



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

**Citation: 2013 TMOB 129**  
**Date of Decision: 2013-07-31**

**IN THE MATTER OF AN OPPOSITION by  
Lutron Electronics Co., Inc. to application  
No. 1,461,401 for the trade-mark LITRON in  
the name of Litron Distributors Ltd.**

[1] Lutron Electronics Co., Inc. (the Opponent) opposes registration of the trade-mark LITRON (the Mark) that is the subject of application No. 1,461,401 by Litron Distributors Ltd. (the Applicant).

[2] The application was filed on December 3, 2009 and is based on proposed use of the Mark in Canada in association with the following wares and services, as revised by the Applicant on September 14, 2010:

Commercial and industrial lighting, namely light bulbs, lighting fixtures, ballasts, lenses, louvers, and baffles.

Wholesale and retail lighting services.

[3] The Opponent alleges that the Mark is not registrable under section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and not distinctive under section 2 of the Act and that the Applicant is not the person entitled to registration of the Mark under section 16(3) of the Act because the Mark is confusing with, among others, the Opponent's registered trade-mark LUTRON that has been previously used in Canada by the Opponent in association with lighting related products. The Opponent further alleges that the application for the Mark does not comply with the requirements of section 30 of the Act for a number of reasons, one of which being that

the Mark is not a proposed use trade-mark in that the Applicant had already commenced using the Mark prior to the filing date of the application.

[4] I find the determinative issue in this proceeding is whether the Mark is confusing with the Opponent's trade-mark LUTRON as registered or used.

[5] For the reasons explained below, I find confusion likely.

#### The Record

[6] The statement of opposition was filed by the Opponent on February 22, 2011 and was denied by the Applicant by counter statement.

[7] As its evidence, the Opponent filed the affidavits of Peter Saccomanno, Vice President of sales for Canada of the Opponent, sworn September 6, 2011, and Dane Penney, a trade-mark searcher employed by the agents for the Opponent, sworn September 1, 2011, as well as certified copies of registration Nos. TMA194,151 and TMA347,577 for its LUTRON word mark and Sun Design mark (shown below) respectively:



[8] None of the affiants was cross-examined. The Applicant elected not to file evidence.

[9] Both parties filed written arguments and were represented at a hearing. As objected to by the Opponent at the hearing, parts of the Applicant's written argument ought to be disregarded as they make reference to evidence that has not been properly filed and served in this proceeding, namely:

- Schedule "A" attached to the Applicant's written argument, which consists of a printout of a Google internet search for the term "litron dimmers" purporting to contradict the Opponent's evidence introduced through the Saccomanno affidavit;

- References to a third party's registrations for the trade-marks LEVITON and LEVITON & Design; and
- References to a search allegedly conducted on the Opponent's website *www.lutron.com* under "lighting fixtures".

[10] Accordingly, these will be disregarded.

#### The parties' respective burden or onus

[11] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

#### Analysis of the grounds of opposition

##### The non-registrability ground of opposition

[12] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's trade-mark LUTRON registered under No. TMA194,151 in association with the wares:

Electrical motor speed and temperature controls, voltage controls, lamp dimmers, gas discharge ballasts.

[13] I have exercised the Registrar's discretion to confirm that this registration, issued on September 21, 1973, is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[14] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark.

### The test for confusion

[15] Section 6(2) of the Act provides that:

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.

[16] Thus, this section does not concern the confusion of the trade-marks themselves, but confusion of wares or services from one source as being from another source.

[17] The test for confusion is one of first impression and imperfect recollection. As noted by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 at 369:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[18] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 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 all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

Consideration of the section 6(5) factors

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[19] The trade-marks at issue are both coined words that are inherently distinctive in the context of their associated wares and/or services.

[20] There is no evidence that the Applicant's proposed use Mark has been used in Canada pursuant to section 4 of the Act or that it has become known to any extent whatsoever in Canada. I will return to the absence of evidence of use of the Mark later on in my decision when considering the section 30(b) and (e) ground of opposition.

[21] In contrast, the Saccomanno affidavit evidences that the Opponent's trade-mark LUTRON has been used in Canada by the Opponent and become known to some extent at least, as per my review below of the salient points of the Saccomanno affidavit.

The Saccomanno affidavit

[22] Mr. Saccomanno first provides a background of the Opponent's activities. The Opponent was founded over 45 years ago and is a worldwide leader in the area of lighting controls and lighting products, including in Canada. The Opponent's first product was called a *dimmer* switch and it represented the world's first commercially successful solid-state electronic device to dim lights. The Opponent is also responsible for the first electronic dimming ballast for fluorescent lights and the first self-contained preset lighting control system [paras 4 and 5 of his affidavit].

[23] Mr. Saccomanno states that the Opponent currently offers more than 15,000 products, including light dimmers and switches, fan controls, ballasts, timers, occupancy/vacancy and wireless sensors (including motor speed, temperature and voltage control), temperature controls, wall plates and accessories, single room control systems, whole home and whole building dimming systems, window shade systems, LED drivers, and lighting fixtures. Mr Saccomanno collectively refers to these products as "Lutron Products" and I will do the same [para 5 of his affidavit].

[24] Mr. Saccomanno then turns specifically to the use of the trade-mark LUTRON in Canada. He states that the trade-mark LUTRON has been used in Canada since at least as early as 1971 in association with light dimmers and switches. Over the years, various other products have been offered in Canada in association with the LUTRON trade-mark such as ballasts (1997), wall plates and accessories (1997), window shade systems (2000), timers (2005), occupancy/vacancy wireless sensors (2010), and lighting fixtures (2010) [para 11 of his affidavit].

[25] Mr. Saccomanno states that the trade-mark LUTRON is prominently displayed on product packaging for Lutron Products sold in Canada. He attaches to that effect as Exhibits C and D respectively, samples of the artwork for current packaging and actual packaging for Lutron Products currently sold in Canada. Upon review of these exhibits, I note that they pertain to the Opponent's dimmers and wall plates only. However, Mr. Saccomanno asserts that these samples are representative of how the LUTRON trade-mark appears on the majority of Lutron Products sold in Canada, and has appeared in a similar manner for a number of years.

[26] As explained by Mr. Saccomanno, the Opponent's Sun Design trade-mark referred to above also appears on such packaging, in addition to the LUTRON trade-mark, as shown below:



[27] I am satisfied that use the LUTRON trade-mark in combination with the Sun Design mark as shown above constitutes use of the registered word mark LUTRON. The trade-mark LUTRON as used maintains its identity and remains recognizable as the registered trade-mark *per se* [see *Canada (Registrar of Trade Marks) v Cie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. Furthermore, nothing prevents the Opponent from using its word mark LUTRON together with its Sun Design mark [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469; and *Cie Internationale pour l'informatique CII Honeywell Bull, société anonyme v Herridge, Tolmie and Registrar of Trade Marks* (1983), 4 CPR (3d) 523 (FCTD), rev'd on other grounds in *Cie Internationale pour l'informatique CII Honeywell Bull, supra* (FCA)].

[28] Lutron Products are extensively used in many sectors, including residential, commercial, and industrial. Mr. Saccomanno explains that the Opponent sells the Lutron Products worldwide, including Canada, both to individual consumers via third party retail outlets, as well as directly to electrical distributors and lighting showrooms [paras 7 and 8 of his affidavit]. I will return to the Opponent's channels of trade when assessing the nature of the trade.

[29] Mr. Saccomanno then turns to the Internet. He states that the Opponent owns the domain name *www.lutron.com* and that the LUTRON trade-mark has been displayed on that website continuously since at least as early as February 1996. He explains that the Opponent's website provides an online directory of where Lutron Products can be purchased in various countries, including Canada. Canadian consumers, electrical distributors, installers, retailers, among others, can access brochures (sell sheets) and product specification guides on Lutron Products. He attaches to that effect as Exhibits E and F respectively, representative samples of brochures for dimmers dated July 2009 and April 2011, and the first pages of three product specification guides for dimmers and wall plates [paras 18 to 20 of his affidavit].

[30] Mr. Saccomanno further states that between May 16, 2010 and September 1, 2011, there were approximately 194,579 visits to the website by individuals from across Canada, as corroborated by Exhibit G that consists of a document showing data on internet traffic to the Opponent's website in this period [para 21 of his affidavit].

[31] Mr. Saccomanno then turns to the sales associated with the LUTRON trade-mark. He states that from 2000 to the date of his affidavit, the Opponent's total revenues generated from the sales of the Lutron Products to customers in Canada, in association with the trade-mark LUTRON, was nearly \$300 million USD. He states that there have been sales in Canada for every year during this time period. However, no breakdown of annual sales for each of the Lutron Products is provided.

[32] Mr. Saccomanno goes on to explain the promotion and advertising of the Lutron Products in Canada.

[33] Lutron Products are advertised and promoted in Canada primarily by means of floor displays in retail establishments, the Opponent's website, brochures, product specifications, and

trade publications [para 23 of his affidavit].

[34] More particularly, Mr. Saccomanno explains that the LUTRON trade-mark appears, and has appeared, on floor displays that are exhibited at over 330 Canadian third party retail locations. The advertising expense associated with such displays was in excess of \$400,000 USD up to the year 2009 [para 24 of his affidavit, Exhibit H that consists of representative sample displays dating back to 2009].

[35] The Lutron Products are further promoted through trade publications intended primarily for electrical contractors and for home renovating and decorating consumers. The identifiable advertising costs for print publications were in excess of \$4 million USD, for all North America [paras 25 and 26 of his affidavit, Exhibit I that consists of representative samples of ads dating back to 2006].

[36] To sum up, the overall consideration of this first factor, which is a combination of inherent distinctiveness and acquired distinctiveness, unequivocally favours the Opponent.

the length of time the trade-marks have been in use

[37] As per my comments above, this factor also favours the Opponent.

the nature of the wares, services or business; and the nature of the trade

[38] When considering the nature of the wares and the nature of the trade, I must compare the Applicant's statement of wares and services with the statement of wares in the registration referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].



[39] As indicated above, the Applicant's application covers: "Commercial and industrial lighting, namely light bulbs, lighting fixtures, ballasts, lenses, louvers, and baffles" whereas the Opponent's registration covers: "Electrical motor speed and temperature controls, voltage controls, lamp dimmers, gas discharge ballasts."

[40] The Applicant submits that the parties' wares and services "are legally different, namely lighting wares vs. electronic wares". The Applicant further submits that their channels of trade differ and that "there is no evidence to suggest that the competing wares are being sold side by side or even in the same retail establishment [sic]." I disagree with the Applicant's approach.

[41] It is not necessary that the parties operate in the same general field or industry or that their respective wares and services be of the same type or quality for there to be a likelihood of confusion. As stated in section 6(2) of the Act, confusion may occur "whether or not the wares or services are of the same general class".

[42] The Applicant's applied-for wares are either identical (with respect to the wares "ballasts") or closely related to those covered by the Opponent's LUTRON word mark registration. The Opponent's lighting controls, dimmers, and ballasts are all lighting related products. They are complementary to the Applicant's applied-for wares, as further illustrated by the following exhibits to the Saccomanno affidavit:

- The samples of packaging filed under Exhibit C, which indicate that the Opponent's dimmers "*work with DIMMABLE CFL & LED bulbs*" and also "*dim incandescent/halogen bulbs*" and further include photographs of compatible light bulbs; and
- The sample displays filed under Exhibit H, which display the Opponent's lighting controls and dimmers together with lighting fixtures.

[43] The Applicant's applied-for wares may be considered a natural extension of the Opponent's registered wares as further evidenced by the Saccomanno affidavit. As indicated above, Mr. Saccomanno's unchallenged testimony is to the effect that the Opponent's business has expanded over the years so as to include, in addition to light dimmers and switches, a broad

range of lighting products and related products in association with the LUTRON trade-mark such as ballasts, wall plates and accessories, lighting control systems, and lighting fixtures.

[44] It seems not unlikely that the parties' wares could be sold through the same or similar channels of trade. As indicated above, the Opponent's wares are sold both to individual consumers via third party outlets, as well as directly to electrical distributors and lighting showrooms.

[45] More particularly, Lutron Products are extensively offered to electrical distributors in Canada, who offer the products to their customers. There are approximately 753 electrical distributors of Lutron Products in Canada [para 15 of the Saccomanno affidavit]. Lutron Products are also sold to approximately 143 lighting showrooms/lighting specialty stores in Canada [para 16 of the Saccomanno affidavit]. In addition, Lutron Products are also offered to individual consumers through over 330 large established retail outlets across Canada [para 17 of the Saccomanno affidavit].

[46] In the absence of evidence to the contrary, there is no reason to conclude that the parties' wares would not travel through the same channels of trade and be directed to the same types of clientele.

[47] The Applicant's applied-for services are for the sale of lighting related products and overlap with the Opponent's wares. As put forward by the Opponent, it is not unrealistic to assume that the Opponent's Lutron Products could be sold in the Applicant's own retail outlets or wholesale channels. In fact, Mr. Saccomanno's unchallenged testimony is to the effect that the Applicant did itself purchase Lutron Products directly from the Opponent in the amount of approximately \$15,482 in 2010, and approximately \$18,312 up to September 2011 [para 29 of his affidavit].

[48] To sum up, I find that the overall consideration of the nature of the parties' wares and/or services and their corresponding trades favours the Opponent.

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

[49] There is a high degree of resemblance between the parties' marks in appearance, sound and in the ideas suggested by them.

[50] The parties' marks share strong similarities in that they are identical except for one letter (i.e. LUTRON vs. LITRON). They share the same structure in that they both consist of a two-syllable word. They are both coined words that convey no particular meaning in the context of their associated wares and/or services if not that the prefix "LIT" in the Mark suggests the word "light" whereas the prefix "LU" in the Opponent's trade-mark LUTRON suggests the word "lumen", that is a unit of light flow or luminous flux. Still, the idea arguably suggested by each of the marks is the same, namely that of luminosity.

Additional surrounding circumstances

Use of the Mark in combination with a "sun design"

[51] The Opponent submits that both parties use a "sun design" in combination with their respective marks.

[52] Relying on Exhibit J attached to the Saccomanno affidavit, which consists of a printout dated August 31, 2011 of the homepage of the Applicant's website located at <http://litroncanada.ca> accessed by Mr. Saccomanno, the Opponent argues that the Applicant uses a "sun design" adjacent to the Mark, as reproduced below:



[53] The Opponent submits that similarly, the Opponent uses its Sun Design trade-mark adjacent to the LUTRON trade-mark (as shown above in paragraph 26 of my decision), and has done so for many years.

[54] That being so, the Opponent submits that the use by the Applicant of a sun design in the exact same manner as the Opponent uses its Sun Design trade-mark demonstrates that the

Applicant has intentionally acted in a way likely to further increase the likelihood of confusion.

[55] The Applicant submits for its part that it can be plainly seen that the Applicant's use of a fanciful rendering of a light bulb is, on any analysis, not a use of any sun design. The Applicant further submits that the alleged use by the Applicant of non-applied for trade-mark or symbol is irrelevant to this proceeding. The Applicant submits that it is more likely that this irrelevant portion of the Opponent's evidence is solely intended to cast the Applicant in a bad light and to tarnish the credibility of the Applicant making it seem as if the Applicant is using the Opponent's Sun Design registration in the marketplace.

[56] I agree with the Applicant that it is not using a "sun design" *per se* in that one would interpret the referenced symbol as a light bulb and not a sun. However, the same finding may apply to the Opponent's Sun Design trade-mark. Indeed, the Opponent's Sun Design trade-mark may be interpreted as a fanciful rendering of a light source coming from either the sun or any artificial light sources, be it a light bulb or other.

[57] This surrounding circumstance may serve to illustrate the principle that registration of the word mark LITRON would permit use of the Mark in any size and with any style of lettering, color or design. As reminded in *Masterpiece, supra* at para 59 "a subsequent use that is within the scope of a registration, and is the same or very similar to an existing mark will show how that registered mark may be used in a way that is confusing with an existing mark".

[58] That said, I am not prepared to accord weight to this surrounding circumstance if only because the present proceeding is about registration of the word mark LITRON as opposed to a composite mark. I will return to that circumstance later on in my decision when considering the section 30(i) ground of opposition.

#### The examiner's decision

[59] The Applicant submits that the Mark was examined and allowed by the examination section of the Trade-marks Office having regard to, among others, the Opponent's registered mark. The Applicant submits that the examiner's decision is correct and ought to be given deference. However, a decision by the examination section of the Trade-marks Office is not

binding on this Board and does not have a precedential value for this Board given that the examination section does not have before it evidence that is filed by the parties in an opposition proceeding. Furthermore, the burden on an applicant differs whether the application is at the examination stage or at the opposition stage. Accordingly, I am not prepared to accord weight to this surrounding circumstance in the present case.

#### Google search

[60] As a further surrounding circumstance, I note that Mr. Saccomanno attaches as Exhibit K to his affidavit Internet printouts from the search engine Google showing search results for “litron dimmers” that returned “Lutron dimmers”. However, as pointed out by the Applicant, the search is in fact showing results for “Lutron dimmers”. The searcher was offered to click the “search instead for Litron Dimmers” which has not been done. Furthermore, as the Applicant is not applying to register the Mark for dimmers *per se* and as there is no evidence that the Applicant manufactures dimmers, I agree with the Applicant that there is no probative sense in searching for “Litron dimmers”. Accordingly, I am not prepared to accord weight to this surrounding circumstance.

#### Conclusion regarding the likelihood of confusion

[61] As indicated above, the issue is whether a consumer, who has a general and not precise recollection of the Opponent’s trade-mark LUTRON, will, upon seeing the Mark be likely to believe that their associated wares and/or services share a common source. I find this to be the case.

[62] As evidenced by the unchallenged testimony of Mr. Saccomanno, the Opponent is a pioneer manufacturer of lighting controls worldwide. It is a well-established company in the field of lighting controls and lighting products, including in Canada. Lutron Products have been sold in Canada for more than 40 years starting with dimmers and switches, and diversifying over the years so as to include various other lighting related products. While I acknowledge the differences existing between the exact nature of the Applicant’s applied-for wares and the wares covered by the Opponent’s registration, the fact remains that they are all lighting related products which are complementary to each other and may travel through the same channels of trade, as

further evidenced by the fact that the Applicant itself did purchase the Opponent's Lutron Products. Furthermore, the Applicant's applied-for wares could be considered a natural extension of the Opponent's registered wares, as evidenced by the Saccomanno affidavit. These circumstances combined with the striking resemblances existing between the trade-marks at issue shift the balance of probabilities in favour of the Opponent. Accordingly, the non-registrability ground of opposition succeeds.

[63] I wish to add that even if I had afforded more weight to the differences existing between the Applicant's applied-for wares and services and the Opponent's registered wares, I would have found that the balance of probabilities does not favour either of the parties. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion as to the source of the parties' wares and/or services in the consumer's mind, I would still have found against the Applicant.

The section 30 grounds of opposition

[64] The Opponent has pleaded two grounds of opposition under section 30 of the Act, namely that:

- The application does not conform to the requirements of section 30(b) and (e) of the Act in that it does not contain the date on which the Applicant has used the Mark in association with the applied-for wares and services and further, the Mark is not a proposed use trade-mark in that the Applicant had already commenced using the Mark prior to the filing date of the application as demonstrated by the fact that the Applicant corporation was registered August 10, 2009, and the Mark appears in the Applicant's trade-name; and
- The application does not conform to the requirements of section 30(i) of the Act in that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada for the wares and services set out in the application because at the date of filing its application it was aware of the prior adoption and use by the Opponent of the LUTRON and LUTRON & Design trade-marks covering lighting related wares.

[65] Each of these grounds can be summarily dismissed as follows:

The section 30(b) and (e) ground of opposition

[66] Relying on the Penney affidavit, the Opponent submits that it has adduced sufficient evidence to support the allegation that the Mark had been used by the Applicant prior to the filing date of the Applicant's proposed use application. More particularly, Mr. Penney attaches to his affidavit the following exhibits:

- Exhibit A: the corporate profile for the Applicant located by his search of Industry Canada's database for federally incorporated companies showing that the Applicant was incorporated on August 10, 2009; and
- Exhibit B: the WHOIS information for the Applicant's website *www.litroncanada.ca* showing that this domain name was registered on October 19, 2009.

[67] However, the mere registration of a corporate name does not constitute use of a trade-mark within the meaning of section 4 of the Act [see *Schwalb v Godbout* (1987), 15 CPR (3d) 532 TMOB]. The same is true of the mere registration of a domain name [see *Sun Media Corporation v The Montreal Sun (Journal Anglophone) Inc*, 2011 TMOB 15]. As a result, I find that the Opponent has failed to satisfy its initial evidentiary burden to put in issue the correctness of the claims set forth in the Applicant's proposed use application.

The section 30(i) ground of opposition

[68] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no such evidence in the present case.

[69] The mere fact that the Applicant may have been aware of the existence of the Opponent's trade-mark LUTRON at the time of filing the present application for the Mark does not preclude it from making the statement in its application required by section 30(i) of the Act. Furthermore, the printout from the Applicant's website attached as Exhibit J to the Saccomanno affidavit purporting to show the Applicant's use of a "sun design" in combination with the Mark in a fashion similar to that of the Opponent is dated August 31, 2011, that is *after* the filing date of

the Applicant's application, which is the material date to assess a section 30(i) ground of opposition [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

Remaining grounds of opposition

[70] As I have already found in favour of the Opponent under the non-registrability ground of opposition, I do not consider it necessary to address the non-entitlement and non-distinctiveness grounds of opposition revolving around the likelihood of confusion between the Mark and the Opponent's trade-marks LUTRON and LUTRON & Design or trade-name Lutron Electronics Co., Inc.

Disposition

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

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office