

**IN THE MATTER OF AN OPPOSITION
by Bosch Rexroth Corporation to application
No. 884,995 for the trade-mark FLEX AIR
Design filed by Paccar Inc.**

On July 21, 1998, the applicant, Paccar Inc., filed an application to register the trade-mark FLEX AIR Design (shown below) for “heavy duty truck parts and components, namely suspension systems” based on proposed use in Canada. The applicant claimed priority based on its corresponding United States application and thus the effective filing date of the present application is February 9, 1998. The application was amended to include a disclaimer to the word AIR and was subsequently advertised for opposition purposes on January 17, 2001.

FLEX Air

Mannesmann Rexroth Corporation (“Mannesmann”) filed a statement of opposition on March 13, 2001, a copy of which was forwarded to the applicant on April 3, 2001. Mannesmann subsequently changed its name to Bosch Rexroth Corporation (“Bosch”) on April 30, 2001.

The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent’s trade-mark FLEXAIR registered under No. 119,729 for “manually operable pneumatic control valves employed in industrial machinery.” The second ground is that, as of the applicant’s effective filing date, the applied for trade-mark was confusing with the trade-mark FLEXAIR previously used in Canada by the opponent. The third ground is that

the applicant's trade-mark is not distinctive because it is confusing with the opponent's trade-mark used in Canada.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Joachim Scholz. As its evidence, the applicant submitted the affidavits of Tonia Pedro and Jane Buckingham. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

THE OPPONENT'S EVIDENCE

In his affidavit, Mr. Scholz identifies himself as the Vice-President, Sales and Marketing of the opponent Bosch. According to Mr. Scholz, the opponent has used its trade-mark FLEXAIR in Canada since 1960 in association with a pneumatic pressure control valve. One of the catalogue excerpts appended as Exhibit C to the Scholz affidavit states that the opponent's valve is "...especially useful to control oil drilling rigs, excavating machinery, hoists, dredges, production machines and special purpose equipment."

Mr. Scholz states that Bosch's Canadian distributor is Basic Technologies Inc. According to Mr. Scholz, Canadian sales of the opponent's FLEXAIR valve for the period 1994-2001 totaled approximately \$150,000. During the period 1998-2001, more than 960 product catalogues were distributed in Canada.

THE APPLICANT'S EVIDENCE

In her affidavit, Ms. Pedro identifies herself as a law clerk and states that she conducted

Internet searches regarding the channels of trade for the trucking industry and the valve industry. Her search for “fluid operated valves and controls” revealed seven businesses which generally appear to be engaged in the fluid power industry.

Ms. Pedro also included a definition of “fluid power” obtained from the web site for the National Fluid Power Association. The definition suggests that valves such as those sold by the opponent would be used in industrial applications and not in the motor vehicle industry.

Ms. Pedro also conducted a search of trade directories for entries for the two parties to this opposition. The entries she located indicated that the opponent and its Canadian distributor are engaged in the business of manufacturing and selling hydraulic and pneumatic valves and power packs whereas the applicant manufactures and sells heavy duty trucks.

The Buckingham affidavit details the results of searches conducted by Ms. Buckingham. Using the CDNameSearch software, she searched the records of the Trade-marks Office to locate trade-marks including the component FLEX and classified within International Class 07. She located more than 250 qualifying registrations, over 70 of which are for trade-marks commencing with the component FLEX.

Ms. Buckingham also conducted searches using the NUANS name reservation system. She was able to locate a number of business names incorporating the component FLEX. However, her results are of little assistance in this case since, for the most part, it is impossible to determine the type of business (if any) carried on under the individual names.

THE GROUNDS OF OPPOSITION

As for the first 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.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, 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 marks at issue are coined terms and are therefore inherently distinctive. However, both are suggestive of the nature of the associated wares and are therefore inherently weak. The opponent's mark FLEXAIR suggests that its control valves are pneumatic or air-driven and have flexible operation. The applicant's mark FLEX AIR Design suggests that its truck suspension systems possess air-driven components and provide a comfortable or flexible ride.

There is no evidence of use of the applicant's mark in Canada. Thus, I must conclude that it has not become known at all in this country. The opponent's mark has been used in this country for a number of years but only to a very limited extent. I can only ascribe a minor reputation for that mark within the specific and specialized trade serviced by the opponent.

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 registration 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.).

In the present case, the wares of the parties differ. Truck suspension systems are different from manually operated pneumatic control valves used in such applications as oil drilling rigs, excavating machines, hoists and dredges. Furthermore, the wares of both parties appear to be fairly expensive items that would be purchased by sophisticated and knowledgeable purchasers (see, for example, the detailed ordering instructions for the opponent's product included on page 19 of Exhibit C to the Scholz affidavit).

Presumably the trades of the parties would also differ significantly. The fact that trucks may be used at the same sites where excavating machines and oil rigs are used does not mean there is any connection of note between the wares and trades of the parties. The opponent contended that, since mining operations and excavation sites are often in remote locations, parts and repair facilities for the needed equipment are typically on site and that the

point of purchase would therefore be on site. However, there is no evidence of record to support these contentions.

As for Section 6(5)(e), the marks at issue are virtually identical in all respects.

As a surrounding circumstance, the applicant has relied on the state of the register evidence in the Buckingham affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

In the present case, the trade-marks register contains a large number of FLEX marks registered in the broad category of wares that includes machinery and the like. Many of those registered marks commence with the component FLEX. None of those third party registrations, however, is for the mark FLEXAIR. Nevertheless, the large number of FLEX marks underscores the inherent weakness of such marks and suggests that consumers are used to seeing such marks in the general field of commerce covering machinery and the like. Thus, differences between such marks or, as in the present case, differences in the associated wares and trades of the parties increase the likelihood that the related marks will not be confused.

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 inherent weakness of the marks at issue, the limited reputation associated with the opponent's mark and the differences between the wares and trades of the parties, I find that the applicant has satisfied the burden on it to show no reasonable likelihood of confusion between its mark and the opponent's registered mark. Thus, the first ground is unsuccessful.

As for the second ground of opposition, the opponent has met its initial burden by evidencing use of its mark FLEXAIR prior to the applicant's effective filing date of February 9, 1998 and non-abandonment of its mark as of the applicant's advertisement date. Thus, the second ground remains to be decided on the issue of confusion between the marks of the parties as of the applicant's effective filing date. For the most part, my conclusions respecting the first ground of opposition are also applicable to the second ground. Thus, I find that the two marks were not confusing as of the material time and the second ground is also 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. - March 13, 2001): 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 two marks of the parties. Again, my conclusions respecting the first ground are, for the most part, also applicable here. Thus, as of the filing of the opposition, the applicant's mark was not confusing with the opponent's mark and the third ground is also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT GATINEAU, QUEBEC, THIS 21st DAY OF FEBRUARY, 2006.

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