

**IN THE MATTER OF AN OPPOSITION
by Ava Enterprises Inc. to application No.
1,007,672 for the trade-mark BOSS CONTROL
filed by Boss Control Inc.**

On March 8, 1999, the applicant, Boss Control Inc., filed an application to register the trade-mark BOSS CONTROL based on proposed use in Canada. The application was advertised for opposition purposes on April 9, 2003 and was subsequently amended on September 8, 2004. The statement of wares currently reads as follows:

- (1) Electronic security devices for controlling power to and/or access to functions of electrical and electronic equipment, devices and appliances, namely security power interrupt switches;
- (2) Consumer electronic products namely: computers including servers, desktop computers, laptop computers, palmtop computers, personal digital assistants, and handheld computers, video game controllers, camcorders, digital cameras, SLR cameras, DVD players, HDTVs, projection TV, satellite receiver, audio amplifiers, copiers, FAX machines, printers, video projectors, audio recorders and transcribers, scanners, shredders, telephone systems, namely, telephone network controllers and routers; typewriters / word processors, video and teleconferencing equipment, namely, video and teleconferencing controllers and routers; answering machines, two-way radios, portable televisions;
- (3) Motorized vehicles namely: automobiles, snowmobiles, personal watercraft, all terrain vehicles, motorcycles, trucks, trains, aircraft, buses, vans, pickups;
- (4) Consumer, commercial and industrial appliances namely: stoves, compactors, dishwashers, freezers, grills (heating and cooling), microwaves, ovens, refrigerators, washers and dryers, air purifiers, irons, steamers, sewing machines, steam cleaners, vacuum cleaners, blenders, breadmakers, can openers, coffee grinders, coffee makers, deep fryers, egg cookers, electric skillets, food processors, food dehydrators, food slicers, griddles, knife sharpeners, portable burners, roaster ovens, slow cookers, toasters, waffle makers;


(5) Medical equipment namely; pressure monitors (EKG, respiratory), fetal monitors, incubators and warmers, syringe pumps, defibrillators, enteral pumps, infusion pumps; X-ray machines, MRI's, heart monitors; electronic exercise machines, namely, treadmills, rowing machines and cycles; cash registers, bank machines (instant teller), all electronic locks both commercial and residential for door entry systems; lock boxes, vaults; vending machines including money vending machines and confectionary, automated coin operated washing machines;

(6) Consumer and commercial telecommunication devices namely: portable telephones, cellular telephones, pagers, global positioning devices and systems, GPS handheld, mobile communications transceivers, radar detectors, mobile audio transceivers;

(7) Construction equipment namely: backhoes, cranes, dozers, excavators, payloaders, road graders/bladders, scrapers, track loaders, trucks, tractor trailers;

(8) Farm equipment namely; chemical applicators, combines and combine heads, grain processors, hay and forge processors, irrigation equipment, namely, sprinklers.

The opponent, Ava Enterprises Inc., filed a statement of opposition on September 8, 2003, a copy of which was forwarded to the applicant on November 25, 2003. The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(i) of the Trade-marks Act because the applicant could not have been satisfied that it was entitled to use the applied for trade-mark in Canada. The second ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the following registered trade-marks owned by the opponent:

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>
528,263	BOSS AUDIO SYSTEMS	Automobile audio components namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers.
528,163		Automobile audio components namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers.

The third ground of opposition is that the applied for trade-mark is not distinctive because it is confusing with the opponent's previously used trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of its President, Soheil Rabbani. The applicant did not file evidence. Only the opponent filed a written argument and an oral hearing was conducted at which both parties were represented.

THE OPPONENT'S EVIDENCE

In his affidavit, Mr. Rabbani states that the opponent sells **BOSS AUDIO** automobile audio components to wholesalers in Canada and, in some cases, directly to retailers. Canadian sales for the period 2000 to 2003 were in excess of \$639,000 (US) at the wholesale level. Advertising expenditures in Canada for that same period were over \$18,000 (US).

THE GROUNDS OF OPPOSITION

The first ground does not raise a proper ground of opposition. The opponent has simply reproduced the wording from Section 30(i) of the Act without any supporting allegations of fact. Thus, the first ground is unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the applicant's mark is inherently distinctive since it has no obvious connotation relating to the nature of the applied for wares. Since the applicant did not file any evidence, I must conclude that its mark has not become known at all in Canada.

The opponent's registered marks are also inherently distinctive. There is a slang meaning for the word BOSS of "excellent" or "neat" but that does not significantly detract from the inherent distinctiveness of the applicant's marks. Given the limited Canadian sales

and advertising, I am only able to conclude that the opponent's marks have become known to some extent in Canada in association with automobile audio components.

The length of time the marks have been in use favors the opponent. As for the wares and trades of the parties, it is the applicant's statement of wares and the statement of wares appearing in the opponent's two registrations that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

It is reasonable to assume that the opponent's automobile audio components could be sold through retail electronics stores and through ordinary department stores. It is also possible that they could be sold through outlets dealing in motorized vehicles as accessories to such vehicles. If such is not the case, the onus was on the applicant to evidence the distinct natures of the particular trades involved. Thus, I find that there is a potential overlap in the trades of parties in respect of the wares identified as (1), (2), (3), (4) and (6). The remaining wares in the application are completely different from the opponent's registered wares and presumably the related trades would also be completely different.

As for Section 6(5)(e) of the Act, the marks of the parties bear a fair degree of resemblance in all respects because the first and most distinctive element in each mark is the word BOSS.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the marks, wares and trades in respect of the applicant's wares listed as (1) - (4) and (6), I find that the applicant has failed to satisfy the onus on it to show that its applied for mark is not confusing with the opponent's two registered marks in relation to those particular wares. Otherwise, I find that the marks are not confusing. Thus, the second ground of opposition is successful in relation to the applicant's wares (1), (2), (3), (4) and (6) and is otherwise unsuccessful.

As for the third ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - September 8, 2003): see Re 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) 412 at 424 (F.C.A.).

The third ground essentially turns on the issue of confusion between the marks at issue. My conclusions respecting the second ground are equally applicable to the third ground. Thus, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's marks and therefore is distinctive in relation to the wares listed as (1) - (4) and (6). The third ground is therefore successful as to those wares and is otherwise unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application in relation to the wares listed as (1), (2), (3), (4) and (6) and I otherwise reject the opposition. Authority for such a divided result may be found in Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH (1986), 10 C.P.R.(3d) 482 at 492 (F.C.T.D.).

DATED AT GATINEAU, QUEBEC, THIS 4th DAY OF OCTOBER, 2006.

**David J. Martin,
Member,
Trade Marks Opposition Board.**