

**IN THE MATTER OF AN OPPOSITION by
Mag Instrument, Inc. to Application No.
1183584 for the trade-mark MAGTOUCH filed
by Dr. Micheal Kretzschmar**

I The Proceedings

On July 21, 2003 Dr. Micheal Kretzschmar (the “Applicant”) filed an application to register the trade-mark MAGTOUCH (the “Mark”) based on use and registration in Germany and on proposed use in Canada. The priority date claimed in the application is January 22, 2003. The application covers: Games and playthings, namely a magnetic construction system to build a wide variety of shapes and objects (the “Wares”).

The application was advertised on June 2, 2004 in the *Trade-marks Journal* for opposition purposes. Mag Instrument, Inc. (the “Opponent”) filed a statement of opposition on November 1, 2004 and the Registrar forwarded it on November 18, 2004 to the Applicant.

The Applicant filed on March 18, 2005 a counter statement denying essentially all grounds of opposition pleaded.

The Opponent filed the affidavit of Alfred Walker. The Applicant filed no evidence. Only the Opponent filed written arguments and was present at an oral hearing.

II The Grounds of Opposition

The grounds of opposition are:

1. The Mark is not registrable pursuant to the provisions of s. 38(2)(b) and 12(1)(d) of the Trade-marks Act R.S.C. 1985, c. T-13, (the “Act”) since it is confusing with the following registered trade-marks:

MAG-LITE, registration TMA361579
MINI MAGLITE, registration TMA361578
MAG CHARGER, registration TMA365447

MINI-MAGLITE & Design, registration TMA374744
MAG INSTRUMENT, registration TMA375895
MAGLITE & Design, registration TMA376625
MINI MAGLITE AA, registration TMA403332
MINI MAGLITE AAA, registration TMA408939
MAG, registration TMA431590
PANTHER & MAG, registration TMA454498
MAG-LITE & Design, TMA522785
MAG-NUM STAR, TMA571654
(collectively referred to as the “Opponent’s registered trade-marks”)

2. The Applicant is not entitled to registration of the Mark in view of the provisions of s. 38(2) (c) and 16(2)(a) of the Act as at the claimed date of priority or the filing date of the application, it was confusing with the Opponent’s registered trade-marks previously used in Canada;
3. The Applicant is not entitled to registration of the Mark in view of the provisions of s. 38(2)(c) and 16(2)(b) of the Act as at the claimed date of priority or the filing date of the application, it was confusing with the trade-marks in respect of which an application for registration had been previously filed in Canada by the Opponent or its predecessor in title, namely:
 - MAG, application number 1100188;
 - MAG-LITE, application number 1110043;
 - MAGLITE & Design, application number 1114820;
 - MAGLED, application number 1156734;(hereinafter referred to as the “Opponent’s pending trade-marks”)
4. The Applicant is not entitled to registration of the Mark in view of the provisions of s. 16(3)(a) of the Act in that, at the date of the filing of the application in Canada and on the priority date, the Mark was confusing with Opponent's registered trade marks which had been previously used in Canada by the Opponent and had not been abandoned at the date of advertisement of the Applicant's application;
5. The Applicant is not entitled to registration of the Mark in view of the provisions of s. 16(3)(b) of the Act in that, at the date of the filing of the application in Canada and on the priority date, the Mark was confusing with Opponent’s pending trade-marks for which applications for registration had been previously filed in Canada by the Opponent and were not abandoned at the date of advertisement of the Applicant's application;
6. Pursuant to s. 38(2)(d) of the Act, the Applicant’s Mark is not and cannot be distinctive of the Wares within the meaning of s. 2 of the Act in that it is not adapted to distinguish them from the wares of the Opponent, in that the Mark is confusing with the Opponent’s registered trade-marks and the Opponent’s pending trade-marks.

All grounds of opposition are based on the allegation that the Mark is confusing with any-one of the Opponent's registered trade-marks or anyone of the Opponent's pending trade-marks. The difference in the material dates will not be of consequence in this file.

I should point out that the Opponent's abovementioned registrations and applications cover, amongst other things, flashlights, flashlight accessories, key rings, batteries, lenses and clothing.

II General Principles Applicable to all Grounds of Opposition

The Applicant has the legal onus to show that its application complies with the provisions of the Act, but 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. Once this initial burden is met, the Applicant still has to prove, on a balance of probabilities, 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; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

III The issue of confusion

The Opponent is alleging that the Mark is not registrable pursuant to s. 12(1)(d) of the Act as it is confusing with its registered trade-marks listed above. The Opponent filed certified copies of these registrations and they are attached to Mr. Walker's affidavit, save and except for MINI MAGLITE AA and MINI MAGLITE AAA. However when an opponent raises as a ground of opposition s. 12(1)(d) of the Act and has not filed the certificate(s) of registration relied upon, the Registrar can use its discretion and check the register which I did [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. The Opponent is the owner of MINI MAGLITE AA but the registration for the trade-mark MINI MAGLITE AAA was expunged. Moreover, I noted that the trade-mark MAGLITE & Design, certificate of registration 376625 was also expunged on July 20, 2006 for failure to renew.

The Opponent has met its initial onus with respect to the remainder of its marks.. Therefore I have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's registered trade-mark MAG-LITE as I consider it to be the best case scenario for the Opponent in view of the evidence of its use filed and detailed hereinafter. If the Opponent were not successful under that trade-mark, it would also be unsuccessful when considering any of its other registered trade-marks.

The test to determine this issue is set out in s. 6(2) of the Act and I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): 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 in the ideas suggested by them. Those criteria 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.)]. I also refer to the decisions of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under s. 6(5) of the Act to determine the likelihood of confusion between two trade-marks.

The Mark is inherently distinctive. It is a coined word; so is the Opponent's trade-mark MAG-LITE. Both marks comprise the prefix "mag" which may suggest "magnetic" in the context of the Applicant's Wares.

The degree of distinctiveness of a trade-mark can be enhanced through use or if made known in Canada. The Applicant has filed no evidence; thus there is no evidence of use of the Mark in Canada in the record.

Mr. Walker is currently retired but was the Opponent's Manager of Canadian Sales from November 1993 to September 30, 2005. Normark Inc previously employed him for approximately four years as Manager of Sales and Administration. He explains that Normark became in August 1984 the exclusive Canadian distributor of flashlights and flashlight accessories produced by the Opponent and continued to do so until December of 1993.

In the early 1980's the Opponent commenced to use the trade-mark MAG-LITE in Canada in association with the Opponent's flashlights and flashlight accessories. The Opponent has continuously used this mark since then until the present. He produced a photocopy of various pages of the Opponent's 2001 and 2004 catalogues and pages from the Opponent's website which shows such wares being offered for sale in association with the trade-mark MAG-LITE.

The Opponent began to use in Canada in 2004 the trade-mark MAGLITE & Design, application number 1114820, which matured to registration since then (certificate of registration TMA626973), as illustrated hereinafter:

MAGLITE

I should point out that I consider any evidence of use of the trade-mark MAGLITE & Design as illustrated above or MAGLITE written in one word to constitute evidence of use of the trade-mark MAG-LITE in view of *Promafil Canada Ltd. v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59. Mr. Walker alleges that the Opponent has continuously used this mark since then until the present.

He filed copies of invoices issued between 2002 and 2005 evidencing sales of products bearing the trade-mark MAGLITE (on the invoice the trade-mark is written in one word without any design portion). He states that the sale of "Mag Products", defined in his affidavit as flashlights and flashlight accessories, with the exception of flashlight bulbs, from 1994 to April 2006 totaled over \$80 million in Canada. However those sales are not broken down by trade-mark. It

is therefore impossible to determine the sales of Opponent's products in association with the trade-mark MAG-LITE or any other of its trade-marks listed above.

He then provides the details of the advertising done by the Opponent to promote the Opponent's flashlights and accessories. Since 1993 these products have been extensively advertised to the Canadian public by virtue of their appearance in a number of mail order and on-line catalogues distributed throughout Canada. He filed extracts of catalogues that are representatives of such advertising on which are illustrated flashlights bearing the trade-marks MAG-LITE and/or MAGLITE.

He asserts that flyers showing the Opponent's flashlights have been distributed by Canadian Tire across Canada and inserted in major newspapers several times each year. It also advertises since 1994 such products in its Annual Value Guide distributed in every province of Canada. He has been informed by a representative of Canadian Tire that at least 8 million copies of its weekly flyers are distributed in Canada. Such evidence constitutes hearsay evidence. Similar numbers of the Opponent's Annual Value Guide catalogue have been distributed but on an annual basis. Samples of those flyers from July 1995 through September 2005 and catalogues from 1998 to 2001 have been produced. They show flashlights bearing the trade-marks MAG-LITE, MAGLITE and MAGLITE & Panther Design. They are no longer featured in the Canadian Tire Annual Value Guide but are featured at the Canadian Tire web site and extracts of such web site have been filed to illustrate flashlights bearing the trade-marks MAGLITE, MINI MAGLITE and MAGLITE & Panther Design.

Since 1994 the Opponent has spent in Canada at least \$300,000 each year to promote the Opponent's flashlights and accessories.

From this evidence I conclude that the Opponent's trade-mark MAGLITE was known in Canada but because we have no breakdown of the sales per trade-mark, it is impossible to conclude, like the Opponent would like the Registrar to do, that it is well known. Despite such deficiency, this factor favours the Opponent.

As for the length of time the parties' trade-marks have been in use, such factor also favours the Opponent.

The wares of the respective parties are different. On one hand we have flashlights and accessories while the Applicant's wares are games and playthings, namely a magnetic construction system. This factor favours the Applicant.

Mr. Walker states that the products covered by the Opponent's registrations (hereinafter referred to as the "Opponent's products") are sold directly to wholesalers who in turn sell them to retailers. Examples of such wholesalers are Canadian Tire, Home Hardware and Rona. The retailers who sell to consumers are Wal-Mart, Home Depot, Club Price. The Opponent's products are also sold through a number of mail order and on-line catalogues such as S.I.R. Mail Order, KnifeZone, EfstonScience and Le Baron.

He alleges that many of the retailers mentioned above also sell games and playthings. The Applicant has not contradicted this statement. Therefore in the absence of evidence to the contrary I conclude that the Applicant's Wares could be sold in the same retail stores as the Opponent's flashlights and accessories bearing the trade-mark MAG-LITE. However the evidence filed by the Opponent shows that its wares are associated with outdoor equipment. Moreover the extracts of the Canadian Tire catalogues filed do illustrate a wide range of products being offered for sale in its retail stores including: flashlights, microwave oven, hockey sticks, boots, electronic equipment, barbecue, soccer shoes, automobile accessories and kitchen appliances. Therefore I am not convinced that, even though the parties' respective wares could be sold in those type of stores, they would be found in the same department or side by side on the same shelf. The description of the Wares does not lead me to believe that they would be considered as outdoor products. Consequently I do not consider the fact that the parties' wares could be sold through the same channels of trade as the ones described above to be a determining factor.

The degree of resemblance is regarded as, amongst any of the relevant factors, to be the most important one. Mr. Justice Cattanach stated in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70:

“Realistically appraised it is the degree of resemblance between the trade-marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.”

The first portion of each mark is identical. The first component of a trade-mark is often considered more important for the purpose of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)]. However the idea suggested by the trade-marks are different. The Mark could suggest that the effect of a magnetic field will help them to fit one into another. The trade-mark MAG-LITE could be viewed as suggesting a magnified source of light. The dissimilarity in the ideas suggested and the difference between LITE and TOUCH are sufficient in my opinion to distinguish the marks when viewed as a whole.

As appears from above, the Opponent is the registered owner of several trade-mark registrations where each trade-mark comprises the term “mag” as a prefix, in most of them. However the Opponent must show use of each of these trade-marks in order to expand the scope of protection afforded by the registration of its trade-mark MAG-LITE [see *MacDonald’s Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)].

Mr. Walker has alleged use of the following trade-marks:

- PANTHER & MAG Design. He filed photocopies of pages of the Opponent’s 2004 catalogue and a 1999 brochure that illustrate flashlights bearing such trade-mark ;
- MAG CHARGER. He filed photocopies of pages of the Opponent’s 2004 catalogue that illustrate flashlights bearing such trade-mark;
- MAG-NUM STAR in association with flashlight bulbs. He produced a photocopy of various pages of the Opponent’s 2004 catalogue that shows such wares being offered for sale in association with such trade-mark;
- MAG INSTRUMENTS on flashlights and accessories. It appears on various packaging

filed as exhibits to Mr. Walker's affidavit;

- MINI MAGLITE in association with flashlights. He filed a picture of a sample of such product.

Except for MAG INSTRUMENTS and MINI MAGLITE, there has been no evidence of use that would satisfy the definition of use found in s. 4(1) of the Act. There has been no evidence of sales of flashlights in association with each of these trade-marks. Representation of wares in a catalogue, let alone the fact that we have a catalogue published on a website without any evidence that such website has been visited by Canadians, does not constitute proper evidence of use of a trade-mark in association with wares.

Even if the Opponent had established a family of trade-marks having as a prefix "mag", it would not be sufficient to expand the scope of protection of its trade-marks to prevent the registration of the Mark in association with the Wares as they are so different from the wares covered by the Opponent's registrations. I have no evidence that would enable me to conclude, on a balance of probabilities, that a Canadian consumer, who is aware of the Opponent's trade-marks used in association with flashlights and accessories when confronted with Wares bearing the Mark, would think that they emanate from the Opponent.

I conclude that the Mark is registrable in association with the Wares. The Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark MAG-LITE when used in association with the Wares. I base this conclusion on the fact that the Applicant's Mark is inherently distinctive; that the Wares are different from the Opponent's wares; and, despite the common prefix "mag", the marks differ in appearance, sound and the idea suggested by them.

I wish to add that my conclusion would have been the same if I had compared the Mark to the Opponent's trade-mark MAG. There is no evidence of use within the meaning of s. 4(1) of the Act of such trade-mark. On that issue, the Opponent is relying on an extract of its website to illustrate use of such trade-mark in association with flashlights. There is no evidence of sales in Canada of flashlights bearing such trade-mark. We have no evidence that such website has been

visited by Canadians. Therefore I would not have been able to conclude that the Opponent's trade-mark MAG was used or known in Canada as I did for the trade-mark MAG-LITE. Furthermore the addition of the suffix "TOUCH" is sufficient to distinguish both visually and phonetically the Mark from MAG. Finally the difference in the parties' respective wares would still be present.

I therefore dismiss the first ground of opposition described above. As for the other grounds of opposition, the evidence of prior use detailed above was sufficient to discharge the Opponent's initial onus in so far as MAG-LITE is concerned. However the conclusion reached with respect to s. 12(1)(d) ground of opposition of no reasonable likelihood of confusion between the marks in issue is equally applicable to all other grounds of opposition for the same reasons described in detail above. Consequently, grounds of opposition two to six inclusive are also dismissed.

VI Conclusion

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

DATED IN BOUCHERVILLE, QUEBEC, THIS 18th DAY OF MARCH 2009.

Jean Carrière,
Member, Trade-marks Opposition Board