



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

Citation: 2012 TMOB 234
Date of Decision: 2012-12-03

**IN THE MATTER OF AN OPPOSITION
by Safety-Kleen Systems, Inc. to
application No. 1,273,765 for the trade-
mark SK & Design in the name of SK
Corporation**

File Record

[1] On September 28, 2005, SK Corporation (the Applicant) filed an application to register the trade-mark SK & Design as illustrated hereinafter:



It is based on proposed use. After a couple of amendments the application now covers:

Ammonia, anti-corrosive contact spray, antifreeze solution, phenolic antioxidants, brake solution, butadiene, chemicals used in industry, namely: catalysts for treating engine exhaust, caustic soda for industrial purposes, chemical preparations for the manufacture of paints, diethyl malonate, diisopropyl malonate, diketene, dimethyl malonate, dimethyl terephthalate, dimethyl formamide, dimethylamine, epichlorohydrine, ethoxylate, ethylene, ethylene amines, ethylene glycol, ethylene oxide, ethylene vinyl acetate, fatty amine, fertilizer, fire extinguishing compositions for fighting fires, fluids for hydraulic circuits, formic acid, fumed silica, furfuryl alcohol, hypochlorite of soda, isopropyl alcohol, melamine, methyl chloride, methyl metal

acrylate, methylamine derivatives, methylene chloride, microorganism cultures for use in industry, science, agriculture, horticulture and forestry, neopentyl glycol, photoresist, plasticizer, polycrystalline silicone, polyester, polyethylene, polyethylene resins, polyethylene terephthalate, polymethylmeta acrylate, polypropylene, polypropylene resins, polytetrafluoro ethylene, polyvinyl butyral film, polyvinyl chloride, potassium sorbate, power steering fluid, propylene, purified terephthalic acids, refrigerants, semi-processed synthetic resins, silicones, sodium carboxymethyl cellulose styrene monomer, solvent, surface-active chemical agents, synthetic resins, terephthalic acids, tetramethyl ammonium chloride, tetramethyl ammonium hydroxide, toluene, transmission fluid, trimethylamine hydrochloric acid, unprocessed acrylic resins, unprocessed artificial resins, unprocessed epoxy resins, unprocessed plastics, unprocessed synthetic resins, urea, urethane resins, UV chemical stabilizer, vulcanization accelerators, water treatment compositions for human use to inhibit scaling, phosphate formation and corrosion (the Wares); and

Cable television broadcasting; cellular telephone services; text messaging, voice and video communication services by computer; communication by facsimile; text messaging, voice and video communication services by satellite; communication by telegram; electronic mail services; news agencies; radio broadcasting; text messaging, voice and video communication services by radio; radio telephone paging services; rental of broadcasting equipment; television and radio broadcasting services by satellite; text messaging, voice and video communication services by telephone; television broadcasting; video teleconferencing services (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 20, 2008. On March 27, 2008 Safety-Kleen Systems, Inc. (the Opponent) filed a statement of opposition which was forwarded by the Registrar to the Applicant on April 21, 2008.

[3] The grounds of opposition pleaded are:

1. The Mark is not registrable in view of section 12(1)(d) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) since the Mark is confusing with the Opponent's registered trade-marks SK Logo reproduced hereinafter in paragraph 9, certificate of registration TMA517,866 and SAFETY-KLEEN & SK Logo reproduced hereinafter in paragraph 13, certificate of registration TMA516,956 (collectively referred to as the Opponent's Trade-marks);
2. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the filing date of the application the Mark was confusing with one or more of the Opponent's Trade-marks as well as the trade-marks SK and SK SAFETY-KLEEN which had been previously used by the Opponent in Canada in association with industrial chemicals, cleaning components of automobiles, aircraft, industrial and agricultural machines and parts thereof used in manufacturing, service and repair facilities, and brushes, filters and replacement parts for such parts washers; cleaning and degreasing solvents for parts washing machines used in service, maintenance and repair and manufacturing, and cleaning emulsions and solvents used in immersion type cleaners for cleaning carburetors and other automotive, marine and

agricultural vehicle parts; automotive fluids and motor oil, including automotive oils, heavy duty motor oil, non-detergent motor oil, motor oil for severe service, diesel truck motor oil, tractor motor oil, high performance motor oil, two cycle motor oil, and refined motor oil; multi-purpose gear oil, snowmobile oil, red chain oil, transmission fluid, multi-purpose grease, hydraulic oil, oil for hydraulic jacks, power steering fluid, undercoating oil for prevention of rust corrosion, automatic transmission fluids, industrial oils and universal tractor fluids; anti-freeze, ethylene glycol, anti-freeze windshield washer liquid and refined motor oil;

3. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive of the Applicant because it does not distinguish, nor is it adapted to distinguish the Wares of the Applicant from the wares of the Opponent in view of the extensive and longstanding use by the Opponent of the confusingly similar trade-marks referred previously.

[4] In its counter statement filed on June 15, 2010 the Applicant denied all grounds of opposition.

[5] The Opponent produced a statement that it would not file any evidence. Subsequently it did request leave under section 44 of the *Trade-marks Regulations* to file as additional evidence the affidavits of Jennifer Stecyk and Grant Clark (sworn on February 11, 2009). Leave was granted. Thereafter the Opponent requested permission to file a second affidavit of Greg Clark (sworn on October 23, 2009). Permission was also granted. The Applicant filed as its evidence the affidavits of Linda Palmer and D. Jill Roberts.

[6] Mr. Clark was cross-examined on his first affidavit as were Ms. Palmer and Ms. Roberts. Each party filed a written argument and was ably represented at a hearing.

Legal Onus and Burden of Proof

[7] The legal onus is upon the Applicant to show that the application complies with the provisions of the Act, but there is however 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

Preliminary remarks

[8] The Opponent did not make any written or oral argument about the likelihood of confusion between the parties' respective trade-marks in so far as the Services are concerned.

[9] The Applicant argues that there has been no evidence of use of the trade-mark SK, alleged in support of the Opponent's ground of opposition under section 16(3) of the Act. The evidence filed shows use amongst other, of the following trade-mark:



(which is the SK Logo trade-mark covered by registration TMA516,956)

[10] It has been ruled that the use of a stylized version of a word registered trade-mark constitutes use of that trade-mark [see for example *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. Here, the situation is different. Could the use of a design registered trade-mark constitute use of an unregistered word trade-mark? In the present case even though the letter K is much smaller in size than the letter S, it is reasonable to treat the use of such design trade-mark as use of the word trade-mark SK. As such I consider the use of the Opponent's registered trade-mark SK & Design, as illustrated above, to be use of the word mark SK.

[11] Finally the Opponent argues that the exhibits attached to Ms. Palmer's affidavit should be disregarded as they represent photocopies of web pages of the Canadian Intellectual Property Office (CIPO) website and not actual certified copies of extracts of the register. Obviously the best way to prove the state of the register is by filing extracts of the register certified to be true by the Registrar in accordance with section 54 of the Act [see *Quebec Maple Products Inc v Stafford Foods Limited* (1988), 20 CPR (3d) 404 (TMOB)]. However a similar situation was dealt in the following manner by O'Keefe J. in *Molson Canada v Anheuser-Bush Inc* (2003), 29 CPR (4th) 315 (FCTD):

The affidavit evidence of Ms. Bereskin was considered by the Registrar as follows:

In her affidavit, Ms. Bereskin states that she conducted a search of the CD-NAMESEARCH database on CD-ROM compiled from the records of the Canadian Trade-marks Office to locate any active applications or registrations in International Classes 3, 6, 8, 9, 12, 14, 16, 18, 20, 21, 24, 25, 26, 28, 30 and 34 containing the word GOLDEN in the trade-mark, but excluding those marks standing in the name of the opponent. Ms. Bereskin has annexed to her affidavit the computerized information pages generated by the computer for her search conducted in the CD-NAMESEARCH system which she printed during the course of her search. The opponent submitted that no weight should be given the computer generated printouts annexed to Ms. Bereskin's affidavit in that the affiant did not verify the accuracy of the information contained in the printouts with the actual records located in the Trade-marks Office [see Bereskin cross-examination, pages 5-6]. However, the information contained in the CD-NAMESEARCH system is that provided by and relied upon by the Trade-marks Office. In this regard, in *Amway Corporation v. Nutravite Pharmaceutical Inc.*, a yet unreported decision of the Trade-marks Opposition Board dated February 17, 2001 involving the trade-mark NUTRA VITA, application No. 790,667, Board Member Martin commented as follows concerning the admissibility of the results of a search on the CD-NAMESEARCH system as follows:

The opponent objected to the admissibility of Ms. Harris' search results on the basis that they comprise inadmissible hearsay since the database searched by Ms. Harris is owned by a third party, CDName Search Corp. Technically, there may be some merit in the opponent's objection. However, given that the Trade-marks Office provides the information for the third party database and relies on it itself in its own public search room suggests that it is a reliable reflection of the Office records. Thus, I consider Ms. Harris' search results to be reliable and admissible.

Likewise, I am of the view that in the absence of evidence pointing to inaccuracies in the computer printouts of the results of the information contained in the database search, the printouts should likewise be admissible as evidence in an opposition proceeding.

[12] Despite the fact that the Opponent tried to introduce as evidence a disclaimer notice appearing on the CIPO website one must not lose sight of the fact that CIPO does provide to the public on its website an unofficial computerized version of the register which is reliable unless proven otherwise. Therefore I find Ms. Palmer's evidence admissible.

Registrability of the Mark under Section 12(1)(d) of the Act

[13] Ms. Stecyk has been a trade-mark searcher employed by the Opponent's agent firm. She filed certified copies of registration TMA517,866 for the trade-mark SK Logo as illustrated

above and registration TMA516,956 for the trade-mark SAFETY-KLEEN & SK Logo as reproduced hereinafter:



[14] I checked the register and these registrations are extant. They both cover:

Mechanical parts washers, including washers for cleaning components of automobiles, aircraft, industrial and agricultural machines and parts thereof used in manufacturing, service and repair facilities, and brushes, filters and replacement parts for such parts washers; cleaning and degreasing solvents for parts washing machines used in service, maintenance and repair and manufacturing, and cleaning emulsions and solvents used in immersion type cleaners for cleaning carburetors and other automotive, marine and agricultural vehicle parts. Automotive fluids and motor oil, including automotive oils, heavy duty motor oil, non-detergent motor oil, motor oil for severe service, diesel truck motor oil, tractor motor oil, high performance motor oil, two cycle motor oil, and refined motor oil; multi-purpose gear oil, snowmobile oil, red chain oil, transmission fluid, multi-purpose grease, hydraulic oil, oil for hydraulic jacks, power steering fluid, undercoating oil for prevention of rust corrosion, automatic transmission fluids, industrial oils and universal tractor fluids; anti-freeze, ethylene glycol, anti-freeze windshield washer liquid and refined motor oil (the Opponent's wares);

as well as:

Cleaning and recycling services, namely, the leasing of mechanical parts washers used in service, maintenance, repair and manufacturing facilities, providing solvent for such washers, periodically collecting, cleaning and replacing such solvent and the maintenance of such mechanical parts washers (the Opponent's services).

[15] Consequently the Opponent has met its initial burden. The relevant date is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[16] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)]. I also refer to the judgments of the Supreme Court of Canada in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada inc* (2006), 49 CPR (4th) 321 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under section 6(5) to determine if there is a likelihood of confusion between two trade-marks.

[17] I consider that the Opponent's trade-mark SK Logo to be the closest registered trade-mark to the Mark. I shall therefore limit my analysis of the relevant criteria to a comparison between the Mark and the trade-mark SK Logo.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[18] The Mark is composed of two letters of the alphabet combined with a design feature and so is the Opponent's trade-mark SK Logo. They cannot be simply put in the category of trade-marks made exclusively of letters of the alphabet, and thus weak trade-marks. They both have a some degree of distinctiveness because of their respective design portion. However I do not consider one trade-mark to be stronger than the other one.

[19] Mr. Clark is the Vice-President–Marketing of the Opponent. He explains the Opponent's origins that go back to the 1950's. It started with the invention of a device for washing and cleaning mechanical parts in a safe manner in order to limit the possibility of fire and spills of hazardous materials. It evolved over time to include a greater focus on environmentally friendly products and services. It is today a leading provider of environmental services, oil re-refining and responsible cleaning solutions. It provides a range of services designed to collect, transport, process, recycle or dispose of hazardous and non-hazardous industrial and commercial waste. Its

headquarters are located in Plano, Texas and it operates in the United States, Canada, Mexico and Porto Rico. The Opponent's products and services have applications in several industries: automotive, metal fabrication, printing, chemical, dry cleaning, imaging and motorsports.

[20] Mr. Clark alleges that the Opponent began its operation in Canada in January 1970. The SK Trade-marks have been used in Canada since 1973 by the Opponent and its various predecessors in title. The products and services associated with the SK Trade-marks (a defined term in Mr. Clark's affidavit that includes the Opponent's Trade-marks and the trade-mark SK) are provided by Safety-Kleen Canada Inc., the Opponent's licensee. Mr. Clark asserts that Safety-Kleen Canada Inc. operates the following facilities in Canada: Manufacturing/re-conditioning utility; recycling centre; oil collection processing centres; oil refinery; distribution centre. There are 13 branches located in British Columbia, Alberta, Ontario, Quebec and Nova Scotia.

[21] Mr. Clark alleges in his affidavit that the following products have been sold in Canada in association with one or more of the SK Trade-marks:

Oils and automotive and mechanical fluids, including motor and automotive oils, refined motor oil, grease, power steering fluid, undercoating oil for the prevention of rust corrosion, automatic transmission fluids, anti-freeze, and windshield washer liquid;
Cleaning equipment and its parts, including mechanical parts washers for cleaning components of automobiles, aircraft, industrial and agricultural machines and paint gun cleaners; and
Cleaning products, including cleaning and degreasing solvents for parts washing machines, as well as hand cleaners, absorbents, spill kits, aerosols, wipers and polishing cloths (collectively referred to as the SK Brand Products).

[22] Mr. Clark states that the following services have been performed in Canada in association with one or more of the SK Trade-marks:

Leasing of mechanical parts washers;
Periodically collecting, cleaning and replacing solvent in mechanical parts washers; and
the maintenance of such mechanical parts washers (collectively referred to as the SK Brand Services).

[23] Mr. Clark filed photographs showing the manner in which the SK Trade-marks are, and have at all material times been displayed in Canada on the SK Brand Products and their packaging since well prior to September 2005. He also filed photographs showing the manner in

which the SK Trade-marks are displayed in Canada on trucks and tankers engaged in the delivery of SK Brand Products and the transport and collection of used oil and on the uniforms worn by service technicians engaged in the performance of SK Brand Services in Canada since well prior to September 2005. However during his cross-examination Mr. Clark admitted that he could not personally confirm any use of the SK Trade-marks in Canada prior to 2007 as it was only on that year that he joined the Opponent.

[24] Mr. Clark provides the annual sales figures of SK Brand Products and SK Brand Services to customers in Canada in association with the SK Trade-marks from 1999 to 2007 which vary from \$28 million to \$175 million. He filed a current catalogue of the SK Brand Products and SK Brand Services. He filed copies of brochures distributed in Canada well prior to September 2005 to consumers, retailers and potential retailers illustrating the SK Brand Products and describing the SK Brand Services. However during his cross-examination he stated that the brochures, exhibit D to his first affidavit, are mostly from 2007; and he did not know how many of those were distributed in Canada.

[25] The SK Trade-marks are also displayed on the Opponent's website in association with SK Brand Products and SK Brand Services. Mr. Clark filed copies of pages printed from such website. During his cross-examination he stated that the products illustrated in exhibit A to his first affidavit have been available for purchase online since 2007. He does not know if they were available prior to that year.

[26] During his cross-examination he also stated that the Opponent has been selling antifreeze since 2007 but in association with the trade-mark KHAMELEON. Finally he admitted that the Opponent does not sell power steering fluid but sells in Canada transmission fluid under the trade-mark PERFORMANCE PLUS.

[27] Despite the admissions made during the cross-examination of Mr. Clark the evidence shows that there has been use of the Opponent's Trade-marks, including the SK Logo trade-mark, in Canada since at least 2007. On the other hand there is no evidence of use of the Mark in Canada by the Applicant. Consequently the first criterion favours the Opponent.

The length of time the trade-marks or trade-names have been in use

[28] From the evidence describe above this criterion also favours the Opponent.

The nature of the wares, services, or business; the nature of the trade

[29] The nature of the Services and of the Opponent's wares (to be enumerated hereinafter) are so far apart that there is no likelihood of confusion between the parties' trade-marks, no matter what would be the conclusion on the degree of resemblance between the marks.

[30] There is an overlap between the Opponent's wares and the following wares:

antifreeze solution, brake solution, catalysts for treating engine exhaust, fluids for hydraulic circuits, power steering fluid, refrigerants and solvent (the Overlapping wares).

[31] There is no overlap in so far as the following wares are concerned:

Ammonia, anti-corrosive contact spray, chemicals used in industry, namely: caustic soda for industrial purposes; chemical preparations for the manufacture of paints; fertilizer, fire extinguishing compositions for fighting fires; melamine, microorganism cultures for use in industry, science, agriculture, horticulture and forestry, plasticizer, polyester, polyethylene, polyethylene resins, semi-processed synthetic resins, silicones, surface-active chemical agents, synthetic resins, unprocessed acrylic resins, unprocessed artificial resins, unprocessed epoxy resins, unprocessed plastics, unprocessed synthetic resins, urea, urethane resins, UV chemical stabilizer, vulcanization accelerators, water treatment compositions for human use to inhibit scaling, phosphate formation and corrosion (the Non-overlapping wares).

[32] I brought to the parties' attention at the hearing that a good portion of the Wares are described in technical or chemical terms for which I have no evidence of their meaning and in what type of business or industry they can be used. In the absence of such evidence it is difficult to determine if the wares hereinafter listed fall in the same general category of the Opponent's wares:

diethyl malonate, diisopropyl malonate, diketene, dimethyl malonate, dimethyl terephthalate, dimethyl formamide, dimethylamine, epichlorohydrine, ethoxylate, ethylene, ethylene amines, ethylene glycol, ethylene oxide, ethylene vinyl acetate, fatty amine, formic acid, fumed silica, furfuryl alcohol, hypochlorite of soda, isopropyl alcohol, methyl chloride, methyl metal acrylate, methylamine derivatives, methylene chloride, neopentyl glycol, photoresist, polycrystalline silicone, polyethylene terephthalate, polymethylmeta acrylate, polypropylene, polypropylene resins, polytetrafluoro ethylene, polyvinyl butyral film, polyvinyl chloride, potassium sorbate,

propylene, purified terephthalic acids, sodium carboxymethyl cellulose styrene monomer, terephthalic acids, tetramethyl ammonium chloride, tetramethyl ammonium hydroxide, toluene, trimethylamine hydrochloric acid (the Undefined wares).

[33] The ultimate onus in opposition proceeding is on the Applicant to convince the Registrar that the Mark is registrable. There is no evidence as to the meaning of the Undefined wares, what they represent, and in what industry they are used. From this, I draw a negative inference on the Applicant such that I assume that there is an overlap in the nature of the Undefined wares and the Opponent's wares.

[34] At the hearing the Applicant's agent emphasized on the specialized nature of the Opponent's business. Its clientele includes amongst other, automotive dealers. It recycles used oil and replaces parts of washing machines used to clean automotive parts. However we have no evidence on the nature of the Applicant's business. Where there is an overlap in the nature of the parties' respective wares, in the absence of evidence to the contrary, I have to assume that, for those wares, there would be an overlap in the parties' channels of trade.

[35] In the end, this factor favours the Opponent in so far the Overlapping wares and the Undefined wares are concerned.

The degree of resemblance

[36] In its judgment in *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27, the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

[37] The Mark and the SK Logo trade-mark are identical phonetically. However they do not look alike. The Opponent dominant feature of its SK Logo trade-mark is the letter S while there is no dominant feature in the Mark. The Mark is comprised of two equal features namely the letters "SK" and a butterfly design.

Additional surrounding circumstances

[38] The Applicant filed state of the register evidence through the affidavit of Ms. Palmer to try to prove that the letters "SK" are a common feature of many trade-marks on the register. She

conducted on November 16 and 18, 2009 a search on the CIPO website for any registered or allowed trade-marks which include the element “SK” in association with “industrial chemicals, petroleum or gas products and industrial cleaning services, the operation of garages or automobile centers, and industrial machine parts and services”. She located 68 hits and filed extracts for each of the citations located.

[39] During her cross-examination Ms. Palmer admitted however that out of the citations mentioned in her affidavit, only 7 of them feature the letters S and K with the only design element being a distinctive font, namely: exhibits A-3, A-4, A-5, A-6, A-12 and A-15 to her affidavit [see page 36 of Ms. Palmer cross-examination]. The other citations either comprise an additional element (another letter and/or a distinguishing design portion) and/or cover unrelated wares and/or services. The addition of a letter, or a word, or a design element is often sufficient to distinguish them [see *GWS Ltd v Great West Steel Industries Ltd* (1975), 22 CPR 2d 154 (FCTD)].

[40] The Applicant is arguing as an additional surrounding circumstance that the parties’ trade-marks have coexisted in the United States without any instances of confusion being reported. In her affidavit Ms. Palmer does provide copies of web pages taken from the website of the United States Patent and Trade-marks Office (USPTO) showing that the Mark is registered in the United States in association with various wares and services. There are 15 citations.

[41] Ms. Palmer also filed extracts of the USPTO register in so far as the Opponent’s registrations are concerned. She filed 7 of those, which include two registrations identical to the Opponent’s Trade-marks.

[42] Mr. Clark mentioned in his affidavit that the Opponent has used the SK Logo trade-mark in the United States. However I have no evidence of use of the Mark in the United States, despite the apparent registration in that country. Consequently the lack of evidence of actual instances of confusion may very well be explained by the fact that there has been no use or token use of the Mark in the United States. Also there may be factors that justify the co-registration of trade-marks in a foreign jurisdiction that do not exist in Canada, and so the co-existence on foreign trade-mark registers is to be accorded little weight [see *Quantum Instrument, Inc v Elinca SA* (1995), 60 CPR (3d) 264 (TMOB)].

[43] Roberts has been an assistant bailiff since 2003. In December 2009 she was retained by the Applicant's agent to locate and make copies of documents available via Internet related to business activities in Canada concerning 39 companies, the names of which were provided to her. She filed as Exhibits 1 to 34 copies of pages of the websites of those companies listed in paragraph 2 of her affidavit. It mainly refers to products bearing a trade-mark which comprises the letters SK and not necessarily the letters SK alone. Some of the pages filed do not refer to SK at all.

[44] During her cross-examination Ms. Roberts stated that she does not have any information on how many Canadians visited each of these websites. Nowhere on these pages there is information about sales made in Canada.

[45] This evidence falls short of establishing use of the trade-mark SK by third parties in the marketplace. I cannot infer that consumers are used to see the letters SK as trade-marks in association with relevant wares such that they are accustomed in distinguishing them.

Conclusion

[46] The Applicant has discharged its legal burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark SK Logo in so far as the Non-overlapping wares and the Services are concerned. I am of the opinion that the difference in the nature of the parties' wares and services and the difference in the design portion of the marks in issue are sufficient to negate any likelihood of confusion.

[47] However I consider that there exists a likelihood of confusion between those marks, in so far as the Overlapping wares and the Undefined wares are concerned As for the Overlapping wares, I base this conclusion on the fact that those wares and the Opponent's wares are very similar in nature and the parties' trade-marks are identical phonetically. Under these circumstances the use of a different design portion is not sufficient to negate any likelihood of confusion between the Mark and the Opponent's trade-mark SK Logo in so far as the Overlapping wares are concerned.

[48] As for the Undefined wares, the lack of information on them leads me to conclude, for the same reasons outlined in the preceding paragraph, that the Applicant has not discharged its legal onus to prove that, for those wares, there is no likelihood of confusion. Any doubt on the nature of those wares is interpreted against the Applicant.

[49] Consequently a split decision will issue.

Other Grounds of Opposition

[50] Under the ground of entitlement the Opponent has the initial burden to prove that it has used or made known its trade-marks SK and SK Logo in Canada prior to the filing date of the Applicant's application, namely September 28, 2005 and that it has not abandoned such use at the advertising date of the application [see sections 16(3) and (5) of the Act].

[51] Mr. Clark admitted during his cross-examination that the Opponent has not used the Opponent's trade-marks in Canada in association with power steering and transmission fluids. Also the documentary evidence shows that the Opponent is using trade-marks other than the Opponent's trade-marks in association with motor oil [see exhibit E to Mr. Clark's affidavit wherein motor oil container bears the trade-mark ECO POWER]. As such I would have to exclude those wares from the defined term "the Opponent's wares" and thus it would have an impact on the list of Overlapping wares. Ultimately the analysis of the relevant circumstances would result in a less favourable outcome for the Opponent.

[52] Consequently I do not intend to analyze this ground of opposition in depth, given that the Opponent would not be able to achieve a better result than the one obtained under the registrability ground of opposition for the reasons described in the preceding paragraph.

[53] A similar reasoning applies to the ground of opposition based on lack of distinctiveness of the Mark given that the Opponent has an initial burden to prove that its trade-marks had become sufficiently known in Canada on March 27, 2008, the filing date of the statement of opposition, so to negate any distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. There has been no use of the Opponent's trade-marks in Canada, as of that date, in association with power steering, transmission fluids and motor oil.

Disposition

[54] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application with respect to:

Antifreeze solution, brake solution, catalysts for treating engine exhaust, fluids for hydraulic circuits, power steering fluid, refrigerants; transmission fluid; diethyl malonate, diisopropyl malonate, diketene, dimethyl malonate, dimethyl terephthalate, dimethyl formamide, dimethylamine, epichlorohydrine, ethoxylate, ethylene, ethylene amines, ethylene glycol, ethylene oxide, ethylene vinyl acetate, fatty amine, formic acid, fumed silica, furfuryl alcohol, hypochlorite of soda, isopropyl alcohol, methyl chloride, methyl metal acrylate, methylamine derivatives, methylene chloride, neopentyl glycol, photoresist, polycrystalline silicone, polyethylene terephthalate, polymethylmeta acrylate, polypropylene, polypropylene resins, polytetrafluoro ethylene, polyvinyl butyral film, polyvinyl chloride, potassium sorbate, propylene, purified terephthalic acids, sodium carboxymethyl cellulose styrene monomer, terephthalic acids, tetramethyl ammonium chloride, tetramethyl ammonium hydroxide, toluene, trimethylamine hydrochloric acid.

and reject the opposition with respect to:

Ammonia, anti-corrosive contact spray, chemicals used in industry, namely: caustic soda for industrial purposes; chemical preparations for the manufacture of paints; fertilizer, fire extinguishing compositions for fighting fires; melamine, microorganism cultures for use in industry, science, agriculture, horticulture and forestry, plasticizer, polyester, polyethylene, polyethylene resins, semi-processed synthetic resins, silicones, solvent, surface-active chemical agents, synthetic resins, unprocessed acrylic resins, unprocessed artificial resins, unprocessed epoxy resins, unprocessed plastics, unprocessed synthetic resins, urea, urethane resins, UV chemical stabilizer, vulcanization accelerators, water treatment compositions for human use to inhibit scaling, phosphate formation and corrosion.

Cable television broadcasting; cellular telephone services; text messaging, voice and video communication services by computer; communication by facsimile; text messaging, voice and video communication services by satellite; communication by telegram; electronic mail services; news agencies; radio broadcasting; text messaging, voice and video communication services by radio; radio telephone paging services; rental of broadcasting equipment; television and radio broadcasting services by satellite; text messaging, voice and video communication services by telephone; television broadcasting; video teleconferencing services (the Services).

pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office