



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 61
Date of Decision: 2015-03-31

**IN THE MATTER OF AN OPPOSITION
by Aevoe Corp. to application No.
1,383,943 for the trade-mark MOSHI in
the name of Stuart Michael Nostrant**

[1] Stuart Michael Nostrant (the Applicant) has applied for the trade-mark MOSHI for use with a long list of toys, electronics-related goods, including electrical appliances, accessories for mobile devices, computer software, and clocks, as well as the on-line sale of these goods and entertainment services. The application was filed on the basis of (i) use of the trade-mark MOSHI in Canada with some of the goods; (ii) the use and registration in the United States for some of the goods, and (iii) proposed use in Canada with the remaining goods and services.

[2] Aevoe Corp. (the Opponent) is a California corporation that uses the identical trade-mark MOSHI in association with goods related to accessories and peripherals for electronic devices, and the on-line sale of these goods. The Opponent has opposed this application primarily on the basis that the MOSHI trade-mark is confusing with its trade-mark and trade-name in Canada. The Opponent also challenges the dates of first use claimed in the application.

[3] For the reasons that follow, I find that the application should be refused for the following goods and services where there is a reasonable likelihood of confusion between the parties' marks:

Goods:

(8) Electrical appliances, namely electric coffee makers.

(9) Accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (d) charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers.

(10) Clocks, watches.

(12) Computer software, namely, computer games, and computer software that enable mobile devices, personal digital assistants, cellular telephones and handheld computers to receive, download, record, store and play audio and audio-visual data.

Services:

(1) On-line retail store services offering for sale clocks, watches, home appliances, computer software, namely, computer games, and computer software that enable mobile devices, personal digital assistants, cellular telephones and handheld computers to receive, download, record, store and play audio and audio-visual data, charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers, and accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers.

Further, I find that the application should be refused with respect to the following goods as the Applicant has failed to prove that it has used the applied-for mark in association with the goods since the date claimed:

(3) Character shape pillows in the form of animals, insects, fish, snowmen, Santa Claus, and a star.

(4) Neck supports.

Background

[4] On February 19, 2008, the Applicant filed an application for the trade-mark MOSHI (the Mark). The application claims proposed use, use in Canada and use and registration in the United States. The goods and services, along with a notation as to the basis on which they were filed and the first use dates, if any, are set out in Schedule A to this decision.

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 24, 2011. The Opponent filed a statement of opposition on October 24, 2011. The Opponent has pleaded non-compliance with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the basis of two of its grounds of opposition. The remaining grounds turn on the likelihood of confusion between the Mark and the Opponent's trade-mark and trade-name MOSHI (pursuant to sections 2, 12 and 16 of the Act). The Applicant filed and served a counter statement on January 3, 2012, in which it denies all of the Opponent's allegations.

[6] The Opponent filed as its evidence the affidavit of Jonathan Lin, President and Executive Director, Finance of the Opponent. The Applicant did not file any evidence. Mr. Lin was cross-examined on his affidavit and the transcript and the answers to undertakings. Only the Opponent filed written arguments and was represented at the hearing on November 18, 2014.

The Grounds of Opposition

[7] The grounds of opposition pleaded by the Opponent can be summarized as follows:

- a) Contrary to section 30(b) of the Act, the Applicant has not used the Mark in association with the Goods and Services as of the claimed dates in the application;
- b) Contrary to section 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Mark in association with the Goods and Services as the Applicant applied for registration of the Mark with knowledge of the Opponent's pre-existing trade-mark and trade-name rights in Canada;

- c) Contrary to sections 16(2)(a) and (c) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing, it was confusing with the Opponent's trade-mark and trade-name MOSHI;
- d) Contrary to sections 16(3)(a) and (c) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing, it was confusing with the Opponent's trade-mark and trade-name MOSHI; and
- e) Contrary to section 2 of the Act, the Mark is not distinctive of the Applicant.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. There is, however, an initial evidential burden on the Opponent to adduce or point to sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[9] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a)/30 – the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(c)/16(2) and 16(3) – the filing date of the application [see section 16(2) and 16(3)]; and
- Sections 38(2)(d)/2 – the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Grounds of Opposition

Section 30(b) Ground of Opposition

[10] The Opponent has pleaded that the application is contrary to section 30(b) of the Act:

Pursuant to Section 38(2)(a) of the *Trade-marks Act* the application does not comply with the requirements of Section 30 of the Act. Pursuant to Section 30(b), the Applicant for

MOSHI has not used the trade-mark in Canada in association with each of the general classes of goods described in the application since the claimed date of first use.

[11] At the hearing, the Opponent submitted that the statement of goods and services in the application was sufficient to meet its burden because the same goods or the same type of goods are claimed both on the basis of use and on the basis of proposed use. I agree with the Opponent's submissions and find that in the absence of evidence or submissions from the Applicant, that if a good has been applied for on the basis of proposed use this leads to the inference that there has been no use in Canada with respect to those goods (even if the same goods are described as being used in Canada). Therefore, the Opponent has met its evidential burden that use of the Mark had not commenced in association with the following goods as of the date claimed in the application:

- Neck supports
- Stuffed character shapes in the form of animals, insects, fish, snowmen, Santa Claus, and a star
- Toys, namely, stuffed balls

[12] As the Applicant has not filed any evidence, it has not met its legal onus and this ground of opposition is successful for these goods. As toys, namely, stuffed balls were also filed on the basis of use and registration abroad, the success of this ground of opposition does not mean that the application will be refused with respect to these goods. With respect to the remaining goods filed for on the basis of proposed use, none of these goods are found in the list of goods for which use is claimed.

[13] At the hearing, the Opponent argued that the application should also be refused with respect to all of the goods filed for on the basis of proposed use because the Applicant states in its counter statement that it had used the Mark with the general classes of goods or services (Opponent's Written Arguments, paras 9-10). The Applicant's counter statement states:

The Applicant has used the Subject Mark in Canada in association with each of the general classes of goods or services described in the Application as having been used in Canada, and since at least as early as the corresponding dates of first use claimed in the application.

[14] As this issue has not been raised in the Statement of Opposition, I am precluded from considering it [*Le Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 95 CPR (4th) 249 (FC) at paras 27-29].

Section 30(i) Ground of Opposition

[15] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark because the Applicant was aware of the Opponent's pre-existing trade-mark and trade-name rights. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [see *Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is rejected.

Remaining Grounds of Opposition

[16] Each of the remaining grounds of opposition turns on the issue of the likelihood of confusion between the Mark and the Opponent's trade-mark and/or trade-name.

Section 16 Grounds of Opposition

Sections 16(2)(c) and 16(3)(c) Grounds of Opposition

[17] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with its trade-name MOSHI.

[18] Grounds of opposition based on sections 16(2)(c) and 16(3)(c) of the Act are restricted to use of a trade-name and cannot rely on the making known of a trade-name [*Habib Bank Ltd v Habib Bank AG Zurich*, 2011 CarswellNat 4526 (TMOB) at para 21]. Accordingly, to meet its burden, the Opponent must show that it had used its trade-name in Canada prior to February 19, 2008, the filing date of the subject application, and that it had not abandoned such use as of August 24, 2011, the date of advertisement of the Mark. In determining whether there has been use of a trade-name, the principles of sections 2 and 4 of the Act apply [*Novopharm Ltd v Genderm Canada Inc* (1998), 85 CPR (3d) 247 (TMOB) at 257]. Since the Opponent provided

no evidence of use of its trade-name prior to the material date, it fails to meet its evidential burden. Accordingly, these grounds of opposition are rejected.

Sections 16(2)(a) and 16(3)(a) Grounds of Opposition

[19] The Opponent further alleges that the Applicant is not the person entitled to register the Mark as it is confusing with the Opponent's trade-mark MOSHI, which has been made known and used in Canada. In order to meet its evidential burden, the Opponent must show that it had made known or used its MOSHI trade-mark in Canada prior to February 19, 2008, the filing date of the subject application, and that it had not abandoned such mark as of August 24, 2011, the date of advertisement of the Mark.

[20] At the outset, I note that the Opponent has not met the requirements for making known set out in section 5 of the Act since it has not provided evidence of advertising in printed publication or radio broadcasting as of the material date, nor that its trade-mark is well known. The Opponent, however, has provided evidence sufficient to satisfy the requirements for use of its trade-mark MOSHI, as set out in section 4 of the Act, in association with the following goods and services (the Opponent's Goods and Services):

Goods: Accessories and peripherals for computers and portable electronic devices, namely, input devices for computers, electronic memory card readers, USB hubs, notebook computer cooling pads, protective cases and covers, keyboards, screen protectors, and computer cables.

Services: Online sales services for these goods.

[21] Mr. Lin provides the following evidence of use of the MOSHI trade-mark in association with the Opponent's Goods as of the material date:

- The Opponent's MOSHI trade-mark is attached to or marked on the Opponent's products themselves or included on packaging (Lin affidavit, para 4). Examples of a MOSHI-branded notebook cooling fan, palm rest, USB hub and memory card reader with USB cable, keyboard, and protective cases, including the "mini iPouch", which is designed for mobile phones and mini iPads, and the "PockiT", which is designed for compact digital cameras, are provided (Lin affidavit, para 4 and Exhibit A). Such use is representative of

the Opponent's use of its MOSHI trade-mark on packaging for products sold by the Opponent in Canada since at least as early as November 10, 2005 (Lin affidavit, para 4; cross-examination Q183).

- An invoice showing the sale of a MOSHI-branded "nano Pouch" to a customer in Ottawa, Ontario dated November 10, 2005 (Lin affidavit, para 5 and Exhibit D).

Use of the MOSH Trade-Mark in Association with the Opponent's Services

[22] Mr. Lin provides the following evidence of use in association with the Opponent's Services as of the material date:

- The Opponent's website *www.moshimonde.com* has been available to Canadians since 2007 (Lin affidavit, para 5). Online orders for MOSHI-branded products for shipment to Canada have been placed every year (Lin affidavit, para 7) and an invoice pertaining to an online sale of MOSHI-branded nana-Pouch to a Canadian customer is provided (Lin affidavit, Exhibit D) [see *Unicast SA v South Asian Broadcasting Corp* (2014), 122 CPR (4th) 409 (FC) at paras 45-46 (*Unicast*) for a discussion of when the use of a trade-mark on a website constitutes use pursuant to section 4 of the Act].
- An archived print-out from the Opponent's MOSHI website dated December 7, 2007, obtained from the WayBack Machine showing the MOSHI trade-mark, is attached as Exhibit C (Lin affidavit, para 5, Exhibit C; Lin cross-examination, Qs 185-189). I note that the Internet archive system WayBack Machine has been accepted as a reliable source for evidencing the state of websites in the past [see *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FC) at para 21; rev'd on other grounds 2008 FCA 100].

[23] As I have found that the Opponent's evidence is sufficient to show use of its trade-mark MOSHI prior to the material date, the Opponent has met its evidential burden to support the sections 16(2)(a) and 16(3)(a) grounds of opposition with the Opponent's Goods and Services.

Test for confusion

[24] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[25] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

[26] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Inherent distinctiveness

[27] As MOSHI is a coined word that does not suggest or appear to have any relation to either the parties' goods or services, it has a high degree of inherent distinctiveness.

Degree of resemblance between the marks

[28] The factor significantly favours the Opponent as the trade-marks of both parties are identical in sound and appearance. Further, both parties' trade-marks suggest the same idea – a coined word, non-sensical word.

Extent known and length of time in use

[29] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. Mr. Lin's evidence is that from 2006 onwards, the Opponent has promoted its MOSHI products by having an exhibition booth at a number of international and Canadian tradeshows (Lin affidavit, para 10), and that the MOSHI trade-mark has become known to some extent in Canada through promotion and sales on the Opponent's Moshi website, *www.moshimonde.com*, since 2007 (Lin affidavit, para 5). In the absence of sales or advertising information, it is difficult to quantify the extent to which the Mark was known as of the material date.

[30] As the Applicant has not filed any evidence of use of the Mark, this factor slightly favours the Opponent.

The nature of the goods, services or business; the nature of the trade

[31] This factor significantly favours the Opponent with respect to the computer/electrical related goods and the on-line sales of these goods. This factor favours the Applicant with respect to the remaining goods including toys, jewellery, stationery supplies and entertainment services.

[32] The Opponent argues that there is a great deal of overlap between those Goods based on proposed use and use and registration abroad and the Opponent's Goods since both parties offer computer related or computer-based goods or services. I find that the nature of the goods set out below and the on-line sales of these goods significantly overlaps with the Opponent's Goods and Services:

- Electrical appliances, namely, electrical coffee makers;
- Accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers;
- Clocks, watches; and
- Computer software.

[33] These goods target a similar audience as the Opponent's Goods (consumers that are interested in personal electrical and electronic devices, particularly computer and mobile devices,

and accessories related thereto). Because the nature of the goods overlap, it is reasonable to assume that these goods may also be sold in the same channel of trade as the Opponent's Goods.

[34] With respect to the remaining goods for which use or use and registration abroad is claimed including toys, pillows, furniture, jewellery, and stationary supplies, I do not find that these goods overlap with the Opponent's goods since they appear to be for different purposes and/or target a different audience through different channels of trade.

[35] Regarding the Applicant's Goods related to toys, games and playthings, the Opponent submitted during the hearing that consumer electronics have become a form of toys for adults and children today. While it is true that some of the toys specified in the application may be computer-related or have a computer component or that some computer and mobile device products may be used for amusement and entertainment, the computer and mobile device field is very broad and this does not in itself indicate overlap [see *VDO Road Digital Inc v @Road, Inc*, 2004 CarswellNat 4706 (TMOB) at para 17]. Further, the majority of the Applicant's toys-related Goods are of a stuffed, plush or soft nature and seem to be directed at young children as indicated by the goods, stuffed balls; stuffed character shapes; plush toys; soft sculpture toys; and toys designed to be attached to car seats, strollers, cribs, and high chairs. Therefore, I find that the Opponent's MOSHI-branded products are of a much more sophisticated nature and do not overlap with the Applicant's toys-related Goods.

[36] The Opponent further submitted during the oral hearing that a number of MOSHI-branded protective cases are ornamental and operate as a fashion item not unlike jewellery. Although I note that the Opponent's MOSHI-branded products are designed to be stylish, I do not find that ornamental protective cases are of the same wearable nature as jewellery, and the nature of the goods does not overlap with the Applicant's jewellery goods.

[37] Finally, regarding the Applicant's entertainment services, since there is no evidence that the Opponent provides any form of such services, I find no overlap in the nature of these services.

Further surrounding circumstances: evidence of actual confusion

[38] In his cross-examination, Mr. Lin testified that at least one person thought a MOSHI brand alarm clock was manufactured by the Opponent:

Q141	A. Yes, and they would come and say that there was this Moshi alarm clock that caused them problems ... So one of our customers picked it up and [threw] it across the room, thinking that ... you know, and then he came to me, telling me the store because he thought we had produced it, and we should know we were producing low quality products.
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[39] Mr. Lin stated that this incident occurred the week before the cross-examination (Lin cross-examination, Q144) but he was unable to recall or confirm through records who made the statements to him (Qs 145-146, Answers to Under Advisement). Given Mr. Lin's lack of recollection, I am only willing to give this evidence some weight to support an inference that consumers find overlap in small electrical goods and the Opponent's Goods.

Conclusion With Respect to Likelihood of Confusion

[40] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark when he or she has no more than an imperfect recollection of the Opponent's MOSHI trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) at para 20].

[41] For the reasons explained above, and in particular, as the Mark is identical to the Opponent's inherently distinctive trade-mark and there is significant overlap in the nature of the goods/services and trade for those goods and services listed below, I conclude that the Applicant has not discharged its burden of establishing, on a balance of probabilities, that the Mark is not confusing with the Opponent's trade-mark. The section 16(2)(a) and 16(3)(a) grounds of opposition are therefore successful with respect to the following goods and services:

Goods:

(8) Electrical appliances, namely electric coffee makers.

(9) Accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (d) charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers.

(10) Clocks, watches.

(12) Computer software, namely, computer games, and computer software that enable mobile devices, personal digital assistants, cellular telephones and handheld computers to receive, download, record, store and play audio and audio-visual data.

Services:

(1) On-line retail store services offering for sale clocks, watches, home appliances, computer software, namely, computer games, and computer software that enable mobile devices, personal digital assistants, cellular telephones and handheld computers to receive, download, record, store and play audio and audio-visual data, charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers, and accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers.

The section 16(2)(a) and 16(3)(a) grounds of opposition are rejected for the remaining goods and services at issue.

Section 2 Ground of Opposition – Non-Distinctiveness

[42] The Opponent alleges that the Mark does not distinguish the Goods and Services of the Applicant from the Opponent's Goods and Services associated with its MOSHI trade-mark and trade-name.

[43] There is an initial burden on the Opponent to establish that, as of October 24, 2011, the filing date of the opposition, its MOSHI trade-mark (or trade-name) was known to such an extent that it could negate the distinctiveness of the Mark. An allegation of non-distinctiveness is not restricted to the sale of goods or services in Canada. It may also be based on evidence of knowledge or reputation of the Opponent's MOSHI trade-mark or trade-name including that spread by means of word of mouth or newspaper or magazine articles [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58-59].

[44] The Opponent's evidence shows that the Opponent's reputation in Canada is sufficient to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at paras 33-34]:

- The Opponent has used the MOSHI trade-mark on product in Canada since at least as early as November 10, 2005 (Lin affidavit, para 4).
- Since the beginning of 2008, the Opponent has sold in excess of 100 thousand units under the MOSHI brand in Canada (Lin affidavit, para 11). While there is no information on what portion of these units were sold as of October 24, 2011, I find it reasonable to infer that a fair percentage of them occurred prior to this date given that Mr Lin's affidavit was sworn on July 7, 2012.
- The Opponent's MOSHI trade-mark is featured on its website *www.moshimonde.com* through which online orders for MOSHI-branded products for shipment to Canada have been placed every year since 2007 (Lin affidavit, paras 5 and 7, Exhibit B).
- MOSHI brand products are also available at the following resellers and retailers in Canada: Boutique Mac, Brock University, Canada Computers, Cesium Telecom, Core, Data Integrity, Mac Station, McMasters University Bookstore, MEDIAsolutions, MyMacDealer, Restart Computers, Simply Computing, Soho Computers, UBC Bookstores, University of Saskatchewan, University of Victoria Books, Apple Canada, Best Buy Canada, Compu2000, Future Shop, The Source, and Staples Canada (Lin affidavit, para 8). While Mr. Lin does not specify which of these resellers and retailers sold MOSHI brand product prior to the material date, he does provide invoices predating

the material date to the following retailers at Canadian addresses: Brock University in St. Catharines, Ontario; Data Integrity in Toronto, Ontario; ReStart Computers in Victoria, BC, Simply Computing, in Vancouver, BC and Celsius Telecom Inc in Montreal, QC (Lin affidavit, Exhibit H).

[45] While the Opponent's evidence suffers from a number of deficiencies, I consider that the Opponent has met its initial burden to show that its trade-mark had acquired a sufficient reputation in Canada on October 24, 2011 to meet its evidential burden. For the reasons set out with respect to the sections 16(2)(a) and 16(3)(a) grounds of opposition, I find that the Applicant has failed to meet its legal onus with respect to the issue of distinctiveness for the following goods and services:

Goods:

(8) Electrical appliances, namely electric coffee makers.

(9) Accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (d) charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers.

(10) Clocks, watches.

(12) Computer software, namely, computer games, and computer software that enable mobile devices, personal digital assistants, cellular telephones and handheld computers to receive, download, record, store and play audio and audio-visual data.

Services:

(1) On-line retail store services offering for sale clocks, watches, home appliances, computer software, namely, computer games, and computer software that enable mobile devices, personal digital assistants, cellular telephones and handheld computers to receive, download, record, store and play audio and audio-visual data, charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers, and accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a

radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers.

Disposition

[46] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,383,943 with respect to:

Goods:

- (3) Toys, namely stuffed character shapes in the form of animals, insects, fish, snowmen, Santa Claus, and a star.
- (4) Neck supports.
- (8) Electrical appliances, namely electric coffee makers.
- (9) Accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (d) charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers.
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Services:

- (1) On-line retail store services offering for sale clocks, watches, home appliances, software, namely, computer games, and computer software that enable mobile devices, personal digital assistants, cellular telephones and handheld computers to receive, download, record, store and play audio and audio-visual data, charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers, and accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones,

and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers.

[47] I reject the opposition with respect to the remainder of the goods and services, pursuant to section 38(8) of the Act [see *Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

Applicant's Applied for trade-mark MOSHI (App. No. 1,383,943)

GOODS:

- (1) Decorative pillows.
- (2) Toys, namely stuffed balls.
- (3) Toys, namely stuffed character shapes in the form of animals, insects, fish, snowmen, Santa Claus, and a star.
- (4) Neck supports.
- (5) Travel pillows.
- (6) Toys, games, playthings, namely stuffed toys, plush toys, toy furniture, stuffed dolls, stuffed puppets, soft sculpture toys, soft sculpture dolls, bean bags, collectable toy figures, collectable toy animals, toy animals, balls, toys designed to be attached to car seats, strollers, cribs, and high chairs.
- (7) Pillows, namely neck roll pillows, character shape pillows in the form of animals, insects, fish, snowmen, Santa Claus and a gingerbread man, pillows in the shape of squares, stars, hearts, balls, the moon, stars and cupcakes, rectangle pillows, round pillows, u-shaped pillows, lip shaped pillows and hassock pillows; cushions, namely head support cushions, neck support cushions, and cushions for dogs and cats; furniture, namely chairs, cat beds and dog beds; photograph frames; picture frames; mirrors.
- (8) Electrical appliances, namely electric coffee makers.
- (9) Accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (d) charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers.
- (10) Clocks, watches, jewellery.
- (11) Paper, cardboard and goods made from these materials, namely books, book covers book marks, publications namely manuals, magazines and newsletters, photographs albums, scrapbooks, albums for stickers, greeting cards, postcards, trading cards, calendars; adhesives for stationery and household purposes; paint brushes; temporary tattoos, stencils, decals, stickers; iron on transfers; plastic transfers; decalcomanias; bumper stickers; pens; pencils; crayons; chalk, writing instruments; markers; highlighting markers; decorations for pencils; decorative pencil top ornaments; pen cases; pencil cases; pen boxes; pencil boxes; erasers; pencil sharpeners; chalkboards for school; chalkboards for home use; drawing rulers; envelopes; note cards; rubber stamps; plastic stamps; wooden stamps; stamp pads; arts and crafts clay kits; arts and craft paint kits; face painting kits; modeling clay; painting sets; drawing sets.
- (12) Computer software, namely, computer games, and computer software that enable mobile devices, personal digital assistants, cellular telephones and handheld computers to receive, download, record, store and play audio and audio-visual data.

(13) Toys, namely stuffed character shapes.

SERVICES:

(1) On-line retail store services offering for sale toys, games, playthings, clocks, watches, home appliances, pillows, cushions, neck supports, furniture, computer software, namely, computer games, and computer software that enable mobile devices, personal digital assistants, cellular telephones and handheld computers to receive, download, record, store and play audio and audio-visual data, charms for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely charms in the form of animals, insects, fish, snowmen, Santa Claus, a gingerbread man, a star, lip shapes and three dimensional geometric shapes that can be attached to mobile devices, personal digital assistants, cellular telephones, and handheld computers, and accessories for mobile devices, personal digital assistants, cellular telephones, and handheld computers, namely: (a) docking stations comprising one or more of a clock or a radio for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (b) battery chargers for mobile devices, personal digital assistants, cellular telephones, and handheld computers, (c) wireless audio, audio-visual and digital receivers and transmitters for mobile devices, personal digital assistants, cellular telephones, and handheld computers; and entertainment services.

CLAIMS:

Used in CANADA since at least as early as July 27, 2004 on goods (1), (4).

Used in CANADA since at least as early as January 17, 2005 on goods (2).

Used in CANADA since at least as early as October 17, 2004 on goods (3), (5).

Used in UNITED STATES OF AMERICA on goods (1), (2), (13).

Registered in or for UNITED STATES OF AMERICA on October 25, 2005 under No. 3008374 on goods (1), (2), (13).

Proposed Use in CANADA on goods (6), (7), (8), (9), (10), (11), (12) and on services.