



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

**Citation: 2011 TMOB 50**  
**Date of Decision: 2011-03-30**

**IN THE MATTER OF AN OPPOSITION  
by 928735 Ontario Limited to application  
No. 1,315,384 for the trade-mark ERGO-  
FOAM in the name of Active &  
Innovative Inc.**

[1] On September 6, 2006, Active & Innovative Inc. (the Applicant) filed an application to register the trade-mark ERGO-FOAM (the Mark) based upon proposed use of the Mark in Canada in association with ergonomic products, namely chairs, backpacks, pillows, mattresses, adjustable back support and seat cushions.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 16, 2007.

[3] On October 15, 2007, 928735 Ontario Limited (the Opponent) filed a statement of opposition, which pleaded the following grounds pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act):

1. pursuant to s. 38(2)(a), the application does not comply with s. 30(i): “the applicant cannot have been satisfied that it is entitled to use the trade-mark in Canada in association with the wares and services listed in the application because it is confusing with the trade-mark ERGO previously used in Canada by the opponent, and accordingly is not distinctive of the applicant”;
2. pursuant to s. 38(2)(b), the Mark is not registrable in that contrary to s. 12(1)(d), it is confusing with the Opponent’s trade-mark ERGO, registered as No. TMA668,119 and used in association with pillows and manufacture of pillows;

3. pursuant to s. 38(2)(c), the Applicant is not the person entitled to registration of the Mark because, contrary to s. 16(3)(a), at the date of filing of the application, it was confusing with the trade-mark ERGO which had been previously used or made known in Canada by the Opponent in association with pillows and manufacture of pillows;
4. pursuant to s. 38(2)(c), the Applicant is not the person entitled to registration of the Mark because, contrary to s. 16(3)(b), at the date of filing of the application, it was confusing with the trade-mark ERGO, in respect of which an application for registration had been previously filed in Canada by the Opponent, namely application No. 1,201,153;
5. pursuant to s. 38(2)(d), the Mark is not distinctive of the Applicant because it does not actually distinguish, nor is it adapted so to distinguish the wares and services of the Applicant from the wares and services of others or from the wares and services of the Opponent sold in association with the trade-mark ERGO.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed the affidavit of Jacquelyn Anderson, a legal assistant with the firm representing the Opponent. Ms. Anderson simply provides a copy of the Opponent's trade-mark registration No. TMA668,119.

[6] In support of its application, the Applicant filed i) a certified copy of registration No. TMA644,277 for ERGO-HEALTH, ii) a certified copy of registration No. TMA699,634 for ERGO-PAK, iii) a certified copy of the file for application No. 1,201,153 for ERGO, and iv) the affidavit of Kathryn Stewart, a technical consultant employed with the firm representing the Applicant. Ms. Stewart simply provides the results of searches that she conducted of the Canadian Intellectual Property Office's trade-mark database on April 28, 2009 for registrations or allowed applications for trade-marks that include the term "ergo".

[7] No cross-examinations were conducted.

[8] No written arguments were filed and an oral hearing was not requested.

## Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements 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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

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

- s. 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 38(2)(b)/12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/16(3) - the filing date of the application;
- s. 38(2)(d) - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

## Grounds of Opposition that Can be Summarily Dismissed

[11] All but one of the grounds of opposition can be summarily dismissed.

[12] The s. 30(i) ground is dismissed because, where an applicant has provided the statement required by s. 30(i), such a ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155].

[13] The s. 16(3)(a) and 38(2)(d) grounds are dismissed because the Opponent has not met its initial burden in regard thereto. The Opponent has not evidenced that its mark was used or known as of the applicable material dates. Although the Opponent's registration refers to use, that is not sufficient to meet the initial onus on the Opponent under grounds of opposition of entitlement or distinctiveness [see *Roxxs, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) 265 (T.M.O.B.)].

[14] The s. 16(3)(b) ground is also dismissed because the Opponent has not met its initial burden. Section 16(4) requires that an application relied upon under s. 16(3)(b) be pending when the Applicant's application is advertised. As the Opponent's application had already issued to registration at that point of time, it does not support a s. 16(3)(b) ground [see *Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.) at 528].

#### Section 12(1)(d) Ground of Opposition

[15] The Opponent has met its initial burden with respect to its s. 12(1)(d) ground because its registration for ERGO is extant.

[16] 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[17] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 wares, 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. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

*inherent distinctiveness of the trade-marks and extent to which they have become known*

[18] The *Oxford Canadian Dictionary* defines "ergo" as "therefore", which suggests that "ergo" has no meaning in association with either party's wares or services. Based on this meaning, the Opponent's mark is inherently distinctive. Applying ordinary dictionary meanings,

the Applicant's Mark is also inherently distinctive, but less so than is the Opponent's since it also incorporates the word "foam", which suggests that the Applicant's wares are made of foam.

[19] However, the Applicant has described its wares as "ergonomic products" and therefore its Mark may be perceived as combining the first portion of ergonomic with foam, resulting in it being suggestive in its entirety. There is nothing before me that indicates whether the Opponent's wares and services are intended to be ergonomically favourable, but it is possible that the Opponent's mark might suggest that to the consumer.

[20] A trade-mark may acquire distinctiveness through use or promotion but there is no evidence of this having occurred with respect to either party's mark.

*length of time each trade-mark has been in use*

[21] The Opponent's registration indicates that a declaration of use was filed on June 6, 2006. It therefore appears that the Opponent's mark has been in use longer than the Applicant's Mark, but this factor is not particularly weighty since there is no evidence that the Opponent's mark has been used continuously since the filing of the declaration of use.

*nature of the wares, services, business or trade*

[22] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application or registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[23] The parties' wares overlap with respect to pillows and there is no reason not to assume that their channels of trade could also overlap. Mattresses and cushions are closely related to pillows; chairs have some relationship to pillows; but backpacks are unrelated to pillows. (I interpret the words "adjustable back support" in the Applicant's statement of wares as not being a separate ware but rather part of the description of the Applicant's cushions, namely "adjustable back support and seat cushions", in view of the lack of an "s" on "support".)

*degree of resemblance between the trade-marks*

[24] The first portion of a trade-mark is typically the most relevant for the purposes of distinction and the marks begin identically. This results in the marks having a relatively high degree of resemblance. The Applicant's suffix does not greatly distinguish the marks since "foam" describes the wares. [See *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.).]

*additional surrounding circumstances*

*i) state of the register evidence*

[25] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[26] Ms. Stewart introduced her search results without providing any analysis and the lack of argument from the Applicant means that I do not know what inference it would have me draw from the 114 marks that she introduced. When a party introduces state of the register evidence, it ought to provide an analysis of that evidence. I note that there is a broad range of wares and services associated with the marks located by Ms. Stewart and so the vast majority of the marks are not relevant to the issue at hand.

[27] I do not see any third party marks that are associated with the parties' overlapping wares, i.e. pillows. However, if one considers the other wares applied for by the Applicant (chairs, backpacks, mattresses, adjustable back support and seat cushions), there are the following relevant third party registrations:

1. ERGO-GEL registered by Global Total Office for office furniture

2. ERGO-INDUSTRIAL SEATING SYSTEMS registered by Ergo-Industrial Seating Systems Inc. for furniture
3. ERGO-RITE & Design registered by Degil Safety Products 1989 Inc. for back support belts used to prevent injury for both commercial and non-commercial uses
4. ERGO PLUS registered by Global Total Office for office furniture
5. ERGO REST & Design registered by Ergorest Oy for removable and moveable arm rest for attachment to tables, chairs and furniture
6. ERGO SUPPORT & Design registered by Cascades Canada Inc. for support qui épouse la partie dorsale du corps afin d'offrir une position saine et confortable sur du mobilier urbain, notamment sur des bancs et des chaises
7. ERGOBUDDY & Design registered by Johnson Technologies Corporation for workstations, accessories and components therefore, namely chairs, etc.
8. ERGOBUS registered by Baulter I.D. Inc. for siège ergonomique pour le conducteur de véhicule routier tel que l'autobus et le camion
9. ERGOCENTRIC registered by Ergo-Industrial Seating Systems Inc. for furniture namely chairs, seats and chair back supports
10. ERGOCENTRIC SEATING SYSTEM & Design registered by Ergo-Industrial Seating Systems Inc. for furniture namely chairs, seats and chair back supports
11. ERGOCUSHION registered by Ergotech Protective Devices Inc. for anti-vibration, impact absorbing seat cushions
12. ERGODYNE registered by Ergodyne Corporation for back supports etc.
13. ERGOMED registered by Keiper Recaro GmbH & Co. for vehicle seats
14. ERGOSIZE registered by R.O.I. Ergonomics for office furniture including chairs
15. ERGOSOFT registered by Global Total Office for office furniture
16. ERGOTECH registered by Teknion Furniture Systems for table having adjustable tops

17. ERGOTRON registered by Ergotron, Inc. for computer furniture
18. ERGOWORKS & Design registered by Ergoworks Canada Inc. for chairs, portable back supports, etc.
19. ERGOXTRA registered by Nightingale Corp. for chairs
20. GET ERGO registered by Ergo-Industrial Seating Systems Inc. for furniture, namely chairs and seats chair back supports
21. HERGO & Design registered by Hergo Ergonomic Support Systems, Inc. for furniture and modular mounting and support structures to hold single or multiple computers, monitors, electronic equipment and televisions

[28] Based on the foregoing, I am prepared to accept that Canadian consumers of furniture, in particular chairs, may be used to distinguishing between one ERGO prefix mark and another.

*ii) other ERGO marks owned by the Applicant*

[29] The Applicant has evidenced that it owns registrations for ERGO-HEALTH and ERGO-PAK, but that does not give it the automatic right to obtain any further registrations no matter how closely they may be related to its existing registrations [see *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 572 (T.M.O.B.) at 576].

*Conclusion*

[30] While it is true that small difference may suffice to distinguish weak marks, I find that the Applicant has not met its legal burden with respect to all of the applied-for wares. It is not clear to me that the average Canadian consumer would interpret the Opponent's mark as being a reference to an ergonomically-favourable aspect of its pillows. However, even if the average consumer did make such an inference, I am not satisfied that the Applicant has sufficiently distinguished its Mark from that of the Opponent. After all, the Applicant has taken the Opponent's mark in its entirety and has simply added a descriptive suffix. The Federal Court's comments in *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188, where the opponent/appellant owned the mark MADEMOISELLE and the applicant applied to register MLLE AGE TENDRE, apply well to the present case:



It has appropriated the appellant's mark in its entirety and added thereto as a suffix the words "age tendre". It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction. Here the first and most important word in the mark which the respondent seeks to register is identical to the mark registered by the appellant.

If there is doubt whether the registration of a trade mark would cause confusion with a prior mark the doubt must be resolved against the newcomer. In this instance the result is that the doubt must be resolved in favour of the appellant.

[31] The legal onus is on the Applicant and it has done little to satisfy me that confusion is not likely. The s. 12(1)(d) ground is therefore successful with respect to all of the wares except chairs and backpacks. The ground does not succeed with respect to chairs due to the state of the register evidence. The ground does not succeed with respect to backpacks because of the significant differences between such wares and the Opponent's wares.

#### Disposition

[32] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application with respect to "pillows, mattresses, adjustable back support and seat cushions" and I reject the opposition with respect to the remainder of the wares pursuant to s. 38(8) of the Act [see *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 482 (F.C.T.D.) as authority for a split decision].

---

Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office