



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

Citation: 2011 TMOB 71
Date of Decision: 2011-04-20

**IN THE MATTER OF AN OPPOSITION by
Specialized Bicycle Components, Inc. to
application No. 1,333,379 for the trade-mark
GLOBE CLAIRS Design in the name of
Goodbaby Child Products Co., Ltd.**

[1] On January 31, 2007, Goodbaby Child Products Co., Ltd. (the Applicant) filed an application to register the trade-mark GLOBE CLAIRS Design shown below (the Mark) based upon proposed use of the Mark in Canada in association with the following wares, as revised:

globe clairs

Baby strollers; baby carriages (prams); bicycles; covers for baby carriages; electric vehicles, namely, electric bicycles; infant car seats; invalid wheelchairs; luggage trucks; motorcycles; pumps for bicycles; pushchairs; rollators (vehicles for old people); safety seats for children and babies for vehicles for transport by land, air and water; shopping trolleys; tires for vehicles; trailers and semi-trailers for bicycles; tricycles; tricycles for children; baby trolleys; bassinets; furniture chests; bakers' bread baskets; bouncers namely rocking chair for babies; cots; cribs; cradles: cushions, namely, bed and chair cushions; crib mattresses; non-electric fans for personal use; bed fittings, namely, casters; furniture, namely, decorative wall plaques (not textile), cupboards, benches, medicine cabinets, bassinets, wooden bedsteads, bottle racks, sideboards, desks, office furniture, costume stands, chairs, easy chairs, furniture head-rests, hat stands, display stands, coat hangers, shelves for filing cabinets, counters, tables, mattresses, tea carts, computer trolleys, and chest of drawers; high chairs for babies; infant walkers; locks, namely, door locks; glass-form mirrors, namely, hand held mirrors, table top mirrors and wall mounted

mirrors for household use; playpens for babies; picture frames; pillows, namely, bed and cervical pillows (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 9, 2008. As pointed out by the Applicant in its letter dated February 1, 2008 addressed to the Registrar, there was a typographical error in the statement of wares as advertised in that the wares described as “trailers and semi-trailers” should have read “trailers and semi-trailers for bicycles” in line with the statement of Wares, as last amended on September 18, 2007.

[3] On August 8, 2008, Specialized Bicycle Components, Inc. (the Opponent) filed a statement of opposition claiming that the application does not conform to the requirements of s. 30(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The statement of opposition also claims that the Mark is not registrable pursuant to s. 12(1)(d) and 38(2)(b) of the Act, that it is non-distinctive of the Applicant pursuant to s. 38(2)(d) of the Act, and that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) and 38(2)(c) of the Act in view of the fact that the Mark is confusing with the trade-mark GLOBE of the Opponent, previously registered under No. TMA464,705 and used in Canada by the Opponent in association with bicycles and structural parts therefor.

[4] The Applicant filed and served a counter statement in which it denies the Opponent’s allegations.

[5] In support of its opposition, the Opponent filed the affidavit of Larry Koury, Managing Director of Specialized Canada, Inc. (Specialized Canada), the Canadian subsidiary of the Opponent, sworn March 13, 2009, as well as a certified copy of registration TMA464,705 for the Opponent’s GLOBE trade-mark. In support of its application, the Applicant filed the affidavits of Sandro Romeo, a trade-mark searcher in the employ of Thomson CompuMark, sworn July 15, 2009, and Lisa Saltzman, director of the trade-mark searching department with Onscope, a division of Marque d’or Inc., also sworn July 15, 2009. The Opponent further filed, as reply evidence, the affidavit of Kimberly Arca, Intellectual Property Manager for the Opponent, sworn August 7, 2009.

[6] Only the Opponent filed a written argument. Neither party requested an oral hearing.

Onus and relevant dates

[7] 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 evidentiary burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]. The presence of an onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant [see *John Labatt supra*].

[8] The relevant dates for considering the circumstances in regard to each of the grounds of opposition in the instant proceeding are the following:

- Ground based on s. 30(a) of the Act: generally, the material date for considering grounds of opposition based on s. 30 of the Act is the date the application was filed. However, when an application has been amended to conform to ordinary commercial terms in response to a preliminary report by the Examiner, as in the instant case, the amended application date (in this case September 18, 2007) will be considered as the material date for considering grounds of opposition that are based on s. 30(a) [see *Eaton Williams (Millbank) Ltd. v. Nortec Air Conditioning Industries Ltd.* (1982), 73 C.P.R. (2d) 70 (T.M.O.B.)];
- Ground based on s. 12(1)(d) of the Act: the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Grounds based on s. 16(3)(a) of the Act: the date the application was filed; and
- Ground based on non-distinctiveness of the Mark: generally accepted as being the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Analysis

Section 30(a) ground of opposition

[9] The Opponent has pleaded that the application does not comply with the requirements of s. 30(a) of the Act because the wares described as “tires for vehicles; baby trolleys; benches; bottle racks; sideboards; costume stands; display stands; counters” do not constitute descriptions of the specific wares as they are customarily referred to in the trade.

[10] More particularly, the Opponent submits in its written argument that the descriptions “tires for vehicles”; “baby trolleys”; “benches”; “bottle racks”; “sideboards”; “costume stands”; “display stands”; and “counters” each cover a countless number of different devices for a variety of unrelated practical applications directed to entirely disparate target markets. The Opponent submits that the aforementioned terms have no commonly understood commercial meaning and are thus too broad and unspecific to constitute a description of the specific wares as they are customarily described in the trade. The Opponent further submits that the broadness and ambiguity of these descriptions are compounded by the fact that the Applicant has not specified the industry or trade to which the descriptions apply.

[11] It is true that some of these terms could, in isolation, refer to a number of different devices for a variety of applications. However, relying on the guidelines and representative listing of wares and services contained in CIPO’s *Trade-marks Wares and Services Manual* (the Manual), I find that each of the aforementioned terms can be considered as an acceptable identification of wares.

[12] More particularly, I note that the wares “tires for vehicles” fall under the category of wares “tires”, which is listed as acceptable as such in the Manual. The term “benches”, which is listed under the category of wares “furniture” in the Applicant’s application, is also listed as acceptable as such in the Manual. The Manual further specifies that such entry reflects the most commonly understood meaning of benches, i.e., furniture. When such is not the case, the Manual expressly provides for further specificity, like for instance “exercise benches”, “park benches”,

“work benches”, etc. Adopting similar reasoning, I find that the terms “bottle racks”, “sideboards”, “counters”, “costume stands” and “display stands”, which are also listed under the category of wares “furniture” in the Applicant’s application, refer to items of household furniture. I further note that an analogy can be made between the wares “bottle racks” and the wares “bottle stands”, “spice racks”, “wine racks”, etc., listed as acceptable as such in the Manual.

[13] As for the wares “baby trolleys”, the Opponent submits that they could refer to a medical trolley for newborns used in a hospital or to a recreational pram or stroller for consumer use. Considering the context of the Applicant’s statement of wares, I am of the view that such term is to be understood as a recreational pram or stroller for consumer use. I further note that the Opponent itself, through the Koury affidavit (discussed below), uses the term “baby trolleys” to describe some of the wares sold by its authorized retailers. I therefore consider the description “baby trolleys” to be an ordinary commercial term.

[14] Accordingly, the s. 30(a) ground of opposition is dismissed on the basis that the Opponent has not satisfied its evidentiary burden.

Section 12(1)(d) ground of opposition

[15] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with the Opponent’s trade-mark GLOBE, registered on October 25, 1996 under No. TMA464,705 in association with “bicycles and structural parts therefor”.

[16] As indicated above, the Opponent has provided a certified copy of such registration. I have exercised the Registrar’s discretion to confirm that it is in good standing as of today’s date.

[17] 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 the Mark and the Opponent’s GLOBE trade-mark.

[18] 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.

[19] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time 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; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

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

[20] The parties' marks are inherently distinctive, not describing any particular feature of their respective goods.

[21] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. There is no evidence that the Applicant's proposed use Mark has been used in Canada or that it has become known to any extent whatsoever in Canada. By contrast, the Opponent has evidenced that its mark has been used and become known at least to some extent in Canada, as per my review below of Mr. Koury's affidavit.

[22] The Opponent was founded in the United States of America in 1974 and today produces a

full range of high-end and entry-level road bicycles, mountain bicycles, commuter/city bicycles, children's bicycles, and BMX bicycles. The Opponent also offers an extensive line of bicycle accessories, including but not limited to helmets, water bottles, jerseys, tires, and shoes [Koury affidavit, paragraphs 2 and 3].

[23] Specialized Canada is a wholly-owned subsidiary of the Opponent, and is the sole distributor of the Opponent's bicycles in Canada. Specialized Canada sells the Opponent's bicycles to consumers in Canada through authorized retailers, of which there are currently over 180 nationwide [Koury affidavit, paragraphs 4, 5, 11 and 12].

[24] Specialized Canada sells a variety of bicycles under the GLOBE mark in Canada. The GLOBE line of bicycles are comfortable, easy-to-use, commuter-style bicycles, suitable for the casual cyclist or consumer. The mark is placed prominently on the frame of each GLOBE bicycle [Koury affidavit, paragraphs 7, 8 and 17; Exhibit A - copy of the 2009 GLOBE bicycles catalogue].

[25] Bicycles bearing the Mark have been sold in Canada from as early as 1996 to 2001 and from 2006 to the present. The total wholesale value of sales of the GLOBE line of bicycles in Canada since 1996 has been in excess of \$2.5 million CAD, which represents in excess of 6000 units sold. Since 2006, the total wholesale value of sales has been in excess of \$2 million CAD, which represents in excess of 5000 units sold [Koury affidavit, paragraphs 9 and 10; Exhibit B – Summary of sales].

[26] The Opponent and Specialized Canada have advertised and promoted the GLOBE line of bicycles to Canadian consumers in a variety of ways, including i) through consumer catalogues featuring the GLOBE line of bicycles which are distributed by Specialized Canada to authorized retailers in Canada for subsequent distribution to consumers; and ii) the Opponent's website *www.specialized.com*. In 2008, approximately 28000 consumer catalogues were so distributed. For each of the years 1994-1999, and 2007 approximately 20000 consumer catalogues were distributed [Koury affidavit, paragraphs 15 to 18; Exhibit A; Exhibit C – copies of extracts from the Opponent's consumer catalogues from 1994-1999 and 2007-2008; Exhibit E – copies of

pages from the Opponent's website that describe the GLOBE line of bicycles for 2009].

[27] Authorized retailers also promote the GLOBE line of bicycles to consumers by displaying of GLOBE bicycles in stores, and purchasing advertising space in magazines [Koury affidavit, paragraph 18; Exhibit F – specimen of advertisement by authorized dealer in the Spring 2009 issue of Velo Mag, a Canadian cycling publication which has distribution of 16500 for each issue].

[28] The Opponent and Specialized Canada have also actively promoted the Opponent's bicycles, including the GLOBE line of bicycles, to retailers in Canada [Koury affidavit, paragraphs 20 and 21; Exhibit D – extracts from the Opponent's Dealer Books from 1994-1997, 1999 and 2007-2009; Exhibit G – copy of extracts from the business-to-business website *www.specialized.ca*].

[29] The Opponent and Specialized Canada have also promoted the GLOBE line of bicycles as a practical and environmentally friendly form of transportation at various conferences in Canada such as the 2008 Toronto Green Living Show [Koury affidavit, paragraph 22; Exhibit H – copies of photographs taken from the 2008 Toronto Green Living Show].

[30] Authorized retailers in Canada, in addition to selling bicycles, typically also sell a variety of bicycle-related accessories such as bicycle tires, pumps for bicycle tires, water bottles and water bottle cages, electronics for bicycles such as lights and computers, and bicycle trailers for young children. A number of authorized retailers also sell tricycles, electric bicycles, conversion kits, baby trolleys and athletic running carriages for children [Koury affidavit, paragraph 13].

[31] While the evidence of use of the GLOBE registered trade-mark provided by the Opponent in this proceeding does not establish continuous use of the GLOBE mark in Canada in association with bicycles and structural parts therefor since the date of the declaration of use of the mark filed by the Opponent in 1996, the sales figures provided for the years 1996 to 2001 and 2006 to 2009 together with the statements of facts and exhibits discussed above, support the Opponent's contention that its GLOBE mark has been used for a considerable length of time and

become known in Canada in association with bicycles and structural parts thereof.

[32] To conclude, the overall consideration of this first factor favours the Opponent.

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

[33] For the reasons given above, this factor also favours the Opponent.

(c) The nature of the wares, services or business; and (d) the nature of the trade

[34] When considering the nature of the wares and services and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the Opponent's registration [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. 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 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); and *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[35] I agree with the Opponent that there is a clear overlap in respect of the wares described in the Applicant's application as: "bicycles"; "electric vehicles, namely, electric bicycles"; "pumps for bicycles"; "safety seats for children and babies for vehicles for transport by land"; "tires for vehicles"; "trailers and semi-trailers for bicycles"; "tricycles"; and "tricycles for children" and the Opponent's bicycles and structural parts thereof. In the absence of evidence to the contrary, it is fair to assume that these particular wares of the Applicant are likely to be sold to Canadian consumers in the same or similar types of retail establishments as those of the Opponent. As per my review of the Koury affidavit above, authorized retailers, in addition to selling bicycles, typically also sell a variety of bicycle-related accessories such as bicycle tires, pumps

for bicycles, and bicycle trailers for young children.

[36] That said, and except for the wares described as “baby trolleys” discussed below, the remainder of the Applicant’s wares share no resemblance or connection with the Opponent’s wares. They have a different nature and purpose. They are not complementary nor in competition with each other. As such, it is fair to assume that their channels of trade also differ.

[37] As for the wares described as “baby trolleys” in the Applicant’s application, the Opponent submits that the Koury affidavit evidences that a number of the Opponent’s authorized retailers in Canada also sell baby trolleys and athletic running carriages for children. The Opponent submits that it appears likely that the Applicant’s wares will be sold in retail establishments that are similar to the Opponent’s authorized retailers. In these circumstances, the Opponent submits that the likelihood of confusion is increased. As there is no evidence from the Applicant to suggest otherwise, and given Mr. Koury’s sworn testimony, I am prepared to conclude that the Applicant’s wares described as “baby trolleys” could be sold in the same type of retail establishments as those of the Opponent that sell baby trolleys and athletic running carriages for children. In the absence of evidence pertaining to the exact nature of the Applicant’s baby trolleys and their corresponding channels of trade, it may be that these particular wares of the Applicant could consist of baby trolleys designed for sport or recreation, as jogging strollers/trolleys and bicycle trailers for children are. As such, they could be perceived as a natural extension of the Opponent’s wares.

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

[38] It is a well accepted principle that the first portion of a trade-mark is generally the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union Des Éditions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) and *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 (F.C.T.D.)]. This results in the marks having a relatively high degree of resemblance.

[39] Indeed, as submitted by the Opponent, both marks convey the idea of the English or French dictionary meaning for “globe”. While the Mark adds the French word “clairs” (the dictionary meaning of which is “brightness” or “light”), I do not consider such addition sufficient in the circumstances to distinguish the Mark from the Opponent’s mark. There is nothing about the word CLAIRS that detracts from the significance of the word GLOBE in the first portion of the Mark.

[40] It is worth reproducing below the remarks made by Mr. Justice Cattanach in *Conde Nast Publications Inc. v. Union des Éditions Modernes*, (1976) 46 C.P.R. (2d) 183 (F.C.T.D.) at 188, where the opponent/appellant owned the mark MADEMOISELLE and the applicant applied to register MLLE AGE TENDRE:

In *J. B. Stone & Co., Ltd. v. Steelace Mfg. Co. Ltd.* (1929), 46 R.P.C. 406, Lawrence, L.J., said at p. 418 that it was no answer for a person to say:

Oh, yes, we use the whole of your trade mark, but we are using it in such a way as we consider will not cause deception or interfere with your trade.

He continued to say:

In my opinion such an answer affords no defence to an action by a registered owner of a trade mark whose mark is being used by a rival trader upon or in connection with the goods of the latter for whatever purpose it may be so used.

This, in my view, is precisely what the respondent has done. It has appropriated the appellant's mark in its entirety and added thereto as a suffix the words "age tendre". It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction. Here the first and most important word in the mark which the respondent seeks to register is identical to the mark registered by the appellant.

If there is doubt whether the registration of a trade mark would cause confusion with a prior mark the doubt must be resolved against the newcomer. In this instance the result is that the doubt must be resolved in favour of the appellant.

[41] The Koury affidavit evidences that the GLOBE line of bicycles includes different models. I agree with the Opponent that in the particular circumstances of this case, consumers aware of the Opponent’s GLOBE line of bicycles could believe that a GLOBE CLAIRS bicycle, for example, is a particular model of the Opponent’s bicycles.

Additional surrounding circumstances

State of the register evidence

[42] The Applicant submitted evidence of the state of the register by way of the Saltzman affidavit. State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[43] More particularly, Ms. Saltzman attaches as Exhibit LS the results of a trade-mark search she performed on July 15, 2009 for the word GLOBE and/or the design of a globe on the Canadian trade-marks register for use in association with bicycles. The results of this search included, among others, the following:

- Trade-mark application No. 1,252,766 for GLOBESAVERS; and
- Trade-mark application No. 1,399,963 for GLOBERIDE Design.

[44] As pointed out by the Opponent, other than the Applicant's application for the Mark and the Opponent's registration of the trade-mark GLOBE, the two results noted above were the only applications or registrations located by Ms. Saltzman which incorporated the word GLOBE in association with bicycles or related accessories. The other trade-mark applications or registrations located by Ms. Saltzman pertained to trade-marks featuring various stylised representations of what has been indexed by CIPO as a "terrestrial globe". I note that, in all instances, the so-called "globe" design element is combined with a prominent word portion. More importantly, none of these design marks comprises the word GLOBE *per se*. As such, I

find the relevancy of these other marks arguable in the present case and am not prepared to afford them any significant weight.

[45] The Opponent submits that the mere existence of the two above-identified pending applications is not persuasive on the issues of the inherent distinctiveness of the Opponent's trade-mark GLOBE or the likelihood of confusion between the Opponent's mark and the Mark. I agree.

[46] Furthermore, there is no evidence that any of these marks has been used in Canada. I note in this regard that each of application Nos. 1,252,766 and 1,399,963 for the trade-marks GLOBESAVERS and GLOBERIDE Design respectively is based upon proposed use of the mark. This brings me to comment on the Arca affidavit.

[47] As indicated above, the Arca affidavit was filed as reply evidence. According to Rule 43 of the *Trade-marks Regulations*, SOR/96-195, such evidence must be strictly confined to matters in reply. I am satisfied that it does.

[48] More particularly, Ms. Arca states in her affidavit that the Opponent subscribes to a trade-mark watch service, which monitors third party applications which are published for opposition purposes in jurisdictions of concern to the Opponent, including Canada. In particular, the Opponent monitors third party applications which incorporate the Opponent's main brands such as applications incorporating GLOBE in respect of bicycles [Arca affidavit, paragraph 2].

[49] Ms. Arca then discusses in detail the status of the aforementioned application Nos. 1,252,766 and 1,399,963. As I have already found the mere existence of these two applications not persuasive in the present case, it is not necessary for me to discuss further Ms. Arca affidavit.

[50] To conclude, I find that the overall consideration of the state of the register evidence is of no significance to the Applicant's case.

Coexistence of the parties' marks

[51] The Applicant submitted evidence that the parties' marks are both registered on the respective trade-marks registers of Germany, Spain and Japan, by way of the Romeo affidavit. However, as stressed by the Opponent, the fact that the marks may coexist on foreign trade-marks registers is not binding upon the Registrar. It is worth referring to the following observation from this Board in *Quantum Instruments Inc. v. Elinca S.A.* (1995), 60 C.P.R. (3d) 264 (*Quantum*):

As yet a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of registrations obtained by both parties in Great Britain and in the United States of America for the trade-marks QUANTA and QUANTUM. However as noted ... in *Re Haw Par...*, little can be drawn from the fact that the trade-marks at issue coexist in other jurisdictions ... the Registrar must base [the] decision on Canadian standards, having regard to the situation in Canada. Further, in *Sun-Maid* ... [the court] pointed out that 'no significance can be attached to failure to oppose or object to registrations in other jurisdictions since such actions, of necessity, have their basis entirely in foreign law and procedure.' Additionally, while the applicant has relied upon evidence of coexistence of the trade-marks at issue on the registers in Great Britain and the United States of America, no evidence has been adduced of the coexistence of the trade-marks at issue in the market-place in either of these countries... Accordingly, I do not consider this evidence to be persuasive in this proceeding. [my emphasis]

[52] As in the *Quantum* case, no evidence has been adduced of the coexistence of the trade-marks at issue in the marketplace, be it in Canada or in any other country.

[53] Furthermore, as noted by the Opponent in its written argument, if I were to give consideration to the fact that the parties' marks coexist on the trade-marks registers in the above-mentioned countries, I should give the same consideration to the fact that the Opponent has successfully opposed the Applicant's European Community trade-mark application No. 5,642,236 for the Mark in association with essentially identical wares to the present application. The Opposition Division of the Office for Harmonization for the Internal Market (O.H.I.M.) rejected the application in respect of "bicycles; electric vehicles; motorcycles; pumps for bicycles; safety seats for children and babies for vehicles for transport by land; tires for vehicles; tricycles; tricycles for children". For the reasons outlined above in the *Quantum* case, it

is unnecessary to comment further on this latter decision of the O.H.I.M. as well as the coexistence of the parties' marks on foreign trade-marks registers.

Conclusion regarding the likelihood of confusion

[54] As indicated above, the issue is whether a consumer who has a general and not precise recollection of the Opponent's mark, will, upon seeing the Mark be likely to believe that their associated wares share a common source.

[55] In view of my findings made above, I find that the Applicant has failed to satisfy its burden that there is not a reasonable likelihood of confusion between the marks in issue in respect of the Applicant's wares described as: "bicycles"; "electric vehicles, namely, electric bicycles"; "pumps for bicycles"; "safety seats for children and babies for vehicles for transport by land"; "tires for vehicles"; "trailers and semi-trailers for bicycles"; "tricycles"; "tricycles for children"; and "baby trolleys" and the Opponent's bicycles and structural parts thereof.

[56] As for the remaining wares covered by the Applicant's application, I find that the differences existing between the said wares and those of the Opponent, and their respective channels of trade are sufficient to preclude a likelihood of confusion.

[57] Accordingly, the s. 12(1)(d) ground of opposition based upon the likelihood of confusion between the Opponent's mark and the Mark succeeds partially.

Non-distinctiveness ground of opposition

[58] The Opponent has pleaded that the Mark is not distinctive within the meaning of s. 2 of the Act in that it does not distinguish and is not adapted to distinguish the Applicant's Wares from the wares of the Opponent sold in association with the trade-mark GLOBE.

[59] An opponent meets its evidentiary burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition its trade-mark had become known to some extent at

least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D)]. The Opponent has met this burden.

[60] Because the difference in relevant dates does not substantially affect my analysis above under the s. 12(1)(d) ground of opposition, I find that the non-distinctiveness ground of opposition succeeds with respect to the wares described as “bicycles”; “electric vehicles, namely, electric bicycles”; “pumps for bicycles”; “safety seats for children and babies for vehicles for transport by land”; “tires for vehicles”; “trailers and semi-trailers for bicycles”; “tricycles”; “tricycles for children”; and “baby trolleys”.

Section 16(3)(a) ground of opposition

[61] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(3)(a) of the Act in that at the date of filing of the application, the Mark was confusing with the Opponent’s registered trade-mark GLOBE, which had been previously used in Canada by the Opponent and continue to be so used.

[62] An opponent meets its evidentiary burden with respect to a s. 16(3)(a) ground if it shows that as of the date of filing of the Applicant’s application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the Applicant’s application [s. 16(5) of the Act]. The Opponent has met this burden.

[63] Because the difference in relevant dates does not substantially affect my analysis above under the s. 12(1)(d) ground of opposition, I find that the s. 16(3)(a) ground of opposition succeeds with respect to the wares described as “bicycles”; “electric vehicles, namely, electric bicycles”; “pumps for bicycles”; “safety seats for children and babies for vehicles for transport by land”; “tires for vehicles”; “trailers and semi-trailers for bicycles”; “tricycles”; “tricycles for children”; and “baby trolleys”.

Disposition

[64] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application in respect of the wares described as “bicycles”; “electric vehicles, namely, electric bicycles”; “pumps for bicycles”; “safety seats for children and babies for vehicles for transport by land”; “tires for vehicles”; “trailers and semi-trailers for bicycles”; “tricycles”; “tricycles for children”; and “baby trolleys”, and I reject the opposition with respect to the remainder of the wares, pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) as authority for a split decision].

Annie Robitaille
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