

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

Citation: 2015 TMOB 117
Date of Decision: 2015-06-29

IN THE MATTER OF AN OPPOSITION

Apple Inc

Opponent

and

**Les Ateliers Mach Dépot (Mach Depot)
Inc.**

Applicant

**1,516,567 for ‘two green arrows pointing
in a rounded shape with a leaf at the top’**

Application

Introduction

[1] Apple Inc. (the Opponent) opposes registration of the trade-mark identified as ‘two green arrows pointing in a rounded shape with a leaf at the top’ as illustrated below:



(the Mark)

Colour is claimed as a feature of the Mark. The Mark is two green arrows pointing in a rounded shape with a green leaf at the top.

[2] The application covers the following services:

Provide repair and recycling of used, out of manufacturers warranty for electronic and computer equipment (the Services)

[3] The application was filed by Les Ateliers Mach Dépot (Mach Depot) Inc. (the Applicant) on February 24, 2011 on the basis of proposed use in Canada.

[4] The Opponent filed a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded are based on sections: 30(a) and (i), 12(1)(d) (registrability), 16(3)(a) and (b) (non-entitlement) and 2 (distinctiveness). They all turn on the issue of likelihood of confusion with the Opponent's Family of Apple registrations listed in the statement of opposition. The grounds of opposition are detailed in Annex A to this decision.

[5] For the reasons explained below, I refuse the application.

The Record

[6] The application was advertised in the *Trade-marks Journal* on November 9, 2011. The Opponent filed its statement of opposition on March 23, 2012. The Applicant filed and served a counter statement on June 11, 2012 in which it denied each and every ground of opposition pleaded by the Opponent.

[7] The Opponent filed as evidence the affidavit of Thomas La Perle dated February 6, 2013 and certified copies of registrations TMA690,668 (apple design); TMA541,334 (MAC); TMA354,378 (apple design); and TMA396,871 (apple design).

[8] The Applicant filed as its evidence the affidavit of Mr. Roberto Ziroma.

[9] The Opponent filed as reply evidence a second affidavit of Mr. La Perle dated November 4, 2013.

[10] Both parties filed written arguments and were represented at the hearing.

The parties' respective burden or onus

[11] The legal onus is on the Applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FCTD)].

Preliminary remarks

[12] I wish to point out that in reaching my decision I have considered all the evidence in the file but I will refer in my reasons for this decision only to the relevant portions of the evidence.

Applicant's Request to file additional evidence

[13] At the beginning of the hearing, the Applicant, represented by its Secretary Mr. Romagnino, informed me that it filed at the Registrar's office a request under sections 47(1) and (2) of the Act for permission to complement its written argument. I presume that the Applicant also meant to refer to rule 44 of the *Trade-marks Regulations*, (Regulations). I was then given a copy of a document that purports to be a complement to the Applicant's written argument. However, at the same time I received 4 different folders containing:

- case law (D.J. 01 to D.J. 12);
- additional documents (P.D. 01 to P.D. 23);
- additional documents (P.D. 24 to P.D. 67); and
- additional documents (P.D. 68 to P.D. 95).

[14] I made, at the hearing, the following observations:

- I had no problems with the folder containing the case law and the document that purports to be additional written arguments. In fact, the Opponent did not contest vigorously the filing of that document;
- There was no affidavit attached to the additional documents filed (P.D. 01 to P.D. 95).

[15] I also mentioned that I would be refusing the production of documents P.D. 01 to P.D. 95 for the reasons that follow.

[16] Given the nature of documents P.D. 01 to P.D. 95, I cannot accept their filing in the record without an affidavit. Rule 42 of the *Trade-marks Regulations* is quite clear: the Applicant's evidence must be in the form of an affidavit, unless they are official documents in the custody of the Registrar. In the latter situation, section 54 of the Act provides that the production of them can be achieved by simply filing a copy certified to be true by the Registrar. None of the documents P.D. 01 to P.D. 95 falls in that category. They are excerpts of various websites or search results of enquiries made on the database of the Registraire des Entreprises du Québec. We have no information as to whom, when and how these searches were made both on the Internet and on the Registraire des Entreprises du Québec.

Objection to the filing of correspondence classified as privileged and reference thereto

[17] In his affidavit Mr. Ziroma, the Applicant's President and Director of Operations, makes reference to the exchange of correspondence between the Opponent's agents and Mr. Romagnino concerning settlement discussions. The Opponent objects to the filing of such correspondence as being privileged communication and that it has not waived such privilege. Without listing all the documents falling in that category, it includes:

- Opponent's demand letter of January 3, 2012 to the Applicant (A-5, pages 1-4 to Mr. Ziroma's affidavit)
- September 19, 2012 email suggesting settlement terms (A-6 to Mr. Ziroma's affidavit);
- September 21, 2012 email to Mr. Romagnino requesting consent for an extension of time to provide a settlement proposal (A-9 to Mr. Ziroma's affidavit);

- February 8, 2013 email concerning the Opponent's evidence and settlement proposal (A-10, A-11 and A-12 to Mr. Ziroma's affidavit)
- Undated email to Mr. Romagnino from the Opponent's counsel, providing another revised settlement proposal (A-13, page 1 to Mr. Ziroma's affidavit); and
- Various correspondences to Mr. Romagnino from the Opponent's counsel (A229-A234 to Mr. Ziroma's affidavit).

[18] In *Bauer Nike Hockey Inc v Tour Hockey*, 2003 FCT 451, Madam Justice Tremblay-Lamer summarized the state of the law on this issue in the following words:

[18] Three conditions must be present for a court to recognize that communications in furtherance of a settlement are privileged: (a) a litigious dispute must be in existence of within contemplation; (b) the communication must be made with the express or implied intention that it would not be disclosed to the court in the event negotiations failed; and (c) the purpose of the communication must be to attempt to effect a settlement (Sopinka, Liederman, and Bryant, *The Law of Evidence in Canada*, 2nd Ed. (1999) at page 810).

[19] Offers of settlement exchanged between parties that meet the above criteria are subject to privilege. The rationale behind protecting such communications is so that parties will not be prejudiced in the event that negotiations fail. (...)

[19] The same principles are applicable in trade-marks opposition proceedings which are litigious in nature [see *Mothercare Ltd v "Precious Secret" Maternity Inc* (1976), 27 CPR (2d) 171 (TMOB)]. I will therefore not consider as part of the evidence the exhibits detailed above or any other correspondence of similar nature.

[20] I may add that, in any event, such documentation is not relevant to the issues raised by these proceedings.

Objection to the filing of additional documents attached to the Applicant's initial written argument

[21] The Opponent objected to any reference made by the Applicant to documents annexed to the Applicant's initial written argument as those documents were not properly filed in the record. I agree. As mentioned previously, any documents must be introduced as evidence by way of an affidavit and, in this case, a request should have been made under rule 44 of the Regulations to file them as additional evidence. I do not consider any of the documents annexed to the Applicant's initial written argument to be part of the record. In any event, their contents constitute inadmissible hearsay evidence being extracts of third parties' websites.

Absence of resolution

[22] In its written argument the Applicant argues that any corporation acts through (translation for 'parole' in French) resolution duly adopted by its Board of Directors. It would appear that the Applicant is arguing that Mr. La Perle was not authorized by resolution to file an affidavit on behalf of the Opponent.

[23] In order to understand the Applicant's argument, I reproduce the first paragraph of Mr. La Perle's affidavit executed on February 6, 2013:

I am the Director in Apple's Legal Department, managing Apple's Trademark and Copyright Group and responsible for, among other things, the global prosecution and protection of trademarks for Apple Inc. (hereinafter Apple Inc. or its predecessors-in-title are called 'Apple' or the 'Company'). Prior to joining Apple in 1999, I was one of Apple's outside intellectual property attorneys. As a result of my considerable experience working as part of Apple's legal team, I am familiar with Apple's operations, especially with its trademarks, including its extremely well known Apple Logo (reference below), and the marketing activities associated with its products and services. All information provided within this affidavit is personally known to me or is information which has been provided to me and which I believe to be true. Further, with respect to the product images contained in my affidavit, I am familiar with the products and have verified that the images are an accurate representation of these products.

[24] At the hearing, the Opponent did not make any representations on this issue and was unable to comment the case law filed by the Applicant on this point at the hearing as they were all in French and could not understand them.

[25] The Applicant referred to three judgments, part of its lists of authorities, but only two of them dealt with or made mention of a resolution. However the context was quite different than what I have before me. In *Foyer de Marie Inc v Barbreau* [1968] C.S. 188 an action was taken to declare null and void a resolution of a corporation that led to the execution of a deed of sale. The plaintiff was alleging that the person who was authorized by resolution to act on behalf of the corporation did not have such authority. The issue before the court was one of procedure as the defendant was arguing that the plaintiff did not initiate the proper procedure to attack the validity of the resolution. I fail to see how this case is applicable to our situation.

[26] The Applicant also referred to *Laflour v Uniboard Canada Inc*, 2008 QCCS 5839. Only a summary of the judgment was filed but I was able to retrieve and read the full decision. In that case, an action in payment of an invoice for services rendered was taken. The plaintiff was a member of the Board of Directors of the defendant, before the latter was sold to a third entity. The services rendered by the plaintiff were for the benefit of the sole shareholder of the defendant. The Court made mention of the general principle in corporate law that a company must be distinguished from its shareholders. They are distinct entities. Also the Court, referring to the applicable corporate law statute, concluded that remuneration to a director must be set out by resolution duly adopted by the Board of Directors. Again, these principles have no application to our case.

[27] Lastly, rule 41 of the Regulations states that the opponent must file its evidence in the form of an affidavit or statutory declaration. Nowhere is there in the Act or the Regulations a provision requiring evidence in the form of a resolution that a deponent has been authorized to depose on behalf of a corporation in an opposition proceeding. Mr. La Perle was never cross-examined. Being the Director of the Opponent's Legal Department, one can assume that he had authority to make the statements included in his affidavit. If the Applicant wanted to challenge the status of Mr. La Perle with the Opponent, it could have done so through a cross-examination.

[28] Consequently, I do not intend to disregard the content of his affidavit on the sole basis that there is no resolution from the Opponent's Board of Directors authorizing Mr. La Perle to sign an affidavit to be filed as evidence in the record.

Hearsay evidence

[29] Both parties raised the argument that the opposite side's evidence contains hearsay evidence and should not be considered as part of the evidence. I will first deal with the Applicant's argument concerning certain statements made by Mr. La Perle in his affidavit.

[30] At the hearing, the Applicant argued that Mr. La Perle did not disclose from whom he obtained the information contained in his affidavit. I beg to differ. For example in so far as the Opponent's sales' figures are concerned, Mr. La Perle clearly states in his affidavit that they were obtained from the Opponent's annual reports and he filed the pertinent excerpts. Another example that Mr. La Perle identifies his source of information is found in paragraph 24 which begins: 'I have been informed by our Canadian counsel...'.

[31] Both in its written argument and at the hearing, the Applicant argued that the failure to provide a resolution of the Opponent's Board of Directors renders the content of Mr. La Perle's affidavit to be hearsay evidence. I already ruled on the necessity for the Opponent to file a resolution authorising Mr. La Perle to file an affidavit on behalf of the Opponent. In view of the fact that there is no need for such resolution, I do not consider the entirety of Mr. La Perle affidavit to constitute inadmissible hearsay evidence.

[32] As for possible inadmissible hearsay statements contained in Mr. Ziroma's affidavit, I will address that issue if indeed those statements need to be considered as relevant portions of the Applicant's evidence.

The Opponent's Trade-mark MAC

[33] I do not intend to address the parties' arguments with respect to the Opponent's trade-mark MAC and the meaning of the Applicant's trade name 'Les Ateliers Mach Dépôt Inc.' as this opposition only relates to the Mark. In any event, the Opponent has not cited its trade-mark MAC in its statement of opposition as a basis of a ground of opposition.

Grounds of opposition summarily dismissed

Section 30(a) ground of opposition

[34] At the hearing the Opponent's agent informed me that she did not intend to make any representations with respect to this ground of opposition. She conceded that there was no evidence in the record to support such ground of opposition.

[35] Consequently, I dismiss this ground of opposition as the Opponent failed to meet its initial burden of proof.

Section 30(i) ground of opposition

[36] Section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use the mark applied for in Canada in association with the services described in the application. Such a statement is included in the present application. An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[37] The Opponent relies on the fact that Mr. Ziroma states in his affidavit that he repaired in the past Apple branded computers and also made references to iPod and iPhone products in his affidavit. Showing that the Applicant had knowledge of the Opponent's trade-marks is not sufficient for an Opponent to meet its initial burden under a section 30(i) ground of opposition.

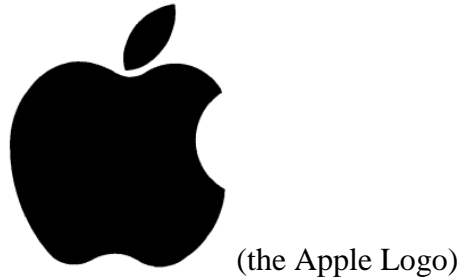
[38] Consequently, this ground of opposition is also dismissed

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

[39] The relevant date for the analysis of this ground of opposition 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)].

[40] As mentioned before, the Opponent filed certified copies of registrations TMA690,668; TMA354,378; and TMA396,871. I used my discretion to check the register and confirm that the Opponent is the owner of those registrations and they are extant.

[41] I will focus my analysis on registrations TMA690,668 and TMA354,378 as they both cover the design hereinafter reproduced:



[42] As for registration TMA396,871, also for the Apple Logo mark, it covers services (operation and management of group of people for the purpose of enhancing their knowledge of computer hardware and computer software) that are not directly related to the Services.

[43] I will simply mention at this stage that registration TMA354,378 covers computers while registration TMA690,668 covers a long list of wares and services that includes computer hardware and software; computer installation services; computer maintenance services; computer repair services; advisory and consultancy services relating to all of the aforesaid (the Opponent's wares and services).

[44] Consequently the Opponent has met its initial burden with respect to this ground of opposition.

[45] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks 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 goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks 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 *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[46] The test under section 6(2) of the Act 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 a consumer who sees the Applicant's Services in association with the Mark, would think they emanate from or are sponsored by or approved by the Opponent.

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

[47] The parties' marks are inherently distinctive consisting strictly of a design that is not related to the parties' respective goods and services.

[48] The degree of distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. The application is based on proposed use and there is no evidence of use of the Mark in the record filed by the Applicant. There is evidence of limited use of the Mark as part of the Opponent's evidence which I will describe later. As for the use of the Opponent's Apple Logo trade-mark, the Opponent filed the affidavit of Mr. La Perle.

[49] As mentioned earlier, Mr. La Perle has been the Director in the Opponent's Legal Department, managing the Opponent's Trade-mark and Copyright Group. He joined the Opponent in 1999. He states that the Opponent's predecessor-in-title Apple Computer, Inc. was incorporated in January 1977. He explains that the Opponent designs, manufactures and markets a range of mobile communication and media devices, personal computers and portable digital music players and sells a variety of related software, services, peripherals, networking solutions, and third party digital content and applications. He alleges that the APPLE brand and its products have become some of the most recognized and highly sought after in the world. He affirms that today the Opponent is recognized as one of the leaders in the computer industry.

[50] He affirms that the Opponent's products and services have been advertised, promoted, marketed and offered in close connection with the Opponent's well known trade-marks including the Apple Logo and its variants (collectively herein the APPLE trade-marks). One of the variants is the Apple Logo depicted in the colour green.

[51] Mr. La Perle states that the Apple Logo has been in continuous and prominent use by the Opponent ever since it was designed in 1977. Over the years, the Opponent has used different variants of the Apple Logo. However the design has consistently retained its distinctive form and proportions, including:

(a) the same relative size and silhouette;

(b) a single detached leaf atop the apple angling to the upper right hand corner.

[52] Mr. La Perle mentions that the Apple Logo is registered in 134 countries around the world, including in Canada. He alleges that as a result of the Opponent's extensive advertising and use of its Apple Logo in connection with its goods and services, which is detailed below, he believes that the Apple Logo is indisputably well known, has acquired extensive goodwill and has come to be immediately identified with the Opponent.

[53] Mr. La Perle affirms that the APPLE and Apple Logo brands have been ranked as some of the most valuable brands in the world. He attached as exhibit B copies of the rankings for the 'Most Valuable Global Brands' conducted by Millward Brown Optimor (MBO) for 2009 to 2012 inclusive. It was ranked number 1 in 2011 and 2012 with an estimated value of more than 153 billion dollars.

[54] Mr. La Perle explains that since introducing the Apple II personal computer in 1977 the Opponent has consistently used the APPLE trade-marks including the Apple Logo, in association with its computer products. The APPLE trade-marks, specifically the Apple Logo, are also displayed on-screen when APPLE software products, including the APPLE computer operating system, are used. They are also displayed on the Opponent's desktop computers, laptops, computer peripherals, on their casings and packaging. In addition, a prominent backlit iteration of the Apple Logo appears on many of these units. He illustrates in paragraph 9 of his affidavit

how the Apple Logo has been depicted on the Opponent's products in the past, including its line of MAC branded computers.

[55] Mr. La Perle filed as exhibit C printouts of the Opponent's Canada-specific website obtained on September 26, 2012 that show how the Apple Logo is depicted on various APPLE computers sold in Canada including its iMac, Mac Pro and Mac Mini computers. He also filed as exhibit D other excerpts of the same website depicting the use of the Apple Logo on the Opponent's portable computers sold in Canada, including its MacBook Air and MacBook Pro portable computers.

[56] Mr. La Perle states that, in addition, the Apple Logo is depicted on the Opponent's well known digital music players and mobile devices such as iPod launched in Canada in November 2001. He filed as exhibit E excerpts of the website mentioned above which show the Apple Logo displayed on and in association with current versions of the iPod music players, all of which are sold in Canada.

[57] As another type of device on which appears the Apple Logo, Mr. La Perle refers to the iPhone mobile phone introduced in Canada in 2007. He filed as exhibit F printouts of the aforesaid website depicting iPhone 4 and iPhone 4s devices sold in Canada.

[58] Also, the Apple Logo appears on iPad mobile digital devices introduced in Canada in May 2010. Mr. La Perle filed as exhibit G printouts from the said website obtained on February 3, 2013 showing the Apple Logo on the current version of the iPad digital mobile device available in Canada.

[59] Mr. La Perle affirms that the APPLE's entire product line is available in Canada through the Opponent's e-commerce website as well as through its brick and mortar retail stores. He filed as exhibit H printouts of the Opponent's website obtained on February 3, 2013 that depict the Apple Logo throughout.

[60] Mr. La Perle states that the first Apple Store retail store opened in Canada on May 21, 2005 in the Yorkdale Shopping Mall in Toronto, Ontario. He states that presently the Opponent operates 26 stores in Canada. He filed as Exhibit I a list of the locations of those stores. He

asserts that all Canadian Apple Store retail stores depict the Apple Logo on the store exterior. Since 2005, there have been over 60 million visitors to the Canadian Apple Store retail stores.

[61] Mr. La Perle then explains that the Opponent offers repair and support services for its various products through a variety of means:

- ‘Genius bar’ is a program available in the Opponent’s retail stores in which customers may speak to experts to receive in-person answers to questions about their various APPLE devices, related software, and any associated needs or troubleshoot any problems, including dealing with repair issues. He filed as exhibit K various printouts from the Opponent’s Canadian website and a smart sign used in Apple Store retail stores in Canada. The Apple Logo is prominently displayed in connection with these services;
- ‘One To One’ is a service where a customer can work together with an Apple Genius expert to set up their new Mac computer. He filed as exhibit L printouts from the aforesaid website regarding this service. The Apple Logo is prominently displayed in connection with these services;
- ‘AppleCare’ is the standard hardware warranty and support service offered by the Opponent and it comes included with all APPLE products. The additional purchase of the AppleCare Protection Plan provides consumers with additional technical support and extended service warranty coverage. He filed as exhibit M printouts regarding the offering of the AppleCare Protection Plan and related advertisements displayed in Apple Store retail stores;
- The Opponent also offers web-based support services to provide answers to general inquiries or frequently asked questions. He filed as exhibit N excerpts of the website obtained on February 4, 2013 showing general questions and related answers in respect of various APPLE devices. The Apple Logo is prominently displayed in connection with such support services;
- The Opponent also offers web-based support services through its Apple Support portal. He filed as exhibit O various printouts obtained on November 29, 2012;
- The Opponent has support lines and he filed as exhibit P a printout of the Apple’s Canadian website showing the contact number for Canada technical support.

[62] Mr. La Perle also filed as exhibits R and S various additional promotional documents relating to the Opponent’s training and support services that depict the Apple Logo. One of the brochures filed as part of exhibit R was printed in 2007 and describes the One to One program.

[63] Mr. La Perle asserts that the Opponent is committed to protecting the environment and provides efficient ways to reuse or recycle electronic equipment, including computers and displays from any manufacturer. He filed as exhibit T a printout of the website detailing the Opponent’s commitment to recycling, and how and where consumers can responsibly recycle their electronic products. Also, part of that exhibit is a compact disk containing digital copies of

two television commercials aired in Canada in 2009. However, there is no information on the extent of this broadcasting.

[64] Mr. La Perle alleges that the Opponent has significantly invested in promoting products bearing the Apple Logo in Canada and globally. Since 2001, he alleges that the Opponent has spent billions of dollars in marketing and advertising expenditures to promote its various products and services. He lists the annual amount spent globally since the fiscal year 1994 through 2012 and they vary from over 140 million dollars USD to 1 billion dollars USD and total for that period close to 7 billion dollars USD.

[65] In Canada, Mr. La Perle states that the Opponent has spent hundreds of millions of Canadian dollars on advertising and marketing during the same period of time.

[66] Mr. La Perle affirms that the Apple Logo is depicted on Apple's Canadian packaging, manuals and advertising materials. He filed as exhibit V various photographs of products and product packaging that are presently being sold in Canada that depict the Apple Logo. Photographs, part of exhibit V, illustrate advertisements in subway stations, on subways and on various buildings throughout Canada over the years.

[67] Mr. La Perle also filed as exhibit W a compact disc which includes digital copies of two advertisements that aired across Canada in 2008, which reference Apple's support services and prominently display the Apple Logo.

[68] Finally, Mr La Perle provides the annual sales figures of the Opponent of its products and services in association with the Apple Logo since 2001 made in the Americas, which region includes North America, South America, Central America and the Caribbean. He states that in Canada alone, the Opponent's revenue during the same period of time has been over \$15 billion dollars (USD). Further, with respect to Canadian retail store sales, the Opponent's revenues since the launch of the first retail store in 2005 to 2012 is over \$3 billion dollars.

[69] From this extensive evidence, I have no hesitation in concluding that the Apple Logo trade-mark is not only well known in Canada, but is also a famous mark.

[70] The application is based on proposed use and the Applicant did not file any evidence of use or reputation of the Mark in Canada. However, as mentioned earlier, there is evidence of limited use of the Mark and it comes from the Opponent's reply evidence. Mr. La Perle filed extracts of the Applicant's website, taken on October 29, 2013, as exhibit C to his November 4, 2013 affidavit where the Mark is depicted. I note that the Applicant advertised the sale of refurbished computers, including those originally manufactured by the Opponent. The Mark appears in close proximity to the name of the Opponent's products such as: iPhone, Apple, iMac etc...Also, I note the following inscription: 'Une entreprise eco-responsable qui se spécialise dans la vente et la réparation de matériel informatique Mac!'.

[71] In all, I conclude that this factor clearly favours the Opponent in view of the fame of its Apple Logo mark.

Length of time the marks have been in use

[72] Again from the evidence described above this factor favours the Opponent.

The nature of the services and their channels of trade

[73] A great deal of the Applicant's arguments relate to this factor.

[74] Mr. Roberto Ziroma is the Applicant's President and Director of Operations. He started to work in 1998 for Micro Boutique Inc., a company that repaired computers of all brands (IBM, Compaq, HP, Apple). He soon realized that numerous parts (electronic waste) were simply thrown into the garbage. He alleges that the Opponent had the monopoly over repairs to its electronic devices and once an Opponent's device was no longer working after the expiry of the warranty, the owner of the device was invited to replace it by buying a newer model, thus creating more waste.

[75] Mr. Ziroma explains that the Applicant is in the business of recycling computer products of all types and brands including the APPLE products which are no longer protected by a warranty or are obsolete. He asserts that, by this service, it provides a second life to a computer product in order to contribute to the safeguard of the green spaces from an ecology standpoint. In fact, the Applicant buys back the product in order to repair it and resell it at a modest price, or

repairs it to put it back in order to be returned to its owner. Any product that can't be repaired is sent to a specialised dump.

[76] In its reply evidence, Mr. La Perle denies the allegations made by Mr. Ziroma about the Opponent's poor recycling record with the introduction of more electronic equipment. Mr. La Perle alleges that the Opponent has achieved a recycling rate of over 70%. He asserts that the Opponent has put in place some trade-in programs where older models of products can be traded-in for newer ones at discounted prices.

[77] On this recycling issue, at the hearing, the Opponent's agent referred more particularly to the content of exhibits M and O to Mr. La Perle's first affidavit. Exhibit M are printouts from the Opponent's Canadian website regarding the offering of the AppleCare Protection Plan and related advertisements displayed in the Opponent's Apple Store retail stores. Exhibit O are printouts from the Opponent's Canada-specific website relating to the Opponent's web-based technical support.

[78] As it can be seen from this portion of the evidence, there is clearly an overlap between the Services and the Opponent's computer repair services covered by registration TMA690,668 and described above.

[79] I am fully aware that the Applicant's Services are repair services on computer equipment out of manufacturer's warranty. Despite the fact that the evidence filed by the Opponent seems to suggest that the Opponent's computer repair services are offered either during the warranty period associated to the product purchased or are offered under an extended warranty program purchased by the consumer, I do not consider such distinction to be an important consideration in assessing these factors.

[80] In fact, the customers seeking the Applicant's Services can include those who purchased at one point and time an APPLE computer which is no longer covered by the Opponent's warranty. In any event, the computer repair services covered by registration TMA690,668 are not limited in time to the duration of the warranty associated to the product purchased.

[81] I conclude that there is an overlap in the nature of the parties' services. As for the channels of trade there is also some overlap as both parties advertise their services on the Internet

and offer their services to owners of computers, including those who purchased a computer from the Opponent.

Degree of resemblance

[82] The Applicant refers to the Mark as ‘a recycling symbol formed by two arrows pointing in opposite directions and a leaf on top of the arrows on the left-handed side, falling inside the rounded shape formed by the two arrows’.

[83] The test for confusion has been set out in the following terms by Mr. Justice Binnie in *Veuve Clicquot, supra*, at para 20:

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.

[84] The Applicant tried to distinguish the marks in issue by pointing out the following differences: the leaf on top of each of the design portion of the marks in issue points in opposite directions; and there is a bite in the Apple Logo.

[85] No matter how the Applicant describes the Mark, it is the first impression of the Mark that needs to be considered and not a detailed analysis of each element of the Mark. There is no doubt in my mind that the overall look of the Mark is an apple, especially with the presence of a leaf on the top portion of the Mark. As pointed out by the Opponent, there are dips at the top and bottom of the design which are similar to the Apple Logo. The use of the colour green in the Mark also adds to this overall look. Consequently, the idea suggested by the Mark is an apple.

[86] Therefore, there is a fair degree of resemblance between the parties’ marks in appearance and in the ideas suggested by them as they both represent an apple. In fact, overall the Mark suggests, when used in association with the Services, that it is a recycling service for APPLE products.

Additional Surrounding Circumstances

Fame of the Apple Logo Mark

[87] As I indicated earlier, the Apple Logo mark is a famous trade-mark. Therefore it should benefit from a wider ambit of protection [see *Veuve Clicquot, supra*]. The wide exposure of the Apple Logo mark in the field of computers, and the absence of apple designs used in this industry, creates in the mind of a consumer an association between the Opponent and the representation of an apple in association with computers and related services, including repair services.

[88] The casual consumer will think that the Services offered in association with the Mark originate or have been authorized by the Opponent.

State of the Marketplace

[89] The bulk of the Applicant's evidence consists of extracts of third parties' websites where an apple is used as a trade-mark or as part of a logo. It consists of three binders representing more than 250 pages of material. They are part of exhibits B to Y to Mr. Ziroma's affidavit. I went through all these exhibits and I fail to see how they can be of any help to the Applicant's case for the reasons that follow.

[90] Except for the illustrations: 1) appearing on page A-210 (part of exhibit W) which seems to be an illustration of a music album depicting an apple; 2) appearing on page A-212 representing a cd depicting an apple with the trade-mark TELUS; and 3) found on page A-215 for the Beatles' (Musical group) Apple Corps logo which is an apple, none of the other illustrations are in association with services that can be directly or remotely associated to the parties' services.

[91] Without listing each and every type of services advertised or offered in association with an illustration of an apple contained in exhibits B to Y to Mr. Ziroma's affidavit, suffice to enumerate the following:

United States U.S. Apple Association

Société des Alcools du Québec

City of Rougemont, Quebec

Apple Farm Inn Hotel & Lodging; Apple Barn Winery

A dental center

Perfume industry

Apple Fitness Store

Boutique Séduction in Montreal

Appletree Medical Group.

[92] Therefore, even if I were to accept the production of excerpts of websites as evidence of use of trade-marks or trade names in the Canadian marketplace, which is not necessarily the case, the evidence filed by the Applicant falls short from demonstrating that various apple designs are widely used in the computer industry.

Preliminary Approval under Section 37

[93] As a further surrounding circumstance, the Applicant argues that the present application received preliminary approval and was advertised in the *Trade-marks Journal* for opposition purposes. However the burden of proof to be met by an applicant at the examination stage is quite different than at the opposition stage [see sections 37 and 38 of the Act]. Moreover, the Registrar did not have the benefit of the evidence filed by the Opponent and described above. Therefore, I do not consider this to be a significant surrounding circumstance favouring the Applicant.

Conclusion

[94] From this analysis of the relevant criteria I conclude that the Applicant failed to meet its legal onus to prove, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's Apple Logo trade-mark. I base my decision on the fact that the Opponent's trade-mark Apple logo is a famous mark; there is an overlap in the parties' services and channels of trade; and there is a fair degree of resemblance between the marks in appearance and the ideas

suggested by them. As for the differences between the Mark and the Apple Logo mark described in paragraph 84 above, I do not consider them to be sufficient to enable a consumer, on a first impression basis, to distinguish the Mark from the Apple Logo mark.

[95] Consequently I maintain the ground of opposition based on section 12(1)(d) of the Act.

Entitlement Ground of Opposition under Section 16(3)(a) of the Act

[96] The relevant date to determine this ground of opposition is the filing date of the application (February 24, 2011) [see section 16(3) of the Act].

[97] Firstly, I must determine if the Opponent has met its initial burden of proof namely, that it has used and/or made known in Canada its trade-mark Apple Logo prior to the relevant date. From the evidence furnished by Mr. La Perle, I am satisfied that the Opponent has met such initial burden. Also, the evidence shows that the Opponent had not abandoned the use of its Apple Logo mark at the date of advertisement (November 9, 2011) of the Applicant's application [see section 16(5) of the Act].

[98] Therefore I must decide if the Mark was confusing with the Opponent's Apple Logo trade-mark on February 24, 2011. This earlier relevant date would not have an impact on the analysis of the various factors which I have done under the previous ground of opposition. The end result would be the same, namely that the Mark was likely to cause confusion with the Opponent's Apple Logo trade-mark as of that relevant date.

[99] Consequently, I also maintain this ground of opposition.

Other Grounds of opposition

[100] The Opponent having been successful under two separate grounds of opposition, it is not necessary to assess the remaining grounds of opposition.

Disposition

[101] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application, pursuant to section 38(8) of the Act.

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

Hearing Date: 2015-05-27

Appearances

Stephanie Vaccari For the Opponent

Dominico A. Romagnino For the Applicant

Agents of Record


Baker McKenzie LLP For the Opponent

No Agent Appointed For the Applicant

Annex a

The grounds of opposition raised by the Opponent are:

1. The application does not comply with the requirements of section 30(i) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the Services because the Applicant knew or is deemed to have known of each and all of the Opponent's trade-marks of the members of the Family of Apple registrations listed below and that any use of the Mark by the Applicant would be confusing with such marks;
2. The application does not comply to the requirements of section 30(a) of the Act because the Services are not stated in ordinary commercial terms;
3. The Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with each of the Opponent's registered trade-marks part of the following Family of Apple registrations:

Trade-mark	Registration No(s)
	TMA690668 TMA354378 TMA396871

4. 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 each of the Opponent's registered trade-marks part of the Family of Apple registrations which has been previously used in Canada or made known in Canada by the Opponent and/or its predecessor in title in association with the goods and services set out in each of the aforesaid registrations and has not been abandoned by the Opponent;
5. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(b) of the Act in that at the filing date of the application the Mark was confusing with each of the Opponent's registered trade-marks part of the Family of Apple registrations in respect

of which an application for registration in Canada had been filed and registered prior to the filing of the application;

6. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive it is not adapted to distinguish the Services from the Opponent's goods and services because of the previous continuous use and advertisement in Canada by the Opponent of its Family of Apple registrations.