



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 010

Date of Decision: 2024-01-22

IN THE MATTER OF SIX OPPOSITIONS

Opponent: Parts ID, LLC

Applicant: Volkswagen Aktiengesellschaft

Applications: 1898587 for ID.,
1938107 for ID.3,
1938109 for ID.4,
1938110 for ID.5,
1938113 for ID.8, and
1966920 for ID.LIGHT

INTRODUCTION

[1] Parts ID, LLC (formerly Onyx Enterprises Int'l, Corp.) (the Opponent) opposes registration of the following six trademarks, applied for by Volkswagen Aktiengesellschaft (the Applicant): ID. (which is the subject of application No. 1898587); ID.3 (No. 1938107); ID.4 (No. 1938109); ID.5 (No. 1938110); ID.8 (No. 1938113); and ID.LIGHT (No. 1966920).

[2] The ID.LIGHT trademark is applied for in association with various lighting-related goods for vehicles in Nice Class 11. The other five trademarks are applied for in

association with various goods and services related to motor vehicles and parts thereof, in Nice Classes 9, 12, 35, and 37.

[3] The oppositions are primarily based on an allegation that the applied-for trademarks are confusing with the Opponent's ID trademarks, previously used in Canada in association with related services.

[4] Although not relevant to these proceedings, I note that the Applicant's concurrently-filed and similar applications for the trademarks ID.1, ID.2, ID.6 and ID.7 were not opposed and such trademarks have been registered since early 2022.

THE RECORD

[5] For the reasons below, it is not necessary to detail the particulars of each application for purposes of this decision. Suffice to say, each of the subject applications were filed on various dates between March 3, 2018 and June 4, 2019, with claimed priority filing dates between November 2017 and December 2018 based on corresponding applications in Germany. The applications were advertised for opposition purposes on various dates between February and July 2021. In August 2021, the Opponent opposed the applications by filing a statement of opposition in each case under section 38 of the *Trademarks Act*, RSC 1985, c T 13 (the Act).

[6] The Opponent pleads essentially the same two grounds of opposition in each proceeding, based on non-entitlement to register under sections 38(2)(c) and 16 of the Act; and non-distinctiveness under sections 38(2)(d) and 2 of the Act.

[7] The Applicant filed counter statements in each proceeding.

[8] The Opponent elected not to submit evidence in any of the subject proceedings, referencing i) difficulties in compiling evidence from its division in Ukraine due to the ongoing conflict in that country, and ii) related trademark litigation proceedings in the United States. Although the Opponent indicated that it may request retroactive extensions of time to file its evidence at a later date, the Opponent did not do so, nor did it submit written representations.

[9] The Applicant also elected not to submit evidence, but it did submit brief written representations, which I note are substantively the same in each case.

[10] Although both parties initially requested a hearing, only the Applicant was represented, as the Opponent withdrew its request and did not attend.

EVIDENTIAL BURDEN AND LEGAL ONUS

[11] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053 (FCTD)]. The presence of an evidential burden on the Opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[12] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. 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 it.

NON-ENTITLEMENT TO REGISTRATION – SECTION 16

[13] In each case, pursuant to sections 38(2)(c) and 16 of the Act, the Opponent pleads that the Applicant is not the person entitled to registration of the applied-for trademark because – as of i) the filing date of the application, ii) the deemed filing date of the application, or iii) at any other date – the applied-for trademark was confusing with one or more of the Opponent's ID, iD, CARiD, STREETiD word marks, and/or 11 specified ID-formative design marks, which had been previously used in Canada by the Opponent and by the Opponent's predecessor-in-title in association with various sales, distributorship and e-commerce services in the field of vehicle parts and accessories.

[14] As noted above, the Opponent elected not to submit evidence in any of the subject proceedings. In the absence of evidence, I agree with the Applicant that the

Opponent fails to meet its initial burden under this ground [Applicant's written representations at paras 14 to 16].

[15] Accordingly, the ground of opposition based on non-entitlement to registration is rejected in each case.

NON-DISTINCTIVENESS – SECTION 2

[16] In each case, pursuant to sections 38(2)(d) and 2 of the Act, the Opponent pleads that the applied-for trademark is not distinctive of the Applicant because it does not distinguish, nor is it adapted to distinguish, the goods and/or services of the Applicant from the services of the Opponent in view of the extensive use and promotion in Canada by the Opponent and by the Opponent's predecessor-in-title of the aforementioned ID-formative word and design marks, and the extensive use and promotion in Canada of the confusingly-similar trade name of the Opponent, being "Parts ID".

[17] Again, in the absence of evidence in support of this ground, the Opponent fails to meet its initial burden.

[18] Accordingly, the ground of opposition based on non-distinctiveness is rejected in each case.

DISPOSITION

[19] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I reject the oppositions.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-01-18

APPEARANCES

For the Opponent: No one attending

For the Applicant: Scott MacKendrick

AGENTS OF RECORD

For the Opponent: Smart & Biggar LP

For the Applicant: Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.