

**In THE MATTER OF
OPPOSITIONS by Accessoires
d'autos Nordiques Inc to Application
No. 860710 for the Trade-mark
NORDIC & SNOWFLAKE Design
filed by Canadian Tire Corporation,
Limited.**

I The Pleadings

On November 6, 1997, Canadian Tire Corporation, Limited (the «Applicant») filed an application, based on proposed use, to register the trade-mark NORDIC & Snowflake Design (the “Mark”), application number 860710, as illustrated hereinafter:



in association with tires (the “Wares”).

On April 19, 2000, the application was advertised in the Trade-marks Journal for opposition purposes. On June 2, 2000, Accessoires d'autos Nordiques Inc (the “Opponent”) filed a statement of opposition, a copy of which was forwarded on June 20, 2000, to the Applicant.

The grounds of opposition can be summarized as follow:

- 1) The application does not comply with the provisions of Section 30(i) of the Trade-marks Act (the “Act”) as, at the date of filing of the application, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares;
- 2) The Mark is not registrable pursuant to the provisions of Section 12(1)(d) of the Act, as it is confusing with the Opponent’s registered trade-mark NORDIQUES, certificate of registration TMA367415, which issued on March 30, 1990 in association with:

« Outillage et accessoires d'auto, nommément: clés, étau, perceuse, meule, planeur, rouleau, table pour planeur, extension de table, corroyeur, scie, banc de scie, disques et tables à scie, tour à bois, collecteur de poussière, sableuse, chalumeau,

tour à fer, perceuse-fraiseuse, coffre, mèches, ruban à mesurer, fusil à peinture, tire-fort, miroir, vérin, support, douilles, coffre à bougies, compas, pince, coffre d'outils, ciseaux, riveteuse, rivets, tournevis, extracteur, cadenas, croix pour roue, chariot, couteaux, attache-mortaise, lame, guide à ongle, mandrin, mâchoire en V, brosse, affûteuse, fusil à souder, fusil à graisser, huilier, casier en plastique emboîtable, câble de nylon, projecteur, vérificateur électrique, vérificateur d'haleine, boule d'attache-remorque, catalogues, éponge, régulateur, compte-tour, antenne, analyseur de mise au point, enjoliveur de roue, guide à refente sur roulements, balai d'essuie-glace, vérificateur de compression, tuyau à air, cliquet, boyau, clé anglaise, racloir en caoutchouc, zip gun, polisseuse, douille électrique, terminal pour phare, lumière de vérificateur. » (the “Opponent’s wares”);

- 3) The Applicant is not the person entitled to the registration of the Mark pursuant to the provisions of Section 16(3)(a) of the Act, as at the time of filing of the application, the Mark was confusing with the Opponent’s trade-mark NORDIQUES and N Design as illustrated hereinafter:

previously used in Canada since December, 1988, in association with the services of offering for sale and selling automobile parts and accessories, tooling for mechanical tune-up and in association with the Opponent’s wares;

- 4) The Applicant is not the person entitled to the registration of the Mark as per the provisions of Section 16(3)(c) of the Act, as at the time of filing of the application, the Mark was confusing with the Opponent’s trade-name Accessoires d’autos Nordiques Inc. previously used in Canada since September 17, 1979, in association with the sale of automobiles’ parts and accessories and the sale of tooling for mechanical maintenance;
- 5) The Mark is not distinctive within the meaning of Section 2 of the Act as the Mark does not distinguish nor is adapted to distinguish the Applicant’s Wares from the Opponent’s wares and services;

In its counter statement, the Applicant denied the allegations contained in the Opponent's statement of opposition. Both parties filed written submissions and were represented at an oral hearing, which took place by way of a conference call.

II The Opponent's evidence

The Opponent's evidence consists of the affidavit of Mr. Denis Bérubé. He was cross-examined and the transcript of his cross-examination was filed in the record.

Mr. Bérubé has been with the Opponent since 1985 and has occupied various functions. On September 6, 1979, the Opponent was incorporated and started to operate a business offering for sale and selling automobiles' parts and accessories and tooling. He alleges that, since December 12, 1986, the Opponent has used the trade-mark NORDIQUES and it obtained its registration on March 30, 1990, a copy of certificate of registration number TMA367415 having been produced as Annex II to his affidavit.

He alleges that, since December 1988, the Opponent has been using the trade-mark NORDIQUES and N Design as illustrated above in association with the Opponent's wares.

He provides, on a yearly basis, the sums of money spent by the Opponent from 1989 to 2000 in advertising to promote the Opponent's trade-marks without breaking down the figures for each of the trade-marks mentioned above. I consider however that the use of the trade-mark NORDIQUES and N Design constitutes use of the trade-mark NORDIQUES. [See *Promafil Canada Ltée v. Munsingwear Inc.(1992)*, 44 C.P.R. (3d) 59]

He filed samples of advertisements published in a Quebec City local newspaper, Le Journal de Québec, on which appear the trade-marks NORDIQUES and N Design and NORDIQUES for the promotion of the Opponent's services and some of the Opponent's wares. I will determine after my summary of the content of his cross-examination if the Opponent's evidence does establish "use" of the trade-mark NORDIQUES in association with the Opponent's wares within the meaning of Section 4(1) of the Act.

Starting in 1994, the Opponent has advertised its business of selling tooling on Quebec City television station CFAP, an affiliate of the French network TQS. During his cross-examination, Mr. Bérubé admitted that the Opponent does not advertised on television the sale of automobile parts and accessories He also filed samples of corporate brochures, publicity sheets that appeared in various trade magazines, promotional pamphlets, letterhead and mailing leaflets, all bearing the NORDIQUES and/or NORDIQUES and N Design trade-marks and/or the Opponent's corporate name. He does not give the details of the use of such promotional material such as, for example, the number of copies distributed, where they were distributed, in which trade magazines those ads were published, when they were published and what were their circulation figures.

Mr. Bérubé states that the Opponent is operating six stores, all located in the greater Quebec City area. He alleges that there is a likelihood of confusion between the Mark and the trade-marks NORDIQUES, NORDIQUES and N Design or the Opponent's corporate name and, in fact there has been cases of confusion. I shall disregard those statements as the issue of a likelihood of confusion between the parties' trade-marks or trade-name is a question to be determined by the Registrar. As for the alleged cases of confusion, there is no information on them and in any event, Mr. Bérubé does not allege to have first hand knowledge of any case of confusion.

His cross-examination revealed that the Opponent imports tooling that it resells either under the manufacturer's brand name or under the Opponent's trade-marks NORDIQUES and/or NORDIQUES and N Design. Sometimes the trade-marks NORDIQUES and/or NORDIQUES and N Design will appear on the box that contains the tooling, on a plaque fixed to the tooling (for example a saw bench) or in the instruction manual (See U-1 to the cross-examination of Mr. Bérubé). He admitted that the Opponent's trade-mark NORDIQUES and NORDIQUES and N Design do not appear on the automobiles parts and accessories sold by the Opponent. He did file as an exhibit to his cross-examination pictures of tooling bearing the trade-marks NORDIQUES or NORDIQUES and N Design. The Opponent does not sell tires but sells brakes, wheels and wheel covers that do not bear the trade-mark NORDIQUES. The Opponent's trade-mark NORDIQUES and N Design appears on the front page of its tooling catalogue which illustrates the tooling sold by the Opponent. Some of the pictures appearing in the catalogue to illustrate the tooling show that

the trade-mark NORDIQUES is on some of the tooling. In 1990 the Opponent ceased to print automobile parts and accessories catalogues.

III The Applicant's Evidence

The Applicant filed the affidavits of Mr. Robert Pierce, Mr. Paul Laurendeau, Ms. Joanne Grison, Ms. Sonja Shpeley and Mr. Sylvain Ouimet. None of them were cross-examined. I should point out that the Applicant sought leave to file the affidavit of Ms. Christine Salo but, by a decision of the former Chairman of the Opposition Board, dated December 17, 2002, Mr. Gary W. Partington refused the request and Ms. Walo's affidavit was returned to the Applicant.

Mr. Pierce described himself as the Category Manager Of Tires of Canadian Tire Corporation Limited ("Canadian Tire"). The last paragraph of his affidavit reads as follow:

"16. This affidavit is filed on behalf of Canadian Tire Corporation, Limited, the opponent in this proceeding."

The Opponent's agent takes the position that by signing his affidavit as an Opponent's representative rather than as an Applicant's representative, it raises doubts as to the personal knowledge of the facts described in his affidavit. The Opponent supports its contention by referring to *Sim & McBurney v. Anchor Brewing Company (2004), 30 C.P.R. (4th) 331*, but I failed to see how that case applies to our present situation. It clearly appears that the use of the word "opponent" instead of "applicant" is an error. Moreover the affiant properly described himself at the beginning of his affidavit as the Applicant's representative. I therefore reject the Opponent's argument to disregard Mr. Pierce's affidavit on this sole basis.

Mr. Pierce alleges that, since October 1998, the Applicant has been selling tires bearing the Mark in its Canadian Tire stores located across Canada, 90 of them being located in the Province of Quebec. He filed as exhibit A to his affidavit a copy of a full scale drawing of a tire showing how the Mark appears on the Wares themselves. He filed as exhibits B and C to his affidavit extracts of the Applicant's catalogues in which there are illustrations of tires bearing the Mark. It should be noted that the design portion of the Applicant's trade-mark NORDIC appearing in these catalogues

is different than the one incorporated in the Mark as illustrated herinafter from a photocopy of the design appearing in said catalogues:

The appearance of a trade-mark on advertising material does not constitute “use” of the Mark in association with the Wares as defined in Section 4(1) of the Act. The evidence in the file, however, does establish use of the Mark by the Applicant as the Mark appears on the Wares themselves at the time of their transfer.

Mr. Pierce has provided sales figures of the Wares in association with the Mark in Canada, which exceeded \$90 million for the period between 1999 and 2001. Mr. Pierce described the usual transaction of sale in the following terms:

“3. Canadian Tire sells tires bearing the NORDIC Design trade mark to Canadian Tire associate stores, which sell them to the public.”

The Opponent, in its written submissions, takes the position that the evidence of “use” of the Mark is ambiguous: which entity sells the Wares, the Applicant or its associated stores? There is no ambiguity in the affiant statement. The Applicant sells to its associated stores the Wares that bear the Mark at the time of their transfer. Such sale does constitute “use” of the Mark within the meaning of Section 4(1) of the Act. The fact that the Wares are subsequently resold by the Applicant’s associated stores without knowing the exact relationship between the Opponent and the associated stores does not invalidate the evidence of use of the Mark through sales in the normal course of trade. An entity that acquires a product from the owner of the trade-mark, or its authorized licensee, is at liberty to resell the product without putting in jeopardy the distinctiveness of the trade-mark.

Mr. Pierce concludes his affidavit by stating that no instances of confusion between the Opponent's products bearing the trade-mark NORDIQUES and the Wares sold in association with the Mark has been brought to his attention since the Applicant started using the Mark.

Mr. Ouimet has been a trade-mark research analyst with IntelPro Thomson & Thomson, an intellectual property research firm. Unfortunately a blank was not filled in paragraph 2 of his affidavit such that we do not know for how long he has been carrying out searches and for how long he has been using the various databases referred to in his affidavit. Such omission will definitely have an impact on the reliability and the weight to be given to the results of his searches.

His mandate, received from the Applicant's agents, consisted in locating common law trade-marks and trade-names in Canada having one or more of the following words as a component: NORDIQUE, NORDIC, or any phonetic equivalents. The results obtained from different databases are described in his affidavit and annexed to it. The Opponent, in its written submissions, argues that the affiant failed to provide information on the frequency of the updates of those databases in order to prove that the results of his searches are accurate and reliable. The affiant made the following allegation:

3(...) I believe that all of these databases are maintained in the usual and ordinary course of business of their owners.”

This statement, without any additional information on the reliability of these databases, together with the absence of information on the affiant's expertise in conducting searches using said databases lead me to give little weight to such evidence. We have no information that the businesses identified in the results of those searches are still in operation and if so, what type of business they are operating and under which trade-name they are carrying on business in Canada. Therefore, I cannot conclude that there is common use of the words NORDIC or NORDIQUES in the business of selling automobile parts and accessories.

Ms. Grison has been a trade-mark searcher with the firm of Grison Intellectual Property Services and has been involved in trade-mark searching for the past 10 years. She received a request from the

Applicant's agents to conduct a search of the Register to locate registered and pending trade-marks containing any of the words NORDIC or NORDIQUE. She restricted her search to active trade-marks, but there was no restriction on the classes of wares and services. The results of her search, using the CDNameSearch database was produced as Exhibit A to her affidavit. Sixty-three (63) trade-marks were located on the Register. Excluding the marks of the respective parties, only five (5) of them cover related wares or services. Such low number does not enable me to infer that the words NORDIC or NORDIQUE are commonly used in the business of selling automobile parts and accessories.

Ms. Shpeley has been a law clerk with the Applicant's agents firm. On February 10, 2002, she conducted a search on the online database operated and maintained by the Canadian Intellectual Property Office in order to locate the registered trade mark NORDIC, certificate of registration TMA303789, owned by Nordic Auto Care Ltd. She did produce the results of said search as exhibit A to her affidavit. This registration covers motor vehicle collision repair services. The remainder of her affidavit consists of evidence to attempt to prove that Nordic Auto Care Ltd. is still in operation and his carrying on business under the trade-name Nordic Auto Care. There is some documentation as an annex to her affidavit that does refer to an entity named Nordic Auto Body Ltd. We have no proof that they are one and the same entity even though they seem to operate from the same address.

Mr. Laurendeau is an associate Professor at the department of French Studies at York University in Toronto, Ontario, where he has been teaching French linguistics. He has a Master in Arts from Sherbrooke University with a specialization in French linguistics and a Doctorat ès Lettres, specialization in morphosyntax from the Université Denis Diderot in Paris, France. He is also the author of approximately forty (40) publications relating to French Linguistics. Unfortunately, Mr. Laurendeau does not explain in details what constitutes French Linguistics, despite a general definition of the word "linguistic" contained in one of the annexes to his affidavit. I am prepared to accept Mr. Laurendeau as an expert in French Linguistics but not an expert on others topics discussed in his affidavit, as we will see hereinafter. [See *WIC TV Amalco Inc. et al v. ITV Technologies, Inc., unreported, [2005] FCA 96, March 14, 2005*]

He was asked by the Applicant's agents firm to provide his views as to how the respective parties trade-marks would be sounded or pronounced in English and in French and what would be the ideas suggested by them. He admits in paragraph 8 of his affidavit that a monolingual French speaking person would pronounce the two words "Nordic" and "Nordiques" in the same manner. Then he goes on to state that, in English, there would be a difference in their pronunciation. I do not think that Mr. Laurendeau, despite his impressive curriculum vitae, can be considered as an expert in English linguistics and morphology, but in view of his educational background, I am prepared to conclude that a bilingual person in Canada would pronounce differently in English those two words. In any event the degree of resemblance needs to be established only within one of the following segments of the population: monolingual French speaking person, monolingual English speaking person or a bilingual person. [See *Smithkline Beecham Corporation v. Pierre Fabre Médicament*, (2001) 11 C.P.R. (4th) 1]

Finally, Mr. Laurendeau gives his opinion, on the connotation to a French speaking person living in the Province of Quebec of the word "Nordiques". Paragraphs 16 and following go well beyond his realm of expertise. His conclusion, based on rule of connotation and semantics, that the word "Nordiques" to a French speaking person would refer to the former hockey team "The Quebec Nordiques" is to say the least speculative. Such conclusion can only be drawn through survey evidence. Mr. Laurendeau has not established himself as an expert in this area and there is no survey evidence to support such contention. Mr. Laurendeau does refer to sport teams' names to support his contention. He does not, however, discuss the case scenario of a person who would have no knowledge of sports in general, and in particular of hockey teams. In any event, one must not lose sight of the fact that the Opponent is the owner of the registered trade-mark NORDIQUES and the likelihood of confusion must be assess using the criteria defined in Section 6(5) of the Act as detailed hereinafter.

The Opponent did not file any reply evidence.

IV The Law

The legal onus is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of each ground of opposition. Once this initial burden is met, the Applicant still has to prove that the particular grounds of opposition should not prevent the registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293].

The first ground of opposition is insufficiently pleaded as the Opponent failed to allege that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares because the Mark was confusing with the Opponent's trade-marks. Therefore, this ground of opposition is dismissed.

The faith of the remaining grounds of opposition will depend on the assessment of the likelihood of confusion between the Mark, when used in association with the Wares, and the Opponent's trade-marks NORDIQUES, NORDIQUES and N Design and its trade-name Accessoires d'autos Nordiques Inc.

The material time for considering the issue of non-entitlement based on Subsection 16(3) of the Act is the filing date of the application (November 6, 1997) [See Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the statement of opposition (June 2nd, 2000) while registrability under 12(1)(d) must be assessed as of the date of my decision. [See *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) 413 at 424 (F.C.A.)] The difference in the relevant dates will not have an impact on the outcome of this case.

In *Miss Universe, Inc. v. Bohna* (1995) 58 C.P.R. (3d) 381 Mr. Justice Décarý defined the applicable test to determine the likelihood of confusion between trade-marks in the following terms:

“To decide whether the use of a trade mark or of a trade name causes confusion with another trade mark or another trade name, the court must ask itself whether, as a matter of first impression on the minds of an ordinary person having a vague recollection of that other mark or name¹, the use of both marks or names in the same area in the same manner is likely to lead to the inference that the services associated with those marks or names are performed by the same person, whether or not the services are of the same general class. (See s. 6(2), (3) and (4) of the Act; *Rowntree Co. v. Paulin Chambers Co.*, [1968] S.C.R. 134; *Oshawa Holdings Ltd. v. Fjord Pacific Marine Industries Ltd.* (1981), 55 C.P.R. (2d) 39, 36 N.R. 71 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 at pp. 9-10, [1988] 3 F.C. 91, 16 C.I.P.R. 282

I also wish to refer to Mr. Justice Denault’s comments in *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. 359:

“Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade mark is the most relevant for purposes of distinction: *Molson Companies Ltd. v. John Labatt Ltd.* (1990), 28 C.P.R. (3d) 457 at p. 461, 32 F.T.R. 152, 19 A.C.W.S. (3d) 1369 (F.C.T.D.); *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at p. 188. I believe the following words of President Thorson in the case of *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 at pp. 57-8, [1944] 4 D.L.R. 577, [1944] Ex. C.R. 239 (Ex. Ct.), to be particularly useful in explaining why attention should be drawn to the first portion of the appellant’s mark in this case:

... the Court should rather seek to put itself in the position of a person who has only a general and not a precise recollection of the earlier mark and then sees the later mark by itself; if such a person would be likely to think that the goods on which the later mark appears are put out by the same people as the goods sold under the mark of which he has only such a recollection, the Court may properly conclude that the marks are similar.»

In the case of *Battle Pharmaceuticals v. British Drug House Ltd.*, [1946] S.C.R.50, the Honorable Mr Justice Kerwin cited the following extract of the decision rendered by the Privy Council in *Aritoc Limited v. Rysta Limited* [1945] A.C. 68:

«The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of s. 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and by syllable, pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.» (My underlines)

I shall also refer to Section 6(2) of the Act that states:

“6(2) The 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 order to determine whether the Marks are confusing with any of the Opponent’s trade-marks, Section 6(5) of the Act directs the Registrar to have regards to all of the surrounding circumstances, including the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. It has been established that the criteria listed in Section 6(5) of the Act are not exhaustive and it is not necessary to give each one of them equal weight [See ***Clorox Co. v. Sears Canada Inc. (1992), 41 C.P.R. (3d) 483 (F.C.T.D.)*** and ***Gainers Inc. v. Marchildon (1996), 66 C.P.R.(3d) 308 (F.C.T.D.)***].

It is with these principles in mind that I shall review the evidence summarized above in the context of the criteria enumerated in Section 6(5) of the Act and any other relevant surrounding circumstances. I shall first assess the second ground of opposition that challenges the registrability of the Mark (Section 12(1)(d) of the Act).

a) Inherent distinctiveness of the marks and the extent to which they have become known;

The Mark does not possess a high degree of inherent distinctiveness because it could be considered as highly suggestive of one of the characteristics of the Wares, namely that the tires sold in association with the Mark are to be used in winter conditions. The Opponent's trade-mark NORDIQUES also does not have a high degree of inherent distinctiveness as it could suggest that some of the automotive parts enumerated in the list of wares covered by certificate of registration TMA367415 are meant to be used during winter condition.

The total sales figures of the Wares in Canada for the period between 1999 and 2001 inclusive are approximately \$90 million. The Opponent challenges the validity of the evidence filed to support such contention on the basis that the photocopies of the electronic records do not refer to the Mark. However, the Applicant did state in paragraph 12 of his affidavit that "... Exhibit E to this my affidavit, are photocopies of extracts from our electronic records ("the Records") which show the sale of tires bearing the NORDIC design trade-mark." The Opponent decided not to cross-examine the deponent to clarify any ambiguity it may have in its mind. I do not see any ambiguity in said statement. Finally, the evidence shows that the Mark appears on the wares themselves. Therefore, the Applicant's Mark is known to some extent in Canada.

The Opponent did mention the sums of money spent over the years to promote its trade-mark NORDIQUES. We do not have, however, any evidence of the extent of the Opponent's sales of the wares listed in certificate of registration TMA367415. Mere advertising does not constitute "use" of a mark in association with wares. [See Section 4 of the Act] Moreover, as indicated above, the cross-examination of Mr. Bérubé did reveal that there has been no "use" of the trade-mark NORDIQUES in association with automotive parts. There is however evidence of "use" of the trade-mark NORDIQUES in association with tooling but we do not know to which extent. It is therefore difficult to determine to what extent the Opponent's trade-mark NORDIQUES is known in Canada.

b) The length of time the marks have been in use

As discussed previously, there is evidence of use of the Mark in association with the Wares since 1998. There is evidence of use of the trade-mark NORDIQUES by the Opponent in association with tooling. The certificate of registration TMA367415 was issued on the basis of use of the trade-mark NORDIQUES since December 15, 1986. Mr. Bérubé, however, admitted during his cross-examination that the Opponent is not using the trade-mark in association with automotive parts. Moreover there is no evidence of use as defined in Section 4 of the Act in association with tooling as there is no evidence of a commercial transaction, in the normal course of trade, of tooling bearing the Opponent's trade-mark NORDIQUES. Under these circumstances, I am not prepared to conclude on the sole basis of certificate of registration TMA367415 that the Opponent has used its trade-mark since December 15, 1986, in association with automobile parts and accessories. [See *Park Avenue, op. cit.*, and *Canadian Co-Operative Credit Society Ltd. v. Commercial Union Assurance Co., Plc (1992), 42 C.P.R. (3d) 239*]

c) The nature of the wares

When comparing the nature of the parties' respective wares, we must look at the wares listed on the certificate of registration and the wares listed in the application under opposition. There is clearly an overlap between some of the Opponent's wares such as brakes, wheels, wheel covers and other automobile accessories and the Applicant's Wares.

d) The nature of the trade

The nature of the parties' business is similar. They both sell, amongst other things automobile parts and accessories. As stated by Teitelbaum J, in *Everex Systems Inc. v. Everdata Computer Inc., (1992) 44 C.P.R. (3d) 175 at 182:*

“Considering the nature of trade, it is not necessary that one prove that the wares in question are, or have, in the past, been sold in the same places. Rather, one may properly look at whether the wares could eventually be sold in the same places. As stated by Mr. Justice Dubé in *Cartier Inc. v. Cartier Optical Ltd./Lunettes Cartier Ltée* (1988), 20 C.P.R. (3d) 68 (F.C.T.D.) at 74:

However, so as to establish the likelihood of confusion, it is not necessary to prove that the wares are sold in the same places, provided they are of the same general class, could eventually be sold in the same places, and the parties are entitled to do so: [see *Eminence, S.A v. Registrar of Trade Marks* (1977), 39 C.P.R. (2d) 40.]”

- e) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them

The degree of resemblance between the trade-marks in issue in appearance, or sound or any ideas suggested by them is often considered as the dominant factor when assessing the likelihood of confusion, especially when there is an overlap in the parties respective wares and their channels of trade. (See *Berverly Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 at 149 (F.C.T.D.))

The marks in issue are phonetically identical for a monolingual French speaking person. The Applicant tried to downplay this fact through the observations contained in Mr. Laurendeau’s affidavit by alleging that the addition of the letter “s” at the end of the word “Nordiques” creates, in the mind of that segment of the population, a connotation with the former professional hockey team “Quebec Nordiques” and not with the Opponent. I do not accept this argument. This conclusion is not supported by any evidence, including survey evidence. Finally, the dominant portion of the Applicant’s Mark is the word “NORDIC” rather than the design portion of the Mark.

V Conclusion

My analysis of the relevant criteria leads me to conclude that the Applicant has not satisfied its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between NORDIC and NORDIQUES when the Mark is used in association with the Wares. I reach this conclusion on the basis that the marks in issue are phonetically identical to a monolingual French speaking person, that there is an overlap between some of the wares covered by certificate of registration TMA367415 and tires, and because of the similarities in the parties' businesses. Therefore, I maintain the Opponent's second ground of opposition.

There has been no evidence of use of the Opponent's trade-name Accessoires d'auto Nordiques Inc. in association with automotive parts and accessories, nor, as required by the provisions of Section 16(5), evidence that the Opponent has not abandoned the use of its trade-name at the date of advertisement of the Applicant's application. I therefore dismiss the fourth ground of opposition.

The Opponent raises as its fifth ground of opposition that the Mark is not distinctive nor is it adapted to distinguish the Wares from the Opponent's wares and services. It should be noted that the Opponent did not refer to its trade-marks NORDIQUES and NORDIQUES and N Design nor did he specified the services. The Applicant did not request any clarification on this ground of opposition. In view of *Novopharm Ltd. v. AstraZeneca AB 21 C.P.R. (4th) 289*, the Board must take into consideration all the evidence filed to assess such ground of opposition. I already ruled that the Mark is not registrable because it is confusing with the Opponent's registered trade-mark NORDIQUES. Therefore, the Applicant's Mark cannot be distinctive within the meaning of Section 2 of the Act. Moreover the Opponent has established use of its trade-marks NORDIQUES and NORDIQUES and N Design in association with the services of offering for sale and selling automobile parts and accessories. There exists a connection between tires and the services of offering for sale automobile parts and accessories. My analysis of the criteria listed under Section 6(5) of the Act, with respect to the ground of opposition based on Section 12(1)(d) of the Act would be equally applicable to the lack of distinctiveness ground of opposition, except for the criteria of the nature of the wares and services, as I would add that there exists a connection between the Wares and the Opponent's services. Moreover there is evidence of use of the trade-marks NORDIQUES and NORDIQUES and N Design since at least 1994 in association with the services of offering for sale and selling

automobile parts and accessories. Therefore the criteria of the length of time of use of the marks in issue would also favour the Opponent.

I conclude as well that the Mark could not be distinctive or apt to distinguish the Applicant's Wares from the Opponent's services of offering for sale and selling automobile parts and accessories in association with the trade-marks NORDIQUES and NORDIQUES and N Design.

Having already ruled in favour of the Opponent on two grounds of opposition, it is not necessary to dispose of the third ground of opposition described above.

Accordingly, having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I refuse the Applicant's application to register the Mark pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 21st DAY OF MARCH 2005.

Jean Carrière
Hearing Officer
Trade-marks Opposition Board