



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

**Citation: 2014 TMOB 176**  
**Date of Decision: 2014-08-26**

**IN THE MATTER OF AN OPPOSITION  
by Caterpillar Inc. to application  
No. 1,506,734 for the trade-mark Black  
Cat Conveyor Components in the name of  
Western Belting Ltd.**

[1] Western Belting Ltd. (the Applicant) filed application no. 1,506,734 for the trade-mark Black Cat Conveyor Components (the Mark) on December 6, 2010. The application (as amended) is based upon proposed use of the Mark in association with wares which are described as “idlers and pulleys used with conveyor belting to convey products” and services which are described as “distribution and sales of conveyor components”.

[2] Caterpillar Inc. (the Opponent) is the owner of several registrations and applications for trade-marks consisting of or incorporating the term CAT, including application No. 1,588,026 for the trade-mark CAT and registration No. TMA807,630 for the trade-mark CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN (shown below), both of which cover a variety of wares, including: “metal chains for hoisting objects, metal slings for loading and metal pulleys for hoisting objects”; “belts for machinery”; “conveyor belts”; “pulleys being parts of machines”; and “plastic pulleys for machines”.



[3] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* on December 19, 2012 and on February 19, 2013, the Opponent opposed it by filing a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[4] The Opponent has raised four grounds of opposition:

- i) the Mark is not registrable under section 12(1)(d) of the Act in that it is confusing with the Opponent's trade-mark CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN (registration No. TMA807,630);
- ii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act in that it is confusing with the Opponent's trade-mark CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN which is the subject of registration No. TMA807,630 and with its trade-mark CAT, which is the subject of application No. 1,588,026, both of which were used by the Opponent in Canada prior to the filing date of the application for the Mark ;
- iii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(c) of the Act in that it is confusing with the Opponent's trade-name CAT, which had been used by the Opponent in Canada prior to the filing date of the application for the Mark; and
- iv) the Mark is not distinctive within the meaning of section 2 of the Act in that it does not distinguish and is not adapted to distinguish the wares and services of the Applicant from those of the Opponent.

[5] For the reasons that follow, the opposition is successful.

#### Onus

[6] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

### Analysis

[7] At the outset, I wish to note that neither party requested an oral hearing in this matter and only the Opponent has filed evidence (the affidavit of Robert M. Robbins, sworn September 12, 2013) and a written argument. No cross-examination was held.

[8] I will now go on to address each of the four grounds of opposition.

### Sections 16(3)(a) – Entitlement

[9] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the provisions of section 16(3)(a) of the Act since at the filing date of the application, the Mark was confusing with the Opponent's trade-mark CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN which is the subject of registration No. TMA807,630 and with its trade-mark CAT, which is the subject of application No. 1,588,026, both of which were allegedly previously used in Canada by the Opponent.

[10] An opponent meets its evidential burden with respect to a section 16(3)(a) ground if it shows that its trade-mark had been used in Canada prior to the filing date of the application for the applicant's trade-mark and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act].

[11] The Robbins affidavit provides some background regarding the Opponent and its use of its trade-marks. In paragraph 1, Mr. Robbins states that he is the Commercial and Marketing Manager of the Caterpillar Conveyor Systems Product Group, Caterpillar Global Mining of the Opponent. At the time of swearing his affidavit, Mr. Robbins had held this position for over two years [Robbins affidavit, para 1]. Prior to that time, he held the same position with a company called Bucyrus International Inc. ("Bucyrus") [Robbins affidavit, para 1]. Bucyrus was acquired by the Opponent in July of 2011 [Robbins affidavit, para 1].

[12] According to the Robbins affidavit, the Opponent is engaged in the “manufacture, sale and distribution of a wide variety of vehicles, transporting devices, equipment and parts for a wide range of industries including mining, material handling, construction, demolition, oil and gas, forestry, paving and power generation” [Robbins affidavit, para 6].

[13] Mr. Robbins states that the Opponent itself and/or through licensees has continuously used its trade-marks CAT and CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN in association with belt terminal groups (conveyor drives, take-ups, loading sections, discharge assemblies, rollers, pulleys, idlers, bearings and frames) since “at least as early as September 20, 2011, if not earlier” [Robbins affidavit, paras 7 and 12].

[14] A Declaration of Use was filed in relation to the Opponent’s registration No. TMA807,630 on September 20, 2011 and the Opponent’s application No. 1,588,026 claims a date of first use “since at least as early as September 20, 2011”. In paragraph 21, Mr. Robbins states that prior to 2011, Bucyrus sold the same kind of wares. Although Mr. Robbins does not expressly say so, presumably, such sales occurred under Bucyrus’ own trade-mark and/or trade-name.

[15] Since the Opponent has not provided any definitive date of first use (other than September 20, 2011) and has not filed any evidence of use of its trade-marks which pre-dates the December 6, 2010 filing date of the application for the Mark, I must conclude that the Opponent has failed to meet its initial evidential burden in respect of this ground.

[16] The section 16(3)(a) ground of opposition is therefore unsuccessful.

#### Section 16(3)(c) – Entitlement

[17] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark under section 16(3)(c) of the Act in that it is confusing with the Opponent’s trade-name CAT, which had been previously used in Canada by the Opponent.

[18] An opponent meets its evidential burden with respect to a section 16(3)(c) ground if it shows that its trade-name was used prior to the filing date of the application for the applicant’s

trade-mark and had not been abandoned at the date of advertisement of the applicant's application [section 16(5) of the Act].

[19] As mentioned previously, Mr. Robbins states in his affidavit that the Opponent acquired Bucyrus in July of 2011 and commenced use of its trade-marks CAT and CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN in association with belt terminal groups (conveyor drives, take-ups, loading sections, discharge assemblies, rollers, pulleys, idlers, bearings and frames) "at least as early as September 20, 2011, if not earlier" [Robbins affidavit, paras 7 and 12]. However, Mr. Robbins' affidavit is silent with respect to when the Opponent commenced use of its trade-name CAT in connection with its business. The only reference to the Opponent's trade-name in the Robbins affidavit, is a brief statement that "each of Exhibits B to D show the use of CAT as a trade name" [Robbins affidavit, para 20].

[20] Exhibits "B-1"- "B-8" consist of copies of promotional brochures which show one or more of the Opponent's CAT trade-marks. Mr. Robbins states that these brochures are regularly distributed to dealers and consumers in Canada and are available to be downloaded from the Opponent's websites [Robbins affidavit, para 17]. The brochures are all undated, except for 2011 and 2012 copyright notices which appear at the end of each brochure.

[21] Exhibit "C" consists of presentation slides which show sample pictures of conveyor system equipment with the Opponent's CAT trade-marks marked thereon [Robbins affidavit, para 18]. Mr. Robbins states that these slides were distributed to the Opponent's dealers, regional sales teams and product groups during a presentation at Caterpillar Proving and Testing Facilities in March of 2013 in Tucson, Arizona [Robbins affidavit, para 18]. Since these materials were not circulated within Canada, I do not find the contents of Exhibit "C" to be of any assistance to the Opponent.

[22] Exhibit "D" consists of a DVD which Mr. Robbins states shows a video of the Opponent's conveyor systems and belt products and how they are used in mining applications. Mr. Robbins states that the video can be accessed on one of the Opponent's websites [Robbins affidavit, para 19]. The video featured on the DVD is undated, except for a 2012 copyright notice which appears at the end of the video.

[23] I query whether the use of CAT which is shown in Exhibits “B-1”-“B-8”, “C” and “D” constitutes use of a trade-name, as the references to CAT in these materials generally appear to be references to Opponent’s wares, rather than references to the Opponent or its business. However, it is unnecessary for me to decide this issue. Since the Opponent has not submitted any evidence which pre-dates the December 6, 2010 filing date of the application for the Mark, I must conclude that the Opponent has failed to meet its initial evidential burden in any event.

[24] The section 16(3)(c) ground of opposition is therefore unsuccessful.

#### Section 12(1)(d) - Registrability

[25] The Opponent has pleaded that the Mark is not registrable because it is confusing with its trade-mark CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN, which is the subject of registration No. TMA807,630.

[26] The material date to assess the section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[27] I have exercised my discretion and checked the register to confirm that the Opponent’s registration is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[28] As the Opponent’s evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between its trade-mark and the Opponent’s trade-mark.

[29] 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.

[30] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 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 [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

*Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known*

[31] The Opponent's trade-mark consists solely of the word CAT and a design component. Although CAT is a plain dictionary word, its meaning has no significance in relation to the Opponent's wares and I therefore consider the Opponent's trade-mark to possess a high degree of inherent distinctiveness. While CAT could be argued to be short form for the Opponent's corporate name, Caterpillar Inc., Mr. Robbins has not attested to this in his affidavit and there is no evidence to suggest that consumers would recognize it as being such as a matter of first impression in the marketplace.

[32] The Mark, which also contains the word "Cat" and which is intended for use in association with essentially the same wares as those which are covered in the Opponent's registration and related services, is also highly inherently distinctive. Although, it is arguably slightly less inherently distinctive than the Opponent's trade-mark in view of the fact that it also contains "Conveyor Components" which is somewhat descriptive of the Applicant's wares and services.

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

[34] The application for the Mark is based upon proposed use and the Applicant has not filed any evidence of use. By contrast, in the Robbins affidavit, Mr. Robbins states that the Opponent itself and/or through licensees has continuously used its trade-mark CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN in association with "belt terminal groups

(conveyor drives, take-ups, loading sections, discharge assemblies, rollers, pulleys, idlers, bearings and frames)” (the “Caterpillar wares”), since “at least as early as September 20, 2011, if not earlier” [Robbins affidavit, paras 7 and 12].

[35] In paragraph 13 of his affidavit, Mr. Robbins states that the Opponent manufactures, sells and/or distributes conveyor belt systems and belt products which are comprised of various components, the major components of which include the frame, motor, pulley and bearings. Mr. Robbins further states that other components of a belt terminal group include drives which run the conveyor belts, take-up and storage units to apply slack removal and responsive belt tension, tail sections to accept loads from a variety of haulage equipment and idlers and rollers on which the conveyor belt runs [Robbins affidavit, para 13].

[36] Mr. Robbins states that the Opponent’s belt terminal systems are used for transporting materials and are used in material handling and mining applications. He explains that the belt terminal systems may be used underground or above ground to handle, transport and convey materials [Robbins affidavit, para 15].

[37] Mr. Robbins states that the Opponent’s trade-mark is prominently displayed on the Caterpillar wares [Robbins affidavit, para 16].

[38] Attached as Exhibits “B-1” to “B-8” are copies of brochures showing pictures of some of the Caterpillar wares [Robbins affidavit, para 17]. Mr. Robbins states that the wares shown in the pictures in the brochures are examples of ways in which the Opponent’s trade-marks are actually displayed on its wares [Robbins affidavit, para 17]. Exhibits “B-1” to “B-8” have been described as follows:

1. Exhibit B-1: Belt Systems & Belt Products brochure;
2. Exhibit B-2: Engineered Belt Terminal Groups brochure;
3. Exhibit B-3: Pre-engineered Belt Terminal Groups brochure;
4. Exhibit B-4: Engineered Class Conveyor Pulleys brochure;
5. Exhibit B-5: Surface Belt Structure – CEMA C&D Series brochure;
6. Exhibit B-6: Underground Belt Structure – CEMA C & D Series brochure;



7. Exhibit B-7: Underground Belt Structure – Flex PAL™ Series (CEMA C & D) brochure; and
8. Exhibit B-8: High Capacity AFC Systems brochure.

[39] I note that there is a discrepancy between the manner in which Mr. Robbins has described the wares in association with which the Opponent has used its trade-mark (i.e. the Caterpillar wares) and the manner in which the wares have been described in the Opponent's registration. I also note that the wares which are shown in Exhibits "B-1" to "B-8" appear in most instances to be fully assembled products or systems, rather than component parts.

[40] In the absence of any cross-examination or submissions on these points on the part of the Applicant, I am prepared to accept Mr. Robbins' sworn statement that the Opponent's trade-mark is prominently displayed on the Caterpillar wares and that the pictures of the Caterpillar wares which are shown in the brochures featured in Exhibits "B-1" to "B-8" are representative of the way in which the Opponent's trade-mark is displayed on the Caterpillar wares [Robbins affidavit, paras 16 and 17]. I am also prepared to accept that the use of the Opponent's trade-mark which appears on at least some of the wares which are shown in Exhibits "B-1" to "B-8" is representative of use of its trade-mark in association with wares which fall within the scope of those which are covered in its registration No. TMA807,630. For example, Mr. Robbins indicates that the Opponent's trade-mark appears on "the belt terminal group, the frame, pulley and on the side of the bearing or plastic cover that is used to keep contaminants out of the bearing on the pulley" [Robbins affidavit, para 16] and the Opponent's registration No. TMA807,630 specifically covers "pulleys being parts of machines", "plastic pulleys for machines" and "metal pulleys for hoisting objects". To the extent that Mr. Robbins has not made specific reference in his affidavit to some of the wares which are covered in the Opponent's registration No. TMA807,630 (for example, "conveyor belts"), I consider such wares to be closely related to those which he has specifically identified in his affidavit and which are covered in the Opponent's registration (for example, the "pulleys").

[41] I also note that the trade-marks shown in Exhibits "B-1" – "B-8" differ slightly from the Opponent's registered trade-mark. However, the differences are slight. Accordingly, I consider such use to constitute use of the Opponent's registered trade-mark [*Canada (Registrar of Trade*

*Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)].

[42] Attached as Exhibit “C” to Mr. Robbins affidavit are slides showing sample pictures of conveyor system equipment with the Opponent’s trade-marks affixed to and marked on the equipment [Robbins affidavit, para 18]. Mr. Robbins states that the slides were distributed at a presentation which took place in Tucson, Arizona in March of 2013 [Robbins affidavit, para 18]. Although these slides do provide some further background on the nature of the Opponent’s wares, they do not assist the Opponent in establishing any reputation in its trade-mark in Canada, as the materials were circulated only within the United States.

[43] Exhibit “D” to Mr. Robbins’ affidavit consists of a DVD which Mr. Robbins states contains a video showing how the Opponent’s conveyor systems and belt products are used in mining applications. Mr. Robbins states that the video is also accessible on the Opponent’s website [Robbins affidavit, para 20]. However, he does not provide any information regarding how many Canadians have accessed and viewed the video.

[44] In paragraph 21 of his affidavit, Mr. Robbins provides sales figures for sales of the Caterpillar wares by Bucyrus (from 2008- 2011) and by the Opponent (2011-2012), in Canada. Sales in 2011 amounted to \$320,000 USD and sales in 2012 amounted to \$265,000 USD. It is unclear what portion of the 2011 sales was attributable to Bucyrus and what portion was attributable to the Opponent. There is also no indication that Bucyrus’ sales were made in association with the Opponent’s trade-mark.

[45] Mr. Robbins states that the Opponent manufactures, sells and/or distributes the Caterpillar wares to authorized dealers and directly to consumers. The authorized dealers also sell to consumers in Canada and to second level distributors [Robbins affidavit, para 22]. At the time of swearing of the Robbins affidavit, the Opponent had licensees or authorized dealers for most of the provinces and territories in Canada [Robbins affidavit, para 23].

[46] Mr. Robbins states that the Opponent’s dealers also offer the Opponent’s Caterpillar wares on their own websites [Robbins affidavit, para 25]. Attached as Exhibits “E” and “F” are printouts of pages from two of the Opponent’s dealers’ websites showing Caterpillar wares

including “underground mining belt systems, surface mining belt systems and longwall systems including armoured face conveyor drives and armoured face conveyor line pans” (Exhibit “E”) and “belt systems, pulleys and longwall systems” (Exhibit “F”). There is no indication as to how many Canadians have viewed these websites or purchased the Caterpillar wares through them.

[47] Based on the foregoing, I can conclude that the Opponent’s trade-mark CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN has become known in Canada to a greater extent than the Mark.

*Section 6(5)(b) – the length of time each has been in use*

[48] The application for the Mark is based upon proposed use and the Applicant has not filed any evidence of use of the Mark. This factor therefore favours the Opponent, as it has evidenced some use of its trade-mark.

*Sections 6(5)(c) and (d) – the nature of wares, services or business and trade*

[49] When considering sections 6(5)(c) and (d) of the Act, it is the statement of wares and services in the application for the Mark and the statement of wares in the Opponent’s registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [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)].

[50] The statement of wares in the Opponent’s registration covers “metal chains for hoisting objects, metal slings for loading and metal pulleys for hoisting objects”; “belts for machinery”; “conveyor belts”; “pulleys being parts of machines”; and “plastic pulleys for machines”. The application for the Mark covers wares which are described as “idlers and pulleys used with conveyor belting to convey products” and services which are described as “distribution and sales of conveyor components”. There is therefore direct overlap in some of the parties’ wares and others are closely related. The Opponent’s wares are also closely related to the Applicant’s services.

[51] The Applicant has not filed any evidence regarding the nature of its business or normal course of trade. However, in view of the fact that the parties' wares overlap and the Applicant's services are closely related to those wares, it is reasonable to conclude that their channels of trade would also overlap.

[52] The sections 6(5)(c) and (d) factors therefore also favour the Opponent.

*Section 6(5)(e) – degree of resemblance between the trade-marks*

[53] “While the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it.” [*United Artists Corp v Pink Panther Beauty Corp* 1998 CanLII 9052 (FCA), (1998), 80 CPR (3d) 247 (FCA) at 263] In *Masterpiece*, the Supreme Court observed that even though the first word of a trade-mark may be the most important, for the purpose of distinctiveness [see *Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)], the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[54] Given that “Conveyor Components” is somewhat descriptive of the wares which are associated with the Mark, I find the word “Cat” to be the aspect of the Mark that is particularly striking or unique. The word “Black” (a color reference), which appears before “Cat” serves to modify or place further emphasis on “Cat”. The Opponent's trade-mark consists of the word CAT, along with a simple and not particularly striking design component. Accordingly, I find that the word CAT is also the most unique component of the Opponent's trade-mark. The Mark therefore incorporates the entirety of the most distinctive part of the Opponent's trade-mark.

[55] There are differences between the parties' trade-marks in appearance, sound and suggested idea (to the extent that “Conveyor Components” in the Mark describes the Applicant's wares and these words are not present in the Opponent's trade-mark). However, due to the presence of the distinctive element CAT, I find that when one considers the parties' trade-marks as a whole and as a matter of first impression, there is some degree of resemblance between them.

### *Surrounding Circumstances*

#### *The Opponent's Family of CAT Trade-marks*

[56] In its statement of opposition and in its written argument, the Opponent made reference to the fact that the Opponent owns a family of other CAT trade-marks, in addition to CAT (application No. 1,588,026) and CAT & TRIANGLE MACHINE BODY HORIZONTAL DESIGN (registration No. TMA807,630). The trade-marks in question are identified in the Robbins affidavit [Robbins affidavit, para 11].

[57] I note that an opponent must evidence use of the members of an alleged family of trade-marks in order for the benefits of a family to apply [see *Ultramar Ltd v Gold Eagle Co* 2011 TMOB 149 at para 26]. As the Opponent has not done so in the present case, it cannot rely on any cumulative effect of its CAT trade-marks.

#### *Conclusion on the Likelihood of Confusion*

[58] Having considered all of the surrounding circumstances, I find that the balance of probabilities is evenly balanced between a finding of confusion between the trade-marks in issue and a finding of no confusion. I have come to this conclusion because on the one hand, there are some differences in resemblance between the parties' trade-marks, but on the other hand, the Applicant has incorporated the whole of the most distinctive and dominant part of the Opponent's trade-mark into the Mark. The Opponent has an inherently distinctive trade-mark which it has started to use and promote in Canada and the Applicant has not established any reputation in association with its Mark and proposes to use it in association with wares and services which directly overlap with or are closely related to the Opponent's wares. In addition, such wares and services would likely be offered through the same channels of trade. As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with the Opponent's trade-mark, I must decide against the Applicant.

[59] I wish to add that had there been state of the marketplace and/or state of the register evidence put forward to suggest that CAT is a common component of trade-marks which are

used in association with wares and services which are similar to those of the parties, my decision may have been different.

[60] The section 12(1)(d) ground of opposition is therefore successful.

## Section 2 – Distinctiveness

[61] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[62] In order to meet its evidential burden, the Opponent is under an obligation to show that, as of the date of filing of the statement of opposition, one or more of its trade-marks had become known sufficiently to negate the distinctiveness of the Mark. The reputation of the Opponent's trade-marks should be substantial, significant or sufficient [*Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[63] I am not satisfied that the Opponent has met its burden for the following reasons.

[64] In his affidavit, Mr. Robbins states that the Opponent began using its trade-marks "since at least as early as September 20, 2011, if not earlier" [Robbins affidavit, para12]. Since Mr. Robbins has not provided any evidence to support any use prior to September 20, 2011, I am not prepared to infer that use commenced any earlier than on that date. Thus, at the time of filing of the statement of opposition, namely, February 19, 2013, the Opponent had been using its trade-marks for less than a year and a half.

[65] According to Mr. Robbins' affidavit, the Opponent had \$320,000 USD in sales in 2011 and \$265,000 USD in sales in 2012 [Robbins affidavit, para 21]. There is no indication in the Robbins affidavit as to the cost of the Opponent's wares, how many were sold in association with its trade-marks as at the material date or where in Canada they were sold. Given the nature of the Opponent's wares, one would not expect them to be inexpensive. Based upon the evidence which has been provided, it is impossible to know whether the Opponent had a few sales or

many in the years of 2011 and 2012. Moreover, it is likely that at least some of the 2011 sales were attributable to Bucyrus, since the Opponent did not acquire Bucyrus until July of 2011 and it did not commence use of its trade-marks in association with the relevant wares until sometime thereafter [Robbins affidavit, paras 1, 12 and 21].

[66] Although there is some information regarding how the Opponent's wares are advertised and promoted in association with its trade-marks via the Opponent's websites, its dealers' websites and through the distribution of brochures, Mr. Robbins has not provided any circulation data for its brochures or any information pertaining to how many hits the websites have received from Canadians as of the material date [Robbins affidavit, paras 17 to 19 and 25 to 27]. Moreover, no figures for annual advertising or promotional expenditures have been provided.

[67] In view of the foregoing, I am unable to conclude that the reputation in the Opponent's trade-marks was substantial, significant or sufficient as of the material date. I therefore find that the Opponent has not met its initial burden in relation to its non-distinctiveness ground of opposition.

[68] Accordingly, this ground of opposition is unsuccessful.

#### Disposition

[69] In view of the foregoing, 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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Lisa Reynolds  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office