



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

**Citation: 2015 TMOB 211**  
**Date of Decision: 2015-11-30**

**Fuchs Petrolub AG** **Opponent**

**and**

**Castrol Limited** **Applicant**

**1,539,442 for the trade-mark TITANIUM** **Application**  
**FLUID STRENGTH TECHNOLOGY**

[1] On August 11, 2011, Castrol Limited filed an application to register the trade-mark TITANIUM FLUID STRENGTH TECHNOLOGY (the Mark) on the basis of its proposed use in association with the following Goods (as amended). The application has a convention priority date of March 4, 2011.

Lubricants for motor vehicles; automotive lubricants; lubricating oils for motor vehicles; non-chemical additives for fuels and lubricants; gear oils; transmission oils

The application was advertised for opposition purposes in the *Trade-marks Journal* of June 27, 2012.

[2] On August 27, 2012, Fuchs Petrolub AG (the Opponent) filed a statement of opposition. Leave to amend the statement of opposition was subsequently granted and the grounds of opposition are as follows:

- (a) The application does not comply with section 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the Applicant could not have been satisfied that it was entitled to use the Mark having regard to the registration and use in Canada of the Opponent's TITAN trade-mark in association with motor and engine oils, hydraulic fluids and transmission fluids, given that use of the Mark will contravene sections 19, 20 and 22.
- (b) The Mark is not registrable, pursuant to section 12(1)(d) of the Act, because it is confusing with the Opponent's registration No. TMA483,384 for TITAN.
- (c) The Applicant is not the person entitled to registration of the Mark, pursuant to section 16(3)(a) of the Act, because at the date of filing, the Mark was confusing with the Opponent's previously used trade-mark TITAN.
- (d) The Mark is not distinctive in that it does not distinguish and it is not adapted to distinguish the Goods of the Applicant from those of the Opponent having regard to the registration and use by the Opponent of its TITAN trade-mark.

[3] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[4] The Opponent filed as its evidence the affidavit of Christian Bigelow, Vice President – Legal of Fuchs Lubricants Co. which is owned by a wholly owned subsidiary of the Opponent. The Applicant filed as its evidence the affidavits of Ian Hutchinson, National Brand Manager, Castrol, employed by the Applicant's exclusive licensee in Canada and Richard Goddard, Trade Mark Counsel for BP p.l.c., the parent company of the Applicant.

[5] Both parties filed a written argument and attended a hearing.

### Material Dates and Onus

[6] While various grounds of opposition are pleaded, the determinative issue for decision is whether the Mark is confusing with the Opponent's trade-mark TITAN. The earliest material date to assess the issue of confusion is the priority date of the application while the latest material date is the date of my decision: for a review of material dates in opposition proceedings see *American Assn of Retired Persons v Canadian Assn of Retired Persons* (1998), 84 CPR (3d) 198 (FCTD) at 206-208 (FCTD) and sections 16 and 34 of the Act.

[7] Before considering the issue of confusion between the parties' marks, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[8] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against it.

### Section 12(1)(d) Ground of Opposition

[9] I will first begin by considering the Opponent's section 12(1)(d) ground of opposition. The Opponent has pleaded that the Mark is not registrable as it is confusing with its registered trade-mark set out below:

**Registration No.      Trade-mark      Registered Goods**

TMA483,384    TITAN            (1) Motor oils. (2) Motor and engine oils.

[10] I have exercised my discretion and checked the Register to confirm that this registration is extant. Therefore, the Opponent has met its initial burden with respect to this ground.

*When are Trade-marks Confusing?*

[11] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act, shown below:

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 goods or services associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the goods or services are of the same general class.

[12] Thus, section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's lubricants, additives, gear and transmission oils sold under the mark TITANIUM FLUID STRENGTH TECHNOLOGY would believe that those goods were provided or authorized or licensed by the Opponent who offers its motor and engine oils under the mark TITAN. The legal onus is on the Applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

*Test for Confusion*

[13] In assessing confusion as set out in section 6(2) of the Act, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or

sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

#### *Inherent Distinctiveness*

[14] The Opponent's trade-mark is inherently distinctive. The word titan means, in part, a person resembling Titan, the sun god in great stature, physical strength, intellectual power, and does not appear to bear a direct connection to the Opponent's registered goods (definition from the *Shorter Oxford English Dictionary on Historical Principles (6th ed)* attached as Exhibit K to Mr. Bigelow's affidavit). The inherent distinctiveness of the Mark is diminished by the fact that it suggests Goods which includes titanium. In this regard, I note that the evidence is that the Applicant's motor oil includes liquid titanium molecules (Hutchison affidavit, Exhibits 2-3).

#### *Extent Known and Length of Time in Use*

[15] These factors favour the Opponent. The Opponent's TITAN trade-mark appears on bottles of motor oil which has been sold in Canada since 1997 (Bigelow affidavit, para 7, Exhibit C). The Opponent's TITAN products sold in Canada are manufactured under the Opponent's control in Germany by its licensee (Bigelow affidavit, para 6). From 2009-2012, the yearly sales of TITAN products increased from over 115,000 L to over 400,000 L (Bigelow affidavit, para 9). In contrast, Mr. Hutchinson states that the Applicant's CASTROL EDGE motor oils have been sold, advertised or promoted in association with the trade-mark TITANIUM FLUID

STRENGTH TECHNOLOGY in Canada, by its licensee under the Applicant's control, since at least as early as 2012 and sales have exceeded hundreds of thousands of litres in 2012 (Hutchinson affidavit, paras 6-9). I note, however, that Mr. Hutchinson's evidence does not show the Mark on the Applicant's Goods themselves as opposed to on promotional material.

*Nature of the Goods and the Trade*

[16] This factor favours the Opponent as the goods of each party appear to be identical. The Opponent's TITAN motor oils and gear oils are used for a variety of purposes including premium performance in vehicles with automatic transmissions, power steering, CVT gear boxes, and hydraulic drives (Bigelow affidavit, Exhibit G). The Applicant's evidence is that its motor oil promoted in association with the Mark contains a patented liquid titanium molecule that increases motor oil strength (Hutchinson affidavit, Exhibits 2-3). As the goods of the parties appear identical and there is no restriction in either the application or the Opponent's registration, it is possible the goods could travel through the same channels of trade and even at the same stores even though at this time the extent of overlap is not clear (see the descriptions of the channels of trade in the Bigelow affidavit, at para 8; and Hutchinson affidavit, at para 8).

*Degree of Resemblance Between the Trade-marks*

[17] In *Masterpiece Inc, supra*, the Supreme Court of Canada indicates that the most important factor under section 6(5) of the Act will often be the degree of resemblance between the marks. Although the Mark begins with the word TITANIUM which incorporates the whole of the Opponent's trade-mark, I find that it significantly differs in appearance and sound due to the other elements (FLUID STRENGTH TECHNOLOGY). Confusion will be unlikely in situations where marks share common features but also feature dominant differences such that the differences are a sufficient signal to the public that the products associated with each mark have different sources [see *Foodcorp Ltd v Chalet Bar B Q (Canada) Inc* (1982), 66 CPR (2d) 56 at 73 (FCA)]. The Opponent's focus on the individual parts of the Mark that are the same as its mark, appears to involve a side-by-side comparison of the type warned against by the courts [*Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée supra*; *International Stars SA v Simon Chang Design Inc*, 2013 FC 1041 at para 9]. Furthermore, the parties' trade-marks cannot be

said to suggest the same idea to the ordinary consumer. The Mark suggests the very specific idea of a technologically advanced fluid containing titanium. While the Opponent's trade-mark does suggest the idea of strength or power due to the definition of TITAN, it does not suggest a fluid containing the element titanium.

*The Word Titanium is Derived From Titan*

[18] Mr. Bigelow attaches to his affidavit the definitions for titan and titanium from the *Shorter Oxford English Dictionary on Historical Principles (6th ed)* (Bigelow affidavit, Exhibit K). The entry for titanium notes that the origin of this word is "TITAN + -IUM, after uranium" and defines titanium as follows:

A chemical element, atomic no. 22, which is one of the transition metals, occurring naturally in various clays and other minerals and used to make strong, light, corrosion-resistant alloys (symbol Ti).

The Opponent also relies on the definitions attached to its written argument for titan and titanium in the *Canadian Oxford Dictionary (2<sup>nd</sup> ed)* set out, in part, below [see *Tradall S.A. v Devil's Martini Inc.* (2011), 92 CPR (4th) 408 (TMOB) at para. 29 confirming that I can take judicial notice of dictionary definitions].

Titan	... a person or organization of very great power, importance, or strength ...
titanium	... a grey metallic element occurring naturally in many clays etc. and used to make strong light alloys that are resistance to corrosion

The Opponent submits that the fact that both TITAN and TITANIUM suggest strength increases the likelihood of confusion. While some consumers may recognize that the root of TITANIUM is the word TITAN, the evidence does not show that as a matter of first impression without such detailed analysis consumers would find that the trade-marks evoke the same ideas.

### *Decisions and Registrations In Foreign Jurisdictions*

[19] The Applicant provides evidence regarding the registration of the Mark in other countries, as well as decisions dismissing the Opponent's opposition to registration in various countries. I do not find this evidence a relevant surrounding circumstance since the registration of the Mark in other countries may be dependent on a completely different factual or legal context than the one in Canada.

### *No Evidence of Actual Confusion*

[20] Mr. Hutchison states in his affidavit that he is not aware of any instances of confusion between Castrol Edge ITANIUM FLUID STRENGTH TECHNOLOGY products and the Opponent's TITAN products (Hutchison affidavit, para 15). Given the short period of time the Mark has been in use, the absence of instances of confusion to date is not surprising. Therefore, I do not find Mr. Hutchinson's evidence on this point to be a relevant surrounding circumstance.

### *Conclusion*

[21] I conclude that, on a balance of probabilities, given all the surrounding circumstances there is not a reasonable likelihood of confusion. The differences between the marks are sufficient to make confusion unlikely.

### Section 30(i) Ground of Opposition

[22] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied it was entitled to use the Mark because such use would have the effect of infringing or depreciating the goodwill of the Opponent's TITAN registration in violation of sections 19, 20 and 22 of the Act. Neither the Registrar, nor the Federal Court has ruled on whether a section 30(i) ground of opposition based on the violation of these sections is a valid ground of opposition [see, for example, *Parmalat Canada Inc v Sysco Corp* 2008 FC 1104, (2008), 69 CPR (4th) 349 (FC) at paras 38-42 which discusses a ground of opposition based on sections 30(i) and 22 of the Act]. Even if I found this to be a valid ground of opposition, as the Opponent has failed to adduce evidence supporting a likelihood of depreciation of goodwill [see *Veuve Clicquot*



*Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23, (2006), 49 CPR (4th) 401 (SCC) at paras 46, 63-68] or a violation of sections 19 or 20 of the Act such that I could find that use of the Mark is unlawful [*Sunbeam Products, Inc v Mister Coffee Services Inc* (2001), 16 CPR (4th) 53 (FCTD) at para 18], it would have no chance of success. Accordingly, this ground of opposition is rejected.

#### Section 2 and 16 Grounds of Opposition

[23] Although the material dates for the section 16 and distinctiveness grounds of opposition fall earlier than today's date, the different dates do not result in a different outcome. In view of my findings in paragraph 15 of this decision, the Opponent has met its initial burden for each of these grounds. The Applicant, however, has also met its legal onus because there is no likelihood of confusion for the reasons set out in the discussion of the section 12(1)(d) ground. Therefore, the section 16(3)(a) and distinctiveness grounds are rejected.

#### Disposition

[24] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Hearing Date: 2015-07-28

Appearances

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For the Opponent

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For the Applicant

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