



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

**Citation: 2011 TMOB 20**  
**Date of Decision: 2011-02-03**

**IN THE MATTER OF AN OPPOSITION  
by City Electrical Factors Limited to  
application No. 1,322,649 for the trade-  
mark CEF SERIES in the name of TDK  
Corporation**

[1] On November 2, 2006, TDK Corporation (the Applicant) filed an application to register the trade-mark CEF SERIES (the Mark) for electric capacitors; capacitors; ceramic capacitors; multilayer ceramic capacitors based upon proposed use of the Mark in Canada.

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

[3] On October 16, 2007, City Electrical Factors Limited (the Opponent) filed a statement of opposition, which pleaded grounds of opposition pursuant to s. 38(2)(a)/30(i), 38(2)(c)/16(3), and 38(2)(d)/2 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

[4] The Applicant filed and served a counter statement, which included a denial of the Opponent's allegations.

[5] In support of its opposition, the Opponent filed an affidavit of Shannon Young (a trade-mark agent employed by the Opponent's agents) and certified copies of Canadian trade-mark applications Nos. 1,260,086 and 1,260,087.

[6] In support of its application, the Applicant filed an affidavit of Carla Edwards (a secretary employed by the Applicant's agents).

[7] No cross-examinations were conducted.

[8] Both parties filed a written argument. 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(i) - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 38(2)(c)/16(3) - the filing date of the application;
- s. 38(2)(d)/2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

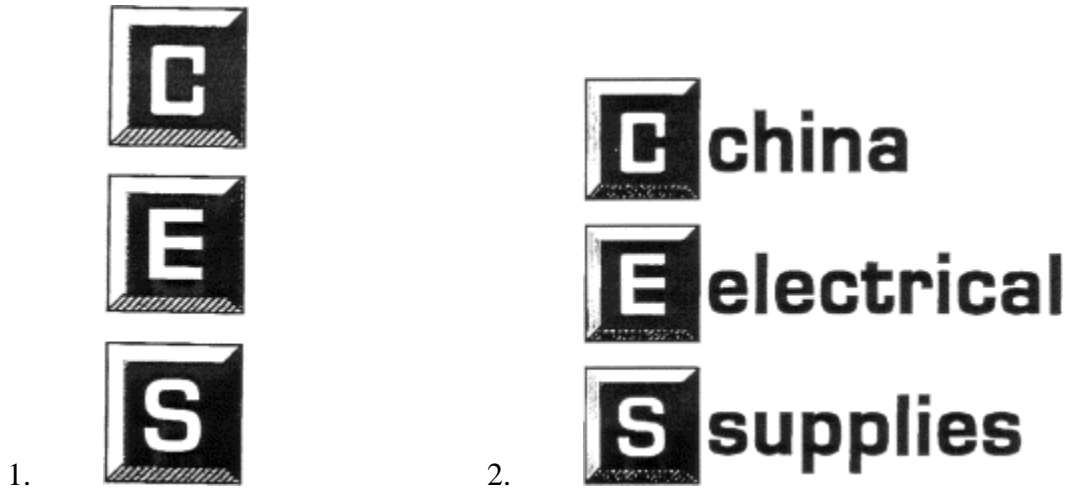
#### Section 16(3) Grounds of Opposition

[11] Pursuant to s. 16(3)(c), the Opponent has pleaded that the Applicant is not the person entitled to register the Mark because the Mark is confusing with the Opponent's trade-name City Electrical Factors Limited. As no evidence has been provided showing use of that trade-name prior to November 2, 2006, the s. 16(3)(c) ground is dismissed on the basis that the Opponent has not met its initial burden.

[12] Pursuant to s. 16(3)(b), the Opponent has pleaded that the Applicant is not the person entitled to register the Mark because the Mark is confusing with two trade-marks, which are the subject of applications previously filed by the Opponent:

1. CES & Design, which is the subject of application No.1,260,086, and
2. CES CHINA ELECTRICAL SUPPLIES & Design, which is the subject of application No. 1,260,087.

[13] The Opponent's marks are shown below:



[14] Both of the Opponent's applications are based upon proposed use of the mark in association with the following wares:

ducting; trunking, cable trunking systems, cavity trunking, cable trays, ladder rack, steel framework systems, boxes; ducting, trunking and conduits of metal for pipes, tubes and cables; joints, couplings, connectors and fixings for use therewith; electric motors; control gear, contractors and starters, all for electric motors; parts and fittings for all the aforesaid goods; electrical and electronic apparatus, instruments and components; apparatus and instruments all for the control, monitoring and distribution of electrical current; electrical switchgear; electric wires and electric cables; conduits and trunking, all being electric; connectors, couplings, junction boxes, bends, elbows, tees and adaptors all for use with ducting, trunking and conduits; switches, fuses, fuse boxes, fuse boards, circuit breakers and earth leakage breakers, relays, consumer units, busbar chambers, consumer units, circuit breakers; voltage stabilizers; thermostats; transformers; electric plugs and electric socket outlets; fused connection units and plugs, coaxial socket outlets; telephone socket outlets; electrical distribution units comprising assemblies of plugs, sockets, switches, fuses, indicator lamps and cables; distribution boards, distribution boxes and junction boxes, all being electric; bells and timers; door chimes and door bells, all being electric; intruder alarms and fire alarms; intercommunication apparatus and installations; testing apparatus and installations; fire protection devices, smoke detectors, fire warning devices, fire control panels; security apparatus and installations; security

alarms, intruder alarms; controlled access security systems (electronic); closed circuit television systems; electrical apparatus incorporating ultraviolet light tubes for the control and extermination of insects; parts and fittings for the aforesaid goods; apparatus for lighting, heating, steam generating, cooking, refrigeration, drying, ventilating, water supply and sanitary purposes; electric light fittings; electrical lighting components; bulkhead light fittings; fluorescent lights; lamps, bulbs and tubes all for lighting; emergency lighting and security lighting; heating and drying apparatus and instruments; electric surface heating tapes; ventilating and air conditioning apparatus and installations; electric cooling and ventilating fans; shower installations and apparatus; water heaters, shower heaters and hand dryers; ducting; insulators for electric mains; ducting, trunking; trunking systems and ducting systems for electrical cables; cavity trunking, cable trunking, junction boxes, cable trays; all of non-metallic material.

[15] As the certified copies filed by the Opponent show that these two applications were pending as of both November 2, 2006 and May 16, 2007, the Opponent has met its initial burden with respect to its s. 16(3)(b) grounds.

[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.).]

[18] As the Opponent's CES & Design mark is more similar to the Applicant's Mark, I will focus my analysis on that mark. If there is not a reasonable likelihood of confusion between the Mark and CES & Design, then there will not be a reasonable likelihood of confusion between the Mark and CES CHINA ELECTRICAL SUPPLIES & Design.

[19] Neither the Applicant's Mark nor the Opponent's mark is inherently strong. (Marks comprised of letters of the alphabet, i.e. initials, are inherently weak [see *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.)].)

[20] There is no evidence that either party's mark has acquired distinctiveness in Canada through use or promotion.

[21] As both parties deal in electrical wares, there is some connection or overlap between their wares.

[22] There is no evidence before me of either party's channels of trade. However, given the connection between their wares, I am prepared to accept that their channels of trade could overlap.

[23] The most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70]. Although both marks start with CE, I am satisfied that confusion between the marks is not likely because small differences are sufficient to distinguish between two weak marks [see *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 7 C.P.R. (2d) 1, (affirmed 14 C.P.R. (2d) 127)]. There are sufficient differences between CEF SERIES and CES & Design in appearance, sound and idea suggested to make confusion unlikely.

[24] The evidence advances two additional surrounding circumstances: the registration of the Applicant's Mark abroad; and the state of the register/marketplace.

[25] Ms. Edwards evidenced that the Mark has been registered abroad but that does not assist the Applicant. Even if both parties' marks co-exist on foreign registers, registrations in other jurisdictions are irrelevant since they have their basis entirely in foreign law and procedure [see *Sun-Maid Growers of California v. Williams & Humbert Ltd.* (1981), 54 C.P.R. (2d) 41 (F.C.T.D.)].

[26] Ms. Young conducted some searches of the Canadian trade-mark register, directed to marks comprising CEF or SERIES; I am not according any weight to these results because she

only provided abbreviated information with respect to each of the applications/registrations (for example, she did not provide the statements of wares and services). Ms. Young also conducted an Internet search directed to locating acronym definitions for CEF; none of the definitions located assist the Opponent.

[27] In view of the inherent weakness of both parties' marks and the lack of acquired reputation in either party's mark, I find that the differences between the marks are sufficient to conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion. I am therefore dismissing both of the s. 16(3)(b) grounds of opposition.

#### Distinctiveness Ground of Opposition

[28] The Opponent has pleaded that the Mark is not capable of distinguishing the Applicant's wares from the wares and services of others, including the wares of the Opponent. In order to meet its initial burden with respect to this ground of opposition, the Opponent must show that as of October 16, 2007 someone's mark had become known sufficiently to negate the distinctiveness of the Applicant's Mark [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.); *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. The Opponent has not done this and so the ground is dismissed on the basis that the Opponent has not met its initial burden.

#### Section 30(i) Ground of Opposition

[29] The Opponent has pleaded that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because the Applicant was aware of the Opponent's "long-established use and registration internationally of its CEF trade-mark in association with electrical goods, the CEF trade-mark being an acronym derived from the opponent's corporate name 'City Electrical Factors Limited'." However, the Opponent did not evidence that the Applicant was aware of the Opponent's mark. In addition, if the Opponent had no reputation in Canada, then its reputation abroad is not relevant insofar as the present proceeding is concerned. In any event, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground

should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant, which is not the case here [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The s. 30(i) ground is accordingly dismissed.

Disposition

[30] As all of the grounds have failed, pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

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