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THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 128

Date of Decision: 2020-11-17

IN THE MATTER OF AN OPPOSITION

WiringPro Corporation Inc.

Opponent

and

Sensolutions Inc.

Applicant

**1,548,572 for MAKE THE
CONNECTION**

Application

INTRODUCTION

[1] Sensolutions Inc. (the Applicant) has applied to register the trademark MAKE THE CONNECTION (the Mark) in association with the following goods based on a claim of use of the Mark in Canada since as early as June 2009:

Cable connectors, namely for automotive electrical and electronic cables and wires; printed circuit board connectors, namely for automotive electrical circuits and automotive electronic connectors cables and wires; electrical and electronic automotive cables and wires; electrical and electronic automotive cable adaptors; electrical and electronic automotive cable connector housings, cable strain reliefs; light adaptor housings for electrical and electronic automotive connectors cables and wires; cigarette light adaptor housings for electrical and electronic automotive connectors cables and wires; electronic devices, namely automotive diagnostic equipment that connect an automotive diagnostic link connectors and automotive telematics equipment to a computing device. (the Goods)

[2] WiringPro Corporation Inc. (the Opponent) owns a pending application for the trademark MAKE THE CONNECTION (the Opponent's trademark or the WP mark) in association with goods including "wire connectors". The Opponent's application was filed after the subject application, but claims an earlier date of first use in Canada.

[3] For the following reasons, I find that the application should be refused.

THE RECORD

[4] The application for the Mark was filed on October 20, 2011 and was advertised for opposition purposes in the *Trademarks Journal* of November 26, 2014. On January 20, 2015, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based on sections 30, 16, and 2 of the Act. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (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 this date).

[5] On March 14, 2015, the Applicant filed and served a counter statement denying the grounds of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Marilyn Fraser (solemnly affirmed on July 19, 2016). In support of its application, the Applicant filed the affidavit of Corinne Timmer (sworn on December 15, 2016). In reply, the Opponent filed the affidavit of Ivone Vieira (solemnly affirmed on December 27, 2017). Ms. Timmer was cross-examined on her affidavit.

[7] Both parties filed a written argument. Only the Opponent was represented at a hearing.

EVIDENTIAL BURDEN AND LEGAL ONUS

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

[9] With respect to (i) above, there is, in accordance with the usual rules of evidence, an evidential burden on an opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Limited v The Molson Companies Limited*, 1990 CanLII 11059 (FC), 30 CPR (3d) 293 at 298 (FCTD)]. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent in the statement of opposition (for those allegations for which an opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, on a balance of probabilities standard, then the issue must be decided against an applicant.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Grounds of opposition under section 30

[10] The material date for considering a ground of opposition under section 30 of the Act is the date of filing of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

Section 30(i)

[11] The Opponent has pleaded that the application does not conform to the requirements of section 30(i) of the Act because:

- (a) the Applicant could not have said that it was satisfied that it would be entitled to use the Mark in Canada in association with the goods set out in the Application. At the filing date, the Applicant was aware (or should have been aware) of the Opponent's prior rights in the WP mark, such mark being owned and used by the Opponent in Canada prior to the date of first use of the Applicant's Mark.

(b) the Applicant could not have been satisfied under paragraph 30(i) that it is entitled to use the Mark in association with the services described in the application as the Applicant was not the owner of the Mark applied for as at the filing date.

[12] 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 [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Even assuming that the Applicant was aware of the Opponent's ownership of its MAKE THE CONNECTION trademark (which has not been established), the mere knowledge of its existence does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [*Woot Inc v Woot Restaurants Inc/Les Restaurants Woot Inc*, 2012 TMOB 197]. In this case, the Applicant has provided the necessary statement, and this is not an exceptional case.

[13] With respect to the second prong, I note that it has been improperly pleaded as the applied-for Mark only covers goods and the allegations relate to services. In any event, even if it had been properly pleaded, as with the first ground, the Opponent would nonetheless have failed to meet its initial burden.

[14] Accordingly, the grounds of opposition under section 30(i) are summarily dismissed.

Section 30(b)

[15] The Opponent has pleaded that "the Applicant does not use and does not intend to use the Sensolutions Mark". While the Opponent has simply identified this ground of opposition under section 30 of the Act, I am prepared to accept it as a ground of opposition under section 30(b), given that it follows in part the wording of this section. Also, it is apparent that parts of the Opponent's cross-examination of Ms. Timmer and the Opponent's reply evidence are directed towards contesting whether it is the Applicant that has used the Mark in Canada (see Timmer cross-examination at Q89-97 and Vieira affidavit, para 3). Finally, in both its written argument and at the hearing, the Opponent made representations expressly citing section 30(b).

[16] The initial burden on an opponent is light respecting the issue of non-conformity with section 30(b) of the Act, because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. This burden can be met by reference not only to the opponent's evidence but also to the applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, an opponent may only successfully rely on the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claims set forth in the applicant's application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 30-38].

[17] At the hearing, the Opponent argued that the user of the Mark is not the Applicant, but rather a separate corporation, "Automotive Connectors, and Cables Corporation" (AC3). The Opponent submits that there is no evidence of any licensing between these two parties, with the result that any relevant use by AC3 does not constitute use by the Applicant. With this in mind, portions of the record are set out below.

Applicant's evidence – The Timmer affidavit

[18] Corinne Timmer has been the co-founder of the Applicant since its establishment in 2000 and became president and sole owner as of July 19, 2013 (paras 1, 2) (cross, Q8). She explains that the Applicant is in the business of the design and manufacturing of on-board diagnostic (OBD) connectors, cables, wires, adaptors and housings (the OBD Products) used in various automotive applications. The OBD Products are sold to the Applicant's customers through its Canadian office via its website located at *www.sensolutions.com* or through its sales representatives (para 3).

[19] With respect to the sale and shipment of OBD Products to customers, Ms. Timmer's affidavit provides the following:

- Ms. Timmer states that "on March 18, 2008, we shipped OBD Products in our branded packaging to Durametric Software Inc. located in the United States" (para 6). She describes Exhibit B as a "photograph of the packaging used to ship OBD Products to

Durametric on March 18, 2008 that clearly show the Mark”. I note that Exhibit B includes a photograph of a cardboard box bearing the Mark on one side. Another side of the box displays part number/quantity information corresponding to the objects that are in the box (cross, Q17-22).

- Exhibit D also shows photographs of the exterior box packaging used by the Applicant to ship OBD Products to customers in Canada and abroad (para 8). The display of the Mark on the box (as shown below) is the same as in Exhibit B (cross, Q25-29):



- The boxes display “Automotive Connectors and Cables Corporation”. They do not display “Sensolutions Inc.” (Exhibit D, Q30-31, 44-52, 90-91).
- Exhibit C is a copy of an invoice dated March 17, 2008, showing the sale of OBD Product being shipped to Durametric Software Inc. (para 7). Durametric Software is located in Oregon, USA (cross, Q34-37).

[20] Ms. Timmer provides additional copies of invoices, dating from 2008 – 2016, of OBD Products shipped to customers in Canada and abroad (Exhibit E). Some of the invoices display the Mark on the bottom right corner of the invoices (para 9, cross Q67).

[21] Ms. Timmer provides annual sales figures for the fiscal years 2008/2009 – 2016 (November) generated from the sale of OBD Products, as well as the total annual volume of sales (units) of OBD Products sold in and from Canada for this same period (paras 10, 11). I note that the total revenue generated from the sale of the OBD Products over this period is approximately 8 million CAD.

[22] Ms. Timmer advises that promotional items, namely business cards and day planners displaying the Mark, are sent to the Applicant's clients (para 13). Ms. Timmer provides copies of business cards identifying Martin Siebert as President at "Automotive Connectors, and Cables Corporation" and Corrine Timmer at "Sensolutions Inc." (Exhibit G). I note that both cards display the same address and phone number (with different extension numbers). The back of a business card is also provided and displays the Mark, though it is not indicated which card it applies to.

[23] In her affidavit, Ms. Timmer also states that on or about October 2011, Mr. Siebert, her husband and the co-founder of the Applicant, instructed its agent at that time, Illuminate IP, to file an application for the Mark with the Canadian Trademarks Office in association with the Goods, claiming a date of first use as early as June 2009 (para 5, cross at Q99-102). I note that Mr. Siebert has passed away (cross at Q102). On cross-examination, counsel for the Opponent requested that Ms. Timmer produce any correspondence between Mr. Siebert and Illuminate IP that would indicate why the date of June 2009 was chosen for the date of first use (Q103).

[24] In response to this request, counsel for the Applicant noted that this information might be protected by solicitor-client privilege. Counsel advised that he would need to make a determination of that, and subsequently undertook to consider the "issue of privilege" (U/T at page 25). The Applicant later filed, as a response to this undertaking, a letter with the Registrar indicating that the agent (with Illuminate IP) who had filed the subject application was a lawyer called to bar in British Columbia. However, this letter was not made of record as it was not properly filed (by the Opponent) as set out in the *Trademarks Regulations* in force at that time.

Cross-examination of Ms. Timmer

[25] Ms. Timmer made the following statements and admissions with respect to the relationship between the Applicant, Sensolutions Inc., and AC3:

88 Q. If I can take you to the first part of your affidavit, page 3, paragraph eight, you'll see here that the pictures we are looking at in Exhibit D are photographs of the packaging used by the applicant. Correct?

A. Right.

89 Q. And you are aware that the applicant is Sensolutions Inc.?

A. Right.

90 Q. And we have already agreed that Sensolutions Inc. isn't actually on the boxes that are depicted behind Exhibit D. Correct?

A. Correct.

91 Q. And that appears to be Automotive Connectors and Cables Corporation. Correct?

A. Correct.

92 Q. That is a different company than Sensolutions Inc. Correct?

A. No. That's just a division of Sensolutions.

93 Q. It says corporation on the words. Doesn't it?

A. Yes, and it's a division so –

94 Q. I'm sorry. I'm not asking you about divisions or any relation of these companies. What I'm asking you is it actually uses the word corporation. Correct?

A. Correct.

95 Q. And it has a website, www.ac3.ca. Correct?

A. Correct.

96 Q. That is not the same as the Sensolutions website. Is it?

A. It's related.

97 Q. It's not the same. Is it?

A. No, it's not perfectly the same, no.

98 Q. In fact, if you go to that website, it's headed Automotive Connectors and Cables Corporation. Isn't it?

A. AC3, correct.

...

106 Q. I'm going to ask a technical question. That is, Ms. Timmer, in your affidavit, you did not set out any explanation as to what the relationship if any between Automotive Connectors and Cables Corporation might be to the applicant, and I'm being very specific here. I'm saying in your affidavit, you didn't set out what the relationship was. Correct?

A. Correct.

Reply evidence – The Vieira affidavit

[26] Ivone Vieira is employed as a corporate searcher at the agent for the Opponent (para 1). She conducted searches to obtain full particulars for AC3 Automotive Connectors and Cable Corp. The corporate profile for this company is attached as Exhibit A to her affidavit (para 3).

[27] The corporate report search, dated October 10, 2017, identifies AC3 AUTOMOTIVE CONNECTORS & CABLE CORP. as a named Alberta corporation registered on August 6, 2003. The company lists “Corrine Siebert” as the sole director of the company (Exhibit A).

Analysis

[28] I find the Opponent has met its evidential burden of putting forward evidence, specifically the corporate search, which calls into issue the use of the Mark by the Applicant. As discussed below, I find that the evidence establishes use of the Mark, pursuant to section 4 of the Act, by AC3. I also find that such use by AC3 constitutes use of the Mark by the Applicant, with the result that the Applicant has met its legal onus with respect to section 30(b) of the Act.

The evidence establishes use of the Mark by AC3

[29] In my view, the evidence is sufficient to establish use of the Mark by AC3 pursuant to section 4 of the Act in association with various of the Goods since March 18, 2008, which is even earlier than June 2009, the date of first use claimed in the application. I do not consider this to be problematic as the case law recognizes that an application may claim a date subsequent to the actual date of first use “out of an abundance of caution” and “in the interest of greater certainty” [*Marineland v Marine Wonderland and Animal Park* (1974), 16 CPR (2d) 97 (FCTD)].

[30] I make this finding of use having regard to the evidence showing that on March 18, 2008, some of the Goods (connectors) were shipped in a cardboard box displaying the Mark to Durametric Inc., a customer in Oregon, thus constituting use by export under section 4(3) of the Act. The display of the Mark on the exterior box packaging in which the Goods were shipped to consumers in Canada also constitutes use of the Mark, pursuant to section 4(1) of the Act (for example, the sale and shipment of Goods (connectors) to a customer in Quebec dated 04/11/2008, per Invoice No. 5240, Exhibit E).

[31] In its written argument, the Opponent submits that the Mark has been displayed as a slogan rather than as a trademark. In this regard, I note that the fact that the Mark may be displayed or used as a slogan does not necessarily mean that it cannot be used as a trademark

[*Valeo Electrical Systems, Inc v Pennzoil-Quaker State Company*, 2011 TMOB 90]. To the extent that the Mark as it appears on the boxes is a slogan, I find that it is also used as a trademark, as discussed above.

[32] With respect to the inclusion of the Mark on some of the Applicant's invoices, it is not clear that these (or any) invoices accompanied the Goods at the time of transfer. Absent this information, it is unnecessary to consider whether the appearance of the Mark on such invoices constitutes use in association with the Goods listed on such invoices "in any other manner" per section 4(1) of the Act [*Tint King of California Inc v Registrar of Trade-marks et al*, 2006 FC 1440 (CanLII), 56 CPR (4th) 223 (FC)].

Use of the Mark by AC3 can be deemed to be use by the Applicant

[33] Section 50(1) of the Act requires the owner of a trademark to have direct or indirect control over the character or quality of the goods and services in order for the use of the trademark by a licensee to be deemed to be use by the owner. Section 50(1) does not require a written agreement. Evidence of control by the owner of the trademark can support the existence of an implied license agreement [*Well's Dairy Inc. v UL Canada Inc.* (2000), 2000 CanLII 15538 (FC), 7 CPR (4th) 77 (FCTD)].

[34] It is trite law that a corporate relationship, on its own, is insufficient to satisfy the requirement of section 50 of the Act [*MCI Communications Corp. v MCI Multinet Communications Inc.* (1995), 61 CPR (3d) 245 (TMOB); *Dynatech Automation Systems Inc. v. Dynatech Corp.* (1995), 64 CPR (3d) 101 (TMOB)]. However, the presence of a common controlling individual may be able to satisfy the requirement of section 50 of the Act [*Petro-Canada v 2946661 Canada Inc.* (1998), 83 CPR (3d) 129 (FCTD); *Lindy v Canada (Registrar of Trade-Marks)* (1999), 241 NR 362 (FCA)]. In this regard, it has been held that if the president or director or officer of a corporate owner is also the president or a director or officer of the user of the trademark, this may be sufficient to satisfy the control requirements of Section 50 of the Act [*TGI Friday's of Minnesota Inc. v. Canada (Registrar of Trade Marks)* (1999), 241 NR 362 (FCA); *Goodwill Industries International Inc v Vedett IP Corporation*, 2015 TMOB 212].

[35] I find that there is sufficient evidence that Ms. Timmer is such a common controlling individual. The evidence establishes that Ms. Timmer co-founded the Applicant (along with her spouse, Mr. Siebert), and became its President and sole owner as of July 19, 2013. The evidence also shows that Corinne Siebert (which appears to be Ms. Timmer's married name) is also the sole director of AC3 (Vieira affidavit, Exhibit A). I therefore find it reasonable to infer that AC3 used the Mark under license from the Applicant, or under an arrangement that was tantamount to a license from the Applicant, such that the Mark remained under the direct or indirect control of the Applicant. As such, I am satisfied that the use of the Mark shown by AC3 enures to the benefit of the Applicant.

[36] As an aside, I note that to the extent that the evidence also indicates Mr. Siebert's past involvement with the Applicant (Timmer affidavit, para 5) and AC3 (Timmer affidavit, Exhibit G), I would similarly infer common control favourable to the Applicant.

No negative inference drawn – undertaking at cross-examination

[37] In its written submissions, the Opponent notes that at cross-examination, it requested an undertaking from the agent for the Applicant to produce the file from the Applicant's former agent to ascertain the basis for the date of first use set out in the application, but this was not provided, based on a privilege objection. The Opponent takes the position that at the relevant times trademark agent correspondence (even to an agent also qualified as a lawyer) was not privileged, and that even if the file was privileged, the facts regarding the date of first use are not. The Opponent submits that a negative inference must therefore be taken that there was no proper basis in the file, or otherwise, for the date of first use set out in the application.

[38] I do not consider it necessary to consider this argument as the Applicant's evidence is sufficient to meet its legal onus of proving that it had used the Mark as of the date claimed. Even if I am wrong in failing to consider this argument and drawing no negative inference, this is of no consequence in the overall outcome of this case.

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

Ground of opposition under section 16

[40] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark since, contrary to sections 38(2)(c) and 16(2)(a) of the Act, the Mark was confusing with the Opponent's trademark previously used in Canada by the Opponent and its predecessors in title in respect of the Opponent's goods.

[41] As the subject application is based on use in Canada, this ground of opposition should have been pleaded under section 16(1)(a) of the Act. However, since the ground was otherwise set out in sufficient detail for the Applicant to reply, I am prepared to treat this as a typographical error and consider this ground as if it had been properly pleaded.

[42] As discussed above, although the application claims a date of first use of June 2009, the Timmer affidavit establishes use of the Mark by the Applicant as early as March 18, 2008. I consider that this date then becomes the date for determining prior entitlement rather than the later date claimed in the application [see *Allan Candy Co v Hostess Food Prods. Ltd* (1986), 9 CPR (3d) 461 at 463 (TMOB), citing *DeCaria Hair Studio Ltd Massimo De Berardinis et al* (1984), 2 CPR (3d) 309 at p 312]. Accordingly, to meet its initial burden, the Opponent must establish use of its MAKE THE CONNECTION trademark prior to March 18, 2008.

[43] In its written argument, the Opponent submits that the Fraser affidavit shows that the "Opponent has used the trademark MAKE THE CONNECTION on its product packaging since before March 31, 2009, but no earlier than February 20, 2009" as the final design of the packaging was approved on February 2009. Some other materials including the Opponent's logo, business cards and stationery bore the MAKE THE CONNECTION brand since as early as 2008" (emphasis added). The Opponent's February/March 2009 allegations (emphasized above) postdate the Applicant's March 2008 use, so even if I were to accept these allegations of use on product packaging, such use would not be prior to the date of first use established by the Applicant in its evidence.

[44] With respect to the "other materials" including logo, business cards and stationery bearing the Mark since 2008, I note that the Fraser affidavit refers to them as files on the Opponent's computer system, that were last modified between October-December 2008,

incorporating the Opponent's mark (para 10, Exhibit M). Copies of the contents of these files are attached as exhibits to the Fraser affidavit and appear to be mock-ups of materials including a logo, sticker, notepad, letterhead, and card (Exhibits N-R). However, without further information, for example showing how these materials would have been associated with the Opponent's goods at the time of transfer, I find them insufficient to show use of the Opponent's mark under section 4 of the Act. Nor would it appear that the Opponent is attempting to rely on this evidence to establish prior trademark use since it has focused on the Opponent's evidence of approved new packaging mock-ups from February 2009 in establishing its timeline of use "since at least as early as March 31, 2009".

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

Ground of opposition under section 2

[46] The Opponent has pleaded that the Mark is not distinctive because it is confusing with the Opponent's MAKE THE CONNECTION trademark which had been "previously filed, registered, used and made known in Canada by the Opponent in association with the Opponent's services as set out above, and therefore not distinctive of (nor is it adapted to distinguish) the Applicant's advertised proposed services".

[47] This ground of opposition has been improperly pleaded in that it refers to the services of the Opponent and the Applicant, since the Application only lists goods, and the Opponent has not identified that it offers any services, but rather goods. However, I am prepared to treat this as a typographical error, particularly since the Applicant in its written submissions has simply replaced the references to "services" with "goods" in its recitation of the pleadings.

[48] The material date to assess this ground of opposition is the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185, 34 CPR (4th) 317 (FC)]. I find the Opponent's evidence discussed below is sufficient to meet its evidential burden to establish that its trademark had become known sufficiently in Canada as of January 20, 2015 to negate the distinctiveness of the Mark [*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)].

Opponent's evidence – The Fraser affidavit

Preliminary Matter-Hearsay objection to portions of the Fraser affidavit

[49] Marilyn Fraser is the Financial and Human Resources Manager of the Opponent, and has worked with the Opponent for approximately twenty years (para 1). In its written argument, the Applicant has noted that the Fraser affidavit contains hearsay evidence as Ms. Fraser relies on information provided orally by Leslee Hrapchak, the marketing coordinator of the Opponent. The Applicant submits that this evidence should therefore be disallowed.

[50] While I agree that the information provided by Ms. Hrapchak constitutes hearsay, Ms. Fraser does provide reasons why a person having direct knowledge could not have provided the evidence. She explains that the principal of the Opponent, who had full and direct knowledge of the Opponent's trademarks in Canada, was supposed to affirm the affidavit but was unable to do so due to medical reasons. Given his unexpected unavailability, and time constraints, in swearing the affidavit, it was necessary for Ms. Fraser to inform herself of some of the issues relating to this matter by speaking with Ms. Hrapchak, the Opponent's marketing coordinator. In view of the foregoing, I am of the view that the requirements of necessity and reliability have been met and so consider those portions of the Fraser affidavit relying on information provided by Ms. Hrapchak to be admissible [*R v Khan*, 1990 CanLII 77 (SCC), [1990] 2 SCR 531 (SCC)].

Fraser affidavit

[51] Ms. Fraser's affidavit provides the following evidence:

- The Opponent is an Ontario-based corporation headquartered in Mississauga, specializing in the manufacture, sale and servicing of electrical wiring products, including terminals, connectors, fuse adaptors and quick disconnect terminals. In addition to utilizing various distributors throughout Canada, the Opponent sells its products directly to consumers through its website *www.wiringpro.com* (para 4).
- The Opponent has filed an application to register the trademark MAKE THE CONNECTION in association with, among other things, wire terminals, connectors, snap plugs, and quick disconnect terminals (para 5, Exhibit B).

- Ms. Fraser states that as indicated in the Opponent’s application for the trademark MAKE THE CONNECTION, it has used the trademark in Canada since at least as early as March 31, 2009 and still uses the mark currently. She states that for example, the trademark is prominently displayed in the header of the Opponent’s website underneath the Opponent’s name, forming the Opponent’s logo (Exhibit C):



- Exhibits D through J are mock-ups of packaging designs for products sold by the Opponent, all of which display the Opponent’s trademark in the manner shown above. The designs were approved for use on February 19, 2009, and Ms. Fraser is advised by Ms. Hrapchak that they were “shortly thereafter put into the market (once approved, any newly packaged products are labelled with these designs)”.
- Ms. Fraser provides representative photographs of some of the Opponent’s wiring products (including connectors) in packaging displaying the Opponent’s mark (Exhibit K). Ms. Fraser understands from Ms. Hrapchak that these photographs were taken in or around the summer and fall of 2015. Ms. Fraser states that these products show some of the approved designs as they are currently used by the Opponent (July 2016), and that the products sold in 2009 would have looked the same or very similar to these photographs (para 8). I note that while the Applicant, in its written argument, submits that it is unable to see any use of the Mark in these photographs, I find it to be visible, though presented in small font.
- Ms. Fraser provides copies of two invoices, dated November and December 2009, showing sales of various of the Opponent’s products to Canadian consumers (para 9, Exhibit L). I note that the Opponent’s mark appears on the top left corner of the invoices.
- Ms. Fraser provides a chart summarizing annual sales of the Opponent’s wiring products since 2008 (para 12). She states that the new packaging was created in or around February 2009 when the above-noted designs were approved, so the annual sales

provided therefore reflect the MAKE THE CONNECTION branded products, though there was some old packaging still in the supply chain until the 2009/2010 year (para 13). Annual sales for the 2009/2010 fiscal year were approximately \$480,000. By 2014/2015, annual sales were approximately \$814,000. I note that the total revenue generated from the sale of the Opponent's products from the years 2009/2010 – 2014/2015 years is approximately 3.9 million CAD. No breakdown of units sold or information on average unit price is provided, though there is some information on unit pricing on the invoices at Exhibit L.

[52] Notably, the Opponent has provided little information relating to advertising. No advertising expenditures are included, and while reference is made to the trademark 'currently' appearing on the Opponent's website (circa July 2016, the date of swearing of the affidavit), there is no indication of when this began, how long this has occurred, and the number of Canadian consumers that may have accessed the website. However, in view of the annual sales of the Opponent's products in association with its trademark (nearly six years up to the material date) and the fact that the Opponent's trademark appears on the packaging and on related materials such as invoices, I find that the Opponent's trademark had become known sufficiently in Canada by the filing date of the opposition to negate the distinctiveness of the Mark.

[53] As I am satisfied that the Opponent has met its burden under this ground, I must now determine whether the Applicant has met its onus of proving, on a balance of probabilities, no reasonable likelihood of confusion between its Mark and the Opponent's MAKE THE CONNECTION trademark.

Confusion Analysis

[54] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods or services are of the same general class or appear in the same Nice Class. In making such an assessment, I must consider all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trademarks and the

extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[55] In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 SCR 824 at paragraph 20, the Supreme Court of Canada set out how the test is to be applied:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[56] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at paragraph 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[57] Importantly, section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's Goods, provided under the trademark MAKE THE CONNECTION, would believe that those Goods were being provided by the Opponent, or that the Applicant was authorized or licensed by the Opponent who offers wiring products under the trademark MAKE THE CONNECTION.

[58] In the present case, and in the absence of significant representations on this issue from either party, I do not consider it necessary to engage in a lengthy confusion analysis. The parties' trademarks are identical in appearance, sound, and idea suggested. Neither of the parties' marks are inherently strong as both are suggestive of the parties' connector/connector-related goods.

[59] Regarding the extent known and length of time in use, this factor does not significantly favour either party. While the Applicant is the earlier user of the Mark (2008), the Opponent's trademark use began in 2009. Neither party has provided significant information relating to advertising expenditures or initiatives for their respective trademarks.

[60] With respect to the nature of the goods, there is some overlap to the extent that both parties offer wiring and cable products, including connectors. However, the Applicant's Goods are restricted to automotive applications, and have a specialized customer base. The Applicant indicates that its customers range from home mechanics to small businesses and large companies, and many of its customers use its products as a base to provide aftermarket solutions to a wide range of automotive brands (Timmer affidavit, para 3). In contrast, the Opponent's goods are not similarly restricted and so would appear to be for general application. Both parties indicate that their respective goods are sold through their company websites and through "sales representatives" (Timmer affidavit, para 3) or "various distributors" (Fraser affidavit, para 4). Without more, it is difficult to assess whether there are (or could be) overlapping channels of trade.

[61] As an additional surrounding circumstance, the Applicant in its written argument has noted that the Opponent has submitted no evidence of actual confusion despite the co-existence of the parties' marks in the marketplace. In this case, I am not satisfied that the Opponent's failure to file evidence of actual confusion favors the Applicant in view of the lack of evidence that the parties' goods have been offered for sale in the same channels of trade. Additionally, both parties have evidenced use of the MAKE THE CONNECTION mark in conjunction with a large and prominent house brand. The presence of the house brands as used may explain the lack of actual confusion [see *Gurwitch Products, LLC v Groupe Marcelle Inc*, 2014 TMOB 22].

[62] Considering all of the surrounding circumstances as discussed above, in particular that the parties' marks are identical in appearance, sound, and ideas suggested, and have some overlap in the nature of the goods, I find that the Applicant has not satisfied its onus of establishing on a balance of probabilities that there is no reasonable likelihood of confusion as between the Mark and the Opponent's MAKE THE CONNECTION trademark. Accordingly, this ground of opposition is successful.

Remark - Further ground of opposition under section 2

[63] In its written argument, the Opponent refers to a second ground under which the applied-for Mark is not distinctive "due to the use by AC3". The Opponent submits that there is no evidence in the record of any licensed use by AC3, or that in fact that the Applicant was the first

user of the Mark, if indeed it is used as a trademark, which is denied. However, as established in *Le Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 2011 FC 118, 95 CPR (4th) 249, the Registrar has no jurisdiction to adjudicate on a ground of opposition not specifically pleaded in a statement of opposition. As a result, I have not considered this allegation, though I note that in any event, the Opponent would not have met its evidential burden for this ground as I have found that use of the Mark by AC3 is trademark use that enures to the benefit of the Applicant.

DISPOSITION

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

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2020-07-23

APPEARANCES

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FOR THE OPPONENT

No one appearing

FOR THE APPLICANT

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