



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

Citation: 2013 TMOB 216
Date of Decision: 2013-12-11

**IN THE MATTER OF AN
OPPOSITION by 1 IDEA ITALIA
S.p.A. to application No. 1,504,319
for the trade-mark PURE in the
name of SwitchEasy Limited**

[1] On November 18, 2010, SwitchEasy Limited (the Applicant) filed an application to register the trade-mark PURE (the Mark) in association with the following wares based on use in Canada since at least as early as August 2009:

Plastic films and membranes adapted for covering and protecting the surfaces of electronic devices, namely, handheld personal electronic devices, namely, digital media player devices, personal digital assistant, handheld wireless devices, mobile telephones, handheld digital audio and video capture devices, or devices having a combination of one of more functionalities of the foregoing; fitted plastic films and membranes adapted for covering and protecting the surfaces of electronic devices, namely, handheld personal electronic devices, namely, digital media player devices, personal digital assistant, handheld wireless devices, mobile telephones, handheld digital audio and video capture devices, or devices having a combination of one of more functionalities of the foregoing; fitted plastic films and membranes adapted for covering and protecting the display screens of electronic devices, namely, handheld personal electronic devices, namely, digital media player devices, personal digital assistant, handheld wireless devices, mobile telephones, handheld digital audio and video capture devices, or devices having a combination of one of more functionalities of the foregoing; plastic films and membranes adapted for covering and providing a scratch proof barrier or protection for electronic devices, namely, handheld personal electronic devices, namely, digital media player devices, personal digital assistant, handheld wireless devices, mobile telephones, handheld digital audio and video capture devices, or devices having a combination of one of more functionalities of the foregoing.

[2] The application claims a priority filing date of May 20, 2010 based on an application filed in the United States

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 8, 2012.

[4] On April 5, 2012, 1 IDEA ITALIA S.p.A. (the Opponent) filed a statement of opposition. At the request of the Applicant, an interlocutory ruling issued on September 24, 2012 striking the ground of opposition based on section 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The remaining grounds of opposition can be summarized as follows:

- Pursuant to sections 38(2)(a) and 30(a) of the Act, the application for the Mark does not contain a statement in ordinary commercial terms of the specific wares in association with which the Mark is proposed to be used.
- Pursuant to sections 38(2)(a) and 30(b) of the Act, the application for the Mark does not comply with section 30(b) of the Act in that the Applicant has not used the Mark in Canada in the normal course of trade in association with each of the wares since the claimed date of first use.
- Pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable as it is confusing with the following trade-marks registered for the following wares:
 - PURO & Design – TMA810,179 – owned by the Opponent



Cases for mobile telephones, cases for computers, cases for MP3 players, cases for photographic apparatus, cases for digital television cameras; headsets; external loudspeakers; screen protectors; charging systems for mobile telephones, computers and MP3 players; trunks and travelling bags, bags, namely athletic bags, paper bags, holdalls, handbags, rucksacks, key cases, wallets, purses.

- PUREPC – TMA775,252 – owned by a third party, Heys International Ltd.

Plastic material for use in the manufacture of luggage; plastic material for use in the manufacture of bags, briefcases, and carrying cases; luggage; wheeled-luggage; suitcases; carrying bags; garment bags; belt bags; shoe bags; overnight bags; travel bags; messenger bags; briefcases; wheeled briefcases; attaché cases;

backpacks; backpacks on wheels; hydration backpacks; day packs; gym bags; all-purpose sports bags; book bags; duffel bags; tote bags; book packs; school bags; luggage straps; luggage tags; waist packs; toiletry kits sold empty; toiletry organizers sold empty; toiletry cases sold empty; cosmetic cases sold empty; garment covers; non-expandable bags on wheels; expandable bags on wheels; computer bags; computer carrying cases and bags; rolling cases and containers for portable computers; backpacks for carrying portable computers; cases, covers, containers, bags, carrying bags, backpacks, pouches, protective bags, and travelling bags for use with computers, personal digital assistant (PDA) devices, telephones and cellular phones, portable or handheld electronic devices, digital players, and MP3 players.

- Pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive in that it will not distinguish the applied for wares from the wares and services of others, and in particular, from the wares in association with which the Opponent has used the trade-marks PURO and PURO & Design in Canada namely those which are set out in the Opponent's registration No. TMA810,179.

[5] The Applicant served and filed a counter statement in which it denied the Opponent's allegations.

[6] In support of its opposition, the Opponent filed certified copies of the registration certificates for the trade-marks PURO & Design (TMA810,179) and PUREPC (TMA775,252).

[7] In support of its application, the Applicant filed a certified copy of the application for the Mark as well as an affidavit of Karim Salemhamed, the President of Atlantia Holdings Inc, the Applicant's distributor.

[8] Neither party filed a written argument and a hearing was not held

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[10] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Non-compliance Grounds – Sections 30(a) and (b) of the Act

[11] The Opponent has not provided any evidence or submissions in support of its section 30(a) and 30(b) grounds of opposition and thus I find that the Opponent has failed to meet its evidential burden and I dismiss these grounds of opposition accordingly.

Non-registrability Ground – Section 12(1)(d) of the Act

[12] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration(s) relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the registrations for the trade-marks PURO & Design (TMA810,179) and PUREPC (TMA775,252) remain valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[13] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured,

sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[14] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[15] The Mark consists of the common dictionary word PURE which has no particular meaning in relation to the Applicant’s wares.

[16] The Opponent’s trade-mark PURO & Design and the third party trade-mark PUREPC are both coined words, with the former featuring design elements as well. While the registration for PURO & Design states that PURO means “pure” in Italian, I have not been provided with any evidence that the average Canadian consumer can speak or understand Italian and thus it is more likely to be understood to be a coined word.

[17] A trade-mark may acquire distinctiveness through use or promotion.

[18] The Opponent has not filed any evidence of use or reputation for the pleaded registered trade-marks. In the absence of evidence of actual use or making known of the marks, I am only able to assume minimal use of these marks from the existence of the registrations [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. Minimal use does not support a conclusion that the PURO & Design and PUREPC marks had become known to any significant extent.

[19] The Applicant has filed some evidence in support of its claim to have used the Mark since August 2009.

[20] In his affidavit, Mr. Salemohamed makes the sworn statement that “the wares sold in association with the PURE trade-mark” are a “screen guard for third party brand name cell phones, and tablets, and other electronic hand-held devices” which he calls the “PURE products”. Mr. Salemohamed also makes the sworn statement that “the PURE products have been sold in Canada since at least as early as August 2009”.

[21] Mr. Salemohamed also attaches to his affidavit materials printed from the Applicant’s website *www.switcheasy.com* which show the Mark displayed beside an image of the PURE products. It appears that the PURE products may be purchased from this website. However, I have no sworn statements to this effect and I note that “United States” is listed as the region in the top right hand corner of the printout.

[22] Mr. Salemohamed provides annual dollar values for wholesale sales of the PURE products sold in Canada by the Applicant which exceeded \$33,000 for 2009 (August – December); \$89,000 for 2010; \$4,000 for 2011 and \$171 for 2012.

[23] In addition, Mr. Salemohamed provides sample invoices for Canadian sales which are dated from August 31, 2009 – January 30, 2010 (Exhibit D). Some of the invoices, including the one dated August 31, 2009, feature the Mark in the product descriptions.

[24] Although there appears to have been some use of the Mark, the evidence is not sufficient to enable me to infer that the Mark has become known to any significant extent in Canada. This is due in part to the fact that the sales figures are not particularly high and the Applicant has not provided any information regarding advertising expenditures associated with the Mark.

[25] Based on the foregoing, this factor does not significantly favour either party.

Section 6(5)(b) – the length of time each has been in use

[26] The registration for PURO & Design (TMA810,179) shows that the trade-mark was registered on the basis of use and registration in Italy and the registration for PUREPC (TMA775,252) shows that it issued subsequent to the filing of a declaration of use on August 23, 2010. However, as discussed further above in the analysis of the section 6(5)(a) factor, these registrations only enable me to assume minimal use of the pleaded marks.

[27] The Applicant claims use of the Mark since August 2009 and provides some evidence in support of this claim.

[28] Ultimately, while the Applicant's use may pre-date the Opponent's, I am of the view that this factor does not significantly favour the Applicant.

Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade

[29] There is some overlap in the nature of the wares associated with the Mark and with the pleaded registered trade-marks.

[30] Specifically, the Applicant's wares share a significant degree of similarity with the Opponent's "cases for mobile telephones, ... cases for MP3 players, cases for photographic apparatus, cases for digital television cameras ..." which are included in the registered wares associated with PURO & Design (TMA810,179). The Applicant's wares also share some similarity with "cases, covers, ...protective bags, ... for use with ... personal digital assistant (PDA) devices, telephones and cellular phones, portable or handheld electronic devices, digital players and MP3 players" which are included in the registered wares associated with PUREPC (TMA775,252).

[31] In his affidavit Mr. Salemohamed explains the Applicant's normal course of trade. Mr. Salemohamed states that Atlantia Holdings Inc. (the Applicant's distributor) distributes the Applicant's products, including products sold in association with the Mark for sale at various retail outlets throughout Canada including London Drugs, various cell phone and wireless retail stores and college and university campus stores.

[32] In the absence of evidence from the Opponent, for the purposes of assessing confusion, I conclude that there is potential for overlap in the channels of trade.

[33] Based on the foregoing, this factor favours the Opponent.

Section 6(5)(e) – the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[34] The Mark shares a greater degree of similarity in appearance, sound and idea suggested with the registered PUREPC mark by virtue of the inclusion of the entirety of the Mark in the PUREPC mark.

[35] The only similarity between the Mark and the PURO & Design mark arises from the shared first three letters (PUR).

[36] In terms of ideas suggested, the Mark suggests the notion “purity” which is defined in the *Canadian Oxford Dictionary* as “pureness, cleanness; freedom from physical or moral pollution”.

[37] The PUREPC mark, while a coined word, also suggests the notion of purity to some extent by virtue of the inclusion of the word “PURE” in the mark.

[38] With respect to the PURO & Design mark, as discussed above in the analysis of the section 6(5)(a) factor, despite the translation that has been provided for the word PURO, I have not been provided with sufficient evidence to enable me to infer that the average Canadian would interpret the PURO & design mark to mean “PURE”.

[39] Based on the foregoing, I find that this factor favours the Opponent but only with respect to the pleaded third party trade-mark, PUREPC.

Conclusion

[40] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, I find that with respect to the registered trade-mark PUREPC, the similarity in the nature of the wares and the degree of resemblance between the marks at

issue favour the Opponent. The remaining factors do not significantly favour either party such that I am of the view that the balance of probabilities is evenly balanced between a finding of confusion between the Mark and the pleaded PUREPC trade-mark and a finding of no confusion.

[41] As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with one or more of the pleaded registered trade-marks, I must decide against the Applicant.

[42] Based on the foregoing, I find that the ground of opposition based on section 12(1)(d) of the Act is successful with respect to the third party registered trade-mark PUREPC (TMA775,252).

Non-distinctiveness Ground of Opposition

[43] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[44] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of its PURO and PURO & Design trade-marks had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FCTD)].

[45] The Opponent has not provided any evidence whatsoever for the pleaded PURO trade-mark and as discussed in the analysis of the non-registrability ground of opposition, the Opponent has also failed to provide any evidence of use of or reputation in Canada for the registered trade-mark PURO & Design.

[46] Accordingly, I find that the Opponent has failed to meet its evidential burden with respect to the non-distinctiveness ground of opposition.

Disposition

[47] 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.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office