



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

Citation: 2016 TMOB 84
Date of Decision: 2016-05-31

IN THE MATTER OF AN OPPOSITION

Razor USA LLC	Opponent
and	
LG Electronics Inc.	Applicant
1,515,763 for the trade-mark Razor Slim	Application

File Record

[1] On February 17, 2011, LG Electronics Inc. filed an application to register the trade-mark Razor Slim (the Mark). The application is based on proposed use in Canada, in association with a long list of electronic goods, including television receivers, computers, digital picture frames, computer software for mobile phones, laser printers, mobile phones, digital cameras, and DNA chips. The complete list of goods is set out in Schedule A.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated February 13, 2013 and was opposed by Razor USA LLC on March 26, 2013. The Applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The Opponent filed the affidavit of Mr. Cochrane along with certified copies of one registration and three applications. The Applicant's evidence consists of the affidavits of Ms. Owens and Mr. Duchesneau (who swore two affidavits). Both parties filed written submissions. Only the Applicant was represented at a hearing held on January 12, 2016.

[4] The grounds of opposition are summarized below:

- (a) The application does not comply with sections 30(e) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). Specifically, the Applicant could not state that it was satisfied it was entitled to use the Mark in Canada in view of the Opponent's RAZOR and RAZR trade-marks registered or filed under Nos. TMA545,590; 1,161,976; 1,281,912; and 1,283,235.
- (b) The application is not registrable in view of section 12(1)(d) of the Act as the Mark is confusing with the Opponent's registration No. TMA545,590 for the trade-mark RAZOR.
- (c) The Applicant is not the person entitled to the registration of the trade-mark pursuant to section 16(3)(a) of the Act since the Mark is confusing with the trade-marks RAZOR and RAZR previously used in Canada by the Opponent in association with computer accessories, power adaptors, cellular telephones and related accessories.
- (d) The Applicant is not the person entitled to registration of the trade-mark pursuant to section 16(3)(b) since it is confusing with the Opponent's trade-marks which are the subject of application Nos. 1,161,976; 1,282,912 and 1,283,235.
- (e) The Mark is not distinctive within the meaning of section 2 in that it is not adapted to distinguish the Goods from the goods and services of others, in particular the Opponent under its RAZOR, RAZOR design and RAZR trade-marks.

[5] Before addressing each ground of opposition, I will first review the evidence of record, the evidential burden on the Opponent and the legal onus on the Applicant.

Opponent's Evidence

Affidavit of Mr. Cochrane

[6] Mr. Cochrane is general counsel for the Opponent. His evidence is that the Opponent's products include scooters, vehicles, and toys such as bikes, dirt quads, choppers and go-carts (para 3). In addition to these products, the Opponent offers video games (para 6). In Canada, the Opponent's scooters, electric scooters and electric powered ride-on toys can be purchased through national retailers such as Canadian Tire, Walmart, Costco, Toy R Us and Sears (para 8). Attached to Mr. Cochrane's affidavit are the Opponent's catalogues for the years 2006-2011 which include pictures of its scooters, electric scooters and ride-on toys all of which feature the RAZOR trade-mark (Exhibits JC-11-JC-16). Sales of RAZOR scooters, electric scooters and ride-on toys, to Canadian Tire exceeded \$2.4 Million between 2007-November 18, 2009 (para 12).

[7] Mr. Cochrane explains that a license agreement between the Opponent and Motorola, Inc. (predecessor to Motorola Mobility, Inc.) dates back to 2004 allowing Motorola to sell flip cellular phones under the RAZR trade-mark (para 15). Subsequent to the expiry of this agreement, a second license agreement was put into place in June 2011 (para 16). Mr. Cochrane states that at all times the Opponent controlled the character and quality of the goods sold by Motorola under license (para 18). Mr. Cochrane further explains that Motorola has confirmed that there were over \$ 8 million in advertising expenditures for RAZR phones in Canada for each of the years 2011-2013 and \$31 million in sales during this period (paras 19-20). However, Mr. Cochrane's evidence regarding the RAZR brand products suffers a serious deficiency in that it does not include evidence of how the RAZR trade-mark appears on or in association with the goods, nor advertising or promotional materials.

[8] In addition to the license agreement with Motorola, Mr. Cochrane provides evidence regarding a Licence Agreement with Callaway Golf Company with respect to

the use of the RAZR and RAZOR trade-mark in association with golf equipment (para 22) and Scarab Entertainment for *Razor Trickshare* an iOS and Android application (para 23).

Certified Copies

[9] A certified copy of each of registration No. TMA545,590 and application Nos. 1,161,976; 1,283,235 and 1,281,912 was filed.

The Applicant's Evidence

Affidavit of Ms. Owens

[10] Ms. Owens is a trade-mark searcher with the trade-mark agent representing the Applicant who attaches copies of various registrations and applications including the RAZOR component.

Affidavit of Mr. Duchesneau

[11] Mr. Duchesneau is a clerk with the trade-mark agent representing the Applicant. He printed out various third-party webpages including brands with RAZOR and archived versions of some of these pages. This evidence does not demonstrate that the word RAZOR has been commonly adopted since, while some of the products appear to have been offered in Canadians, there is no evidence of sales in Canada of any of the RAZOR brand products or services [*Generation Nouveau Monde Inc v Teddy SPA*, 2006 CanLii 80484 (TMOB)]. Also of note in Mr. Duchesneau's evidence is a print-out showing a LG Razor Slim plasma television (Exhibit 17).

Affidavit Mr. Duchesneau (No. 2)

[12] Mr. Duschesneau filed a second affidavit attaching two cross-examination transcripts wherein Mr. Cochrane was cross-examined on affidavits filed in another trade-mark opposition involving the Applicant and the Opponent. The Opponent objects to this evidence on the basis that as the Applicant did not request cross-examination in this

proceeding, it cannot now use the transcripts to challenge Mr. Cochrane's evidence. I do not find the *Imperial Oil Ltd. v Lubrizol Corp* (1998), 82 CPR (3d) 440 (FCTD) case cited by the Opponent to stand for the proposition that a cross-examination transcript from a related proceeding cannot be filed to challenge evidence given in another proceeding. As such, I decline to find the transcripts of examination to be inadmissible. That being said, given the deficiencies noted in Mr. Cochrane's evidence in paragraph 7 of this decision, it was unnecessary for me to consider the submissions of the Applicant relying on the cross-examination transcript.

Burdens and Material Dates

[13] Before considering the grounds of opposition, it is necessary to review (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[14] With respect to (i) above, there is in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged by the opponent in the statement of opposition (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

Grounds of Opposition Based on Confusion – Section 12, 16, 2 Grounds of Opposition

When Are Trade-marks Confusing?

[15] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act as, set out below:

The 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 goods or services . . . associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the goods or services . . . are of the same general class.

[16] Thus, section 6(2) 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 purchasers of the Applicant's Goods sold under the Mark would believe that those goods were provided or produced or authorized or licensed by the Opponent.

Test for Confusion

[17] In assessing confusion pursuant to section 6(2) of the Act, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 (CanLII), [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

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.

[18] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Section 16(3)(b) Ground of Opposition

[19] This ground of opposition alleges that, pursuant to section 16(3)(b) of the Act, the Applicant is not entitled to register the applied-for mark because, as of February 17, 2011, the applied-for mark was confusing with the Opponent's previously filed trade-mark application Nos. 1,161,976 for RAZOR Design (set out below) and 1,281,912, and 1283,235 for RAZR.

Razor

The goods and services covered by each of these applications are reproduced in their entirety at Schedule B. The Opponent has met its evidential burden with respect to these applications as each was filed before February 17, 2011 and was pending as of the date of advertisement (see section 16(5) of the Act.)

Consideration of the Section 6(5) Factors

Inherent and Acquired Distinctiveness; Length of Time in Use (sections 6(5)(a) and 6(5)(b))

[20] The dictionary definition of razor is “an instrument with a sharp blade or blades used in cutting hair” [Canadian Oxford Dictionary (2nd ed); see *Tradall S.A. v Devil's Martini Inc.* (2011), 92 CPR (4th) 408 (TMOB) at para 29 confirming that I can take judicial notice of dictionary definitions].

[21] The parties' trade-marks each have a similar degree of inherent distinctiveness since there appears to be no nexus between the marks and the parties' goods other than an allusion to the fact that the goods may be thin or of sharp design. Such an allusion is consistent with Exhibit 17 to Mr. Duchesneau's affidavit showing an Internet print-out of a LG Razor Slim plasma television. That being said the Opponent's trade-marks are slightly more distinctive due to (i) the unique spelling with respect to its RAZR trade-mark and (ii) the design elements in the RAZOR Design trade-mark.

[22] There is no evidence of use of the Mark. With respect to the Opponent's RAZR trade-mark, due to the deficiencies in the evidence with respect to showing use or advertising of the RAZR trade-mark, there is no evidence from which I can infer that this trade-mark has acquired distinctiveness. With respect to the Opponent's RAZOR Design trade-mark, the evidence is that this trade-mark has acquired a reputation in Canada with respect to scooters and other toys since the sales of the Opponent's RAZOR scooters, bikes and ride-on toys at Canadian Tire exceeded \$2.4 Million between 2007-November 18, 2009.

Nature of the Parties' Goods, Trades and Business (sections 6(5)(c) and 6(5)(d))

[23] This factor favours the Opponent with respect to the telephone, mobile device, consumer electronic and related goods; however, it favours the Applicant with respect to its specialized goods including those related to toll roads, surveillance and scientific research.

[24] At the outset, I find that there is not a significant degree of overlap between the products in the Opponent's RAZOR Design application which appear targeted at children for the purposes of amusement and entertainment in the scooter / ride-on toy field or computer games with a focus on scooters and any of the goods in the application which appear to be in the nature of general electronics.

[25] With respect to the RAZR applications, the Goods described below are identical or very close in nature to the goods in the Opponent's RAZR applications (the Identical and Similar Goods). Given the identical nature, I would expect that the parties' channels of trade would also be the same.

Telephone sets; wireless telephone sets; portable communications apparatus namely walkie-talkies, satellite telephones and personal digital assistants (PDA); mobile phones; MPEG audio layer-3 (MP3) players; headsets for mobile phones; portable chargers for mobile phone batteries and digital camera batteries; apparatus for recording, transmission or reproduction of sound or images for use in telecommunications, namely CD players, compact disc players, DVD players, MP3 players, apparatus for recording, transmission or reproduction of sound or images, namely cassette players, audio receivers, video receivers, microphones, amplifiers, speakers, digital cameras, video disc players; stereos; computer software for mobile

phones, namely, software for mobile phone operating systems, sending and receiving information, to provide web-based access to applications, products and services; audio-video (AV) receivers for home theaters; audio receivers; solar batteries for watches, mobile phones and cameras; personal computer (PC) cameras

[26] The Opponent's RAZR applications also cover a wide range of electronic products including in application No. 1,281,912 radio receivers, calculators, modems, global positioning devices, and computer software and programs featuring music, movies, animation, electronic books and in application No. 1,283,235 digital cameras, motion picture cameras, and power adapters. In the absence of evidence showing otherwise, I find that the following Goods (the Overlapping Goods) are consumer electronic goods closely related to those of the Opponent which may be likely to travel through the same channel of trade.

television receivers; television remote controllers; encoded electronic chip cards for improvement of television image quality; universal serial bus (USB) drives; electronic photo albums; digital picture frames for displaying digital pictures, video clips and music; monitors for computer; lap top computers; computers; digital versatile disc (DVD) players; portable hard disk drives; computer software for televisions, namely, software for setting-up and calibrating televisions; computer software for personal computer monitors, namely software for setting-up and calibrating personal computer monitors; digital versatile disc (DVD) players for home theaters; speakers for home theaters; electronic advertising display using sound and image with function of transmitting and receiving data; thermal printers; digital colour printers; laser printers; ink jet printers; colour printers; printers for use with computers;; digital voice recorders; videocassette recorders; electronic notepads; tablet computers; interactive electronic white boards; settop boxes; monitors for video conference; cameras for video conference; speakers for video conference; three dimensional eyeglasses for television receivers; projectors for home theaters; integrated circuits;

[27] With respect to the goods in the application set out below (the "Non-overlapping Goods"), I do not find that there is any significant overlap in the nature of these goods with any of the Opponent's applications as these appear to be specialized in nature with very particular purposes, for example, surveillance and administration of road tolls, scientific research. As I do not find the nature of the Non-Overlapping Goods the same, I infer that the channels of trade are likely different.

on board units on vehicle and electronic toll smart cards for easy pass in highway; vehicle mounted transponders for use with stationary readers for electronic monitoring of highway lane activity, electronic toll collection and electronic toll enforcement operations; closed-circuit television (CCTV) cameras; network monitoring cameras namely for surveillance; DNA chips; incubators for bacteria culture; test tubes; pipettes; software for dosimetry purposes in the field of radiotherapy.

Degree of Resemblance between the Parties' Marks

[28] In considering the degree of resemblance, the Supreme Court of Canada in *Masterpiece*, above, provided guidance that resemblance is the quality of being either like or similar (para. 62) and that assessing resemblance should involve a consideration of whether there is an aspect of a trade-mark that is particularly striking or unique (para. 64).

[29] I find that there is a significant degree of resemblance between the Mark and each of the Opponent's trade-marks in appearance, sound and ideas suggested as the Mark substantially incorporates the entirety of each of the trade-marks in the Opponent's applications. In so finding, I have taken into account the fact that the Mark does not share the design features in application No. 1,161,976; and the Opponent's misspelling of RAZR in application Nos. 1,281,912 and 1,283,235. Finally, the word SLIM does not diminish the resemblance between the parties' trade-marks as it appears to be suggestive of the goods (specifically, that they may be of sharp or thin design) [*Reno-Dépôt Inc v Homer TLC Inc* (2009), 84 CPR (4th) 58 (TMOB) at para 58]. Also as mentioned earlier, the degree of resemblance between the parties' marks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion. This is particularly the case where the parties' goods, or services, and the parties' channels of trade, are the same or overlapping: see *Reynolds Consumer Products Inc. v. P.R.S. Mediterranean Ltd.* (2013), 111 CPR (4th) 155 (FCA) at paras. 26 -30. Accordingly, the last factor favours the Opponent, particularly in respect of the Identical and Similar Goods and the Overlapping Goods.

State of the Register and Third Party Use of RAZOR

[30] I do not consider the Internet evidence filed by Mr. Duchesneau to assist the Applicant as there is no evidence of sales in Canada of any of the third party RAZOR goods. With respect to the state of the register evidence, the Opponent argues that the Applicant's evidence is insufficient to allow for inferences to be made about the state of the marketplace and points to various decisions of the Registrar including: *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD) at 209. I agree with the Opponent's submissions in this regard and note that two of the nine trade-marks attached to Ms. Owen's affidavit are for pending applications and four appear to be for computer software with very specific uses (none of which appear to be related to either of the parties' interests).

Applicant's Interests Limited to Scooters

[31] The Applicant argues that the nature of the parties' goods are so different that there can be no possibility of confusion. At paragraph 4 of its written argument, the Applicant submits:

While there are important differences between the respective parties' trademarks themselves, even more significant in the present case are the differences between the respective parties' goods. The Opponent sells scooters and ride-on toys marketed to children, while the Applicant sells major home electronics marketed to adults. The nature of these goods, their purposes, and their channels of trade are so noticeably different that there can be no possibility of confusion.

[32] I agree with the Applicant's submissions when considering the Opponent's application No. 1,161,976 for RAZOR Design. However, when considering application Nos. 1,281,912 and 1,283,235, the distinction between the parties' goods wavers. The applications relied on by the Opponent cover a much broader list of goods than what it has currently sold to date. Thus, the question is whether consumers would assume that a party who sells such a broad line of electronics and related computer software under the RAZR trade-mark is likely to also be the source of a broad line of electronics and computer software sold under the Mark.

Finding as to Confusion

[33] While I have addressed the section 6(5) factors with respect to the Mark and the Opponent's relied upon applications as a group, in conducting the confusion analysis I have compared the Mark to each of the Opponent's trade-marks.

[34] With respect to application No. 1,281,912 for RAZR, for the reasons above, and in particular, due to the degree of resemblance in appearance, sound and idea suggested and the significant overlap in the nature of the goods/services and trade for the Identical and Similar Goods and the Overlapping Goods, I conclude that the Applicant has not discharged its burden of establishing, on a balance of probabilities, that the Mark is not confusing with the Opponent's trade-mark. However, due to the differences between the parties' goods, the Applicant has discharged its burden with respect to the Non-Overlapping Goods. With respect to application No. 1,283,235, for RAZR, my conclusion is the same. The 16(3)(b) ground of opposition is therefore successful with respect to the Identical and Similar Goods and Overlapping Goods.

[35] With respect to the Opponent's application for RAZOR Design (application No. 1,161,976), I do not find that there is confusion between the Applicant's Mark and the Opponent's trade-mark due to the difference in the nature of the goods.

Section 12(1)(d) Ground of Opposition

[36] I will now assess the likelihood of confusion between the Mark and the Opponent's trade-mark RAZOR, as registered under No. TMA545,590 for use in association with the following goods.

Computer accessories, namely computer game controllers, computer game and video game accessories, namely video game joysticks and computer game joysticks, blank and pre-recorded computer game memory cards; data switches; power adapters; audio and video connectors and audio adapters.

[37] As this registration is extant, the Opponent has met its burden with respect to this ground of opposition.

Inherent and Acquired Distinctiveness; Length of Time in Use (sections 6(5)(a) and 6(5)(b))

[38] This factor favours neither party. The Mark and the trade-mark RAZOR have a similar degree of inherent distinctiveness for the reasons set out in paras 20-21 of this decision. Neither the Applicant, nor the Opponent has submitted any evidence that would allow me to infer acquired distinctiveness of the Mark or the RAZOR trade-mark in association with the registered goods.

Nature of the Parties' Goods, Trades and Business (sections 6(5)(c) and 6(5)(d))

[39] The nature of the parties' goods appears to differ slightly (computer and video game related goods vs general consumer electronics). The target audience of the parties also seems to differ with the evidence of the Opponent referencing computer and video games targeted at scooter enthusiasts (Exhibits JC-7-JC-8; JC-23). In contrast, there is nothing to suggest that the Goods target a similar audience. While it is true that some of the Goods could be used for gaming purposes (such as laptop computers or televisions), the computer and mobile device field is very broad and this does not in itself indicate overlap.

Resemblance (Section 6(5)(e))

[40] There is a high degree of resemblance between the parties' marks as the most striking feature of the Mark is the word RAZOR, with word SLIM emphasizing that the Goods may have a thin design. The degree of resemblance between the trade-marks therefore favours the Opponent.

State of the Register and Internet Evidence

[41] I do not find the state of the Register and Internet evidence filed by Ms. Owens and Mr. Duchesneau to assist the Applicant for the reasons set out in paragraph 30.

Conclusion

[42] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In weighing all of the factors enumerated at section 6(5) of the Act, I am satisfied that the Applicant has discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark in association with a wide range of consumer electronics and the Opponent's registration No. TMA545,590 covering computer and video game related goods. In contrast with the section 16(3)(b) ground of opposition, the Opponent's registration at issue in this ground does not cover a broad range of consumer electronics, nor is there evidence that the Opponent offers a broad range of electronics, and there is evidence which suggests that the actual trade of the Opponent in the computer and video game field is targeted at scooter enthusiasts. As such, this ground of opposition is rejected.

Section 2 Grounds of Opposition

[43] Regarding the ground of opposition based on lack of distinctiveness, pursuant to section 2 of the Act, the Opponent needs to show that as of the date of filing the statement of opposition its trade-marks RAZOR and RAZR had become known sufficiently to negate the distinctiveness of the Mark. To do so, the Opponent must establish that its trade-marks are known to some extent at least and its reputation in Canada was substantial, significant or sufficient or well known in a specific area of Canada [*Bojangles International, LLC v Bojangles Café Ltd* (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC)].

[44] With respect to the Opponent's trade-mark RAZR in the absence of evidence showing how the trade-mark is used, even if I accept the impressive sales and advertising expenditures, I am unable to determine whether or not the trade-mark has acquired any reputation in Canada.

[45] With respect to the Opponent's trade-mark RAZOR, its evidence is sufficient to meet its burden with respect to scooters by virtue of the evidence of distribution of RAZOR branded scooters at various Canadian retailers and sales at Canadian Tire.

However, I find that the Mark is adapted to distinguish and actually distinguishes the Goods from these goods of the Opponent due to the differences between the nature of the goods. In this regard, the Opponent's goods are directed at a very specific audience, those consumers wishing to use a scooter or other ride on device in contrast with the Goods which appear to have a more general application.

[46] Accordingly, this ground of opposition is rejected.

Section 16(3)(a) Ground of Opposition

[47] The Opponent has also pleaded that the Mark is confusing with its use of its trade-marks RAZOR and RAZR previously used in Canada by the Opponent in association with computer accessories, power adaptors, cellular telephones and related accessories.

[48] In order to meet its initial burden under section 16, the Opponent must evidence that it was using one of its RAZOR or RAZR trade-marks in Canada prior to February 17, 2011 and had not abandoned its marks as of February 13, 2013, the date of advertisement of the subject application (section 16(5) of the Act).

[49] This ground of opposition is rejected since the Opponent's evidence is insufficient to meet its evidential burden of proving that it had used its RAZOR or RAZR trade-marks in association with any of computer accessories, power adaptors, cellular telephones and related accessories.

No Evidence of RAZR with Computer Accessories, Cellular Telephones and Related Accessories

[50] While Mr. Cochrane attests that the Opponent entered into a licensing agreement with Motorola Mobility, Inc. whereby Motorola obtained the right to use the trade-mark RAZR in association with wireless telephones and entered into a second agreement in June 2011 whereby it was granted the right to use the trade-mark RAZR in association with mobile communications products and computers (paras 15-16; Exhibits JC-18, JC-20), Mr. Cochrane does not provide evidence showing use of the RAZR trade-mark. In this regard, the representative photographs of RAZR flip phones (Exhibits JC-19, JC-21)

does not show use of the RAZR trade-mark (rather the trade-marks MOTOROLA, VERIZON or M Designs appear on the phones). In the absence of evidence of use of the trade-mark RAZR, the information regarding revenues and promotional expenditures at paras 19-20 do not meet the Opponent's initial burden with respect to the RAZR trade-mark. Given my findings, it is unnecessary for me to address the Applicant's arguments regarding the deficiencies in the evidence with respect to the license between the Opponent and Motorola.

No Evidence of RAZOR with Computer Accessories, Cellular Telephones and Related Accessories

[51] While Mr. Cochrane's evidence is that the Opponent sold RAZOR brand scooters and other toys in Canada to distributors such as Canadian Tire, Walmart, Costco, Toy R Us and Sears (para 8), a review of the invoices and catalogues attached to Mr. Cochrane's affidavit (Exhibits JC-11-JC-16; JC-17) does not provide any evidence of sales of computer accessories, power adaptors, cellular telephones or related accessories within the meaning of section 4 of the Act.

Sections 30(e) and 30(i) Ground of Opposition

[52] This ground of opposition has two parts.

[53] The first part alleges that the Applicant could not state it was entitled to use the Mark in view of the registered or filed trade-marks of the Opponent and as such the application does not comply with section 30(i). Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155] or other exceptional circumstances. As this application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the part of this ground of opposition relying on section 30(i) of the Act is rejected.

[54] The second part alleges that the Applicant wrongly states that it had intended to use the Mark in association with the Goods and as such the application does not comply

with section 30(e) of the Act. There is no evidence that supports this allegation consequently; the part of this ground of opposition relying on section 30(e) of the Act is rejected.

Disposition

[55] The opposition is partially successful pursuant to the section 12(1)(d) ground of opposition. Accordingly, the application is refused in respect of the goods set out below and otherwise, the opposition is rejected. Authority for a divided decision is found in *Produits Ménagers Coronet Inc. v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD).

(1) Telephone sets; wireless telephone sets; portable communications apparatus namely walkie-talkies, satellite telephones and personal digital assistants (PDA); mobile phones; MPEG audio layer-3 (MP3) players; television receivers; television remote controllers; encoded electronic chip cards for improvement of television image quality; universal serial bus (USB) drives; headsets for mobile phones; portable chargers for mobile phone batteries and digital camera batteries; electronic photo albums; digital picture frames for displaying digital pictures, video clips and music; monitors for computer; lap top computers; computers; digital versatile disc (DVD) players; portable hard disk drives; apparatus for recording, transmission or reproduction of sound or images for use in telecommunications, namely CD players, compact disc players, DVD players, MP3 players, apparatus for recording, transmission or reproduction of sound or images, namely cassette players, audio receivers, video receivers, microphones, amplifiers, speakers, digital cameras, video disc players; stereos; computer software for mobile phones, namely, software for mobile phone operating systems, sending and receiving information, to provide web-based access to applications, products and services; computer software for televisions, namely, software for setting-up and calibrating televisions; computer software for personal computer monitors, namely software for setting-up and calibrating personal computer monitors; digital versatile disc (DVD) players for home theaters; speakers for home theaters; audio-video (AV) receivers for home theaters; projectors for home theaters; integrated circuits; audio receivers; electronic advertising display using sound and image with function of transmitting and receiving data; thermal printers; digital colour printers; laser printers; ink jet printers; colour printers; printers for use with computers; solar batteries for watches, mobile phones and cameras; personal computer (PC) cameras; digital voice recorders; videocassette recorders; electronic notepads; tablet computers; interactive electronic white boards; settop boxes; monitors for video conference; cameras for video conference; speakers for video conference; three dimensional eyeglasses for television receivers;

[56] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under section 63(3) of the *Trade-marks Act*.

Natalie de Paulsen,
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: January 11, 2016

APPEARANCES

Giovanna Spartaro

FOR THE OPPONENT

No one appearing

FOR THE APPLICANT

AGENTS OF RECORD

Gowling WLG (Canada) LLP

FOR THE OPPONENT

Smart & Biggar

FOR THE APPLICANT

Schedule A

Goods and Services

(1) Telephone sets; wireless telephone sets; portable communications apparatus namely walkie-talkies, satellite telephones and personal digital assistants (PDA); mobile phones; MPEG audio layer-3 (MP3) players; television receivers; television remote controllers; encoded electronic chip cards for improvement of television image quality; universal serial bus (USB) drives; headsets for mobile phones; portable chargers for mobile phone batteries and digital camera batteries; electronic photo albums; digital picture frames for displaying digital pictures, video clips and music; monitors for computer; lap top computers; computers; digital versatile disc (DVD) players; portable hard disk drives; apparatus for recording, transmission or reproduction of sound or images for use in telecommunications, namely CD players, compact disc players, DVD players, MP3 players, apparatus for recording, transmission or reproduction of sound or images, namely cassette players, audio receivers, video receivers, microphones, amplifiers, speakers, digital cameras, video disc players; stereos; computer software for mobile phones, namely, software for mobile phone operating systems, sending and receiving information, to provide web-based access to applications, products and services; computer software for televisions, namely, software for setting-up and calibrating televisions; computer software for personal computer monitors, namely software for setting-up and calibrating personal computer monitors; digital versatile disc (DVD) players for home theaters; speakers for home theaters; audio-video (AV) receivers for home theaters; projectors for home theaters; integrated circuits; audio receivers; on board units on vehicle and electronic toll smart cards for easy pass in highway; vehicle mounted transponders for use with stationary readers for electronic monitoring of highway lane activity, electronic toll collection and electronic toll enforcement operations; closed-circuit television (CCTV) cameras; network monitoring cameras namely for surveillance; electronic advertising display using sound and image with function of transmitting and receiving data; thermal printers; digital colour printers; laser printers; ink jet printers; colour printers; printers for use with computers; solar batteries for watches, mobile phones and cameras; personal computer (PC) cameras; digital voice recorders; videocassette recorders; network monitoring cameras namely for surveillance; electronic notepads; tablet computers; interactive electronic white boards; settop boxes; monitors for video conference; cameras for video conference; speakers for video conference; three dimensional eyeglasses for television receivers; DNA chips; incubators for bacteria culture; test tubes; pipettes; software for dosimetry purposes in the field of radiotherapy.

Schedule B

Application No. 1,161,976 for RAZOR Design

(1) Computer operating software for use with hand-held computers and personal digital assistants, namely, for playing games on hand-held computers and personal digital assistants; and downloaded instruction manuals sold therewith as a unit for all the

aforesaid goods.

(2) Printer materials and publications, namely stickers, decals, calendars, magazines, books, newsletters; bicycles, tricycles, motorized vehicles, namely motorized scooters and structural parts; video game software; interactive video game programs; video games; toys, namely, toy bicycle, model scooter, model bicycle, rideable toys, plush toys, stuffed toy animals, toy animals, toy animals and accessories therefor, stuffed toys; toy vehicles, toy scooters, non-motorized scooters, ride-on toys, pogo sticks, skate boards, sports bags, protective equipment and pads, namely, pads for protecting knee, wrist, elbow, arm.

Application No. 1,281,912, for RAZR

(1) Pagers, two-way radios, radio transmitters, radio receivers, radio transceivers, electronic organizers, and related accessories for the foregoing goods, namely, headsets, microphones, speakers, carrying cases, and belt clips; computer software and programs used for transmission or reproducing or receiving of sound, images, video or data over a telecommunications network or system between terminals; computer software and programs for enhancing and facilitating use and access to computer networks and telephone networks; computer software for use in general purpose database management; computer e-commerce software to allow user to safely place orders and make payments in the field of electronic business transactions via a global computer network or telecommunications network; computer software for training and product support for computers and mobile phones in the field of communications; computer game software for mobile handsets; computer software and programs featuring music, movies, animation, electronic books; computer software for the distribution of information and interactive multimedia content containing text, images, video and sound to users in the field of communications; computer software and programs for management and operation of wireless telecommunications devices; computer software for accessing, searching, indexing and retrieving information and data from global computer networks and global communication networks, and for browsing and navigating through web sites on said networks; computer software for sending and receiving short messages and electronic mail and for filtering non-text information from the data; analog and digital radio transceivers or receivers for data, voice, image and video communication; electronic game software for mobile handsets; cameras, namely photographic cameras, digital cameras, motion picture cameras, video cameras; systems and apparatus for electric money transactions, namely chip cards, integrated circuit cards; chip card readers, integrated circuit card readers; calculators; cards for communications purposes, namely, data cards, modem cards and fax modem cards for communication purposes, all for use with communications apparatus; modems, global positioning units, batteries and battery chargers for handheld electronic devices, power adapters, antennas, and sunglasses.

(2) Telephones and related accessories, namely, headsets, microphones, speakers, carrying cases and belt clips.

(1) Mobile telephone communications services; wireless communication services and calling plans; communication services, namely cellular telephone services, namely cellular telephone services; wireless facsimile mail services, wireless digital messaging services.

Application No. 1,283,235 for RAZOR

(1) Cellular telephone and related accessories, namely carrying case, belt clips, batteries and battery chargers for cellular phones.

(2) Pagers, two-way radios, radio transmitters, radio receivers, radio transceivers, electronic organizers, and related accessories for the foregoing goods, namely, headsets, microphones, speakers; computer software and programs used for transmission or reproducing or receiving of sound, images, video or data over a telecommunications network or system between terminals and for enhancing and facilitating use and access to computer networks and telephone networks; computer software for use in general purpose database management; computer e commerce software to allow user to safely place orders and make payments in the field of electronic business transactions via a global computer network or telecommunications network; computer software for training and product support for computers and mobile phones in the field of communications; computer game software for mobile handsets; computer software and programs featuring music, movies, animation, electronic books.

(3) Computer software for the distribution of information and interactive multimedia content containing text, images, video and sound to users in the field of communications; computer software and programs for management and operation of wireless telecommunications devices; computer software for accessing, searching, indexing and retrieving information and data from global computer networks and global communication networks, and for browsing and navigating through web sites on said networks; computer software for sending and receiving short messages and electronic mail and for filtering non-text information from the data; analog and digital radio transceivers or receivers for data, voice, image and video communication; electronic game software for mobile handsets; cameras, namely photographic cameras, digital cameras, motion picture cameras, video cameras; systems and apparatus for electric money transactions, namely chip cards, integrated circuit cards, chip card readers, integrated circuit card readers; calculators; cards for communications purposes, namely, data cards, modem cards and fax modem cards for communication purposes all for use with communications apparatus; modems, global positioning units, power adapters and antennas.