



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

Citation: 2011 TMOB 161
Date of Decision: 2011-09-08

**IN THE MATTER OF AN OPPOSITION
by Caterpillar Inc. to application
No. 1,292,989 for the trade-mark
SUPACAT in the name of Supacat
Limited**

[1] On March 9, 2006, Supacat Limited (the Applicant) filed an application to register the trade-mark SUPACAT (the Mark) based on use of the Mark since at least as early as 1989.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 11, 2007. The statement of wares at that time read: wheeled military vehicles; off-road vehicles, namely all-terrain vehicles; trailers; vehicles for use in transporting and launching boats; parts and fittings for all the aforesaid goods.

[3] On May 22, 2007, Caterpillar Inc. (the Opponent) filed a statement of opposition.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations. It also amended its statement of wares to read: wheeled all-terrain vehicles for military use; vehicles for transporting and launching boats; parts and fittings for the aforesaid goods.

[5] In support of its opposition, the Opponent filed the affidavit of Terry G. Sharp, its World Wide Manager, Solutions and Services, Global Paving. The Applicant elected to not file any evidence and it did not cross-examine Mr. Sharp. It did however further amend its statement of

wares to read: wheeled all-terrain vehicles for military use, but not including any vehicles fitted with digging equipment; vehicles for use in transporting and launching boats; parts and fittings for the aforesaid goods.

[6] Only the Opponent filed a written argument. An oral hearing was not held.

Onus

[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 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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Likelihood of Confusion

[8] All of the grounds of opposition turn on the issue of the likelihood of confusion between SUPACAT and two trade-marks owned by the Opponent, namely CAT and CATERPILLAR. I will begin my assessment of the likelihood of confusion by considering the registrability ground of opposition insofar as it is based on the Opponent's trade-mark CAT registered under No. TMA205,367.

Registrability Ground based on Registration No. TMA205,367

[9] The Opponent has pleaded that the Mark is not registrable by virtue of s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) because it is confusing with the Opponent's mark CAT registered under No. TMA205,367 for, *inter alia*, all terrain vehicles, transporting devices, parts and fittings for the above.

[10] The material date for assessing a s. 12(1)(d) ground is today's date [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]. The Opponent's initial burden is met if its registration is extant. I have exercised the Registrar's discretion to check the Register and confirm that registration No. TMA205,367 is extant.

[11] 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.

[12] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in 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 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. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

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

[13] Both parties' marks are inherently distinctive.

[14] A trade-mark may acquire distinctiveness by becoming known through use or promotion. There is no evidence that the Applicant's Mark has acquired distinctiveness. In contrast, there is evidence that the Opponent's CAT mark has further increased its distinctiveness through use and promotion. In particular, Mr. Sharp has provided substantial evidence showing use of the CAT mark on the Opponent's wares since at least as early as 1986 through to 2007, as well as promotion of its wares in association with the CAT mark (Exhibits B1 through B35 and C-1 through C-29). Mr. Sharp also indicates that there have been substantial Canadian sales of, as well as substantial money spent promoting, its wares. Although none of the figures have been broken down by mark and the advertising figures are for the U.S. and Canada combined, overall the evidence still supports a conclusion that the extent to which the marks have become known favours the Opponent.

length of time each trade-mark has been in use

[15] This factor also favours the Opponent since the Opponent claims use of its CAT mark in Canada since 1948 and Mr. Sharp provides evidence of its use in Canada since at least 1986.

nature of the wares, services, business or trade

[16] Mr. Sharp attests that the Opponent's business includes the manufacture, sale, distribution and provision of a wide variety of vehicles, transporting devices, equipment, parts and related accessories and services for use in various fields. He adds that the Opponent's wares "are extensively used in various fields including, without limitation, in the fields of military and defence, marine, construction, excavation, road construction, demolition, tunnel construction, quarrying, forestry and foundries." He further attests that the Opponent's customers include both civilian and military organizations.

[17] The Opponent's wares are sold and promoted through authorized dealers. In 1989, the Opponent had 78 authorized dealer locations in Canada, with dealers located in every province and territory. When Mr. Sharp signed his affidavit in 2008, the Opponent had 107 authorized dealer locations.

[18] The statement of wares in the Opponent's registration No. TMA205,367 for CAT reads:

(1) Engines, transmissions, gears, speed reducers, marine gears, trucks, tractors, all terrain vehicles, material handling machines and vehicles, lifting and transporting devices, fork lift trucks, straddle carriers, loaders, pipelayers, log skidders, tree harvesters, snow removing equipment, winches, bulldozers, earthmovers, wagons, scrapers, graders, compactors, excavators, back hoes, bearings, hardware, track links, track shoes, track pins, track bushings, cutting edges, bits, tooth groups, generators.

(2) Batteries, lights, lamps, fuses, electrical cables, conduits, fasteners and terminals, switches, starting systems, spark plugs, spark plug firing indicators, signal systems, flashers, alarms, buzzers, horns, gauges, meters, windshield wipers, seat belts.

(3) Mud flaps, hose, hose couplings, tires, vee belts, link belts, filters.

(4) Grease, oil and lubricants, adhesives, rust inhibitors.

(5) Hand tools.

[19] Although the Applicant has not provided us with any information concerning its wares, business or channels of trade, Mr. Sharp has provided print outs of certain pages from *www.supacat.com* dated 9/29/2008 (Exhibit E). These pages refer to the Applicant and provide information concerning that party's products. No objection has been raised with respect to the admissibility of Exhibit E and while I appreciate that evidence of a third party's website is not evidence of the truth of its contents, it seems to me that a different conclusion is appropriate where the owner of the website, being a party, has the opportunity to refute the evidence being tendered. Thus, I am inclined to take note that according to Exhibit E, the Applicant's SUPACAT ware is "a multi purpose all terrain utility platform" which is promoted for both military and civilian use. Regarding the civilian market, the website reads:

Civilian and military specification Supacats are very much the same, the only difference being the equipment fitted to them.

Many of the 'extras' such as Ramps, Winches, Bilge Pumps used are common to both.

A wide range of extras are available to enable the vehicle to be suited to any specific application, which include:

Electricity Supply Industry, Film location transport, Air Crash Recovery, Fire Fighter, Beach Rescue, Flotation Kit, Forestry and Estate Management.

[20] As the parties provide similar types of wares and their clientele overlap, I conclude that a consideration of the nature of the wares, services, business and trade favours the Opponent. I note that I would have reached the same conclusion even without consideration of Mr. Sharp's Exhibit E.

degree of resemblance between the trade-marks

[21] "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), 80 C.P.R. (3d) 247 (F.C.A.) 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 C.P.R. (2d) 183 (F.C.T.D.)], 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.

[22] Given that the prefix “supa” is evocative of the laudatory word “super”, I find that the suffix “cat” is the aspect of the Mark that is particularly striking or unique.

[23] In its written argument, which predated the decision in *Masterpiece*, the Opponent submitted that the prefix “supa” makes the Applicant’s Mark “suggestive of a super or superior product or super ‘cat’.” I agree. It also submitted that because “supa” is the non-distinctive, suggestive element of the Mark, the average consumer would focus on the distinctive “cat” element of the Mark. This reasoning is in line with that taken by the Supreme Court in *Masterpiece*.

[24] I conclude that, although there are some differences between the parties’ marks in appearance and sound, the ideas suggested are very similar and overall the degree of resemblance between the marks as a whole is quite high.

conclusion re registrability ground based on registration No. TMA205,367

[25] All of the surrounding circumstances favour the Opponent. The Applicant has done nothing to satisfy its legal burden. Accordingly, the s. 12(1)(d) ground of opposition succeeds based on registration No. TMA205,367.

Distinctiveness Ground

[26] The Opponent has pleaded that the Mark when used in association with the Applicant’s wares is not distinctive within the meaning of s. 2 of the Act since it neither distinguishes or is adapted to distinguish the Applicant’s wares from the Opponent’s wares.

[27] The material date for assessing a distinctiveness ground is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[28] In order to meet its initial burden with respect to this ground, the Opponent must establish that the marks upon which it relies were known to some extent at least in Canada as of May 22, 2007 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) and *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)]. The Opponent has evidenced that its CAT mark was sufficiently known as of that date.

[29] In the circumstances of this case, nothing turns on the date at which the issue of confusion is determined. The distinctiveness ground therefore succeeds based on the Opponent's CAT mark for the reasons set out in my discussion of the registrability ground of opposition.

Remaining Grounds

[30] As I have already refused the application under more than one ground, I see no need to rule on the remaining grounds of opposition.

Disposition

[31] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application, pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office