

**IN THE MATTER OF AN OPPOSITION
by Acklands Limited to application No. 688,057
for the trade-mark A & Design filed by Anamet, Inc.**

On August 20, 1991, the applicant, Anamet, Inc., filed an application to register the trade-mark A & Design (illustrated below) for the following wares:

- (1) electrical conduit,
- (2) electrical conduit fittings and assemblies,
- (3) hoses, tubing assemblies, expansion joints, flex connectors, vibration eliminators, and ducting.

The application was based on use in Canada since 1984 with the wares marked (1) and (3) and on use in Canada since January 1991 with the wares marked (2). The application was advertised for opposition purposes on July 8, 1992.

The opponent, Acklands Limited, filed a statement of opposition on July 22, 1992, a copy of which was forwarded to the applicant on August 19, 1992. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark A & Design (illustrated below) registered under No. 217,602 for the following services:

merchandising and distribution of builders hardware, power and hand tools, home entertainment and electronics products, industrial chemicals, industrial products, lawn care and garden equipment, fasteners, electrical equipment, building supplies, lubricants, paper products, home appliances, welding equipment, adhesives, abrasives, mining equipment, housewares, plumbing, heating and air conditioning equipment, paint and painting supplies, recreational and leisure equipment, automotive equipment, parts and accessories, motor cycles, bicycles, boats, snow-mobiles, outboard motors, ferrous and non-ferrous metals, supplies and accessories, heavy machinery.

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act in respect of the wares marked (2) because, as of the claimed date of first use of January 1991, the applied for trade-mark was confusing with the opponent's trade-mark A & Design for which an application to extend the wares and services of registration No. 217,602 (application No. 387,720) had previously been filed on December 18, 1989 for a number of hardware, automotive and household items and for the services of the "operation of a wholesale and retail outlet" dealing in the sale of a very wide range of specific products including "electrical equipment", "wire, cable, portable cords, component conduits....conduit fittings, outlet boxes and enclosures" and "electrical distribution equipment, fuses, circuit breakers, utility metering equipment, motor control equipment, transformers, instruments and testers." The extension application is based on use of the opponent's trade-mark in Canada since 1974 for both wares and services.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant's claimed dates of first use, the applied for trade-mark was confusing with the trade-mark A & Design previously used in Canada by the opponent. The fourth ground is that the applied for trade-mark is not distinctive because it is confusing with the opponent's trade-mark.

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of its Vice-President Finance, Richard Clegg. As its evidence, the applicant filed an affidavit of Carol Luciani and an affidavit of Bev. R. Thew, the President of its wholly

owned subsidiary Anamet Canada Inc. As evidence in reply, the opponent filed an affidavit of its Secretary, Eugene Nicholas Hretzay although much of that affidavit is inadmissible as not being strictly confined to matter in reply. Only the applicant filed a written argument and no oral hearing was conducted.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to Section 12(1)(d) of the Trade-marks Act is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The marks of both parties are inherently distinctive although both marks are not inherently strong since they both can be viewed as stylized representations of the letter A and letters or initials comprise weak marks. Although Mr. Clegg, in his affidavit, attests to significant sales by the opponent, he failed to provide any facts from which I could conclude that any of those sales were made in association with the registered mark A & Design. Thus, I must conclude that the opponent's mark has not become known at all in Canada.

In his affidavit, Mr. Thew states that Anamet Canada Inc., as a distributor and licensee of the applicant, has effected fairly significant sales of A & Design electrical wares. However, Mr. Thew also states that those wares have been sold primarily to "...specialized trades, namely, the electrical trades." Furthermore, the exhibits to Mr. Thew's affidavit invariably show the applicant's trade-mark used in conjunction with the trade-mark ANAMET or the trade-name Anamet Canada Inc. Thus, much of the acquired reputation arising from the sales of the applicant's goods would be associated with the trade-mark ANAMET or the Canadian subsidiary's trade-name. Nevertheless, I am able to conclude that the applicant's mark had become known in Canada although only within the electrical trade.

Since the opponent did not properly evidence continuing use of its trade-mark, the length of time the marks have been in use favors the applicant although this circumstance is not of great significance in the present case. The applicant's wares and the opponent's registered services would appear to be related since the opponent merchandises and distributes many products including "electrical equipment." Although Mr. Clegg was silent as to the opponent's manner of doing business, the opponent's extension application points to the operation of wholesale and retail outlets dealing in a wide range of hardware, automotive and industrial products including some of the same wares for which the applicant seeks registration such as "electrical equipment", "component conduits" and "conduit fittings." Thus, it would seem likely that the type of wares listed in the applicant's application could be sold by the opponent. In fact, the opponent may have sold the applicant's specific A & Design wares since Mr. Thew states in paragraph 17 of his affidavit that his company has sold more than \$18,000 of such goods to the opponent during the period 1985 to 1990.

The applicant contends that its trade is very specific and that its customers comprise a specialized trade, namely the electrical trade. However, no such restrictions appear in the applicant's statement of wares and that is what governs: see the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and pages 11-13 of the recent unreported decision of the Federal Court of Appeal in Miss Universe, Inc. v. Dale Bohna (Court No. A-841-92; November 7, 1994). In any event, notwithstanding the applicant's contention otherwise, it appears that there has been or could be an actual overlap in the trades of the parties.

As for Section 6(5)(e) of the Act, I consider there to be a fair degree of visual resemblance between the marks of the parties. Both marks appear to be stylized versions of the letter A. Each mark consists of a black triangular design enclosing a smaller white triangular area. The marks do differ in some respects, however, since the opponent's registered mark includes a small leaf and the applicant's black triangle has slightly rounded

points as compared to the sharp points of the opponent's triangle. To the extent that both marks are stylized versions of the letter A, there may be some degree of resemblance in the sounding of the marks although it seems unlikely that either mark would be identified in that manner. There is, however, some resemblance in the ideas suggested by the marks since they both suggest a triangle or the letter A.

The applicant contends that the effect of any resemblance between the marks at issue is mitigated by the existence of a number of similar marks on the trade-marks register as evidenced by the Luciani affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

Most of the design marks located by Ms. Luciani consist of different designs from the two marks at issue, include significant additional wording or design matter or are registered for different wares. At most, only several of the marks identified by Ms. Luciani are relevant. Such a small number is insufficient to allow me to make any meaningful inferences about possible common use of that type of mark in the marketplace.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, services, trades and marks of the parties, I find that I am left in a state of doubt respecting the issue of confusion. Since the onus or legal burden is on the applicant to show no reasonable likelihood of confusion, I must resolve that doubt against it. I suspect that if the opponent had filed useful evidence, the outcome would not have been so open to doubt. In any event, the first ground of opposition is successful and

the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS _____ DAY OF _____ 1995.

**David J. Martin,
Member,
Trade Marks Opposition Board.**