

**IN THE MATTER OF AN OPPOSITION by  
National Forming Systems Inc. to application No.  
1,267,387 for the trade-mark SKYHAND filed by  
Skyhand Inc.**

[1] On August 4, 2005, Skyhand Inc. (the Applicant) filed an application to register the trade-mark SKYHAND (the Mark). The application is based upon use of the Mark in Canada since April 7, 2004 in association with “a tool holder made of light metal designed to be held on a rail used with aerial lifts and scaffolding, and used in various industries.”

[2] The application was advertised for opposition purposes in the Trade-marks Journal of April 12, 2006. On May 30, 2006, National Forming Systems Inc. (the Opponent) filed a statement of opposition. The Opponent has pleaded grounds of opposition under s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

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

[4] On April 13, 2007, the Opponent requested leave to amend its statement of opposition. Leave was granted on July 23, 2007.

[5] In support of its opposition, the Opponent filed the affidavits of Radivoje Andrejevic, the Opponent’s Operations Manager, and Ron Karras, a businessman. (I note that the affidavit of Mr. Andrejevic, as filed with the Registrar of Trade-marks, consists of paragraphs 1-9 and 14-20 plus exhibits A-H; it does not include any paragraphs numbered 10-13.)

[6] In support of its application, the Applicant filed the affidavits of James Westra, the owner of the Applicant, and Amy Croll, a trade-mark agent.

[7] No cross-examinations were conducted.

[8] Neither party filed a written argument. An oral hearing was not requested.

### Onus

[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 [*John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

### Section 38(2)(a)/30(i) Ground of Opposition

[10] The Opponent has pleaded that the application does not comply with s. 30(i) because the Applicant cannot be satisfied that it is entitled to register the Mark in view of the prior use/making known of the Opponent's SKY LIFT mark. The Opponent has pleaded that the Applicant should have been aware that its Mark was confusing with the Opponent's mark.

[11] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the Opponent has not evidenced any bad faith on behalf of the Applicant, this ground is dismissed.

### Section 38(2)(b)/12(1)(d) Ground of Opposition

[12] The Opponent has pleaded that the Mark is not registrable because it is confusing with the trade-mark SKY LIFT registered under No. TMA363,368 for "construction equipment, namely lifting devices for concrete forming equipment and material." The Opponent has met its initial burden with respect to this ground as registration No. TMA363,368 is extant. I will therefore now assess the evidence with a view to determining if the Applicant has met the legal burden on it to demonstrate that, based on a balance of probabilities, confusion between SKYHAND and SKY LIFT is not likely.

[13] The material date for assessing the likelihood of confusion under this ground is the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

[14] 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.

[15] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 C.P.R. (4th) 321 (S.C.C.)]

*(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[16] Both marks have similar degrees of inherent distinctiveness. Both marks have become known to some extent through use and promotion, as summarized below.

[17] Mr. Karras lists seven construction projects in Vancouver where he knows SKY LIFT devices were employed. Mr. Andrejevic provides details of two other construction sites where SKY LIFT devices were used, states that the SKY LIFT trade-mark is advertised at trade-shows, in print and on electronic media, and provides representative samples of advertising.

[18] Mr. Westra provides a list of three retailers (with a total of seven locations in Ontario) where the SKYHAND product can be bought. He states, “The SKYHAND tool holder is advertised and promoted in various ways including via our company website and in exhibition booths at tradeshow such as the Construct Canada Tradeshow held in Toronto in November 2006.”

[19] Overall, the evidence before me does not enable me to accurately determine the extent to which either mark has become known.

*(b) the length of time each has been in use*

[20] Mr. Andrejevic attests that the Opponent has used SKY LIFT on its registered wares since at least November 26, 2003. He also attests that use in association with the services of leasing construction equipment has been ongoing since at least April 26, 2003 (the registration for SKY LIFT covers the services of “leasing of construction equipment”, in addition to the pleaded wares).

[21] The Applicant’s application claims a date of first use of April 7, 2004. In his June 14, 2007 affidavit, Mr. Westra simply states that the Applicant has been selling the SKYHAND tool carrier for several years.

*(c) and (d) the nature of the wares, services, business and trade*

[22] Both marks are associated with wares used in the construction industry.

[23] Mr. Westra explains that the SKYHAND tool holder, which acts as a hardware/tool caddy, can be hung from scaffolding. It is used by various tradespeople in the construction industry. It normally sells for \$149 and can be purchased on-line directly from the Applicant’s website or at various retailers in Ontario.

[24] The Opponent is involved in the manufacture and supply of products used in the high rise construction industry. Mr. Andrejevic explains that the SKY LIFT lifting devices are rented or

leased by contractors during the construction of high rise buildings that require the use of a device for re-positioning fly form tables from one level to the other. Mr. Andrejevic does not provide the cost of the SKY LIFT wares but Mr. Westra estimates that “the SKY LIFT would cost at least a few thousand dollars.” Clearly the SKY LIFT ware is physically much larger than the SKYHAND ware.

*e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[25] Although marks are to be considered in their entirety, the first component of a mark is often considered more important for the purpose of distinction [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)]. Thus there is a fair degree of resemblance between SKY LIFT and SKYHAND in appearance and sound.

[26] Regarding the ideas suggested, in the context of the associated wares, SKY LIFT suggests that the ware will help the user lift something up in the air, while SKYHAND suggests that the ware will help (or give a hand to) the user when operating high above ground.

*other surrounding circumstances*

*i) state of the register*

[27] Ms. Croll has conducted various searches of the Canadian Trade-marks Office’s database directed to marks that include the word SKY.

[28] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located. [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]

[29] Although Ms. Croll has evidenced the existence of many SKY marks on the register for wares in the international classes that cover the SKY LIFT wares, her evidence is ultimately not meaningful because she has not provided details of the actual wares covered by those applications/registrations. International classes cover a wide range of wares; for example, as evidenced by Ms. Croll, international class 7 covers both “machine tools” and “incubators for eggs”. Without knowing the specific wares associated with the other SKY marks, one cannot tell whether they are actually in the same field as that of the parties at hand. Therefore Ms. Croll’s evidence only shows that other traders have adopted SKY marks, not that others have adopted SKY marks in association with wares that are used in the construction industry or closely related to either party’s wares.

*ii) state of the marketplace*

[30] Mr. Westra attests that another Canadian company, Skyjack Inc., sells construction lift equipment that Mr. Westra considers to be very similar in nature to the SKY LIFT wares. Skyjack Inc. uses SKYJACK in association with such wares. However no evidence has been provided of the extent to which SKYJACK has been used or promoted.

*iii) lack of evidence of confusion*

[31] Mr. Westra states that the Applicant “has been selling the SKYHAND tool carrier without incident for several years in Canada.” I assume that by this he means that there have been no instances of confusion with SKY LIFT.

[32] An adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by the opponent [*Christian Dior S.A. v. Dion Neckwear Ltd.* 2002, 20 C.P.R. (4th) 155 (F.C.A.)]. However, it is not appropriate to draw such an adverse inference in the present case because there is no evidence of “extensive” concurrent use (there is not even evidence that the parties’ wares are sold in the same province).

*conclusion re s. 12(1)(d)*

[33] Having considered all of the surrounding circumstances, I am not satisfied that confusion between the marks is not likely. The marks share the prefix SKY and are used in the same industry. Although there are significant differences between the wares associated with each mark, the Applicant's ware could be seen as an accessory to the Opponent's wares. Overall, I am not satisfied that the ordinary consumer would not think that the SKY LIFT and SKYHAND wares share a single source. The evidence of third party use of SKY in the parties' industry is insufficient to make confusion unlikely.

[34] The Applicant has not met its legal burden and the s. 12(1)(d) ground of opposition accordingly succeeds.

#### Section 38(2)(c)/16(1)(a) Ground of Opposition

[35] The Opponent has pleaded that the Applicant is not the person entitled to register the Mark because at the date of filing of the Applicant's application, the Mark was confusing with SKY LIFT, which was "previously used and/or made known in Canada by the Opponent well prior to the adoption of the Applicant's SKYHAND trade-mark."

[36] The Opponent has not properly pleaded a s. 16(1)(a) ground of opposition in that the material date regarding the likelihood of confusion under s. 16(1)(a) is the date of first use of the Applicant's Mark, not the date of filing of the Applicant's application. In the event that the improper pleading is not fatal to the ground, I further note that, for the reasons set out below, the Opponent's evidence does not show use of SKY LIFT prior to April 7, 2004.

[37] Mr. Andrejevic attests that SKY LIFT has been used continuously since prior to April 7, 2004, but use has not been shown as of any date other than the date of Mr. Andrejevic's affidavit (May 16, 2007). Mr. Andrejevic has provided the following exhibits that arguably show use of SKY LIFT: Exhibit C is a photograph of equipment bearing an indication that SKY LIFT appears on the name plate (the name plate is too small to read); Exhibit D is a page from the Opponent's website promoting the SKY LIFT device, dated 2007; Exhibit E is an undated promotional

brochure for the SKY LIFT device; Exhibit F is an undated operational manual for the SKY LIFT device. Mr. Andrejevic does not state that any of these exhibits are representative of materials in use prior to April 7, 2004 and he does not provide any sales figures or invoices that predate April 7, 2004. In other words, we only have a bald statement of use prior to April 7, 2004.

[38] In these circumstances, I am dismissing the s. 16(1)(a) ground on the alternative bases that it has either not been properly pleaded or the Opponent has not met its initial burden.

#### Section 38(2)(c)/16(1)(b) Ground of Opposition

[39] The Opponent has pleaded that the Applicant is not the person entitled to register the Mark because at the date of filing of the Applicant's application, the Mark was confusing with SKY LIFT, which was the subject of the previously filed application No. 1,211,331. Once again, the Opponent has not pleaded the appropriate material date for assessing the likelihood of confusion.

[40] Also, in order to meet its initial burden under s. 16(1)(b), the Opponent must evidence that its previously filed application was pending as of the date of advertisement of the opposed application, namely April 12, 2006. [s. 16(4)] The Opponent's application issued to registration under No. TMA636,368 before April 12, 2006, namely on March 30, 2005.

[41] Accordingly, the s. 16(1)(b) ground is dismissed on the alternative bases that it has either not been properly pleaded or the Opponent has not met its initial burden [*Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.) at 528].

#### Section 38(2)(d) Ground of Opposition

[42] The Opponent has pleaded that the Applicant's Mark is not distinctive of the wares of the Applicant since it does not actually distinguish nor is it adapted to distinguish the wares of the Applicant from the wares and services of the Opponent.



[43] In order to meet its initial burden under this ground, the Opponent must show that as of the filing of the statement of opposition, May 30, 2006, the Opponent's mark had become known sufficiently to negate the distinctiveness of the Mark [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.*, *supra*; *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)].

[44] As I have not been provided with any specific evidence of sales or promotions associated with the Opponent's mark prior to May 30, 2006, I cannot conclude that the Opponent's mark had become sufficiently known to negate the distinctiveness of the Mark as of that date. This ground is accordingly dismissed on the basis that the Opponent has not met its initial burden.

#### Disposition

[45] Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application, pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 9th DAY OF NOVEMBER 2009.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board