



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2024 TMOB 032

**Date of Decision:** 2024-02-26

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

**Requesting Party:** Lutron Electronics Co., Inc.

**Registered Owner:** Limbic Media Corporation

**Registration:** TMA422,724 for AURORA

### **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. TMA422,724 for the trademark AURORA (the Mark), owned by Limbic Media Corporation (the Owner).

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

### **THE RECORD**

[3] At the request of Lutron Electronics Co., Inc. (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on September 21, 2021. The notice required the Owner to show whether the Mark had been used in Canada in association with 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 use since that date. In this case, the relevant period for showing use is September 21, 2018, to September 21, 2021.

[4] The Mark is registered for use in association with the goods “Electric lighting fixtures.”

[5] 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.

[6] It is well accepted that the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. However, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with the goods specified in the registration during the relevant period.

[7] In response to the Registrar’s notice, the Owner furnished the statutory declaration of Justin Love, the CEO of the Owner, declared on April 19, 2022. Both parties filed written representations; no oral hearing was held.

## **EVIDENCE**

[8] Mr. Love attaches the following exhibits to his statutory declaration:

- Exhibit A: screenshots of webpages from the Owner’s website *limbicmedia.ca/aurora*, taken from the Internet Archive at *archive.org* dated April 25, 2019. Mr. Love confirms that these webpages existed for the Owner’s customers and potential customers during the relevant period. The

pages display the Mark and refer to “A unique plug-and-play technology that transforms traditional lighting displays into interactive experiences”. The page includes a heading for “Lights”, which refers to “A variety of light fixtures available including large globes, 360 lights, tubes”.

- Exhibit B: screenshots from *limbicmedia.ca* captured on October 5, 2021. Mr. Love confirms that these show the webpages as they appeared prior to the end of the relevant period. Among the products listed on these pages are the “Singing Tree”, “Canopy”, and “Aurora Chandelier”. Mr. Love states that all of these products are electrical lighting fixtures, and “were sold by the registered owner under that trademark” during the relevant period.
- Exhibit C: screenshots from *limbicmedia.ca* captured on December 20, 2021. Mr. Love confirms that these show the webpages as they appeared prior to the end of the relevant period. The screenshots show a number of products, including the chandelier referenced in the Exhibit B screenshots. I note that the copy quality of the screenshots is poor; while I accept that certain pictures show light fixtures, it is not clear how, if at all, the Mark was displayed on any of these products.

## **ANALYSIS**

[9] In its written representations, the Requesting Party notes that Mr. Love does not explain how long he has held his position or identify the basis of his knowledge of the facts in the declaration. However, given the Mr. Love’s position within the Owner, I accept that he would have knowledge of the Owner’s activities, and I therefore accept his statements at face value [for a similar conclusion, see *Bereskin & Parr v Mövenpick-Holding* (2008), 73 CPR (4th) 28 (TMOB)]. Similarly, although the Requesting Party observes that some of the screenshots originate from the third party website *archive.org*, such evidence has been held to be reliable by the Registrar in the past [see *ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056, affirmed 2005 FCA 96].

[10] However, I agree with the Requesting Party that the Love declaration does not show that the Owner’s goods were transferred in the normal course of trade in Canada during the relevant period. To show use within the meaning of section 4(1) of the Act, it

is necessary for an owner to provide evidence *demonstrating* sales of the goods in the normal course of trade in Canada during the relevant period. In this respect, while it is well established that invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], an owner must provide *some* evidence showing use of its trademark through a transfer as set out in section 4(1) of the Act. Such evidence can be in the form of documentation like invoices or sales reports, but can also be through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79].

[11] Further, it is well established that “offering for sale” is not the same as “selling” [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)], and that advertising alone is insufficient to establish use of a trademark in accordance with section 4(1) of the Act [see *Riches, McKenzie & Herbert LLP v Cleaner’s Supply Inc*, 2012 TMOB 211].

[12] In this case, Mr. Love states that the Owner’s electrical lighting fixtures “were sold by the registered owner” during the relevant period, but provides no documentary evidence or factual particulars to support this claim. In the absence of further details demonstrating how, when, and where the Owner sold its goods during the relevant period, I am not satisfied that the Love declaration shows that the Mark was used in association with a transfer of the goods in Canada in the normal course of trade during the relevant period.

[13] Even if I were to accept that the Owner sold its electrical lighting fixture goods in Canada in the normal course of trade during the relevant period, I agree with the Requesting Party that the evidence does not show whether, or how, the Mark was displayed on the Owner’s goods. In this respect, I note that the Owner refers to the Requesting Party’s objection to the poor quality of the printout by citing the *ITV Technologies* Federal Court case, in which the Court allowed under reserve the use of the internet where the documents being retrieved had been produced at discovery. To the extent that the Owner is suggesting that I ought to refer to the online versions of the

pages attached to the Love declaration, section 45(2) is clear that the Registrar shall not receive any evidence other than the affidavit or statutory declaration prescribed by section 45(1).

[14] In any event, neither the Love declaration nor the Owner's written representations suggest that the Mark appeared on the Owner's goods or their packaging, or that clearer versions of the exhibited webpages would establish as much. Instead, the Owner submits that the display of the Mark on the Owner's website itself shows that the Mark was associated with the goods at the time of transfer. While the display of a trademark on a webpage from which goods are purchased can be sufficient to establish the necessary notice of association between the trademark and those goods [see *McMillan LLP v Neogen Corp*, 2013 TMOB 187 at para 14; *FeraDyne Outdoors, LLC v Bass Pro Intellectual Property, LLC*, 2023 TMOB 104 at para 19], in this case, it is not clear that the Owner's goods could be purchased from the Owner's website. While the product descriptions shown in the Exhibit B and C screenshots appear to have "LEARN MORE" buttons, there are no indicia on the pages themselves which would suggest that the goods can be purchased through the website. While Mr. Love states that the Owner's webpage "existed for customers" during the relevant period, it would be speculative, in my view, to infer from this statement that those customers were able to purchase the Owner's goods through the website, in the absence of clear confirmation from the Owner. In this respect, the Federal Court has held that the Registrar must be able to "rely on an inference from proven facts rather than on speculation" to satisfy every element required by the Act [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 11; see also *Smart & Biggar v Curb*, 2009 FC 47].

[15] As such, I am not satisfied that the Owner has established use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act. There is no evidence of special circumstances which would excuse non-use of the Mark.

**DISPOSITION**

[16] For the reasons set out above, 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.

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G.M. Melchin  
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:** Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

**For the Registered Owner:** No agent appointed