



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 130**

**Date of Decision: 2020-11-25**

**IN THE MATTER OF AN OPPOSITION**

**PODS Enterprises, LLC**

**Opponent**

**and**

**Qwik Contain Solutions Inc.**

**Applicant**

**1,742,509 for MODPOD & Design**

**Application**

OVERVIEW

[1] PODS Enterprises, LLC (the Opponent) is an international business that provides moving and storage services, including the provision of containers for the storage and transportation of goods. The Opponent conducts its business in Canada in association with the registered trademarks PODS (TMA672,471) and PODS Logo (TMA721,151).

[2] The Opponent has opposed application No. 1,742,509 (the Application) filed by Qwik Contain Solutions Inc. (the Applicant) for the trademark MODPOD & Design (the Mark), depicted below, in association with similar goods and services to those of the Opponent.



[3] For the reasons set out below, the Application is refused as the Applicant has not met its burden to demonstrate that there is no likelihood of confusion between the parties' trademarks.

#### THE RECORD

[4] The Application was filed on August 19, 2015 and lists the following goods and services (the Goods and Services):

##### **Goods**

(1) Collapsible modular metal containers for the storage, warehousing, transportation of household, commercial, industrial purposes and waste.

(2) Storage container accessories, namely, metal storage containers for the modular storage containers, large or small ramps, metal security doors, shelving sets, skylight panel, windows of metal, window shutters, packaging containers of metal, packaging containers of plastic, all purpose scouring powder, down insulation, fiberglass insulation, vandal bars.

(3) Portable metal and plastic fence panels and portable waste disposal bins.

(4) Printed and electronic instructional publications, namely booklets, handouts, pamphlets, brochures, in relation to assembling and disassembling collapsible modular metal containers.

##### **Services**

(1) Moving and storage services, namely, rental, storage, delivery, installation and pick-up of portable storage containers namely, hydraulic lifts for use in respect of transportation and installation of storage containers.

(2) Operation of an Internet website providing information on modular storage containers to the general public.

[5] The Application is based on use of the Mark in Canada since at least as early as September 2013 in association with Goods (1), (2), (4) and the Services, and proposed use of the Mark in Canada in association with Goods (3).

[6] The Application was advertised for opposition purposes in the *Trademarks Journal* on February 22, 2017. On July 19, 2017, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that 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 which refer to the Act as

it read 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 prior to that date).

[7] The Opponent raises grounds of opposition based on registrability under section 12(1)(d), entitlement under sections 16(1)(a) and 16(3)(a), distinctiveness under section 2, and non-compliance with sections 30(b) and 30(i) of the Act. For the grounds of opposition based on an alleged likelihood of confusion, the Opponent relies on its use and registration in Canada of the trademarks PODS (TMA672,471) and PODS Logo (TMA721,151), details of which are included as Schedule A to this decision. The Opponent also relies on its use of the trademark PODS in the design format depicted below.



[8] The Applicant filed a counter statement on September 20, 2017 denying the grounds of opposition.

[9] The Opponent filed as its evidence the Affidavit of David Metcalf sworn January 11, 2018 (the Metcalf Affidavit). Mr. Metcalf is the Vice President, Marketing of the Opponent. He attests to the Opponent's use in Canada since 2006 of its trademark PODS, and design versions thereof, in association with the goods and services set out in the Opponent's registrations. His evidence is discussed further in the analysis of the grounds of opposition. Mr. Metcalf was not cross-examined.

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

[11] Both parties submitted written representations and a hearing was held at which both parties were represented.

#### ONUS AND MATERIAL DATES

[12] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[13] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a)/30 of the Act - the filing date of the Application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(c)/16(1)(a) of the Act – the claimed date of first use of the Applicant’s Mark;
- Sections 38(2)(c)/16(3)(a) of the Act – the filing date of the Application; and
- Sections 38(2)(d)/2 of the Act - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

#### GROUND OF OPPOSITION SUMMARILY DISMISSED

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

[14] There is no evidence of record from either party speaking to the claimed date of use in the Application. Accordingly, the Opponent has not met its initial evidential burden for the section 30(b) ground of opposition, and this ground of opposition is dismissed.

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

[15] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant’s statement untrue, such as evidence of bad faith or non-compliance with a Federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Mere

knowledge of the existence of an opponent's trademark is not sufficient to support a section 30(i) ground of opposition [see *Woot Inc v WootRestaurants Inc*, 2012 TMOB 197].

[16] In the present case, the Application contains the requisite statement and there is no evidence that this is an exceptional case involving bad faith or the violation of a Federal statute. Accordingly, the section 30(i) ground of opposition is dismissed.

#### REMAINING GROUNDS OF OPPOSITION

##### **Section 12(1)(d) ground of opposition**

[17] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent's registered trademarks PODS (TMA672,471) and PODS Logo (TMA721,151). I have exercised my discretion to check the Register and confirm that these two registrations remain extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has also filed evidence of its use of these two trademarks in Canada by way of the Metcalf Affidavit. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition. As a result, the Applicant bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's registered trademarks.

[18] In considering the issue of confusion, I will focus my analysis on the Opponent's registered word trademark PODS (TMA672,471), as in my view that represents the Opponent's best case.

#### Test for confusion

[19] The test for 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, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: 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.

[20] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 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.

[21] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

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

[22] Neither party submitted evidence of the meanings of the word components of the trademarks in issue. However, the Registrar may take judicial notice of dictionary definitions (see *Tradall SA v Devil's Martini Inc* 2011 TMOB 65 (TMOB) at para 29), which I have done in the present case by having reference to the *Canadian Oxford Dictionary*, 2nd Ed.

[23] In my view, the Opponent's trademark PODS has a low degree of inherent distinctiveness; the word "pod" being suggestive of a compartment or casing. Also, it is apparent from the evidence of the Opponent's marketing materials, as well as its design trademark registration No. TMA721,151, that the Opponent in some instances identifies the term "PODS" as an acronym for "Portable On Demand Storage". Acronyms are generally considered to have a low degree of inherent distinctiveness [see *Gemological Institute of America Inc v Gemology Headquarter International LLC*, 2014 FC 1153, 127 CPR (4th) 163].

[24] Trademarks that do not have a high degree of inherent distinctiveness can nevertheless acquire distinctiveness through extensive use and advertising. In the present case, the Metcalf Affidavit demonstrates that the Opponent (via a franchise system over which it exercises control) commenced using its trademark PODS in Canada in 2006 in association with the goods and services listed in registration TMA672,471. Since 2006, the Opponent has expanded to include eight locations in major cities across Canada. The Opponent's annual revenue in Canada in association with its trademark has grown from approximately \$112,780 CAD in 2006 to approximately \$17,973,126 CAD in 2016. The Opponent has advertised its goods and services in association with its trademark PODS extensively in Canada, including via a website, social media, television, radio, print advertisements, tradeshow, and sponsorship of sporting events. As a consequence, I am satisfied that the Opponent's trademark PODS is known to a considerable extent in Canada.

[25] The Applicant's Mark has a slightly higher degree of inherent distinctiveness than the Opponent's trademark, given that "MODPOD" is not a dictionary term. I do not consider the design elements of the Mark to add much to its inherent distinctiveness, as the design elements are fairly rudimentary. However, I consider it relevant that the design elements of the Mark separate the terms "MOD" and "POD" in such a way that, in my view, a reader is likely to understand the term "MOD" as describing the type of "POD". While the word "mod" can have a variety of meanings, in the present context I consider it likely to be understood as an abbreviation of the word "modular", given that the description of Goods and Services in the Application includes multiple references to "*modular* metal containers" [emphasis added].

[26] The Applicant has not filed any evidence that it has commenced use of the Mark or that the Mark is known to any extent in Canada.

[27] On balance, taking into account both the inherent distinctiveness of the trademarks and the extent they have become known, in my view, this factor favours the Opponent due to the evidence of the Opponent's extensive use and advertising of its trademark in Canada since 2006.

*The length of time the trademarks have been in use*

[28] The Opponent's evidence demonstrates that it has used its trademark PODS in Canada in association with the goods and services listed in its registration since 2006.

[29] The Application claims use of the Mark in association with certain of the Goods, as well as the Services, since September 2013. However, the Applicant has provided no evidence of any use of its trademark.

[30] Consequently, this factor favours the Opponent.

[31] As an aside, and in response to an argument raised by the Applicant during the hearing, I note that I can draw no inference in the Applicant's favour based on an absence of evidence of actual confusion, as the Applicant has not provided any evidence of use of its Mark.

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

[32] In my view, there is direct overlap between the parties' goods and services and the likely channels of trade. By way of example, the Opponent's registration includes the goods "containers for the storage and transportation of goods" and the services "[m]oving and storage services; rental, storage, delivery and pick-up of portable storage units". The Opponent's evidence of its use of its trademark PODS is consistent with these descriptions. The Applicant's Application includes the goods "[c]ollapsible modular metal containers for the storage, warehousing, transportation of household, commercial, industrial purposes and waste" and the services "[m]oving and storage services, namely, rental, storage, delivery, installation and pick-up of portable storage containers namely, hydraulic lifts for use in respect of transportation and installation of storage containers."

[33] The Applicant has filed no evidence and made no submissions to suggest that its Goods and Services, or the channels of trade in which they would be offered, are different from those of the Opponent.

[34] In view of the above, this factor strongly favours the Opponent.



*Degree of resemblance*

[35] In considering the degree of resemblance, it is preferable to determine whether there is an aspect of each trademark that is “particularly striking or unique” [*Masterpiece, supra*, at paragraph 64].

[36] The striking or unique element of the Opponent’s trademark is the word “PODS”.

[37] The striking or unique element of the Applicant’s Mark, in my view, is the word element “MODPOD”, rather than the design elements of the Mark.

[38] The resemblance between the parties’ trademarks is reasonably high. The Applicant’s Mark incorporates effectively the entirety of the Opponent’s trademark PODS (but for the final letter “S”), and adds the component “MOD” as a prefix. While in some circumstances the first component of a trademark will be considered the most significant, in the present case, for the reasons noted above, the prefix “MOD” in the Applicant’s Mark is likely to be understood as descriptive of the type of “POD”, which lessens the impact of the first portion of the Mark. Thus, while there are some differences between the trademarks in terms of appearance and sound, the ideas conveyed are very similar, and in my view the resemblance between the trademarks as a whole is reasonably high.

[39] In its written representations, the Applicant argued that the design elements of the Mark reduce the degree of resemblance. However, the Opponent’s registration TMA672,471 is in respect of the word trademark PODS, which entitles the Opponent to depict the trademark in any font, style or colour [see *Pizzaiolo Restaurants Inc v Restaurants La Pizzaiolle Inc*, 2016 FCA 265, 142 CPR (4th) 329 at paras 24-25]. In addition, the design elements of the Mark bear some resemblance to the manner in which the Opponent depicts its trademark PODS in the marketplace (for example, see Exhibits “B” through “D” of the Metcalf Affidavit, and the depiction included at paragraph 7 of this decision, above), with both parties incorporating block upper case letters set against contrasting quadrilateral backgrounds.

[40] In sum, the degree of resemblance factor favours the Opponent.

### Conclusion regarding the Section 12(1)(d) ground

[41] Having considered all of the surrounding circumstances, I conclude that the Applicant has not satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties' trademarks. I reach this conclusion considering that each of the statutory factors favour the Opponent, including the degree of resemblance between the parties' trademarks, the extensive use of the Opponent's trademark in Canada, and the overlap in the parties' goods and services.

[42] Consequently, the section 12(1)(d) ground of opposition succeeds in respect of the Opponent's registration TMA672,471. In addition, in my view, the outcome of the confusion analysis is the same when considering the Opponent's registration TMA721,151, for essentially identical reasons to those set out above, and so the Opponent's section 12(1)(d) ground of opposition succeeds based on that registration as well.

### **Sections 16(1)(a) and 16(3)(a) grounds of opposition**

[43] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark because it is confusing with the Opponent's trademark PODS, and design versions of that trademark (such as that shown in paragraph 7 of this decision, above, and registration TMA721,151), that have been previously used in Canada.

[44] The Opponent has met its initial evidential burden by way of its evidence demonstrating extensive and continuous use of its trademark PODS in Canada since 2006, well prior to the material dates for the non-entitlement grounds of opposition (namely, September 2013 for the section 16(1)(a) ground and August 19, 2015 for the section 16(3)(a) ground).

[45] In my view, the earlier material dates for the non-entitlement grounds of opposition do not alter the confusion analysis set out above for the section 12(1)(d) ground of opposition. Thus, the Applicant has not met its legal burden to demonstrate no likelihood of confusion as of the material dates for the non-entitlement grounds, and the section 16(1)(a) and 16(3)(a) grounds of opposition are also successful.

## **Section 2 ground of opposition**

[46] As I have already found in the Opponent's favour in respect of the section 12(1)(d) and non-entitlement grounds of opposition, I will refrain from addressing the section 2 ground of opposition.

### DISPOSITION


[47] 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.

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Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

SCHEDULE A

**Registrations relied on by Opponent**

Reg. No.	Trademark	Goods/Services
TMA672,471	PODS	<p><b>Goods</b>                      (1) Paper and cardboard packing boxes and materials used for packing of goods in connection with transportation and storage services; containers for the storage and transportation of goods; hydraulic lifts for use in respect of transportation and storage of storage containers.</p> <p><b>Services</b>                      (1) Moving and storage services; rental, storage, delivery and pick-up of portable storage units; franchising services in relation to the establishment and/or operation of moving and storage services.</p>
TMA721,151	 <p><b>Note:</b> Colour is claimed as a feature of the trade-mark. The colour red is claimed as a feature of the mark. Each of the letters P, O, D, and S across the top of the logo appear in squares. The background of these squares is red.</p>	<p><b>Goods</b>                      (1) Cardboard packing boxes and wrapping/packing paper; wood and metal portable storage containers.</p> <p><b>Services</b>                      (1) Moving services, on-site storage services, namely, provision of storage services at a customer's location, warehouse storage services.</p>

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

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**HEARING DATE** 2020-10-28

**APPEARANCES**

Michael O'Neill	For the Opponent
James Swanson	For the Applicant

**AGENTS OF RECORD**

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