



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 058

Date of Decision: 2023-03-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Ronald S. Ade

Registered Owner: Federal Mogul Motorparts Corporation

Registration: TMA694,862 for CHAMPION & bow tie Design

INTRODUCTION

[1] This is a decision involving summary expungement proceedings under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA694,862 for the trademark CHAMPION & bow tie Design (the Mark), which is shown below.



[2] The Mark is registered in association with the following goods:

(1) Oil and fuel additives, power steering fluid; fuel injector cleaners, fuel system cleaners.

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

PROCEEDING

[4] At the request of Ronald S. Ade (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on March, 25, 2019, to Federal-Mogul Motorparts Corporation, the registered owner of the Mark at the time.

[5] I note that the Registrar updated the subject registration to record a change of name from the registered owner to Federal-Mogul Motorparts LLC (the Owner) on November 8, 2019, with an effective date of April 12, 2017. This change of name is not an issue in this proceeding.

[6] The notice required the Owner to show whether the Mark 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 March, 25, 2016 to March, 25, 2019.

[7] 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.

[8] Where the owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[9] In response to the Registrar’s notice, the Owner furnished the affidavit of Rebecca Mahan, sworn on October 24, 2019, to which were attached Exhibits A1 to C2. Only the Owner submitted written representations and was represented at an oral hearing.

[10] The Owner filed separate but similar affidavits and written representations in the section 45 proceedings involving Registration No. TMA754,289 for the trademark CHAMPION, and Registration No. TMA366,223 for the trademark CHAMPION & Design. These proceedings are the subject of separate decisions.

EVIDENCE

[11] In her affidavit, Ms. Mahan states that she has been the Owner's Marketing Communications Director since February 2018 and that she previously held the position of Global Brand Manager. She also states that the Owner provides vehicle manufacturers and customers in the automotive after-market business with maintenance, service and performance enhancing parts and products. The Owner also supplies parts and supplies for small engine applications including lawn and garden equipment [paras 1 to 3].

[12] Ms. Mahan attests that the Owner has used the Mark in association with "*Oil and fuel additives, fuel injector cleaners, fuel system cleaners*" (the Goods). In this respect, Ms. Mahan states that the Owner sold lawnmower maintenance kits (the Kits) containing the Goods and other items to consumers in Canada during the relevant period [para 8].

[13] Ms. Mahan explains that the Kits include a sparkplug, an air filter, a 594 ml bottle of lawnmower oil and a 74 ml bottle of fuel stabilizer. She also explains that the Kit's plastic packaging can be used as an oil funnel and drain pan. She describes the fuel stabilizer as a chemical additive that, when added to fuel, prevents the oxidization and degradation of the fuel which can occur when the fuel sits in an engine for an extended period of time. According to Ms. Mahan, the Owner's fuel stabilizer cleans carburetors and fuel injectors and also serves to assist in engine starting after periods of inactivity [paras 8 to 9, 16 and 21].

[14] In support to her statements concerning the Goods, Ms. Mahan provides three photographs of one Kit including the packaging and components thereof [Exhibits A.1 and A.2], two photographs of the lawnmower oil bottle included in the Kit shown in Exhibits A.1 and A.2 [Exhibit A.3], and one photograph of the fuel stabilizer bottle also

included in the Kit [Exhibit A.4]. Ms. Mahan states that the photographs are representative of the Kits and components thereof sold by the Owner in Canada during the relevant period [paras 9 to 15]. I note that the Mark is displayed on the front and back of the Kit's packaging and on the bottles of lawnmower oil and fuel stabilizer.

[15] Ms. Mahan states that the Kits were sold through authorized distributors and retailers, as well as on the sites of various Canadian hardware and automotive parts retailers. In particular, she states that the Owner sold around 3,100 Kits for nearly USD 20,000.00 in Canada during the relevant period [para 20].

[16] As further support of sales during the relevant period, Ms. Mahan provides three copies of invoices issued by the Owner to distributors and retailers in Canada between June 2016 and May 2018 showing sales of the Kits [Exhibits B.1 to B3]. Ms. Mahan confirms that the items identified with part numbers in the invoices are the Kits shown in exhibits A.1 to A.4 [paras 16 to 19].

PRELIMINARY REMARKS

[17] At the hearing, the counsel for the Owner conceded that the evidence is limited to the Goods indicated at paragraph 8 of the Mahan affidavit. As for the remaining goods specified in the registration, the evidence is silent with respect to use or any special circumstance excusing the absence of use of the Mark in association with them. Consequently, the registration will be amended to delete "power steering fluid" from the registration.

[18] Therefore, the sole issue to consider in this proceeding is whether, pursuant to section 4(1) of the Act, the evidence demonstrates use of the Mark in association with the Goods.

REASONS FOR DECISION

[19] In assessing the evidence, I have kept in mind that evidence in a section 45 proceeding must be considered as a whole [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB) at para 10] and

that a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9].

[20] In the present case, Ms. Mahan correlates the Kit's components, and specifically the oil and fuel additive, with the Goods. With respect to the fuel stabilizer, I find that the Owner has provided sufficient facts from which I can conclude that its function and nature is such that the Goods other than oil can be maintained. Indeed, Ms. Mahan describes the fuel stabilizer as both a cleaner and a chemical additive to be added to fuel, and confirms that its functions are to clean carburetors and fuel injectors and also to assist in starting the engine. In this respect, it has been established that an affiant's statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25]. Therefore, I accept that the oil and the fuel stabilizer shown in Exhibits A1 to A4 correlate to the Goods.

[21] Further, in view of the invoices in evidence, I am satisfied that the Goods were transferred in the Owner's normal course of trade to its distributors and retailers in Canada during the relevant period. Moreover, based on the representative photographs in evidence, I am satisfied the Mark was displayed on the Goods themselves when they were sold.

[22] Accordingly, I am satisfied that the Mark was used in Canada by the Owner in association with the Goods during the relevant period within the meaning of sections 4(1) and 45 of the Act.

DISPOSITION

[23] 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 "power steering fluid" from the statement of goods.

[24] Consequently, the amended statement of goods will read as follows:

(1) Oil and fuel additives, fuel injector cleaners, fuel system cleaners.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-03-08

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Erin Creber

AGENTS OF RECORD

For the Requesting Party: Ronald S. Ade

For the Registered Owner: Gowling WLG (Canada) LLP