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

Citation: 2016 TMOB 16
Date of Decision: 2016-01-27

IN THE MATTER OF AN OPPOSITION

Acer Incorporated	**Opponent**
and	
OTG Experience, LLC	**Applicant**
1,549,493 for ACER	**Application**

Background

[1] The Applicant's line of business is in the airport concession industry. The Applicant has been recognized throughout the airport restaurant and bar industry for its exceptional customer focus. Part of the Applicant's customer focus is integrating technology as a key component of its customer experience, through the introduction of Apple iPads at its restaurants to display its menu and for customer use. The Applicant has applied to register the trade-mark ACER (the Mark) in association with restaurant services based on proposed use in Canada.

[2] The Opponent was formed as a corporation in 1976 and is a multinational hardware and electronics corporation. The Opponent has corporate offices worldwide, including North America, Italy, Switzerland and Taiwan. The Opponent's ACER trade-marks are registered in association with a long list of computer related goods and services, including desktop and laptop computers, tablet computers, servers, storage devices, displays, smartphones and computer

peripheral. Between 2003 and 2013, ACER trade-marked goods have had net worldwide sales of approximately $132,000,000,000 U.S.

[3] As noted by the Supreme Court of Canada in *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321, famous brands are deserving of a broader ambit of protection and in some cases, the courts have emphasized that a significant dissimilarity in goods or services is no longer fatal for a finding of confusion. However, while the Court agreed that a relatively strong trade-mark can leap vast product line differences at a single bound, it is implicit in this statement that the product line will generally represent a significant obstacle for even a famous mark to leap over [*Mattel*, *supra* at 355-356]. The Court further stated that in some circumstances, the difference in goods or services will carry greater weight than the other surrounding circumstances [*Mattel*, *supra* at 354].

[4] As was the case with *Mattel*, the Opponent in the present case relies on the fact that the Applicant's Mark is virtually identical to its ACER trade-marks and it submits that due to the fame of its trade-marks, a likelihood of confusion would arise despite any differences in the nature of the goods and services or the channels of trade of the parties. The Opponent asserts that there is an association in the minds of Canadian consumers between technology related items. Accordingly, and given the fame of the Opponent's ACER marks, an ordinary consumer could very easily mistakenly associate a restaurant featuring such technology with the Opponent.

[5] The evidence put forward, however, is insufficient for me to make such a finding. For the reasons that follow, the opposition is unsuccessful.

File Record

[6] On October 27, 2011, the Applicant filed application No. 1,549,493 for the Mark based on proposed use in Canada in association with restaurant services. On October 27, 2011, the Opponent filed a statement of opposition alleging several different grounds of opposition including non-compliance with section 30 of the *Trade-marks Act*, RSC 1985 c T-13 (the Act), non-registrability, non-entitlement and non-distinctiveness. Most of the grounds of opposition turn on the issue of whether there is a reasonable likelihood of confusion between the Mark and at least one or more of the Opponent's family of registered, applied for and used ACER trade-

mark applications or registrations for computers and related goods and services (see attached Schedule A), or the Opponent's trade-name Acer Incorporated.

[7] The Applicant filed a counter statement on November 23, 2012, denying each of the Opponent's allegations.

[8] The Opponent filed as its evidence in chief the affidavits of Sharon Hogan, senior paralegal in the employ of Gateway, Inc., Katherine Guilmette, trade-mark agent employed by McFadden, Fincham Inc. and Kelly Sears, administrative assistant in the employ of McFadden Fincham Inc. The Applicant's evidence comprises the affidavits of Christopher J. Redd, Vice-President and General Counsel of the Applicant, Alwyn Phillips, articling student with the Applicant's agent, Paulette Howes, law clerk with the Applicant's agent, Danielle Murphy, law clerk with the Applicant's agent, and Anick Desautels, Aja Campbell, Sandro Romeo, all employees of Thomson CompuMark, an intellectual property research firm. As its evidence in reply, the Opponent filed a second affidavit of Sharon Hogan. None of the affiants was cross examined.

[9] Both parties submitted written arguments and both were represented at an oral hearing.

Material Dates/Onus

[10] The material date for assessing each ground of opposition varies as follows: non-conformance with sections 30(e) and 30(i) – the filing date of the application; non-registrability under the section 12(1)(d) ground - today's date [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]; non-entitlement under the section 16 grounds – filing date of the application; and non-distinctiveness under the section 38(2)(d)/2 ground – the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably

be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition Summarily Dismissed

Non-compliance – Section 30(i)

[12] The Opponent pleads that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because the Applicant was aware or should have been aware of the Opponent's previously applied for ACER Design trade-marks under registration numbers TMA702,009, TMA583,567; TMA370,534; and TMA381,003 and its previously applied for trade-marks ACER & Design and ACERCLOUD under application numbers 1,523,711 and 1,534,520.

[13] Section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of an opponent's trade-mark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use the mark [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[14] In the present case, the Applicant has provided the necessary statement and this is not an exceptional case. This ground is accordingly dismissed.

Non-compliance – Section 30(e)

[15] The Opponent pleads that the application does not conform to the requirements of section 30(e) of the Act because at the date of filing of the application, the Applicant had used and/or was using its Mark in Canada in connection with the applied for services.

[16] The Opponent did not file any supporting evidence or make any submissions with respect to this ground of opposition. The section 30(e) ground of opposition can therefore be summarily

dismissed on the basis that the Opponent has not met its initial evidentiary burden in respect thereof.

Determinative Issue – Likelihood of Confusion

[17] As noted above, while various grounds of opposition are pleaded, the determinative issue for decision is whether the Mark is confusing with the Opponent's Acer Incorporated trade-name or at least one of the Opponent's trade-mark applications, registrations or previously used marks.

[18] The Opponent's case regarding confusion is strongest under the section 12(1)(d) ground of opposition because its later material date allows all of the Opponent's evidence concerning its reputation to be considered. Therefore, if the Opponent is not successful under section 12(1)(d), then it will not be successful under the section 16 and non-distinctiveness grounds either.

Section 12(1)(d) Ground of Opposition

[19] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with one or more of the following ACER & Design trade-marks (shown below) that have been registered by the Opponent: TMA702,009; TMA583,567; TMA370,534; and TMA381,003.

TMA370,534	TMA381,003	TMA583,567	TMA702,009
			

[20] I have exercised my discretion and confirm that each of these registrations is extant. The Opponent has therefore met its initial burden under this ground.

[21] In view that the Opponent's ACER logo does not appear to have changed much over the years, I will refer to the Opponent's registered marks collectively as the Opponent's ACER mark.

Test for confusion

[22] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act, shown below:

> The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services … associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the goods or services . . . are of the same general class.

[23] As noted above, section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's restaurant services sold under the Mark would believe that the restaurant services were provided, authorized or licensed by the Opponent who offers its computer related goods and services under virtually the same mark. The legal onus is on the Applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

[24] In making such an assessment I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

> The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[25] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. In most instances, the dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145, conf. 60 C.P.R. (2d) 70 (FCTD)]. In *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC), the Supreme Court of Canada considered the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion (see para 49):

> …the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis … if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar… As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[26] In this proceeding, the Mark is virtually identical in appearance, sound and ideas suggested to the Opponent's ACER trade-marks as the stylization of the word ACER in the Opponent's design trade-marks does not impact the similarity between the marks in appearance to any great extent. Accordingly, as reasoned in *Masterpiece, supra,* the remaining factors must be carefully considered since they take on added significance in these circumstances,

section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[27] As noted by the Applicant, this factor is broken down into two separate considerations, namely, the inherent distinctiveness of the marks and the acquired distinctiveness of the marks.

[28] The Applicant submits that the word "acer" is an ordinary dictionary word which means any tree or shrub of the genus Acer, often cultivated for their brightly colored foliage (English Collins Dictionary). As evidenced by the Howes and Murphy Affidavits, the word ACER and variations of it (which include phonetic equivalents) have been registered and used by

third parties across a broad spectrum of goods and services. The Phillips Affidavit shows that the word ACER is often used by third parties in association with landscaping and gardening.

[29] In my view, even though both parties' marks are comprised of an ordinary dictionary word, in view that this word is not suggestive of either parties' goods or services, I find the marks of both parties to be inherently distinctive.

[30] With respect to the acquired distinctiveness of the trade-marks, I am satisfied from the evidence furnished that the Opponent's ACER mark has become known to a significant extent in Canada in association with personal computers, and related goods and services. It is to be noted that some of the evidence discussed below refers to one or more of the design versions of the ACER marks registered by the Opponent.

[31] The evidence of the Opponent's affiant, Ms. Hogan, can be summarized as follows:

- The Opponent was formed as a corporation in 1976, headquartered in Hsinchu City, Taiwan; The Opponent is a multinational hardware and electronics corporation whose goods are well known and sold worldwide (para. 2);
- The Opponent manufactures and sells desktop and laptop computers, tablet computers, servers, storage devices, displays, smartphones and computer peripherals (the Goods) (para. 3);
- On October 16, 2007, the Opponent acquired Gateway, Inc. and its subsidiary companies; Gateway became a privately held company and a wholly owned subsidiary of Acer Incorporated; Gateway Inc. continues to operate under the name Gateway, Inc. (para. 4);
- In January, 2008, the Opponent acquired European computer company Packard Bell; With the acquisitions of Gateway, Inc. and Packard Bell, the Opponent created a multi-branded computer company with over $15 billion U.S. in revenuews and shipsments in excess of 20 million units per year by 2008 (para. 5);
- Acer Incorporated has corporate offices worldwide, including in North America, Italy, Switzerland and Taiwan (para. 6);
- the Opponent sells its goods under the ACER logo which has been used and registered worldwide since at least as early as 1987 (para. 7);
- the Opponent's ACER logo has not changed significantly over the years and over the last ten years has been known for its green colour (para. 7);

- the Opponent uses its ACER logo on all Goods sold, on all packaging, and on the company website (para. 7);

- between 2003 and the time the evidence was submitted, the Opponent had net worldwide sales of approximately $132,000,000,000 (para. 8);

- sales in Canada of the Opponent's ACER Goods from 2003 – 2012 were estimated to be over $3.7 billion (U.S.) (para. 9);

- the Opponent's ACER Goods are sold, and have for many years prior to the filing of the Applicant's application been sold, in Canada through retail stores such as Walmart, Best Buy, Future Shop, Costco, Staples, The Source as well as through specialized computer shops (para. 9);

- the Opponent has been presented with many awards and accolades for its goods in magazines, newspapers, award ceremonies and the like (para. 10, Exhibits A and B);

- the Opponent was an official worldwide TOP Partner representing the highest level of corporate sponsorship of the 2010 Vancouver Olympic Games and the 2012 London Summer Olympic Games (para. 13); and

- the Opponent has sponsored many major sporting events worldwide (para. 14; Exhibit D).

[32] Ms. Hogan also states that during the years 2003 – 2012, over $890,000 U.S. was spent on advertising the Opponent's ACER Goods. Although we do not know what part of this amount was spent on advertising the Opponent's ACER Goods in Canada, representative flyers and advertisements of the Opponent's ACER Goods distributed in Canada for the years 2010 – 2013 are provided by Ms. Hogan as Exhibit X (paras 11, 12 and 34).

[33] Ms. Hogan's affidavit evidence establishes that the Opponent's ACER mark was very well known, if not famous, in Canada at all material times when used in association with computer related goods and services.

[34] On the other hand, the Applicant has not shown any use of its proposed use Mark. As a result, overall, this factor favours the Opponent.

section 6(5)(b) - the length of time each trade-mark has been in use

[35] As noted above, the application for the Mark is based upon proposed use in Canada and the Applicant has not filed any evidence to show that any use of the Mark has commenced to

date. By contrast, one of the Opponent's ACER marks has been registered since 1987 and the Opponent has provided evidence of use of its ACER mark in Canada since at least as early as 2003. This factor therefore favours the Opponent.

sections 6(5)(c) and (d) - the nature of the goods, services or business; the nature of the trade

[36] When considering sections 6(5)(c) and (d) of the Act, it is the statement of services in the application for the Mark and the statement of goods and services in the Opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. Those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. Evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[37] Relying on the FCA decision in *ITV Technologies, Inc v WIC Television Ltd* (2003), 29 CPR (4th) 182 at 218 (FCTD), aff'd 2005, 38 CPR (4th) 481 (FCA), the Opponent submits that similarity in the respective goods or services cannot be the *sine qua non* in the determination of confusion as section 6(2) of the Act dictates that confusion may result whether or not the goods or services are of the same general class. The Applicant, on the other hand, submits that where trade-marks are similar, the degree to which the goods or services are similar will be a large factor in determining whether confusion is likely to result. The Applicant refers to the following statement made by the FCA in *Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA):

> "…the ultimate test is confusion, and where one product does not suggest the other it will be a strong indication that confusion is unlikely. The nature of the wares, services and business, therefore, though not always controlling are certainly of significance".

[38] It is clear from the description of goods and services that the goods and services covered by the Opponent's registrations and the application for the Mark differ substantially, even taking

into account that some aspects of the Applicant's restaurant services will incorporate the use of a tablet. In this regard, the Opponent's marks are registered in association with a long list of computer related goods and services. By contrast, the applied for services are restaurant services. The parties' goods and services are directed at completely different target markets – those wishing to purchase computer goods and services and those wishing to purchase prepared food and beverages. The fact that the Applicant proposes to use Apple iPads to display its restaurant menu will be considered in further detail below as a further surrounding circumstance.

[39] With respect to the parties' channels of trade, the Opponent's registered goods and services are not the types of goods and services that are sold in restaurants. In this regard, while the Opponent submits that it promotes, advertises and displays its goods by way of social media on its Facebook page (Sears, para. 5; Exhibit E), its services are available online through its various websites (Guilmette, para. 8 and Sears, para. 4 & 5; Exhibits C & D) and its goods are marketed through multiple channels including Walmart, Best Buy, Future Shop, Costco, Staples, The Source as well as specialized computer stores (Guilmette, para. 2; Exhibit A), the Opponent does not reference sales of authorized products in restaurants. Further, the unchallenged and uncontradicted evidence in the Redd affidavit confirms that the Applicant does not intend to offer for sale computer products or any of the other goods or services listed in the Opponent's Canadian trade-mark registrations in its ACER restaurants in Canada [Redd, para. 7]. While I appreciate that the Applicant's applied for services do not contain this specific restriction, I am prepared to also take judicial notice that it is not in the normal course of trade for a restaurant to sell computer products. I therefore do not find it likely that the parties' respective channels of trade would ever overlap.

Other surrounding circumstances

Fame of the Opponent's ACER marks and Intended Manner of Use of the Mark

[40] The Opponent submits that in view of the evidence showing that ACER is famous and well known in the computer industry, the Applicant's intention to use the word ACER in association with a restaurant, along with the free use of an Apple iPad at each table bearing a menu displaying the word ACER**,** contributes to there being a likelihood of confusion between the marks in the present case.

[41] The Applicant, on the other hand, relies on several decisions wherein the stark differences between the goods or services of the parties has been recognized by the Supreme Court of Canada as significant in finding no confusion between identical trade-marks, even in the case of famous trade-marks [see *Mattel, supra*, *Toyota Jidosha Kabushiki Kaisha v Lexus Foods Inc* (2000), 9 CPR (4th) 297, and *Veuve Cliquot, supra*].

[42] Although not referred to by the parties, I find it helpful to reproduce the following excerpt from my decision in *Canadian Pacific Ltd v Yasmin Products Pty Ltd* (2004), 42 CPR (4th) 455 where I summarized the governing jurisprudence on this issue as follows at pages 463-464:

> In *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247, the Federal Court of Appeal had this to say about the difference between the parties' wares and services in that case:
>
> > "...the Act makes clear that what is being protected is not the exclusive right to any mark that a person might think of, but the exclusive right to use it in association with certain products or services.
> >
> > "A trade-mark is a mark used by a person to distinguish his wares or services from those of others. The mark, therefore, cannot be considered in isolation, but only in connection with those wares or services. This is evident from the wording of subsection 6(2). The question posed by that subsection does not concern the confusion of marks, but the confusion of goods or services from one source as being from another source."
> >
> > "The wide scope of protection afforded by the fame of the appellant's mark only becomes relevant when applying it to a connection between the applicant's and the opponent's trade and services. No matter how famous a mark is, it cannot be used to create a connection that does not exist."
> >
> > "United Artists produces movies. It does not manufacture or distribute beauty products. United Artists' products are not likely to be made available in the same places of trade as the appellant's products. Shampoo is not sold in movie theatres or video stores. Videos are not available in beauty parlours. These are facts recognized by the Trial Judge, but they bear emphasizing. What the Trial Judge did not give sufficient weight to is that, not only were the wares in each case completely disparate, but there is no connection whatsoever between them. As I stated earlier, where no such connection exists a finding of confusion will be rare."

In *Toyota Jidosha Kabushiki Kaisha v. Lexus Foods Inc.* (2000), 9 C.P.R. (4th) 297, November 20, 2000, A-622-99, at page 6 the Federal Court of Appeal said the following about the extent to which notoriety might extend the scope of protection accorded to a trade-mark [p. 301, C.P.R.]:

> "Famousness alone does not protect a trade-mark absolutely. It is merely a factor that must be weighed in connection with all the rest of the factors. If the fame of a name could prevent any other use of it, the fundamental concept of a trade-mark being granted in relation to certain wares would be rendered meaningless."

More recently, in *Mattel Inc. v. 3894207 Canada Inc.* (2004), 30 C.P.R. (4th) 456 (F.C.T.D.), Justice Rouleau stated the following at p. 465:

> "The notoriety of a mark is only one factor that must be taken into consideration. If the fame of a name could prevent any other use of this name, the fundamental concept of granting a trade-mark in association with certain wares would be rendered meaningless."

[43] I agree with the Opponent that the evidence establishes that there would be an association in the minds of Canadian consumers between computer-related goods and services and the Opponent's ACER trade-mark. The Opponent's evidence does not, however, establish that its ACER trade-mark has become famous for anything other than computer related goods and services.

[44] In view that the applied for restaurant services are clearly different from the Opponent`s computer related goods and services, the key factor in considering the extent to which the Opponent's famous mark transcends the computer industry with which it is normally associated is whether an ordinary consumer is likely to mistakenly infer that the Applicant's restaurant services come from the Opponent or are in some way associated with the Opponent. The Opponent submits that in the present case, the manner in which the Mark is used or intended to be used is relevant to this determination.

[45] Evidence regarding the manner in which the Applicant's Mark is intended to be used was presented in the evidence of Mr. Redd and Ms. Guilmette. I highlight the following points from Mr. Redd's and Ms. Guilmette's affidavits:

- Since its entry into airports in 1996, the Applicant has been recognized throughout the airport restaurant and bar industry for its exceptional customer focus;

- In February, 2012, the Applicant's Canadian affiliate and licensee, OTG Management YYZ, LLC acquired a contract with the Greater Toronto Airports Authority (GTAA), the operator of Toronto Pearson International Airport to open a number of restaurants and bars at this airport;
- Part of the Applicant's customer focus is integrating technology as a key component of its customer experience, through the introduction of 7000 new Apple iPads at its restaurants in three major international airports – LaGuardia, Minneapolis-St. Paul and Toronto Pearson;
- Providing its customers with Apple iPads allows customers to order food and beverages, log in to their Facebook, Twitter and personal email accounts, check their flight status, play games and watch the news; and
- Such Apple iPads will contain the proposed menu for the ACER restaurant and bar and will provide a diversion to customers while there.

[46] The actual or intended use of a trade-mark in the marketplace has been considered by the Court to be relevant in certain circumstances. For example, in *Wrangler Apparel Corp v Timberland Company* (2005), 41 CPR (4th) 223 (FC), the Federal Court stated the following regarding the relevance of how a mark is used:

> For purposes of registrability, the Applicant asserts that the Registrar can only look at the mark as it is to be registered and not on how it is to be used in the marketplace (*Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) (F.C.A.) at 11). In other words, the Applicant argues that, while this evidence might be relevant for a passing off action, the Registrar should not have given it any weight in assessing confusion.
>
> I do not see any error. While marks must not be dissected for minute examination, individual features of a mark may be examined for comparison purposes (*United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.), at para. 34. The first part of a mark is particularly important and is often examined on its own (*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188). **The Registrar may also look to how marks are presented to the public (*Pink Panther* at para. 37).** In this case, the Registrar notes that, in presentation of the mark, the Applicant often downplays the words BY WRANGLER. Based on the jurisprudence referred to, I view this examination of the Applicant's mark as entirely acceptable. (emphasis added)

[47] In the present case, the only evidence of the Applicant's intended use is that it has expressed the intention to provide the free use of an Apple iPad upon which it would display its restaurant menu in association with the Mark ACER. In my view, the use of a tablet in a restaurant does not create a "nexus" or connection in the minds of consumers between restaurant services and the Opponent's registered goods or services such that there is an increased

likelihood that a consumer is likely to mistakenly infer that the Applicant's restaurant services come from the Opponent or are in some way associated with the Opponent.

[48] In my view, a consumer who would enter the Applicant's restaurant in an airport would presumably come there for the purpose of eating, not for the purpose of buying computer related goods or services. In view that the average consumer likely uses technology on a daily basis (as both parties have agreed), it may not come as a surprise to him or her that the restaurant in which they have just entered has decided to use technology as a key component of its customer experience.

[49] In view of the above, I do not find that the fame of the Opponent's marks transcends the computer goods and services with which it is normally associated. I also do not find that the manner in which the Applicant intends to use the Mark in association with its restaurant services contributes to there being a likelihood of confusion between the parties' marks in the present case.

State of the Register and State of the Marketplace evidence

[50] The state of the register and state of the marketplace evidence filed by the Applicant is voluminous. I will summarize the most pertinent points of this evidence below, address some of the Opponent's objections to this evidence and then provide my analysis.

Howes Affidavit

[51] Ms Howes is a law clerk with the Applicant's agent. Her affidavit provides the following information:

- evidence of 2 co-existing Canadian trade-mark registrations for ACER – one for fertilizers and one for plasma arc cutting machines;
- evidence of 3 co-existing Canadian trade-mark registrations and 1 application for ACR within the computer goods and services field;
- evidence of 17 co-existing Canadian trade-mark registrations and 2 applications for ACER or ACR with various goods and services;

- printouts of Wayback machine archived pages (prior to September 2012) from about 17 third party websites using ACER or AACER in association with various goods and services; and

- a print-out of U.S. trade-mark registration No. 1568532 for the mark ACER owned by Hireko Trading Inc.

Phillips Affidavit

[52] Mr. Phillips was an articling student with the Applicant's agent. His affidavit attaches search results of Canada Yellow Pages for the years 2011, 2012, and 2013. The report lists 4 landscaping companies located in the Toronto area having the trade-name ACER between 2011 and 2013.

Murphy Affidavit

[53] Ms. Murphy was a law clerk with the Applicant's agent. Her affidavit provides print-outs of Wayback machine archived pages (prior to September 2012) from at least 11 third party websites using ACER in association with various goods and services.

Campbell, Desautels and Romeo Affidavits

[54] Ms. Campbell's affidavit comprises the results of a search of the Thomson & Thomson (d.b.a. Thomson CompuMark) search database in association with a Web Common Law search for the terms ACER, ACER, AACER or ACERR for all goods and services.

[55] The Desautels affidavit comprises the results of a search of the Thompson CompuMark search database in association with a Common Law Dilution search. The search parameters consisted of the term ACER as well as ACCER, AACER or ACERR for all goods and services.

[56] The Romero affidavit comprises the results of a Thompson CompuMark Domain Name database in association with a Domain Dilution (How Common) search. The search parameters consisted of the term ACER as well as ACCER, AACER, or ACERR for all goods and services.

Opponent's Submissions

[57] The Opponent submits that most of the Applicant's state of the register and state of the marketplace evidence is not relevant to the issue of confusion for a number of reasons, including the following:

- the only relevant search results are those for the word ACER, not those for ACCER, ACCER, AACER, ACERR, ACR, ACCR, or ACRR;
- the Hogan affidavit filed in reply to the Applicant's evidence consists of pointing out the irrelevancy of the searches conducted and evidence filed in the Desautels, Campbell and Romero affidavits since the results refer to goods or domain names owned by the Opponent or its subsidiary companies;
- none of the websites located by the Howes affidavit show use of ACER as a trade-mark or provide any indication as to the ownership of the domain name or the entity operating the website – it therefore cannot be concluded that the websites located do not belong to the Opponent or any of its affiliated companies; and
- the formation or registration of a company under a particular name by itself does not constitute use of that name as a trade-mark or a trade-name.

Analysis

[58] While state of the register evidence can be useful to assess the commonality or distinctiveness of a trade-mark or portion of a trade-mark in relation to the register as a whole, it is only relevant insofar as inferences may be made with respect to the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. The Applicant in this case has located a relatively large number of trade-marks on the Register and in the marketplace. However, I agree with the Opponent that the relevance of many of them is questionable.

[59] In this regard, businesses that are not in the computer or restaurant industry and marks or names that do not contain the actual word ACER or its phonetic equivalent (eg. AACER or ACERR) are not relevant because they are different in both appearance and sound from the

marks at issue and are not used in the same fields. The fact that some of the evidence may show use of the mark ACER (or its phonetic equivalent) in association with landscaping services, for example, is not all that surprising given the defined meaning of the word ACER set out above. The Applicant's Internet evidence is also of limited assistance because the contents thereof are hearsay and there is no evidence that Canadians viewed the websites. Further, as pointed out by the Hogan reply affidavit, none of the websites located by the Campbell, Desautels and Romeo searches provide any indication as to the ownership of the domain name or the company operating the website. It therefore cannot be concluded that the websites located do not belong to the Opponent or one of its subsidiary companies. Finally, the existence of one third party U.S. registration for the mark ACER is not relevant to the issue of the likelihood of confusion in Canada.

[60] In summary, I do not find the Applicant's evidence sufficient to show that use of ACER by the Opponent is not inherently distinctive such that the Opponent should therefore be entitled to a narrower scope of protection for its ACER mark.

Use of Opponent's ACER mark with sub-branded product lines

[61] The Applicant submits that the Opponent incorporates add-on elements to its branding to further distinguish between the Opponent's product lines. In this regard, the Opponent's evidence shows that the Opponent uses ACER in connection with a number of sub-branded product lines including the following: Acer Aspire, Acer Veriton, Acer Ferrari One, Acer Predator, Acer Iconnia, etc.

[62] I agree with the Applicant that the fact that the Opponent's ACER mark is often used in connection with sub-brands serves to further distinguish the Opponent's goods and services from those of the Applicant.

Conclusion

[63] Although the Mark and the Opponent's trade-marks are virtually identical, the Opponent's use of its trade-marks in Canada has been limited to sales of computer goods and related services. I see no reason why the extensive reputation of the Opponent in Canada would

extend beyond its goods and services to those in the subject application, such that the average consumer would, as a matter of first impression, be confused as to the source of the services, or think that the services of the Applicant are in some way associated with the goods or services of the Opponent. I agree with Linden J.A. in *Pink Panther, supra*, that in assessing the likelihood of confusion in the marketplace "we owe the average consumer a certain amount of credit". In my view, an ordinary consumer who attends the Applicant's restaurant and is presented with the Applicant's menu on a tablet would not, as a matter of first impression and imperfect recollection, likely mistakenly infer that the source of the restaurant services is the Opponent.

[64] As I am satisfied that the Applicant has met the legal onus upon it, the section 12(1)(d) ground of opposition is therefore unsuccessful.

Remaining Grounds of Opposition

[65] As indicated earlier, the section 12(1)(d) ground presented the Opponent's strongest case regarding the issue of confusion. The remaining grounds fail for reasons similar to those set out with respect to the section 12(1)(d) ground.

Disposition

[66] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

_____

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE: 2015-12-07

APPEARANCES

Donna White	FOR THE OPPONENT
Carol Hitchman	FOR THE APPLICANT

AGENTS OF RECORD

Osler Hoskin and Harcourt	FOR THE OPPONENT
Gardiner Roberts	FOR THE APPLICANT

Schedule A
Opponent`s Trade-mark Applications and Registrations

Trade-mark	Application or Registration Number	Goods or Services
	TMA702009	1) DVD player, DVD recorders, tuner, home projectors, router, game box, cable box, internet phone, video phone, kids PC, digital TV, auto PC, liquid crystal display PC, LCD monitor, wireless internet slate, personal digital assistant, palm size PC, computer workstation, computer accessories, namely storage boxes, server appliance for storage area networks, SAN (storage area network), computer hardware, computer software and programs for management and operation of wireless telecommunications devices, computer software for accessing, searching, indexing and retreiving information and data from global computer networks and global communication networks, and for browsing and navigating through web sites on said networks, and computer software for sending and receiving short messages and electronic mail and for filtering non-text information from the data, personal computers, desktop computers, notebook computers, all-in-one computers with LCD, all-in-one computers with CRT (cathode ray tube), handheld computers, portable computers, laptop computers, PC-TV, mobile computers, multi-processors computers, network servers, rack-mount servers, video-on-demand servers, voice-over IP servers, computer mother boards, computer set-up boxes, computer peripherals, keyboards, mouse, wireless keyboards, modems, modem cards, Ethernet network interface card, wireless network cards, equipment for wireless connection between portable electronic appliances, telecommunication machines and apparatus, namely, telephones, mobile telephones and personal digital assistance, internet phones, mobile phones, wireless internet phones, low-power mobile phones, integrated circuits, disk drives, optical disk drives, data storage equipment, namely, blank floppy disks, magnetic disks and optical disks, all of the aforementioned featuring memory for computers, printed circuit boards, interface cards, video cards, VGA (Video Graphics Array) cards, CRT monitor, computer chip, magnetic disc or tape with network management system and network operating system computer programs, optical CD-recorder, CD-rewritable recorder, wireless devices, namely, electronic handheld units for the wireless receipt or

		transmission of data that may also have the capacity to transmit and receive voice communications, computer scanners, printers, servers, parts and fittings for all the aforesaid goods **(2) LCD TV, PC camera, digital still camera, dual mode digital camera.** **(3) LCD monitors, modems, screen filters, computer bags, cameras, digital cameras, personal digital assitant, MP3 players, computer hardware, keyboards, printers, mouse, handheld computers, notebooks, computer cases, palm size PC, mobile computer, personal computer, CD-ROM recorder, computers, mouse pads, interfaced cards, TV, LCD TV, servers, internet servers, speakers**
acer	**TMA583567**	GOODS: **(1) LCD monitor, personal digital assistant, palm size PC, workstation, disc drives, computer hardware, computer software, personal computers, desktop computers, notebook computers, handheld computers, laptop computers, mobile computers, multi-processors computers, network servers, rack-mount servers, video-on-demand servers, voice-over-IP servers, computer mother board, computer peripherals, keyboards, mouse, wireless keyboards, wireless mouse, networking hardware, modems, modem cards.** **(2) Ethernet network interface card, wireless network cards, blue tooth cards, power supplies, switching power supplies, integrated circuits, disk drives, optical disk drives, computer memory, data storage equipments, printed circuit boards, video cards, VGA cards, CRT monitor, computer chips, magnetic disc or tape with rnetwork operation system computer programs, optical CD-Recorder, CD-Rewritable recorder, flat monitor, transistor, circuit boards, semi-conductor, silicon transistor, electronic circuit, semiconductor chip, printed circuit boards.** SERVICES: **(1) Provision of business information via computer systems, computerized business information storage and retrieval, dissemination of industry and business advertisement, marketing related to computers and parts thereof, analysis, design, research and consulting in computer-related fields which are related to establishing internal network structure, office-automation planning, maintenance of computers systems, design for catalogue, trademark, recruiting, market survey, public relations services, arranging and preparing trade fair, exhibition and exposition for industrial and commercial business.**

		(2) Providing multi-user access to a global computer information network for the transfer and dissemination of a wide range of information, providing online information including search engine and application service provider and in the field of computers, services relating to computer software, namely, computer software design, research and development for others, development of computer software relating to education, training and educational research, educational research services, analysis, research, consultation and advisory services, all relating to computer hardware and software; computer time-sharing services.
	**TMA370534**	GOODS: **(1) Computers, processors, visual display monitors, modems, printers, laser printers, keyboards, computer peripherals, including, computer input and computer output apparatus: computer instruments such as computer terminals, monitors, keyboards, mouse, light pens and bar code readers, switching power suppliers, expansion slots, add-on boards, memory expansion boards, disk drives, networking components, high resolution graphics display monitors and programs: telecommunication modems, computer software programs, instructional material, namely, books, manuals, brochures, magazines, drawings, periodicals, user's guides, workbooks and training manuals.** SERVICES: **(1) Services of wholesale, retail, marketing, distribution, import and export of computers, data processors and components and parts therefor, and computer programs and components therefor; services relating to computer software and hardware including design and development of computer software and data processing programs; services of development, design and installation of computers and computer programs; instruction in the use of computers and computer programs; computer programming and maintenance servicing and repair; services of vending and leasing of computer software and hardware; analysis, design, research, consultation and advisory services relating to the foregoing.**
	**TMA381003**	GOODS: **(1) Computers; processors; visual display monitors; modems, printers; laser printers, keyboards, computer peripherals, including, computer input and computer output apparatus, computer instruments such as computer terminals, monitors, keyboards, mouse, light pens and bar code readers,**

		switching power suppliers, expansion slots, add-on boards, memory expansion boards, disk drives, networking components, high resolution graphics display monitors and programs, telecommunication modems, computer software programs, instructional material, namely, books, manuals, brochures, magazines, drawings, periodicals, user's guides, workbooks and training manuals.
acer	**1523711**	GOODS: **(1) Computers; desktop computers; notebooks; netbooks, computer servers; network servers; Computer utility file storage programs; computer memory cards; computer monitors; television monitors; digital versatile disk rewriters; AC Adaptors for use with computers, notebooks and netbooks; keyboards; batteries for use with computers, notebooks and netbooks; smart handheld personal digital assistants; smart phones; mobile phones; televisions; Liquid Crystal Display Televisions; Plasma televisions; Projection televisions; TVCR, namely, video cassette recorder coupled with a television; DVD player coupled with a television; closed-circuit television (CCTV); TV remote controls; set-top box for use with television.** SERVICES: **(1) Providing space on a web site for the advertisement of the goods and services of others; advertising agency services; business management services; business administration services; retail department store services; promoting the services of others through the distribution of printed and audio promotional materials and by rendering sales promotional advice; Promoting the goods and services of others by means of operating an on-line shopping mall with links to retail web sites; retailing and distributorship of goods and services of others in the field of computers and computer peripherals via the global computer information network; business management consulting services; maintenance of computer systems; consulting services in the field of business management; consulting services in the field of personnel management; employment recruiting; market surveys; public relations services; manufacture, design, maintenance, test, analyze and consultation adviser of computer software systems and programs; computer data processing services; design and consultation services in the field of global computer information network; consultation for hardware integration; consultation for hardware and software integration of LAN system; Integrated Service Digital Network Digital**

		Subscriber Line (ISDL) services; Computer services, namely creating indexes of information and websites available on computer networks; wireless internet access service; ICP (Internet Content Provider) and Internet Portal services.
ACERCLOUD	**1534520**	GOODS: **(1) Computers, computer peripheral devices, namely, computer disk drives, computer memory cards, computer mouse, computer printers, computer scanners, computer servers, computer terminals; computer hardware; computer gaming machines, microprocessors, memory boards, monitors, display screens, computer keyboards, computer cables, modems, printers, disk drives, computer network adapters, computer network adapter cards, computer connectors and drivers; blank computer storage media, namely memory cards and memory sticks; blank magnetic data carriers, namely floppy discs, hard discs and plastic cards with a magnetic strip; downloadable electronic publications namely, books, plays, pamphlets, brochures, newsletters, journals, magazines, and periodicals on a wide range of topics of general interest; handheld digital electronic devices, namely, MP3 players, cellular telephones, hand held gaming machines, handheld computers, digital radio, cassette, compact disc, digital disc players and recorders, digital video cassette, compact disc, digital disc players and recorders, digital image compact disc, digital disc recorders and viewers; hand held computers, tablet computers, personal digital assistants, electronic organizers, electronic notepads; mobile digital electronic devices, namely, handheld computers, digital radio, cassette, compact disc, digital disc players and recorders, digital video cassette, compact disc, digital disc players and recorders, digital image compact disc, digital disc recorders and viewers; global positioning system (GPS) consisting of computers, computer software, transmitters, receivers, and network interface devices; telephones; cordless telephones; mobile telephones; parts and accessories for mobile telephones, namely, ear pieces, storage cases, battery chargers, screen protectors; facsimile machines, answering machines, cameras, videophones, electronic handheld units for the wireless receipt, storage and transmission of data and messages, namely, personal digital assistants, MP3 players, cellular telephones, hand held gaming machines, handheld computers and electronic devices that enable the user to keep track of and manage personal information, namely, personal digital assistants, MP3 players, cellular telephones, hand held gaming machines, handheld computers;**

		pre-recorded computer software containing printing fonts, printing typefaces, printing designs and printing symbols; computer chips, discs and tapes containing computer operating programs and software for recording music, movies, films, news; random access memory, read only memory; computer and electronic games; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; hard drives; miniature hard disk drive storage units; blank audio video discs, CD-ROMs, and digital versatile discs; pre-recorded audio video discs, CD-ROMs, and digital versatile discs namely, books, plays, pamphlets, brochures, newsletters, journals, magazines, and periodicals on a wide range of topics of general interest; mouse pads; batteries for cameras, cellular phones, watches, hearing aids and general purpose batteries; rechargeable batteries for cameras, cellular phones, watches, hearing aids and general purpose batteries; chargers for cellular telephones, personal digital assistants, hand held gaming machines; general purpose battery chargers; headphones; stereo headphones; in-ear headphones; stereo speakers; audio speakers; audio speakers for home; monitor speakers; speakers for computers; personal stereo speakers; radio receivers, amplifiers, sound recording and reproducing apparatus, namely, electric phonographs, record players, high fidelity stereos, tape recorders, loudspeakers, multiple speakers, microphones; audio cassette recorders and players, video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players; digital music and video players namely, personal digital assistants, MP3 players, cellular telephones, hand held gaming machines, handheld computers; radios; video cameras; audio, video, and digital mixers; radio transmitters; car radios; protective covers, carrying bags and carrying and storage cases to store and transport all of the aforesaid goods, made of leather, imitations of leather, cloth, or textile materials. SERVICES: **(1) Provision of news by electronic transmission via the Internet; providing multiple user access to a computer network and electronic news services online allowing users to download information and audio, video and voice data via a global computer network; delivery of digital music via the Internet; wireless digital messaging, paging services, and electronic mail services, namely services that enable a user to send and receive messages through a wireless data network; one-way and two-**

		way paging services; telex, telegram and local and long distance telephone services; broadcasting and transmission of radio and television programs; air time price packaging services for wireless communication via a global computer network; broadcasting pre-recorded videos namely, music television programs, motion pictures, news, sports, games, via a global computer network; streaming of videos namely, music, television programs, motion pictures, news, sports, games, via a global computer network; subscription radio broadcasting via a global computer network; radio broadcasting; radio broadcasting of news, music, concerts, and radio programs, broadcasting pre-recorded videos namely, music, television programs, motion pictures, news, sports, games, via computer and a global computer network; streaming of radio stations via a global computer network; electronic transmission via satellite, wireless and wan (wide area network) of music, television programs, motion pictures, news, sports, games, via a global computer network; electronic communication services via satellite, wireless and wan (wide area network), namely, on-line sharing of music, via a global computer network; providing on-line bulletin boards via a global computer network for the transmission of messages among computer users concerning music, concerts, movies, radio, television, film, news, sports, and games; electronic news services; facsimile, telephone voice message collection and transmission services; application service provider (ASP) services namely, software in the fields of web-based conferencing, audio conferencing, electronic messaging, document collaboration, video conferencing, and voice and call processing; application service provider (ASP) services namely, software for authorizing, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; design and development of computer hardware and software; computer hardware and software consulting services; multimedia and audio-visual software consulting services; computer programming; support and consultation services for developing computer systems, databases and applications; graphic design for the compilation of web pages on the Internet; information namely, computer hardware and software technical support services provided on-line from a global computer network and the Internet; creating and maintaining web-sites of others; hosting the web-sites of others; providing search engines for obtaining data via a global communication network; application service provider (ASP) services namely, software for use in

		connection with online music subscription service, software that enables users to play and program music; providing temporary internet access to use on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, namely, music, concerts, radio, television, news, sports, and games; providing search engines for obtaining data on a global computer network; information, advisory and consultancy services relating to all the aforesaid; operating search engines for others; computer consulting and support services for scanning information onto computer discs; creating indexes of online information, sites and other resources available on global computer networks for others; providing user access to the Internet (service providers); online social networking services on global computer networks; providing a social networking website; Engineering services for telecommunications and data networking.