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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2019 TMOB 121**

**Date of Decision: 2019-11-06**

**IN THE MATTER OF AN OPPOSITION**

**Trademark Industries Inc.**

**Opponent**

**And**

**Atlantia Holdings Inc.**

**Applicant**

**1,630,650 for LOGIIX**

**Application**

INTRODUCTION

[1] On June 11, 2013, Atlantia Holdings Inc. (the Applicant) filed an application to register the trade-mark LOGIIX (the Mark).

[2] The application is based on use of the Mark in Canada in association with the following goods (as revised) since at least as early as August 2012:

- (1) Computers; notebook computers; computer hardware; computer operating system software; electrical power adaptors, namely, electrical power adapters, electrical AC power adapters and electrical DC power adapters for computers; electrical power cords; computer batteries; remote controls for use with computers; cables, electric power connectors and electric data connectors for use with computer and computer peripherals, namely, mice, keyboards, monitors, printers, hard drives flash drives, expansion cards, graphics cards, image scanners, tape drives, microphones, loudspeakers, webcams, digital cameras, smartphones, tablet computers; downloadable electronic publications in the nature of

instruction manuals in the field of computers, notebook computers, computer hardware, computer operating system software, computer batteries and other computer accessories and peripherals; bags, namely, briefcases, shoulder bags, knapsacks, bags for computers, bags for computer accessories (the Goods).

[3] The application was advertised for opposition purposes in the Trade-marks Journal of January 7, 2015.

[4] Trademark Industries Inc. (the Opponent) filed a statement of opposition on August 6, 2015. Certain grounds of opposition were struck by way of interlocutory ruling dated March 18, 2019, which considered the statement of opposition as it had been amended on March 9, 2019. The remaining grounds of opposition are pleaded pursuant to sections 30, 16, 12 and 2 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[5] Numerous amendments to the Act came into force on June 17, 2019. The date for identifying which version of the Act applies to opposition proceedings is the date on which the application being opposed was advertised. As the present application was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read on June 16, 2019, with the exception of confusion for which subsections 6(2) to (4) of the Act as they currently read will be applied.

[6] The Applicant filed and served a counter statement. The Opponent filed and served the affidavit of Pavle Levkovic. The Applicant filed and served the affidavit of Karim Salemohamed. Only the Applicant filed a written argument; a hearing was held at which both parties attended but only the Applicant made submissions.

#### ONUS

[7] 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) at 298].

## ANALYSIS OF THE GROUNDS OF OPPOSITION

### **Section 30(i) Ground of Opposition**

[8] The Opponent alleges in its statement of opposition that the Applicant could not have been satisfied that it is entitled to use the Mark as the Applicant was not the owner of the Mark applied for as of the filing date.

[9] Where an applicant has provided the statement required by section 30(i) of the Act, 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]. There is no evidence of bad faith or exceptional circumstances. This ground of opposition is therefore dismissed.

### **Section 30(b) Ground of Opposition**

[10] The Opponent also pleads that the Applicant “does not use and does not intend to use the Mark”. It is not clear that this ground was properly pleaded as it does not allege that the Applicant had not been using its Mark since the claimed date of first use. In any event, no evidence has been filed nor submissions made by the Opponent which support its allegation that the Applicant has not used the Mark in association with the Goods since the date of first use claimed in the application.

[11] Accordingly, the section 30(b) ground of opposition is dismissed as the Opponent has not met its evidential burden.

### **Section 12(1)(d) Ground of Opposition**

[12] The Opponent alleges in its statement of opposition that the Mark is not registrable in view of section 12(1)(d) of the Act because it is confusing with the LOGIX mark, registration TMA782,743 which had been previously filed, registered and used in Canada by Trademark Tools Inc. (and was also used under license by the Opponent).

[13] An Opponent’s initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. I have

exercised my discretion and confirm that the registration relied upon by the Opponent was expunged July 25, 2017. Accordingly, the Opponent has not met its initial burden with respect to this ground with the result that this ground of opposition is dismissed.

### **Section 16(1)(a) Ground of Opposition**

[14] The Opponent alleges in its statement of opposition that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada given the prior use in Canada of the LOGIX mark by Trademark Tools Inc. (and prior use by the Opponent under license) in association with the following goods “Tool bags, flashlights and tools, namely hammers, saws, screw drivers, measuring tapes, hand-held drills, spirit levels, pliers and wrenches, small electric kitchen appliances, kitchen carts, kitchen towels, wine bottle openers and spice racks.”

[15] Section 17 of the Act states that no application for the registration of a trade-mark shall be refused due to previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant or his predecessor-in-title, except at the instance of that other person or his successor-in-title. Therefore, an opponent can only rely upon prior use or making known of its own trade-marks or trade-names. A ground of opposition based upon prior use or making known of a third party’s trade-marks or trade-names is an invalid ground of opposition.

[16] In this case, the Opponent has relied upon the prior use of a trade-mark owned by a third party, i.e. Trademark Tools Inc. Accordingly the non-entitlement ground of opposition is dismissed for being an invalid ground of opposition.

### **Section 2 Ground of Opposition**

[17] The Opponent alleges in its statement of opposition that the Mark is not distinctive in light of it being confusing with the LOGIX registered mark and the unregistered LOGIX mark which had been previously been filed, registered, used and made known in Canada by Trademark Tools Inc. and/or the Opponent (under license) in association with the Goods previously set out above.

[18] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that, as of the date of filing its statement of

opposition, August 6, 2015, the LOGIX mark was known to some extent at least and the reputation of this mark in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[19] The only evidence submitted by the Opponent was the affidavit of Pavle Levkovic, articling student employed by the Opponent's agent. Attached to Mr. Levkovic's affidavit are printouts of various dictionaries indicating that the word "software" is "logiciel" in French, printouts of certain webpages from the Applicant's website <https://www.logiix.net>, and printouts of homepages relating to various websites that used one of the following terms: LOGIIX, LOGIX, LOGIICS, LOGICS, LOGUICKS, and LOGICKS.

[20] I agree with the Applicant that the evidence filed by the Opponent is not sufficient to show that the LOGIX mark had been previously used by Trademark Tools Inc. and/or the Opponent or had been made known sufficiently by the filing date of the statement of opposition to negate the distinctiveness of the applied for Mark. This ground is therefore unsuccessful.

#### DISPOSITION

[1] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Cindy Folz  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** 2019-09-04

**APPEARANCES**

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For the Opponent

Aiyaz A. Alibhai

For the Applicant

**AGENTS OF RECORD**

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For the Applicant