

**IN THE MATTER OF AN OPPOSITION
by Primo Bedding Company, Inc. to
application No. 1012699 for the trade-mark
PRIMO filed by HSM Pressen GmbH + Co.
KG**

On April 21, 1999, HSM Pressen GmbH + Co. KG (the “Applicant”) filed an application for the registration of the trade-mark PRIMO (the “Mark”) claiming priority to German application No. 398 64 226.5 filed November 6, 1998, and based on proposed use of the Mark in Canada in association with the following wares: “(1) Shredding machines; cutting mechanisms and stands for shredding machines as well as combinations of shredding machines and baling presses; microfilm shredding machines; presses for the production of bales of waste materials, in particular fully automatic baling presses with electro-hydraulic drive systems; parts of shredding machines and baling presses, in particular waste paper baskets forming parts of shredding machines” (the “Wares”).

The application was advertised for opposition purposes in the Trade-marks Journal issue of June 14, 2000.

On July 4, 2000, Primo Bedding Company, Inc. (the “Opponent”) filed a statement of opposition against the application. The grounds of opposition can be summarized as follows:

1. The application does not comply with s. 30 of the *Trade-marks Act* (R.S.C. 1985, c. T-13, as amended) (the “Act”) in that on April 21, 1999, the date on which the application was filed, the Applicant knew or should have known that it was not entitled to use the Mark because the Applicant knew or should have known that the Mark was confusing with or was likely to be confusing with the trade-names of the Opponent and with the family of PRIMO trade-marks made up of the marks PRIMO, PRIMO BEDDING, PRIMO INTERNATIONAL, CLUB PRIMO PLUS, PRIMOTION, PRIMO LEATHER previously used and made known in Canada by the Opponent (I am attaching hereto to my decision, as Schedule A, the details of the Canadian registration certificates obtained

for these marks);

2. The second ground of opposition, in support of which the Opponent is relying on s. 38(2)(a) of the Act, is that the Mark is not a trade-mark as defined in s. 2 of the Act as it cannot be used for the purpose of distinguishing or so as to distinguish the Wares of the Applicant from the wares of the Opponent;
3. The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the Opponent's aforementioned family of registered PRIMO trade-marks, which have been used and made known in Canada by the Opponent prior to April 21, 1999;
4. The Applicant is not the person entitled to registration of the Mark in that as of the date of filing of the application, the Mark was confusing with the aforementioned family of PRIMO trade-marks of the Opponent, all of which had been used and made known in Canada prior to April 21, 1999, and which trade-marks have not been abandoned by the Opponent and continue to be used in Canada by the Opponent; and
5. The Mark is not distinctive of the Applicant pursuant to s. 38(2) of the Act in that the Mark neither distinguishes nor is adapted to distinguish the Wares of the Applicant from the wares provided in Canada by the Opponent under its trade-names and in association with its aforementioned trade-marks.

By counter statement dated November 22, 2000, the Applicant denied each and every one of the allegations made in the statement of opposition.

In support of its opposition, the Opponent filed the affidavit of George Itzkovitz, sworn December 15, 2000. In support of its application, the Applicant filed the affidavits of Irene Schwelling, sworn June 29, 2005, Shirley Ann Farley, sworn June 27, 2005, and Jane Buckingham, sworn June 28, 2005.

Each party filed a written argument. While only the Applicant's agent timely requested an oral hearing and timely confirmed her attendance at the said hearing, the Opponent's agent presented herself at the oral hearing after arriving half an hour late. More particularly, the Opponent's agent, relying on s. 47(2) of the Act, and alleging the right to be heard, requested, verbally, a retroactive extension of time to request an oral hearing and participate in the hearing. The

Applicant's agent objected to the Opponent's agent's request. After having heard the submissions of both parties, I decided to refuse the Opponent's agent's request. While the reasons for my refusal were provided verbally to the parties, I indicated that such reasons would also be included in my decision below, so that the Opponent could seek judicial review if it so wishes.

Rules 46(3) and (4) of the *Trade-marks Regulations* (the "Regulations") provide that:

"(3) Written arguments, if any, shall be filed in duplicate and, after the written arguments of both parties have been filed or the period for filing written arguments has expired, the Registrar shall forward

(...)

(b) a notice to each party that a hearing may be requested.

(4) A party wishing to be heard by the Registrar shall give the Registrar written notice within one month after the date of the Registrar's notice referred to in paragraph 3(b) and, on receipt of a notice from the party, the Registrar shall send the parties a written notice setting out the time, date and location of the hearing".

As indicated above, only the Applicant did comply with Rule 46(4) of the Regulations; the Opponent elected not to respond to the Registrar's notice referred to in paragraph 3(b). Moreover, after the Registrar sent the parties the written notice setting out the time, date and location of the hearing, only the Applicant did confirm its attendance at the hearing; the Opponent elected, again, not to respond to the Registrar's notice.

Not only has the Opponent elected to ignore the Registrar's notices and did not abide by the rules, it has also failed to set forth *any* facts to justify the conclusion that the failure to request an oral hearing within the prescribed time was not reasonably avoidable. It is noteworthy that the Opponent's agent's sole submission made in this regard was that the Applicant would not suffer any prejudice, as her verbal representations would simply recap the contentions put forward in the Opponent's written argument. Such submission falls short of being convincing, not to mention the fact that the Applicant's agent would have needed to go over again her representations made during the first thirty (30) minutes of the hearing. The right to be heard does not by itself extend so far as to allow the Opponent's agent to make representations under

these circumstances.

Summary of the parties' evidence

Opponent's evidence

Affidavit of George Itzkovitz

Mr. Itzkovitz states that he is an officer and director of the Opponent. He states that the Opponent has been in the business, since at least 1967, of making, selling and distributing furniture and furnishings for homes, industry and offices.

Mr. Itzkovitz attaches to his affidavit photocopies of the trade-mark registration certificates obtained for each of the Opponent's aforementioned family of PRIMO trade-marks, except for the PRIMOTION trade-mark that has been passed over in silence. He also attaches photocopies of three other trade-mark registration certificates for the PRIMO, PRIMO INTERNATIONAL and PRIMO BEDDING trade-marks registered under Nos. 503,312, 502,142 and 502,141 in association with services described as "Business of manufacturing, importing, selling and distributing of furniture, namely beds, bunk beds, cribs, mattresses, bed frames, box springs, sofas, sofa beds, futons, chairs, ottomans, stools, tables, end tables, coffee tables, loveseats, buffets, hutches, lamps, mirrors, dressers, bureaus, chests, dinettes and armoires". As stressed by the Applicant, these latter three registrations have not been pleaded in the statement of opposition. Accordingly, I shall not consider them as part of the opposition [see *Imperial Development Ltd. v. Imperial Oil Ltd.* (1984), 79 C.P.R. (2d) 12 (F.C.)]. Mr. Itzkovitz states that the Opponent continues to use each and all of these marks and that the Opponent has no intention of abandoning any of them.

Mr. Itzkovitz attaches to his affidavit an undated catalogue, which he states shows "some of the wares of the Opponent that it has been making, selling and distributing in Canada, prior to and since 1998 in association with the PRIMO trade-marks and PRIMO trade-name". The catalogue displays sofas, loveseats, chairs, cocktail tables, sofa beds, dining room tables and chairs, kitchen tables and chairs, wine racks, buffets, hutches, breakfast stools and bars, kitchen islands, futons,

rocking chairs, beds, daybeds, bunkbeds and cots. Except for a small logo made of the word PRIMO in conjunction with design elements, displayed at the lower left-hand corner of the first page of the catalogue, the Opponent's evidence discloses that it has not used the PRIMO mark on its own, but rather, in association with INTERNATIONAL in which the "international" element is emblazoned over the "primo" element. The mere mention of a trade-mark on the cover page of a catalogue does not constitute use of that mark in association with wares [see *Bereskin & Parr v. Hamac International Ltd.* (1999), 3 C.P.R. (4th) (T.M.O.B.)]. Furthermore, to the extent "PRIMO INTERNATIONAL" appears in this specimen, I am not convinced that it would be perceived as a trade-mark as opposed to identifying the originator for the wares.

Indeed, while the PRIMO INTERNATIONAL logo appears practically on every single page of the catalogue, it is most of the time followed by either the mention "Makers of Quality Mattresses and Furniture" or the address and telephone and fax numbers of the Opponent. Only numeric or alphanumeric codes accompanied by descriptions appear beside or under the products illustrated (except in exceptional cases where a model name is provided instead of a numeric or alphanumeric code).

As for the invoices attached to Mr. Itzkovitz's affidavit, they only contain descriptions of the products, all preceded by codes. No description is followed by a trade-mark. The PRIMO INTERNATIONAL logo is, again, followed by the address of the Opponent, although it also appears as a watermark. The earliest invoice is dated May 12, 1995. The invoices are for chairs, loveseats, sofas, mattresses, futons, futon frames, bunkbeds, kitchen tables, butcher blocks, rocking chairs and sofa beds.

That said, given that "PRIMO INTERNATIONAL" appears as a watermark on the invoices and the fact that the delivery address and date shown on the invoices are, in most cases, the same as the invoice address and date, I am prepared to accept that the foregoing materials show an association between the trade-mark PRIMO INTERNATIONAL and the wares when ownership is transferred [see *Literie Primo Inc./Primo Bedding Co. v. Albums DF Ltée/DF Albums Ltd* (2005) CarswellNat 1312 (T.M.O.B.)].

Mr. Itzkovitz continues his affidavit by stating that for many years prior to 1998, the Opponent has been known as, and is often commonly referred to by customers and distributors as PRIMO, and this trade-name of the Opponent was used in Canada for decades prior to November 1998. These statements of Mr. Itzkovitz are not supported by evidence.

Mr. Itzkovitz states that many of the customers of the Opponent, including those referred to in the invoices mentioned above, sell wares that are used in, or that can be used in various locations and premises, including offices, industrial areas or other places where the Wares of the Applicant could be, or are likely to be, used. Mr. Itzkovitz further states that while the primary emphasis of the Opponent's business has not necessarily been wares intended for industrial plants, although many of the Opponent's wares are in fact found and used in such plants, it is a normal evolution of the business of the Opponent for it to concentrate a greater extent on the manufacture and distribution of wares intended for industrial plants, and in fact the Opponent has for some time been considering and planning for this. I will revert to these statements of Mr. Itzkovitz later on in my decision when considering the type of wares and the nature of the trade of the parties to be taken into account under the test for confusion.

In the same vein, Mr. Itzkovitz states that the Applicant would not be entitled to obtain registration of its pretended PRIMO Mark because it knew, or should have known, that the Opponent had used its PRIMO trade-mark and its PRIMO trade-name in Canada for more than twenty-five (25) years prior to November 1998 in association with wares that are found and used in the same type of premises and locations where the Applicant's Wares are likely to be found and used, and/or in association with wares that travel through, or are entitled to trade through, channels of trade identical to the channels of trade as those through which the Wares of the Applicant are likely to, or may, travel. I will revert to these statements of Mr. Itzkovitz later on in my decision when considering the s. 30 ground of opposition as well as the type of wares and the nature of the trade of the parties to be taken into account under the test for confusion.

Applicant's evidence

Affidavit of Irene Schwelling

Ms. Schwelling identifies herself as a Director Sales & Marketing with the Applicant. She states that the Applicant is a German company doing business worldwide in the field of shredding machines and baling presses. The Applicant was founded in 1971 as a one-man business but has grown into a multinational corporation and is one of the largest manufacturers of shredders in Europe and America.

Ms. Schwelling states that the Applicant has been promoting its products in Canada in association with the PRIMO mark since at least as early as 2001 and she attaches to her affidavit a copy of a sample invoice dated July 12, 2001 regarding a paper shredder associated with the Applicant's Mark which was delivered to PAYstation Inc. in Ontario for testing and evaluating purposes. Ms. Schwelling further states that sales of the Applicant's Wares in association with the PRIMO mark in Canada began at least as early as August 2004. In 2004, the Canadian sales of PRIMO products were in excess of \$155 000.

Ms. Schwelling states that the Applicant's PRIMO products are manufactured in Germany by the Applicant and distributed in North America exclusively by the Applicant's U.S. subsidiary, HSM of America, and she attaches to her affidavit copies of pages from HSM of America's website relating to the Applicant's PRIMO products.

Ms. Schwelling also attaches to her affidavit copies of the operating instructions from 1999 for one of the Applicant's shredders associated with the PRIMO mark.

Ms. Schwelling further attaches to her affidavit copies of printouts from the United States Patent & Trademark Office (the "USPTO") Trademark Electronic Search System for U.S. registration Nos. 2,454,534 (PRIMO for use in association with a number of wares including shredding machines and baling presses – registered on May 29, 2001 under the name of the Applicant) and 2,266,259 (PRIMO for use in association with adult furniture, namely mattresses, futons, sofa beds, chairs, tables, buffets, hutches, gliders and beds – registered on August 3, 1999 under the

name of the Opponent). Ms. Schwelling concludes her affidavit by stating that she is unaware of any instances of persons in the United States confusing the source of the Applicant's shredders and baling wares with the Opponent or vice versa. I will revert to these latter statements of Ms. Schwelling later on in my decision when considering the additional surrounding circumstances to be taken into account under the test for confusion.

Affidavit of Shirley Ann Farley

Ms. Farley identifies herself as an articling student with the Applicant's agent firm.

Ms. Farley states that she conducted Internet searches for "primo" related trade-marks. Her search query with Google.ca yielded approximately 304,000 results and her search with Yahoo.ca yielded approximately 305,000 results. She attaches to her affidavit copies of various websites for companies and products which use "primo" in association with a variety of products and services. I will revert to these websites later on in my decision when considering the additional surrounding circumstances to be taken into account under the test for confusion.

Affidavit of Jane Buckingham

Ms. Buckingham identifies herself as a trade-mark searcher employed by the Applicant's agent firm.

Ms. Buckingham states that she conducted a search of the CDNameSearch database for all active trade-mark applications and registrations containing the element "primo" without restrictions to any particular wares or services. The results of her search are summarized at paragraph 4 of her affidavit. I will revert to these results later on in my decision when considering the additional surrounding circumstances to be taken into account under the test for confusion.

Onus

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 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 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Grounds of opposition

I will now analyze the grounds of opposition in regard to the evidence filed in the record, without necessarily respecting the order in which they were raised in the statement of opposition.

Section 12(1)(d) ground of opposition

As indicated above, the Opponent has provided through the Itzkovitz affidavit, photocopies of the trade-mark registration certificates obtained for each of the Opponent's aforementioned family of PRIMO trade-marks, except for the PRIMOTION trade-mark. I have exercised my discretion to review the Register and confirm the details of the registrations referred to in the Opponent's statement of opposition. As they are in good standing, the Opponent's initial burden with respect to this ground of opposition has been satisfied.

Because of this evidence by the Opponent, the Applicant must establish on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's marks.

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 listed at 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 the

trade-marks have 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. This list is not exhaustive and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

As I am of the opinion that the Opponent's strongest case respecting this ground of opposition is in relation to its PRIMO mark (No. 411,602), I will focus my discussion on that one mark of the Opponent unless indicated otherwise. A determination of the issue of confusion between the PRIMO mark and the Mark will effectively decide the outcome of the ground of opposition.

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

The Applicant's Mark and the Opponent's mark are identical; they both consist of the dictionary word PRIMO, which suggests the idea of being first or of premier quality. By reason of their laudatory character, I consider both marks as equally weak marks. The same comment applies to the other trade-marks of the Opponent comprised in its family of PRIMO trade-marks given the low distinctiveness of the elements "INTERNATIONAL", "BEDDING", "LEATHER", "CLUB" and "PLUS" in the context of the Opponent's wares.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

As stressed by the Applicant, the Opponent has provided no evidence concerning the marking and labelling of its wares and the extent of its sales in Canada. The Opponent has similarly provided no evidence concerning its promotional activities, information concerning the distribution of the catalogue that it has produced, the type of advertising, or the amounts spent by the Opponent in advertising its PRIMO trade-mark.

Except for the PRIMO INTERNATIONAL trade-mark, the foregoing evidence does not allow me to conclude that any of the Opponent's PRIMO trade-marks has been used and much the less become known to any extent in Canada. As for the PRIMO INTERNATIONAL trade-mark, it is difficult for me to determine the extent to which this mark has become known in Canada given the lacunas in the Opponent's evidence. In the absence of any information concerning the volume or value of the Opponent's sales, I can assume no more than a minimal reputation for the PRIMO INTERNATIONAL trade-mark.

Turning to the Applicant's use and promotion of the Mark in Canada, I am satisfied that the Schwelling affidavit establishes that the Applicant has been advertising the Mark in association with shredding machines since at least as early as 2001 and has been selling its products in association with the Mark since at least as early as August 2004. While the Applicant's evidence of promotion of the Mark does not provide conclusive evidence as to the extent of its promotional activities, the type of advertising, or the amounts spent by the Applicant in advertising the Mark, the sales figures provided for the first six (6) months of use of the Mark in Canada do corroborate to some extent Ms. Schwelling's statement that the Applicant has become one of the largest manufacturers of shredders in Europe and America, and do allow me to conclude that the Mark has become known to some extent in Canada.

To conclude, the overall consideration of this first factor tends to favour the Applicant.

(b) the length of time the trade-marks have been in use

The Opponent's PRIMO trade-mark registrations claim use in Canada for various home furnishing wares since 1967, 1991, 1992, 1996 and 1997. However, as stressed by the Applicant, the evidence of the Opponent comprises "randomly selected invoices" which, at best show sales by "PRIMO INTERNATIONAL" from 1995 and the catalogue produced by the Opponent is said to show wares that it has been making, selling, and distributing in Canada "prior to and since 1998".

In the absence of supporting evidence of use, the dates of first use claimed in the Opponent's registrations can establish no more than "de minimis" use and cannot give rise to an inference of significant or continuing use of the marks.

That said, given the evidence in the record, the overall consideration of this second factor, while not significant, favours the Opponent.

(c) the nature of the wares, services or business; and (d) the nature of the trade

Considering the type of wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the registrations referred to by the Opponent [see *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.)].

The Opponent's registrations cover furniture wares (and "bicycles" – it is noteworthy that the Opponent's evidence does not address in any way these wares that are, in any event, totally distinct and unrelated to the Wares) whereas the Applicant's application covers shredding machine and baling press wares. The Applicant contends that the parties' wares and channels of trade are totally unrelated and that they are overwhelming factors in favour of the Applicant in this proceeding. The Opponent contends for its part that it is clear that there exist substantial similarities between the Opponent's furniture and furnishings, which the Opponent contends are destined for the home, industry and office, and the Wares of the Applicant, which the Opponent contends consist of instruments and furniture to be used in the home, industry and in the office.

The Applicant has not provided much information as to its channels of trade and clientele. The only evidence provided in this regard consists in the following material attached to the Schwelling affidavit:

- a sample invoice regarding a paper shredder delivered to a corporation named PAYstation Inc. in Ontario for testing and evaluating purposes;

- copies of the operating instructions from 1999 for one of the Applicant’s shredders containing, amongst others, the following instructions:
 - “The shredder is especially suitable for shredding smaller quantities of paper at the workplace or at home (...)
 - Caution! Keep paper shredder out of reach of children (...)
 - This shredder should be operated only with an operator in attendance.”
- copies of pages from the Applicant’s U.S. subsidiary’s website relating to the Applicant’s products and displaying, amongst others, medium capacity PRIMO shredders “ideal for home office use and deskside personal shredding where discretion is a priority” and high capacity PRIMO shredders of the “office series” suitable for large offices.

In view of the above, I agree with the Opponent’s contention made in its written argument that it is fair to assume that the Applicant’s Wares are destined for wholesale and retail consumers of office furniture and equipment.

By comparison, a fair reading of the Opponent’s evidence establishes that the Opponent’s wares are destined for wholesale and retail consumers of home furnishings. While Mr. Itzkovitz has stated in his affidavit that many of its customers sell wares that are used in, or that can be used in, offices, industrial areas and other places where the Applicant’s Wares could be or are likely to be used, the Opponent’s only evidence concerning its sales are a catalogue displaying home furnishings such as bedroom, kitchen, dining and living room furniture, and invoices from various furniture stores that include Leon’s, Orleans City Mattress, and the Brick.

While a potential overlap between the parties’ channels of trade can arguably be found in that the wares described as “office chairs”, “office desks” and “steno chairs” in the Opponent’s trademark registrations and the Applicant’s Wares could be sold through the same kind of outlets specialized in the sale of office furniture and equipment, it is unlikely that they would be sold side by side given their totally disparate nature, which is emphasised by the specialized and technical nature of the Applicant’s Wares. Furthermore, the primary emphasis of the Opponent’s business on home furnishings as evidenced above and further admitted by Mr. Itzkovitz in his affidavit, renders the connection between the two parties’ fields of interest and their channels of

trade tenuous, to say the least.

In concluding on these third and fourth factors, I am not prepared to accord significant weight to Mr. Iztkowitz's statement that it is a normal evolution of the business of the Opponent for it to concentrate a greater extent on the manufacture and distribution of wares intended for industrial plants, as it constitutes a mere assertion of expansion that is insufficient by itself to support the conclusion that the parties' wares and channels of trade are similar.

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

As the trade-marks at issue are identical, this factor favours the Opponent.

Additional surrounding circumstances

State of the register

As an additional surrounding circumstance, the Applicant contends in its written argument that the Opponent cannot claim exclusivity in PRIMO given that the Opponent's evidence (at paragraph 4 of the Buckingham affidavit) discloses that there are approximately thirty (30) different owners of marks on the trade-marks Register which contain the PRIMO element, and eight (8) different owners of marks which consist of only the element PRIMO often without additional design elements. The Opponent contends in its written argument that this evidence is not pertinent given the "extreme dissimilarity in appearance and/or wares and services".

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 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

I agree with the Opponent that the various trade-mark registrations and/or applications revealed by Ms. Buckingham's search pertain to dissimilar wares and/or services, and as such may not be found that pertinent. That said, I nevertheless find that they support to some extent my comment made above on the inherently low distinctiveness of laudatory marks.

Websites maintained by third parties

The Applicant contends in its written argument that the Farley affidavit further supports the Applicant's contention that the PRIMO element is common in the marketplace. The Opponent contends for its part, that the Farley affidavit simply alleges a series of Internet sites maintained by legal persons using a name including the word PRIMO operating in fields that are completely foreign to the business of the Opponent.

Ms. Farley was able to locate a dozen of potentially relevant websites in reference to Canadian businesses or products in Canada that use the trade-mark or trade-name PRIMO alone or in combination with other elements. However, the pages produced from those sites cannot be used to prove the truth of their contents. Ms. Farley did not provide any evidence that the names located have been used in Canada, nor did she evidence any Canadian visitors to these sites. Accordingly, I am not prepared to accord significant weight to this evidence of the Applicant.

Coexistence of the parties' marks

As indicated above, the Applicant contends that the respective marks of the Applicant and the Opponent have been coexisting on the USPTO register and in the marketplace in the United States since at least as early as May 2001 without any instances of actual confusion. While I appreciate the reasons for Ms. Schwelling's statements, it is to be reminded that the Registrar is not bound by the findings made by the USPTO because although a mark can be registrable in the United States, it may not be registrable in Canada having regard to the applicable legislation and circumstances of the case [see *Quantum Instruments Inc. v. Elinca S.A.* (1995), 60 C.P.R. (3d) 264]. Furthermore, as no evidence of use of the parties' marks in the marketplace in the United States has been adduced in the instant proceeding, I am not prepared to consider such fact as a relevant circumstance in the determination of the likelihood of confusion between the Mark and the Opponent's PRIMO mark.

The Applicant has contended in its written argument that, additionally, in Canada, the Opponent has submitted no evidence of actual confusion as between the Opponent's marks and the Applicant's mark despite "the number of years that the marks have coexisted in the marketplace". As Ms. Schwelling's affidavit was executed on June 29, 2005, that is less than a year after use of the Mark has commenced in Canada, I do not find that circumstance to be particularly persuasive (not to mention that there is also no evidence that the trade-marks have coexisted in the same parts of Canada).

Family of trade-marks

While the Opponent has alleged that it is the owner of a family of trade-marks which incorporates the word PRIMO, the evidence in the record does not allow me to conclude that the Opponent owns such a family of marks. Indeed, except for the PRIMO INTERNATIONAL trade-mark, no evidence of use of any of these marks has been adduced by the Opponent. Accordingly, I am not prepared to consider such fact as a relevant circumstance in the determination of the likelihood of confusion between the Mark and the Opponent's marks [see *Techniquip Ltd. c. C.O.A.* (1998), 3 C.P.R. (4th) 298 (F.C.A.)].

Conclusion re likelihood of confusion

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 differences existing between the parties' wares and channels of trade and the low distinctiveness of the Opponent's PRIMO trade-marks, I find that the Applicant has shown, on a balance of probabilities, that the average consumer having an imperfect recollection of the Opponent's PRIMO marks would not likely be confused as to the source of the Wares upon seeing the Mark. Accordingly, the s. 12(1)(d) ground of opposition is unsuccessful.

Non-entitlement and non-distinctiveness grounds of opposition

The fourth and fifth grounds of opposition turn on the issue of confusion as of the date of filing of the application (which in the present case is the priority date of November 6, 1998) and as of

the date of filing the opposition. With respect to the non-entitlement ground of opposition, I note that the Opponent did not refer to the priority date as the pertinent date in its statement of opposition. However, Mr. Itzkovitz has made reference to the priority date in his affidavit and so has the Applicant in its written argument.

The s. 16 ground of opposition is unsuccessful as, except for the PRIMO INTERNATIONAL trade-mark discussed below, the Opponent failed to evidence use of its allegedly confusing PRIMO trade-marks prior to the Applicant's filing date and non-abandonment of these marks as of the Applicant's advertisement date. As for the PRIMO INTERNATIONAL trade-mark, while the Opponent may have discharged its initial burden, the outcome remains the same given my conclusions above in respect of the s. 12(1)(d) ground of opposition.

The non-distinctiveness ground of opposition is also unsuccessful. As for the part of this ground relying on the Opponent's PRIMO trade-marks, the Opponent failed to discharge the initial burden upon it to establish that the said trade-marks had become sufficiently known in Canada at the date of the statement of opposition that they negated the distinctiveness of the Mark [see *Motel 6, Inc. v. No.6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.)]. As for the part of the non-distinctiveness ground relying on the Opponent's trade-names, the Opponent failed to identify the trade-names being relied upon. Furthermore, while Mr. Itzkovitz states in his affidavit that for many years prior to 1998, the Opponent has been known as, and is often commonly referred to by customers and distributors as, PRIMO, and this trade-name of the Opponent was used in Canada for decades prior to November 1998, these statements of Mr. Itzkovitz are not supported by evidence. The Opponent's evidence only establishes use of the trade-name PRIMO INTERNATIONAL, the distinctiveness of which is difficult to qualify given the lacunas in the Opponent's evidence discussed above. In any event, for the most part, my conclusions in respect of the s. 12(1)(d) ground of opposition also apply to the non-distinctiveness ground. As I have found the Applicant's Mark not confusing with the Opponent's PRIMO trade-marks, the non-distinctiveness ground based on the Opponent's trade-names is also unsuccessful.

Section 30 ground of opposition

The s. 30 ground of opposition is also unsuccessful. The mere fact that the Applicant may have been aware of the Opponent's alleged prior rights as of the filing date of its application is not inconsistent with the statement that the Applicant was satisfied that it was entitled to use the applied-for trade-mark on the basis that it considered its trade-mark to not be confusing with the Opponent's trade-marks and trade-names. Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. There is no such evidence in the present case.

Second ground of opposition

The Opponent pleads that the Mark is not a trade-mark as defined in s. 2 of the Act as it cannot be used for the purpose of distinguishing or so as to distinguish the Wares of the Applicant from the wares of the Opponent. As stressed by the Applicant, this ground of opposition, as pleaded, has no legal basis under s. 38(2)(a) of the Act and is, accordingly, rejected.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition, the whole pursuant to s. 38(8).

DATED AT Montréal, Québec, THIS 16 DAY OF February 2009.

Annie Robitaille
Member
Trade-marks Opposition Board

SCHEDULE "A"

- PRIMO, registered under No. 411,602, used in Canada since at least October 1967 in association with "Furniture, namely, beds, mattresses, chairs, tables, sofas, recliners, sofa-beds, desks, cupboards, box springs, office chairs, office desks, steno chairs and bicycles"
- PRIMO BEDDING, registered under No. 400,641, used in Canada in association with "(1) Beds, mattresses, box springs. (2) Chairs, tables, sofas, recliners, sofa beds, desks, cupboards, office chairs, office desks, steno chairs. (3) Bicycles." Used in CANADA since at least January 1967 on wares (1). Used in CANADA since at least January 1988 on wares (2). Used in CANADA since January 1991 on wares (3)
- PRIMO INTERNATIONAL, registered under No. 403,312, used in Canada since at least January 1991 in association with "Furniture namely: beds, mattresses, chairs, tables, sofas, recliners, sofa-beds, desks, cupboards, box springs, office chairs, office desks, steno chairs and bicycles"
- CLUB PRIMO PLUS, registered under No. 442,453, used in Canada since at least 1992 in association with "Service of offering gifts and incentives to customers who buy furniture and furnishings"
- PRIMOTION, registered under No. 468,510, used in Canada since at least October 1996 in association with "Glider rockers, beds, mattresses, box springs, sofa beds, mattress foundations, chairs, sofas, tables, recliners, bar stools, cribs, cradles, bassinets, loveseats, foot rests, cupboards, dressers, desks, wall units rocking chairs, office chairs, steno chairs and office desks".
- PRIMO LEATHER, registered under No. 481,118, used in Canada since at least July 1997 in association with "Leather furniture, namely leather chairs, leather upholstered chairs, leather club-chairs, leather recliners, leather sofas, leather chesterfields, leather couches, leather settees, leather love-seats, leather stools, leather futons, leather hassocks, leather foot-rests and tables and desks with leather tops"