

**IN THE MATTER OF AN OPPOSITION by  
Trefimétaux, Société anonyme to Application No. 868183 for the  
Trade-mark TMX filed by Thyssen Canada Limited.**

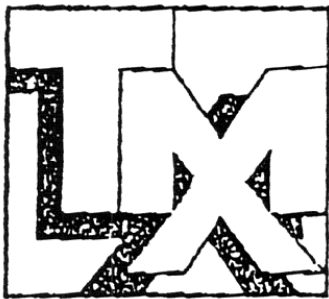
On February 3, 1998, Thyssen Canada Limited (the «Applicant») filed an application to register the trade-mark TMX («Mark») in association with distributorship services for semi-finished non-ferrous metal and plastics for industrial purposes; custom manufacturing and processing of semi-finished non-ferrous metals and plastics for industrial purposes (the “Services”), based on proposed use. The application was subsequently advertised in the *Trade-marks Journal* on May 26, 1999, for opposition purposes.

On July 14, 1999, Trefimétaux, Société anonyme (the «Opponent») filed a Statement of Opposition. The Applicant served and filed on September 9, 1999, a Counter Statement in response to the Statement of Opposition, in which it denied each and every ground of opposition raised by the Opponent in its Statement of Opposition. Leave to amend its Statement of opposition was filed by the Opponent and by a decision rendered January 18, 2002, the Board granted such request. The Applicant did not file an amended counter statement. I shall thereafter only refer to grounds of opposition raised in the Amended Statement of Opposition.

These grounds of opposition can be summarised as follows:

- a) The application does not comply with Section 30 of the Trade-mark Act («Act») in that:
  - (i) The Applicant had already used the Mark in whole or in part in Canada;
  - (ii) The Applicant never had the intention to use the Mark in Canada or abandoned it in whole or in part;
  - (iii) The Applicant falsely declared that it was entitled to use the Mark in Canada in view of the facts hereinafter set forth;
  
- b) The Mark is not registrable in view of the provisions of Section 12 (1)(d) of the Act as:

- (i) It is confusing with the Opponent's registered trade-mark «TMX» and design, as illustrated hereinafter, registration number TMA 523744 (the "Opponent's Registered Trade-Mark") in association with base metals and their alloys, namely brass and copper, metal building materials, namely strips with or without surface treatment for: roofing and cladding, eavestroughs, water drain pipes, semiconductors, household appliances, solar, electronic and electric heating; solid and hollow bars and channels for: faucets, electrical, automobile industry, household appliance manufacturing, micromechanical and optical, die making and interior decorating, tubes made of copper for the air conditioning and refrigeration industries, faucets and fittings, electro-mechanical, measuring apparatus and medical supplies; metal materials for the railway industry; non-electrical metal cables and wires; metal pipes; safes; metal products not included in other classes, namely, non-slip treads, gridworks, trellises, grating, steel balls, horseshoes, nails and screws, lead, anvils, rails (the "Opponent's Wares");



- c) The Applicant is not the person entitled to the registration of the Mark in view of the provisions of section 16(3) of the Act as:

- (i) At the date of filing, it was confusing with the trade-mark TMX previously used or made known in Canada by the Opponent or its predecessor-in-title in association with the Opponent's Wares;
  - (ii) At the date of filing, it was confusing with a trade-mark for which an application had been previously filed in Canada, namely application number 883170 for the trade-mark TMX and Design in association with the Opponent's Wares;
  - (iii) The application doesn't comply to the provisions of section 30 of the Act as it should have been based on use as it was used or abandoned as the case may be and is not registrable;
- d) The Mark is not distinctive, within the meaning of section 2 of the Act, of the Applicant's Services nor is it adapted to distinguish them from the Opponent's Wares because:
- (i) Of the adoption, use, made known and registration of the Opponent's famous trade-marks;
  - (ii) Subsequent to its transfer, there remained use rights to two or more entities which were exercised by them concurrently, the whole contrary to the provisions of section 48(2) of the Act;
  - (iii) The Applicant allowed third parties to use the Mark in Canada, and in fact those third parties used it, outside the scope of protection of licensed use provided at section 50 of the Act.

The Opponent's evidence consists of a certificate of authenticity of application number 883170 for the trade-mark TMX and design and the affidavit of Dimitri DiDedda. The Applicant didn't file any evidence. Neither party filed written submissions. Only the Opponent appeared at the oral hearing.

During the hearing, the Opponent made a verbal request, pursuant to Rule 44, to file as additional evidence a certificate of authenticity of registration number 523744 for the Opponent's Registered Trade-Mark to support its ground of opposition based on Section 12(1)(d) of the Act. As the Applicant was absent at the hearing, I asked that such demand be made in writing with a copy addressed to the Applicant's agent. By letter dated December 1<sup>st</sup>, 2003, I sought comments from the

Applicant with respect to such request but the Applicant failed to respond. As the aforesaid registration was raised in the Opponent's Amended Statement of Opposition, the Applicant is not taken by surprise by the filing of such additional evidence. I'm therefore granting the Opponent's request to file, as additional evidence, the certificate of authenticity of registration number 523744 for the Opponent's Registered Trade-Mark.

Mr. DiDedda has been an employee of the Opponent for the last fifteen (15) years. The Opponent has been selling in Canada since 1993 various base metals and their alloys in association with the trade-mark TMX. The Opponent filed on July 2, 1998, an application, number 883170, for the registration of the trade-mark TMX and design in association with the Opponent's Wares. Such application matured to registration on January 13, 2000, with the issuance of certificate of registration number 523744.

Filed as Exhibit A-1 to his affidavit are brochures illustrating the various products sold by the Opponent in association with the trade-mark TMX. There is no evidence as to when and to whom these brochures were distributed in Canada. Moreover the appearance of a trade-mark on brochures, by itself, does not constitute proper evidence of use of a trade-mark. [See *Clairol International Corp. v. Thomas Supply & Equipment Co. Ltd. (1968), 55 C.P.R. 176*]

A bundle of certificates of receipt of products was filed as exhibit A-2, but they all issued in 1999. Invoices also issued in 1999 were filed as exhibit A-3. Labels bearing the trade-mark TMX were filed as exhibit A-4. There is therefore no evidence of "use" as defined in Section 4 of the Act prior to 1999 of the trade-mark TMX or the Registered Trade Mark in association with the Opponent's Wares. [See *Bombardier Ltd.v. British Petroleum Co. Ltd., (1973), 10 C.P.R. (2d) 21, Conde Nast Publications Inc. v. Union des Editions Modernes (1979), 46 C.P.R.(2d) 183 and Hughes Aircraft Co. v. Fairchild Camera & Instrument Corp. (1990), 33 C.P.R. (3d) 500*]

The legal burden is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of its grounds of opposition. Once this initial burden is met, the burden shifts to the Applicant who must prove that the particular grounds of opposition should not

prevent registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293].

The material time for considering the issue of non-entitlement based on Subsection 16(3) of the Act is the filing date of the application (February 3<sup>rd</sup>, 1998) [Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the opposition (July 14, 1999) while registrability under 12(1)(d) must be assessed as of the date of my decision.[See *Andres Wines Ltd. and E&J Gallo Winery (1975)*, 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991)*, 37 C.P.R. (3d) 413 at 424 (F.C.A.)]

There has been no evidence to substantiate the grounds of opposition a), c) (iii) and d) (ii) and (iii) described above, and as such they are all dismissed.

There hasn't been any proper evidence of "use" in Canada by the Opponent of the trade-mark TMX prior to the date of filing of the application, as discussed above. Therefore ground of opposition c) (i) is dismissed. As for ground of opposition c) (ii), application 883170 wasn't filed prior to Applicant's present application and as such, this ground of opposition is also dismissed.

Confusion is a key issue to the remaining grounds of opposition, namely registrability of the Mark (Section 12(1)(d)) and distinctiveness of the Mark. In order to determine whether the Mark is confusing with the Opponent's registered trade-mark, Section 6(5) of the Act directs the Registrar to have regards to all of the surrounding circumstances, including:

- i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- ii) The length of time the trade-marks or trade-names have been in use;
- iii) The nature of the wares, services, or business;
- iv) The nature of the trade; and

- v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

It has been established that the criteria listed in section 6(5) of the Act are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co. v. Sears Canada Inc. (1992)*, 41 C.P.R.(3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon (1996)*, 66 C.P.R.(3d) 308 (F.C.T.D.)]. I shall therefore apply these principles to the evidence filed in the record by the parties.

The Opponent has discharged its initial burden of proof by filing the certificate of registration 523744 for the trade-mark TMX and design in association with the Opponent's Wares. The burden of proof therefore lies on the Applicant who must convince the Registrar, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trade-mark at the abovementioned relevant dates [see *Sunshine Biscuits Inc. c. Corporate Foods Ltd. (1982)*, 61 C.P.R. (2d) 53 and *Christian Dior, S.A. v. Dion Neckwear Ltd [2002] 3 C.F.405*].

- i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

The evidence filed in the record establishes "use" of the trade-mark TMX by the Opponent since January 28, 1999, while the Applicant hasn't filed any evidence of use of the Mark. As such the Opponent's trade-mark TMX, even though a weak mark as formed of letters of the alphabet, has acquired some distinctiveness. Therefore the first factor described above clearly favours the Opponent.

ii) The length of time the trade-marks or trade-names have been in use;

This criteria also favours the Opponent as it has established “use” of the trade-mark TMX since January 28,1999, while there is no evidence of use of the Mark by the Applicant.

iii) & iv) The nature of the wares, services, or business and the nature of the trade;

By comparing the description of the Services to the Opponent’s Wares, it is apparent that there exists an overlap between the Services and the Opponent’s Wares. The Applicant failed to adduce any evidence to try to differentiate the channels of trade of its Services from the channels of trade used by the Opponent to sell or offer for sale the Opponent’s Wares. Moreover Mr. DiDedda alleges in his affidavit, and it is uncontradicted evidence, that the Applicant is an important competitor of the Opponent. Therefore the third and fourth factors described above also favour the Opponent.

v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

The Mark is identical in appearance, sound and ideas suggested to the word portion of the Opponent’s Registered Trade-Mark. Therefore the fifth criteria listed above also favours the Opponent.

I conclude that the Applicant hasn’t discharged its burden to prove, on the balance of probabilities, that the Mark would not likely cause confusion with the Opponent Registered Trade-Mark and its trade-mark TMX , when used in association with the Services. I therefore maintain ground of opposition b) (i) described above.

The difference in the material dates to assess the evidence in relation to the lack of distinctiveness ground of opposition doesn't alter my conclusion reached above. As my conclusion reached on the issue of confusion is equally applicable to the ground of opposition based on lack of distinctiveness of the Mark, I also maintain ground of opposition d) (i) described above as the Mark is not adapted to distinguish the Applicant's Services from the Opponent's Wares.

Therefore, having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I refuse the Applicant's application to register the Mark in association with the Services, the whole pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 15 DAY OF JANUARY 2004.

Jean Carrière,  
Member,  
Trade-mark Opposition Board