

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 070**

**Date of Decision: 2022-04-14**

**IN THE MATTER OF AN OPPOSITION**

**Honda Giken Kogyo Kabushiki Kaisha  
also trading as Honda Motor Co., Ltd.**

**Opponent**

**and**

**Chongqing Changan Automobile Co., Ltd.**

**Applicant**

**1,744,496 for V & Design (colour claim)**

**Application**

[1] Honda Giken Kogyo Kabushiki Kaisha also trading as Honda Motor Co., Ltd. (the Opponent) opposes application no. 1,744,496 (the Application) for registration of the trademark “V & Design (colour claim)” (the Mark) filed by Chongqing Changan Automobile Co., Ltd. (the Applicant). The Mark consists of a bevelled design featuring a downward pointing chevron within two concentric rings, as shown below:



[2] The application includes a colour claim, which reads as follows:

Colour is claimed as a feature of the trade-mark. This trademark consists of a design of two silvery white quasi-circular rings and a V shape device with blue as base color (not representing the background) and black shading.

[3] I note that the “base color” refers to the negative space between the design elements, which has been coloured blue (instead of being left empty to let the background surface show through). For consistency, I will refer to colouration of this negative space in both parties’ trademarks as a “base colour”.

[4] The opposition is based primarily on the Opponent’s allegation that the Mark, which is intended for use in association with cars, other motor vehicles, and parts therefor, is confusing with the Opponent’s trademarks featuring either an upward pointing chevron in a ring or a stylized letter H in a ring, also for use in association with cars and/or other motor vehicles, and parts therefor, as well as related accessories and services.

[5] For the reasons that follow, the opposition is successful.

#### THE RECORD

[6] The Application was filed on September 2, 2015, based on proposed use of the Mark in Canada in association with the following goods:

Buses; Trucks; Vans; Cars; Automobiles; Shock absorbers for motor vehicles; Motor vehicle motors; Electric motors for motor cars; Wheels of automobiles; Wheels for motor vehicle; Clutches for motor vehicles; Motorcycles; Automobile bodies. (the Goods)

[7] The Application was advertised for opposition in the *Trademarks Journal* on July 20, 2016, and opposed on December 16, 2016, when the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition allege that the Application does not comply with the formal requirements of sections 30(e) and 30(i) of the Act; that the Mark is not registrable under section 12(1)(d) of the Act; that the Applicant is not entitled to registration under section 16(3)(a) of the Act; and that the Mark is not distinctive as defined in section 2 of the Act. The Applicant filed a counter statement denying each of the grounds of opposition.

[8] Numerous amendments to the Act came into force on June 17, 2019. Pursuant to the transitional provisions in section 70 of the Act for applications advertised before June 17, 2019, the grounds of opposition will be assessed based on the Act as it read immediately before amendment, an exception being that the definition of confusion in sections 6(2) to 6(4) of the Act as it currently reads will be applied.

[9] In support of its opposition, the Opponent filed the following evidence:

- The affidavit of the Senior Vice President of Sales and Marketing of the Opponent's affiliate Honda Canada Inc. (Honda Canada), Jean Marc Leclerc, which is dated September 14, 2017. Mr. Leclerc describes how vehicles and parts are marketed and sold in association with the Opponent's trademarks through its exclusive Canadian distributor, Honda Canada.
- Certified copies of the five trademark registrations on which the Opponent relies.
- A certified copy of the Applicant's prior application no. 1,549,392 (now abandoned) to register a version of the Mark omitting the colour claim and dark base colour, indexed on the Register as V & Design and reproduced below (Original Mark):



[10] In support of the Application, the Applicant filed the following evidence:

- The affidavit of its President, Baolin Zhang, which is dated April 10, 2018. Mr. Zhang describes the Applicant's global operations, including the sale and promotion of vehicles in association with the Mark in China and Central and South America.
- The affidavit of an independent trademark searcher, Alan Booth, which is dated March 29, 2018. The sole exhibit to Mr. Booth's affidavit introduces into evidence the particulars of 89 trademark registrations he printed that month from the Registrar's database. These trademarks will be discussed in more detail below, but consist essentially

of relatively simple designs in a frame or against a background that is more or less round in shape, registered for use in association with motor vehicle goods and services, generally including automobiles.

- The affidavit of an independent Canadian automotive industry analyst, Dennis DesRosiers, which is dated March 27, 2018. Mr. DesRosiers is the founder and president of DesRosiers Automotive Consultants Inc. (DesRosiers Automotive), a strategic consulting company in Canada focussing exclusively on the automotive industry. Mr. DesRosiers describes the company's business, which includes publishing periodicals relating to the industry as well as conducting feasibility studies, market analyses, and market forecasting for the industry, financial institutions, and the government. He notes in particular that the company has an established network of industry contacts and access to internal databases of public information released by vehicle companies and their trade associations. Drawing on these databases, he provides annual Canadian sales figures from the 1990s to 2017 for nine third-party automobile brands (collectively the "Third Party Brands").
- The affidavit of an independent Canadian automobile industry journalist and race-car driver, Jacques Duval, which is dated April 5, 2018. Mr. Duval describes his background and work experience, which includes publication of reference books, production of television programs, and appearances in newspaper columns, magazine articles, and radio shows, as a specialist on automobiles and the automobile industry, including reviews of cars on the market in Canada. Mr. Duval provides his opinion about the use and renown in Canada of nine of the logos referenced in Mr. Booth's affidavit (collectively the "Third Party Logos"), corresponding to the nine Third Party Brands featured in Mr. DesRosiers' affidavit. Mr. Duval was cross-examined on his affidavit and the transcript is of record.

[11] Both parties filed written arguments and were represented at an oral hearing.

#### **Admissibility of Mr. Leclerc's opinion evidence**

[12] I note that I have disregarded the opinions expressed in Mr. Leclerc's affidavit regarding how the Opponent and its trademarks are known and what Canadian consumers will believe upon seeing the Mark. Since Mr. Leclerc has not established himself as an expert in Canadian

trademark law or human behaviour and is not independent of the parties, I am not prepared to give his opinions on consumer perceptions or the likelihood of confusion any weight.

#### **Admissibility of Booth affidavit**

[13] The Opponent submits that Mr. Booth's evidence must be disregarded because he did not disclose the search parameters used to identify the registrations referenced in his affidavit. However, I agree with the Applicant that Mr. Booth's evidence as to the existence of these registrations in March 2018 is not affected by the methodology he used to decide which registrations' particulars to print, and his failure to specify the search parameters does not render his evidence inadmissible.

#### **Admissibility of DesRosiers affidavit**

[14] The Opponent submits that Mr. DesRosiers' sales figures (i) constitute hearsay that is not admissible under either the principled exception of necessity and reliability or the business records exception and (ii) are of limited value in the absence of supporting documentation. Conversely, the Applicant submits that Mr. DesRosiers provides sufficient support by stating that this data is from his company's internal database of information publicly released by vehicle companies and their trade associations. The Applicant submits that the veracity of the source cannot be challenged when the Opponent has foregone cross-examination, also noting that the figures are in line with the Opponent's annual sales provided by Mr. Leclerc and that supporting documentation for decades of sales by nine separate auto makers would be voluminous.

[15] Having reviewed the credentials Mr. DesRosiers provides in his affidavit, I am satisfied that his evidence regarding sales levels is relevant, addresses a matter outside the Registrar's knowledge and expertise, and otherwise meets the test for the admissibility of expert evidence set out in *R v Mohan*, [1994] 2 SCR 9. Although his evidence in this respect is technically hearsay, it appears to be necessary, given that vehicle companies competing with the Applicant would not be expected to help it make its case. It also appears to be reliable, given that the source data was collected and documented in the ordinary course of DesRosiers Automotive's business and Mr. DesRosiers is an independent witness with the qualifications to evaluate such information. I am therefore satisfied that this evidence meets the principled exception to the

hearsay rule [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD), re admissible hearsay in trademark cases]. In light of this conclusion, it is not necessary to address the Opponent’s submissions regarding the business records exception. Furthermore, having found the evidence admissible, and in the absence of cross-examination or evidence to the contrary, I am prepared to give the evidence some weight.

### **Admissibility of Duval affidavit**

[16] The Opponent submits that Mr. Duval’s evidence is of limited value in the absence of statistics or surveys to support his conclusions regarding the Canadian public’s knowledge, particularly when the majority of his activities and experience are restricted to the province of Quebec and/or conducted in French, whereas his conclusions concern Canada’s entire population, regardless of age, location, or driving history [per Q236-Q238]. During the oral hearing, the Opponent further submitted that Mr. Duval could not be considered an independent witness because (i) there is no indication that he signed the certificate to acknowledge having read the Code of Conduct for Expert Witnesses prescribed to in section 52.2(1)(c) of the *Federal Court Rules*, SOR/98-106, and (ii) he did not include the Opponent’s trademarks in his list of well known logos, even though he considered one of the Opponent’s logos to be well known and another pair to be well known by connoisseurs [see Q293-Q296].

[17] Conversely, the Applicant submits that Mr. Duval supports his opinion with the sales figure statistics in Mr. DesRosiers’ affidavit by confirming having reviewed that affidavit and being familiar with DesRosiers Automotive and its “considerable knowledge and expertise in the Canadian automotive industry” [Duval para 31]. The Applicant further submits that Mr. Duval’s qualification as an expert on the Canadian automobile industry—accepted in *American Pacific Industries, Inc v Chrysler, LLC*, 2013 TMOB 82, and *BMW Canada Inc v Nissan Canada Inc*, 2007 FC 262—obviates the need for a survey. In the Applicant’s submission, it is inappropriate to suggest that expertise gained in Quebec—a “major” part of Canada—is insufficient, and, in the alternative, judicial notice may be taken of the fame of the Third Party Logos because each of them has been seen “many, many times over decades – on cars, signage, and advertisements” by “[e]very Canadian” [written argument paras 48-49].

[18] I do not consider the fame of the Third Party Logos to be the type of notorious or generally accepted fact or immediately verifiable information of which I can take judicial notice. Even if I were to take judicial notice of such logos' presence on cars driven in Canada, that would not mean that I could take judicial notice of any particular level of reputation.

[19] With respect to Mr. Duval's qualifications, I would first note that the absence of the certificate required by section 52.2(1) of the *Federal Courts Rules* does not prevent the Registrar from considering the expert's evidence. Moreover, given that Mr. Duval's affidavit appears directed towards the state of the Register and marketplace, I do not consider omission of the parties' trademarks to suggest bias or a lack of independence.

[20] Having reviewed the credentials Mr. Duval provides in his affidavit, I am satisfied that he is qualified as an expert on the technical aspects of the automobile industry in Canada, but not on consumer behaviour, public opinion, or trademark law. Indeed, in *American Pacific Industries*, Mr. Duval was only said to have testified as an expert on the nature of motor vehicle goods and tire goods and on the nature of the trade for such goods. In *BMW*, his evidence was accepted regarding the *industry's* recognition of the quality and performance of a particular brand of automobile and regarding the *purpose* of a brand (*e.g.* corporate logo versus model or trim designation) and its advertising venues. It is also worth noting that when a separate expert witness in *BMW*, likewise a long-time auto journalist and race-car driver, was accepted as an expert commentator on the car industry, the Court refused to accept his opinion that the Canadian public associated certain trademarks with a particular source, because, without some evidence in support, "it is not within his recognized expertise as a journalist to be a spokesperson for 'the Canadian public'" [at para 31]. I find the Court's reasoning in that respect to be applicable to Mr. Duval's evidence before me.

[21] Furthermore, opinion evidence is not to be accepted on the basis of expertise alone; the facts and assumptions upon which it is based must also be examined to assess both its validity and the process by which it was reached [see *William H. Rorer (Canada) Ltd. v. Johnson & Johnson* (1980), 48 CPR (2d) 58 (FCTD)]. I am not bound by the expert's conclusions and must carefully weigh the credibility of the opinion in light of all the circumstances to reach a decision

[*Culinar Inc. v. Gestion Charaine Inc.* (1987), 16 FTR 202 (FCTD); *ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056].

[22] Upon review of the transcript of Mr. Duval's cross-examination, I have doubts with respect to the reliability and probative value of his conclusions regarding the extent to which the Third Party Logos are used and have become known, for the following reasons:

- Although Mr. Duval based his opinion on sales volume, he admitted under cross-examination that he was not a specialist in the assessment of automobile sales [Q289] and that his work involved the physical and mechanical aspects of automobiles affecting their sales rather than logos or marketing [Q212].
- When asked what sales figures he relied on, Mr. Duval was equivocal, stating that he *probably* used the statistics published annually by DesRosiers Automotive, but might have used a secondary source or figures from other authorities in the field, and, above all, used his own knowledge and judgment in a manner that varied depending on the vehicle [Q256-Q260, Q264, Q298-Q302].
- Certain conclusions stated in Mr. Duval's affidavit were qualified during cross-examination. I note in particular his statements that the logos of BMW, Lexus, and Infinity were "well known among members of the Canadian public" as a result of a "high volume" of sales [paras 33, 36, 40]. Upon cross-examination, he clarified that BMW's logo was only well known by enthusiasts and less known by the general public, as the brand was *not* a big seller relative to others [Q138-Q141]. He specified that Lexus sales (which were lower than BMW's according to Mr. DesRosiers) were only fair, but moderately high [Q284-Q285: "*potables, mais moyennement élevés*"]. As for Infinity sales (which Mr. DesRosiers shows as being lower still but gradually rising), Mr. Duval specified that they were excellent to start but then declined by a fair amount because Infinity had a relatively low number of models, which Mr. Duval still considered to be "high" volumes under the circumstances [Q273-Q274].
- Mr. Duval appeared not to recall aspects of the process by which some of his conclusions were reached. For example, he could not recall why he concluded that each of the Third Party Logos was well known by the specific date of September 2, 2015, and stated



emphatically that this date had not been provided by counsel for the Applicant, contrary to counsel's subsequent confirmation that indeed it had [Qs197-Q198].

- Mr. Duval admitted that he did not verify certain information provided in his affidavit with respect to each of the Third Party Logos, namely (i) the registration date and, as the case may be, the claimed date of first use or date of filing a declaration of use and (ii) the dates as of which each logo was affixed to new cars sold in Canada [Q201, Q211, Q216]. Mr. Duval also admitted to not knowing the meaning of the term "declaration of use" and stated that he had simply assumed the information regarding the logos being affixed was logical, although exceptions could have been made for a year [Q201, Q219-Q220].

[23] In view of the foregoing, I would be prepared to give some weight to Mr. Duval's evidence regarding how automobiles are branded, but little weight to the precise dates referenced in his affidavit or to his opinions regarding consumers' perceptions.

#### EVIDENTIAL BURDEN AND LEGAL ONUS

[24] In an opposition proceeding, the legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, 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 that ground of opposition exist. If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

#### GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D)

[25] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act, because it is confusing with the five registered trademarks set out at Schedule A hereto (Opponent's Trademarks) and also with the Opponent's "family of registered marks" comprising the five Opponent's Trademarks.

[26] The material date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. An opponent's initial burden is met if one or more of the registrations relied upon are in good standing on the material date and the Registrar has discretion to check the Register in this respect [per *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised this discretion, I confirm that all of the registrations for the Opponent's Trademarks are extant. The Opponent having met its evidential burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with any of the Opponent's Trademarks.

### **The test for confusion**

[27] 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 [section 6(2) of the Act]. Thus the test for confusion does not concern confusion of the trademarks themselves but rather confusion as to whether the goods and services associated with each party's trademark come from the same source.

[28] The test is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applicant's trademark 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 trademarks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. Regard must be had to all the surrounding circumstances, including those set out in sections 6(5)(a) to (e) of the Act, but these criteria are not exhaustive and the weight given to each factor will vary in a context-specific analysis [*Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22].

[29] The Opponent's evidence focusses on the three trademarks shown below, namely (i) H Design, registered under no. TMA578,922, consisting of a stylized letter H in a ring (H Logo); (ii) H & Design, registered under no. TMA388,350, consisting of a solid, upward-pointing chevron in a ring, the chevron being slit from its upper tip to just above the branching

point (Solid Acura Logo); and (iii) Acura Logo Design, registered under no. TMA855,018, consisting of an outline of the same upward-pointing chevron in a ring, shaded as if to suggest bevelling and sheen (Shaded Acura Logo):



Reg. No. TMA578,922  
Indexed as H Design  
(H Logo)



Reg. No. TMA388,350  
Indexed as H & Design  
(Solid Acura Logo)



Reg. No. TMA855,018  
Indexed as Acura Logo Design  
(Shaded Acura Logo)

[30] I note that, although the Solid Acura Logo is indexed on the register under the name “H & Design”, it would more accurately be described as a variation of the trademark indexed as “Acura Logo Design”. I will occasionally refer to both of these trademarks collectively as the “Acura Logos” and to all three trademarks collectively as the “Opponent’s Logos”.

[31] In my opinion, the Shaded Acura Logo, registered for use in association with “automobiles and structural parts thereof”, represents the Opponent’s strongest case, and comparing this trademark with the Mark will effectively decide the registrability ground of opposition. I will therefore focus my discussion on the Shaded Acura Logo.

#### Considerations regarding the Shaded Acura Logo

[32] I note at the outset that I would consider use of the Solid Acura Logo to also constitute use of the Shaded Acura Logo. In applying the principles set out by the Federal Court of Appeal in *Canada (Registrar of Trade Marks) v Cie Internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I find that the dominant features of the Shaded Acura Logo—the particular chevron design in a ring—have been preserved in the Solid Acura Logo. I do not consider the difference in shading, which I find to be essentially a difference in colour or apparent texture, to be a significant deviation, particularly given that registration of a trademark in black and white covers use of the trademark in any colour scheme [for similar conclusions, see *Brooks Sports, Inc. v Anta (China) Co, Ltd.*, 2018 TMOB 151; and *H&M, Patent and Trade-mark Agents v Kinedyne Canada Limited*, 2015 TMOB 48 ]. Thus I find that the Shaded Acura Logo has not

lost its identity, remains recognizable, and can acquire distinctiveness through use and promotion of the solid variation.

[33] Likewise, I consider it immaterial whether the Shaded Acura Logo is displayed in two dimensions, for example, as a shaded drawing, or in three dimensions, for example, stamped, embossed, or sculpted, with actual bevelling and/or sheen. I consider such differences to be small and unimportant, and readily explainable when one considers the various materials on which and techniques with which trademarks in the automotive field may be affixed, ranging from printed brochures and exterior signage to leather steering wheels and metal radiator grilles [see *Promafil, supra*, for a discussion of similar technical realities in the clothing field].

[34] Finally, I will not discount uses of the Acura Logos in conjunction with either the word ACURA or a phrase such as ACURA ADVANCE, ACURA DEVANT, ACURA | MDX, or ACURA PRECISION CRAFTED PERFORMANCE (collectively “ACURA Branding”). Nothing prevents two trademarks from being used at the same time, so long as they are not combined in a way that renders the individual marks indistinguishable [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)]. While in some of the cases depicted in the evidence, the combination may constitute a composite trademark, I find that in each case the Acura Logo stands out sufficiently, by virtue of its size, colour, and/or position, to also be identifiable as a distinct trademark.

#### **Section 6(5)(e): Degree of resemblance between the trademarks**

[35] The degree of resemblance between the trademarks at issue is often the factor likely to have the greatest effect on the confusion analysis and thus is an appropriate starting point [*Masterpiece, supra*]. In assessing resemblance, each trademark must be considered as a whole and assessed for its effect on the average consumer as a matter of first impression; it is not the proper approach to set the trademarks side by side and carefully examine them to tease out similarities and differences. However, considering a trademark as a whole does not mean that a dominant component that would affect an average consumer’s overall impression of the trademark should be ignored. The preferable approach is to begin by determining whether there is an aspect of each trademark that is “particularly striking or unique” [*ibid.* at para 64].

[36] The Opponent submits that the Mark is very similar in overall appearance to the Shaded Acura Logo, since both “comprise a badge design consisting of a two-pronged shape within a circular band” [written argument para 96]. The Opponent submits that the colour claim in the Application is irrelevant because registration of the Shaded Acura Logo in black and white covers all possible colour combinations, including the one proposed by the Applicant.

[37] The Applicant submits that the differences between the Mark and the Shaded Acura Logo are significant, for the following reasons:

- The Shaded Acura Logo is dominated by the single letter A (a reference to the word mark ACURA) whereas the Mark is dominated by the single letter V.
- The Shaded Acura Logo features a horizontal component and gap at the juncture of the chevron’s branches whereas those two features are absent from the Mark. Members of the public will “impulsively look for the horizontal component” to determine whether the trademark is to be interpreted as a V or an A and would not see the Mark as an upside-down A because it has no horizontal component [written argument para 38].
- The colour blue is also a dominant component of the Mark, whereas the signage and advertisements depicted in Mr. Leclerc’s affidavit show that “white/black” is the “core colour” for the Acura Logos [written argument para 36].
- The Mark features two rings whereas the Shaded Acura Logo has only one.

[38] I find that both the Mark and the Shaded Acura Logo feature a chevron shape somewhat similar to pincers or an open beak, contained in a frame shaped more or less like a rounded square. In both cases, the chevron’s branches are elongated diamond shapes. I find this overall basic shape of an angular pincer-style chevron in a rounded frame to be the most striking aspect of each trademark. Notwithstanding the doubling of the ring in the Mark and the subtle difference in the ring’s shape, the overall impression remains that of a chevron in a frame. In addition, both trademarks are shaded to create a three-dimensional effect reminiscent of bevelling and/or sheen, which I find contributes to the degree of visual similarity between the them.

[39] Although the characteristics of the letter A are recognizable in the Shaded Acura Logo and the characteristics of a V in the Mark, I am not convinced that either trademark would necessarily be interpreted as a letter of the alphabet as a matter of first impression. In this respect, I note that a capital A is typically closed at the top and I am not satisfied that the Shaded Acura Logo's frame creates the illusion of this closure as a matter of first impression. With respect to the Mark, the diamond shapes composing the chevron give its branches a bent look that is not typical of the letter V.

[40] I reach these conclusions notwithstanding Mr. Leclerc's evidence that generally shows the Shaded Acura Logo in proximity to the word ACURA, which begins and ends with the letter A. Under a section 12(1)(d) ground of opposition, it is the effect of the Opponent's registered trademark *itself* that must be considered, and not the effect of any other indicia or brands that may appear in proximity. Although there may be cases where a trademark has acquired distinctiveness as an acronym for a brand name, I am not satisfied that the Opponent's evidence of the Acura Logos being displayed in proximity to the word ACURA is in itself sufficient to establish such a secondary meaning in the present case.

[41] At the oral hearing, the Applicant also sought to distinguish the trademarks at issue by their central portions. In the Shaded Acura Logo, the midline of the chevron features a tall vertical slit with three-dimensional shading, whereas in the Mark, the midline features a thin, white, vertical line. This line appears to increase in brightness as it passes through a shadow at the base of the chevron (whose effect is not quite three-dimensional, in contrast to the shading in the valley of the chevron) and then flares slightly to join a horizontal white line in the inner ring of the logo's frame. The Applicant characterizes the slit in the Shaded Acura Logo as a prominent wide gap, above a horizontal bar representing a pivot joint, while characterizing the white line in the Mark as merely a reflection of light off a three-dimensional surface. However, I am not convinced that such interpretations would occur to a casual consumer as a matter of first impression. I find that, in the Shaded Acura Logo, the shading makes the horizontal "bar" look solid, with no suggestion that it would pivot or that the overall shape lacks rigidity. As for the Mark, I do not find the white line to convey merely the suggestion of light catching a raised edge, because the increase in the line's brightness as it passes through a shadow is inconsistent with rendering a third dimension. In my view, this incongruity draws some attention to the white

line, and the fact that both trademarks feature a form of vertical line where the chevron prongs meet is an additional point of resemblance.

[42] With respect to colour, claiming it in an application as a feature of the trademark does not necessarily make it a dominant feature [*Pacific Western Brewing Company Ltd v Mythos Brewery SA*, 2011 TMOB 211; *Novopharm v. Novo Nordisk A/S* (2005) 43 CPR 4th 305 (TMOB)]. Moreover, the registration for the Shaded Acura Logo covers any colour scheme, and, indeed, the evidence shows that the design is often displayed in a light silver colour with a dark surface showing through the transparent base. The evidence also includes examples of the Shaded Acura Logo displayed on a light surface with a dark base colour (notably on or above vehicle grilles) as of 2001 [Leclerc Exhibits F, S]. Of course, when the logo is affixed to the frame of a blue car, for example, on the trunk, the colour showing through the base will be blue, which I find contributes to the degree of visual resemblance.

[43] With respect to resemblance in sound, although the letter A is sounded differently than the letter V, I do not consider this to result in a significant difference between the trademarks at issue, because I do not consider either of them likely to be sounded as a matter of first impression or imperfect recollection.

[44] As for resemblance in ideas suggested, in my view, both trademarks convey, as a matter of first impression, the idea of a chevron shape somewhat similar to pincers or an open beak in a frame shaped more or less like a rounded square. I consider the fact that each trademark might also suggest the idea of a letter of the alphabet to be a secondary feature, particularly in light of the various other concepts that also served as inspiration for the designs. Neither party has convinced me that any of these other particular ideas are a dominant feature.

[45] In this respect, Mr. Leclerc explains in his affidavit that the Acura Logos were designed to resemble a stylized engineer's caliper, intended to represent "precision crafted performance" [para 9]. He attaches as Exhibit D an excerpt from a magazine published by the Opponent's U.S. subsidiary American Honda Motor Co., Inc. (Honda U.S.) that describes this derivation and how the design was adapted to also represent Acura's initial A. However, there is no evidence of that magazine article's circulation in Canada; nor is there any evidence that an average Canadian

consumer would readily identify the chevron design in the Acura Logos as either the letter A or a caliper motif, or relate it to precision crafted performance.

[46] With respect to the Mark, Mr. Zhang states that it is the Applicant's original creation, having as its dominant component a stylized letter V intended to represent both a stylized bird in flight and a stylized animal foot, while also referencing the Roman numeral five to evoke the Five Elements Theory in traditional Chinese philosophy [para 9]. However, there is no evidence that the average Canadian would identify the chevron design as an animal foot, bird, letter, or Roman numeral, or relate its presence on a motor vehicle to the Five Elements Theory.

[47] In summary, I find that the differences between the two trademarks at issue are in the details. On balance, I do not consider any of these differences—alone or in combination—to be so significant as to stand out in the mind of an average consumer having only a general recollection of the earlier trademark. Given the degree of resemblance between the parties' trademarks in appearance and in the ideas suggested by them, this factor favours the Opponent.

**Section 6(5)(a): Inherent distinctiveness of the trademarks and extent to which they have become known**

[48] Trademarks lacking in distinctiveness are only entitled to a narrow ambit of protection, in the sense that a greater degree of discrimination may fairly be expected from the public and relatively small differences between the trademarks may suffice to avert confusion [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)].

Inherent distinctiveness

[49] The Opponent submits that the Shaded Acura Logo comprises a unique design unrelated to the associated goods and as such is inherently distinctive. Conversely, the Applicant submits that the Shaded Acura Logo is composed of a letter of the alphabet and as such possesses a relatively low degree of inherent distinctiveness.

[50] Trademarks consisting primarily of one or more letters of the alphabet are generally considered to possess a low degree of inherent distinctiveness in the absence of design features going beyond fanciful scripts or other embellishments intrinsic to the letters themselves [see



*Canadian Jewish Review Ltd v The Registrar of Trade-marks* (1961), 37 CPR 89 (Ex Ct); and *John Labatt Ltd v Canada (Registrar of Trade Marks)* (1984), 79 CPR (2d) 110 (FCTD)].

However, as discussed above, I do not consider the trademarks at issue in the present case to consist primarily of letters. Rather, I find that they consist primarily of artistic shapes. To the extent that letters of the alphabet are recognizable, I consider the degree of stylization to go well beyond a fanciful script or mere embellishment.

[51] As the designs in question have no readily apparent connection to the parties' goods, I find that both trademarks in this case possess some degree of inherent distinctiveness. That said, given that the designs are relatively simple geometric shapes, I find that neither trademark has more than a moderate degree of inherent distinctiveness.

[52] However, the degree of distinctiveness of a trademark can be enhanced through use and promotion in Canada [see *GSW, supra*]. Both parties filed evidence in this respect.

Extent to which the Opponent's trademark has become known

[53] Mr. Leclerc states that Honda Canada, as the Opponent's exclusive distributor for the Acura vehicle line in Canada, supports a network of approximately 51 authorized Acura dealers throughout the country [para 6]. He explains that Honda Canada purchases vehicles bearing the Acura Logos from the Opponent upon receipt of orders from the authorized dealers, which resell the vehicles at the retail level to individual consumers, who in turn may resell the vehicles as used or pre-owned, either themselves or through any automobile dealer [para 8, with representative sampling of Honda Canada's invoices from 2012 to 2017 at Exhibit R]. Similarly, Honda Canada purchases parts for Acura vehicles from the Opponent or from Honda U.S. upon receipt of orders from authorized dealers and parts resellers throughout Canada, which then resell the parts at the retail level to individual consumers [para 33, with representative sampling of invoices to authorized dealers in 2017 at Exhibit T].

[54] With respect to licensing arrangements, Mr. Leclerc specifies that Honda Canada is not permitted to purchase products or parts from anyone other than the Opponent—or a company authorized or instructed by the Opponent such as Honda U.S.—and confirms that the Opponent controls the quality and character of all the products and parts on a regular basis [paras 7-8, 32].

He adds that the Opponent has also licensed Honda Canada to use the Opponent's Logos in Canada and issues guidelines to control the manner of their use and display [para 7]. In view of the foregoing, I am satisfied that any use or display of the Acura Logos in association with the products and parts sold through Honda Canada enures to the Opponent's benefit.

[55] Mr. Leclerc's evidence with respect to the manner and extent of use and promotion of the Acura Logos in connection with such vehicles and vehicle parts is as follows:

- All authorized Acura dealers display one of the Acura Logos on exterior building signage [para 6]. Representative photographs from British Columbia, Alberta, and Ontario show four dealerships displaying the Shaded Acura Logo next to the word ACURA on the building façade—the oldest has been in operation since 1987 [para 6, Exhibit C].
- At least one of the Acura Logos is displayed directly on Acura automobiles sold in Canada since the introduction of the 1991 models in 1990 [paras 9, 12]. In each of the calendar years from 1990 to 1999, dealers' retail sales of Acura automobiles in Canada ranged from nearly 9,000 to over 20,000 vehicles; from April 1, 1999 to March 31, 2017, the annual wholesale figures for Acura automobiles sold in Canada by Honda Canada ranged from over 14,000 to over 27,000 vehicles [paras 10-11].
- The Acura Logos are displayed on the front and/or back end of the vehicle's exterior and, typically, also on the wheel caps, steering wheel, and floor mats [para 9]. Representative photographs of the Acura models for 2001, 2013, and 2016 [Exhibit S], as well as a sample flyer for the 2012 model year and sample product brochures for the 1990, 2008, 2009, 2010, and 2016 model years [Exhibit F] variously depict the Acura Logos displayed on automobile bodies, parts, and accessories as follows:
  - The Shaded Acura Logo is displayed on or slightly above the radiator grille (with a dark base color in the years since 2001), on the trunk (above the word ACURA in 2001), on the steering wheel (most years), on wheel caps (most years), and on an engine component (2013 and 2016).
  - A version of the Acura Logos that appears to be stamped or embossed is displayed on the steering wheel in 2001 and on an engine component in 2008.

- The Solid Acura Logo is displayed on wheel caps in 2001 and 2009 and on a sound system in 2001.
- Sales of Acura automobiles are also typically accompanied by an owner's manual or guide bearing at least one of the Acura Logos [para 12]. Copies of the covers from eight such manuals or guides, provided with vehicles sold in Canada in the period from 1995 to 2017, show the Solid Acura Logo displayed next to the word ACURA on the front cover and, as of 2013, also on the back cover [Exhibit E].
- The Acura Logos are also applied to certain automobile parts and accessories sold in Canada. Contrary to the Applicant's written submissions, it is not only the H Logo: Mr. Leclerc states that the "Honda Design Marks" are applied and he had previously defined "Honda Design Marks" as including both the Acura Logos and the H Logo [paras 4, 32, Exhibits A-B]. Indeed, representative photographs show the Acura Logos on an engine component and wheel caps [Exhibit S]. Although Mr. Leclerc does not specify whether these items were purchased separately from the associated vehicles, I note that motors and wheel caps are among the items he identifies as "parts and accessories" [at para 32], and I find it reasonable to infer that items such as replacement grilles, for example, would also be sold bearing the Shaded Acura Logo.
- Annual revenues from Honda Canada's sales of Acura vehicle parts in Canada exceeded \$50 million each year from 2012 to at least 2016 [para 34]. However, neither Mr. Leclerc nor the representative sampling of invoices he provides indicates which or how many of the Acura parts sold bore one of the Acura Logos. It is also not clear what percentage of the parts sold may be considered "structural" and thus within the scope of the Shaded Acura Logo registration; however, to the extent that non-structural parts and accessories are branded with an Acura Logo, I would consider such branding to be an additional surrounding circumstance tending to increase the likelihood of confusion.
- Over the past five years, at least \$10 million have been spent annually on the advertising and promotion of products bearing the Acura Logos, through magazines, newspapers, brochures, and other printed advertisements distributed throughout Canada, as well as in radio advertisements, television advertisements (the latter since at least 1995), and online promotional broadcasts in Canada [paras 1, 14, 18].

- Honda Canada supplies brochures, pamphlets, and point of sale materials to dealers, which then make these materials available to purchasers and prospective purchasers [para 15]. In addition to photographs within the materials depicting the Acura Logos on vehicles, as described above, the sample product brochures and flyer referenced above display the Acura Logos on their covers in the following manners [Exhibit F]:
  - The Shaded Acura Logo with a silver base colour above ACURA Branding (1990); on its own with a transparent base (2008, 2010); and affixed to vehicles either with a dark base colour (2008, 2009) or a transparent base (2010).
  - The Solid Acura Logo next to ACURA Branding as of 2008.
- Since at least 2001, products bearing the Acura Logos have been promoted in the magazine *Expressions*, which Honda Canada mails twice a year to approximately 130,000 Acura vehicle owners across Canada [para 16]. Copies of the front and back covers from 2001, 2010, 2015, and 2017 display the Acura Logos in the following manners [Exhibit G]:
  - The Solid Acura Logo above the word ACURA or ACURA Branding;
  - The Shaded Acura Logo on a vehicle; and/or
  - A variation of the Shaded Acura Logo having shiny highlights (2010).
- Acura automobiles are advertised in magazines circulated in Canada [para 17]. A sample advertisement from 1993 displays the Shaded Acura Logo with a silver base colour above ACURA Branding, and six sample advertisements dating from 1996 to 2014 display the Solid Acura Logo above the word ACURA or ACURA Branding and display the Shaded Acura Logo (with a dark base colour in 2014) affixed to a vehicle [Exhibit H]. No circulation figures are provided; however, I am prepared to take judicial notice that there is general circulation of the *Time*, *Maclean's*, and *Sports Illustrated* magazines in Canada [with respect to taking judicial notice of magazine circulation, see *e.g. Danjaq Inc v Zervas* (1997), 75 CPR (3d) 295 (FCTD); *Timberland Co v Wrangler Apparel Corp*, (2004), 38 CPR (4th) 178 (TMOB)].
- The website at [www.acura.ca](http://www.acura.ca) displays the Solid Acura Logo in conjunction with ACURA Branding and depicts vehicles branded with the Shaded Acura Logo [Exhibit I].

Its website traffic analytic reports show over 2 million visitors in each of 2015 and 2016 and over 200,000 in August 2017, more than 90% being from Canada and more than 60% being new visitors [Exhibits J].

- Honda Canada promotes Acura vehicles with the Acura Logos through its Canadian social media accounts, including Twitter (since 2009), Facebook (since February 2012), YouTube (since April 2012), and Instagram (since 2014) [para 20, Exhibit K]. Pages from these accounts display the Solid Acura Logo above the word ACURA and/or ACURA Branding; most also depict the Shaded Acura Logo on vehicles. Other depicted displays include the Shaded Acura Logo on a race car, the Solid Acura Logo above the word ACURA on promotional signage, and a flaming outline of the Acura Logo on what appears to be an anniversary video.

[56] In view of the foregoing, I find that the Shaded Acura Logo has become known to a significant extent in Canada. Although the Applicant argues that the degree of awareness of the Shaded Acura Logo in Canada is much lower than the degree of awareness of the H Logo given that the volume of sales under the former is much lower than the volume of sales under the latter, I find that the volume of sales under the Shaded Acura Logo is nevertheless significant. Moreover, I agree with the Opponent's submissions at the oral hearing that display of the Shaded Acura Logo on cars being driven and parked by their owners in public would increase the general public's exposure to this trademark. In the circumstances, I am satisfied that this level of sales, in conjunction with the evidenced advertising and promotion, results in the Shaded Acura Logo becoming known among consumers of automobiles in Canada to a considerable extent.

#### Extent to which the Applicant's trademark has become known

[57] Mr. Zhang states that the Applicant is a top Chinese automobile manufacturer with licensees operating a total of 6,000 sales and service facilities in over 60 countries [paras 2, 5-7]. He states that authorized distributors have sold automobiles branded with the Mark in numerous countries and provides sales figures, as well as examples of dealership signage, promotional signage, and other advertising, for the period from 2010 to 2017 [paras 12-17, Exhibits 6-10].

[58] However, Mr. Zhang’s evidence with respect to sales, as well as print advertising and promotional signage, covers only China and Central and South America, and there is no evidence of spill over into Canada. The only evidence of advertising potentially accessible in Canada is the following evidence of the Applicant’s online activity [paras 3-4]:

- The Applicant operates a website at *www.globalchangan.com*, where the Mark is displayed next to the particulars for various car models, as well as being shown in certain photographs depicting cars, for example, on grilles and printed above the word CHANGAN on a vehicle’s side [Exhibit 1]. I note that some of the car models on the website, such as the “Honor” minivan, are depicted next to a different logo, consisting of an upward-pointing arrowhead or rocket shape superimposed on a horizontal oval (the Arrowhead Logo), to which I will refer again below. However, there is no evidence that any Canadians have actually accessed this website.
- The Applicant’s social media accounts for Facebook, Twitter, Instagram, and Weibo display the Mark throughout, generally above the word CHANGAN [Exhibit 2]. Although small, the Mark can be made out in certain images, including on car grilles on the Twitter and Weibo pages and on what appears to be an engine component on the Instagram page. The Twitter and Instagram pages indicate that each has several thousand followers, but without identifying what country they are from. There is no evidence that the Twitter, Instagram, or Weibo pages have actually been accessed from Canada.
- A website traffic analytics report for the Facebook account shows reach in Canada [Exhibit 3]. However, this report is undated. Moreover, although Mr. Zhang states that it shows hundreds of thousands of followers, the statistics appear to be for “Fans”—described in the report as “people who like your page”—and only 109 of the “Fans” appear to be from Canada.

[59] I note that the exhibits to Mr. Zhang’s affidavit are printed in black and white and it is therefore not possible to determine whether the Mark appears in any of the exhibited documents in accordance with the Application’s colour claim. However, as I do not consider the colour scheme to be a dominant feature, I find that nothing turns on this distinction in the present case. Regardless of colour, the evidence that the Mark has become known in Canada remains very limited.

### Conclusion with respect to inherent and acquired distinctiveness

[60] I find that the Mark and the Shaded Acura Logo each possess only a moderate level of inherent distinctiveness; however, it appears from the evidence that the Shaded Acura Logo has become known to a considerable extent whereas the Mark has not become known to any meaningful extent. Accordingly, this factor strongly favours the Opponent.

### **Section 6(5)(b): Length of time the trademarks have been in use**

[61] As it appears from the evidence described above, use of the Shaded Acura Logo dates back to 1990 while the Application is based on proposed use and use of the Mark in Canada has not yet begun. Accordingly, this factor also strongly favours the Opponent.

### **Sections 6(5)(c) & (d): Nature of the parties' goods, businesses, and trades**

[62] When considering the nature of the goods, businesses, and trades under the registrability ground of opposition, it is the statement of goods in the applicant's application and in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. Each statement must be read with a view to determining the probable type of business or trade intended rather than all possible trades that might be encompassed by the wording; evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[63] It appears that the nature of the parties' goods in this case is largely the same. Those listed in the Application are in the nature of (i) motor vehicles, including "Automobiles", as well as "Buses; Trucks; Vans; Cars" and "Motorcycles", and (ii) parts for motor vehicles, including motors, wheels, shock absorbers, clutches, and automobile bodies. The identical good "Automobiles" is listed in the registration for the Shaded Acura Logo, and this registration also covers "structural parts thereof". Moreover, the evidence confirms that both parties actually market and sell automobiles.

[64] In the absence of evidence to the contrary, I consider cars to be essentially the same good as automobiles, and I consider personal motor vehicles such as trucks, vans, and motorcycles to be closely related goods. I also consider buses to be related, to the extent that they too are road vehicles, and somewhat akin to long vans. Furthermore, in the absence of evidence to the contrary, I am prepared to accept that at least “automobile bodies” are a structural part, and I consider the remaining types of parts listed in the Application to at least be related to automobiles and structural parts thereof, as the remaining types of parts are for installation in motor vehicles, within or among the structural parts.

[65] The parties also appear to operate through similar channels of trade. Mr. Leclerc’s evidence is that the Opponent’s licensee Honda Canada supports a network of authorized automotive dealers for vehicles manufactured by the Opponent and their parts and in particular authorized Acura dealers [paras 6-8, 33, Exhibit C]. Similarly, Mr. Zhang’s evidence is that the Applicant has licensees outside China operating sales and service facilities for vehicles and engines manufactured by the Applicant and in particular authorized distributors selling automobiles branded with the Mark [paras 7-8, 12-13, Exhibit 6].

[66] In addition, there appears to be at least an apparent potential for overlap, to the extent that the photographs attached to Mr. Zhang’s affidavit show the Applicant and/or its licensees and distributors operating in proximity to or with differently branded car companies, as follows:

- The Applicant’s dealership adjacent to what appears to be a different dealership: JAC MOTORS in one case and ASIANA MOTRS in another [Exhibit 6].
- At automobile expositions, the Applicant’s vehicles and signage located next to the signage for a HYUNDAI exhibit in one case and surrounded by signage for ASIANA MOTORS in another [Exhibit 9].
- At promotional car rallies, a car bearing both the Mark on the grille and an ASIANA MOTORS banner across the front windshield, while rally signage combines the Mark with ASIANA MOTORS branding [Exhibit 10].

Mr. Zhang does not explain the Applicant’s apparent relationship with ASIANA MOTORS or state whether the Applicant has a relationship with JAC MOTORS or HYUNDAI.



[67] At the oral hearing, the Applicant argued that its trade channels cannot be said to overlap with those of the Opponent, even if the parties' authorized dealerships are located next door to each other, because the Applicant's goods cannot be purchased at an Acura dealer and *vice versa*. In the Applicant's submission, the parties' goods are sold exclusively through their respective dealers, and the Registrar is "free to take judicial notice of this well-known reality in the Canadian automobile industry" [written argument para 57].

[68] However, neither the Application nor the registration for the Shaded Acura Logo contains such a restriction. Furthermore, I do not consider automobile industry practice on dealer exclusivity to be the kind of notorious fact or easily verifiable information of which I can take judicial notice. In any event, notwithstanding the Applicant's submission that it is "implausible" to suggest an authorized dealer would choose to sell both parties' goods [written argument para 58], there is no suggestion in the evidence that two unrelated automobile manufacturers could not authorize the same dealer.

[69] In this respect, while Mr. Leclerc specifies that *Honda Canada* is not permitted to purchase products or parts from anyone other than the Opponent or a company it has approved [para 7], he does not specify whether the *authorized automotive dealers and parts resellers* are similarly restricted. Likewise, Mr. Zhang does not specify whether the dealerships offering the Applicant's automobiles for sale are permitted to also carry products or parts from other manufacturers. Indeed, the third advertisement at Exhibit 7 to his affidavit (discussed in more detail below) appears to be for an AUTOSTAR dealership that sells not only vehicles branded with the Mark but also a FOTON TUNLAND truck branded with an inverted triangle logo, which, according to Mr. Booth's evidence, belongs to a third party, Beiqi Foton Motor Co., Ltd. In the absence of further particulars or explanations from Mr. Zhang, I find that such advertising and the proximity of the Applicant's signage to signage displaying other car brands at dealerships, automobile expositions, and car rallies suggests a potential for real or apparent overlap between the Applicant's channels of trade and those of other car manufacturers, including the Opponent.

[70] I would also note Mr. Leclerc's evidence that used or pre-owned vehicles branded with the Shaded Acura Logo may be resold through *any* automobile dealer [para 8]. Regardless of

whether the Shaded Acura Logo would be considered in “use” at that point within the meaning of the Act, Mr. Leclerc’s evidence that used car sales constitute an element of the trade is unchallenged and, in my view, could affect consumers’ perceptions as to whether automobile manufacturers’ trade channels may overlap.

[71] In any event, even if the evidence were to show that the trade channels in this case do not in fact overlap, I would still consider the similarity in the nature of the channels to be a significant factor in favour of the Opponent. In my view, a consumer whose imperfect recollection of only the Shaded Acura Logo comes from dealership signage would be no less likely to be confused when first encountering the Mark at a dealership.

[72] Overall, I find that there is considerable overlap in the nature of the parties’ goods and considerable similarity in the nature of their trades, with at least a potential for overlap in the trade channels. Therefore, these factors also favour the Opponent.

#### **Additional surrounding circumstances**

[73] Both parties raise several additional surrounding circumstances, as follows.

##### Family of trademarks

[74] As noted above, the Opponent pleads that the Mark is also confusing with its alleged family of registered marks comprising the five Opponent’s Trademarks.

[75] When multiple trademarks having common characteristics are registered and used by the same owner, this series is known as a “family”. Owning a family of trademarks increases the likelihood of consumers assuming that a new trademark having the same characteristic is simply another member of the family [*Everex Systems Inc v Everdata Computer Inc* (1992), 44 CPR (3d) 175 (FCTD)]. A party seeking to rely on this concept must establish that it is using more than one or two trademarks within the alleged family and such use must be sufficient to establish that consumers would recognize a family of marks [*Arterra Wines Canada, Inc v Diageo North America Inc*, 2020 FC 508; *McDonald’s Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD)]. However, if the common characteristic is also common to the trade, it cannot form the

basis of a family of marks [*Benjamin Moore & Co Limited v Home Hardware Stores Limited*, 2017 FCA 53; *Techniquip Ltd v Canadian Olympic Assn* (1999), 3 CPR (4th) 298 (FCA)].

[76] In the present case, I agree with the Applicant that the concept of a family of trademarks does not apply. The Acura Logos are essentially two different colour versions of the same trademark, differing from each other only in relatively minor visual respects, as opposed to a series of different trademarks within a family.

[77] Further, although the Solid Acura Logo is indexed on the register under the name “H & Design”—and its chevron design could conceivably be formed by pinching together the top prongs of a stylized H—I consider the difference in appearance between the H Logo and the Shaded Acura Logo too great to support a finding of a common characteristic. I do not consider the H Logo’s frame shaped more or less like a rounded square to contribute to the creation of a family of marks, given Mr. Booth’s evidence of the commonality of more or less similarly shaped frames on the register (approximately 50 are identified in his affidavit).

[78] Accordingly, the concept of a family of trademarks does not apply to the present case.

#### Appearance of trademarks in different orientations

[79] The Opponent submits that the trademarks at issue in the present case are displayed on car parts that rotate—such as steering wheels and wheel caps—and as such may be seen in the marketplace in all possible orientations, including upside down. In the Opponent’s submission, when the Mark is viewed right-side up and the Shaded Acura Logo upside down, the two trademarks are “overwhelmingly similar” [written argument para 98].

[80] The Opponent cites two prior cases where the possibility of rotating the parties’ trademarks was considered a relevant factor in assessing the degree of resemblance. In *Levi Strauss & Co v Benetton Group SpA* (1997), 77 CPR (3d) 223 (TMOB), the Registrar found that the parties’ respective trademarks for display on pant pockets bore a “fairly high degree of resemblance” when one of them was turned upside down, as it might be on a pair of jeans in a retail store. Similarly, in *Phoenix Footwear Group, Inc v Little Soles Inc*, 2015 TMOB 92, the Registrar found that the degree of resemblance between the parties’ respective trademarks for

use in association with footwear increased when one of them was turned sideways or upside down, as it might be on a pair of shoes.

[81] Conversely, the Applicant submits that, in the present case, even if one of the parties' trademarks were to be viewed upside down, which is "inconceivable" and would only happen with a car overturned in an accident, the significant distinction created by the "horizontal component" and "gap" in the Shaded Acura Logo, as well as other differences, would remain [written argument para 12].

[82] The Applicant also seeks to distinguish the cases cited by the Opponent. First, the Applicant submits that the double arcuate design trademarks at issue in *Levi Strauss* did not involve letters of the alphabet and that the footprint design trademarks at issue in *Phoenix Footwear* were both formed from the letter S, which looks identical upside down, and shared other details, namely five dots representing toes. Conversely, the present case involves two different letters of the alphabet and, despite the increased resemblance between them when one is rotated, neither letter looks *identical* upside down. Second, the goods at issue in the cited cases were ones that would typically be picked up and turned around by potential purchasers, which cannot be said of automobiles.

[83] In addition, the Applicant submits that consumers will learn which orientation of the parties' trademarks is right-side up from their display on automobiles, dealership signage, owners manuals, advertisements, and the like, and, in any event, will naturally recognize when the letter A or V is upside down even in the absence of contextual cues. Thus, viewing one of the parties' trademarks upside down will not increase the degree of resemblance.

[84] I agree with the Opponent that the potential to see the parties' trademarks upside down is a relevant factor. I accept that display of the trademark next to text will make its "correct" orientation apparent even when the combination is seen sideways or upside down, such as on a vertical banner or on a small promotional item. However, the evidence shows that the Acura Logos are also occasionally displayed on their own, notably on wheel caps, and I would not consider it uncommon for wheel caps to be seen upside down or sideways on stationary vehicles under normal conditions.

[85] Furthermore, Mr. Zhang's evidence includes photographs from automobile expositions where the Mark appears in different orientations. Notably, the first photograph at Exhibit 8 shows an overhead sign depicting the Mark on its side, *i.e.* with the chevron pointing to the right, followed immediately by the word CHANGAN in its standard orientation. Mr. Zhang does not specify to what extent the Applicant's signage features the Mark rotated in this manner vis-à-vis the word CHANGAN or whether it is ever featured in other orientations. I would also note that the second photograph at Exhibit 9 depicts cars draped with a cloth bearing a large image of the Mark, which would be seen in different orientations depending on the direction from which the car is approached. Mr. Zhang does not explain when or how often such draping is displayed.

[86] In any event, even if consumers are considerably more likely to first encounter the Mark right-side up, I consider the fact that the Acura Logos may have previously been seen rotating and in multiple orientations (with and without accompanying word elements) to contribute to the manner in which they will be recollected. I am not convinced that a consumer with only a vague or imperfect recollection of the Shaded Acura Logo would perceive the Mark as being less similar simply because it points in a different direction. Moreover, since I do not consider either trademark to be readily recognizable as a letter of the alphabet, I am not satisfied that consumers would necessarily remember the Shaded Acura Logo pointing in the same direction as an A.

[87] Finally, although not determinative, I consider the cases cited by the Opponent to lend support to the argument that the possibility of rotating the parties' trademarks may be a relevant circumstance to consider. I disagree with the Applicant that the nature of the trademarks at issue in those cases was fundamentally different. In *Levi Strauss*, the double arcuate designs were arguably in the general shape of the letters M and W, and thus comparable to the trademarks in the present case, which I find are in the general shape of letters but would not necessarily be perceived as such on first impression. As for the trademarks in *Phoenix Footwear*, the addition of the five "toe" dots to the S design created a trademark that did not look identical upside down.

[88] In view of the foregoing, I find the potential to see the parties' trademarks rotated in different orientations a relevant surrounding circumstance that works in the Opponent's favour.

### Contextual factors

[89] The Applicant submits that the likelihood of confusion is reduced in the present case because the Opponent “usually” uses the Acura Logos together with the word ACURA and the Applicant “usually” uses the Mark together with the word CHANGAN [written argument para 60]. The Applicant notes in particular that all of the dealership signage depicted in the exhibits to Mr. Leclerc’s affidavit displays the Shaded Acura Logo together with the word ACURA. In the Applicant’s submission, it is well known that a particular dealership’s automobiles and parts are branded the same way as the dealership and manufactured by the owner of the trademarks displayed on the dealership’s signage and advertising. Therefore, prospective purchasers of the Opponent’s goods are “well aware” that they are in an ACURA dealership and it is “irrational” to suggest that automobiles manufactured by or for the Applicant would be expected or sold there [written argument paras 15, 33].

[90] In support, the Applicant cites *Loblaws v Columbia Insurance Company*, 2019 FC 961, aff’d 2021 FCA 29, an infringement action where the plaintiff failed to establish a likelihood of confusion between the parties’ logos featuring the letters PC, in part because the plaintiff’s logo was used together with the word mark PRESIDNET’S CHOICE while the defendant’s logo was used together with the word mark PAMPERED CHEF.

[91] However, as noted by the Opponent, *Loblaws v Columbia* was an infringement action, where the legal burden of establishing a likelihood of confusion rests on the plaintiff, whereas in an opposition proceeding, the onus is on the Applicant to establish that confusion is unlikely. Moreover, in an infringement action, the plaintiff’s registration is asserted against the defendant’s actual use, and thus the context in which that use occurs is important. By contrast, in an opposition proceeding, it is the effect of the Applicant’s mark *itself* that must be considered, and not the effect of any other indicia or brands that may appear with it or in proximity. Such contextual factors do not form part of the trademark the Applicant seeks to register and nothing would prevent the Applicant from using the Mark without them. Likewise, at least under a section 12(1)(d) ground of opposition, it is the effect of the Opponent’s registered trademark *itself* that must be considered, and not the effect of any accompanying indicia or brands. Such contextual factors do not limit the scope of the opponent’s registration.

[92] I would also note that the newspaper and magazine advertisements at Exhibit 7 to Mr. Zhang’s affidavit suggest that the Mark may be used in contexts where the dealership branding is less clear cut. The second advertisement—branded at the top with the Mark and word CHANGAN—features vehicles that appear to be from the Applicant, including an automobile identified as a “CHANGAN CS35 AUTOMATICA” with the Mark on its grille and a truck branded on its side with the word CHANGAN and the Arrowhead Logo. By contrast, the third advertisement appears to be for an AUTOSTAR dealership that sells the Applicant’s vehicles under the CHANA brand instead of CHANGAN and also a third party’s FOTON brand vehicles. This advertisement’s footer is branded with (i) an AUTOSTAR logo, (ii) the word CHANA with the Mark and Arrowhead Logo, and (iii) the word FOTON with the inverted triangle logo that Mr. Booth’s affidavit indicates is registered in the name of Beiqi Foton Motor Co., Ltd. The vehicles featured include a “CHANA CS35” automobile with the Mark on its grille, a “CHANA HONOR” minivan with the Arrowhead Logo on its grille, and a “FOTON TUNLAND” pickup truck with the inverted triangle logo on its grille (the minivan’s logo is somewhat difficult to make out but is shown clearly on the similar “Honor” minivan in the fourth advertisement). Mr. Zhang offers no explanation of the brands AUTOSTAR, CHANA, or FOTON, or of the Arrowhead Logo or inverted triangle logo. In the absence of any explanation or evidence to the contrary, this advertisement is consistent with the potential for dealerships to carry vehicles branded with the Mark alongside differently-branded vehicles that may or may not originate from the Applicant.

[93] I would also note that, in *Loblaws v Columbia*, a related factor served to decrease the likelihood of confusion: the defendant sold its goods as a direct seller while consumers would know that the plaintiff does not sell its goods through that channel. By contrast, in the present case, the evidence is that both parties sell their goods through automotive dealerships and there is no evidence to suggest that the Applicant’s dealerships would follow a fundamentally different sales model than those of the Opponent.

[94] Accordingly, I do not find that the contextual factors in this case assist the Applicant.

### Enhanced significance of automobile manufacturers' brands

[95] The Applicant further submits that the word ACURA, typically displayed in close proximity to the Shaded Acura Logo, not only indicates the source of the goods but also has an “enhanced significance” that reduces any likelihood of confusion [written argument para 16]. More particularly, the Applicant submits that, when automobile buyers start their decision to purchase a particular brand of vehicle, they already know who the manufacturer is, and it is “inconceivable” that a person considering buying one of the Opponent’s automobiles would decide to travel to one of the Applicant’s dealerships or *vice versa*, even if that person is familiar with the competitor’s mark [para 17]. In support, the Applicant cites *American Pacific Industries*, where the significance of such advanced knowledge was recognized.

[96] However, in *American Pacific Industries*, there was expert evidence (that of Mr. Duval) attesting to the fact that consumers decide on a manufacturer’s brand (*e.g.* HONDA) and model (*e.g.* CIVIC) that fits their needs and price range before choosing a specific motor vehicle to purchase. It was on that basis that the “enhanced significance” of the manufacturer’s brand was accepted. There is no such evidence in the present case.

[97] At best, I can accept that consumers shopping for expensive or important goods such as automobiles are likely to be somewhat more alert and attentive to the trademarks encountered and the brands associated with them [*Masterpiece, supra*]. This phenomenon could decrease the likelihood of confusion for those consumers who happen to recall being at an ACURA-branded dealership when they saw the Shaded Acura Logo and are aware of being in a CHANGAN-branded dealership when they subsequently encounter the Mark. Having said that, the Supreme Court confirmed in *Masterpiece* that, even if consumers in the market for expensive goods may be less likely to be confused when they first encounter a trademark, the test is still one of imperfect recollection and first impression.

[98] On balance, I find that this factor slightly favours the Applicant.

### Original equipment manufacture and aftermarket supply

[99] The Applicant further submits that a logo on automobile parts has no impact on the purchasing decision, because purchasers decide ahead of time whether to buy from the original



equipment manufacturer whose brand of automobile they are repairing or from an aftermarket supplier. Moreover, according to the Applicant, parts are typically (i) purchased through a parts catalogue or site online, both of which are branded with the manufacturer's name and logo, and (ii) installed by a mechanic, so that the purchaser never sees the goods. However, the Applicant provides no evidence to support these contentions. In any event, when assessing the likelihood of confusion, the question to be asked is not whether the average consumer will already be familiar with the brands involved and base the purchasing decision on something other than the trademark displayed on the goods. Rather, it is whether a casual consumer with only a general recollection of the opponent's trademark would be likely to think, as a matter of first impression, that goods bearing the applicant's trademark might come from the same source. Accordingly, the alleged circumstances surrounding the purchase of parts do not assist the Applicant.

#### Scope of protection afforded to stylized letters

[100] The Applicant submits that all "simple logos dominated by a single letter" have a narrow ambit of protection, even when they have been used for a long time [written argument para 11]. In support, the Applicant cites several decisions in which no likelihood of confusion was found between trademarks consisting of one or two stylized letters or shapes generally resembling a letter [written argument paras 29, 53].

[101] The Opponent, for its part, submitted at the oral hearing that any actual distinctiveness a stylized letter has acquired cannot be ignored. The Opponent further submitted that the cases cited by the Applicant can be distinguished because factors other than resemblance militated against a likelihood of confusion, including differences in the nature of the goods, the nature of the trades, and the contexts in which the trademarks were displayed, as well as evidence of coexistence in the marketplace. The Opponent also noted that some of the cited decisions predate the Supreme Court's guidance in *Masterpiece* and as such might have accorded less importance to the degree of resemblance between the trademarks.

[102] It has been held that a single trader should not be entitled to obtain exclusive property rights over a letter or combination of letters that happen to be its initials, to the detriment of other traders who may have the same initials [*Acklands v Anamet* (1996), 67 CPR (3d) 478 (FCTD); *Alfred Grass v Grant Industries* (1991), 47 FTR 231, citing *GSW, supra*]. In *GSW*, the Federal

Court explained that “the natural inclination of an observer is to relate the letters back to the source of their derivation and think in terms of the corporate names, which are substantially different, and of which the letters are in reality abbreviations” [at para 67]. However, in the present case, neither A nor V is an initial from the parties’ corporate names. While A is the initial of the brand of car to which the Shaded Acura Logo is applied, that is not the scenario contemplated in *Acklands* and *Alfred Grass*, and the Opponent is not claiming an exclusive right to the Applicant’s initial. Moreover, as discussed above, it is doubtful whether the average consumer would perceive a letter of the alphabet in either trademark as a matter of first impression. On this basis, the present case is distinguishable from *GSW*, *Alfred Grass*, and *Loblaws v Columbia*, as well as *Loblaws v Peek & Cloppenburg* (2009), 76 CPR (4th) 213 (TMOB) and *BBM v Research in Motion*, 2012 FC 666.

[103] On a similar basis, the present case is also distinguishable from *Mitre Sports v Inaria*, 2016 TMOB 187. In that case, the applicant’s trademark and the most similar of the opponent’s trademarks each consisted of a much simpler chevron, and the opponent’s trademark was found to possess a relatively low degree of inherent distinctiveness specifically because it could be perceived as the letter V. I would also note that, in *Mitre*, there was no evidence of the opponent’s trademark having acquired any distinctiveness in the marketplace.

[104] In view of the foregoing, I do not find that a narrower ambit of protection is warranted in the present case.

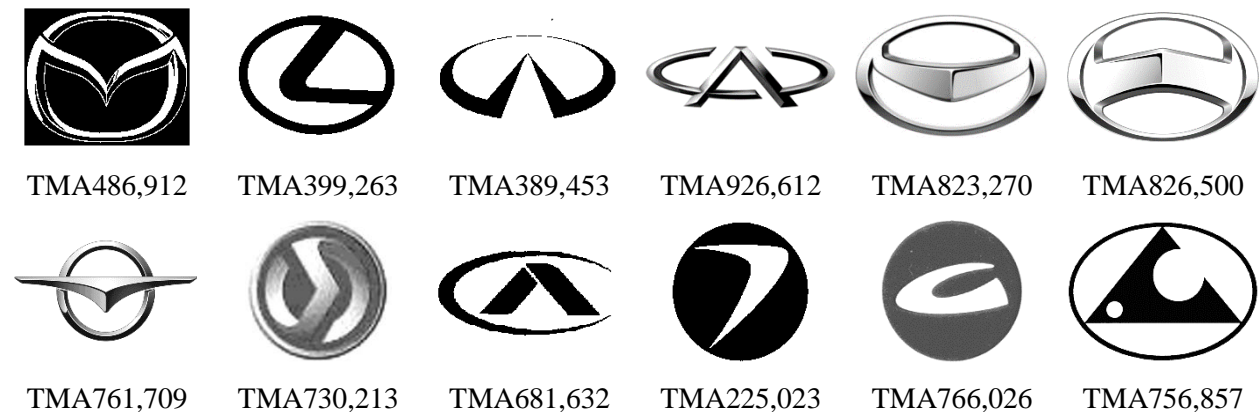
#### State of the register and state of the marketplace

[105] The Applicant further submits that the portion of the Canadian public that purchases automobiles has “become accustomed to automobile logos that are composed of simple graphics enclosed in a circle/oval” and as such is inclined to notice minor differences between such logos [written argument para 13]. In the Applicant’s submission, the Mark and the Shaded Acura Logo have in common that they are each “a simplified logo dominated by a single letter” and “simplified automobile logos with a circular/oval border” [paras 11, 43].

[106] The common occurrence of a certain element in trademarks tends to cause purchasers to pay more attention to the other features of the trademarks and to distinguish between them by

those other features [see *Polo Ralph Lauren Corp v United States Polo Assn* (2000), 9 CPR (4th) 51 (FCA); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. In the present case, Mr. Booth provides evidence of 89 registrations for trademarks consisting of relatively simple logos that are more or less round in shape, registered for use in association with motor vehicle goods and services, which generally include automobiles.

[107] However, automobile purchasers accustomed to distinguishing between simple, round logos would not necessarily be accustomed to distinguishing between ones featuring a single chevron shape. Of the trademarks identified by Mr. Booth, only the following 12 (standing in the names of 11 different owners) consist solely of a chevron shape with a circular or somewhat circular background or frame:



[108] I note that none of the chevrons in the above-referenced trademarks is composed of two diamond-like shapes or is reminiscent of the same type of pincers or beak as in the parties' trademarks. Although not determinative, I would also note that only the first of the trademarks depicted above has a frame whose shape is roughly that of a rounded square (or, as the Opponent puts it, a circle with flattened sides).

[109] Where a large number of relevant trademarks is identified on the register, the Registrar can infer that the element they all have in common is used in the marketplace; however, where the number of trademarks identified is not large, evidence of such use needs to be furnished [see *Maximum Nutrition, supra*; *McDowell v Laverana GmbH & Co KG*, 2017 FC 327; and *Canada Bread Company, Limited v Dr Smood APS*, 2019 FC 306] In the present case, I am not satisfied that the number of registrations above—some for trademarks quite different than those of the

parties—is sufficient to enable me to draw any meaningful inferences regarding the state of the marketplace and consumers’ ability to distinguish between more similar chevron designs.

[110] However, the Applicant has also furnished evidence of use of some of the trademarks. Specifically, Mr. Duval states that the three logos depicted below have been affixed to the exterior of new cars sold in Canada and Mr. DesRosiers, provides annual Canadian sales figures from the 1990s to 2017 for the brands of car to which Mr. Duval states these logos are affixed:



TMA486,912  
(Mazda Logo)



TMA399,263  
(Lexus Logo)



TMA389,453  
(Infinity Logo)

[111] Read together, the evidence of Mr. DesRosiers and Mr. Duval suggests that between 1 and 15 thousand new automobiles were sold in Canada in association with the Infinity Logo each year from 1995 to 2017; between 1 and 25 thousand in association with the Lexus Logo each year from 1995 to 2017; and between 25 and 90 thousand in association with the Mazda Logo each year from 1998 to 2017 [DesRosiers paras 10, 11, 16; Duval paras 33, 34, 36].

[112] Mr. DesRosiers also provides sales figures for six other automobile brands: Hyundai, Totota, Mercedes, Volkswagon, Subaru, And BMW. However, the logos Mr. Duval associates with those brands do not consist of a solitary chevron within a circular frame. During the oral hearing, the Applicant submitted that the purpose of Mr. DesRosiers’ and Mr. Duval’s affidavits is to demonstrate the widespread acceptance of simple automobile logos consisting of a letter within a ring; however, in my view, only two of the additional logos feature a design that could be interpreted as representing a single letter:



TMA392,339  
(Hyundai Logo)



TMA376,774  
(Toyota Logo)

[113] Although an H shape is recognizable in the Hyundai Logo and a T shape in the Toyota Logo, given the high degree of stylization and visual difference from the Mark and Acura Logos,

I do not find this additional evidence to be of assistance in establishing the commonality of the features shared by the parties' trademarks in the present case.

[114] With respect to the Mazda Logo, Lexus Logo, and Infinity Logo, considering the sales levels to which Mr. DesRosiers attests, and bearing in mind the visibility of brands on cars driven by the general public, I am prepared to accept that the average automobile consumer would be somewhat accustomed to differentiating between brands featuring framed chevron shapes. However, I do not find the evidence sufficient to establish that the average automobile consumer would be accustomed to differentiating between pincer- or beak-like shapes, or between chevrons in the particular style of the parties' trademarks.

[115] On balance, I find that this factor favours the Applicant, but only slightly.

#### Coexistence of similar trademarks

[116] The Applicant submits that the coexistence of the H Logo with the Hyundai Logo depicted above, for decades, as well as the coexistence of the Mazda Logo, Lexus Logo, and Infinity Logo, is proof that the Canadian public will immediately see the "significant differences" between the Mark and the Shaded Acura Logo, such that these two trademarks should be permitted to coexist as well [written argument paras 11, 13]. In the Applicant's submission, the differences between the Mark and the Shaded Acura Logo are much greater.

[117] However, a finding with respect to the likelihood of confusion between the H Logo and Hyundai Logo—or among the Mazda Logo, Lexus Logo, and Infinity Logo—would not assist in determining the likelihood of confusion between the Shaded Acura Logo and the Mark. Regardless of any previous positions taken by the Opponent or the Registrar in respect of trademarks unrelated to the Mark, I must come to a determination as to confusion in the case before me that is in accordance with the Act and the relevant jurisprudence, and that has regard to the particular facts of the present case [see *Molson Breweries v Labatt Brewing Co* (1996), 68 CPR (3d) 202 (FCTD)].

[118] In this respect, to the extent that the Applicant relies on the coexistence of pairs of arguably similar trademarks on the register that have not been opposed, I would also note that this Board is not in a position to explain examiners' findings. Examiners do not have before them

the evidence and arguments that are filed by the parties in an opposition proceeding, and the onus is different at the examination stage, where the Registrar must be satisfied that a trademark is *not* registrable to refuse it under section 37 of the Act [see *Simmons IP Inc v Park Avenue Furniture Corp* (1994), 56 CPR (3d) 284 (TMOB); and *Proctor & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 (TMOB)].

[119] Therefore, I do not consider the coexistence of different pairs of trademarks on the Register to be a surrounding circumstance that assists the Applicant.

#### Registration in foreign jurisdictions

[120] Finally, I agree with the Opponent that the Applicant's evidence of registration of the Original Mark and Mark in a number of foreign countries [Exhibits 4-5] is irrelevant, particularly in the absence of evidence regarding the state of the marketplace and the law governing trademark registration in those jurisdictions. While evidence of significant, co-extensive use of two trademarks in another jurisdiction without any actual confusion arising may sometimes be a relevant consideration, the mere existence of a trademark on foreign registers is not [*Vivat Holdings Ltd v Levi Strauss & Co* (2005), 41 CPR (4th) 8 (FCTD)]. Moreover, the Applicant does not provide any evidence to suggest that Canadians have become aware of the Mark in view of its registration and reputation abroad. Accordingly, this factor does not assist the Applicant.

#### **Conclusion with respect to confusion**

[121] As noted above, the onus is not on the Opponent to show that confusion is likely but rather on the Applicant to satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion. The presence of a legal onus on the applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

[122] In the present case, analysis of all the surrounding circumstances leads me to conclude that the Applicant has failed to demonstrate, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Shaded Acura Logo. I reach this conclusion owing primarily to the considerable degree of resemblance between the parties' trademarks; the length of the Shaded Acura Logo's use and the extent to which it has become

known in Canada, compared to the absence of evidence of the Mark being used or becoming known in Canada; and the considerable similarity in the nature of the parties' goods and trades. Despite the fact that the Shaded Acura Logo has only a moderate level of inherent distinctiveness, I do not find the likelihood of confusion to be significantly lowered by the presence of the other chevron logos on the register and in the marketplace.

[123] I reach this conclusion bearing in mind the potential for car manufacturers' brands to have enhanced significance when consumers with an imperfect recollection of a certain automobile logo first encounter another, similar logo. If it had been shown that the Mark had in fact become known in Canada as a result of sales over a significant period of time with no evidence of actual confusion, my conclusion may perhaps have been different.

[124] In view of all the foregoing, I find that the Applicant has not met its legal onus to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Shaded Acura Logo. The ground of opposition based on registrability of the Mark under section 12(1)(d) of the Act is therefore successful.

#### GROUND OF OPPOSITION BASED ON ENTITLEMENT TO REGISTRATION UNDER SECTION 16(3)(A)

[125] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark because, at the Application's filing date, namely September 2, 2015, the Mark was confusing with (i) each of the Opponent's Trademarks and "other variations thereof", which had been previously and continuously used in Canada by the Opponent in association with "the goods and services identified", and (ii) the Opponent's "family" of trademarks previously used in Canada, including the five Opponent's Trademarks and variations thereof.

[126] To meet its initial burden under this ground, the Opponent must evidence not only use of its trademark prior to the Application's filing date of September 2, 2015, in accordance with section 16(3)(a) of the Act, but also that its trademark had not been abandoned when the Application was advertised on July 20, 2016, as stipulated in section 16(5). Abandonment requires both an absence of use and an intention to abandon use [*Labatt Brewing Co v Formosa Spring Brewery Ltd* (1992), 42 CPR (3d) 481 (FCTD); *Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)].

[127] I find that comparing the Mark with the Shaded Acura Logo will again effectively decide the ground of opposition. I also find that Mr. Leclerc's evidence of use of the Shaded Acura Logo in association with automobiles and structural parts thereof as set out above under the section 12(1)(d) ground of opposition is sufficient to meet the Opponent's evidential burden in respect of this trademark. The onus is thus on the Applicant to satisfy the Registrar, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Shaded Acura Logo at the Application's filing date.

[128] The earlier material date does not significantly alter the results of the analysis. However, since the non-entitlement ground of opposition is based on the Opponent's actual use of its trademarks, the manner and context in which the Shaded Acura Logo is used is more relevant.

[129] In this respect, the colour scheme of the Shaded Acura Logo in actual use could become important. However, as noted above, Mr. Leclerc's evidence shows that the framed chevron in the Shaded Acura Logo is often light silver with a dark surface showing through its transparent base, and his evidence also includes examples of it displayed with a dark base colour as of 2001. As also noted above, when the Shaded Acura Logo is affixed to the frame of a blue car, the base colour will appear blue. Accordingly, I do not find that the Applicant's colour claim gains any substantial significance under this ground.

[130] I also note that much of Mr. Leclerc's evidence shows the Shaded Acura Logo displayed in proximity to the word ACURA and occasionally other ACURA Branding. In some cases, the proximity is sufficient to create a composite word and design trademark and, to the extent that the Opponent would need to rely on such a composite trademark, its case would not be quite as strong. Nevertheless, as discussed under the previous ground, nothing prevents two trademarks from being used at the same time so long as they are not combined in a way that renders the individual marks indistinguishable. In the present case, I find that the Shaded Acura Logo stands out sufficiently from the composite trademarks to also be identifiable as a distinct trademark. Moreover, the evidence also includes examples of the Shaded Acura Logo displayed on its own on certain parts of automobiles, on automobile parts, and in advertising. In the circumstances, I am satisfied that the Shaded Acura Logo has become known in its own right to at least some



extent, such that the section 6(5) factors concerning the length of use of the parties trademarks and the combination of inherent and acquired distinctiveness continue to favour the Opponent.

[131] Furthermore, although I also find that the proximity of the ACURA brand could take on increased significance as a contextual factor under the entitlement ground based on prior use, I do not find this factor sufficient to tip the balance in the Applicant's favour in the present case. First, the evidence establishes that the Opponent is entitled to registration of the Shaded Acura Logo on its own and I am not satisfied from the evidence that its use in proximity to the word ACURA has given it a secondary meaning as an acronym. Second, it remains the effect of the Applicant's mark *itself* that must be considered, and thus the addition of the CHANGAN branding is of no additional assistance to the applicant's case.

[132] Finally, I note that under the entitlement ground, the Opponent pleads a family of trademarks previously used in Canada including the five Opponent's Trademarks *and variations thereof*. At the oral hearing, the Opponent relied on the two Acura Logos and the composite trademarks formed by use of these logos with the word mark ACURA to constitute a family.

[133] However, as discussed above, I consider the two Acura Logos to be essentially different colour versions of the same trademark as opposed to being two different trademarks within a family. Furthermore, although I find that some instances of use of the word ACURA immediately above or following the Acura Logos may be interpreted as use of a composite trademark (in addition to being recognizable as use of separate word and design trademarks), I am not convinced that adding the word ACURA in this manner creates a meaningful family of trademarks. More specifically, I do not consider that the use of such a composite trademark would prompt consumers to believe more easily that goods branded with the Mark come from the same source as goods branded with the Shaded Acura Logo. In any event, as noted above, two trademarks is insufficient to constitute a family.

[134] Consequently, the ground of opposition pleading non-entitlement based on prior use is successful as well.

## GROUND OF OPPOSITION BASED ON DISTINCTIVENESS OF THE MARK UNDER SECTION 2

[135] The Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act, in that the Mark will not distinguish, as it is not adapted to distinguish, the Goods from the goods and services of others and, in particular, from the goods, services, and business in association with which the Opponent has used the Opponent's Trademarks and "its family of marks".

[136] The material date for this ground of opposition is December 16, 2016, the date the statement of opposition was filed [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. To succeed, an opponent relying on its own trademark must establish that, as of this date, its trademark had become sufficiently known in Canada to negate the distinctiveness of the applicant's trademark [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. If this initial burden is met, the applicant will then have the legal onus of showing, on a balance of probabilities, that the mark it seeks to register was adapted to distinguish or actually distinguished its goods and services from those of the opponent. In this respect, an applicant must establish that its trademark was not likely to create confusion with the opponent's trademark at the material date [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[137] It is not necessary to address this ground of opposition in detail. To the extent that the Opponent will have met its initial burden, the applicant's case will be no stronger than it was at the material date for assessing confusion under the entitlement ground of opposition. Thus the outcome of the distinctiveness ground would be the same and, accordingly, this ground of opposition would succeed as well.

## GROUND OF OPPOSITION BASED ON INTENT TO USE THE MARK UNDER SECTION 30(E)

[138] The Opponent pleads that the Application does not comply with the requirements of section 30(e) of the Act in that the Applicant could not have had a *bona fide* intention to use the Mark in Canada in association with the Goods, because, at the filing date of the Application, the Applicant must be deemed to have been aware of the Opponent's prior rights in each of the

Opponent's Trademarks and in the family of marks comprising the Opponent's Trademarks, with all of which the Mark is confusing.

[139] In support, the Opponent's evidence includes a certified copy of the Applicant's prior application no. 1,549,392 to register the Original Mark, which was abandoned following the receipt of a statement of opposition from the Opponent relying on the Opponent's Trademarks and its alleged family of marks.

[140] However, even if the Applicant had been aware of the Opponent's trademarks, the mere existence of an allegedly confusing trademark does not preclude an applicant from having a *bona fide* intention to use the specific trademark it is applying to register.

[141] Furthermore, I agree with the Applicant that withdrawing an application to register a particular trademark is not evidence that the applicant later lacked the intention to use a related trademark.

[142] Finally, I note the Opponent's allegations, discussed more fully below, that the Applicant acted in bad faith in filing the application to register the Original Mark based on use in Canada and in submitting a specimen of use of the Mark to the United States Patent and Trademark Office (USPTO). However, an incorrect claim of use would not necessarily have been made in bad faith or without an intention to use.

[143] Consequently, this ground of opposition is dismissed, as the Opponent has failed to meet its evidential burden.

#### GROUND OF OPPOSITION BASED ON SATISFACTION OF ENTITLEMENT TO USE UNDER SECTION 30(I)

[144] The Opponent also pleads that the Application does not comply with the requirements of section 30(i) of the Act, because, at the Application's filing date or any other material time, the Applicant could not have been satisfied it was entitled to use the Mark in Canada in association with the Goods, having regard to the allegations set forth in the other grounds of opposition and in view of the following:

- The Applicant was well aware or should be deemed to have been aware of the Opponent's earlier adoption and use in Canada of each of the Opponent's Trademarks,

which were registered in Canada, and of the family of marks comprising the Opponent's Trademarks, particularly in view of the fact that the Opponent had previously opposed the Applicant's Canadian application to register the nearly identical Original Mark.

- Use of the Mark in association with the Goods in Canada would (i) have the effect of depreciating the value attached to the Opponent's Trademarks contrary to section 22 of the Act; (ii) violate section 7 of the Act; and (iii) infringe the Opponent's copyright in its "artistic works".

[145] Section 30(i) of the Act merely requires that an applicant include a statement in its application that it is satisfied it is entitled to use the trademark in Canada in association with the goods or services described in the application. However, awareness of an allegedly confusing trademark does not in itself preclude an applicant from being satisfied of its own entitlement to use the mark it is applying to register. Even an applicant who is found not to be entitled to registration may be entitled to use the trademark without registration. Similarly, an applicant whose previous application for the same or a similar trademark was voluntarily withdrawn or successfully opposed may prevail in an opposition proceeding against a subsequent application, owing to changes in the factual circumstances, the evidence presented, and the material dates.

[146] Accordingly, where, as here, the required statement is included in the application, an opponent may only rely on section 30(i) in specific cases, such as where bad faith is alleged or where a *prima facie* case of non-compliance with a federal statute arguably prevents registration [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); *Interactiv Design Pty Ltd v Grafton-Fraser In.* (1998), 87 CPR (3d) 537 (TMOB); and *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB)].

### **Allegation of bad faith**

[147] In the present case, there are no specific allegations of bad faith or fraud in the statement of opposition and there is no evidence in the record to that effect. The Opponent submits that the claim of use in Canada in the application for the Original Mark is evidence of bad faith, to the extent that one would have expected any actual use of the Original Mark to be evidenced in the present case (the Mark being essentially a version of the Original Mark in a specific colour

scheme). However, an error in claiming use of a trademark in a prior application is not evidence that the Applicant was not satisfied of its *entitlement* to use that trademark, or a specific version thereof, and is not evidence that the Applicant stated it was so satisfied in bad faith.

[148] At the oral hearing, the Opponent cited a ruling made by the USPTO in a cancellation proceeding the Opponent has brought against the Mark's registration in the United States based on a specimen of use filed with the USPTO; the ruling refers to the Applicant's admission that it had not sold the product shown in the specimen. However, foreign decisions are not binding on the Registrar and, although such decisions can sometimes have persuasive value, I do not find the decision referenced by the Opponent to be relevant. In particular, the USPTO did not decide whether the Applicant had acted in bad faith or made an innocent misstatement; indeed, the USPTO also noted the Applicant's denial of the allegation that it had not used the Mark in U.S. commerce. Furthermore, even if the U.S. file history were in evidence before me, the submission of an incorrect specimen of use in the United States is not evidence that the Applicant was not satisfied of its entitlement to use the Mark in Canada.

[149] The Opponent also submitted at the oral hearing that, since V is not the initial of the Applicant or its brand, the Applicant's choice of a V shape for its logo, with only small differences from the Shaded Acura Logo, suggests an attempt to trade off the latter's goodwill. However, I do not find the Applicant's choice not to depict its initial sufficient for an inference that the resemblance between the two trademarks is owed to bad faith.

### **Compliance with federal legislation**

[150] The Opponent also alleges non-compliance with sections 7 and 22 of the Act and, implicitly, with the *Copyright Act*, RSC 1985, c C-42. The Registrar has previously considered such grounds of opposition to be valid, under the general principle that registration of a mark cannot be condoned if its use would violate federal legislation [see *Bojangles' International LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553 (TMOB); and *Institut national des appellations d'origine v Pepperidge Farm Inc.* (1997), 84 CPR. (3d) 540 (TMOB)]. As noted above, an opponent may rely on such grounds where there is a *prima facie* case of non-compliance with the federal statute.

[151] In the present case, I am not satisfied that the Opponent has met its evidential burden under this branch of the ground, for the following reasons.

### Section 22

[152] Section 22 of the Act provides that no person shall use a trademark registered by another person “in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto”. The trademark used need not be identical but must be “sufficiently similar ... to evoke in a relevant universe of consumers a mental association of the two marks that is likely to depreciate the value of the goodwill attaching to the [registered] mark” [*Veuve Clicquot, supra*, at para 38]. It is necessary to establish not only the sufficient similarity but also the likelihood of both the mental association or “linkage” and its effect being depreciation of the goodwill, with “likelihood” being “a matter of evidence not speculation” [see the discussion of the first, third, and fourth elements of section 22 *ibid.* at paras 56-61, 67-68].

[153] In the present case, even if I were to find that the parties’ trademarks are “sufficiently similar”, the Opponent has not submitted any evidence to indicate that the Mark would be used in a manner likely to depreciate the value of the Opponent’s goodwill. At the oral hearing, the Opponent submitted that it follows from the likelihood of confusion that the design of the Acura Logos will be diluted. Indeed, the value of goodwill can be depreciated by “the lesser distinctiveness that results when a mark is bandied about by different users” and by “the notions of the ‘blurring’ of the brand image ... or of its positive associations, or a ‘whittling away’ of its power to distinguish ... and attract consumers” [*Veuve Clicquot, supra* at paras 63-65]. Moreover, likelihood being a matter of evidence does not prevent drawing inferences from the evidence “in appropriate cases” [*Boulangerie Vachon Inc v Racioppo*, 2021 FC 308 at para 115]. However, in the present case, although I am not satisfied the Applicant has met its legal onus under the previous grounds, I find the evidence insufficient for an inference that the Mark would necessarily be used in a manner likely to depreciate the value of the goodwill attached to the Opponent’s Trademarks.

[154] In particular, whereas I did not find the contextual factors surrounding the parties’ branding and the coexistence of simple chevron logos on the Register sufficient to tip the balance in the Applicant’s favour under the previous grounds, such factors may be relevant in

determining whether the manner in which the Mark is used is likely to depreciate the value of the Opponent's goodwill. So might evidence of the enhanced significance of automobile manufacturers' brands and the mechanisms by which vehicle parts are purchased. In the present case, there is no evidence to suggest the Mark would *not* be used in a manner that leaves the Opponent's goodwill intact and no evidence to suggest the Applicant was not satisfied it could use the Mark in such a manner. Accordingly, I am not satisfied the Opponent has provided sufficient evidence for a *prima facie* case.

### Section 7

[155] With respect to the allegation that use of the Mark would violate section 7 of the Act, the ground is insufficiently pleaded. As the Opponent does not specify which subsection is alleged to be violated, the pleading does not provide sufficient material facts to enable the Applicant to reply. Once evidence is filed, the Registrar must take it into account when interpreting the pleadings [per *Novopharm Ltd v AstraZeneca AB*, 2002 FCA 387]. However, in the present case, the Opponent has not provided any evidence to suggest that the Applicant has violated a particular subsection of section 7.

[156] At the oral hearing, the Opponent submitted that it follows from the fame of the Acura Logos that they would have goodwill and that it follows from the likelihood of confusion that use of the Mark would constitute a misrepresentation resulting in damage in the form of confusion and brand dilution. Thus it appears the Opponent's intention may have been to plead passing off under section 7(b) of the Act, which requires (i) the existence of goodwill; (ii) deception of the public due to a misrepresentation; and (iii) actual or potential damage [*Kirkbi AG v Ritvik Holdings Inc*, 2003 FCA 297, aff'd 2005 SCC 65; and *Ciba-Geigy Canada Ltd v Apotex Inc*, [1992] 3 SCR 120]. However, I do not find that the Opponent's evidence either suggests this interpretation or would suffice to meet the Opponent's initial burden for a *prima facie* case.

[157] Again, while I did not find the contextual factors surrounding the parties' branding or the Applicant's arguments regarding the increased significance of automobile manufacturers' brands and the mechanisms by which vehicle parts are purchased to decrease the likelihood of confusion under the test for the previous grounds, such considerations may well be relevant to a determination of potential damages. I accept that an inference of damage *may* be drawn *if* a loss

of control over the use and commercial impact of a plaintiff's trademark is implicit in a defendant's confusing use [see *e.g. Boulangerie Vachon Inc v Racioppo*, 2021 FC 308]. However, in the present case, for the reasons discussed above, there is no basis to infer that the Applicant would actually use the Mark in a manner that would lead to such a loss of control or depreciate the Opponent's goodwill.

#### Copyright Act

[158] Finally, I am not satisfied that the Opponent has met its evidential burden for a *prima facie* case of copyright infringement, which would require establishing ownership of copyright and substantial copying. In this respect, suffice it to say that the Opponent has filed no evidence of its ownership of any copyright subsisting in the Shaded Acura Logo design or in any of the other designs in the Opponent's Trademarks. The magazine excerpt attached as Exhibit D to Mr. Leclerc's affidavit is insufficient in this respect: it describes the derivation of the Acura Logos but neither the article nor Mr. Leclerc identifies the authors of the design, explains their relationship to the Opponent and the circumstances under which the logo was created, or otherwise establishes that the Opponent acquired copyright in the design, either as its first owner or by assignment.

[159] Consequently, the section 30(i) grounds of opposition are dismissed as well, as the Opponent has failed to meet its evidential burden.

#### DISPOSITION:




[160] In view of all the foregoing and 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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Oksana Osadchuk  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



SCHEDULE A

<b>Reg. No. / Trademark</b>	<b>Goods / Services</b>
<p>TMA855,018</p>  <p><i>Acura Logo Design</i></p>	<p>Automobiles and structural parts thereof.</p>
<p>TMA388,350</p>  <p><i>H &amp; Design</i></p>	<p>Automobiles.</p>
<p>TMA578,922</p>  <p><i>H &amp; Design</i></p>	<p>(1) Parts and accessories for motorized two-wheel vehicles, namely, radiator wash, radiator liquid; additives to gasoline.</p> <p>(2) Parts and accessories for motorized two-wheel vehicles, namely, touch-up paints.</p> <p>(3) Parts and accessories for motorized two-wheel vehicles, namely, waxes.</p> <p>(4) Engine oil; additives to gasoline.</p> <p>(5) Motorcycle accessories, namely number plates.</p> <p>(6) Parts and accessories for motorized two-wheel vehicles, namely, filters; internal combustion engines; industrial and marine equipment, namely outboard motors; agricultural machines, namely power tillers and their parts; machines and implements for agricultural, horticultural, gardening and forestry uses, namely tillers; attachments for use with tractors and tillers, namely, hillers, plows, iron wheels, mulchers, drum rotors, cage rotors, spiral rotors, screw rotors, rotary, screw and fixed blade cultivators, cultivator wheels, furrowers, ridgers, planting openers, float skids, rakes, seeders, mowers, sweepers, rollers, graders, crawlers, hoppers, sprayers, reapers, sickles, pumps, snow plows; accessories for use with machines and implements for agricultural, horticultural, gardening and forestry uses, namely tractors, tillers; attachments for use with tractors and tillers, namely, hillers, plows, iron wheels, mulchers, drum rotors, cage rotors, spiral rotors, screw rotors, rotary, screw and fixed blade cultivators, cultivator wheels, furrowers, ridgers, planting openers, float skids, rakes, seeders, mowers, sweepers, rollers, graders, trailers, wheeled carriers, crawlers, hoppers, sprayers, reapers, sickles, pumps, snow plows, namely power take-off shafts, extension shafts, lighting cols, pullies; and parts and components for all the aforesaid wares; machines and implements for agricultural, horticultural, gardening, home and forestry uses, namely, tillers, lawn mowers, riding mowers and trimmers, snow blowers, snow plows, and integral parts and components for these wares; transmissions for the aforementioned wares; generators,</p>

water pumps, general purpose engines, and tillers; generators, namely electric generators and their parts; alternating current generators, direct current generators, starters, alternating current motors, direct current motors, motors other than for land vehicles, namely internal combustion engines; plowing machines and implements, namely power tillers; cultivating machines and Implements, namely planters, welding machines, fertilizer distributors, seeders; harvesting machines and Implements, namely reapers; marine equipment, namely outboard motors; outboard engines and their parts; water pumps and structural and functional parts thereof; driving chains, brake friction pads, pistons, by-pass oil filters, drive shafts, water pumps, brake shoes, distributors, air cleaner, pumps for power steering; water pumps and structural parts and fittings therefor; accessories for automobiles, namely, ignition systems for engines of land vehicles, ventilators and cylinders for engines of land vehicles; motorcycle accessories, namely exhaust controls; ignition systems for engines of land vehicles.

(7) Parts, components, fittings and accessories for vehicles, namely automobiles, motorcycles, scooters, all terrain vehicles, sports utility vehicles, motor trucks, vans, buses, motor cars, motor-driven four-wheeled buggies, bicycles, tricars, tricycles, electric vehicles, namely automobiles, single-seater small-sized electric vehicles, one-seater hybrid cars, namely, altimeters, humidity gauges, temperature gauges, ammeters, inclinometers, tachometers, switches, antennas, cases for cassettes; motorcycle accessories, namely face shields; helmets for motorcyclists; image (reflection) processing systems by an infrared camera for motorcars for assistance of visibility, navigation assistance systems by an infrared camera for motorcars, infrared vision cameras and their parts and fittings; acoustic system for motorcars, including car stereos and its speakers; electric batteries; electroanalytic rust defector or rust detecting apparatus, namely electrolytic tester for detecting rust on automobile parts, such as engine mounts; computer software programs used to control functions of apparatus for locomotion by land, air and water, namely automobiles, motorcycles, boats, planes, rockets and robots and their parts.

(8) Parts, components, fittings and accessories for vehicles, namely automobiles, motorcycles, scooters, all terrain vehicles, sports utility vehicles, motor trucks, vans, buses, motor cars, motor-driven four-wheeled buggies, bicycles, tricars, tricycles, electric vehicles, namely automobiles, single-seater small-sized electric vehicles, one-seater hybrid cars, namely air conditioners; accessories for use with machines and implements for agricultural, horticultural, gardening and forestry uses, namely tractors, tillers; attachments for use with tractors and tillers, namely, hillers, plows, iron wheels, mulchers, drum rotors, cage rotors, spiral rotors, screw rotors, rotary, screw and fixed blade cultivators, cultivator wheels, furrowers, ridgers, planting openers, float skids, rakes, seeders, mowers, sweepers, rollers, graders, crawlers, hoppers, sprayers, reapers, sickles, pumps, snow plows, namely head lights and parts and components for all the aforesaid wares; parts, components, fittings and accessories for vehicles, namely automobiles, motorcycles, scooters, all terrain vehicles, sports utility vehicles, motor trucks, vans, buses, motor cars, motor-driven four-wheeled buggies, bicycles, tricars, tricycles, electric vehicles, namely automobiles, single-seater small-sized electric vehicles, one-seater hybrid cars, namely headlights; parts and accessories for motorized two-wheel vehicles, namely, heaters, fog lamps, stop lamps, turn signal lamp sets for motorcycles, head lamp protectors, head lamp covers; headlights, light bulbs for directional signals for vehicles.

(9) Vehicles, namely automobiles, motorcycles, scooters, all terrain vehicles, sports utility vehicles, motor trucks, vans, buses, motor cars, motor-driven four-wheeled buggies, bicycles, tricars, tricycles, electric vehicles, namely automobiles, single-seater small-sized

electric vehicles, one-seater hybrid cars and integral parts, and fittings for all the aforesaid wares; parts, components, fittings and accessories for vehicles, namely automobiles, motorcycles, scooters, all terrain vehicles, sports utility vehicles, motor trucks, vans, buses, motor cars, motor-driven four-wheeled buggies, bicycles, tricars, tricycles, electric vehicles, namely automobiles, single-seater small-sized electric vehicles, one-seater hybrid cars, namely wheels, sun visors, consoles, bumper railings, body mouldings, windows, windscreens, wiper blades, ski carriers, hood louvers, visors, mudguards, seat covers, vehicle body covers, tire chains, wiper controls, key alarms, lighting alarms, mirrors, gear shift knobs, steering wheels, steering wheel covers, trays, pockets, trunk space covers, seat extenders, seat covers, seat cushions, sun shields, hub caps, decorative poles, trunk racks, tailgate openers, cigarette lighters, door and interior linings, umbrella holders, reversing buzzers; accessories for automobiles, namely lockable wheel bolts, wheel caps, splash guards, license plate frames, trailer hitches, luggage carriers, anti-skid chains, head rests, safety belts, safety child's seats, instrument panels, rear view mirrors, bumpers, mufflers, brakes, direction signals, horns, gearings, couplings, clutches, engines and belts, body works, vehicle seats, steering wheels, shock absorbers, motors and belting; motorcycle accessories, namely, fenders, air cleaners, fairings, fairing mounting kits, windshields, saddlebags, travel trunks, plastic gas tanks, mud flaps, fender brackets and fairing mounting kits; trunks and saddle bags for motorcycles; parts and accessories for motorized two-wheel vehicles, namely, touring bags, carrier bags, baskets, carriers, safety bars, leg shield assemblies, fuel tank covers, seat covers, control level covers, handle bar grip covers, handle bar grip braid, bells, air pumps, baby seats, wind breakers, safety child's seats, bicycle racks, bicycle baggage holders, motorcycle covers, motor car body covers, license plate brackets and holders, engine guards, luggage boxes, tire pumps, snow chains; engines for automobiles; internal combustion engines; electronic driven braking control systems for motorcars, namely anti-lock systems, traction control systems and anti-skidding systems used to improve traction and steering; electronic driven control systems for motorcars, namely torque transfer system used to improve steering and parts thereof; accessories for use with machines and implements for agricultural, horticultural, gardening and forestry uses, namely tractors, tillers; attachments for use with tractors and tillers, namely, hillers, plows, iron wheels, mulchers, drum rotors, cage rotors, spiral rotors, screw rotors, rotary, screw and fixed blade cultivators, cultivator wheels, furrowers, ridgers, planting openers, float skids, rakes, seeders, mowers, sweepers, rollers, graders, trailers, wheeled carriers, crawlers, hoppers, sprayers, reapers, sickles, pumps, snow plows, namely, tires and tubes, wheel weights, front weights, fenders, mirrors, horns, and parts and components for all the aforesaid wares; driving chains, sprocket, brake friction pads, drive shafts, brake shoes, gear boxes for power steering, pumps for power steering; rearview mirrors, bonnets, doors for vehicles, trunks, roof for vehicles, wiper blades; machines and implements for agricultural, horticultural, gardening and forestry uses, namely tractors; machines and implements for agricultural, horticultural, gardening, home and forestry uses, namely tractors; lawn tractors; attachments for use with tractors and tillers, namely, trailers, wheeled carriers.

(10) Parts, components, fittings and accessories for vehicles, namely automobiles, motorcycles, scooters, all terrain vehicles, sports utility vehicles, motor trucks, vans, buses, motor cars, motor-driven four-wheeled buggies, bicycles, tricars, tricycles, electric vehicles, namely automobiles, single-seater small-sized electric vehicles, one-seater hybrid cars, namely clocks.

(11) Parts, components, fittings and accessories for vehicles, namely automobiles, motorcycles, scooters, all terrain vehicles, sports utility vehicles, motor trucks, vans,

buses, motor cars, motor-driven four-wheeled buggies, bicycles, tricars, tricycles, electric vehicles, namely automobiles, single-seater small-sized electric vehicles, one-seater hybrid cars, namely body stripes; stickers for vehicles.

(12) Parts, components, fittings and accessories for vehicles, namely automobiles, motorcycles, scooters, all terrain vehicles, sports utility vehicles, motor trucks, vans, buses, motor cars, motor-driven four-wheeled buggies, bicycles, tricars, tricycles, electric vehicles, namely automobiles, single-seater small-sized electric vehicles, one-seater hybrid cars, namely films for windows and protection tapes for vehicle's body.

(13) Parts and accessories for motorized two-wheel vehicles, namely, flag rods, fender ornaments.

(14) Parts and accessories for motorized two-wheel vehicles, namely, anti-frost cloths, brushes, and chamois cloths.

(15) Parts, components, fittings and accessories for vehicles, namely automobiles, motorcycles, scooters, all terrain vehicles, sports utility vehicles, motor trucks, vans, buses, motor cars, motor-driven four-wheeled buggies, bicycles, tricars, tricycles, electric vehicles, namely automobiles, single-seater small-sized electric vehicles, one-seater hybrid cars, namely carpets; accessories for automobiles, namely, floor mats, trunk floor mats.



(16) Toys, namely models or replicas of motor vehicles; rideable, pedal-powered toy all-terrain vehicles; toys, namely, scale models of vehicles such as motor cars, motorcycles or the like.

*(1) Program for the warranty, repair, service, maintenance, sale and advertising of used vehicles; the provision of dealer locator services, all of the aforementioned services being provided to operators of automotive vehicles.*

*(2) Operation of an extended warranty program for automotive vehicles; the provision of compensation for emergency transportation, trip interruption benefits, compensation for car rental expenses necessitated by automotive vehicle unavailability as a result of repairs being conducted, all of the aforementioned services being provided to operators of automotive vehicles; automotive vehicle leasing services; financing services relating to vehicles and similar goods; leasing services in respect of vehicles and similar goods; operation of extended warranty programs relating to vehicles; financing services relating to vehicles, power equipment and marine products.*

*(3) Services of repair, maintenance and servicing of automobiles; inspection, adjustment, modification, repair, maintenance and servicing of vehicles including installation of parts, accessories and fittings for vehicles, internal combustion engines, industrial and marine equipment; the provision of roadside assistance services, traffic accident services, tire repair or replacement services, all of the aforementioned services being provided to operators of automotive vehicles; building, construction and repair services, namely the inspection, adjustment, modification, repair, maintenance and servicing of land vehicles (apparatus for locomotion by land, air or water), internal combustion engines, industrial equipment, namely starters for motors or engines, alternating or direct current motors, alternating or direct current generators, lawn mowers.*

*(4) Operation of a data communications network used to communicate with customers, dealers and all internal employees by using the Internet and Intranet as part of their business activity; emergency message relay services, all of the aforementioned services*

	<p><i>being provided to operators of automotive vehicles.</i></p> <p><i>(5) The provision of winching services, towing services, and trip planning services, all of the aforementioned services being provided to operators of automotive vehicles.</i></p> <p><i>(6) Testing/research for prevention of pollution, namely research services involving the study of reduction of harmful and polluting substances produced in the manufacture of land vehicles (apparatus for locomotion by land, air or water); research services involving the promotion, re-use and/or recycling of land vehicles (apparatus for locomotion by land, air or water) and their parts, accessories and fittings; services of producing environmentally friendly highly efficient engine technology relating to vehicles, power equipment and marine products.</i></p> <p><i>(7) The provision of emergency lockout services, alt of the aforementioned services being provided to operators of automotive vehicles.</i></p>
<p>TMA273115</p>  <p><i>H Design</i></p>	<p>Automobiles and parts thereof; accessories for automobiles, namely lockable wheel bolts, wheel caps, floor mats, trunk floor mats, seat covers, splash guards, mudguards, license plate frames, steering wheel covers and body covers.</p>
<p>TMA483632</p>  <p><i>New H</i></p>	<p><i>Inspection, adjustment, modification, repair, maintenance and servicing of motor vehicles including installation of parts, accessories and fittings for motor vehicles, internal combustion engines, industrial and marine equipment.</i></p>

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

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**HEARING DATE** 2021-04-27

**APPEARANCES**

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Paul Tackaberry	For the Applicant

**AGENTS OF RECORD**

Marks & Clerk	For the Opponent
Rideout & Maybee LLP	For the Applicant