

TRADUCTION/TRANSLATION



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

Citation: 2011 TMOB 2
Date of Decision: 2011-01-04

**IN THE MATTER OF AN OPPOSITION
by Oakley, Inc. and Oakley Canada Inc.
to application No. 1,301,223 for the trade-
mark HIGH RESOLUTION VISION in
the name of Essilor International
(Compagnie Générale D'Optique)**

[1] On May 11, 2006, Essilor International (Compagnie Générale D'Optique) (the Applicant) filed an application for the trade-mark HIGH RESOLUTION VISION (the Mark) for proposed use in Canada in association with the following wares: "eyeglass lenses" (the Wares).

[2] The application includes a disclaimer of the right to the exclusive use of the word VISION apart from the Mark. The application claims a priority date under section 34 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), on the ground that an application for registration of the same trade-mark was filed in France by the Applicant on November 16, 2005, under No. 05/3391867. The original application was also filed on the basis of use and registration of the Mark in France. The basis for this registration was however voluntarily withdrawn by the Applicant on November 9, 2007. I will return to this aspect later on in my decision.

[3] The application was advertised in the *Trade-marks Journal* on April 18, 2007.

[4] Oakley, Inc. and Oakley Canada Inc. (collectively referred to as the Opponent) filed a statement of opposition against that application on September 18, 2007. The four grounds of opposition may be summarized as follows:

1. With regard to the provisions of section 12(1)(d) of the Act, the Mark is not registrable in that it is confusing with the Opponent's HIGH DEFINITION OPTICS trade-mark registered under No. TMA412,118 in association with the following wares: "Spectacles, goggles, anti-glare glasses and sunglasses and their parts and accessories, including replacement lenses, frames, earstems and nosepieces; cases specially adapted for spectacles and sunglasses and their parts and accessories; clothing namely, t-shirts, gloves, racing pants, hats, sweatshirts, sportshirts, jackets, jeans, jerseys and ski pants, jackets and socks";
2. The Applicant is not the person entitled to the registration of the Mark with regard to the provisions of section 16(3)(a) of the Act in that the Mark is confusing with the Opponent's mark used prior to the filing date of the application, or the priority date, and which continues to be used by the Opponent in association with the wares listed under registration No. TMA412,118;
3. The Mark is not distinctive of the Applicant's Wares within the meaning of section 2 of the Act in that the Mark is not adapted to distinguish and does not actually distinguish the Applicant's Wares from the Opponent's wares in association with which the Opponent's mark is used; and
4. The application does not comply with the requirements of section 30(d) of the Act in that the Mark has not been used in France by the Applicant as alleged in the application.

[5] I reproduce below the fifth ground, as argued by the Opponent:

At the date of application by the Applicant, the Applicant was well aware or ought to have been aware of the existence of the [Opponent], and the use and notoriety of its [HIGH DEFINITION OPTICS] trade-mark in Canada. The Applicant could not have

been satisfied under s. 30(i) of its entitlement to use the [Mark]. Moreover, the Applicant's use of the [Mark] in issue will result in the damage to the goodwill of the registration relied upon herein contrary to s. 22 of the Act. The [Opponent] object[s] to any use of the [Mark] in Canada[.]

[6] On November 9, 2007, the Applicant filed a counter statement denying all the grounds of opposition. At the same time, the Applicant filed an amended application for registration in which the basis of the application based on registration and use of the Mark in France was withdrawn. As I pointed out to the parties at the hearing, it appears that this application for registration was not processed by the Registrar. On behalf of the Registrar, I accepted the amended application for registration at the hearing.

[7] In support of its opposition, the Opponent filed an affidavit of Elenita Anastacio, a trade-mark searcher with the law firm and trade-mark agency representing the Opponent in this proceeding, sworn June 9, 2008, the goal of which was to introduce into evidence a copy of the Opponent's registration No. TMA412,118. In support of its application, the Applicant filed certified copies of eight trade-mark registrations held by third parties and having as a component the expression "HIGH DEFINITION".

[8] Only the Applicant filed a written argument. As indicated previously, both parties participated in a hearing.

Analysis

[9] The Applicant has the onus of showing that its application complies with the requirements of the Act. However, the Opponent bears the burden of ensuring that each of its grounds of opposition is duly argued and of discharging its initial evidentiary burden by establishing the facts supporting its grounds of opposition. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that none of the grounds of opposition impedes the registration of the Mark [*Massimo De Berardinis v. Decaria Hair Studio* (1984), 2 C.P.R. (3d) 319 (T.M.O.B.); *John Labatt Ltd. v. Molson Co.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Joseph E. Seagram & Sons Ltd. et al c. Seagram Real Estate Ltd.*, (1984) 3 C.P.R.

(3d) 325 (T.M.O.B.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al*, (2002), 20 C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp. v. The Timberland Company*, 2005 FC 722].

[10] Applying these principles to this case, the only ground of opposition the Registrar must decide on is that based on section 12(1)(i) of the Act. Grounds of opposition 2 to 5 are dismissed for the following reasons:

(i) Ground based on section 16(3)(a) of the Act: the Opponent has not met its initial burden of proof. To discharge its initial burden of proof in regard to section 16(3)(a), the Opponent must show that its trade-mark was used or made known in Canada prior to the filing date of the application (in this case the priority date of November 16, 2005) and that it had not abandoned the use at the date of advertisement of the application [section 16(5)]. The Opponent did not file any evidence of use of its trade-mark. The mere filing of a certified copy of registration No. TMA412,118 can establish no more than *de minimis* use of the HIGH DEFINITION OPTICS trade-mark [*Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Such use does not meet the requirements of section 16(3)(a) of the Act;

(ii) Ground based on non-distinctiveness: the Opponent has not met its initial burden of proof. To discharge its initial burden of proof in regard to the non-distinctiveness of the Mark, the Opponent must establish that, at the date of the statement of opposition, its trade-mark had become sufficiently known in Canada to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No.6 Motel Ltd.* (1981) 56 C.P.R. (4th) 44 (F.C.)]. As indicated above, the Opponent did not file any evidence of use of its trade-mark. The assumption of *de minimis* use mentioned above does not satisfy the Opponent's evidentiary burden;

(iii) Ground based on section 30(d) of the Act: given that the basis for the registration founded registration and use of the Mark in France was voluntarily withdrawn by the Applicant, this ground of opposition is moot and therefore not valid; and

(iv) Fifth ground: this ground, as pleaded, is not a proper ground of opposition. The mere fact that the Applicant may have been aware of the existence of the Opponent's prior registered trade-mark does not preclude it from making the statement in its application

required by section 30(i) of the Act. Moreover, no evidence has been filed by the Opponent in support of its allegation that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada.

I will add on this point that it is not clear that the Opponent's allegation based on section 22 of the Act is tied to section 30(i). In any event, I have no evidence that would enable me to be convinced of the existence of any goodwill attaching to the Opponent's trade-mark that would support the Opponent's submissions based on section 22 of the Act. In the circumstances, I do not find it necessary to discuss the fifth ground of opposition any further.

[11] There remains the ground of opposition based on section 12(1)(d) of the Act.

Ground based on section 12(1)(d) of the Act

[12] As indicated above, the Opponent has provided through the affidavit of Ms. Anastacio, a copy of registration No. TMA412,118 for the HIGH DEFINITION OPTICS trade-mark relied upon in support of its section 12(1)(d) ground of opposition. I have exercised my discretion and confirmed that this registration still appears as valid in the Trade-marks Register. Accordingly, the Opponent has met its initial burden of proof. The Applicant must now show, on a balance of probabilities, that there is no likelihood of confusion between its Mark and the Opponent's. The material date with respect to the ground of opposition based on section 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[13] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[14] In deciding whether trade-marks are confusing, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act,

namely (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services, or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This is not an exhaustive list, and different weight may be attributed to each factor according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824].

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[15] The Mark consists of the expression “HIGH RESOLUTION” and the word “VISION”. The expression “high resolution” is defined as follows in the second edition of the *Canadian Oxford Dictionary*: “*adj.* (also high-res, hi-res) (of a display or image) showing a large amount of detail.” In turn, the word “vision” is defined as follows: “*n.* **1** the act or faculty of seeing. **2 a** a thing or person seen in a dream or trance. **b** a supernatural or prophetic apparition. **3** a thing or idea perceived vividly in the imagination (*had vision of sandy beaches*). **4** imaginative insight. **5** ability to plan or form policy in a far-sighted way, e.g. in politics. **6** a person etc. of unusual beauty . •*v.tr.* see or present in or as in a vision.”

[16] Considering the Mark in relation to the Wares covered by the application, it is my view that the Mark is highly suggestive of the quality of the Wares in that it suggests what the Applicant’s eyeglass lenses can procure, namely clearer vision. It should be noted in this respect that the Applicant has disclaimed the right to exclusive use of the word “vision” apart from the Mark. I am therefore of the view that the Mark possesses little inherent distinctiveness.

[17] The Opponent’s mark consists of the expression “HIGH DEFINITION” and the word “OPTICS”. The *Canadian Oxford Dictionary* defines “high definition” as follows: “*adj.* Designating or providing a relatively clear or distinct image (*high-definition TV*).” And “optics” is defined as “*n.pl.* **1** (treated as *sing.*) the scientific study of sight and the behaviour of light, or of other radiation or particles (*electron optics*). **2** the optical components of an instrument or apparatus. **3** the way in which something is perceived by the public.”

[18] Considering the Opponent's mark in relation to the wares covered by registration No. TMA412,118, I am of the opinion that this trade-mark too is highly suggestive of the character or quality of the Opponent's wares (with the exception of the clothing class) insofar as the word "OPTICS" describes the field in which the Opponent works and alludes to the components of the Opponent's glasses and "HIGH DEFINITION" suggests a clear image. It should be mentioned here that the Opponent's registration disclaims the right to the exclusive use of the word "OPTICS" apart from the trade-mark. I am therefore of the view that the Opponent's mark also possesses little inherent distinctiveness.

[19] The strength of a trade-mark may be increased by means of it becoming known through promotion and use. For lack of evidence of use of either of the marks at issue, I am unable to determine that they have become so known in Canada that their inherent distinctiveness has been enhanced. To the contrary, the marks both seem particularly and equally weak.

(b) the length of time the trade-marks have been in use

[20] As mentioned previously, there is no evidence that the parties' respective marks have been used. The present application for registration is based upon proposed use of the Mark in Canada. In comparison, registration No. TMA412,118, obtained on May 7, 1993, includes a claim of use in Canada of the HIGH DEFINITION OPTICS trade-mark by the Opponent since as early as February 1990. Given the assumption of *de minimis* use mentioned above, this factor tends to favour the Opponent.

(c) the nature of the wares, services or business; and (d) the nature of the trade

[21] The Wares listed by the Applicant in the present application are included in those listed in the Opponent's certificate of registration. For lack of evidence of use of the parties' trade-marks, I find it reasonable to conclude that their distribution channels and the nature of the trade at issue are the same, or, at least, likely to overlap. In this regard, I afford no weight to the Applicant's submission in its written argument that [TRANSLATION] "the parties' products are intended for eye care professionals who are able to make the necessary distinctions". This

argument is not supported by any evidence, nor is there any evidence that the products' ultimate consumers are different.

[22] Consequently, consideration of these third and fourth factors favours the Opponent.

(e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[23] “Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the overall surrounding circumstances.” [*Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.), at page 149, affirmed by (1982), 60 C.P.R. (2d) 70 (F.C.A.)].

[24] Moreover, as mentioned above, it is well established in case law that likelihood of confusion is a matter of first impression and imperfect recollection. In that respect, “[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it” [*Pink Panther Beauty Corp. v. United Artists Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.), at paragraph 34].

[25] The Opponent argues that the marks at issue are very similar in that both suggest the same idea. The marks consist of the expressions “HIGH DEFINITION” or “HIGH RESOLUTION” and the words “OPTICS” or “VISION”, which, for all intents and purposes, are synonymous. The marks at issue have the same number of syllables and letters. Their synonymous terms are located in the same position or placed in the same order.

[26] In its written argument, the Applicant submits, on the contrary, that the degree of resemblance between the parties’ respective trade-marks is low in that [TRANSLATION] “the only word shared by the two trade-marks is “high”, which most certainly is not very distinctive taken in isolation” and [TRANSLATION] “the other portions of the marks are different”.

[27] The Applicant adds that [TRANSLATION] “the Opponent’s mark has little inherent distinctiveness, and the Opponent cannot claim a monopoly over the idea expressed by its mark”.

[28] I agree with the Applicant that the marks in question have substantial visual and phonetic differences. However, I agree with the Opponent that the ideas suggested by the marks are similar albeit not identical. With regard to this point, I would like to reproduce a passage from Joliffe and Gill, *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th Edition, at page 8-65:

Trade-marks may differ in their various components and yet the idea or impression left on the mind may be such that they amount to confusing marks. Conversely, where the marks tend to suggest different meanings, there is less likelihood of confusion.

...

When it is contended that two words are confusing by reason of the fact that they suggest the same idea, regard should be had to the nature of the words. If the words are distinctive, in the sense of being invented words, small differences will not be sufficient to distinguish them, whereas if the words are common or descriptive in meaning, they must be taken with their disadvantages. No person is entitled to fence in the common of the English or French languages and words of a general nature cannot be appropriated over a wide area. [Emphasis added.]

[29] Given the low degree of inherent distinctiveness of the two parties’ trade-marks due to the descriptive or highly suggestive nature of their respective components in the context of the wares, it is my view that consideration of the fifth factor favours the Applicant.

Additional circumstance

[30] The Applicant argues that the Opponent does not have a monopoly over the use of the expression “HIGH DEFINITION”, since there are third parties who also own trade-marks using this expression. In particular, the Applicant relies on certified copies of the eight registrations of trade-marks held by third parties adduced in evidence, which have the expression “HIGH DEFINITION” as a component.

[31] The Opponent argues that these registrations are not particularly relevant, in that with the exception of two (namely registrations TMA623,762 and TMA632,085, held by Herzig Eye Institute Inc. for the HIGH DEFINITION VISION mark, and its design mark in association with

the services of “Refractive and cataract surgical procedure”), the wares and services covered by these registrations are completely different from those of the parties. As for registration Nos. TMA623,762 and TMA632,085, although they relate to eye care, one cannot conclude from only these registrations that the expression “HIGH DEFINITION” is widespread on the Canadian market in the parties’ industry.

[32] I agree with the Opponent that this evidence is not particularly useful in the circumstances. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can be drawn only where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Del Monte Corp. v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. Given the low number of registrations located, it is difficult to draw any inferences in favour of either party.

Conclusion – likelihood of confusion

[33] Considering the well-established principle in case law that, in the case of weak marks, small differences between the trade-marks are usually sufficient to avert all likelihood of confusion, I am of the view that the Applicant has established, on a balance of probabilities, that a consumer with an imperfect recollection of the Opponent’s mark HIGH DEFINITION OPTICS would not be likely to infer that the Wares bearing the Applicant’s Mark HIGH RESOLUTION VISION come from the same source or are otherwise connected or associated with the Opponent’s wares. As indicated previously, the trade-marks at issue both seem particularly weak to me. Since there has been no evidence that would lead me to conclude that the Opponent’s mark has been used, to a certain extent, to increase its distinctiveness, I find that the visual and phonetic differences between the marks, and, to a lesser extent, the ideas suggested by them, are sufficient to avoid a likelihood of confusion between them. Accordingly, I reject the ground of opposition based on section 12(1)(d) of the Act.

Disposition

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

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Johanna Kratz