

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 83
Date of Decision: 2020-07-14

IN THE MATTER OF AN OPPOSITION

**Bayerische Motoren Werke
Aktiengesellschaft**

Opponent

and

**MONCLER S.P.A., an incorporated
business forming a joint stock company
of Italian nationality**

Applicant

1,754,757 for M (& DESIGN)

Application

INTRODUCTION

[1] MONCLER S.P.A., an incorporated business forming a joint stock company of Italian nationality (the Applicant) has applied to register the trademark M (& DESIGN) (the Mark), reproduced below, on the basis of proposed use in Canada in association with a long list of goods, covering among other things, goods classified under Nice classes 12 (relating to vehicles), 20 (including furniture); and 32 (including non-alcoholic beverages). I am reproducing in Schedule A to my decision, the statement of goods, as revised by the Applicant.



[2] Bayerische Motoren Werke Aktiengesellschaft (the Opponent) opposes the application based on several grounds, including that the Mark is confusing with various trademarks of the Opponent allegedly “dominantly composed of the letter ‘M’”, as per the details reproduced in Schedule B to my decision.

[3] For the reasons that follow below, I find the opposition ought to be rejected.

THE RECORD

[4] The application for the Mark was filed on November 13, 2015 and claims a priority filing date of June 12, 2015, based upon the Applicant’s corresponding application in Italy.

[5] The application was advertised for opposition purposes in the *Trademarks Journal* on November 2, 2016.

[6] On April 3, 2017, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). This Act was amended on June 17, 2019. All references herein are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date).

[7] The statement of opposition originally included grounds of opposition based upon sections 2 (non-distinctiveness); 12(1)(d) (non-registrability); 16(3)(a) and (b) (non-entitlement); and 30(b), (e) and (i) (non-compliance) of the Act. However, the sections 30(e) and (i) grounds

of opposition were struck by the Registrar by way of an interlocutory ruling made on June 8, 2017.

[8] The Applicant filed and served a counter statement denying each ground of opposition pleaded in the statement of opposition.

[9] In support of its opposition, the Opponent filed certified copies of the Canadian trademark registrations and applications relied upon in its statement of opposition.

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

[11] Neither party filed written representations, and no hearing was held.

ANALYSIS

The parties' respective burden or onus

[12] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

[13] Applying these principles to the present case, some of the grounds of opposition can be summarily rejected for the Opponent having failed to satisfy its initial evidential burden in respect thereof, as explained below.

Grounds of opposition summarily rejected

Non-compliance of the application with section 30(b) of the Act

[14] The Opponent has pleaded that the application does not conform to the requirements of section 30(b) of the Act in that the Mark had been used in Canada by the Applicant in association with the applied-for goods, in the ordinary course of trade, prior to the priority filing date of the application in Canada. However, there is no evidence that supports this ground of opposition.

Non-distinctiveness under section 2 of the Act

[15] The Opponent has pleaded that the Mark is not distinctive as it does not actually distinguish the applied-for goods of the Applicant from the goods and services of the Opponent, nor is it adapted so as to distinguish them as it is confusing with the Opponent's trademarks as set out in sections I, II and III of Schedule B attached hereto.

[16] To meet its evidential burden under this ground, the Opponent had to show that its trademarks had been used or become known in Canada as of the filing date of the statement of opposition so as to negate the distinctiveness of the Mark [*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427]. However, the Opponent has not filed any evidence demonstrating the extent to which any of its trademarks have been used or become known in Canada.

[17] In this regard, I note that the mere filing of a certificate of registration of a trademark is not sufficient to meet the initial onus upon an opponent under a ground of opposition based upon section 2 of the Act [*Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)].

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

[18] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because, as of the priority filing date of the application in Canada, it was confusing with the Opponent's trademarks as set out in sections I and II of Schedule B attached hereto, which were used prior to the priority filing date in Canada by the Opponent and were not abandoned as of the advertisement date of the Applicant's application.

[19] To meet its evidential burden under this ground, the Opponent had to show that, as of the priority date of filing of the Applicant's application, its trademarks 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]. However, as indicated above, the Opponent has not filed any evidence of use of its trademarks.

[20] Here again, I note that the mere filing of a certificate of registration of a trademark is not sufficient to meet the initial onus upon an opponent under a ground of opposition based upon section 16(3)(a) of the Act [*Rooxs, Inc v Edit-SRL* (2002), *supra*].

Remaining grounds of opposition

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

[21] The Opponent has pleaded that the Mark is not registrable in view of the provisions of section 12(1)(d) of the Act in that it is confusingly similar to the Opponent's registered trademarks as set out in section I of Schedule B attached hereto.

[22] I have exercised the Registrar's discretion to confirm that the Opponent's registrations are in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[23] Hence, the Opponent has met its evidential burden in respect of this ground of opposition. The Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trademarks.

The test for confusion

[24] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[25] Thus, section 6(2) of the Act does not concern the confusion of the trademarks themselves, but of the goods or services from one source as being from another. In the present case, the question is essentially whether a consumer, with an imperfect recollection of the Opponent's registered trademarks, who sees the Applicant's applied-for goods in association with the Mark, would think that they emanate from, are sponsored by or approved by the Opponent.

[26] 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 trademarks and the extent to which they have become known; (b) the length of time the trademarks 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 trademarks 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 are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion].

The inherent distinctiveness of the trademarks and the extent to which they have become known

[27] In general, trademarks comprised of letters of the alphabet or numbers with little additional distinctive indicia are considered to be inherently weak and are not entitled to a wide ambit of protection [*GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FC); and *Noxzema Chemical Co of Canada Ltd v Estee Lauder Cosmetics Ltd* (1975), 23 CPR (2d) 214 (TMOB)].

[28] In the present case, I do not find any of the Opponent's registered trademarks to be inherently strong because each is comprised of the letter "M" either alone in a stylized lettering (arguably conveying the idea of movement), or in combination with a number and/or other word elements that are also of low inherent distinctiveness in the context of the Opponent's registered goods. For example, M ROADSTER is suggestive of the Opponent's automobile related goods.

[29] While the Applicant's Mark also comprises the letter "M", I consider it stronger than the Opponent's marks because it is nested within a fanciful representation of a cock or chicken, and somewhat represents a part of that animal's body, which contributes to the inherent distinctiveness of the Mark.

[30] The strength of a trademark may be increased by means of it becoming known through promotion or use in Canada. However, there is no evidence that either of the parties' trademarks has been used or become known in Canada to any extent. Here again, 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 [*Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

The length of time the trademarks have been in use

[31] As the Applicant has not filed any evidence of use of the Mark since its date of filing, and there is no evidence for concluding to continuous use of the Opponent's registered trademarks in Canada, this factor does not favour either party.

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

[32] When considering the nature of the goods and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods and/or services in the registrations relied upon by the Opponent [*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.

[33] The Opponent's registered goods and/or services generally relate to automobiles, automobile parts, automobile accessories, as well as the retail sale of automobiles and/or their parts and accessories. Some of the Opponent's registered goods also include clothing items, key chains, lapel pins, scale model cars, toy vehicles, backpacks, sport bags and travel bags.

[34] The Applicant's application covers a wide range and variety of goods, including "rings, not of metal, for keys", and goods classified under Nice class 12 relating to vehicles, such as "baby strollers"; "safety seats for children for automobiles"; "automobile seat cushions"; "bicycles"; "sports cars"; "go-carts"; "steering wheels for vehicles"; "motorcycles"; "upholstery for vehicles"; "anti-theft alarms for vehicles"; "safety devices for automobiles, namely, air bags"; "luggage carriers for vehicles"; "fitted covers for vehicles"; etc.

[35] That said, in the absence of written representations and of a hearing, it is difficult to determine to which of the Applicant's applied-for goods precisely the Opponent objects to.

[36] While I do find that there is at least some overlap between some of the parties' goods, I find it is not necessary to undertake a detailed analysis of the Applicant's statement of goods in order to precisely identify which of the applied-for goods overlap, either directly or indirectly, with the Opponent's registered goods and/or services and to what extent their corresponding channels of trade may also overlap, in view of my ultimate conclusion on the likelihood of confusion below.

The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them

[37] 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".

[38] Moreover, as previously mentioned, 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" [*Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA), at para 34]. I also must take into consideration the fact that the first portion of a trademark is often considered the most important one for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[39] Applying those principles to the present case, I find that the parties' marks bear little to no resemblance.

[40] The Mark has two components namely, the letter "M" and the fanciful representation of a cock or chicken, which are both fairly equally dominant. The Mark does not have any clear meaning in the context of the applied-for goods.

[41] The Opponent's registered trademarks, on the other hand, are comprised of the letter "M" either alone in a stylized lettering (arguably conveying the idea of movement), or in combination

with a number and/or other word elements of equal prominence, including for example M4, X6 M, M TWIN POWER TURBO, M ROADSTER, etc. The letter “M” does not have any clear meaning in the context of the Opponent’s registered goods and/or services.

[42] With respect to the marks as sounded, while I acknowledge that it may be that there would be no pronunciation of the design element of the Mark, and therefore, that the Mark and the Opponent’s registered trademarks that are comprised solely of the letter “M” in a stylised lettering (namely registration Nos. TMA766109, TMA744663, and TMA336985) would be sound the same, the fact remains that these latter three registrations of the Opponent are not for the letter “M” *per se*, but for that letter in a stylized lettering. That said, I find that the phonetic similarity that may exist between these particular trademarks of the Opponent and the Mark do not outweigh the significant differences existing between the parties’ marks in terms of appearance.

Additional surrounding circumstances - Family of trademarks

[43] As indicated above, it is the Opponent’s position that it is the owner of “a family of trademarks dominantly composed of the letter ‘M’”.

[44] However, there can be no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must establish that it is using more than one or two trademarks within the alleged family (a registration or application does not establish use) [*Techniquip Ltd v Canadian Olympic Assn* (1998), 1998 CanLII 7573 (FC), 145 FTR 59 (FCTD), *aff’d* 250 NR 302 (FCA); and *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)]. As the Opponent has filed no evidence of use, it has not established that it has a family of marks.

Conclusion regarding the likelihood of confusion

[45] Having considered all of the surrounding circumstances, I find that the Applicant has met its onus to show, on a balance of probabilities, that the Mark is not likely to cause confusion with any of the Opponent’s registered trademarks. I reach this conclusion as I find the sections 6(5)(a) (inherent distinctiveness) and 6(5)(e) (differences existing between the parties’ trademarks)

factors outweigh any potential for overlap with respect to some of the parties' goods and their channels of trade. Accordingly, the section 12(1)(d) ground of opposition is hereby rejected.

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

[46] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because, as of the priority filing date of the present application in Canada, it was confusing with the Opponent's pending applications as set out in section III of Schedule B attached hereto, which were filed prior to the priority filing date in Canada by the Opponent and remained pending as of the advertisement date of the present application.

[47] To meet its evidential burden under this ground of opposition, the Opponent had to show that its applications were filed prior to the priority filing date of the Applicant's application and were pending when the Applicant's application was advertised [section 16(4) of the Act].

[48] The Opponent has met its evidential burden in respect of this ground of opposition.

[49] My findings above under the ground of opposition based on section 12(1)(d) remain applicable here. In fact, I find the Applicant's case is even stronger as none of the Opponent's pleaded trademark applications are for the letter "M" alone in a stylized lettering, and the statements of the goods covered by the Opponent's trademark applications are narrower than the ones covered by its trademark registrations.

[50] Accordingly, the section 16(3)(b) ground of opposition is hereby rejected.

DISPOSITION

[51] 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.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Statement of goods (as revised), covered by the present application (including Nice classes)

(IC 12) Baby strollers; foldable baby strollers; covers for baby strollers; baskets for baby strollers; harness for baby strollers; canopies for baby strollers; linings for baby strollers; parasols to be affixed to baby strollers; umbrellas to be affixed to baby strollers; baby carriages; covers for baby carriages; hoods for baby carriages; shields for baby carriages; baskets for baby carriages; harness for baby carriages; pads for baby carriages; shaped covers for baby carriages; baby carriages incorporating carry cots; baby carriages with removable infant carry cot; prams, being baby carriages; covers for prams; safety seats for children for automobiles; safety seats for use in vehicles; car seats for children; child restraints for vehicle seats; child safety harnesses for vehicle seats; car seat bases for children; child booster cushions for vehicle seats; stands for children's car seats; automobile seat cushions; seat covers for vehicles; security harness for vehicle seats; safety belts for vehicle seats; pet safety seats for use in vehicles; bicycles; bicycles for children; tandem bicycles; bicycle saddles; saddlebags adapted for bicycles; bicycle bells; baskets adapted for cycles; luggage carriers for bicycles; bicycle trailers; saddle covers for bicycles or motorcycles; bicycle seat posts; tricycles for children; delivery tricycles; small wagons for transporting children; sports cars; go-carts; steering wheels for vehicles; gliders; golf carts, being vehicles; shopping trolleys, being carts; pushchairs; vehicles, namely, scooters, motorized scooters, non-motorized scooters; motorcycles; paddles for canoes; parachutes; kick sledges; sleeping cars; yachts; fitted dashboard covers for vehicles; upholstery for vehicles; anti-theft alarms for vehicles; panniers adapted for cycles; safety devices for automobiles, namely, air bags; luggage carriers for vehicles; roof rack storage containers for land vehicles; ski carriers for cars; ski carriers for vehicles; bicycle racks for vehicles; luggage racks for attachment to vehicle hoods; luggage racks for attachment to vehicle trunks; drink holders for vehicles; fitted covers for vehicles; spare wheel covers; covers for vehicle steering wheels; shaped vehicle covers.

(IC 20) School furniture; furniture, namely, bedroom furniture, lawn furniture, patio furniture, living room furniture, kitchen furniture, dining room furniture, bathroom furniture; furniture of metal, namely metal camping furniture; upholstered furniture, namely sofas, armchairs, chairs; outdoor furniture; garden furniture; inflatable furniture; computer furniture; workstations having multi-use work surfaces for use in a wide variety of fields, namely custom-built computer workstations and custom-built office desks; wardrobes; furniture, namely, closets, index cabinets, showcases, washstands, carts for computers, benches, trolleys, trestles, screens for fireplaces, screens; cupboards; pantries, not of metal; shelves; sideboards; drawers, being furniture parts; chests of drawers; medicine cabinets; tables of metal; dressing tables; tea tables; massage tables; tables; writing desks; desks; nightstands; counters, being tables; ladders of wood or plastics; step stools, not of metal; furniture frames; furniture shelves; furniture partitions of wood; doors for furniture; furniture casters, not of metal; furniture fittings, not of metal; fitted furniture covers of fabric; furniture moldings; edgings of plastic for furniture; fitted furniture covers, not of fabric; plastic drawer lining material; seating furniture, namely sofa; divans, extendible sofas, sofa beds, settees, chaise longues, armchairs, chair beds, footrests, chairs, being seats; seats of metal, namely, chairs, tables, tall and bar stools; easy chairs; rocking chairs; recliners, being furniture; ergonomic chairs for seated massage; Japanese-style floor seats, namely, zaisu; stools; bathroom stools; chair legs; chair pads; portable back supports for use with chairs; children's furniture; beds; mattresses; futon mattresses; sleeping mats; sleeping bags;

sleeping bags for camping; pillows; cushions; stadium cushions; Japanese floor cushions, namely, zabuton; chair cushions; seat cushions; futons, being furniture; bed rails; bed bases; bed fittings, not of metal; storage racks for ski and sports equipment; storage racks for surfboards; baseball and softball bat racks; CD storage racks, being furniture; storage racks for storing works of art; shoe racks; shoe cabinets; keyboards for hanging keys; coat stands; towel stands, being furniture; hat stands; tie racks; book rests, being furniture; umbrella stands; magazine racks; door stops of wood; door stops of plastic; photograph frames made of paper; picture frames made of paper; picture frames; photograph frames; picture frames of precious metal; mirror frames; picture hangers, not of metal; embroidery frames; hand-held mirrors, being toilet mirrors; toilet mirrors; display stands; display cases for merchandise; furniture for displaying goods; display cases; jewellery organizer displays; newspaper display stands; fair stands, being display stands; mannequins; life-size forms of the human body to display clothes; costume display stands; costume stands; coat hangers; covers for clothing, being wardrobe; clothes rods; garment covers, being storage; clothes hooks, not of metal; cradles; infant beds; sleeping mats for use by children; mats for infant playpens; baby bolsters; head support cushions for babies; baby changing tables; wall-mounted diaper, being napkin, changing platforms; baby changing mats; high chairs for babies; booster seats; baby bouncers, being seats; portable baby bath seats for use in bath tubs; infant walkers; playpens for babies; baby gates; furniture, namely, safety gates of metal for babies, children, and pets; furniture, namely, safety gates, not of metal, for babies, children, and pets; crib bumpers; chests for toys; containers, not of metal, for commercial use, namely industrial packaging containers of rubber, of paper, of textile, commercial garbage containers, commercial beverage containers, commercial thermal insulated containers for food and beverages; floating containers, not of metal, namely refrigerated shipping containers; boxes of wood or plastic; caskets; non-metal furniture chests; hampers [baskets], namely laundry hampers, food hampers; non-metal baskets, namely bread baskets, waste paper baskets, sewing baskets, picnic baskets, gift baskets sold empty, flower baskets; packaging containers of plastic; party ornaments of plastic, namely plastic party decorations; holiday ornaments of plastic, other than tree ornaments, namely Christmas ornaments, birthday ornaments; gift package decorations made of plastic sold as a whole and containing Christmas decorations, and party decorations; figures of bone, ivory, plaster, plastic, wax and wood; figurines, being statuettes, of bone and ivory; figurines, being statuettes, of wood, wax, plaster and plastic; decorative window finials; statuettes of resin; desktop statuary made of bone, ivory, plaster, plastic, wax and wood; statues of bone, ivory, plaster, plastic, wax and wood; busts of wood, wax, plaster and plastic; busts of bone and ivory; sculptures of bone, ivory, plaster, plastic, wax and wood; works of art of wood, wax, plaster and plastic, namely statues, statuettes, figurines, sculptures; woven timber blinds, being furniture; slatted indoor blinds; indoor blinds of textile; interior textile window blinds; paper blinds; furniture, namely, indoor window blinds, being shades; blinds of reed, rattan or bamboo, being sudare; curtain hooks; curtain tie-backs; door handles, not of metal; furniture handles, not of metal; drawer pulls of plastics, wood, cork, reed, cane, wicker, horn, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and of substitutes for all these materials, namely resins; door knobs, not of metal; door knockers, not of metal; door fittings, not of metal; bag closures, not of metal; closures for containers, not of metal, nor of plastic; non-metallic stoppers, namely bottle stoppers, cork and cork imitations stoppers, glass stoppers, rubber stoppers for industrial packaging containers; bottle caps, not of metal; corks for bottles; playhouses for pets; kennels for household pets; dog kennels; pet crates; pet cushions; non-electric ventilating fans for personal use; cabinet work; name badges of plastic; clear plastic


holders for badges; display boards; placards of wood or plastics; signboards of wood or plastics; rings, not of metal, for keys; towel dispensers, fixed, not of metal; drawer dividers; pedestals, namely lavatory and sink pedestals; flower-pot pedestals; plant stands; plant hangers, not of metal; brush mountings; non-metal trays, namely paper trays, desk trays, letter trays, serving trays, meal trays, crumb trays, pen trays.

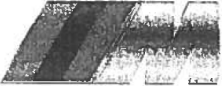

(IC 32) Table waters; beverages, namely, mineral water; aerated water; still water; flavoured mineral water; energy drinks; isotonic beverages; sports drinks; non-alcoholic beverages, namely cocoa-based beverages, coffee-based beverages, fruit juice beverages, honey-based beverages, milk beverages containing fruits, tea-based beverages, fruit-flavored beverages, chocolate-based beverages, non-dairy soy beverages; carbonated beverages, non-alcoholic; colas, being soft drinks; lemonades; soda water; tonic water; low calorie soft drinks; non-alcoholic beverages flavoured with tea; coffee-flavoured soft drinks; non-alcoholic fruit juice beverages; fruit-based soft drinks flavoured with tea; fruit-flavoured soft drinks; non-alcoholic beverages containing fruit juices; smoothies; fruit smoothies; vegetable smoothies; fruit nectars, non-alcoholic; fruit juices; aloe vera juices; sherbets, being beverages; aperitifs, non-alcoholic; cocktails, non-alcoholic; beer-based cocktails; beer-based beverages; low-alcohol beer; de-alcoholised beer; non-alcoholic wine; rosolio, being non-alcoholic beverages; syrups for beverages; non-alcoholic fruit extracts; essences for making beverages; preparations for making aerated water; preparations for making mineral water.

SCHEDULE B



Opponent's trademarks


I - The Opponent's registered trademarks (as reproduced from the statement of opposition)

Trademark	Serial Number	Owner Name
powered by M logo powered by 	App 1695771 Reg TMA921309 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Engine oils, gear oils, hydraulic oils, lubricants, lubricating greases, brake fluids, transmission fluids.		
M TWIN POWER TURBO	App 1696777 Reg TMA920831 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Engine oils, gear oils, hydraulic oils, lubricants, lubricating greases, brake fluids, transmission fluids.		
M4	App 1606595 Reg TMA920649 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts		
M235	App 1546868 Reg TMA897816 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and structural parts therefor.		
M Performance	App 1534753 Reg TMA881065 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Engine exhaust systems comprised of pipes, collectors, mufflers; automobiles and parts therefor, namely bumpers, door sills, steering wheels, spoilers, seats, engines, chassis, wheels, badges.		
M235i	App 1527220 Reg TMA876106 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles.		
M50d	App 1491139 Reg TMA855136 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles.		


Trademark	Serial Number	Owner Name
M Design 	App 1427101 Reg TMA766109 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts. (2) Key rings, lapel pins. (3) Car user manuals, brochures, books, stickers. (4) Backpacks, sports bags, travel bags. (5) Casual clothing, athletic clothing, outdoor jackets and windbreakers, caps; scale model cars, toy vehicles. (1) Repair, maintenance and installation services in the field of automotive. (2) Organization of car enthusiast clubs; organizing and hosting of automobile themed parties and celebrations; driver training.		
X5 M	App 1411279 Reg TMA803589 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Motor vehicles, namely automobiles, sports utility vehicles and light trucks, and their parts (except for inner tubes and tires).		
X6 M	App 1411280 Reg TMA803912 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Motor vehicles, namely automobiles, sports utility vehicles and light trucks, and their parts (except for inner tubes and tires).		
M Logo 	App 1383128 Reg TMA744663 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts. (2) Casual clothing, athletic clothing, outdoor jackets and windbreakers, caps; scale model cars, toy vehicles. (3) Key chains, lapel pins. (4) Car user manuals, brochures, books, stickers. (5) Backpacks, sports bags, travel bags. (1) Retail services in the field of automobiles and parts and accessories therefor. (2) Organization of car enthusiast clubs; organizing and hosting of automobile themed parties and celebrations; driver training.		

Trademark	Serial Number	Owner Name
M6	App 1296845 Reg TMA706649 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts.		
M SPORT PACKAGE	App 1274093 Reg TMA708012 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts.		
M PERFORMANCE EDITION	App 1274233 Reg TMA707240 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts.		
M EXECUTIVE PACKAGE	App 1274092 Reg TMA708011 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts.		
M ROADSTER	App 1273588 Reg TMA708002 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts.		
M COUPE	App 1273589 Reg TMA708010 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts.		
M NIGHT	App 1269440 Reg TMA706454 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Retail services in the field of automobiles, motorcycles, and parts and accessories therefor; retail services in the field of fashion accessories, lifestyle articles, sporting articles and clothing; organizing and hosting of automobile themed parties and celebrations.		

Trademark	Serial Number	Owner Name
M - THE MOST POWERFUL LETTER	App 1263900 Reg TMA664875 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts. (1) Organization of car racing and car club events.		
M - THE MOST POWERFUL LETTER IN THE WORLD	App 1263902 Reg TMA664704 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts. (1) Organization of car racing and car club events.		
M SERIES	App 1173967 Reg TMA614701 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts.		
M5	App 1018419 Reg TMA561482 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Motor vehicles, namely, automobiles and their parts.		
M3	App 1018420 Reg TMA544922 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts.		
M & DESIGN 	App 519467 Reg TMA336985 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles, parts for automobiles.		
M TECHNIC DESIGN 	App 507088 Reg TMA376313 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Parts of land vehicles including shock absorbers, springs, stabilizers, steering wheels, air conducting devices namely spoilers.		

Trademark	Serial Number	Owner Name
M POWER DESIGN 	App 507086 Reg TMA329972 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts, namely engines.		
M240	App 1672939 Reg TMA961460 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles.		
BMW M	App 1649880 Reg. TMA929812 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their parts, namely, structural parts, wheels, steering wheels, door sills, gear shift knobs, headrests, seats, tire valve stem caps, license plate frames, badges for motor vehicles being trim; automotive body kits comprising external structural parts of automobiles; engines for motor vehicles. (1) Retail store services featuring motor vehicles, motor vehicle parts and accessories. (2) Repair and maintenance of motor vehicles.		
M2	App 1617360 Reg. TMA930186 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts		
M550	App 1547292 Reg. TMA959525 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and structural parts therefor.		
M40	App 1541247 Reg. TMA927990 Registered	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles.		

II – The Opponent’s **non-registered** trademarks, which have allegedly been used by the Opponent in Canada (as reproduced from the statement of opposition)

Trademark	Goods and Services
M	Automobiles and their parts. Bicycles and their parts. Accessories for Automobiles and bicycles. Retail sales of automobiles and their parts/accessories. Repair and maintenance of motor vehicles.
BMW M	Automobiles and their parts. Bicycles and their parts. Accessories for automobiles and bicycles. Retail sales of automobiles and/or their parts/accessories; repair and maintenance of motor vehicles.
M POWER	Automobiles, engines and their parts. Accessories for Automobiles. Retail sales of automobiles, engines and parts/accessories therefor; repair and maintenance of motor vehicles.
M SUSPENSION	Automobile parts and accessories. Retail sales of automobile parts/accessories.
M SPORT SEATS	Automobile parts and accessories. Retail sales of automobile parts/accessories.
M STEERING WHEEL	Automobile parts and accessories. Retail sales of automobile parts/accessories.
M WHEELS	Automobile parts and accessories. Retail sales of automobile parts/accessories.
M SPORT	Automobile, parts and accessories for automobiles. Retail sale of automobiles, parts and accessories for automobiles.
M Logo 	Bicycles and parts and accessories. Automobile accessories.

III – The Opponent’s pending trademark applications that were filed prior to the June 12, 2015 priority date of the Applicant’s application for the Mark (as reproduced from the statement of opposition)

Trademark	Serial Number	Owner Name
M140	App 1672941 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles.		

Trademark	Serial Number	Owner Name
M1	App 1617359 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts		
M7	App 1617361 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts		
M8	App 1617362 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts		
M9	App 1617363 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts		
M10	App 1617366 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and their constituent parts		
M750	App 1547378 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and structural parts therefor.		
M650	App 1547290 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles and structural parts therefor.		
M55	App 1541246 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles.		
M60	App 1541038 Allowed (Pending)	Bayerische Motoren Werke Aktiengesellschaft
Goods and Services (1) Automobiles.		

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

No Hearing Held

AGENTS OF RECORD

GOWLING WLG (CANADA) LLP

For the Opponent

ROBIC

For the Applicant