

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 228

Date of Decision: 2021-10-12

IN THE MATTER OF A SECTION 45 PROCEEDING

Cassels Brock & Blackwell LLP

Requesting Party

and

Ametek (GB) Limited

Registered Owner

TMA127,286 for SOLARTRON

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA127,286 for the trademark SOLARTRON (the Mark).

[2] The Mark is registered for use in association with the following goods (the Goods):

Electronic and electrical apparatus and instruments, namely, oscilloscopes, voltmeters and testmeters for measuring resistance and capacity, spectrometers, data handling, processing, recording systems and apparatus, magnetic tape recorders and systems, computers analogue and digital, accounting, adding and calculating apparatus and instruments, apparatus and instruments for teaching keyboard operation and assessing operators skill, apparatus and instruments for testing and inspecting products during and after manufacture, reading machines and paper handling apparatus and print-out

apparatus therefore, pulse generators, transfer function analysers, oscillators, ignition delay meters, laboratory amplifiers, attenuators, ratio indicators, solarscopes, converters, amplifiers, commutator switches for data logging detectors, annunciators, simulators adapted for radar, industrial and scientific processes e.g. atomic reactors, transducers, power supply units, apparatus and instruments for recording and indicating pressure, chemical conditions, temperature and speed; sound recording, transmitting and reproducing apparatus and instruments; and parts and modules of all the aforesaid apparatus.

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

THE PROCEEDING

[4] On February 21, 2018, at the request of Cassels Brock & Blackwell LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Lloyd Instruments Limited, the registered owner of the Mark at the time. In that regard, I note that the name of the owner was changed from Lloyd Instruments Limited to Ametek (GB) Limited (the Owner) on October 30, 2015. This change was recorded by the Registrar on October 11, 2018.

[5] The notice required the owner of the Mark to show whether it was used in Canada in association with each of the goods specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between February 21, 2015 and February 21, 2018.

[6] The relevant definition of “use” 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.

[7] In response to the Registrar’s notice, the Owner submitted the affidavit of Charles Robert Sides, sworn on September 21, 2018.

[8] Both parties filed written representations and attended an oral hearing.

THE EVIDENCE

[9] The affiant explains that he is the Director of Marketing and Product Management for Advanced Measurement Technology, Inc., the parent company of the Owner. He also explains that the Owner offers “specialized equipment” for testing a number of materials and components, and that the Owner’s Goods are sold to Canadian consumers through its distribution partner Gamble Technologies Limited, located in Ontario.

[10] The affidavit is relatively brief. The core paragraphs of the Sides affidavit regarding use of the Mark are reproduced below. I note that the affiant refers to the Owner as “the Registrant”.

Sales figures for the SOLARTRON Goods

6. The Registrant maintains its sales volumes and figures highly confidential. However, I can confirm that the Registrant has sold each of the SOLARTRON Goods in Canada in each of the past three years with the dollar amount in the order of \$1M CAD.

Evidence of use in association with the SOLARTRON Goods

7. Exhibit “C” includes copies of representative invoices for the sale of SOLARTRON Goods by the Registrant to its Canadian distributor Gamble Technologies Limited.

8. The Registrant maintains manuals and product brochures for each of the Goods on the website of its parent company, and each of the manuals and brochures include several photographs showing the Goods with the Mark appearing on it. Exhibit “D” are representative examples of manuals and brochures for the SOLARTRON [*sic*] Goods, each of which prominently display the Mark SOLARTRON.

Conclusion

9. The Registered Mark is an important and valuable asset of the Registrant. As outline above, the Registrant extensively used the Mark in Canada in connection with the SOLARTRON Goods during the Relevant Period. As a result, the Registered Mark is certainly not “deadwood”.

[11] Although the affiant refers to “representative invoices”, Exhibit C includes a single two-page invoice. The invoice is dated within the relevant period and issued to Gamble Technologies Limited, with a billing and shipping address in Ontario, Canada. The left-hand corner of the invoice displays the following header:



[12] The Owner is specifically identified at the bottom of the invoice in a note which reads: “Registered Office: AMETEK (GB) Limited. PO Box 36, 2 New Star Road, Leicester, LE4 9JQ”.

[13] The invoice lists 10 items which are identified with product descriptions such as “ModuLab XM MTS - Materials Core Module”, “ModuLab XM – 8Slot Chassis (for ECS and MTS)”, “ModuLab XM MTS – Low Current Option”, “ZView for Impedance +USB Dongl” and “Electrode Kit”. The Mark is not displayed on the invoice.

[14] The affiant attests that the invoice evidences the sale of “SOLARTRON Goods”, but does not correlate any of the invoiced products with specific registered goods, or with any of the products depicted elsewhere in the evidence.

[15] As for Exhibit D, despite the affiant’s description that it contains “manuals and brochures”, I note that it does not contain any product manuals; it includes only a product brochure for an “Impedance/gain-phase Analyzer”, as well as a product catalogue. The catalogue cover page indicates that the catalogue pertains to “Potentiostats/Galvanostats, Scanning Electrochemical Systems, Materials Test Systems, Solar Test Systems” and “Accessories”. Again, none of these product descriptions clearly match terms found in the statement of goods

and the affiant provides no correlations between the products featured in the exhibited materials and the registered goods.

[16] The brochure, the catalogue cover page and some of the subsequent catalogue pages display the Mark with additional surrounding material, as shown below:



[17] The Mark together with the same additional material is also displayed on some of the products depicted in the catalogue, including the invoiced ModuLab XM MTS.

POSITIONS OF THE PARTIES

[18] The Requesting Party summarized its position succinctly at the hearing. In particular, the Requesting Party's primary position is that the limited evidence, namely a single invoice for uncorrelated goods, the affiant's "bald statement of use" and an agglomerated sales figure, is insufficient to show use of the Mark in association with each of the registered goods. In the alternative, the Requesting Party argues that if any use is shown, such use does not enure to the Owner but rather to another vendor identified on the invoice as "AMETEK Advanced Measurement Technology" and the trademark used is not the Mark as registered.

[19] In contrast, the Owner essentially argues that providing specific evidence for each of the registered goods would amount to evidentiary overkill. The Owner submits that it has clearly shown use of the Mark in association with the invoiced ModuLab XM MTS product and that the evidence considered as a whole is sufficient to maintain the registration in association with all of the Goods. In support, the Owner points to the "representative" nature of the exhibited invoice as well as the affiant's sworn statement regarding the sale of "each of the SOLARTRON goods".

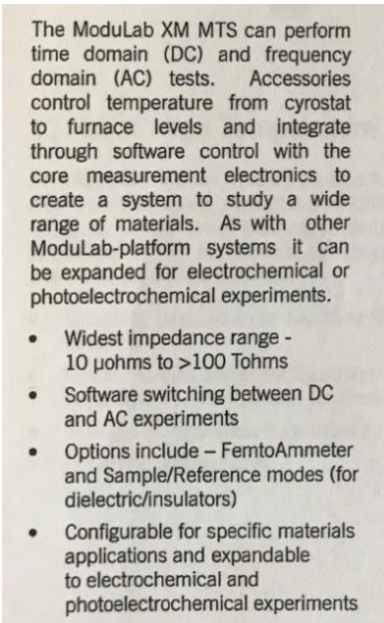
ANALYSIS AND REASONS FOR DECISION

[20] Despite the parties' submissions on a number of points, in my view, the central issue in this proceeding is the absence of correlations between the goods shown in evidence and the

goods listed in the registration. In short, the evidence before me is insufficient to determine which specific Goods were sold by the Owner.

[21] In terms of evidence regarding transfers of specific products, the Owner has provided one invoice. The product descriptions in the invoice are not self-explanatory and none of them correspond to terms found in the statement of goods. Moreover, as indicated above, the affiant provides no correlations between the invoiced products and the Goods, or between the invoiced products and those depicted elsewhere in the evidence.

[22] On that point, based on my review of the evidence, the product identified in the invoice as a “ModuLab XM MTS” is the only invoiced product referenced elsewhere in the exhibited materials. This product is described in the Exhibit D catalogue as follows:

The image shows a text excerpt from a catalogue, likely Exhibit D. It describes the capabilities of the ModuLab XM MTS, including its ability to perform time domain (DC) and frequency domain (AC) tests, control temperature from cryostat to furnace levels, and integrate with core measurement electronics. It also lists several options and features, such as the widest impedance range, software switching between DC and AC experiments, and expandability for electrochemical and photoelectrochemical experiments.

The ModuLab XM MTS can perform time domain (DC) and frequency domain (AC) tests. Accessories control temperature from cryostat to furnace levels and integrate through software control with the core measurement electronics to create a system to study a wide range of materials. As with other ModuLab-platform systems it can be expanded for electrochemical or photoelectrochemical experiments.

- Widest impedance range - 10 μ ohms to >100 Tohms
- Software switching between DC and AC experiments
- Options include – FemtoAmmeter and Sample/Reference modes (for dielectric/insulators)
- Configurable for specific materials applications and expandable to electrochemical and photoelectrochemical experiments

[23] I note that the ModuLab XM MTS is also the only invoiced product referenced by the Owner in its submissions. I further note that when referencing this product, the Owner has submitted varying possible correlations. First, in its written submissions, the Owner submitted that the invoice pertains to a ModuLab XM MTS “testmeter”. Then, at the hearing, the Owner pointed to the above excerpt of the Exhibit D catalogue and argued that the ModuLab XM MTS

product could also be correlated to other registered goods, such as “data handling, processing, recording systems and apparatus” and “apparatus and instruments for testing and inspecting products during and after manufacture”.

[24] In my view, the catalogue description does not provide much assistance in terms of identifying to which specific registered good the ModuLab XM MTS product corresponds. In fact, if anything, I tend to agree with the Owner that the ModuLab XM MTS could correspond to many of the registered goods.

[25] Having said that, use evidenced with respect to one product cannot serve to maintain multiple goods in a registration [per *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Accordingly, to consider the exhibited invoice as evidence of a transfer within the meaning of section 4 of the Act, it would be necessary, at a minimum, to correlate an invoiced product to one specific registered good.

[26] When interpreting a statement of goods, it is well established that the meaning of terms can evolve over time and that an astutely meticulous analysis of the language used is not the correct approach for the purposes of section 45 proceedings. That being said, and although reasonable inferences may be drawn from the evidence provided, it is not for the Registrar to speculate as to the nature of the registered goods. It is the responsibility of the registered owner to show the connection between the goods registered and those included in the evidence [see, for example, *Fraser Milner Casgrain LLP v Fabric Life Ltd*, 2014 TMOB 135 at para 13].

[27] In the present case, the affiant indicates that the invoice is representative of “invoices for the sale of SOLARTRON Goods”, but makes no effort to correlate any of the invoiced products with specific Goods. Further, there is no information in the exhibited materials from which I can reasonably infer such correlations. Consequently, and given that the subject registration covers fairly specialized goods, I am unable to correlate the invoiced products without improperly speculating as to their nature.

[28] Likewise, I am not prepared to accept the statement at paragraph 6 of the Sides affidavit regarding sales of “each of the SOLARTRON Goods” as sufficient evidence of sales of each of the Goods. Even if this statement is accompanied with an aggregated sales figure, the sales figure is not broken down by item. As a result, the sales figure is of no assistance in establishing which specific Goods were sold. Without any evidence relating to sales of specific Goods, I find that the affiant’s assertion of sales and accompanying sales figure amounts to a bald assertion of sales of the registered goods in general, rather than a statement of fact showing use of the Mark in association with specific registered goods.

[29] Consequently, on the basis of the evidence before me, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

[30] In view of this conclusion, I find it is not necessary to address the Requesting Party’s alternative arguments, including the question of deviation of the Mark.

DISPOSITION

[31] As there is no evidence of special circumstances excusing non-use of the Mark before me, 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.

Eve Heafey
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE September 1, 2021

APPEARANCES

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For the Registered Owner

Steven Kennedy

For the Requesting Party

AGENTS OF RECORD

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For the Registered Owner

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For the Requesting Party