



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

Citation: 2015 TMOB 199
Date of Decision: 2015-10-30

IN THE MATTER OF AN OPPOSITION

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|-------------------------------|--------------------|
| Standard Products Inc. | Opponent |
| and | |
| TRUMPF GmbH + Co. KG | Applicant |
| 1,387,286 for TruLight | Application |

I. Background

[1] The Applicant has filed an application to register the trade-mark TruLight (the Mark). The application is based upon proposed use in Canada in association with “lighting apparatus, namely LED operating room lights; video camera systems for medical purposes, namely video cameras and viewing monitors”. It was filed on March 13, 2008 and it claims an October 1, 2007 priority filing date based upon German Application No. 307 64 126.0/10.

[2] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* on May 16, 2012 and on July 12, 2012, the Opponent filed a statement of opposition against it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[3] The grounds of opposition are: (i) the application does not conform to the requirements of section 30 of the Act; (ii) the Mark is not registrable under section 12(1)(b) of the Act, as it is clearly descriptive or deceptively misdescriptive of the character or quality of the goods in association with which it is proposed to be used; (iii) the Mark is not registrable under

section 12(1)(d) of the Act, as it is confusing with the Opponent's registered trade-mark TRUE LITE , which is the subject of registration No. TMA471,990 for "full spectrum fluorescent lamps"; iv) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act in view of the Opponent's prior use of its trade-mark TRUE LITE in Canada in association with the aforementioned wares; and (v) the Mark is not distinctive within the meaning of section 2 of the Act.

[4] A counter statement denying all of the allegations set out in the statement of opposition was filed by the Applicant on September 6, 2012.

[5] As evidence in support of its opposition, the Opponent filed the affidavit of Albert Ansky, sworn December 21, 2012 (the Ansky affidavit). Mr. Ansky was not cross-examined.

[6] The Applicant elected not to file any evidence.

[7] Only the Opponent filed a Written Argument.

[8] No hearing was held.

II. 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

III. Analysis

Grounds of Opposition Summarily Dismissed

Non-conformity - Section 30

[10] Where an applicant has provided the statement required by section 30(i), a ground of opposition based upon this section 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]. The Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, the ground of opposition based upon section 30(i) is dismissed.

[11] The remaining grounds of opposition raised under section 30 appear to be duplicative of the grounds which are based upon sections 12(1)(d) and 2 of the Act and, in my view, have not been properly pleaded under section 30 of the Act. Accordingly, they are also dismissed.

Non-registrability - Section 12(1)(b)

[12] The Opponent has pleaded that the Mark is not registrable under section 12(1)(b) of the Act, as it is either clearly descriptive or deceptively misdescriptive of the character or quality of the goods in association with which it is proposed to be used. The Opponent has not explained the basis for this ground in its statement of opposition, nor has it filed any evidence or written submissions to support it. Accordingly, this ground of opposition is also dismissed.

Analysis of Remaining Grounds of Opposition

Non-Registrability – Section 12(1)(d)

[13] The Opponent has pleaded that the Mark is not registrable because it is confusing with its trade-mark TRUE LITE, which is the subject of registration No. TMA471,990.

[14] The material date to assess the section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[15] The Opponent filed a copy of its registration as Exhibit 1 to the Ansky affidavit and I have exercised my discretion and checked the register to confirm that the Opponent's registration is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[16] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between its trade-mark and the Opponent's trade-mark.

[17] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[18] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[19] The parties' trade-marks both consist of a combination of ordinary dictionary terms or phonetic equivalents thereof ("true", "tru", "light" and "lite"). However, they do possess at least some degree of inherent distinctiveness.

[20] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. The Applicant has not filed any evidence of promotion or use of the Mark. The Opponent has filed the affidavit of Albert Ansky affidavit, the Vice President of Finance of the Opponent. According to Mr. Ansky, the Opponent has been using its TRUE LITE trade-mark continuously for nearly 18 years (since 1995), in association with "lighting fixtures and lighting apparatus" [paras 8 and 16].

[21] Mr. Ansky states that the Opponent has offices in Quebec, Ontario and British Columbia, and warehouses in Quebec, Ontario, British Columbia and Alberta [para 6].

[22] Attached as Exhibit 2 are invoices which Mr. Ansky states evidence sales by the Opponent of its lighting fixtures and apparatus in association with its TRUE LITE trade-mark. Mr. Ansky states that even though some of the invoices in Exhibit 2 do not specifically mention TRUE LITE, they all relate to sales of lighting fixtures and lighting apparatus that had the trade-mark TRUE LITE etched onto the goods themselves and all of those products were shipped in a cardboard sleeve or box on which the trade-mark TRUE LITE was marked [paras 10-12].

[23] Notably, some of the invoices attached as Exhibit 2 range in date from 2007 to 2009 and show the company name as Produits Standard Products Inc. and the remainder of the invoices are dated 2012 and show the company name as being Standard Products Inc. While there is no explanation for the two year gap in dates between the invoices, Mr. Ansky does indicate elsewhere in his affidavit that the invoices were “randomly selected” [paras 9 and 11]. In the absence of any cross-examination or submissions by the Applicant, in view of Mr. Ansky’s statement in paragraph 9 that the sales evidenced by the invoices were made by the Opponent, and in view of the fact that the address listed in the later invoices corresponds to the address shown in the Opponent’s registration for its trade-mark, I find it reasonable to infer that the company identified in the invoices and the Opponent are one and the same.

[24] Attached as Exhibits 3 and 4 are photographs of the Opponent’s lighting fixtures and apparatus and of the sleeves in which they are sold in Canada. The products and the packaging both show the trade-mark as TRUELITE (with no space between the words TRUE and LITE). However, I consider the difference between how the trade-mark is used and how it is registered to be inconsequential. In other words, I consider the manner in which the trade-mark has been used to constitute use of the trade-mark as registered [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)].

[25] Attached as Exhibit 5 are promotional sheets which Mr. Ansky states are distributed across Canada by the Opponent. The Opponent’s trade-mark is prominently displayed thereon.

[26] In view of the foregoing, I can conclude that the Opponent's trade-mark has become known to at least some extent in Canada.

Section 6(5)(b) – the length of time each has been in use

[27] The application for the Mark is based upon proposed use in Canada and the Applicant has not filed any evidence to show that any use of the Mark has commenced to date. By contrast, the Opponent has provided some evidence of use.

Sections 6(5)(c) and (d) – the nature of wares, services or business and trade

[28] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods in the application for the Mark and the statement of goods in the Opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*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)]. 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. Evidence of the parties' actual trades is useful in this respect [*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 Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[29] The statement of goods in the Opponent's registration covers "full spectrum fluorescent lamps" and the application for the Mark covers "lighting apparatus, namely LED operating room lights; video camera systems for medical purposes, namely, video cameras and viewing monitors".

[30] I consider there to be some overlap in the parties' lighting products. While the application for the Mark indicates that the Applicant's lights are intended for use in operating rooms, as the Opponent has pointed out, its lights may also be used in such an environment and purchased by the same consumers who purchase the Opponent's lighting products, as there are no restrictions in the Opponent's registration. In the absence of any cross-examination on this point or any

evidence from the Applicant, I consider it reasonable to conclude that there is overlap in the nature of the parties' lighting products and possibly also in their respective channels of trade.

[31] However, I am not prepared to arrive at the same conclusion with respect to the goods "video camera systems for medical purposes, namely, video cameras and viewing monitors", which are also covered by the application for the Mark. Although Mr. Ansky states in his affidavit that the cameras specified in the application for the Mark would involve LED technology which is also involved in the goods which are covered in the Opponent's registration, he has not provided any evidence in support of this statement. In the absence of such evidence, I do not consider it reasonable to conclude that the Applicant's video camera systems are of a similar nature to or have some association with the lighting products of the Opponent or that they would likely be sold to the same consumers through similar channels of trade.

Section 6(5)(e) – degree of resemblance between the trade-marks

[32] The parties' trade-marks TRUE LITE and TruLight closely resemble one another in appearance, sound and connotation.

Conclusion on the Likelihood of Confusion

[33] Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its onus to show that, on a balance of probabilities, confusion between the parties' trade-marks is unlikely with respect to "video camera systems for medical purposes, namely, video cameras and viewing monitors", as these goods are, in my view, fundamentally different than lighting and the Opponent hasn't submitted any evidence to support its contention that there is some relationship between the type of lighting that the parties' sell and these goods. However, I am not satisfied that it has satisfied its burden with respect to its "lighting apparatus, namely LED operating room lights".

[34] As mentioned previously, although the Applicant has restricted its application to LED lights for an operating room environment, the Opponent's registration does not contain any restrictions and there is nothing precluding its lights from being used in the same type of environment or from being sold to the same consumers. In view of this, and in view of the fact

that the Opponent has evidenced some use and reputation in its trade-mark for lighting products and the fact that the parties' trade-marks are highly similar, I find it reasonable to conclude that there is a likelihood of confusion between the parties' trade-marks with respect to the Applicant's lighting goods.

[35] The section 12(1)(d) ground of opposition is therefore successful with respect to "lighting apparatus, namely LED operating room lights", but unsuccessful with respect to "video camera systems for medical purposes, namely, video cameras and viewing monitors".

Non-entitlement – Section 16(3)(a)

[36] The Opponent has pleaded that the Mark is confusing with its previously used trade-mark TRUE LITE. There is an initial burden upon the Opponent in respect of this ground to prove that its trade-mark was used in Canada prior to the date of filing of the application for the Mark and had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

[37] I am satisfied that the Opponent has discharged its evidentiary burden to show prior use and non-abandonment of its TRUE LIGHT trade-mark prior to the Applicant's March 13, 2008 filing date. Assessing each of the section 6(5) factors as of this date, rather than as of today's date, does not significantly impact my previous analysis under section 12(1)(d) of the surrounding circumstances of this case.

[38] Accordingly, for reasons similar to those expressed in relation to the section 12(1)(d) ground of opposition, the 16(3)(a) ground of opposition is successful in relation to "lighting apparatus, namely LED operating room lights", but unsuccessful with respect to "video camera systems for medical purposes, namely, video cameras and viewing monitors".

Non-distinctiveness – Section 2

[39] The Opponent has pleaded that the Mark does not distinguish and is not adapted to distinguish the goods of the Applicant from those of the Opponent.

[40] The material date to assess this ground of opposition is the filing date of the statement of opposition, namely, July 12, 2012 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[41] I am satisfied that the Opponent has met its evidentiary burden to establish that its TRUE LIFE trade-mark had become known sufficiently in Canada as of, July 12, 2012 to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[42] Assessing each of the section 6(5) factors as of July 12, 2012 does not significantly impact my analysis of the surrounding circumstances of this case. Thus, for reasons similar to those previously expressed, I am satisfied that the Applicant has discharged the legal onus resting upon it to show that, as of July 12, 2012, the Mark was not reasonably likely to cause confusion with the Opponent's trade-mark for "video camera systems for medical purposes, namely, video cameras and viewing monitors", but that it would have been likely to do so for "lighting apparatus, namely LED operating room lights".

[43] In view of this, I am satisfied that as of the material date, the Mark distinguished or was adapted to distinguish the video camera systems of the Applicant from the Opponent's lighting products, but not its lighting products.

[44] In view of the foregoing, the non-distinctiveness ground of opposition is also successful with respect to "lighting apparatus, namely LED operating room lights", but unsuccessful with respect to "video camera systems for medical purposes, namely, video cameras and viewing monitors".

IV. Remark

[45] As a final remark, I wish to note that in its written submissions, the Opponent also argued that the application for the Mark does not comply with section 30(a) of the Act, as "video camera systems" is not an ordinary commercial term. The statement of opposition does not contain a

section 30(a) ground of opposition. In view of this, I have disregarded the Opponent's arguments in this regard.

V. Disposition

[46] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to “lighting apparatus, namely LED operating room lights” and I reject the opposition with respect to “video camera systems for medical purposes, namely video cameras and viewing monitors” pursuant to section 38(8) of the Act [see *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: No Hearing Held

Agents of Record

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