



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

Citation: 2014 TMOB 287
Date of Decision: 2014-12-30

**IN THE MATTER OF SECTION 45 PROCEEDINGS
requested by Cameron IP against registration
Nos. TMA693,747 and 667,821 for the trade-marks
HALDEX and HALDEX & DESIGN respectively, in the
name of Haldex AB**

[1] This is a decision involving summary expungement proceedings with respect to registration Nos. TMA693,747 and 667,821 for the trade-marks HALDEX and HALDEX & DESIGN (shown below) respectively (sometimes collectively referred to as the Marks), owned by Haldex AB.



[2] The Marks are currently registered for use with the goods and services listed in the attached Schedules A (with respect to the word mark HALDEX) and B (with respect to the HALDEX & DESIGN mark).

[3] For the reasons that follow, I conclude that registration Nos. TMA693,747 and 667,821 ought to be maintained in part with respect to both the goods and the services.

The Proceeding

[4] On May 29, 2012, the Registrar of Trade-marks sent notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Haldex AB (the Registrant). The notices were sent at the request of Cameron IP (the Requesting Party).

[5] The notices required the Registrant to provide evidence showing that it had used the Marks in Canada, at any time between May 29, 2009 and May 29, 2012 (the relevant period), in association with each of the goods and services specified in the respective registrations. If the Marks had not been so used, the Registrant was required to furnish evidence providing the date when the Marks were last in use and the reasons for the absence of use since that date.

[6] The relevant definitions of use in the present case are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark 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.

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

[7] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. However, sufficient facts must be provided to allow the Registrar to conclude that the Marks were used in association with each of the registered goods and services during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Furthermore, bare statements of use are insufficient to prove use and ambiguities are to be interpreted against the interests of the Registrant [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar’s notices, the Registrant provided the affidavit of Brian Bowerman, the Director North American Aftermarket Sales for Haldex Limited, sworn on

January 24, 2013. The evidence filed in response to each notice is substantively identical. Both parties filed written representations; however, an oral hearing was not conducted.

The Evidence

[9] In his affidavit, Mr. Bowerman indicates that both Haldex Limited and Haldex Inc. are wholly owned subsidiaries of the Registrant. He states that Haldex Inc. is responsible for the manufacture of parts under the Haldex brand under the authority of the Registrant while Haldex Limited is responsible for the sales of the parts manufactured by Haldex Inc. in Canada. Mr. Bowerman explains that in Canada, Haldex Limited sells parts for heavy duty commercial vehicles to automotive parts distributors, retailers, and installers. Finally, he states that the Registrant controls the character and quality of all of the products that Haldex Limited sells in Canada in association with the Marks through the distribution of quality control standards and periodic inspection and review of manufacturing processes and facilities to ensure quality control.

[10] Mr. Bowerman then attests that from May 29, 2009 until the date of swearing of his affidavit, Haldex Limited has continuously used the Marks in association with all of its products by: (i) marking the Marks on the products themselves, (ii) displaying the Marks on the packaging in which the products are sold, and (iii) displaying the Marks on invoices related to the sale of such products.

[11] In support of Mr. Bowerman's above-noted assertions of use, he provides the following:

- Exhibit A – a copy of a brochure entitled “Aftermarket Product Lines” bearing the HALDEX & DESIGN mark on the front page. Mr. Bowerman states the brochure lists and illustrates all of the products currently sold by Haldex Limited in Canada. He also indicates that the product lines referenced in the brochure have been available in Canada since at least as early as 2009. The brochure lists and illustrates a large range of parts (new or remanufactured) that relate to the automotive industry. I note the Marks do not appear to be visibly displayed on the illustrated products, with exception of one product related to automotive brakes. In this case, while the image itself lacks clarity, the trade-

mark that appears on the product is consistent with the appearance of the HALDEX & DESIGN mark on the front cover of the brochure.

- Exhibits B, C, and D – copies of invoices identified by Mr. Bowerman as issued by Haldex Limited for items manufactured by Haldex Inc. The invoices are dated during the relevant period and show sales and deliveries of parts related to the automotive field to Canadian companies. Mr. Bowerman states that the invoices are provided to the purchaser of the products at the time that the products are delivered to the purchaser. I note that the HALDEX & DESIGN mark is prominently displayed on the invoices in the top right corner, while the trade-names/business names Haldex Limited and Haldex Inc. appear separately with their respective corresponding addresses.

Submissions of the Parties and Analysis

[12] The Requesting Party submits that the Bowerman affidavit is silent on the use of the Marks in association with the services; therefore, the services should be cancelled from the registrations.

[13] In addition, the Requesting Party submits the Registrant has not provided actual evidence of use of the Marks in association with the registered goods since:

- The distribution of brochures does not constitute use of a trade-mark in association with the goods as it has not been shown that the brochures were distributed with the goods [citing *Grapha-Holding AG v Illinois Tool Works Inc*, [2008] FCJ No 1994]; and
- It is not clear from the invoices that the goods of only one manufacturer are being sold, therefore the invoices cannot be used to establish use of the Marks in association with the goods listed in the registration [citing *88766 Canada Inc v Phillips*, 2008 CarswellNat 2006 at para 19 (TMOB); and *Hortilux Schreder BV v Iwasaki Electrical Co* [2001] FCJ No 1189 at paras 62 and 67].

[14] In the alternative, the Requesting Party submits, all of the goods and services should be cancelled less “*valves, bushings, sensors, cables, automatic brake adjustment (ABA) and installations kits therefor*”, which are specifically listed in the invoices of Exhibits B, C, and D.

[15] With respect to the registered goods, the Registrant submits that it is not relying on the brochure as evidence of use of the Marks *per se*, but rather is relying on the brochure as a means to identify the specific registered goods with which the Marks have been used. In all, the Registrant submits, it has supplied facts from which, on balance, a conclusion of use follows as a logical inference [citing *Osler, Hoskin & Harcourt v United States Tobacco Co* (1997), 77 CPR (3d) 475 (FCTD)]. In particular, the Registrant submits, it has provided unambiguous evidence with respect to the dates during which it has used the Marks, the goods in association with which the Marks have been used, and the manner in which the Marks have been used.

[16] With respect to the manner in which the Marks have been used, the Registrant submits that such use has not only been described, but also that it has provided examples of its use of the Marks during the relevant period on invoices.

[17] As previously indicated however, the Requesting Party submits that the appearance of the Marks on the invoices does not constitute use in association with the invoiced goods. In particular, the Requesting Party notes the appearance of other entities on the invoices, suggesting that this raises questions as to whether the goods of one or more manufacturers are listed on the invoices. The Requesting Party identifies three entities on the invoices: Haldex Limited, Haldex Inc., and Haldex Midland Ltd., the latter of which appears at the top of the invoices under the remittance information. The Requesting Party submits that the fact that all of the aforementioned companies have names comprising the term HALDEX makes it impossible to know which, if any, of Haldex Limited, Haldex Inc. or Haldex Midland Ltd. manufactures the goods listed on the invoices.

[18] The Registrant submits that contrary to the Requesting Party's position, a full consideration of the reasons in *Hortilux, supra* resoundingly supports the conclusion that the invoices establish use of the Marks. In this regard, the Registrant submits that the factors enumerated in *Hortilux* relevant to establishing use of a trade-mark on an invoice have clearly and unambiguously been satisfied in the present case, including that the goods of only one manufacturer are being sold.

[19] More particularly, with respect to the appearance of Haldex Midland Ltd. on the invoices, the Registrant submits that it is irrelevant, as it is clear that this information has been provided

solely for the purpose of remittance of payment for the goods. I agree, and note that Haldex Limited is also referred to under payment remittance information on the invoices. Further to this, the Registrant submits, Mr. Bowerman has clearly attested that Haldex Inc. is the manufacturer of the registered goods, and that Haldex Limited sells these goods in Canada. Again, I agree, and note that the invoices are consistent with Mr. Bowerman's attestations in that Haldex Limited is listed as the shipper of the invoiced goods from its "Canadian Distribution & Service Centre". I also note that Mr. Bowerman has provided statements clearly attesting to the Registrant's control over the character and quality of all of the products sold by Haldex Limited; thus, I accept that any such use enures to the benefit of the Registrant [*Gowling, Strathy and Henderson v. Samsonite Corp.* (1996), 66 C.P.R. (3d) 560; *Sim & McBurney v. LeSage Inc.* (1996), 67 C.P.R. (3d) 560 (T.M.S.H.O.); and see *Mantha & Associés/Associates v. Central Transport Inc.* (1995), 64 C.P.R. (3d) 354, regarding statements of fact].

[20] Lastly, I accept that any use of the mark HALDEX & DESIGN may constitute use of each of the Marks. The Marks do not differ substantially and the use of a word mark can be supported by the use of a composite mark featuring the word mark and other elements [see for example *Stikeman, Elliot v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393].

[21] The question then becomes, whether use of the Marks has been shown with respect to each of the registered goods. Upon examining the goods listed in the invoices together with those appearing in the brochures, in addition to Mr. Bowerman's sworn statements regarding which registered goods are specifically identified within each invoice, I accept that use of the Marks has been demonstrated in association with the following registered goods:

TMA693,747

valve springs; machine valves for combustion engines; shaft seals, relief valves, and controls for engine cooling radiators; brakes, brake linings, and hydraulic valves for machines, engines and motors; machine coupling and transmission components (except for land vehicles), namely, couplings and clutches, and couplings; machine parts, namely bushings and bearings; pneumatic valves, control valves for regulating the flow of liquids and gasses, braking valves; compressors for machines, compressed air brakes, compressed air reservoirs, compressed air cylinders and compressed air motors; control devices for regulating the operation of machines and engines; automotive electronic diagnostic equipment consisting of electronic diagnostic devices for vehicles that compare vehicle's condition with sensor testers, and temperature sensors; electronic control units for the

processing and the evaluation of signals generated by sensors which measure the operational status of functional systems in land vehicles; solenoid valves and components thereof.

TMA667,821

Brake systems, and torque transfer couplers for vehicles and apparatus for locomotion by land, water, rail or air, namely automobiles, buses, trucks, truck trailers, cargo trailers, forklift trucks, construction vehicles, aircraft, boats, ships, locomotives and rail vehicles; compressors for aforesaid vehicles and apparatus.

[22] However, there is no evidence showing use of the Marks in association with the remaining registered goods and no special circumstances have been brought forth to excuse the absence of such use; consequently, the remaining registered goods will be deleted from the respective registrations.

[23] Lastly, with respect to the registered services, despite that Mr. Bowerman does not provide an explicit attestation with respect to use of the Marks in association with services, I find that the evidence supports use; however, as with the registered goods, I find that use has only been shown with respect to the services in part.

[24] In the present case, as previously indicated, the Marks are clearly displayed on the top of the invoices and Mr. Bowerman clearly states that the invoices are provided to the purchaser of the products at the time of delivery. Mr. Bowerman also identifies the invoice items to be parts related to the automotive industry. While the appearance of the Marks on the invoices constituted use for goods, I am satisfied that this evidence can also demonstrate use in association with the performance of some of the services [See *LIDL Stiftung & Co KG v Thornbury Grandview Farms Ltd* (2005), 48 CPR (4th) 147 (TMOB)]. In this regard, the invoices taken together with Mr. Bowerman's sworn statements and the brochure (Exhibit A) which clearly bears the Marks and lists automotive products sold by Haldex Limited, clearly show that Haldex Inc manufactures automotive parts and that Haldex Limited sells and distributes such goods. Consequently, in view of the display of the Marks on both the brochure and on the invoices, I am satisfied that the Registrant has shown use of the Marks in the performance of the following services:

TMA693,747

Retail services for the sale of parts for land vehicles, distributorship service in the field of automotive and off-road vehicle parts and accessories.

TMA667,821

Sale of parts for land vehicles, distributorship services in the field of automotive parts and accessories; manufacture of motor vehicles parts.

[25] However, there is no evidence showing use of the Marks in association with the remaining registered services and no special circumstances have been brought forth to excuse the absence of such use; consequently, the remaining registered services will be deleted from the respective registrations.

Disposition

[26] 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 goods and services for registration Nos. TMA693,747 and TMA667,821 will be maintained in part.

[27] The amended statement of goods for registration No. TM693,747 will read as follows:

valve springs; machine valves for combustion engines; shaft seals, relief valves, and controls for engine cooling radiators; brakes, brake linings, and hydraulic valves for machines, engines and motors; machine coupling and transmission components (except for land vehicles), namely, couplings and clutches, and couplings; machine parts, namely bushings and bearings; pneumatic valves, control valves for regulating the flow of liquids and gasses, braking valves; compressors for machines, compressed air brakes, compressed air reservoirs, compressed air cylinders and compressed air motors; control devices for regulating the operation of machines and engines; automotive electronic diagnostic equipment consisting of electronic diagnostic devices for vehicles that compare vehicle's condition with sensor testers, and temperature sensors; electronic control units for the processing and the evaluation of signals generated by sensors which measure the operational status of functional systems in land vehicles; solenoid valves and components thereof.

[28] The amended statement of goods for registration No. TMA667,821 will read as follows:

Brake systems, and torque transfer couplers for vehicles and apparatus for locomotion by land, water, rail or air, namely automobiles, buses, trucks, truck trailers, cargo trailers, forklift trucks, construction vehicles, aircraft, boats, ships, locomotives and rail vehicles; compressors for aforesaid vehicles and apparatus.

[29] The amended statement of services for registration No. TMA693,747 will read as follows:

Retail services for the sale of parts for land vehicles and related computer software, distributorship services in the field of automotive and off-road vehicle parts and accessories.

[30] The amended statement of services for registration No. TMA667,821 will read as follows:

Sale of parts for land vehicles and related computer software, distributorship services in the field of automotive parts and accessories, manufacture of motor vehicle parts.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule “A”

Wares described in Registration TMA693,747:

Rods for springs; fuel injection springs in combustion engines; valve springs; electric wires; motors and engines (except for land vehicles), namely, marine engines, aircraft engines, engines for industrial, agricultural and forestry machines, stationary combustion engines, turbines, electric motors; electric generators and alternators for land vehicles, for marine craft, for aircraft, for marine engines, aircraft engines, engines for industrial, agricultural and forestry machines, stationary combustion engines; high-frequency electric generators; air cleaners (air filters) for engines and air pollution control devices for reducing the airborne emissions from motors and engines; carburetors, converters for liquid fuels, injectors, injection pumps, fuel pumps, speed governors, injection nozzles and nozzle holders, machine valves, vaporizers, starters, ignition systems, ignition coils, glow plugs, spark plugs, spark plug connectors, lambda probes, magnetos, silencers/mufflers and spark arresters for combustion engines; fuel filters, oil filters, air filters; rolling bearings, plain bearings, shafts, shaft seals, gearwheels, drive wheels, speed change gear, pulleys, drive chains and belts, springs, filters, pumps, regulators, relief valves, controls, fans and fan belts, all for engine cooling radiators; cooling fans, cooling radiators, starters, fuel feed apparatus, oil cooling apparatus, brakes, brake linings, caps for cooling radiators, accelerators, hydraulic pumps, hydraulic cylinders, hydraulic reservoirs, hydraulic filters, hydraulic motors, hydraulic pipes, hydraulic valves, boost units for hydraulic transmission, all for machines, engines and motors; machine coupling and transmission components (except for land vehicles), namely, power transmissions, gearboxes/ transmissions, reverse gears, reduction gears, gearbox controllers, traction control systems, vehicle dynamics control systems, shaft connections, couplings and clutches, exhausts, couplings and transmission belts; piston rings; power transmission take-off units for motor vehicle engines, for use as prime movers; inboard/outboard drive units and sailing boat drive units for inboard engines; hydraulic pumps and motors and components thereof, surgical pumps or air pumps as vehicle accessories; machine parts, namely bushings and bearings; pneumatic valves, power steering systems, control valves for regulating the flow of liquids and gasses, braking valves; exhaust-gas turbo-chargers; compressors for machines, compressed air brakes, compressed air reservoirs, compressed air cylinders and compressed air motors, bilge pumps; incubators for eggs; control devices for regulating the operation of machines and engines, programmable controllers; machines for the automobile industry; machines and machine tools for the cutting and forming of materials; electric power tools and their plug-in tools; hydraulic lift jacks, body and frame aligners; packing and labeling machines, conveyors, conveyor belts; loading and handling machines for pressing plants and foundries and machines for the tooling of blanks; hydraulic lifting apparatus, cranes, winches; bucket, grapple and fork type implements for machines; teeth and cutting edges for machines; parts, and fittings for the aforementioned goods and for motor land vehicles; computer hardware including GPS and GSM based communication modules for supervision/positioning, telecommunication and data communication system and associated software for remotely controlling, diagnosing, analyzing and monitoring the status, operation, location and functionality of still or mobile objects, namely transportation vehicles, construction equipment and machinery equipment, and transmitting and receiving data regarding the objects from/to

onboard units associated with the objects, and forwarding the collected data via an information network, which is a combination of one or more of wireless, local and global networks, and structural parts for the aforementioned equipment; automotive electronic diagnostic equipment consisting of electronic diagnostic devices for vehicles that compare vehicle's condition with specification database software for use in diagnostic testing and live data retrieval for computerized vehicle systems, code readers used to retrieve and clear diagnostic trouble codes, ignition module testers, sensor testers, multi meters, circuit testers, engine analyzers, electrical testers, remote starter switches, temperature sensors, timing lights for ignitions systems, compression testers, fuel pressure testers, vacuum testers, and battery testers; diagnostic systems used to measure and monitor the operational status of functional systems in land vehicles and industrial equipment; measuring and control devices for electrical or compression operated systems and structural parts thereof for land vehicles used to measure the operational status of functional systems in land vehicles; electronic control units for the processing and the evaluation of signals generated by sensors which measure the operational status of functional systems in land vehicles; pressure operated switches; solenoid valves and components thereof; control systems and components thereof for heating, ventilating and air conditioning in land vehicles.

Services described in Registration TMA693,747:

Retail services for the sale of parts for land vehicles and related computer software, distributorship services in the field of automotive and off-road vehicle parts and accessories, computerized on-line retail services in the field of automotive and off-road vehicle parts and accessories; positioning and locating of vehicles via computers; electronic monitoring services in the fields of transportation vehicles, construction equipment and machinery equipment, namely remote monitoring, controlling, analyzing and diagnosing services of the status, operation, location and functionality of still or mobile transportation vehicles, construction equipment and machinery equipment; design and development of computer hardware and software.

Schedule "B"

Wares described in Registration TMA667,821:

Brake systems, suspension systems, dynamic control systems, friction material, hydraulic systems, torque transfer couplers, dynamic controllers, pneumatic systems, and electronic systems for vehicles and apparatus for locomotion by land, water, rail or air, namely automobiles, buses, trucks, truck trailers, cargo trailers, forklift trucks, construction vehicles, aircraft, boats, ships, locomotives and rail vehicles; motors, engines, pumps, compressors and axles for aforesaid vehicles and apparatus; industrial gas and diesel engines; machines tools.

Services described in Registration TMA667,821:

Sale of parts for land vehicles and related computer software, distributorship services in the field of automotive parts and accessories, computerized online retail services in the field of automotive parts and accessories; manufacture of motor vehicle parts.