



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 004

Date of Decision: 2024-01-08

IN THE MATTER OF AN OPPOSITION

Opponent: Fellowes, Inc

Applicant: Ergonomic Solutions International Limited

Application: 1892307 for ERGONOMIC SOLUTIONS & Design

INTRODUCTION

[1] Ergonomic Solutions International Limited (the Applicant) seeks registration of the trademark ERGONOMIC SOLUTIONS & Design (the Applied-for Mark), shown below:



[2] The Applicant seeks registration of the Applied-for Mark in association with a variety of goods and services related to point-of-sale payment terminals, tablets, and similar devices, and mounting brackets for such devices. The complete list of goods and

services set out in the application (the Applied-for Goods and Services) is provided in Schedule A to this decision.

[3] Fellowes, Inc (the Opponent) opposes registration of the Applied-for Mark. The opposition is based on two grounds, both of which turn on the allegation that the Applied-for Mark is confusing with the trademark ESI ERGONOMIC SOLUTIONS (the Opponent's Mark). The Opponent claims to have used this trademark in Canada in association with various accessories for computers, monitors, peripherals, and various office furniture.

[4] For the following reasons, the application is refused.

THE RECORD

[5] The application was filed on April 6, 2018. The Applicant claimed a priority filing date of October 6, 2017 pursuant to section 34 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). In the application, the Applicant also claimed to have used the trademark in Canada since at least as early as March 2017.

[6] The application was advertised for opposition purposes on November 13, 2019. The Opponent filed its statement of opposition on July 9, 2020, pursuant to section 38(1) of the Act. The Applicant filed and served its counterstatement on February 11, 2021.

[7] Both parties filed affidavit evidence, but neither party conducted any cross-examinations. The Opponent filed and served written representations, and was represented at the hearing of this matter. The Applicant did not file written representations, and did not attend the hearing.

The Opponent's Evidence

[8] The Opponent relies on the affidavit of Blendi Kokona, a VP of Finance for the Opponent, sworn January 14, 2021 (the Kokona Affidavit).

[9] Mr. Kokona describes the Opponent as a privately-owned global specialist in office equipment and other office supplies [Kokona Affidavit, para 2]. According to Mr.

Kokona, the Opponent sells its products in connection with several different brands, one of which being the Opponent's Mark [para 3].

[10] Mr. Kokona states that the Opponent has used the Opponent's Mark in Canada continuously since at least September 11, 2015 [para 6]. He states that specifics with respect to the Opponent's financial data, including aggregate sales data by country or brand, is "highly private and confidential information" [para 5]. Despite this, Mr. Kokona has provided two purchase orders, an invoice, and two sets of shipping receipts and customs invoices that he says demonstrate sales to a Canadian purchaser (Grand & Toy Limited), in association with the Opponent's Mark [para 6, and Exhibits B-D].

[11] Mr. Kokona also describes the typical ordering process by which the Opponent's customers usually obtain product from the Opponent [para 8], and provides examples of the Opponent's catalog [Exhibit E], price list [Exhibit F] and website [Exhibit G], which feature the Opponent's Mark. Mr. Kokona also comments on the Opponent's use of its trademark in the United States, and provides a copy of a United States trademark registration for the Opponent's Mark [Exhibit H].

The Applicant's Evidence

[12] In support of the application, the Applicant relies on the following evidence:

- the affidavit of Ralph Lambers, Chief Product Office of the Applicant, sworn August 16, 2021 (the Lambers Affidavit); and
- the affidavit of Christoph Heinemann, a law clerk with the Applicant's trademark agents, sworn August 23, 2021 (the Heinemann Affidavit).

[13] Mr. Lambers states that the Applicant and several subsidiary and related companies design and develop mounting solutions for electronic devices such as payment terminals, for use in the retail, grocery, hospitality and entertainment sectors [Lambers Affidavit, paras 2, 4]. Descriptions and photographs of examples of the Applicant's products are provided [para 13, and Exhibit F]. Mr. Lambers states that the Applicant also provides retail and wholesale services related to the products it sells,

such as product sales and support, individualized sales support, and customized quotations and packages [para 13(d) and Exhibit F]. The Applicant sells its products and services directly via its website [para 14, and Exhibits A-C], as well as through several distribution partners [para 15].

[14] Mr. Lambers asserts that the Applied-for Mark has been used continuously by the Applicant since at least March 2017 [para 12]. He provides printouts of the Applicant's website from various points in time after this date [Exhibits A-E], which display the Applied-for Mark. He also provides the Applicant's aggregate sales from 2017 to 2020 [paras 18, 20], along with some sample invoices [Exhibit H] and examples of customers to which the Applicant has sold its products and services [para 17]. Mr. Lambers also provides descriptions and photographs of the Applicant's promotional activities on social media [para 21 and Exhibit I] and at trade shows [paras 22-23, Exhibits J-K].

[15] As for Mr. Heinemann, he states that he accessed both the Applicant's current websites (located at the domain names *www.ergonomic.solutions* and *www.spacepole.com*) and prior versions of its websites (via the Wayback Machine at *archive.org*), and attached screen captures of these websites to his affidavit [Heinemann Affidavit, paras 3-8 and Exhibits A-F]. Mr. Heinemann also accessed and provided screen captures of the Applicant's Twitter, LinkedIn, and YouTube accounts [para 9, Exhibit G].

GROUND OF OPPOSITION

[16] The Opponent raises two grounds of opposition:

- the Non-entitlement Ground: relying on sections 38(2)(c) and 16(1)(a) of the Act, the Opponent pleads that the Applied-for Mark is confusing with the Opponent's Mark, which has been previously and continuously used in Canada prior to i) the filing date of the application (April 6, 2018), ii) the deemed filing date pursuant to section 34 of the Act (October 6, 2017), and iii) the Applicant's claimed first use of the Applied-for Mark in Canada (March 2017); and

- the Non-distinctiveness Ground: relying on sections 38(2)(d) and 2 of the Act, the Opponent alleges that the Applied-for Mark neither distinguishes the goods and services listed in the application from the goods and services of the Opponent nor is it adapted to so distinguish, because the Applied-for Mark is confusing with the Opponent's Mark.

[17] For each ground of opposition, there is an initial evidential burden on the Opponent to adduce evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition are true. If this initial burden is met, then the Applicant bears the legal onus of satisfying the Registrar that, on a balance of probabilities, the ground of opposition should not prevent registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

THE NON-ENTITLEMENT GROUND

[18] To meet its initial evidential burden in respect of this ground, the Opponent must show that the Opponent's Mark was used in Canada prior to the material date for this ground. The Opponent must also show that the Opponent's Mark had not been abandoned as of the date of advertisement of the application [section 16(1)(a) of the Act]. If this initial evidential burden is met, the Applicant will bear the onus of showing that the parties' trademarks are not confusing.

[19] The material date for this ground of opposition is the earlier of (i) the date of first use of the Applied-for Mark in Canada, and (ii) the priority filing date of the application (namely, October 6, 2017) [section 16(1)(a) of the Act]. Mr. Lambers attests to the claimed date of first use of the Mark in Canada as set out in the application, namely March 2017 [Lambers Affidavit at para 12]. Although the Opponent did not cross-examine Mr. Lambers on his affidavit, the Opponent nonetheless argues that the evidence does not support this claim, and in fact does not demonstrate any use of the Applied-for Mark in Canada, at any time [Opponent's written representations at para 50]. Despite the Opponent's arguments, I am prepared to accept March 2017 as the material date for purposes of this ground. The later material date urged by the

Opponent would not meaningfully impact the analysis of the Non-entitlement Ground because, for the reasons stated below, I find for the opponent in respect of this ground.

Opponent's Initial Burden

[20] The Opponent claims to have used the Opponent's Mark in Canada since at least September 11, 2015 [Opponent's written representations, para 20], before both the first use date claimed by the Applicant and the priority filing date of the application. The Opponent claims to have used the Opponent's Mark in association with the following goods (the Opponent's Goods):

Computer monitor arms; computer wrist rests and supports; computer palm rests and supports; foot rests and supports; computer keyboards; computer keyboard trays; computer mouse trays; computer mouse pads; computer stands designed for holding computers and computer peripherals; and computer stands with articulating arms; electrical power outlets for use on desks and tables; USB outlets for use on desks and tables

Lamps; lighting fixtures; lighting installations

Height-adjustable tables and desks; tables, desks and table bases

[21] Mr. Kokona's evidence of use of the Opponent's Mark includes the following:

- the Opponent's Mark has been in continuous use in Canada since at least as early as September 11, 2015 [para 6]. The specific goods in association with which the Opponent's Mark was used, as of this date, are not explicitly identified;
- the Opponent sells the Opponent's Goods in Canada "through a number of brands", including the Opponent's Mark [para 3]. Mr. Kokona's evidence in this regard is stated in the present tense. The specific goods sold in Canada as of the material date for this ground of opposition is not provided;
- purchase orders, an invoice, shipping receipts and customs invoices from two sales of product, one that shipped on September 11, 2015, and another that shipped on January 15, 2016 [para 6, and Exhibits B, C, and D]. These sales were made by ESI Ergonomic Solutions, LLC to Grand & Toy Ltd;

- the first sale was for four units of a product called TITAN2-EDGE. This product appears to be a stand for mounting a computer and peripherals to a wall to create a publicly accessible work station in an institutional setting, such as a hospital [Exhibit D, third page, and Exhibit E, page 24];
- the second sale was for several units of a product called SOLUTION 2-27 which, based on the Opponent’s catalog, appears to be a keyboard tray with an articulating arm for mounting the tray to an office desk [Exhibit D, seventh page, and Exhibit E, page 29];
- the shipping receipts and customs invoices are affixed to the goods when they are shipped to the buyer [para 7]; and
- the trademark shown below is displayed on the customs invoices that are affixed to the goods when shipped [Exhibit D, third and seventh pages].



[22] The Opponent argues that its evidence is sufficient to satisfy its initial burden, in respect of all of the Opponent’s Goods. In particular, the Opponent argues the following:

- the Opponent’s initial evidential burden is light [Opponent’s written representations, para 15, citing *John Labatt Limited v Molson Companies Limited* (1990), 30 CPR (3d) 293, and *Tubecon Inc v Tubeco Inc* (1986), 10 CPR (3d) 386];
- for confidentiality reasons, the Opponent is not able to disclose actual volumes of sales in Canada associated with the Opponent’s Mark. However, Mr. Kokona attests that the Opponent’s sales are “meaningful and significant” and would represent “broad sales and distribution to a large number of Canadians”, and these attestations should be treated as reliable and credible [paras 22-26];

- in view of the foregoing, and the evidence of sales transactions provided by the Opponent, the evidence clearly establishes that the Opponent has been using the Opponent's Mark in Canada since at least as early as September 11, 2015 [para 20];
- the use of the Opponent's Mark on the shipping receipts and customs invoices that accompanied the product shipments constituted the required association of the Opponent's Mark with the Opponent's Goods, at the time of transfer of the goods, in accordance with section 4(1) of the Act; and
- at the hearing, the Opponent argued that the evidence permits an inference that the sales of products by ESI Ergonomic Solutions, LLC were made under an implied licence from, and enure to the benefit of, the Opponent. The Opponent points to the reference to ESI Ergonomic Solutions on the Opponent's website [Kokona Affidavit, Exhibit A, second page]. The Opponent also points to a company location entitled "ESI" on a map of the Opponent's locations at approximately Arizona, USA, which corresponds to the address of ESI Ergonomic Solutions, LLC on the shipping documents [Kokona Affidavit, Exhibit A, second and third pages, and Exhibit D].

[23] With regard to the nature of the Opponent's initial burden, I do not accept that it is "light" in respect of non-entitlement grounds of opposition. The prior decisions cited by the Opponent in support of this proposition both involve grounds of opposition under section 30(b) (formerly section 29(b)) of the Act, as it read prior to June 17, 2019. The factual question raised in those cases was whether the *applicant* had used its trademark as of the date claimed in its application. Since an opponent could not reasonably be expected to have access to much evidence relating to an applicant's trademark use, it was held that an opponent's burden in such cases was light. This is *not* the case in the present matter, where the relevant factual question relates to the *opponent's* trademark use. Opponents can reasonably be expected to have ample evidence of *their own* trademark use, and so there is no rationale for applying a "light" burden in this case.

[24] Despite the foregoing, I accept that the Opponent has met its initial burden in respect of the following goods (the Opponent's Trays and Stands):

computer keyboard trays; computer stands designed for holding computers and computer peripherals; computer stands with articulating arms.

[25] Based on the purchase orders, invoices, and shipping receipts in evidence, I accept that the Opponent's Trays and Stands were sold in Canada prior to the material date for the Non-entitlement Ground (some on September 11, 2015, and others on January 15, 2016). I also accept that these sales, by ESI Ergonomic Solutions, LLC, inure to the benefit of the Opponent pursuant to section 50 of the Act. Based on the content of the Opponent's website referring to ESI Ergonomic Solutions as one of the Opponent's brands [Kokona Affidavit, Exhibit A, first and second pages], and Mr. Kokona's testimony that the Opponent sells office equipment and supplies under a variety of brands, including the Opponent's Mark [para 2, 3], I accept that the Opponent controls the operations of ESI Ergonomic Solutions, LLC, and the character or quality of that entity's products. Furthermore, in the absence of any indication that the Opponent's Mark is no longer used, I am satisfied that the trademark has not been abandoned.

[26] I am also satisfied that the Opponent's Mark was associated with the Opponent's Trays and Stands at the time they were transferred to purchasers, as required by the definition of trademark use in section 4(1) of the Act. The evidence shows that the Opponent's Mark appears prominently on the customs invoices, and that these invoices are affixed to the goods when they are shipped to the buyer. Applying the principles articulated in *Hortilux Schreder BV v Iwasaki Electric Co Ltd*, 2011 FC 967, I am satisfied that the Opponent's Mark, as it appears on the invoices, is sufficiently associated with the goods such that notice of the association would come to the attention of the purchaser.

[27] I am not satisfied that the Opponent has met its initial burden in respect of the Opponent's Goods other than the Opponent's Trays and Stands. While Mr. Kokona states that the Opponent has sold all of the Opponent's Goods in Canada, in association with the Opponent's Mark, his statement to this effect is made in the present tense, as of the date of his affidavit. He does not state that all of the Opponent's Goods were sold in association with the Opponent's Mark prior to the material date for the Non-entitlement Ground. While the evidence demonstrates sales of the Opponent's Trays

and Stands occurring prior to the material date, it does not show any sales of any other of the Opponent's Goods, prior to the material date. I am therefore not satisfied that these goods were sold in Canada prior to the material date, and the Opponent has not met its initial evidential burden in respect of these goods.

The Test for Confusion

[28] Since the Opponent meets its initial evidential burden in respect of the Opponent's Trays and Stands, the Applicant bears the onus of showing, on a balance of probabilities, that the Applied-for Mark was not confusing with the Opponent's Mark, used in association with the Opponent's Trays and Stands, as of the material date of March 2017.

[29] The use of a trademark will cause confusion with another trademark if the use of both in the same area would be likely to lead to the inference that the goods or services associated with the trademarks are manufactured, sold, leased, hired or performed (as the case may be) by the same person [section 6(2) of the Act].

[30] Assessing the relevant question of confusion is a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applied-for trademark at a time when they have no more than an imperfect recollection of the opponent's trademark. This casual, hurried consumer 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 at para 20].

[31] Applying the test for confusion is an exercise in finding facts and drawing inferences [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 102]. All surrounding circumstances of the case must be considered, including those listed at section 6(5) of the Act, namely:

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

- the length of time the trademarks have been in use;
- the nature of the goods, services or business;
- the nature of the trade; and
- the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them.

Degree of Resemblance

[32] Despite being the last factor listed in section 6(5) of the Act, the degree of resemblance is the factor that often has the greatest impact on the confusion analysis. Other factors become significant only once the trademarks at issue are found to be identical or very similar [*Masterpiece* at para 49].

[33] When considering the degree of resemblance, the trademarks must be considered in their entirety as a matter of first impression. They must not be carefully analyzed and dissected into their component parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD)]. That being said, the preferable approach is to consider whether there is an aspect of each trademark that is particularly striking or unique [*Masterpiece* at para 64]. In this regard, it has been held that first word of a trademark is important for the purpose of distinguishing trademarks [*Masterpiece* at para 63].

[34] When considered in their entirety, both trademarks contain the words “ergonomic solutions” as a prominent, striking aspect thereof. The Applied-for Mark also includes a prominent design element of two nested semi-circles, while the Opponent’s Mark also prominently includes the letters ESI as the first “word” of the trademark. The prominent word elements “ergonomic solutions” are identical, and obviously give rise to resemblance between the trademarks in terms of appearance, sound, and ideas suggested. At the same time, the other elements of the parties’ trademarks, which are about as prominent as the words “ergonomic solutions”, are largely dissimilar, detracting from the degree of resemblance between the trademarks. Overall, considering both

trademarks in their entirety, I find there to be a fair degree of resemblance between the trademarks. Accordingly, this factor favours the Opponent.

Inherent Distinctiveness and Extent Known

[35] The inherent distinctiveness of a trademark refers to its originality. Trademarks are inherently distinctive when nothing about them refers the consumer to a multitude of sources. Where a trademark may refer to many things, or is only descriptive of the goods or services at issue, less protection will be afforded the mark [*United Artists Pictures Inc v Pink Panther Beauty Corp*, 1998 CanLII 9052 (FCA), [1998] 3 FC 534, at para 23]. A greater degree of discrimination may fairly be expected from the public in respect of such trademarks, such that even relatively small differences may suffice to avert confusion [*General Motors Corp v Bellows*, 1949 CanLII 47 (SCC), [1949] SCR 678]. Where a mark does not have inherent distinctiveness it may still acquire distinctiveness through continual use in the marketplace. To establish this acquired distinctiveness, it must be shown that the mark has become known to consumers as originating from one particular source [*United Artists Pictures* at para 24].

[36] As mentioned above, both trademarks prominently include the words “ergonomic solutions”. This phrase is fairly generic, and could be used to describe the function of both the Opponent’s Trays and Stands and the Applied-for Goods and Services, in that they provide ergonomically beneficial solutions for mounting computer terminals, keyboards, mice, and payment terminals. On the other hand, both trademarks also prominently include other elements that, while not overly unique, are not suggestive or descriptive of the parties’ goods and services, either. For these reasons, I consider the inherent distinctiveness of both trademarks to be fairly low, though not absent entirely.

[37] Furthermore, the evidence does not support a conclusion that either of the parties’ trademarks had become known in Canada to any appreciable extent, as of the material date for the Non-entitlement Ground. The Opponent’s evidence only establishes two sales in Canada occurring prior to the material date. While these sales are sufficient to meet the Opponent’s initial burden in respect of this ground of opposition, they are not a sufficient basis from which to infer that the Opponent’s Mark

had become known in Canada to any appreciable extent. As for the Applied-for Mark, there is no use or other evidence as of the material date from which I can infer that the Applied-for Mark had become known in Canada.

[38] In view of the low level of distinctiveness of the parties' trademarks, the narrow ambit of protection to which such trademarks are generally entitled, and the greater degree of discrimination that may fairly be expected from the public when considering such trademarks, I consider this factor to favour the Applicant, or at worst for the Applicant this factor is neutral.

Length of Time in Use

[39] As stated above in respect of the Opponent's initial burden, the Opponent's Mark has been in use in Canada since September 2015. Accordingly, as of the material date for the Non-entitlement Ground, the Opponent's Mark had been in use for approximately 18 months, whereas the Applied-for Mark had not been used in Canada. This factor therefore favours the Opponent.

Nature of the Goods and Services, and Nature of the Trade

[40] When considering the parties' goods and services, it is the statement of services as set out in the application that must be considered [see *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. The statement of goods and services must be read with a view to determining the probable type of business or trade intended by the Applicant. In this regard, evidence of the actual trade of the Applicant is useful [see *McDonald's Corp v Coffee Hut Stores Ltd.* (1996), 68 CPR (3d) 168 (FCA)].

[41] As for the Opponent's goods, since the Opponent relies on its prior use of the Opponent's Mark, the goods in connection with which the Opponent was using the Opponent's Mark, namely, the Opponent's Trays and Stands, must be considered [*Hayabusa Fightwear Inc v Suzuki Motor Corporation*, 2014 FC 784 at paras 46, 47].

[42] Mr. Lambers evidence shows that the Applicant sells products in the nature of stands, mounts, enclosures, docking stations and charging stations, all for point of sale terminals, and computers and tablets used at the point of sale [para 13, and Exhibit D].

The Applicant also offers sales and support services in relation to its products, such as customized products and solutions, consulting on equipment and systems, and quotations and packages for customers and distribution partners [para 13(d)].

Considering the Applied-for Goods and Services in light of the Applicant's evidence, it is apparent that these goods and services all relate to mounting equipment for electronic devices used at points of sale.

[43] As for the Opponent's Trays and Stands, these appear to be keyboard trays with articulating arms for mounting to an office desk [Kokona Affidavit, Exhibit E, page 29], and stands for mounting computers, monitors and keyboards to a wall to create a public access terminal [Kokona Affidavit, Exhibit E, page 24]. The Opponent has made no submissions as to the similarity of its goods to the Applied-for Goods. Nonetheless, I consider there to be a limited degree of relationship between the Opponent's Trays and Stands on the one hand, and the Applied-for Goods on the other hand, in that they both include stands and mounts for electronic devices.

[44] With respect to the nature of the parties' trade, the Opponent submits that the ultimate consumers to whom the parties market their goods and services are identical. In my view, the evidence does not support this assertion. However, the evidence does show some potential for the parties' channels of trade to overlap. The Opponent's Trays and Stands are sold to retailers such as Grand & Toy [Kokona Affidavit, para 6 and Exhibits B-D], whereas the Applied-for Goods and Services are sold directly by the Applicant, as well as through distribution partners [Lambers Affidavit, paras 14, 15], to retail businesses such as IKEA Canada Partnership Limited and Winners Merchants International LP [Lambers Affidavit, para 17]. It is conceivable that retail business requiring both point of sale terminal mounts and public access computer mounts, for example, could seek out such products from distributors of business and office supplies.

[45] In view of the existence of a limited degree of relationship between the parties' goods and services, and the potential overlap of the parties' channels of trade, I consider that both of these factors are, at best for the Applicant, essentially neutral.

Conclusion Regarding Confusion

[46] Having considered all of the surrounding circumstances, I am not satisfied that the Applicant has met its legal onus to demonstrate, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties' trademarks. At best for the Applicant, I find that the likelihood of confusion as to the source of the parties' goods and services to be evenly balanced. I reach this conclusion primarily due to the fair degree of resemblance between the trademarks, the relationship between the parties' goods and services, and the potential overlap in the parties' channels of trade. I reach this conclusion despite the low degree of distinctiveness of the parties' trademarks, and the greater degree of discrimination that may be expected from the consuming public.

[47] In view of the foregoing, the Non-entitlement Ground is successful.

THE NON-DISTINCTIVENESS GROUND

[48] To meet its initial burden in respect of this ground, the Opponent must establish that, as of the material date for this ground of opposition, the Opponent's Mark had a reputation in Canada that was "substantial, significant or sufficient" to negate the distinctiveness of the Applied-for Mark [*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 at para 34]. Clear evidence to this effect must be presented [*Bojangles'* at para 33]. The material date for this ground of opposition is the filing date of the opposition, namely July 9, 2020 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at para 25].

[49] I am not satisfied that the Opponent has met its initial evidential burden in respect of this ground. As discussed above, the Opponent's evidence only clearly establishes two sales of products to one buyer in Canada, in association with the Opponent's Mark. The only other evidence of the Opponent's Canadian sales is Mr. Kokona's characterization of such sales as "meaningful and significant", and representing "broad sales and distribution to a large number of Canadians" [para 5]. This characterization is vague, both in terms of the volume of the Opponent's Canadian sales and the time at which they occurred. In all, the Opponent's evidence does not provide a sufficient basis from which to conclude that the Opponent's Mark enjoyed a

reputation in Canada that was “substantial, significant or sufficient” to negate the inherent distinctiveness of the Applied-for Mark.

[50] Accordingly, I find that the Opponent has not met its initial evidential burden in respect of the Non-distinctiveness Ground. This ground is therefore rejected.

DISPOSITION

[51] 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.

Jaimie Bordman
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A – THE APPLIED-FOR GOODS AND SERVICES

Goods

- (1) Ironmongery, namely, small items of metal hardware for mounting and tethering point of sale terminals and tablets, tubes of metal for mounting point of sale terminals and tablets, telescopic tubes of metal for mounting point of sale terminals and tablets, sheets and plates of metal, poles of metal, goods of common metal, namely buckles of common metal [hardware] for mounting point of sale terminals and tablets, metal holders for signboards, fittings of metal for pipes.
- (2) Holders, mounts, supports, fastening fittings, swing arms, lever arms and telescopic arms for electric and electronic apparatus and instruments, namely payment terminals, apparatus for registration of electronic signatures, namely electronic signature boards; data processing equipment, namely computers, card readers, electronic payment terminals, and point-of-sale terminals; computer and tablet monitors, flat panel display screens, touch screens, video screens, customer displays, namely computer display screens, keyboards, telephones, calculators, printers, scanners, and electronic weighing scales for retail use.

Services

- (1) Retail, wholesale and online shopping services in the field of Ironmongery, small items of metal hardware, tubes of metal, telescopic tubes of metal, sheets and plates of metal, poles of metal, Holders, mounts, supports, fastening fittings, swing arms, lever arms and telescopic arms for electric and electronic apparatus and instruments, namely payment terminals; Retail, wholesale and online shopping services in the field of payment terminals, apparatus for registration of electronic signatures, namely electronic signature boards, data processing equipment, namely computers, card readers, electronic payment terminals, and point-ofsale- terminals, monitors, flat panel display screens, touch screens, video screens, customer displays, namely computer display screens, keyboards, telephones, calculators, printers, scanners, and electronic weighing scales for retail use.

Appearances and Agents of Record

HEARING DATE: 2023-11-23

APPEARANCES

For the Opponent: Steven Andrews

For the Applicant: No one attending

AGENTS OF RECORD

For the Opponent: Andrews Robichaud

For the Applicant: Gowling WLG (Canada) LLP