



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 033

Date of Decision: 2024-02-27

IN THE MATTER OF AN OPPOSITION

Opponent: AMKmotion GmbH + Co. KG

Applicant: Kollmorgen Corporation

Application: 2,069,930 for AKM

OVERVIEW

[1] Kollmorgen Corporation (the Applicant) has applied to register the trademark AKM (the Trademark) in association with the goods “servomotors”.

[2] AMKmotion GmbH + Co. KG (the Opponent) opposes registration of the Trademark, including on the ground that the Trademark is confusing with the Opponent’s registered trademark AMK.

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

THE RECORD

[4] Application No. 2,069,930 was filed in Canada on November 3, 2020. The application was advertised for opposition purposes in the *Trademarks Journal* of

May 25, 2022. On July 19, 2022, the Opponent opposed the application by filing a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[5] The grounds of opposition raised by the Opponent are discussed in greater detail in the analysis below. Suffice it to note at this juncture that they primarily rely on an allegation of likely confusion between the applied-for Trademark and the trademark AMK, for which the Opponent owns a registration (No. TMA756,709) in association with the following goods (the Opponent's Goods):

Electric motors, electric generators and electric motor-generators, gears, adjustable gears, feedgear mechanisms and their parts, feed gear machines, couplings, brakes, single disk brakes and lamellar brakes, metalworking machine tools, lathes, milling machines, drills, trueing machines, machining centres, linear and pivoting electric prime movers, industrial robots (machines), (all aforementioned products not for land vehicles); motor-driven pumps, compressors, packing machines, textile machines, paper making machines, printing presses, machines for machining glass and for the manufacture of ceramics, rolling mills, plate-working machines for machining sheet metal and wood working machines, winders for metal wires and wire folding machines, foundry and moulding machines, synthetic material injectors, pressure-moulding machines, power presses for industrial use, test stands, machines for construction purpose in the field of roads and buildings; electronic and electrotechnical controllers and monitors for checking, measuring, controlling and regulating electricity, and their parts, electric and electronic regulating components and their control devices, electric frequency converters and electric controls forming part of the same; ventilators and their electric motors and electronic controllers, refrigerating machines.

[6] The Applicant filed a counter statement.

[7] Only the Opponent filed evidence. Neither party elected to file written representations and no hearing was requested.

ONUS AND LEGAL BURDEN

[8] The legal onus is on the Applicant to show that the application complies with the provisions of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent registration of the Trademark [*John*

Labatt Ltd v Molson Companies Ltd (1990), 30 CPR (3d) 293 (FCTD) at 298, 1990 CanLII 11059; *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29].

THE OPPONENT'S EVIDENCE

[9] In support of its opposition, the Opponent filed the affidavit of Kimberly Parrott, sworn January 30, 2023, together with Exhibits A to S. The Applicant did not cross-examine Ms. Parrott on her affidavit.

[10] Ms. Parrott is an assistant at the Opponent's agent firm.

[11] On January 30, 2023, she conducted online searches and captured her results. In particular, she entered each of the parties' names in the Google search engine, printed the first page of each search result, as well as webpages from the Opponent's and Applicant's websites, located at *amk-motion.com* and *www.kollmorgen.com*, respectively. Copies of those webpage captures are attached as exhibits to her affidavit.

[12] Ms. Parrott also attaches the particulars of registration No. TMA756,709 for the trademark AMK, which she printed from the Canadian Intellectual Property Office (CIPO)'s online database.

[13] Generally speaking, the affidavit of an employee of an agent's firm is admissible only to the extent that the evidence relates to non-controversial and non-central matters [see *Cross Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada* 2005 FC 1254, *aff'd* 2006 FCA 133].

[14] As Ms. Parrott has simply provided copies of webpages and an excerpt from the CIPO trademark database, I do not consider this evidence to run afoul of the principles set forth in *Cross Canada Auto Body*. Having said that, Ms. Parrott is not in a position to confirm the accuracy of the contents of the webpages attached to her affidavit. At most, this evidence may be relied upon only as proof of the existence of the search results and website pages, not as proof of the truth of their contents [*ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056].

[15] In the absence of submissions, the relevance of Ms. Parrott's evidence is unclear. To the extent that the Opponent introduced this evidence to establish use of its AMK trademark, I note that the mere existence of webpages does not establish the extent or duration of use of marks that may be displayed on them, or even that the pages have been accessed by relevant consumers [*ITV Technologies Inc, supra*, at paras 21-22].

REASONS FOR DECISION

Non-registrability ground

[16] The Opponent has pleaded that, pursuant to section 38(2)(b) of the Act, the Trademark is not registrable in view of section 12(1)(d) of the Act because it was confusing with the Opponent's registered trademark AMK.

[17] The material date for this ground of opposition is the date of my decision.

[18] I have exercised the Registrar's discretion to confirm that registration No. TMA756,709 is extant. Hence, the Opponent has met its evidential burden in respect of this ground of opposition. The Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Trademark and the AMK trademark.

Test for confusion

[19] The test for confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods associated with those trademarks are manufactured or sold by the same person, whether or not the goods are of the same general class or appear in the same class of the Nice Classification. Therefore, section 6(2) of the Act does not deal with confusion between trademarks themselves, but with the likelihood that goods from one source will be perceived as being from another source.

[20] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees an applicant's mark, at a time when

they have no more than an imperfect recollection of an opponent's trademark, and do not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[21] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods and services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54].

Inherent distinctiveness of the trademarks

[22] Trademarks comprised of a simple combination of letters or initials are traditionally considered to be “weak” marks with low inherent distinctiveness [*GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD) at 162-164].

[23] In the present case, both parties’ trademarks consist of a combination of the letters A, K, and M, albeit in a different order. I therefore consider them to have an equally low degree of inherent distinctiveness.

[24] This factor is neutral as it favours neither party.

Extent known and length of time in use

[25] There is no evidence before me regarding use of the parties’ trademarks or the extent to which either has become known in Canada.

[26] I note that the Opponent’s registration includes a declaration of use dating back to December 15, 2009. In the absence of any evidenced use of the Opponent’s trademark, at best, I can assume only *de minimis* use [see *Tokai of Canada v Kingsford*

Products Company, LLC, 2018 FC 951 at para 37]. *De minimis* use does not support a conclusion that the trademark has become known to any significant extent, nor that the trademark has necessarily been used continuously since the date stated [see *Krauss-Maffei Wegmann GmbH & Co KG v Rheinmetall Defence Electronics GmbH*, 2017 TMOB 50].

[27] In my view, if the Opponent wished to have the benefit of these surrounding circumstances, it should have furnished proper evidence accordingly.

[28] As such, these factors are also neutral.

Nature of the goods or business; and nature of the trade

[29] Under a registrability ground of opposition, the statement of goods in the applicant's application and in the opponent's registration must be assessed having regard to the channels of trade that would normally be associated with such goods and services [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3, 1987 CanLII 8953 (FCA); *Henkel Kommandit-gesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)].

[30] The Opponent's registration covers mechanical goods like electric motors, gears, motor-driven pumps, motor-driven pumps, industrial robots (machines) and various types of other machines such as packing machines, textile machines, paper making machines. The Applicant's application covers servomotors. Given their connection to mechanical systems, at a minimum, I consider that the parties' goods are related.

[31] In the absence of evidence regarding their businesses and channels of trade, and without the benefit of written submissions from either party, I find it reasonable to infer that the nature of the parties' businesses and channels of trade could overlap.

[32] Accordingly, these factors favour the Opponent.

Degree of resemblance between the trademarks

[33] The Supreme Court of Canada has stated that the degree of resemblance between the trademarks will often have the greatest effect on the confusion analysis;

the Court also advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trademark that is particularly striking or unique [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at paras 49 and 64]. If no component is particularly striking or unique, if the first portion of a trademark can be the most relevant for the purposes of distinction [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)].

[34] The trademarks AKM and AMK are both solely comprised of a combination of three letters, namely A, K, and M. Neither trademark presents a particularly unique or striking aspect.

[35] As letter combinations having no discernable meaning in the English or French languages, neither mark conveys a particular idea and so there is no resemblance in the ideas conveyed. However, when viewed and sounded, the trademarks bear a considerable degree of resemblance given that they share identical letters albeit in a different order. The resemblance is further accentuated by the shared first letter A.

[36] On balance, this factor also favours the Opponent.

Conclusion on likelihood of confusion

[37] Having considered all of the surrounding circumstances, and in particular the high degree of resemblance between the marks and the relatedness of the goods, I find that the Applicant has not met its legal burden with respect to the likelihood of confusion between the parties' trademarks.

[38] Accordingly, the non-registrability ground of opposition is successful.

Non-entitlement to register and non-distinctiveness grounds

[39] The Opponent has pleaded that:

- pursuant to section 38(2)(c) of the Act, the Applicant is not entitled to registration of the Trademark in view of section 16(1)(a) of the Act because, at the time of the filing date of the application, the Trademark was confusing with the

Opponent's trademark AMK that had been previously used and made known in Canada in association with the Opponent's Goods; and

- pursuant to section 38(2)(d), and contrary to section 2 of the Act, the Trademark is not distinctive of the Applicant's servomotors, and is not capable or adapted to distinguish those goods from those of others, including the Opponent's Goods.

[40] The material date for assessing the section 16(1)(a) non-entitlement ground is the filing date of the application. The material date for assessing the non-distinctiveness ground is the date of filing of the statement of opposition.

[41] The Opponent has provided evidence of neither use nor making known of its AMK trademark, prior to the material dates or otherwise. Therefore, there is no evidence of record with which the Opponent could meet its initial evidential burden for the section 2 and 16(1)(a) grounds of opposition.

[42] Accordingly, these grounds of opposition are rejected.

Applicant was not using and did not propose to use ground

[43] The Opponent has pleaded that, pursuant to section 38(2)(e) of the Act, the Applicant was not using and did not propose to use the Trademark in Canada in association with servomotors, either by itself or through a licensee.

[44] The material date for this ground is the filing date of the application.

[45] I first note that the pleading is insufficient. While it is generally sufficient to simply plead that an applicant was not using the applied-for trademark to satisfy the first aspect of section 38(2)(e), the Opponent has not pleaded material facts as to why the Applicant did not propose to use the Trademark in Canada, to satisfy the second aspect of this ground.

[46] In any event, the Opponent has filed no evidence to support this ground. Accordingly, for at least the reason that the Opponent has not met its evidential burden, this ground of opposition is rejected.

Non-entitlement to use ground

[47] Finally, the Opponent has pleaded that, pursuant to section 38(2)(f) of the Act, at the filing date of the application, the Applicant was not entitled to use the Trademark in Canada in association with servomotors because it was confusing with the Opponent's AMK trademark that had been previously used and made known in Canada in association with the Opponent's Goods.

[48] The material date for this ground is the filing date of the application.

[49] I note that likely confusion between an applied-for trademark and a previously used and made known trademark is not a fact that supports a non-entitlement to use ground of opposition. Indeed, section 38(2)(f) of the Act does not address an applicant's entitlement to register the mark relative to another person's trademark (pursuant to section 16 of the Act).

[50] Instead, section 38(2)(f) addresses an applicant's lawful entitlement to use the trademark, for example, in compliance with relevant federal legislation and other legal obligations prohibiting "use" of the trademark within the meaning of section 4 of the Act [see *Methanex Corporation v Suez International, société par actions simplifiée*, 2022 TMOB 155].

[51] In other words, the facts pleaded by the Opponent are not ones that can support a section 38(2)(f) ground of opposition. Accordingly, this ground is also rejected.

DISPOSITION

[52] In view of all of the foregoing, 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.

Eve Heafey
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held.

AGENTS OF RECORD

For the Opponent: Riches, McKenzie & Herbert LLP

For the Applicant: Robic Agence PI S.E.C./ Robic IP Agency LP