;

Group 12: design, development, analyse, consultancy, measurement, monitoring services in the fields of energy efficiency and energy sustainability in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes;

Group 13: design, development, analyse, consultancy, measurement, monitoring services in the field of process management in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes;

Group 14: design, development, analyse, consultancy, measurement, monitoring services in the fields of security management, access control, video surveillance in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes.

[3] The notice required the Owner to show whether the Mark was used in Canada in association with the goods and services 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 use since that date. In this case, the relevant period for showing use is December 8, 2017 to December 8, 2020.

[4] The relevant definitions of use are 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.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

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

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Alessandro DeLuca, sworn on November 8, 2021 (the DeLuca Affidavit).

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

[8] The hearing was held jointly with respect to the summary cancellation proceeding for registration No. TMA855401 for the trademark EcoStruxure (& DESIGN) (the Design Mark). Although the same evidence was furnished, a separate decision will be issued with respect to that proceeding.

### **THE OWNER'S EVIDENCE**

[9] I first note that the DeLuca Affidavit is unusually lengthy for a section 45 proceeding, consisting of a 53-page affidavit together with 38 exhibits spanning an additional 225 pages.

[10] Mr. DeLuca is the Global Director of Trademark and Brand Protection Services at Schneider Electric USA, Inc., a company affiliated with the Owner [paras 1 and 2].

[11] He states that the Owner is a multinational company "providing energy and automation products, services, software and digital solutions for efficiency and sustainability", explaining that, in Canada during the relevant period, the Owner developed and sold "a variety of products, technologies, software and services in the fields of energy management infrastructure improvements and modernization, industrial automation, energy and sustainability for homes, buildings, data centers, infrastructure, and industries" [para 5]. He asserts use of the Mark during the relevant period in Canada in association with all of the registered goods and services, confirming that the Owner maintained the requisite control with respect to any goods and services offered by the Owner's affiliate companies [paras 6 to 8].

[12] Mr. DeLuca explains that, since at least 2017, the Mark and the Design Mark have been the "overarching" brand for the Owner's Canadian product and service

offerings, which are “modular and interoperable across the platforms and industries” that the Owner services [para 9]. He describes the EcoStruxure goods and services as being based on “internet of things” (IoT) technology, which he identifies as “a network of physical objects embedded with sensors, software and other technologies for the purpose of connecting and exchanging data with other devices and systems via the internet and/or an online global communications network” [para 13]. As such, he attests that, throughout the relevant period, the Owner’s EcoStruxure goods and services have been an “IoT enabled, open, interoperable architecture and platform which can be applied to a variety of industries and technologies to improve businesses’ safety, reliability, efficiency, sustainability, operations managements, productivity, and connectivity”, offered to Canadian consumers under a variety of different product and service offerings [paras 13 and 14].

[13] Mr. DeLuca identifies various branded “solutions” through which the Owner offers the EcoStruxure goods and services, explaining that many such solutions “encompass both a good and a service” [paras 15 and 16], and further that some solutions have more than one primary purpose and are often interoperable and combined together [para 17].

[14] Mr. DeLuca asserts that the total value of Canadian sales of the Owner’s EcoStruxure goods and services was over \$80 million annually during the relevant period [para 19]. He identifies the Owner’s online ordering tool, the iPortal, as one channel through which the Owner sold its EcoStruxure goods and services in Canada during the relevant period [para 20, Exhibit F]. In particular, he notes that the EcoStruxure trademarks were visible on the iPortal when adding and purchasing items.

[15] Although Mr. DeLuca’s affidavit is otherwise generally structured to address each of the relevant groups of goods and services in turn, in view of the Requesting Party’s frequently-repeated submission throughout its written representations that portions of the affidavit should be “disregarded”, I consider it worthwhile to note that, in a section 45 proceeding, sworn statements made in an affidavit must be accorded substantial credibility [*Ogilvy Renault v Compania Roca-Radiadores SA*, 2008 CarswellNat 776

(TMOB)] and the evidence as a whole must be considered, such that focusing on individual pieces of evidence is not the correct approach [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)].

[16] Furthermore, as I consider display of the Design Mark to constitute display of the Mark, references to the Mark below include displays in design form.

## **GOODS - ANALYSIS**

### ***Software Goods***

[17] With respect to the Group 1 software goods, Mr. DeLuca identifies the Owner's "EcoStruxure Power Advisor" as one example of such software goods sold in Canada during the relevant period [para 21]. He explains the purpose and functionality of the EcoStruxure Power Advisor software and gives examples of how the Mark was displayed in association with such software [paras 23 to 26]. He also confirms that this software was sold in Canada during the relevant period, providing representative invoices from July and September 2019 [para 26, Exhibit G].

[18] Mr. DeLuca also identifies the Owner's "EcoStruxure Asset Advisor" as another example of a software solution that correlates with the Group 1 software goods [para 27]. Again, he describes the purpose and functionality of this software [paras 28 and 29], how the Mark was displayed when customers used the software [paras 30 and 31], and a representative invoice from the relevant period, showing sales of various products including the EcoStruxure Asset Advisor product [para 33, Exhibit H]. In addition, Mr. DeLuca explains that the application has been available for download in Canada since November 2018, and provides a representative screenshot of the download page for the application [para 32]. I note that the Mark is displayed in the thumbnail image that forms part of the screenshot.

[19] I agree with the Owner that even if other trademarks are displayed in the course of a consumer's interaction with the Owner's software, considering the evidence as a whole, the display of the Mark on a "splash page" is sufficient to associate the Mark with

such software, given the nature of the Owner's software and Mr. DeLuca's explanation of same in this case.

[20] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the Group 1 goods within the meaning of sections 4 and 45 of the Act.

[21] Mr. DeLuca provides similar evidence for the Group 2 software goods (in relation to the Owner's "EcoStruxure IT Advisor" software application) [paras 34 to 39, Exhibit I], and the Group 3 software goods (in relation to the Owner's "EcoStruxure Data Center Expert software) [paras 40 to 43, Exhibit J].

[22] Accordingly, I am satisfied that the Owner has also demonstrated use of the Mark in association with the Group 2 and Group 3 goods within the meaning of sections 4 and 45 of the Act.

### ***Systems Goods***

[23] Mr. DeLuca addresses the Group 4 "systems" goods at paragraphs 44 to 50 of his affidavit. With respect to such "systems", Mr. DeLuca explains that the Owner's product offerings "include the provision of EcoStruxure systems which may include a complementary series of goods built around an EcoStruxure sub-branded product" [para 44]. He identifies the "EcoStruxure Power Monitoring Expert" (the PME system) as one example of a system that correlates to the Group 4 goods. He explains the purpose, functionality, and use of the PME system, e.g., that with its "open, scalable architecture", the PME system "connects to smart devices across the [customer's] electrical system ... and integrates with process control systems and many other enterprise platforms" [para 46]. He further explains that the PME system has various uses, including giving customers the ability "to track key performance indicators for energy and reliability" or to "apply advanced power quality analysis to ensure reliable network operation, equipment performance, and reduced network outages" [para 46]. At paragraph 47 of his affidavit, Mr. DeLuca provides a graphic from a guide that illustrates the components of the PME system [para 47; also Exhibit K].

[24] In this case, the correlation between the evidence and the “systems” good as registered is problematic at best. In this respect, it is useful to consider the guidance at section 2.4.5.7 of the *Goods and Services Manual*:

Goods including the term “systems” may be acceptable if the goods are reasonably understood in the trade to be a recognized set of items that is often sold as one complete unit, such as “suspension systems for motor vehicles”, which are specific ordinary commercial terms for the system of springs, shock absorbers and linkages that connect a motor vehicle to its wheels.

[25] In this case, rather than being static systems with “a recognized set of items”, the Owner’s systems “solutions” appear to be modular and variable, depending on customer needs. As such, while the Group 4 goods may have been superficially articulated to meet the requirements of the Act in terms of ordinary commercial terms and specificity, they do not actually correlate with the Owner’s evidenced business model or how the Owner’s systems or components thereof were actually sold during the relevant period. Such offerings through, for example, the Owner’s iPortal, were modular and variable; they were not static such that any product(s) sold necessarily correlates to the “systems” goods as articulated in the registration, being a defined set of components.

[26] Furthermore, this appears to be a case where the systems-related software solutions were associated with the Mark, but not necessarily the components of the systems themselves. Such components may or may not have even been installed at the time of transfer of the EcoStruxure software, and there is at best no clear evidence that all such components would have been associated with the Mark. In this respect, I agree with the Requesting Party that the statement of goods has been articulated in a very specific manner such that it is susceptible to partial expungement, as the evidence does not show transfers and/or use of the Mark in association with each of the component parts of these “system” goods. The aforementioned graphic is in part illustrative of this issue, as it identifies certain components as being “3rd party”, such that it is unclear whether the Mark would be associated with these third-party components. As discussed at the hearing, connecting EcoStruxure software with a pre-owned device does not transform that device into an “EcoStruxure” device/system component.



[27] For both these reasons, the evidence is at best not clear as to whether any PME systems or other products sold during the relevant period actually correlate to the Group 4 goods as articulated in the registration.

[28] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the Group 4 goods within the meaning of sections 4 and 45 of the Act.

[29] The Group 5 goods are addressed at paragraph 51 to 55 of the affidavit, in relation to the Owner's "EcoStruxure Data Center Expert solution". Again, however, this "open and flexible system" [para 52] does not appear to correlate to the Group 5 "systems" goods as articulated in the registration.

[30] Accordingly, I am not satisfied that the Owner has demonstrated use of the Mark in association with the Group 5 goods within the meaning of sections 4 and 45 of the Act.

[31] Similarly, although Mr. DeLuca attempts to correlate the Group 6 goods with the Owner's "EcoStruxure Building" product [paras 56 to 63], the evidence fundamentally does not correlate with such "systems" goods as articulated in the registration. In this respect, again, it is worth noting that the "architecture" graphic included at paragraph 58 of the affidavit identifies several "Third-Party Connected Products" that form part of such systems. As such, it is at best not clear that the Owner sold systems that correlate with the Group 6 goods as registered, or that all of the components would necessarily have been associated with the Mark in any event.

[32] In view of the foregoing, I am also not satisfied that the Owner has demonstrated use of the Mark in association with the Group 6 goods within the meaning of sections 4 and 45 of the Act.

### ***Servers Goods***

[33] With respect to the Group 7 "servers" goods, Mr. DeLuca explains that, in the Owner's industry, a "server" is something that stores, circulates, processes, and

exchanges data between networked devices and provides functionality to other programs, and can be either hardware or software [para 64]. As such, he correlates the Group 7 goods with the Owner's "EcoStruxure OPC UA Server Expert" product and further explains its functioning, how the Mark was displayed to customers, and provides a representative invoice from the relevant period [paras 65 to 68].

[34] In view of such evidence, I am satisfied that the Owner has demonstrated use of the Mark in association with the Group 7 goods within the meaning of sections 4 and 45 of the Act.

[35] With respect to the Group 8 "servers" goods, Mr. DeLuca provides similar evidence at paragraphs 69 to 75 of his affidavit (in relation to the Owner's "EcoStruxure Building Advisor" software).

[36] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the Group 8 goods within the meaning of sections 4 and 45 of the Act.

### ***Databases Goods***

[37] The Group 9 "databases" goods are addressed at paragraphs 76 to 79 of the affidavit. Mr. DeLuca identifies an example product through which customers access relevant databases (the "EcoStruxure Data Center Operation" software), explains the use and functionality of that software, how the Mark was displayed to customers, and gives representative evidence of a sale and transfer of such product during the relevant period [Exhibit R].

[38] Accordingly, I am satisfied that the Owner has demonstrated use of the Mark in association with the Group 9 goods within the meaning of sections 4 and 45 of the Act.

### **SERVICES - ANALYSIS**

[39] With respect to the services generally, Mr. DeLuca attests that, during the relevant period, the Owner displayed the Mark throughout its Canadian website *se.com/ca/en* to advertise its EcoStruxure services in Canada [paras 80 to 84, Exhibits S and T], as well as via YouTube videos [paras 85 and 86, Exhibit V].

[40] Mr. DeLuca explains that the Owner “works with customers to create customized solutions using the EcoStruxure product line, from analysis and design, to customization, implementation and ongoing services throughout the lifecycle of the customer project” [para 87]. He gives an example of working with the Port of Montreal to help them design a “ship-to-shore power solution that would help the Port tackle the challenge of ship emissions” [para 88], and gives details regarding that project and how the implementation of this project helped to further advertise the Owner’s EcoStruxure services via, for example, YouTube videos about the project [paras 89 and 90, Exhibits W and X].

[41] Despite the Requesting Party’s submissions, in the context of the evidence as a whole, I do not consider it reasonable to conclude that such advertisements and webpages – which Mr. DeLuca confirms were accessible over a period of years in the form as exhibited – were never accessed by customers or potential customers. While the evidence in this case is not perfect, in this respect, at least, I do not consider it reasonable to infer that such advertisements and webpages were never seen by customers or potential customers in Canada, in particular given the scope and volume of sales of the EcoStruxure products and services during the relevant period.

[42] With respect to the Group 10 services, Mr. DeLuca confirms that the Owner displayed the EcoStruxure trademarks in Canada during the relevant period in the performance and advertisement of “setting up of electric and electronic apparatus, maintenance and repair services” [paras 91]. Regarding advertisement, he correlates such services with those advertised via YouTube videos [paras 92, 97 and 98] and menu options on the Owner’s website [paras 93 to 96]. Regarding performance, he provides representative invoices from the relevant period, and identifies certain line items as correlating with these services, such as “assembly and scheduled assembly services for various parts” [paras 99 and 100, Exhibits M and CC].

[43] The Group 11 services are addressed at paragraphs 101 to 108 of the affidavit. Again, Mr. DeLuca confirms performance and advertisement, gives an example product correlating with such services (the abovementioned EcoStruxure Power Advisor),

examples of advertisement and performance in association with the EcoStruxure trademarks [Exhibits DD to FF], and representative invoices [Exhibit G].

[44] Similar evidence is provided at paragraphs 109 to 117 with respect to the Group 12 services; at paragraphs 118 to 124 with respect to the Group 13 services; and at paragraphs 125 to 131 with respect to the Group 14 services.

[45] Although the Requesting Party objected to Mr. DeLuca's reference to and reliance on the same products in some instances to evidence different groups of goods and services, such objection is without merit in this case. For example, software with multiple functions will potentially correlate with multiple services; in my view, Mr. DeLuca adequately identifies the nature of the Owner's products and their functionality to establish the necessary correlation with respect to each of the services for purposes of this proceeding.

[46] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with all of the services as registered within the meaning of sections 4 and 45 of the Act.

### **DISPOSITION**

[47] 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 the above-defined Group 4, Group 5 and Group 6 goods. The amended statement of goods and services will be as follows:

#### *Goods:*

Software for management, availability, reliability and optimization of electric power in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes; software for improving energy efficiency and energy sustainability in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes; software for process management, security management, access control, video surveillance in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes; internet and intranet servers for providing data and software applied to energy efficiency, to energy sustainability and to management, availability, reliability and optimization of electric power; internet and intranet servers for providing data and software applied to process management, to security management, to access control and to video surveillance; databases in the fields of power management, process

management and security management in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes.

*Services:*

Setting up of electric and electronic apparatus, maintenance and repair services. Design, development, analyse, consultancy, measurement, monitoring services in the field of management, availability, reliability and optimization of electric power in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes; design, development, analyse, consultancy, measurement, monitoring services in the fields of energy efficiency and energy sustainability in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes; design, development, analyse, consultancy, measurement, monitoring services in the field of process management in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes; design, development, analyse, consultancy, measurement, monitoring services in the fields of security management, access control, video surveillance in industrial, tertiary and residential buildings, in infrastructures and data centres, in industrial machines and processes.

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Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2023-05-24

## **APPEARANCES**

**For the Requesting Party:** Eliane Ellbogen

**For the Registered Owner:** Mark Biernacki

## **AGENTS OF RECORD**

**For the Requesting Party:** Fasken Martineau Dumoulin LLP

**For the Registered Owner:** Smart & Biggar LP