



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 58
Date of Decision: 2016-04-11

IN THE MATTER OF AN OPPOSITION

LED Source, LLC

Opponent

and

SGi Lighting Inc.

Applicant

1,441,986 for The LED Lighting Source

Application

FILE RECORD

[1] On June 17, 2009, SGi Lighting Inc. filed an application to register the trade-mark **The LED Light Source** (the bold font indicates trade-mark significance) based on use of the mark, since December 5, 2008, in association with the goods and services listed below:

goods

energy efficient LED lighting fixtures and LED light bulbs used in residential, commercial, and industrial applications

services

lighting related energy audits, surveys, installation, and design services for residential, commercial, and industrial applications

[2] It appears that at some time on or about April 26, 2010, the Examination Section of the Canadian Intellectual Property Office (“CIPO,” under whose aegis this Board operates) accepted a request by the applicant to amend the application to change the mark to **The LED Lighting Source**. Presumably the Examination Section permitted amendment pursuant to s.31(b) of the *Trade-mark Regulations*, which reads as follows:

31. No application for the registration of a trade-mark may be amended where the amendment would change

.....

(b) the trade-mark, except in respects that do not alter its distinctive character or affect its identity; (emphasis added)

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated August 1, 2012 and was opposed by LED Source, LLC on October 1, 2012. The Registrar forwarded a copy of the statement of opposition to the applicant on November 6, 2012, as required by s.38(5) of the *Trade-marks Act*, R. C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponent was subsequently granted leave to amend the statement of opposition: see the Board ruling dated March 26, 2013. Further references herein to the statement of opposition are to the amended pleadings.

[4] The opponent’s evidence consists of the affidavit of Fay O’Brian and a certified copy of the file wrapper for the subject application. The applicant’s evidence consists of the affidavits of Sapna Santdasani and Jamie-Lynn Kraft. Ms. Santdasani was cross examined on her affidavit testimony. The transcript of her cross-examination and answers to questions taken under advisement form part of the evidence of record.

STATEMENT OF OPPOSITION

[5] As several of the pleadings are somewhat technical, the amended grounds of opposition, including strikeouts and underlining, are shown in full below:

(a) The application does not comply with paragraphs 38(2)(a) and 30 of the *Trademarks[sic] Act*, specifically, the application seeking registration does not comply with the requirements of Section 30 of the *Trade-marks Act* because that application was amended in a manner contrary to paragraph 31(b) of the *Trade-marks Regulations*, namely the amendment

materially changed the identity of the trademark with the result that it is not an application within the meaning of Section 30 of the *Trade-marks Act*.

Specifically, the original application filed on 17 June 2009 was for registration of the trade-mark **The LED Light Source**. On or about 26 April 2010, the Applicant changed the trade-mark to **The LED Lighting Source**; such change is a material change that altered the distinctive character and identity of the original trade-mark and therefore is contrary to paragraph 31(b) of the *Trade-marks Regulations*.

(b) The application does not comply with paragraphs 38(2)(a) and 30(b) of the *Trade-marks Act*:

The Applicant filed an application for registration of **The LED Light Source** on 17 June 2009 claiming use in Canada since 05 December 2008.

The Applicant then abandoned the mark **The LED Light Source** in favour of materially changing the identity of trade-mark to **The LED Lighting Source** on or about 26 April 2010, in an attempt to overcome an Examiner's objection based on Section 12(1)(d) of the Trade-marks Act[sic], namely that the applied for trademark[sic] (**The LED Light Source**) is considered to be confusing with registered trade-mark No.TMA417888 (LIGHTSOURCE).

Accordingly, the Applicant has not used the trade-mark **The LED Lighting Source** in Canada since 05 December 2008 in association with ~~the~~ each of the general classes of wares and services described in the application.

(c) The application does not comply with paragraphs 38(2)(a) and 30(i) of the *Trade-marks Act*:

On 17 June 2009, the Applicant applied for registration of the trade-mark **The LED Light Source** stating that the Applicant is satisfied that it is entitled to use the trade-mark in Canada in association with the wares and services described in the application.

However, the Applicant abandoned the mark **The LED Light Source** on or about 26 April 2010 by materially changing the identity of the trade-mark to **The LED Lighting Source** and therefore on 17 June 2009 the Applicant could not have been satisfied that it was entitled to use the trade-mark in association with the wares and services described in the application.

(d) The trade-mark is not registrable pursuant to Section 38(2)(b) and ~~42(1)(d)~~ 12(1)(b) of the *Trade-marks Act* because the trade-mark is clearly descriptive of the character or quality of the wares and services in association with which it is used or proposed to be used.

The trade-mark clearly describes that a character or quality of the Applicant's wares and services, namely that wares are sources of LED lighting and services are energy audits, surveys, installation, and design services of sources of LED lighting and that the Applicant provides a source for consumers to purchase LED lighting and LED lighting services.

(e) The applied for trade-mark is not distinctive within the meaning of Sections 38(2)(d) and 2 of the *Trade-marks Act*, in that the applied for trade-mark does not actually distinguish the

wares and services in association with which it is used or proposed to be used by the Applicant from the wares and services of others nor is it adapted so as to distinguish them. The trade-mark is not distinctive and does not distinguish the wares and services of the Applicant from the wares and services of others because it is clearly descriptive of the applied for wares and services and it is common language used by other proprietors of the same or substantially the same wares and services.

The use of the terms “The LED Lighting Source” would be understood by consumers as identifying a LED lighting fixture or LED light bulb that is a source of LED lighting. Further, the trade-mark would be understood by consumers as indicating a place or source to purchase LED lighting products and services as well as for services relating to LED lighting sources.

[6] I will review the parties’ evidence before addressing the grounds of opposition.

OPPONENT’S EVIDENCE

Fay O’Brian

[7] Ms. O’Brien identifies herself as a trade-mark agent retained by the agents for the opponent to conduct searches relating to trade-mark matters. The searches she performed are attached as exhibits to her affidavit, summarized below:

Exhibits A - CC

[8] These exhibits are comprised of dictionary entries for the terms LED; light; lighting; and source. In particular, the term LED is the short form for an electronic device known as a “light emitting diode.” LEDs have various applications in flat screen televisions, digital watches, calculators and other electronic apparatus which emit light. The primary meaning of “source” is a place from which something comes or is obtained.

Exhibit D

[9] This exhibit is a copy of the particulars of the subject application of record at CIPO.

Exhibits E and EE

[10] The exhibits are Internet searches for the applicant and its homepage. It is clear from the homepage that the applicant is in the business of providing LED lighting to residential and commercial clients.

Exhibit F

[11] This exhibit is an Internet search conducted for the applicant's web site on the Wayback Machine.

Exhibit G, GG

[12] The first exhibit is an Internet search for the applicant's use of the mark **The LED Lighting Source** prior to 2010. The search located one reference to **The LED Light Source**. The second exhibit is comprised of the applicant's spec sheets for its lighting apparatus. The applicant's trade-name SGi Lighting appears on the sheets but the mark **The LED Lighting Source** is absent.

Sapna Santdasani

[13] Ms. Santdasani identifies herself as a co-founder of the applicant company. The applicant specializes in the design, manufacturing, sales and distribution of LED lighting products for residential, commercial and industrial applications. The applicant has used the mark **The LED Lighting Source** since December 5, 2008 and "has also used the variation" **The LED Light Source**.

[14] Attached as Exhibit B are examples of product packaging dated December 2008 and May 2009 which are representative of packaging used on December 5, 2008. I note that the applicant's trade-name is dominant, however, the mark **The LED Lighting Source** is clearly visible. In particular, the mark is clearly visible on packaging dated December 12, 2008. Attached as Exhibit C are samples of product information and installation sheets dating from October 2008 to 2013. Again, the applicant's trade-name is dominant while the applied-for trademark functions in a secondary capacity. In particular, the applied-for mark is clearly visible on a spec sheet dated October 14, 2008.

[15] Attached as Exhibit D is an "energy audit" dated 2010. It appears to be a standard form used by the applicant to indicate a client's present energy consumption for lighting, the cost of installation of the applicant's products, and resultant savings for switching to LED lighting. The

applicant's trade-name is dominant on the standard form while the applied-for trade-mark functions in a secondary capacity but is clearly visible.

[16] Exhibit E is comprised of sample invoices dating from 2007 to 2013. Again, the applicant's trade-name is dominant while the applied-for trade-mark functions in a secondary capacity. Nevertheless, the applied-for mark is clearly visible on several invoices dated prior to December 5, 2008.

[17] The applicant's total net sales under its mark (and trade-name) have been in excess of \$1.8 million from December 5, 2008 to December 2013.

[18] The applicant promotes its goods and services by print materials distributed at industry trade-shows, through online advertising, by signage on its booth at trade-shows, by sponsoring events at related trade-shows, and by signage and promotional materials at a product showroom opened in July 2012 in Halton Hills, Ontario. The applicant has expended about \$415,000 in advertising and promotion for the period December 2008 to December 2013.

[19] Ms. Santdasani's testimony on cross-examination is consistent with her affidavit evidence.

APPLICANT'S EVIDENCE

Jamie-Lynn Kraft

[20] Ms. Kraft identifies herself as an articling student employed by the agents for the applicant. Her affidavit serves to introduce into evidence the particulars of numerous trade-mark registrations and applications, comprised in part of the term SOURCE, of record on CIPO data bases (of 65 marks evidenced, three are applications). Some of the marks are referred to in paras. 52-54 of the applicant's written argument:

52. The evidence of record also demonstrates that the word SOURCE is consistently recognized as non-descriptive. The Applicant's evidence contains numerous examples of comparable marks in which no disclaimer has been entered for SOURCE. We note the following marks which we submit are highly analogous to the present case in the

construction of the mark (i.e. “[insert element] SOURCE”) and given the fact that each mark covers goods and/or services closely related to the first element of the mark:

LIGHTSOURCE for lamps, lighting fixtures;

POWER SOURCE for power bars and extension cords; GAS SOURCE for industrial and specialty gases;

ZIPPER SOURCE for custom made zippers and retail mail order services to the home sewing trade featuring custom made zippers;

YOUR MORTGAGE SOURCE for financial services, namely a residential and commercial mortgage brokerage;

DENTAL SOURCE for oral care products, namely dental floss, flossers, manual toothbrushes . . .

VISION SOURCE for optical products namely eyeglasses [sic]

THE TOTAL METAL SOURCE for the operation of a business relating to the importation, exportation, distribution and recycling of metals;

BREADSOURCE for baked products, namely fresh, partially baked and frozen bread; and services including “wholesale and retail sales of baked products, namely fresh, partially baked and frozen bread”[sic]

THE SCARF SOURCE for goods including scarves;

TRAVEL SOURCE for arranging and organizing of travel by air, land or water, travel tours and vacation packages for individual travellers and for groups;

RXSOURCE for the operation of a wholesale pharmacy in Canada and internationally, including the distribution of generic pharmaceutical products, ethical brand pharmaceuticals and niche pharmaceutical products.

53. Certainly, if the Registrar has deemed these marks not to be clearly descriptive then there is no basis on which the subject mark should be considered unregistrable on the basis of being clearly descriptive.

54. Based on the foregoing, it is submitted that this ground of opposition should be rejected by the Board.

I will address the applicant’s above submissions later in these reasons for decision, at paras. 28 - 30, below.

CONSIDERATION OF THE GROUNDS OF OPPOSITION

First Ground

[21] The first ground of opposition alleges that the application is not in compliance with s.30 of the *Trade-marks Act* because the amendment to application, referred to in para. 2, above, was permitted in error. The applicant's answer to the first ground is found at paras 30-36 of its written argument:

30. In the Opposition Board's 1990 decision in *Magill v Taco Bell Corp.*³⁴ it was noted that if the Board were to consider an allegation of non-compliance with s.31(b) of the Regulations as raising a valid ground of opposition, the Board could only review the Examiner's exercise of the Registrar's discretion under s.31(b) if the Examiner's exercise of discretion in allowing the amendment constituted an error of law or if the Examiner's decision was based on a misinterpretation of the facts. The fact that the Board Member may have elected to exercise the discretion of the Registrar in a manner different than the manner in which discretion was exercised by the Examiner was not considered to be reviewable by the Board absent an error in law or misinterpretation of the facts. As noted by Chairman Partington at page 226 of the *Magill* decision:

. . . Further, a decision which has been made by an examiner in the exercise of the registrar's discretion cannot be reviewed by the board unless there is a clear error of law or an error in the interpretation of the facts which were before the examiner at the time that he or she exercised the registrar's discretion. Accordingly, if there is no error in law and if it has not been shown that the person who exercised the registrar's discretion misinterpreted the facts which were before him or her, that decision cannot be reconsidered in an opposition proceeding.³⁵

31. The error in law/misinterpretation of the facts principle of the *Magill* case was referenced by Hearing Officer Bradbury in the Board's 2009 Decision in *Ipex Inc. v Royal Group Technologies Ltd.* At paragraph 39 of the decision, the Hearing Officer notes as follows: (emphasis added):

[39] In the event that I am wrong in determining that the first ground does not plead a proper ground of opposition, I will add that, although the amendment by the Applicant of its trade-mark during prosecution was arguably contrary to s.31(b), I do not consider the acceptance of the amendment by the examiner to be clearly an error of law nor has it been shown that there was a misinterpretation of the facts by the examiner which would justify my reconsidering the decision rendered by the examiner in the exercise of the Registrar's discretion (see *Magill v Taco Bell Corp.* (1990), 31 C.P.R. (3d) 221 (T.M.O.B.)

32. Even if the Board considers that the amendment of the Mark by the Applicant raises an allowable ground of opposition, the Opponent's argument should not succeed. The Examiner's decision to allow the amendment of the Applicant's mark from THE LED LIGHT SOURCE to THE LED LIGHTING SOURCE is not an error in law. Moreover, there is no evidence that the Examiner misinterpreted any facts before him in allowing the amendment of the Applicant's Mark.

33. As noted in the Supreme Court of Canada's decision *Housen v. Nikolaisen*, [2002] 2 SCR 235, an error of law constitutes "the application of an incorrect standard, a failure to consider a required element of a legal test, or similar error in principle."³⁶ There is no evidence that the Examiner applied the incorrect standard, or failed to consider the correct test (or any elements thereof) applicable to the decision to allow the amendment of the Mark. On the contrary, it can be inferred, by way of the Applicant's April 2010 correspondence to Examiner Cameron Tiesma in which it is stated:

". . . I trust this amendment has not changed the trade-mark's distinctive character or affected its identity. . ."

that the Examiner had the issue and the relevant test already before him when the decision to allow the amendment of the Mark was made.

34. Further, there is no evidence of record to suggest that the Examiner in any way misinterpreted the facts which were before him at the time of the decision to allow the amendment.³⁷

35. Finally, even if the Board considers that the amendment of the Mark could potentially be an error in law or was based on a misinterpretation of the facts, we submit that the amendment of the Mark did not change the distinctive character of the Mark or affect its identity.

36. The Federal Court of Appeal, in *Promafil Canada Ltee v Munsingwear Inc.*³⁸, noted that:

. . . cautious variations can be made without adverse consequences, **if the same dominant features are maintained** and the differences are so unimportant as not to mislead an unaware purchaser. [**emphasis added**]

[22] I agree with the reasoning and analysis in quoted paras. 30-34, above, which provide a sufficient basis to reject the first ground of opposition.

[23] I also agree with the reasoning and analysis in quoted paras 35-36, above. In my view the guidance in the *Promofil* case, quoted above, leads to the conclusion that the mark **The LED Lighting Source** is a permitted variation of the mark **The LED Light Source**. In other words, they are the same mark for the purposes of this opposition. This finding has ramifications for the second ground of opposition, discussed below.

Second Ground

[24] The second ground of opposition alleges that the applicant did not use the applied-for mark as of December 5, 2005. Rather, the opponent alleges that the applicant initially used the

mark **The LED Light Source** and only began using the mark **The LED Lighting Source** on or about 26 April 2010. However, in view of my finding that the two marks are variants of one mark, the second ground of opposition is unsupported by any material facts and must be rejected. In any event, if I am wrong in finding that **The LED Lighting Source** is a permitted variation of the mark **The LED Light Source**, Ms. Santdasani's affidavit evidence, discussed earlier, and her testimony on cross-examination, conclusively support the applicant's claim to use of the mark **The LED Lighting Source** as of December 5, 2008.

Third Ground

[25] The third ground of opposition, based on s.30(i) alleges that the applicant could not have been satisfied that it was entitled to use the applied-for mark in association with the goods and services described in the application. The applicant's answer to the third ground is found at paras. 41-45 of its written argument:

41. With respect to the Opponent's allegation that the Application does not comply with s. 30(b), the affidavit evidence and subsequent cross-examination of Ms. Santdasani make it clear that SGI launched, offered for sale and sold, and promoted the goods and services under the Mark, in Canada, since at least as early as December 5, 2008. "THE LED LIGHT SOURCE" and "THE LED LIGHTING SOURCE" (a minor variation thereof) were both used since December 5, 2008.³⁹ The Opponent has not put forward any evidence which counters this. Further, Ms. Santdasani's evidence demonstrates that the Applicant has continuously used the Mark in the normal course of trade since December 5, 2008, and that it has not abandoned the Mark.⁴⁰

42. During the cross-examination of Ms. Santdaeani, counsel for the Opponent made repeated references to the Applicant's trade-mark SGI Lighting logo "in combination" with the Mark. We note that the affidavit evidence of Ms. Santdasani also shows use of the Mark appearing separately from other marks.⁴¹

43. We further note that it is well settled law that more than one mark can be used in association with goods and services, particularly where one of the marks used is a "house" mark.⁴²

44. Finally, bad faith is required to succeed on a ground of opposition based on s. 30(i) of the Act. No allegation of bad faith has been made In this case and there is nothing to support any such allegation in any event.⁴³

45. Accordingly, these s.30 grounds of opposition should be dismissed.

[26] I agree with the applicant concerning its summary of the evidence in this case and its submission that a finding of bad faith is necessary to succeed on a ground of opposition based on s.30(i). Accordingly, the third ground of opposition is rejected.

Fourth and Fifth Grounds

[27] The two remaining grounds of opposition turn on whether the applied-for mark **The LED Lighting Source** is clearly descriptive of the character or quality of the applicant's goods and services. The goods are designated fairly precisely in the application and the particulars of the applicant's services are clarified in its evidence, that is, to provide a cost estimate for designing and installing LED lighting; to design and install LED lighting; and to provide an estimate of the resultant cost savings over the client's current lighting.

[28] As mentioned earlier, I will address paras. 52-54 of the applicant's written argument (quoted earlier) which argues that the register evidence introduced by Ms. Kraft leads to the conclusion that "there is no basis on which the subject mark should be considered unregistrable on the basis of being clearly descriptive." I must disagree with the applicant's submission. In my view the type of evidence furnished by Ms. Kraft cannot be determinative of whether a mark is clearly descriptive. In this regard, I take guidance from the recent *Bologna Bites* decision (*Maple Leaf Foods Inc v Pinnacle Foods Group LLC*, 2015 TMOB 137 (CanLII)), discussed below.

[29] The mark BOLOGNA BITES was intended for use in association with sausages, frankfurters and the like. In support of its application the applicant filed state of the register evidence of the same type and for the same purpose that Ms. Kraft's evidence was filed in the instant case. The Board discussed the probative value of such evidence:

[22] Insofar as the registrations are concerned, I note that not all of them relate to goods which are similar to those of the Applicant and many of the trade-marks which are the subject of the registrations do not have a construction which is similar to that of the Mark (i.e. the name of a food product, followed by the word "bites" in French or in English). That being said, there are still quite a few trade-marks standing in the name of various third parties, which are constructed similarly to the Mark and which are associated with similar types of goods. Some of these include: RICE BITES (registration No. TMA877,920); COOKIE DOUGH BITES (registration No. TMA762,787); TOMATO BITES (registration No. TMA679,396); STEAK BITES (registration No. TMA630,032); EGG BITES (registration No. TMA591,114);

TURKEY BITES (registration No. TMA593,239); BEEF BITES (registration No. TMA442,977); BROWNIE BITES (registration No. TMA415,578); BAGEL BITES (registration No. TMA352,616); and PORK BITES (registration No. TMA348,609). As the Applicant has pointed out, the Opponent itself owns two of these marks (BEEF BITES and PORK BITES for meat products). (emphasis added)

[23] The Applicant submits that the existence of these similar trade-marks on the Register supports its contention that the Mark is registrable and it notes that the Court has cautioned that it is incumbent on the Registrar in refusing an application to reconcile his refusal to some extent in view of the existence on the trade-mark register of somewhat similar marks [*Reed Stenhouse Co Ltd v Registrar of Trade-marks* (1992), 45 CPR (3d) 79 (FCTD)]. The Applicant further submits that the refusal of its Mark against the acceptance of numerous others would result in an unexplained inconsistency [*Rothmans, Benson & Hedges Inc v RJ Reynolds Tobacco Inc Co*, (1993) 47 CPR (3d) 439 (FCTD)]. In addition, the Applicant has pointed out that the court is also cognizant of the fact that refusing one trade-mark where others have been accepted, is not only unfair to the individual applicant, but also results in a situation in which “the status of all the other registrations would be in serious doubt, thereby turning the intellectual property field into a virtual jungle” [*Imperial Tobacco Limited v Rothmans, Benson & Hedges Inc* 1996 CanLII 11873 (FC)]. (emphasis added)

[24] On more than one occasion, this Board has held that it is not in a position to explain at the opposition stage, why particular trade-marks were permitted to proceed to registration by the examination section of the Trade-marks Office. Such a decision may have resulted because the examiner did not have the benefit of the type of evidence filed in an opposition proceeding or because the onus or legal burden is different at the examination stage . . . I also note that the policies and practices of the Registrar may evolve over time resulting in the appearance of inconsistency [see *Cliche v. Canada (Attorney General)*, 2012 FC 564 (CanLII) at para 27].

[25] Furthermore, as pointed out by Justice Kelen in *Worldwide Diamond Trademarks Limited v Canadian Jewellers Association*, while the Court has recognized that the Registrar must consider prior registrations when assessing descriptiveness, it is trite law that if the Registrar has erred in the past, there is no reason to perpetuate that error [*Worldwide Diamond Trademarks Limited v Canadian Jewellers Association*, 2010 FC 309 (CanLII); aff'd at 2010 FCA 326 (CanLII)]. In *Worldwide Diamond Trademarks Limited*, Justice Kelen found that the state of the register with respect to similar marks could not render the proposed trade-marks at issue non-descriptive and therefore registrable. I have come to a similar conclusion in the present case.

[30] I am adopting the same approach followed by this Board in *BOLOGNA BITES*. That is, each case must be decided on its own facts, having regard to the particular mark in issue and to the applicant’s particular goods and services. Of course, the state of the register evidence in the instant case differs from *Bologna Bites* in that the cited marks are not associated with the applicant’s goods or services (except for the mark *LIGHTSOURCE*) which further lessens any probative value of Ms. Kraft’s evidence.

Judicial Principles for Determining whether a Mark is Clearly Descriptive

[31] The judicial principles for determining whether a mark is clearly descriptive have been comprehensively canvassed at paras. 46-50 of the applicant's written argument:

46. In order to be denied registration under s. 12(1)(b) of the *Act*, a mark must be clearly descriptive or deceptively misdescriptive of the character or quality of the goods or services to which it relates. There is no prohibition against trademarks that are suggestive or even descriptive (as opposed to clearly descriptive).

47. This principle was set down by the Federal Court in *Thomas J Lipton Ltd. v. Salada Foods Ltd. (No 3)* (1979), 45 CPR (2d) 157 (FCTD), a decision which found that the trademark LIPTON CUP•A•TEA was not clearly descriptive of tea. In this decision Addy J. stated:

In my view, the Registrar has misdirected himself. "Connotation" means an implication or a suggestion. Even a "specific descriptive suggestion or implication" or "a clear implication or suggestion" that a mark is descriptive or misdescriptive is not sufficient to disqualify it for registration under section 12(1)(b). That enactment admits of no mere implication or suggestion.⁴⁴

48. That principle has been adopted repeatedly by the Federal Court and the Opposition Board. Recently, *Harrington. J[sic] in Movenpick Holding AG v. Exxon Mobil Corp.* (2011), 98 CPR (4th) 334 (FCTD), *aff'd* (2013), 109 CPR (4th) 255 (FCA), stated:

The word "clearly" has been held to mean "easy to understand, self-evident or plain and specifically preserves the registrability of suggestive trademarks. The *Act* only prohibits the registration of marks that are clearly descriptive. Courts have consistently recognized that a trademark[sic] is registrable even though it is suggestive or even descriptive. Courts also permit the skilful[sic] allusion to a characteristic of the associated wares or services.⁴⁵

49. The test for determining whether a mark is clearly descriptive (as opposed to merely suggestive or simply descriptive) is set out in the oft-quoted passage of *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trademarks)* (1978), 40 CPR (2d) 25 (FCTD):

The decision that a mark is clearly descriptive is one of immediate impression; it must not be based on research into the meaning of words. [...] If the mark is merely suggestive it does not fall within the prohibition against clearly descriptive marks.⁴⁶

50. It is well settled that the impression created by a mark must be assessed from the perspective of an ordinary, everyday purchaser of the wares rather than from the perspective of experts or people with special knowledge.⁴⁷

[32] In the present case, it appears to me that the immediate impression of an ordinary, everyday purchaser encountering the mark **The LED Lighting Source**, used in association with

the applicant's goods, would be that the applicant's light fixtures and light bulbs provide LED lighting, that is, the light bulbs and the light fixtures are a source of LED light. Similarly, the immediate impression created by the applied-for mark used in association with the applicant's services would be that the applicant is a provider of, that is, a source for, LED lighting. I therefore find the applied-for mark clearly describes the character of the applicant's goods and services within the meaning of s.12(1)(b) of the *Trade-marks Act*.

[33] Another perspective on whether a mark is clearly descriptive was enunciated by Pigeon, J. in *Johnson (S.C.) and Son, Ltd. et al. v. Marketing International Ltd.*, [1980] 1 SCR 99, 1979 CanLII 171 (SCC) at p. 110:

In his reasons for judgment, the trial judge said (at p. 24):

...it seems that the word "off" is most usually used in connection with other words and derives its meaning from the context in which it is used. If the use is elliptical then because of its many uses the ellipses are many.

That being so the word "off" standing alone bereft of context has no meaning readily ascribed to it and accordingly that word cannot be "clearly descriptive of the nature and quality of the wares in association with which it is used" without the explanation accomplished by additional words which are not expressed and what those words might be is left to conjecture.

Therefore, I conclude that the registration of the word "OFF!", followed by an exclamation mark as it is, was validly registered by the Wisconsin plaintiff, that it was "adapted" to distinguish that owner's wares and has a degree of distinctiveness capable of doing so.

With respect, I have to say that the learned trial judge was in error in the view he took of the plaintiffs' use of the word "off". He failed to consider the essential factor that this was an elliptical use of the word in association with an insect repellent and therefore, in that context, it was descriptive of the wares or of their effect.

(emphasis added)

[34] In the instant case, when the applied-for mark **The LED Lighting Source** is considered as a whole in the context of the applicant's goods and services, it is self-evident that the applicant

provides LED lighting. The opponent therefore succeeds on the fourth and fifth grounds of opposition.

DISPOSITION

[44] In view of the foregoing, the subject application is refused. This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office

APPEARANCES AND AGENTS OF RECORD

HEARING DATE: 2015-12-15

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