



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

Citation: 2013 TMOB 186
Date of Decision: 2013-10-30

**IN THE MATTER OF AN OPPOSITION
by Kerr Controls Limited to application
No. 1,474,585 for the trade-mark SMART
ENERGY in house underlined with text
geothermal-solar-wind systems in the
name of Mike Witherall Mechanical Ltd.**

[1] On March 25, 2010, Mike Witherall Mechanical Ltd. (the Applicant), filed an application for the trade-mark SMART ENERGY in house underlined with text geothermal-solar-wind systems (the Mark), shown below, based upon use of the Mark in Canada since June 12, 2009.



[2] The statement of services currently reads:

Sales, service, installation, maintenance of geothermal heat pumps, photovoltaic cells/panels, wind generators, heat exchangers; design of energy efficient heating plans and cooling plans for households and industry, designing energy conservation plans for households and industry.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 25, 2010.

[4] On May 24, 2011, Kerr Controls Limited (the Opponent), opposed the application on several grounds as set out in the attached Schedule A. 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 some of its grounds of opposition and the remaining grounds turn on the determination of the likelihood of confusion between the Mark and at least one of the following trade-marks of the Opponent:

SMART ENERGY

Registration No.: TMA703,771



Registration No. TMA703,769



Registration No. TMA239,310



Registration No. TMA251,012

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

[6] As its evidence, the Opponent filed the affidavit of Peter Henderson, President of the Opponent. The Applicant filed the affidavits of Michael Weatherall, President of the Applicant Company and Alan Booth, trade-mark searcher. As its evidence in reply, the Opponent filed the affidavit of Steven Wilson, Director of Kerr Controls Limited and Kerr Smart Energy Limited. Cross-examinations were not conducted.

[7] Both the Applicant and the Opponent filed a written argument and both parties were represented at an oral hearing.

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 burden on the Opponent to establish 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; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[9] The material dates that apply to the grounds of opposition are as follows:

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

- Section 38(2)(b)/Section 16 – the Applicant’s date of first use [section 16(1)];
- Section 38(2)(b)/Section 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Preliminary Issue – Admissibility of Wilson Affidavit as Proper Reply Evidence

[10] The Applicant objects to the affidavit of Steven Wilson filed March 14, 2012, on the basis that it is not proper reply evidence. A short summary of part of the evidence filed is necessary to understand this objection.

[11] The Opponent’s evidence in chief comprised the affidavit of Peter Henderson. Attached to Mr. Henderson’s affidavit as Exhibit 20 were invoices showing purchases made by the Applicant of the Opponent’s product. Although the Applicant submits that none of the invoices attached as Exhibit 20 to Mr. Henderson’s affidavit prove that Mr. Witherall attended at the Opponent’s store and picked his products up over the counter, I note that at least several of the invoices, under the heading “Ship Via Description” state “pick up” whereas some others do not state anything. Some of the invoices also state “invoiced from Kerr Sudbury” in the body of the invoice.

[12] Filed as part of the Applicant’s evidence is the affidavit of Michael Witherall. In paragraph 5 of his affidavit, Mr. Witherall states that while he has purchased products from the Opponent, he has not purchased a “SMART ENERGY” brand item. He further states that no product that his company received from the Opponent bore reference to the Opponent’s trademarks listed in the opposition “either on the products themselves or on the packaging in which they were received”.

[13] The Opponent submits that the affidavit of Mr. Wilson is submitted in reply to paragraph 5 of the affidavit of Michael Witherall. Mr. Wilson deposes that on March 5, 2012, he attended the Sudbury, Ontario branch location of the Opponent’s licensee and took photographs of the

exterior, entrance, and reception area of this location. He also attached photographs of the delivery vehicles parked outside this location. All of the photos clearly show the display of one or more of the Opponent's KERR marks on signage at each of these locations.

[14] The Applicant's position is that there is nothing in the Wilson affidavit that responds to the facts outlined in the Applicant's evidence, including paragraph 5 of the Witherall affidavit. In this regard, the Applicant submits that there is nothing in the Witherall affidavit which suggests that he attended the Opponent's store in Sudbury.

[15] Proper reply evidence responds to issues raised in the other side's evidence. Mr. Witherall's affidavit clearly put into play the issue of whether the Applicant had ever purchased a SMART ENERGY brand product from the Opponent. I consider it proper reply to demonstrate that the Opponent's SMART ENERGY and KERR SMART ENERGY and Design marks were clearly displayed at the location where it can be inferred from Mr. Henderson's evidence that Mr. Witherall could have purchased at least some of his products.

[16] The test for whether or not evidence is proper reply evidence is not simply whether the evidence introduced by Mr. Wilson could have been included in the Opponent's evidence in chief. The test is whether the evidence introduced by Mr. Wilson is in reply to the Applicant's evidence and is responsive to unanticipated matters. I find that it is. The affidavit of Mr. Wilson is therefore admissible as proper reply evidence.

Section 30 – Non-conformity

Non-compliance with section 30(i) of the Act

[17] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[18] The Opponent submits that the present circumstances are exceptional because the relationship between the parties is that of between supplier and customer in the same industry (i.e. heating, ventilation and air conditioning (HVAC)). In this regard, the evidence shows that, at the date of filing its trade-mark application, the Applicant had already made several purchases

from the Opponent of products it needed in order to provide its services. Further, the Mark applied for by the Applicant incorporates two main components of the Opponent's marks, namely the words SMART ENERGY and the silhouette of a house design.

[19] Although I am satisfied that the Applicant was aware of the existence of the Opponent's trade-marks when it filed its application, I am of the view that being aware of the Opponent's marks would not necessarily have prevented the Applicant from being satisfied that it was entitled to use the Mark, on the basis that the Applicant did not believe that the marks were confusing. Further, the Applicant's awareness of the Opponent's prior use of its trade-mark does not by itself preclude the Applicant from making the statement required by section 30(i) of the Act [*Woot, Inc v WootRestaruants Inc Les Restaurants Woot Inc* 2012 TMOB 197].

[20] I am therefore dismissing this ground of opposition.

Non-compliance with section 30(b) of the Act

[21] The Opponent also pleads that the application does not comply with section 30(b) of the Act because the Applicant has not used the Mark in Canada in association with services listed in the application since the date alleged, namely, since at least as early as June 12, 2009.

[22] There is an initial evidential burden on the Opponent with respect to the issue of the Applicant's non-compliance with section 30(b). This burden can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at 230]. However, while the Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claims as set forth in its application [see *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), affirmed 11 CPR (4th) 489 (FCTD)].

[23] In this case, the Opponent has relied exclusively upon the Applicant's evidence to meet its initial burden. In this regard, the Opponent has focused on what was missing in the Witherell affidavit to substantiate the Applicant's claimed date of first use as opposed to pointing out

where there may have been inconsistencies in the Applicant's evidence in order to meet its evidential burden under this ground. Had there been a clear discrepancy in the evidence regarding the Applicant's claimed date of first use of June 12, 2009, then the onus would have been on the Applicant to positively support the date it has claimed.

[24] Although it may have been preferable for the Applicant to have provided details pertaining to the use of the Mark in association with the applied for services dating back to June 12, 2009, the fact that it may not have done so does not amount to an inconsistency. Further, while I agree with the Opponent that the photographs of the Mark as it appears on the Applicant's cargo trailer and truck does not by itself show use of the Mark in association with services pursuant to section 4(2), the fact that the Applicant advertises the Mark in this manner does not necessarily mean that the Applicant has not also properly used the Mark in association with the applied for services since the claimed date of first use. I am therefore unable to conclude that the Opponent has met its initial evidential burden.

[25] Accordingly, this ground of opposition is dismissed.

Section 12(1)(d) – Non-registrability

[26] The Opponent further pleads that the Mark is not registrable because it is confusing with its trade-marks set out above. I have exercised my discretion and checked the register to confirm that the Opponent's registration Nos. TMA703,771; TMA703,769; TMA239,310; and TMA251,012 are extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[27] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks.

[28] I will assess the section 12(1)(d) ground of opposition based on confusion between the Mark and the Opponent's SMART ENERGY and KERR SMART ENERGY and Design trade-marks, subject to registration Nos. TMA703,771 and TMA703,769 as I am of the view that the

Opponent's case is strongest with respect to these trade-marks. Both of these registrations are registered for use in association with the following wares:

Oil furnaces, gas furnaces, electric furnaces, wood furnaces, pellet furnaces; Oil boilers, gas boilers, electric boilers, wood boilers, pellet boilers; heat pumps, geothermal heat pumps, heating and cooling controls, hot water heaters.

[29] If there is no likelihood of confusion between the Mark and either of these registrations then there would be no likelihood of confusion with respect to the Opponent's other registrations. As a result, my determination of a likelihood of confusion as between the Mark and these registrations will be determinative of the section 12(1)(d) ground of opposition. As most of the Opponent's evidence of use regards all four of the Opponent's trade-marks, I will refer to "the Opponent's marks" when necessary.

test for confusion

[30] 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. 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 or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them.

[31] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC), the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[32] Neither the Opponent's SMART ENERGY mark nor the Mark possesses a high degree of inherent distinctiveness given their suggestive nature in association with their respective wares and services. The Opponent's KERR SMART ENERGY and Design mark possesses a slightly higher degree of inherent distinctiveness than the Mark because of its more distinctive first component even though Kerr could be perceived as a surname.

[33] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The evidence of the Opponent's affiant, Mr. Henderson, provides the following information:

- the Opponent uses its marks in association with the wholesale sales of heating, ventilation, and air conditioning products to approved distributors in the four Atlantic provinces (Nova Scotia, New Brunswick, Newfoundland and Labrador and Prince Edward Island) and licenses its marks to its affiliate Kerr Smart Energy Limited which uses them in connection with the same business in Ontario;
- gross annual sales of products under the Opponent's marks for the years 2004 to 2011 have been between \$41,459,258 and \$56,948,257;
- representative invoices showing sales of Kerr Products in Canada from November 8, 2005 to September 22, 2011, displaying the Kerr Smart Energy and Design trade-marks in association with a variety of wares including boilers, furnaces and water heaters [Henderson, Exhibit 2];
- the Opponent's marks have been used with Kerr products through packaging, labels and decals; invoices; and specification, warranty and user manual documents which accompany the products [Henderson, Exhibits 2, 3, 4, and 8]; and
- since 2006, wholesale customers of the Opponent have been able to order the Opponent's products online.

[34] The Applicant made numerous general and specific objections to Mr. Henderson's evidence. I have summarized what I find to be the most pertinent of the Applicant's objections as follows:

- 41 of the 87 representative invoices attached as Exhibit 2 to Mr. Henderson's affidavit do not show any of the registered wares used in association with the KERR SMART ENERGY mark and Design mark;
- many of the invoices do not identify any of the Opponent's wares but rather those of third parties;
- the marks displayed on the specification sheets, warranty documents, owners manuals and installation manuals attached as Exhibit 3 do not display all of Opponent's marks;
- the gross annual sales of products under the KERR trade-marks are not restricted to wares covered in the Opponent's registrations.

[35] The Opponent addressed each of these objections as follows.

[36] First, the Opponent submits that even if 41 of the invoices attached as Exhibit 2 to Mr. Henderson's affidavit do not show use of the Opponent's marks in association with its registered wares, there are many that do. Second, the Opponent admits that its evidence shows use of third party marks. The Opponent explains that because it is a wholesaler, some of the products it sells are sold in association with its marks while others are sold in association with third party marks. As for the display of all of the Opponent's marks in Exhibit 3, the Opponent has explained that the KERR SMART ENERGY and Design mark has evolved from its original KERR and Design registrations and the examples of use from 1993 to 2011 reflect this. Finally, the Opponent submits that even if some of the annual sales do not reflect wares sold in association with the Opponent's KERR marks, it can be inferred from its evidence of over \$41 million in sales each year between 2004 and 2011 that the Opponent's marks have become well known in Canada.

[37] I agree with the Applicant that there are some deficiencies in the Opponent's evidence. However, I agree with the Opponent that when its evidence is viewed in its totality, it establishes that the Opponent's marks have become known to a considerable extent in Canada.

[38] With respect to extent known of the Mark, aside from a statement that the Mark has been displayed on a cargo trailer and truck since at least June 2009, there is no other information regarding the extent to which the Mark has become known in Canada.

[39] Based on the foregoing information, I conclude that the Opponent's marks have become known to a greater extent in Canada than the Mark.

section 6(5)(b) - the length of time each trade-mark has been in use

[40] The length of time that each mark has been in use favours the Opponent.

sections 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[41] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd.* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[42] Both parties are in the heating, ventilating, and air conditioning business. There is at least some overlap between the wares of the Opponent and the services of the Applicant. For example, one of the wares associated with the Opponent's marks is "geothermal heat pumps" and the Applicant's services include "sales, service, installation, maintenance of geothermal heat pumps."

[43] With respect to the parties' channels of trade, the Applicant submits that the parties' wares and services are not aimed at the same customers. In this regard, the Applicant submits that since the Opponent promotes itself as a wholesaler of HVAC supplies [Henderson, para. 2 and Exhibit 14], its products are aimed at professional heating and cooling technicians and not the ordinary homeowner.

[44] While I agree with the Applicant that the end user of each party's respective wares and services may be different, the Applicant has not provided any evidence of its channels of trade.

In the absence of evidence to the contrary, in view that both parties are in the HVAC business, I find that their channels of trade could overlap.

section 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[45] In most instances, the dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145, conf. 60 CPR (2d) 70 (FCTD)].

[46] In the present case, the Applicant has adopted the Opponent's registered mark SMART ENERGY in its entirety. While the Mark also includes a house design and some additional words in smaller font at the bottom of the house design, I find all of these additional elements to be non-distinctive. I therefore consider there to be a significant degree of resemblance between the Mark and the Opponent's registration No. 703,771, in appearance, sound and ideas suggested.

[47] I also find there to be a relatively high degree of resemblance between the Opponent's KERR SMART ENERGY and House Design mark and the Mark for similar reasons.

Surrounding circumstances

[48] As a further surrounding circumstance, the Applicant has relied on the Booth and Witherall affidavit to establish that i) the words SMART ENERGY; and 2) a house design are common elements of trade-marks and trade-names in the HVAC industry.

[49] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD)]. 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 [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[50] Mr. Booth searched the Canadian Trade-marks Office records to locate (i) active marks incorporating the words SMART and ENERGY for all wares and services and ii) active trade-marks involving a house design in building, construction and renovation fields with particular regard to HVAC products and services. From the evidence of Mr. Booth, I find that there are about nine active third party registrations for marks that include both the words SMART and ENERGY for wares or services related to those of the parties, and about 41 registrations that incorporate house designs for wares or services related to those of the parties.

[51] Mr. Witherall conducted a Google search of the Internet directed to the words “SMART ENERGY” and found 317,000,000 hits for the words “smart energy”. Attached as Exhibit A to his affidavit pages taken from the following 6 websites: www.smartenergybc.com; www.smartenergyshow.com, www.smartenergycanada.com; www.se-instruments.com; www.smartenergy-canada.com; and www.geosmartenergy.com. As Exhibit B to his affidavit he attaches copies of pages from 23 websites allegedly in the HVAC business that display stylized houses in the promotion of their business.

[52] I have given limited weight to this evidence of Mr. Witherall for the following reasons. First, Mr. Witherall’s Google search results are not helpful as he has not provided a copy of the full results and it is impossible to know if any of the “hits” relate to services being offered in Canada in the field of the Opponent or the Applicant. Further, excerpts from websites constitute hearsay and cannot be relied upon for the truth of their contents. In any event, I can only infer from this evidence that about three of these websites are Canadian. His evidence is therefore far from sufficient to allow me to conclude that there has been a common adoption of the words “smart energy” as a component of trade-marks in the HVAC industry in Canada.

[53] From all of the evidence furnished, I find that the number of registered marks that incorporate house designs with wares or services that overlap with those of the parties is sufficient to conclude that it is common in the marketplace to adopt house designs in the same field as that occupied by the parties. Accordingly, consumers are presumably adept at distinguishing between one such mark and another. This conclusion is further supported by Mr. Witherall’s evidence, deficiencies aside, of at least 10 websites that I can infer from their

contents are Canadian companies which display a house design in the promotion of their HVAC business.

[54] I am not, however, able to make the same inference from the state of the register evidence for marks comprised of the words SMART and ENERGY. The existence of about nine relevant third party registrations allows me to conclude that possibly a couple of third party SMART ENERGY marks are in active use for similar wares and services. In the absence of evidence of actual use of other such marks in the marketplace, however, such evidence is of little value. The Witherall affidavit does little, if anything, to buttress Mr. Booth's findings. I therefore consider the Applicant's evidence insufficient to show that Canadians are used to distinguishing between SMART ENERGY marks for HVAC wares and services and I have concluded that this is not a significant surrounding circumstance in the present case.

conclusion

[55] 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 in association with the Applicant's HVAC services at a time when he or she has no more than an imperfect recollection of the Opponent's SMART ENERGY and KERR SMART ENERGY and House Design marks used in association with HVAC wares, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[56] The Applicant has taken the Opponent's SMART ENERGY mark in its entirety and has applied to use it in association with services that are in the same industry as the Opponent's wares. The Applicant argues that the Opponent's marks are not entitled to a broad scope of protection but I believe that if I were to find that there was no likelihood of confusion in the present case, then I would be applying an overly narrow scope of protection. In view of the Opponent's lengthy use of its almost identical marks for wares in the same industry as the services of the Applicant, I conclude that a consumer who has an imperfect recollection of either the Opponent's marks may reasonably infer that the Applicant's SMART ENERGY and House Design mark for HVAC services shares the same source as the Opponent's SMART ENERGY marks for HVAC wares.

[57] The section 12(1)(d) ground of opposition therefore succeeds.

Remaining Grounds of Opposition

[58] The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's marks. The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's filing date and the date of opposition. I am satisfied from the evidence furnished that the Opponent has met its evidentiary burden under both of these grounds of opposition.

[59] In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are likely to be confused applies to these grounds of opposition which also succeed.

Disposition

[60] In view of the above and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The grounds of opposition are as follows:

a. The Application does not conform to the requirements of Section 30 of the Trade-marks Act, R.S.C. 1985 c. T-13 (the "Trade-marks Act") specifically:

- i. contrary to Section 38(2)(a) and 30(b) of the Trade-marks Act, at the date of filing of the application, the Applicant had not used the trade-mark as alleged or had subsequently abandoned the trade-mark; and
- ii. contrary to Sections 38(2)(a) and 30(i) of the Trade-marks Act, at the date of filing of the Application, the statement by the Applicant with respect to its entitlement to use the trade-mark in Canada was not accurate because the Applicant had knowledge of the Opponent and the Opponent's trade-marks.

b. The trade-mark applied for is not registrable for the following reasons:

- i. in view of Sections 38(2)(b) and 12(1)(d) of the Trade-marks Act, it is confusing with one or more of the following registered trade-marks owned by the Opponent:
 - (a) SMART ENERGY, TMA 703,771;
 - (b) KERR SMART ENERGY & Design, TMA 703,769;
 - (c) KERR & Design, TMA 239,310;
 - (d) KERR & Design, TMA 251,012;
- ii. in view of Sections 38(2)(b) and 12(2) of the Trade-marks Act, the trade-mark applied for is not registrable by reason of Section 12(1)(d) of the Trade-marks Act, and has not been so-used in Canada by the Applicant as to have become distinctive at the date of the filing of the Application.

c. The Applicant is not the person entitled to registration of the trade-mark:

- i. having regard to the provisions of Sections 38(2)(c) and 16(1)(a) of the Trade-marks Act, the trade-mark was confusing with a trade-mark that had been used previously in Canada or made known in Canada by the Opponent as follows:

SMART ENERGY



- d. The trade-mark applied for is not distinctive for the following reasons having regard to the provisions of Sections 38(2)(d) and 2 of the Trade-marks Act, (the definition of "distinctive"), because it does not actually distinguish, nor is it adapted to distinguish the Applicant's wares and services from the wares and services of others, particularly those of the Opponent under the registered trade-marks listed in 1 (b) above and in connection with the trade-marks listed in 1 (c) above, nor is it adapted, nor can it be adapted, to so-distinguish them.