



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

Citation: 2016 TMOB 54
Date of Decision: 2016-03-31

IN THE MATTER OF AN OPPOSITION

General Electric Company and	Opponent
LG Electronics Inc.	Applicant
1,465,691 for Econovation	Application

[1] On January 13, 2010, LG Electronics Inc. (the Applicant) filed application No. 1,465,691 to register the trade-mark Econovation (the Mark).

[2] The application, as revised by the Applicant, is based upon proposed use of the Mark in Canada in association with *inter alia* a variety of household appliances and electronic goods and retail and wholesale services of same, as set out in Schedule “A” attached hereto. The application claims a December 7, 2009 priority filing date based upon Korean application No. 45-2009-0004531.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 8, 2012. General Electric Company (the Opponent) opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by filing a statement of opposition on October 1, 2012. The grounds of opposition are based upon sections 30(e), 30(i), 12(1)(d), 16(3)(a), 16(3)(b), 16(3)(c) and 2 of the Act.

[4] In support of its opposition, the Opponent filed the affidavit of Catherine Mennenga, Counsel – Advertising and Brand Management for the Opponent, sworn March 5, 2014 (the Mennenga affidavit), as well as certified copies of its registrations and pending application for trade-marks which consist of or contain the word ECOMAGINATION. The particulars of these registrations and pending application are set out in Schedule “B” attached hereto, and will sometimes be hereinafter collectively referred to as the ECOMAGINATION Trade-marks.

[5] As its evidence, the Applicant filed the affidavits of Aleksandar Vukovic, a trade-mark searcher employed by counsel for the Applicant, sworn December 1, 2014 (the Vukovic affidavit) and Michael S. Duchesneau, a law clerk employed by the same firm, sworn December 19, 2014 (the Duchesneau affidavit).

[6] Only the Opponent filed a written argument.

[7] No hearing was held.

[8] For the reasons that follow, the opposition is rejected.

The parties’ respective burden or 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Grounds of opposition that can be summarily dismissed

[10] At the outset, I wish to note that the Opponent’s written argument relates only to the sections 12(1)(d), 16(3)(a) and 2 grounds of opposition.

Non-compliance with section 30(e) of the Act

[11] The section 30(e) ground of opposition alleges that the statement in the Applicant’s

application that it intends to use the Mark in association with all of the goods and services described in the application is false in that the Applicant had no such intention at the time of filing its application.

[12] There is no evidence that puts into issue the correctness of the proposed use basis claimed in the Applicant's application.

[13] Accordingly, the section 30(e) ground fails on the basis that the Opponent has not met its initial evidential burden in respect thereof.

Non-compliance with section 30(i) of the Act

[14] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada at the time of filing its application because "it was aware at that time that the Opponent had previously applied to register, registered, and/or used in Canada one or more of the ECOMAGINATION Trade-marks, with which it knew the [Mark] has been confusing at all material times."

[15] Section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of the Opponent's trade-marks does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[16] The Applicant has provided the necessary statement and the Opponent has not demonstrated that this is an exceptional case.

[17] Accordingly, the section 30(i) ground fails on the basis that the Opponent has not met its initial evidential burden in respect thereof.

Non-entitlement under section 16(3)(c) of the Act

[18] The section 16(3)(c) ground of opposition alleges that the Applicant is not the person entitled to registration of the Mark in that, at the date on which the Applicant filed its application, the Mark was confusing with the Opponent's trade-name ECOMAGINATION, which had been previously used by the Opponent in Canada.

[19] An opponent meets its evidential burden with respect to a section 16(3)(c) ground if it shows that as of the date of filing of the applicant's application, its trade-name had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act]. While the Mennenga affidavit (discussed below) does establish use of one or more of the ECOMAGINATION Trade-marks, it fails to establish use of that word as a trade-name.

[20] Accordingly, the section 16(3)(c) ground fails on the basis that the Opponent has not met its initial evidential burden in respect thereof.

Remaining grounds of opposition

Non-registrability under section 12(1)(d) of the Act

[21] The section 12(1)(d) ground of opposition alleges that the Mark is not registrable because it is confusing with the Opponent's registered trade-marks ECOMAGINATION and HOMES INSPIRED BY ECOMAGINATION that are the subject of registration Nos. TMA765,676; TMA753,685; TMA754,766; TMA824,454; and TMA794,873 set out in Schedule "B".

[22] The material date to assess this ground of opposition is the date of my decision [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[23] I have exercised my discretion to check the register to confirm that the Opponent's registrations are extant.

[24] As the Opponent's evidential burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and any of the trade-marks which are the subject of these registrations.

[25] Unless indicated otherwise, I will focus my analysis on the Opponent's trade-mark ECOMAGINATION, which is the subject of registration Nos. TMA753,685; 754,766; TMA765,676; and TMA824,454.

The test for confusion

[26] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that 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, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[27] Thus, this section does not concern the confusion of the trade-marks themselves, but of the goods or services from one source as being from another.

[28] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time the trade-marks have been in use; (c) the nature of the goods, 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. This list is not exhaustive and all relevant factors are to be considered. Further, all factors need not be attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

Consideration of the section 6(5) factors

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

[29] Both parties' marks are inherently distinctive. However, neither of them is inherently strong in view of their somewhat laudatory or suggestive connotation, as discussed below under

the section 6(5)(e) factor.

[30] The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

[31] There is no evidence that the Mark has been used in Canada pursuant to section 4 of the Act or that it has become known to any extent in Canada.

[32] By contrast, the Opponent has filed evidence of use and reputation of its trade-mark by way of the Mennenga affidavit, in which Ms. Mennenga states that:

- directly or through one or more of its subsidiaries and licensees, the Opponent is engaged in the business of manufacturing, distributing, advertising and selling numerous lines of goods and services, primarily though not exclusively related to energy generation, collection, storage, distribution, use and application. Among other lines of business, the Opponent is one of the largest manufacturers of major appliances for home use in North America [para 2];
- directly or through corporate predecessors, the Opponent began manufacturing, marketing and selling home electrical appliances in Canada at least as early as the 1920s, and has done so continuously throughout Canada to the present time. The Opponent's home electrical appliance products include washing machines, clothes dryers, refrigerators, freezers, ranges, ovens, water heaters, dishwashers, disposers, compactors, air conditioners, etc. [para 3];
- in 2005, the Opponent launched an unprecedented and ground-breaking company-wide, global commitment to energy efficiency and emission reduction, both in its product and service offerings and in its own operations. The Opponent named its program with the coined term ECOMAGINATION. The ECOMAGINATION program is founded on a commitment to substantial and documented improvement in the energy consumption and environmental impact of the Opponent's products and operations [para 4];
- the Opponent has, since at least 2005, continuously used the ECOMAGINATION trade-mark in Canada in association with a range of products and services in a number of fields, including home appliances, energy generation, storage lighting, transportation, health care products, computer software, and others. The Opponent's products and

services qualify for inclusion in the ECOMAGINATION portfolio only after undergoing a rigorous ECOMAGINATION Product Review (EPR) process, with participation of an outside environmental consulting firm that demonstrates that they meet objective criteria for environmental performance and sustainability, and that associated marketing claims are clear, compelling and substantiated [para 5];

- in 2011, 34 products were added to the ECOMAGINATION portfolio, bringing the total number of the Opponent's products and services offered under the ECOMAGINATION mark to more than 140. Home electrical appliances are prominent among these, including clothes washing machines, dishwashers, refrigerators, air conditioners, water purifiers, and water heaters [para 6];
- the Opponent's portfolio of ECOMAGINATION products and services generated approximately \$25 billion in sales in 2012, the most recently completed year for which this information was available at the time of swearing of the affidavit. Since its inception in 2005, more than \$130 billion in ECOMAGINATION products and services have been sold worldwide [para 7];
- the Opponent authorizes numerous subsidiary and affiliated companies in Canada, including General Electric Canada, to use the ECOMAGINATION mark. The Opponent exercises direct or indirect control over the character or quality of all goods and services sold/performed under the ECOMAGINATION mark in Canada [paras 10 and 11];
- the Opponent has expended significant funds in advertising and marketing the ECOMAGINATION mark on and in connection with its goods and services, and to the general Canadian consuming public. Video commercials prominently featuring the mark have aired during the NFL Super Bowl® telecast, and have been broadcast on NBC, USA Network, MSNBC, ESPN, Comedy Central, and the Sci-Fi Channel, many of which channels are viewable by Canadians. Commercials in the ECOMAGINATION campaign have won more than 20 advertising industry awards, and one of the commercials in the campaign has been nominated for an Emmy® Award. Many of these advertisements are also available for viewing to Canadians on the ECOMAGINATION YouTube channel, which featured 82 such advertisements and other videos at the time of swearing of the affidavit. The videos on the ECOMAGINATION YouTube channel have been viewed over 240,000 times. Many third parties have also put ECOMAGINATION

advertisements on YouTube, and have cumulatively received hundreds of thousands of views [para 19]; and

- print advertisements featuring the ECOMAGINATION trade-mark have appeared in *The New York Times*, *The Wall Street Journal*, *Time Newsweek*, *Business Week*, *Vanity Fair*, *USA Today*, *Atlantic Monthly*, *Scientific American*, and *National Geographic*. These advertising and promotional activities have generated substantial favorable media comment and publicity for the ECOMAGINATION mark as a symbol of the Opponent's energy-efficient and environmentally-responsible products and services including favorable editorial coverage in publications such as *The New York Times*, *The Financial Times*, *The Wall Street Journal*, *Time Magazine*, *The Economist*, and *Forbes* magazine, as well as many Canadian publications [paras 20 and 21].

[33] In support of her assertions of use and advertising of the ECOMAGINATION trade-mark, Ms. Mennenga attaches the following exhibits to her affidavit:

- Exhibits A1 and A2, which consist of the 2010 and 2011 ECOMAGINATION REPORTS, which describe the scope of the Opponent's ECOMAGINATION initiative;
- Exhibit A3, which consists of a document summarizing representative examples of ECOMAGINATION-branded projects in Canada;
- Exhibits B, which consists of printouts from the website *www.ecomagination.com* providing information about the ECOMAGINATION kitchen, which is a suite of refrigeration, cooking and dishwashing products that offer improved energy efficiency; and a photograph of a vehicle on which the ECOMAGINATION mark is displayed. Ms. Mennenga states that this vehicle is part of the fleet of vehicles driven by the Opponent's sales representatives when visiting retail stores and distributors, all of which vehicles display the ECOMAGINATION mark [para 13];
- Exhibit C, which consists of printouts from the same website providing information about the ECOMAGINATION line of lighting products, which consists of compact fluorescent lamps;
- Exhibits D1 and D2, which consist of printouts from the website *www.ge.com/yourhome* providing information about the HOMES INSPIRED BY ECOMAGINATION program, and a brochure providing additional information about the ECOMAGINATION

Homebuilder Program, which preceded the HOMES INSPIRED BY ECOMAGINATION program. Ms. Mennenga explains that this program is a whole-home energy solution the Opponent created to help builders and developers build homes with greater energy efficiency [paras 15 and 16];

- Exhibit E1, which consists of printouts from the website *www.livininharmony.ca* providing information about the Opponent's partnership with a housing developer in the construction of an ECOMAGINATION community outside of Calgary, Alberta called "Harmony";
- Exhibits F1 and F2, which consist of printouts from the website *www.kenthomes.com* providing information about the Opponent's partnership with a builder of manufactured and modular housing in Atlantic Canada to build energy efficient homes and referring to the Opponent's HOMES INSPIRED BY ECOMAGINATION program and to some of the "ECOMAGINATION Features";
- Exhibit G, which consists of printouts from YouTube showing a sample of the ECOMAGINATION videos available for viewing to Canadians. Ms. Mennenga explains that these pages were accessed from a computer in Canada and with "Canada" selected as the "content location" [para 20];
- Exhibits H1 and H2, which consist of representative examples of the print advertisements described by Ms. Mennenga, and a listing of other ECOMAGINATION advertisements that have appeared in publications, which includes the names of the publication and the dates the advertisements ran; and
- Exhibit I, which consists of representative examples of the editorial coverage described above by Ms. Mennenga.

[34] I will not discuss in detail each and every one of the exhibits attached to the Mennenga affidavit. Suffice it to say that it appears that there has been a fair amount of use and advertising of the ECOMAGINATION mark in association with the Opponent's environmental strategy. As indicated above, the ECOMAGINATION program is the Opponent's business strategy to address critical challenges, including the need for cleaner and more-efficient sources of energy, reduced emissions and abundant sources of clean water.

[35] Based on a fair reading of the Mennenga affidavit as a whole, it appears that the

ECOMAGINATION program has been associated with various projects relating to the development of solutions that offer the Opponent's customers across sectors as diverse as power generation, energy management, water, transportation, and oil and gas industries, the capability to enhance resource productivity, reduce environmental impact, and improve business performance [see representative examples of the Opponent's projects described in Exhibits A, D, E and F]. As these projects appear to be related to the Opponent's research, consultation and advisory services in the fields of, generally speaking, building construction, power generation, energy management, water, transportation, and oil and gas industries, I am prepared to accept that the ECOMAGINATION trade-mark has been used and become known to some extent in Canada in association with the services described as follows in the Opponent's registrations: "research, consultation and advisory services all relating to engineering, design and development problems encountered by utility, industrial and commercial companies, governments and individuals"; "technical consultation and research services in the oil and gas industries"; and "consultation services in the field of building construction".

[36] However, the evidence does not enable me to determine to what extent, if any, the ECOMAGINATION trade-mark has been used and become known in Canada in association with each of the remaining services described in the Opponent's registrations and any of the goods described therein.

[37] While Ms. Mennenga states that the total number of the Opponent's products and services offered under the ECOMAGINATION mark amounts to more than 140, it is unclear how the ECOMAGINATION mark is in fact associated with each of the Opponent's registered goods at the time of transfer in the manner required by section 4(1) of the Act.

[38] Use of a trade-mark cannot be established in relation to goods through mere advertisements and promotional type materials. For the use of a mark in advertisement and promotional material to be sufficiently associated with a good to constitute use, the advertisements and promotional type materials must be visible at the time of transfer of property [see *BMW Canada Inc v Nissan Canada Inc* (2007), 2007 FCA 255 (CanLII), 60 CPR (4th) 181 (FCA)]. There is no indication to that effect in the present case.

[39] Furthermore, the printouts providing information about the ECOMAGINATION kitchen,

lighting products or features filed under Exhibits B, C, D and F to the Mennenga affidavit rather seem to refer to the ECOMAGINATION trade-mark to identify the Opponent's program as opposed to the products themselves. As such, they support my finding made above with respect to the ECOMAGINATION trade-mark having acquired a reputation in association with the Opponent's program. However, they do not establish that such is the case with respect to each of the Opponent's registered goods and remaining services.

Conclusion regarding the inherent and acquired distinctiveness of the parties' marks

[40] In view of the foregoing, I find that this factor, which is a combination of inherent distinctiveness and acquired distinctiveness, favours the Opponent but only to the extent that its research, consultation and advisory services in the fields of, generally speaking, building construction, power generation, energy management, water, transportation, and oil and gas industries are concerned.

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

[41] In view of my comments above, this factor favours the Opponent but only to the extent that its research, consultation and advisory services in the fields of, generally speaking, building construction, power generation, energy management, water, transportation, and oil and gas industries are concerned.

[42] Indeed, the mere existence of the Opponent's registrations can establish no more than "de minimis" use and cannot give rise to an inference of significant or continuing use of the ECOMAGINATION trade-mark in Canada [see *Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

The nature of the goods, services or business; and the nature of the trade

[43] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant's statement of goods and services with the statements of goods and services in the registrations relied upon by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110

(FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[44] The Applicant's goods described as:

electric clothes washing machines; automatic dishwashers; electric refrigerators; refrigerators for kimchi; lightwave ovens; temperature controlled electric wine cellars; electric ovens; electric freezers; electric laundry dryers; gas ranges; microwave ovens; gas cooktops; electric ranges for household use; air purifiers; air conditioners; hot air apparatus namely portable electric space heaters; humidifiers; electric dehumidifier for household use; gas grills; dry heat sterilizer; water purifiers for household purposes; electric water purifiers for household use; water ionizers; water ionizers for household purposes; electric and non-electric water filtering, distillation and softening units for domestic use; water purifiers for household purposes (non-electric)

are identical to, or overlapping with the Opponent's registered goods described as:

air conditioners; clothes dryers; dehumidifiers; humidifiers; electric fans, freezers; refrigerators; gas and electric stoves; gas and electric ovens and cooktops; microwave ovens for cooking; ventilation hoods for stoves; ventilating exhaust fans; household water filters for filtering drinking water; water purifiers and electric water softening units; air coolers and heat exchangers; dishwashers; laundry washing machines; laundry drying machines.

[45] In the absence of evidence to the contrary, there is no reason to conclude that these goods would not travel through the same channels of trade and be directed to the same clientele.

[46] Likewise, I find there is an overlap between the above-described goods of the Opponent and the Applicant's services described as: "retail and wholesale services of household appliances" in that they are complementary and target the same clientele.

[47] However, I find that there is no clear overlap between the remaining applied-for goods and services of the Applicant and those of the Opponent.

[48] I disagree with the Opponent's contention that "the goods in the [a]pplication that do not directly overlap with the Opponent's ECOMAGINATION goods are sufficiently closely related that they would be likely sold in the same channels of trade (e.g., retailers of electronics and appliances)." There is no evidence to support this contention. The bulk of the remaining goods and services of the Opponent primarily appear to relate to the power generation, energy management, water, transportation, healthcare, or oil and gas industries. Thus, they appear to be quite different in nature. In view of this, and in the absence of any evidence to the contrary, I am not prepared to conclude that there would be any overlap in the channels of trade associated with such goods and services and those of the Applicant.

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

[49] As noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, "the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion".

[50] Moreover, as previously mentioned, it is well-established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, "[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it" [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 1998, CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA), at para 34]. Even though the first word or portion of a trade-mark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique [see *Masterpiece*, above, at paragraph 64].

[51] The Opponent submits that the degree of resemblance between the parties' marks is very high. More particularly it submits that:

27. The first two syllables (ECO) and the last two syllables (ATION) are identical in the

two marks.

28. The [Mark] truncates the beginning “I” sound in the word “innovation” and replaces it with the “eco” element in the same way that [the Opponent’s] ECOMAGINATION mark truncates the beginning “I” sound in the word “imagination” and replaces it with the “eco” element.

29. Both marks carry connotation of creativity and new thinking with respect to environmental issues. Indeed, innovation is often the result of imagination at work.

30. Ordinarily, the first portion of a mark is somewhat more important for the purposes of distinction; however, when the first component is a common, descriptive or suggestive word, the significance of the first component decreases. (see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)). In the present case, the Applicant will presumably take the position that the element ECO is common and descriptive or suggestive. Even if the marks are dissected and the element ECO given little weight in assessing resemblance (which we submit is not the proper approach), the second elements of the marks (MAGINATION and NOVATION) are very close in resemblance. As stated above, these two components have the identical suffix component (ATION). The evidence does not show that any other marks on the Register that include the element ECO end with this suffix component. Both components are clearly truncated words, in which the initial letter/syllable has been deleted (IMAGINATION and INNOVATION). Both components are very similar in idea suggested. Imagination and innovation are both products of creativity. Both suggest new and fresh ways of thinking.

[52] The fact that there may not be any other applications or registrations on the Canadian register for trade-marks including the element ECO with the suffix component ATION is not a relevant consideration when assessing the degree of resemblance between the parties’ marks *per se*. However, state of the register evidence is a relevant surrounding circumstance in assessing confusion. I will return to this point later.

[53] In the present case, both parties’ trade-marks consist of single coined words and I do not find that any one part of either of them stands out as being more striking or unique.

[54] Considering first the ideas suggested by the marks, I do not find that either of the parties’ marks has any clear meaning in relation to their respective goods and services. However, they are both somewhat laudatory or suggestive in nature.

[55] Indeed, the prefix ECON (ECONO) in the Mark is likely to be perceived as referring to the adjective “economical” (or the French language equivalent “*économique*”). Alternatively, the prefix ECO may also be perceived as referring to the adjective “ecological” (or the French

language equivalent “*écologique*”) or not harming the environment (i.e. eco-friendly).

[56] While the French and English word “novation” may be defined as “the substitution of a new contract or contracting party for an old one”, I find it more likely that the second element of the Mark will be perceived, as a matter of first impression and in the context of the Applicant’s applied-for goods and services, as a truncation of the French and English word “innovation” (i.e. something newly introduced, such as a new method or device). I would add that the *Collins English Dictionary* and *Le Petit Larousse Illustré* also define “novation” as an obsolete word for “innovation”. The Mark as a whole is likely to be viewed as a coined and fanciful trade-mark suggesting that the Applicant’s goods and services are innovative and have been designed in accordance with beneficial ecological and/or economic principles.

[57] The prefix ECO in the Opponent’s mark is likely to be readily perceived as referring to adjective “ecological”. Likewise, the second element of the Opponent’s mark is likely to be readily perceived as a truncation of the French and English word “imagination”. The mark as a whole is likely to be viewed as a coined and fanciful trade-mark suggesting that the Opponent’s goods and services have been designed in accordance with beneficial ecological principles and are the result of imagination.

[58] To sum up, I find there are conceptual differences between the parties’ trade-marks. However, to the extent that the marks may to some extent both suggest that their respective goods and services have been designed in accordance with beneficial ecological principles and are, in some way, the result of new or fresh ways of thinking, I find there is some degree of resemblance in the ideas suggested by the marks.

[59] Visually and phonetically speaking, both parties’ marks begin with the letters ECO and end with the letters ATION. However, they differ significantly, especially when sounded, in the letter sequences MAGIN versus NOV that appear in their middle parts.

[60] Overall, when all three aspects of resemblance are considered together, I find that the parties’ marks are more different than alike.

Additional surrounding circumstances

State of the register and marketplace

[61] The Applicant has introduced state of the register evidence through the Vukovic affidavit and state of the marketplace evidence through the Duchesneau affidavit.

[62] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[63] In the present case, the Vukovic affidavit purports to introduce into evidence the particulars of some 205 trade-mark registrations and applications standing on the Canadian register of trade-marks. Notably, the parameters of Mr. Vukovic's search are not explained. The affidavit is also silent as to the factual inferences which ought to be drawn from the results annexed thereto.

[64] In the decision *Maple Leaf Foods Inc v Lidl Stiftung & Co KG*, 2010 TMOB 13, wherein it was noted that no analysis of similar searches conducted by an affiant had been provided either by the affiant or in a written argument, the Registrar wrote:

If a party wants to raise an argument on the basis of the state of the register or what is in the marketplace, it is the responsibility of that party not only to file the appropriate evidence but to develop this argument. In the absence of any argument relating to this voluminous portion of the evidence, I cannot substitute myself for the Applicant.

[65] Likewise, I have no intention of undertaking a thorough review of the voluminous search results annexed to the Vukovic affidavit. The onus is on the Applicant to substantiate its contentions in this regard [see also *Novalab Inc v. Lidl Stiftung & Co Kg* (2008), 2008 CanLII 88266 (TMOB), 73 CPR (4th) 470 (TMOB)]. That being said, I note that the

Duchesneau affidavit seemingly focuses on 24 of these marks, namely: eco attitude; ecocentral; eco changes; EcoConserve; eco ideas; ECOization; ECONAVI; Eco Options; EcoPlusHome; ECO PRO; EcoPure; EcoQuest; EcoSense; ECOSYS; ECOTHERM ; ECO-Touch; ECOWATER; EcoTech; RONA ECO; eco style; Eco-Heater; ECOPEAK; Eco King; and ECOVACS. More particularly, Mr. Duchesneau encloses with his affidavit printouts of webpages purporting to relate to goods/services offered in association with these 24 marks.

[66] I further note that the Opponent has commented on the Vukovic and Duchesneau affidavits as follows:

11. [The Vukovic] affidavit encloses the particulars of a number of Canadian trademark registrations and applications for marks containing the term ECO. Many of the marks contain design elements or do not feature the term ECO as the first element. Notably, *none* of the marks located by the search consist of a single coined word beginning with the prefix component ECO- and ending in the suffix component –ATION. Only four of the marks located clearly combine the prefix component ECO with a second word in which the initial letter/syllable has been truncated: ECOIZATION (TMA795853), GREENEDGE ECOTAINMENT (1480794) and HARMAN ECOTAINMENT (1480795), and ECOFINITY (TMA778220). These marks are not otherwise similar to the ECOMAGINATION or Econovation marks.

12. [...]. [The Duchesneau] affidavit encloses printouts of webpages purporting to relate to goods/services offered in association with 24 marks/names that include the element ECO. Notably, *none* of the marks selected by Mr. Duchesneau for inclusion in this affidavit consist of a single coined word beginning with the prefix component ECO- and ending in the suffix component –ATION. Only one of the marks in his affidavit clearly combines the prefix component ECO with a second word in which the initial letter/syllable has been truncated: ECOIZATION. The webpages included in the affidavit suggest that the owner of the ECOIZATION mark is located in Milwaukee, Wisconsin. While the company appears to have several Canadian representatives, the evidence does not show the ECOIZATION mark being used in Canada on any goods.

[67] Under the circumstances, I will focus my review of the state of the register evidence introduced through the Vukovic affidavit on the 24 marks highlighted in the Duchesneau affidavit.

[68] Upon review of the particulars attached to the Vukovic affidavit, I note that these 24 marks have, for the most part, been registered or allowed for registration in association with, generally speaking, a variety of household goods, such as lighting products, heating, cooling and ventilating apparatus, major appliances (e.g. dishwashers, refrigerators, clothes dryers, washing

machines, etc.), vacuum cleaners, computers, etc.

[69] While I agree with the Opponent that none of these marks may be as close to the Opponent's ECOMAGINATION trade-mark as the Mark, the fact remains that they do incorporate the prefix "eco" for a variety of household goods. These registrations (and few allowed applications) represent a number significant enough for inferences about the state of the marketplace to be drawn (without the need for me to comment on the website printouts attached to the Duchesneau affidavit). In other words, I am able to infer that at least some of those marks are in use and that consumers are accustomed to seeing such "eco" marks in the marketplace. They would therefore be more likely to differentiate such marks on the basis of their other components.

[70] To sum up, I find that this is a surrounding circumstance favouring the Applicant.

Conclusion regarding the likelihood of confusion

[71] As noted by the Federal Court of Appeal in *Dion Neckwear, supra*, at page 163, the Registrar "need not be satisfied beyond doubt that confusion is unlikely. Should the 'beyond doubt' standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity."

[72] I find that the Applicant has established, according to the balance of probabilities, that a consumer having an imperfect recollection of the Opponent's ECOMAGINATION trade-mark would be unlikely to conclude that the Applicant's goods and services originate from the same source or are otherwise related to or associated with the Opponent's registered goods and services.

[73] As indicated above, neither of the parties' marks is inherently strong. While the distinctiveness of the Opponent's ECOMAGINATION trade-mark may have been reinforced through use and promotion of the Opponent's environmental strategy and program, and to some extent with respect to the Opponent's research, consultation and advisory services in the fields of, generally speaking, building construction, power generation, energy management, water, transportation, and oil and gas industries, the evidence of record does not establish any

significant reputation for any of those goods and services which directly overlap with or are similar in nature to those of the Applicant.

[74] As comparatively small differences may suffice to distinguish between marks of low inherent distinctiveness [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)], I find that the differences existing between the parties' marks are sufficient to avoid any reasonable likelihood of confusion in the present case. My finding is reinforced when the state of the register evidence is factored in.

[75] Accordingly, the section 12(1)(d) ground of opposition is dismissed. In addition, the Opponent necessarily also does not succeed under section 12(1)(d) based on its registration No. TMA794,873 for HOMES INSPIRED BY ECOMAGINATION in view of the even more pronounced differences existing between this mark and the Mark.

Non-distinctiveness of the Mark under section 2 of the Act

[76] The Opponent has pleaded that the Mark is not distinctive, within the meaning of section 2 of the Act, in that it does not distinguish, nor is it adapted to distinguish the goods and services of the Applicant from the goods and services of others, and in particular from the Opponent's goods and services associated with the ECOMAGINATION Trade-marks and trade-name.

[77] An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing date of the opposition (in this case October 1, 2012) its trade-mark (or trade-name) had become known sufficiently to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As per my review above of the Mennenga affidavit, the Opponent has met its burden insofar as the ECOMAGINATION trade-mark in association with the Opponent's research, consultation and advisory services in the fields of, generally speaking, building construction, power generation, energy management, water, transportation, and oil and gas industries are concerned. It has also met its burden with respect to its HOMES INSPIRED BY ECOMAGINATION trade-mark in association with consulting services in the field of building construction. However, the Opponent has not met its burden with respect to the remaining of the Opponent's goods and services described in

Schedule “B” and the Opponent’s trade-name.

[78] The difference in relevant dates does not materially affect my conclusion under the section 12(1)(d) ground of opposition above.

[79] Accordingly, the non-distinctiveness ground of opposition is also dismissed.

Non-entitlement under section 16(3)(a) of the Act

[80] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act, because at the date the application was filed (that is, the priority filing date December 7, 2009), the Mark was confusing with the ECOMAGINATION Trade-marks, which had been previously used by the Opponent in Canada with the goods and services listed in Schedule “B”.

[81] With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its ECOMAGINATION Trade-marks prior to the date of filing of the Applicant’s application and non-abandonment of its marks as of the date of advertisement of the Applicant’s application [section 16(5) of the Act].

[82] As per my review above of the Mennenga affidavit, the Opponent has met its burden insofar as the ECOMAGINATION trade-mark in association with the Opponent’s research, consultation and advisory services in the fields of, generally speaking, building construction, power generation, energy management, water, transportation, and oil and gas industries are concerned. It has also met its burden with respect to its HOMES INSPIRED BY ECOMAGINATION trade-mark in association with consulting services in the field of building construction. However, the Opponent has not met its burden with respect to the remaining of the Opponent’s goods and services listed in Schedule “B”.

[83] The difference in relevant dates somewhat affects my analysis above under the section 12(1)(d) ground of opposition in that I am no longer prepared to find that the state of the register evidence is a surrounding circumstance favouring the Applicant, because most of the 24 trade-marks highlighted in the Duchesneau affidavit were not registered (or allowed for registration) back in December 7, 2009. In other words, they no longer represent a number

significant enough for inferences about the state of the marketplace to be made. Furthermore, while the Duchesneau affidavit apparently purports to establish use of these marks in the marketplace, most of the website printouts attached thereto also postdate the material date to assess the present ground of opposition, not to mention that they by no means establish the truth of their content.

[84] That being said, my ultimate conclusion under the section 12(1)(d) ground remains applicable since there is no clear overlap between any of the Applicant's goods and services and the Opponent's research, consultation and/or advisory services for which use of the ECOMAGINATION or HOMES INSPIRED BY ECOMAGINATION trade-marks has been shown. In other words, the differences existing between the Mark and the Opponent's trade-marks combined with the ones existing between the parties' respective goods and/or services were sufficient to avoid a likelihood of confusion as of the material date of December 7, 2009.

[85] Accordingly, the section 16(3)(a) ground of opposition is also dismissed.

Non-entitlement under section 16(3)(b) of the Act

[86] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(b) of the Act, because at the date the application was filed (that is, the priority filing date December 7, 2009), the Mark was confusing with the ECOMAGINATION Trade-marks, "applications to register which had been previously filed by the Opponent in Canada."

[87] An opponent meets its evidential burden with respect to a section 16(3)(b) ground if it shows that its application was filed prior to the date of filing of the applicant's application and was pending when the applicant's application was advertised [section 16(4) of the Act].

[88] Except for its application Nos. 1,396,836, 1,445,019 and 1,394,654, the Opponent has failed to meet its burden since all of the remaining applications referred to in Schedule B were either filed after the Applicant's application or not pending when the Applicant's application was advertised.

[89] Turning to application Nos. 1,396,836, 1,445,019 and 1,394,654, my ultimate conclusion

under the section 12(1)(d) ground remains applicable since there is no overlap between any of the Applicant's goods and services and the Opponent's services described as:

Leasing of automobiles, aircraft, railcars, marine vessels, cargo containers and shipping containers; consulting services in the field of power distribution of electricity from its generation at an electrical power plant to its delivery to customers; providing courses, lectures and problem solving sessions in the field of power distribution of electricity pertaining to its generation at electrical power plants and to its delivery to customers;

or,

Consulting services in the field of building construction.

[90] In other words, the differences existing between the Mark and the Opponent's ECOMAGINATION and HOMES INSPIRED BY ECOMAGINATION trade-marks combined with the ones existing between the parties' respective goods and/or services were sufficient to avoid a likelihood of confusion as of the material date of December 7, 2009.

[91] Accordingly, the section 16(3)(b) ground of opposition is also dismissed.

Disposition

[92] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition under section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"

Electric vacuum cleaners; electric clothes washing machines; automatic dishwashers; telephone sets; wireless telephone sets; portable communications apparatus namely handsets, walkie-talkies, satellite telephones and personal digital assistants (PDA); mobile phones; MPEG audio layer-3 (MP3) players; television receivers; television remote controllers; Universal Serial Bus (USB) drives; Digital Media Broadcasting (DMB) players; headsets for mobile phones; portable chargers for mobile phone batteries and digital camera batteries; electronic photo albums; digital picture frames; 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 telecommunication, namely CD players, compact disc players, DVD players, MP3 players, digital audio players, audio recorders; 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; computer software for mobile phone; 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; electronics toll collection systems comprised of on board units, electronic card and terminal; terminals for electronic transactions equipped in vehicle; Closed-Circuit Television (CCTV) cameras; network monitoring cameras; digital signage; massage chairs; massage gloves; vibrator massagers; bed vibrators; chairs for electric massage; electric refrigerators; refrigerators for kimchi; lightwave ovens; temperature controlled electric wine cellars; electric ovens; electric freezers; electric laundry dryers; gas ranges; microwave ovens; gas cooktops; electric ranges for household use; air purifiers; air conditioners; hot air apparatus namely portable electric space heaters; humidifiers; electric dehumidifier for household use; gas grills; dry heat sterilizer; water purifiers for household purposes; electric water purifiers for household use; water ionizers; water ionizers for household purposes; electric and non-electric water filtering, distillation and softening units for domestic use; water purifiers for household purposes (non-electric); electric footwarmers.

Marketing and promotion of third party products and services for business management, arrangement and operation of advertising material on computer network and global communication network, advertising via electronic media and the internet for business management; retail and wholesale services of computers, computer accessories, household appliances and electronic goods.

Schedule "B"

Trade-mark	Appl'n No. /Reg'n No. Filing date / Reg'n date	Goods / Services
ECOMAGINATION	Appl'n No. 1,254,576 Reg'n No. TMA765,676 April 14, 2005 / May 04, 2010	<p>Goods:</p> <p>(1) Chemicals and chemical products for all types of water treatment and processing systems.</p> <p>(2) Lighting controls; LEDS; led signals; electrical meters; electrical controllers; programmable logic controllers; electric lighting panel boards; electric power panel boards; electrical wiring fixtures; electric energy cells; fuel cells; electricity distribution boards and boxes; electricity distribution consoles; electricity switchboards and switch boxes; electric power supplies; transformers; apparatus for the treatment and monitoring of industrial, commercial and municipal water systems and for the treatment and monitoring of commercial and municipal materials processing systems and for the treatment and monitoring of hydrocarbon and petrochemical processing systems; filters and membranes for water clarification and/or purification.</p> <p>(3) Medical diagnostic imaging apparatus for displaying diagnostic images; x-ray and radiological apparatus; x-ray tubes for medical use; computer tomography apparatus, magnetic resonance imaging apparatus, positron emission tomography apparatus and spectroscopic apparatus, all for medical use; ultrasonic medical apparatus; nuclear medical apparatus; radiation therapy apparatus; medical diagnostic imaging accessories, namely, magnetic gradient coils; fetal pulse and vital signs monitors.</p> <p>Services:</p> <p>(1) Remote tracking, monitoring and location of land vehicles, trailers, cargo containers, rail cars and water vessels, and providing business, inventory, maintenance</p>

		<p>and pooling reports in connection therewith.</p> <p>(2) Providing repair, maintenance and installation services for gas and steam turbine power plants and for all types of power generation, transmission and/or distribution plants and facilities and accessories and component parts of all the foregoing; oil and gas pipeline inspection, maintenance and repair services; drilling and pumping of oil and gas; drilling for crude oil; oil well casing, tubing and drill pipe installation; rental of oil and gas well drilling tools.</p> <p>(3) Oil production services; gas production services; oil and gas well treatment services; oil and gas refining services.</p> <p>(4) Research, consultation and advisory services all relating to engineering, design and development problems encountered by utility, industrial and commercial companies, governments and individuals; technical consultation and research services in the oil and gas industries; oil and gas exploration services; geophysical exploration for the oil and gas industries; analysis of oil and gas fields; oil and gas prospecting, namely well logging and testing; oil and gas well testing.</p> <p>(5) Providing imaging, screening, diagnostic treatment and information technology services in the field of healthcare; leasing and rental of medical and dental equipment and accessories; management and operation of medical and dental facilities; consultancy, advisory and information services relating to all the foregoing services.</p>
ECOMAGINATION	<p>Appl'n No. 1,396,836 Reg'n No. TMA753,685 May 26, 2008 / Nov. 23, 2011</p>	<p>Services:</p> <p>(1) Leasing of automobiles, aircraft, railcars, marine vessels, cargo containers and shipping containers; consulting services in the field of power distribution of electricity from its generation at an electrical power plant to its delivery to customers; providing courses, lectures and problem solving sessions in the field of power distribution of electricity pertaining to its generation at</p>

		electrical power plants and to its delivery to customers
ECOMAGINATION	Appl'n No. 1,396,838 Reg'n No. TMA754,766 May 26, 2008 / Dec. 08, 2009	<p>Goods:</p> <p>(1) Motors and engines for locomotives; locomotives.</p> <p>(2) Electric light bulbs; luminescent, incandescent and fluorescent lighting lamps and tubes; lamps and lights for vehicles; electric luminaires; electric discharge lamps; electric lights for Christmas trees; electric night lights; flashlights; lights for vehicles; air conditioners; clothes dryers; dehumidifiers; humidifiers; electric fans, freezers; refrigerators; gas and electric stoves; gas and electric ovens and cooktops; microwave ovens for cooking; ventilation hoods for stoves; ventilating exhaust fans; water heaters; household water filters for filtering drinking water; water purifiers and electric water softening units; steam and gas generators; air coolers and heat exchangers; steam condensers; heavy wall reactors; electric and gas grills, nuclear reactors; and component parts of all the foregoing.</p> <p>(3) Electric and wind-powered electric generators; aeronautical and airplane engines; cranes; jet engines for aircraft; motors and engines for boats; dishwashers; garbage and waste disposals; engines for aircraft and aeroplanes; starters for motors and engines; laundry washing machines; laundry drying machines; compressors, turbo compressors, fuel injectors and turbochargers for machines, motors and engines; wind, steam, gas and hydraulic turbines; axial and centrifugal compressors; reciprocating compressors; screw and vane compressors; turbo expanders; Compressed Natural Gas, i.e., CNG refueling equipment and accessories and component parts therefor, namely, pumps, valves, filters, casings, rotors, blades, bearings and seals; valves for pumps; steam and gas turbines; industrial robots, and component parts of all the foregoing; electric starters, electric full-</p>

		voltage manual starters, and electric reduced voltage starters all for use in starting electric motors
ECOMAGINATION	Appl'n No. 1,445,019 Reg'n No. TMA824,454 July 16, 2009 / May 22, 2012	Services: (1) Consulting services in the field of building construction.
HOMES INSPIRED BY ECOMAGINATION	Appl'n No. 1,394,654 Reg'n No. TMA794,873 May 08, 2008 / April 06, 2011	Services: (1) Consulting services in the field of building construction.
ECOMAGINATION	Appl'n No. 1,514,299 Feb. 08, 2011	Goods: (1) Automated systems, namely, software, hardware and communications equipment for planning, scheduling, controlling, monitoring and providing information on transportation assets and parts thereof. (2) Electronic signaling mechanism, namely, a train control system used in the railway industry for detecting and controlling trains, ground faults, broken rails, power failures, track switches and lights. (3) Avionic sensor system comprised of computer hardware, software, and navigation equipment for the purpose of optimizing flight paths. (4) General purpose batteries and chargers and industrial batteries for uninterrupted power supply and for direct source of power; all for use in transportation, utilities, industry and telecom applications; computer hardware and software, for use with medical patient monitoring equipment, for receiving, processing, transmitting and displaying data; computer software for accessing information directories that may be downloaded from the global computer network; computer software for controlling and managing patient medical information; electronic controllers to manage the temperature and energy usage of a home or business; electrical apparatus, namely, charging stations for charging electric vehicles; electrical power distribution boxes, panels, and systems composed of breakers and switchgears, multiplexers, switchboards,

		uninterruptible electrical power supplies, voltage regulators, voltage stabilizers; electronic devices, namely, energy meters for tracking and monitoring energy usage.
ECOMAGINATION	Appl'n No. 1,551,283 Reg. No. TMA843,434 Nov. 8, 2011 / Feb. 15, 2013	<p>Goods:</p> <p>(1) Apparatus, equipment and instruments for the generation of power, namely, electric generators and wind powered electricity generators; turbines; turbines for power generation; wind turbines for power generation; wind turbines in association with wind farms; engines for the generation of electricity; and structural parts therefor for all the aforesaid; and solar-powered electricity generators.</p> <p>(2) Apparatus for converting electronic radiation to electrical energy, namely, photovoltaic solar modules.</p> <p>Services</p> <p>(1) Construction, installation, repair, replacement, overhaul and maintenance of power plants, engines, turbines, wind turbines, motors and apparatus, equipment and instruments for the generation of power and electricity and their component parts, fittings and accessories.</p>

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

No Hearing Held

AGENT(S) OF RECORD

Bereskin & Parr LLP/S.E.N.C.R.L.

FOR THE OPPONENT

Smart & Biggar

FOR THE APPLICANT