

TRADUCTION/TRANSLATION



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

Citation: 2011 TMOB 179
Date of Decision: 2011-09-30

**IN THE MATTER OF AN OPPOSITION
by DK-Spec Inc. to the application for
registration No. 1,198,463 for the
trade-mark BGR and Design in the name
of Scies B.G.R. Inc.**

[1] Scies B.G.R. Inc. (the Applicant) filed the application for registration No. 1,198,463 for the trade-mark BGR and Design shown below



in association with saw blades (Wares).

[2] This application is filed on the basis of use of the Mark in Canada since as early as March 2001. The application was advertised for opposition purposes in the *Trade-marks Journal* of June 16, 2004.

[3] On July 29, 2004, DK-Spec Inc. (the Opponent) notified the Registrar that it intended to file a statement of opposition. It finally filed a statement of opposition on April 16, 2007, which the Registrar forwarded to the Applicant on April 26, 2007. On October 26, 2007, the Applicant filed a counter statement denying all of the grounds of opposition described below. On the same

day, the Applicant filed an amended application for registration in order to remove any reference to use of the Mark by the predecessor in title 1192-6557 Québec Inc. On November 21, 2007, the Registrar accepted this amended application.

[4] As Rule 41 evidence, the Opponent filed the affidavit of Clermont Levasseur. Under Rule 42, the Applicant filed the affidavits of Sylvain St-Hilaire and Jocelyne Genest. Only Mr. Hilaire was examined, and the record contains his cross-examination transcript and his replies to undertakings made on cross-examination.

[5] Each of the parties filed a written argument. No oral hearing was held.

Grounds of opposition

[6] The various grounds of opposition raised by the Opponent may be summarized as follows:

1. the application does not fulfill the requirements of s. 30(b) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (Act) because it contains the name of a predecessor in title that commenced use of the Mark, which predecessor in title had been dissolved by the date of first use claimed in the application;
2. the application does not fulfill the requirements of s. 30(i) of the Act because the Applicant could not have stated being satisfied that it is entitled to use the Mark in Canada in association with the Wares;
3. the Mark is not registrable under s. 12(1)(d) of the Act, as it is confusing with the Opponent's registered trade-mark BGR, registration No. TMA420,841;
4. the Applicant is not the person entitled to register the Mark under s. 16(1)(a) of the Act because the Mark is confusing with the trade-marks OUTILS BGR, OUTILS B.G.R, B.G.R. TOOLS, BGR TOOLS and OUTILS BGR TOOLS used by the Opponent since at least as early as 1988;
5. the Applicant is not the person entitled to register the Mark under s. 16(1)(a) of the Act because the Mark is confusing with the trade-mark BGR used by the Opponent since at least as early as 1974;
6. the Applicant is not the person entitled to register the Mark under s. 16(1)(c) of the Act because the Mark is confusing with the trade-names BGR, Outils BGR, Outils B.G.R. Inc., Outils B.G.R. Tools, BGR Tools and Outils BGR Tools used by the Opponent since at least as early as 1988;

7. the Mark is not distinctive within the meaning of s. 2 of the Act because the Mark does not actually distinguish and is not adapted to distinguish the Wares from the wares and services of other persons and, more specifically, from the wares and services of the Opponent, in association with which the Opponent has used and uses the marks identified above.

Burden of proof when opposing registration of a trade-mark

[7] In proceedings to oppose registration of a trade-mark, the opponent must present enough evidence in relation to the grounds of opposition raised to show that there are facts supporting those grounds. If the opponent meets this requirement, the applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition raised should not prevent registration of the mark [see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)].

Grounds of opposition summarily decided

[8] The first ground of opposition is now moot because the Applicant amended its application for registration by removing any reference to its predecessor in title 1192-6557 Québec Inc.

[9] Section 30(i) of the Act does not require the Applicant to state that it is satisfied that it is entitled to register the Mark. This statement appears in the application for registration. Section 30(i) of the Act may be argued, among other cases, where it is alleged that the Applicant's statement was made in bad faith [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. This was neither alleged nor proven. The second ground of opposition is therefore dismissed.

[10] Mr. Levasseur, president of the Opponent, filed a copy of registration No. TMA420,841 for the mark BGR, registered December 10, 1993, which is the legal basis for the third ground of opposition. However, I exercised my discretion to check the register [see *Quaker Oats Co. of Can. v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)], and I note that this registration was expunged on July 23, 2009, because the owner failed to renew it. Given that this ground of opposition must be analyzed at the date of my decision [see *Park Avenue Furniture Corporation*

v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 at page 424 (F.C.A.)], it is dismissed on the basis of the expungement of this registration.

Preliminary remarks

[11] The parties are no strangers to one another. There have been corporate changes involving both parties to this opposition. However, I can briefly summarize some of the corporate transactions between 1974 and 1995 involving the parties to this opposition. Afterwards, I will address each party's evidence in greater detail.

[12] In the beginning, there was a company named Scies BGR Inc. (Scies BGR) which, between 1974 and 1988, operated in the manufacturing and sales of saws, saw blades, knives and planer heads, all designed for use in the forest industry. In 1988, the three senior executives of this company decided by mutual agreement to part ways. As a result, the commercial activities related to saw and saw blade marketing became the business of the Applicant, run by Mr. Blanchet, whereas the Opponent, with Mr. Ruel at the helm, took over the manufacturing and sale of planer knives and heads. Although two different entities carried on these activities as of 1988, they occupied premises in the same building until 1995. From time to time, they even exchanged information regarding mutual customers' needs for the wares sold by each of the respective parties.

Opponent's evidence

[13] Mr. Levasseur has been the president of the Opponent since 2002. He explains that the Opponent is the result of a number of acquisitions and reorganizations of various corporate entities, including Outils BGR Inc. A copy of the printout from the Quebec enterprise register shows that Outils BGR Inc. was incorporated on January 1, 1988. It changed its name to DK-Spec Inc. in February 2004.

[14] Mr. Levasseur explains that, in 2002, the entities he headed acquired the shares of Outils BGR Inc., then run by Jacques Ruel. He alleges that, despite the corporate name change in 2004, the Opponent carried on its activities in the sale and marketing of tools and knives under the trade-mark BGR.

[15] Mr. Levasseur stated that Jean-Claude Blanchet, Raymond Gauvin and Jacques Ruel operated Scies BGR from 1974 to 1988. The letters “BGR” in the corporate name are the combination of the first letter of each partner’s surname. Thus, Scies BGR only began using these letters as of 1974, when Mr. Ruel joined Mr. Blanchet and Mr. Gauvin. Mr. Levasseur has filed samples of presentation material, catalogues and price lists for tools and knives produced, marketed and sold by Scies BGR before the split in 1988, in which some of the saws illustrated display the trademark BGR. The corporate names BGR Saws Inc., Les Scies BGR Inc. and Les Scies BGR Saws Inc. are also marked on the catalogues filed.

[16] In 1988, this company’s assets and activities were divided up as part of a butterfly transaction. Unfortunately, no information has been provided on the characteristics of such a transaction. Before and in anticipation of this split, Scies BGR changed its name to 1192-6557 Québec Inc. After that, this company was dissolved on December 10, 1990, and Mr. Levasseur has filed a copy of the dissolution order.

[17] Until 1988, Scies BGR operated in the manufacturing and sales of saw blades, knives and tools used in the forest industry. When the assets were separated in 1988, the activities and assets of Scies BGR related to saw blades were given over to entities headed by Mr. Blanchet and Mr. Gauvin, whereas the assets and activities related to knives and tools were assigned to entities run by Mr. Ruel.

[18] Following the butterfly transaction between the partners of Scies BGR, Mr. Ruel set up a business known as Outils BGR Inc. (now the Opponent, after a change of name), and Messrs. Blanchet and Gauvin founded a company by the name of Scies BGR Inc., the Applicant.

[19] Mr. Levasseur alleges that many tools manufactured by the Opponent have the mark BGR displayed on the tool itself, and he filed a copy of a photograph of one such tool. He also filed the catalogues and price lists published after 1988, which contain illustrations of tools and knives, some of which have the letters BGR engraved on them. There are also some catalogues published after 1995, since they are marked with the address of the Opponent at its new place of business after having left the common premises of the parties. Mr. Levasseur stated that the mark BGR is also marked on stickers placed on the Opponent’s products when they change ownership as part of the normal course of business.

[20] Mr. Levasseur states that, as for the Applicant, its saw blades have always been chiefly known and marketed under the name “Scies BGR”, not “BGR” alone. He also states that, following the transaction of 1988, the Applicant did not oppose the Opponent’s registration or use of the mark BGR. According to Mr. Levasseur, the Applicant cannot be unaware of the Opponent’s presence and its use of the mark BGR in the various Canadian and U.S. forest industry markets, since the Opponent and the Applicant target the same customers and the same markets.

[21] According to Mr. Levasseur, after the Opponent’s acquisition in 2002, that company went from having three sales representatives to more than 20 over the years that followed. Thus, the annual sales of the Opponent, which [TRANSLATION] “banked on the mark BGR” to use Mr. Levasseur’s turn of phrase, went from \$5 million before its acquisition in 2002 to over \$20 million in recent years. However, there is no way to determine whether those figures are associated exclusively with products displaying the BGR mark that are sold in Canada.

[22] I give no weight to Mr. Levasseur’s comments and opinions regarding the possibility of confusion in a customer’s mind if the Applicant uses the Mark in association with the Wares. However, I do accept his observations about the similarity between the Wares and the Opponent’s products. I will address this similarity in greater detail.

[23] Regarding the allegations concerning the Applicant’s commercial activities in association with wares other than the Wares and the steps taken in the United States, I deem them irrelevant to the issues that must be decided in these opposition proceedings. More specifically, I refer to the allegations set out at paragraphs 47 to 52 of Mr. Levasseur’s affidavit.

Applicant's evidence

[24] Mr. St-Hilaire began his involvement with Scies B.G.R. as a stock keeper in August 1982. Since 2004, he has been the Applicant's president. I must point out that I am drawing a distinction between the Applicant and Scies B.G.R., the corporate entity operating before the January 1988 transaction, because of the nature of the corporate transactions that took place in 1988 and thereafter.

[25] On January 22, 1988, Scies B.G.R. changed its corporate name to 1192-6557 Québec Inc., and that entity was dissolved, as mentioned above, on December 10, 1990. Mr. St-Hilaire, without any supporting documentation, alleged transactions took place between 1192-6557 Québec Inc. and Scies B.G.R. (1998) Inc., a new company formed following the January 1988 transaction, which changed its name in 1999 to become the Applicant.

[26] A photograph filed as Exhibit SH-15 to Mr. St-Hilaire's affidavit shows clearly that the Opponent and the Applicant operated under one roof from 1988 to 1995. This photograph illustrates the exterior sign displaying the letters BGR in the centre, the word [TRANSLATION] "saws" to the left and the word [TRANSLATION] "tools" to the right of those letters.

[27] Mr. St-Hilaire confirms that the Applicant, headed by Mr. Blanchet, continued designing and manufacturing saws and saw blades, activities carried on by Scies B.G.R. between 1974 and 1988, whereas the Opponent, steered by Mr. Ruel, concentrated its activities on the manufacturing and sale of planer knives and heads, activities also carried on by Scies B.G.R. over the same period.

[28] Mr. St-Hilaire states that the saws and saw blades designed and manufactured by the Applicant are custom-made to meet the operational specifications of its customers' mills. Once the saws and saw blades are delivered to its customers, the Applicants' representatives visit each of its customers to offer them technical support. Mr. St-Hilaire's cross-examination also revealed that the parties have customers in common. At least for the period during which the parties shared the same building, from 1988 to 1995, there was a level of complicity between them, such that it was not infrequent for a representative of one party to alert the sales representative of the other party of the possibility that a shared customer might need that other party's equipment.

[29] Mr. St-Hilaire admits that, after the Opponent moved out of the building jointly occupied by the parties, there were instances of confusion, but with time and given the limited markets of each party, these occurrences quickly came to an end. To his personal knowledge, there have been no instances of confusion for at least 17 years.

[30] Mr. St-Hilaire explained the difference between the Wares and the Opponent's wares and services. The Wares are intended for use in the primary wood-processing industry, in particular saw mills, whereas the Opponent's wares are intended for use in planing mills. However, on cross-examination, Mr. St-Hilaire admitted that a given company could carry on both operations in close proximity to one another, even on the same site.

[31] Mr. St-Hilaire contends that, on January 18, 1988, Scies B.G.R. and the predecessors in title of the Applicant and the Opponent agreed that each of them could use the term "BGR" in association with their respective activities. He filed excerpts from the minutes of the administrator and shareholder meetings of B.G.R. held on that date. I have reproduced the resolutions adopted:

[TRANSLATION]

Change of corporate name

BE IT RESOLVED to change the corporate name, as follows: SCIES B.G.R. INC. decides and mandates its president, Mr. Jean-Claude Blanchet, to change the corporate name to a number name.

Therefore, BE IT RESOLVED to authorize GESTION JEAN CLAUDE BLANCHET INC. to incorporate a company or change the corporate name of the company GESTION JEAN CLAUDE BLANCHET INC, which will henceforth have the name SCIES B.G.R. INC.

BE IT FURTHER RESOLVED to allow GESTION JACQUES RUEL INC. to change its corporate name, allowing it to use the corporate name Outils B.G.R. INC.

BE IT FURTHER RESOLVED that the current company SCIES B.G.R. INC. incorporate a subsidiary having the corporate name IMMEUBLES B.G.R. INC. and that Jean-Claude Blanchet, its president, is authorized to sign any documents required for that purpose.

[32] Mr. St-Hilaire asserts that, following those resolutions, [TRANSLATION] “the Applicant (or its predecessor in title) has been using, in Canada, since at least 1974, in association with saws and saw blades, trade-marks containing the element ‘BGR’, including the marks BGR . . .”. I will return to this notion of “predecessor in title of the Applicant” in light of the evidence in the record.

[33] Mr. St-Hilaire explained that, in 2001, the Applicant changed its corporate identity, adopting the Mark, and alleges that the Applicant has been using the Mark since at least as early as March 2001 in association with saws and saw blades. To illustrate this use, Mr. St-Hilaire filed excerpts from the Applicant’s Web site. These excerpts, as such, are not evidence of use of the Mark in association with the Wares within the meaning of s. 4(1) of the Act.

[34] However, Mr. St-Hilaire filed photographs of saw blades manufactured by the Applicant and packaging for saws, on which the Mark is displayed [see Exhibits SH-7 and SH-8]. He also filed a sampling of invoices dating from 2001 to 2009 and advertising material such as brochures and advertisements in various special-interest publications. Last, he provided the sums invested by the Applicant since 2001 to promote and advertise the Mark and listed the various trade shows in which the Applicant participates to promote sales of Wares displaying the Mark.

[35] I also accept the following elements brought to light by Mr. St-Hilaire’s cross-examination: since 2007, the Applicant has been selling planing knives, but under the trade-mark KNI, and, in everyday language, BGR is sometimes said instead of Scies BGR or Outils BGR.

Analysis of the fifth ground of opposition under s. 16(1) of the Act

[36] The best scenario for the Opponent is closely linked to the evidence pertaining to its use, or non-use, of the mark BGR. If I find that the Opponent failed to meet its burden of proving use of the mark BGR, I will then have to analyze the grounds of opposition predicated on use of the trade-marks and trade-names OUTILS BGR.

[37] I will therefore rely on this premise in considering the fifth ground of opposition, stated above. The relevant date for analyzing this ground of opposition is the date of first use alleged in the application for registration (March 31, 2001) [see s. 16(1) of the Act].

[38] To meet its initial burden of proof, the Opponent must demonstrate previous use of its trade-mark BGR and show that it had not abandoned that use at the date of advertisement of the Applicant's application (June 16, 2004) [see s. 16(5) of the Act].

[39] It is clear that the Opponent has used the mark BGR since at least January 1988 (see Exhibit CL-1 to Mr. Levasseur's affidavit).

[40] I note, from the outset, that we must not forget the Applicant's claim of use of the Mark (not BGR) since March 2001. Therefore, any use by the Applicant of the trade-mark BGR lends no support to its application for registration of the Mark. I would add that Scies BGR changed its name to 1192-6557 Québec Inc. in 1988 and was dissolved on December 10, 1990. I have no evidence that the rights in the trade-mark BGR were assigned to either of the parties before this dissolution. The resolution of the administrators of Scies BGR Inc. on January 18, 1988, is not an assignment to that effect; it is an agreement between several corporate entities, which stipulated that these corporate entities, including the parties to these opposition proceedings, could use a corporate name containing the element BGR. However, below, I will discuss the parties' shared use of the mark BGR as of 1988.

[41] The Opponent's evidence therefore unequivocally establishes use of the trade-mark BGR in association with planer knives and heads as of 1988. However, has the Opponent established that, at June 16, 2004, it had not abandoned this use? The documentary evidence filed to establish use of the Opponent's mark BGR shows that the Opponent thoroughly demonstrated use of this trade-mark as of 1988, which predates the date of first use alleged by the Applicant in its application for registration. However, I was unable to find any documentary evidence establishing use of the trade-mark BGR by the Opponent contemporary with June 16, 2004. There are certainly Mr. Levasseur's contentions that, ever since the Opponent was acquired by Mr. Levasseur in 2002, it has continued to use the trade-mark BGR. At paragraph 22 of his affidavit, he contends that the tools produced by the Opponent, referring specifically to the name DK-Spec Inc., display the mark BGR. He filed a photograph of one such tool, on which this

mark may be seen. However, the corporate name DK-Spec has only been registered since February 13, 2004 [see Exhibit CL-1 to Mr. Levasseur's affidavit].

[42] The notion of abandonment of a trade-mark, found at s. 16(5) of the Act, must not be associated with non-use of the trade-mark. For there to be abandonment of use of a trade-mark, there must be evidence of an intention to abandon use of that trade-mark [see *Labatt Brewing Co. v. Formosa Spring Brewery Ltd.* (1992), 42 C.P.R. (3d) 481(F.C.T.D.)]. Although the record contains scanty evidence of the Opponent's use of the trade-mark BGR within the meaning of s. 4(1) of the Act, in light of the allegations stated in the paragraph above, I cannot conclude that there was abandonment of the trade-mark BGR by the Opponent at June 16, 2004, within the meaning of s. 16(5) of the Act. As a result, the Opponent has met its initial burden of proof.

[43] The Applicant must therefore show that there is no likelihood of confusion between the Mark and the Opponent's mark BGR. The applicable test in this case is described at s. 6(2) of the Act. Thus, the use of the Mark will cause 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 and services associated with those trade-marks are manufactured, sold, hired or performed by the same person, whether or not the wares or services are of the same general class.

[44] A non-exhaustive list of the relevant circumstances appears at 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 business; 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. In the recent decision *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27, the Supreme Court of Canada interpreted s. 6(2) and clarified the scope of the various criteria listed at s. 6(5) of the Act. This analysis shows that the most important factor is still the degree of resemblance between the marks at issue.

The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known

[45] The Opponent's trade-mark BGR possesses a very low degree of inherent distinctiveness because it consists only of letters of the alphabet [see *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (T.M.O.B.)]. The Mark has a slightly higher inherent distinctiveness than the Opponent's mark because of the graphic element of the Mark. However, I do not consider this slim advantage to be a determinative factor.

[46] A trade-mark's distinctiveness may be enhanced by its use and reputation in Canada. The Opponent has demonstrated use of its mark BGR since January 1988. However, there is very little evidence of use of this mark by the Opponent after 1995. During that same period, the Applicant also used the trade-mark BGR. This parallel use of the mark BGR by both parties lessened the distinctiveness of the Opponent's mark BGR. Clearly, these opposition proceedings are not the appropriate forum for determining the Opponent's rights in the trade-mark BGR. However, as stated above, the mark at issue in these opposition proceedings is not BGR, but the Mark, of which the Applicant only claims use since March 2001.

[47] Considering all of the circumstances, I give but little weight to the first factor listed at s. 6(5) of the Act.

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

[48] The use of the Mark dates back to March 2001, whereas the Opponent's use of the trade-mark BGR began in January 1988. The Applicant argues that it has also been using the trade-mark BGR since January 1988, such that this factor would not be to either party's advantage. I note that the Mark at issue in this application is the Mark, not BGR. In that sense, the Applicant cannot claim that use in support of its allegations with regard to this factor. This factor favours the Opponent.

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

[49] The evidence in the record addresses this aspect comprehensively. From the evidence described above, I accept that the Wares and the Opponent's products were initially sold by the

same entity, Scies BGR Inc. In 1988, the parties were created and, thus, the commercial activities of Scies BGR Inc. were divided in two. On the one side are the Wares, sold by the Applicant, and, on the other side, planer knives and heads, sold by the Opponent. The Applicant has attempted to show that the parties' products are intended for different uses and are not found in the same buildings. However, the fact remains that these products are all intended for use in the forest industry, and that both parties have the same potential customers. In fact, these customers are the ones who cut wood in sawmills and process it using the Opponent's products, albeit in a different building, but nonetheless one located close to the buildings where wood is generally cut. In the circumstances, I conclude that these factors weigh strongly in the Opponent's favour.

The degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them

[50] The marks at issue here are phonetically identical. To be sure, they may be distinguished by the graphic element, but I am not satisfied that an average consumer who has an imperfect recollection of the Opponent's trade-mark BGR would be adept at distinguishing the source of the Wares solely on the basis of this graphic element. It is more likely to think that this consumer would recall the word portion of the Mark. This factor favours the Opponent.

[51] From this analysis I conclude that the Applicant has failed to establish, on a balance of probabilities, that the Mark was not confusing with the Opponent's mark BGR at the date of first use claimed in its application for registration. Indeed, despite the low distinctiveness of the Opponent's mark BGR, the inherent distinctiveness of the Mark is also fairly low. In this case, the marks at issue are phonetically identical. In addition, potential purchasers of the Wares and of the products sold by the Opponent are the same.

[52] I therefore allow the fifth ground of opposition.

Ground of opposition under s. 2 of the Act

[53] The distinctiveness of the Mark must be assessed at the filing date of the statement of opposition (April 16, 2007) [see *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.) at page 130 and *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.*

(2004), 34 C.P.R. (4th) 317 (F.C.)). The Opponent must therefore show that its trade-marks were sufficiently known at the relevant date.

[54] There is no doubt, from the evidence summarized above, that at April 16, 2007, the Opponent's trade-mark BGR was known in Canada in the forest industry. The corporate name Outils BGR was also known. I will therefore limit my analysis of this ground of opposition to a comparison of the Opponent's trade-mark BGR with the Mark, since this is the best scenario for the Opponent.

[55] The Applicant must therefore show that, at April 16, 2007, the Mark was distinctive or adapted to distinguish the Wares from the wares sold by the Opponent in association with its trade-mark BGR. In other words, the Applicant must establish, on a balance of probabilities, that at this date, the use of the Mark in association with the Wares was not confusing with the Opponent's mark.

[56] I do not see how a critical date three years later than the relevant date for the previous ground of opposition would alter favourably my analysis of the various relevant factors to the Applicant's advantage. The phonetic similarity of the marks at issue combined with the nature of the parties' wares and their market niches favour the Opponent, regardless of the relevant date. In my opinion, the lack of evidence of instances of confusion during the relevant period (March 2001 to April 16, 2007) is not a sufficiently important factor to counterbalance the factors concerning the nature of the wares, their market niches and the degree of resemblance of the marks, all of which favour the Opponent. The test is not the lack of instances of confusion, but the likelihood of confusion between the marks.

[57] In the circumstances, I also allow the seventh ground of opposition.

Remaining grounds of opposition

[58] Since the Opponent has been successful under two separate grounds of opposition, there is no need to rule on the fourth and sixth grounds of opposition.

Decision

[59] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application for registration in accordance with s. 38(8) of the Act.

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

Certified true translation
Sarah Burns