



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

**Citation: 2010 TMOB 131**  
**Date of Decision: 2010-08-24**

**IN THE MATTER OF AN OPPOSITION  
by Hyundai Auto Canada Corp. to  
application No. 1,321,379 for the trade-  
mark HYUNDAI & Design in the name of  
Hyundai Heavy Industries Co., Ltd.**

The Pleadings

[1] On October 24, 2006 Hyundai Heavy Industries Co., Ltd. (the Applicant) filed an application to register the trade-mark HYUNDAI & Design as hereinafter reproduced:



wherein colour is claimed as a feature of the Mark. The letters are blue; the full triangle is green and the partial triangle is golden/orange. Also the Applicant has disclaimed the right to the exclusive use of the words HEAVY INDUSTRIES apart from the Mark.

[2] The application is based on proposed use in Canada. It has been amended on a couple of occasions such that the list of wares now reads:

Bulldozers, oil centrifugal pumps, water centrifugal pumps, cranes (lifting and hoisting apparatus), excavators, wire hoists, elevators, mangles, presses (machines for industrial purposes), truck lifts, graders, pay loaders, electric motors for

generators; diesel engines for ships or aircrafts and diesel engines for generators (the Wares).

[3] The application was advertised on December 19, 2007 in the *Trade-marks Journal* for opposition purposes. Hyundai Auto Canada Corp. (the Opponent) filed a statement of opposition on July 25, 2008 containing the grounds of opposition described hereinafter. The Applicant filed a counter statement on September 30, 2008 denying all grounds of opposition listed below.

[4] The Opponent filed as its evidence a certificate of authenticity for registration TMA302,619 for the trade-mark HYUNDAI while the Applicant chose not to file any evidence.

[5] Neither party filed a written argument nor requested an oral hearing.

#### The Grounds of Opposition

[6] The grounds of opposition pleaded can be summarized as follow:

1. The application does not comply with the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 1985 c. T-13 (the “Act”) in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada given the prior use of the Opponent’s registered trade-mark HYUNDAI and its unregistered trade-mark HYUNDAI previously used in Canada by the Opponent and its predecessors in title and the Opponent’s trade-names Hyundai Auto Canada and Hyundai which had been previously used by the Opponent and its predecessors Hyundai Auto Canada, a division of Hyundai Motor America and Hyundai Auto Canada Inc.

At the filing date of the application, the Applicant was or should have been aware of the Opponent’s registered and unregistered trade-mark and the Opponent’s trade-names. At the filing date of the application, the Applicant was or should have been aware that the Mark was likely to be confused with one or more of the Opponent’s registered trade-mark, the Opponent’s unregistered trade-mark and the Opponent’s trade-names mentioned above;

2. The Mark is not registrable under s. 12(1)(d) of the Act as it is confusing with the Opponent’s registered trade-mark HYUNDAI, certificate of registration TMA302,619;
3. The Applicant is not the person entitled to registration in that, contrary to s. 16(3)(a) of the Act, at the filing date of the application the Mark was confusing with any one or combination of the Opponent’s registered trade-

mark HYUNDAI which had been previously used in Canada in association with the wares listed hereinafter and the Opponent's unregistered trade-mark HYUNDAI which had been previously used in Canada in association with the services of repair and maintenance of motor vehicles by the Opponent and its predecessors in title, and not abandoned;

4. The Applicant is not the person entitled to registration in that, contrary to s. 16(3)(c) of the Act, at the filing date of the application the Mark was confusing with any one or combination of the Opponent's trade-names Hyundai Auto Canada and Hyundai which had been previously used in Canada in association with the services of repair and maintenance of motor vehicles by the Opponent and its predecessors in title, and not abandoned;
5. Pursuant to s. 38(2)(d) and s. 2 of the Act, the Mark is not distinctive of the Applicant in that the Mark does not actually distinguish and is not adapted to distinguish the Wares from the wares and services of others, namely the wares and services of the Opponent used in association with the Opponent's registered and unregistered trade-mark HYUNDAI and the Opponent's trade-names Hyundai Auto Canada and Hyundai.

#### Burden of Proof in Trade-mark Opposition Proceedings

[7] The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus 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 onus 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 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

#### Grounds of Opposition That Can Be Summarily Dismissed

[8] In grounds of opposition 1, 3, 4 and 5 the Opponent alleges prior use of its registered and unregistered trade-mark HYUNDAI and/or prior use of its trade-names to support any of those grounds of opposition. The Opponent has not filed any factual evidence except for the filing of a

certificate of authenticity for its registered trade-mark HYUNDAI, certificate of registration TMA302,619. The mere filing of a certificate of registration of a trade-mark is not sufficient to meet the initial onus on the Opponent, under the grounds of opposition of entitlement and distinctiveness, to prove prior use of its trade-mark or trade-name(s) [see *B.D. Wait Co. v. Dorwood Industries Ltd.* (1987), 15 C.P.R. (3d) 527]. Moreover there is no evidence that the Applicant was aware of the Opponent's registration and/or use of its unregistered trade-mark and trade-names. In any event a s. 30(i) ground of opposition should only succeed in exceptional cases such as where there is evidence of bad faith on the part of an applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155].

[9] Consequently I dismiss grounds of opposition 1, 3, 4 and 5 described above for failure by the Opponent to meet its initial onus.

#### Registrability of the Mark under s. 12(1)(d)

[10] The Opponent has met its initial onus under the ground of opposition of registrability by filing a certificate of authenticity for its registered trade-mark HYUNDAI, certificate of registration TMA302,619. The Opponent is listed as the current owner. I used my discretion and checked the register. I confirm that the registration is still in good standing. It covers the following wares:

Automobiles and parts therefor, and accessories namely, door stripes, body trim stripes, wheel trim rings, wheel lug nuts kits, fog light kits, sport grills, steering wheel covers, rear-view mirrors, sunroofs, cruise-control, wheel covers, quartz clocks, spoilers/stripping kits, sunshield/wiper wings, rear deck spoilers, front air dams, sport racks, am/fm stereo-cassette players, am/fm stereo radios, speaker kits, speakers, carpeted floor mats, sisal floor mat sets, rubber floor mat sets, touch-up paint, block heaters, battery warmers, wiper blades, key protector pads; t-shirts, jackets, golf shirt and baseball caps.

[11] Consequently I must determine if there is, on a balance of probabilities, a likelihood of confusion between the Mark and the Opponent's registered trade-mark HYUNDAI. If that is the case, then the Mark cannot be registered.

[12] The relevant date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424].

[13] The test to decide if there is a likelihood of confusion is set out in s. 6(2) of the Act wherein it is stipulated 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 likely 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. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 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 businesses; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or in the ideas suggested by them. For an in-depth analysis of the relevant surrounding circumstances I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321.

[14] I have no evidence that HYUNDAI is a common word in a foreign language. Therefore I conclude that it is inherently distinctive. As for the Mark, I do not think that the addition of the descriptive words "HEAVY INDUSTRIES, CO., LTD" and the triangle design would render the Mark much more inherently distinctive than the Opponent's registered trade-mark such that it would favour the Applicant.

[15] As for the length of time the parties' respective trade-marks have been in use in Canada, the application is based on proposed use and there has been no evidence filed by the Applicant. Certificate of registration TMA302,619 does contain a statement of use of the trade-mark HYUNDAI since January 2, 1984 in association with the wares listed in the certificate of registration and mentioned above. The Registrar can refer to the information contained in the certificate of registration filed by the Opponent [see *Cartier Men's Shops Ltd. v. Cartier Inc.* (1981), 58 C.P.R. (2d) 68 (Fed. T.D.), at 71]. However, the Registrar can only conclude to *de*

*minimis* use of the trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]

[16] In the absence of any evidence on the parties' respective trades it is difficult to assess the connection or lack thereof between the Opponent's wares, namely automobiles and parts thereof on one hand and the Applicant's wares that include heavy motor vehicles and different engines and motors. The Applicant has the burden of proof and has not filed any evidence that would convince me that some of the parties' wares and their channels of trade belong to different general classes. I can foresee, from the description of some of the Wares that there could be in the mind of a consumer a connection between the Opponent's wares and some of the Wares such as: bulldozers, cranes (lifting and hoisting apparatus), excavators, truck lifts, graders, pay loaders and diesel engines for ships or aircrafts. All of those wares fall in the general category of "vehicles" or parts thereof. The *Canadian Oxford Dictionary* defines "vehicle" as: "Any conveyance for transporting people, goods, etc...".

[17] Therefore I find that a consideration of the nature of the wares, services, businesses and trade favours the Opponent save and except with respect to the following wares: oil centrifugal pumps, water centrifugal pumps, wire hoists, elevators, mangles, presses (machines for industrial purposes); electric motors for generators and diesel engines for generators.

[18] The degree of resemblance between two trade-marks is one of the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145]. It has been held that the first portion of a trade-mark is the most relevant for the purpose of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183]. In our case the first component of the Mark is the entirety of the Opponent's registered trade-mark HYUNDAI. The additional word elements are descriptive in nature and thus do not serve to distinguish the Mark from the Opponent's registered trade-mark HYUNDAI. Visually the word HYUNDAI is written in much larger letters than the other words comprising the Mark. The design feature is not an overwhelming characteristic of the Mark. Phonetically and visually the marks in issue do resemble one another as the main element of the Mark is the Opponent's trade-mark HYUNDAI. Overall this factor does favour the Opponent.

[19] From this analysis I conclude that the Applicant failed to discharge its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trade-mark HYUNDAI, when used in association with bulldozers, cranes (lifting and hoisting apparatus), excavators, truck lifts, grades, pay loaders and diesel engines for ships and aircrafts. However, I consider that there is no likelihood of confusion between the parties' trade-marks when the Mark is used in association with oil centrifugal pumps, water centrifugal pumps, wire hoists, elevators, mangles, presses (machines for industrial purposes), electric motors for generators and diesel engines for generators as there is no connection between those wares and the wares covered by the Opponent's registration.

### Disposition

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

Bulldozers, cranes (lifting and hoisting apparatus), excavators, truck lifts, graders, pay loaders; diesel engines for ships or aircrafts;

and reject the opposition with respect to:

Oil centrifugal pumps, water centrifugal pumps, wire hoists, elevators, mangles and presses (machines for industrial purposes); electric motors for generators and diesel engines for generators;

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

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