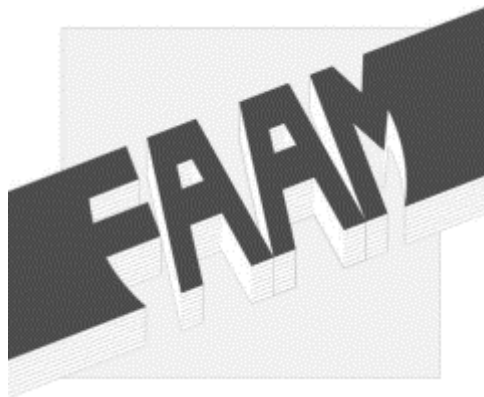


LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 251
Date of Decision: 2012-12-20

IN THE MATTER OF AN OPPOSITION
by Fabbrica Italiana Accumulatori
Motocarri Montecchio F.I.A.M.M. S.p.A
to application No. 1,358,935 for the trade-
mark FAAM & Design in the name of
FAAM S.P.A.

[1] On August 7, 2007, FAAM S.P.A. (the Applicant) filed an application to register the trade-mark FAAM Design (the Mark) set out below.



[2] The application was filed on the basis of the Applicant's use of the Mark since at least as early as June 2007 in Canada with the following wares (as amended):

Acidulated water for recharging batteries for automobiles, for bikes, for cameras, for cellular phones, for hearing aids, for watches; acidulated water for recharging accumulators, anti-frothing solutions for batteries for automobiles, for bikes, for

cameras, for cellular phones, for hearing aids, for watches; fluids for removing sulphate from electric batteries for automobiles, for bikes, for cameras, for cellular phones, for hearing aids for watches; battery jars, acidimeters for batteries, batteries for automobiles, bikes, cameras, cellular phones, hearing aids and watches; rechargers for automotive, bike, camera and cellular phone batteries, grids for batteries, batteries for vehicles, automotive battery chargers, bike battery chargers, camera battery chargers, telephone battery chargers; electric accumulators for automobiles, buses, taxis, dump trucks, golf buggy; fuel cell; electric vehicles; electric cars; bicycles; motorcycles; electric engines for automobiles, buses, taxis, dump trucks, golf buggy. (the Wares).

The application was advertised for opposition purposes in the *Trade-marks Journal* of June 25, 2008.

[3] On November 25, 2008, Fabbrica Italiana Accumulatori Motocarri Montecchio F.I.A.M.M. S.p.A. (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) contrary to section 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Applicant has not used the Mark in association with the Wares since at least as early as June 2007;
- (b) contrary to section 30(i) of the Act, the Applicant could not have been satisfied it was entitled to use the Mark in Canada with the Wares as the Applicant was aware of the Opponent's FIAMM & Design trade-mark;
- (c) contrary to section 12(1)(d) of the Act, the Mark is not registrable because it is confusing with registration No. TMA225,583;
- (d) contrary to section 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the claimed date of first use in Canada by the Applicant, the Mark was confusing with the trade-mark FIAMM & Design of the Opponent previously used or made known in Canada with the wares Horns for vehicles; ignition coils; electrical parts for cars and motorcycles, namely relays; and storage batteries; and
- (e) contrary to section 2 of the Act, the Mark is not distinctive of the Applicant.

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

[5] In support of its opposition, the Opponent filed the affidavit of Alexandre Caron. Mr. Caron was cross-examined and the transcript was filed. In support of its application, the Applicant filed the affidavits of Gianluca Statti (one affidavit sworn August 31, 2010; one affidavit sworn October 27, 2010), Marianne G. Smith, Lesley Gallivan and a certified copy of registration No. TMA556,552 for FAAM Design (set out below) and the section 45 decision in respect of this registration. The Opponent filed a written argument and both parties attended a hearing held on December 6, 2012.



Onus and Material Dates

[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].

[7] The material dates with respect to the grounds of opposition are as follows:

- sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

- sections 38(2)(b)/12(1)(d) of the Act - 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)];

- sections 38(2)(c)/16(1) of the Act – the date of first used alleged in the application;
and

- sections 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Preliminary Evidence Issue

[8] Alexandre Caron, an employee of a company related to the agent for the Opponent (cross-examination of Mr. Caron, Qs 5-8), includes in his affidavit the following:

- details of an Internet search for FIAMM through which he “discovered that the FIAMM Group, which is a single enterprise owns, FIAMM Technologies, L.L.C. in America” (para 6);
- details of contact with Canadian Tire’s head office where he was informed that they have sold products under the FIAMM trade-mark for over a decade (para 13);
- a catalogue of horns manufactured by FIAMM and invoices for horns issued to Canadian Tire (Exhibits H and I);
- details of contact with a Ferrari dealer in Ontario where he was informed that FIAMM batteries are original equipment on Ferrari and Maserati cars and that replacement batteries are available (para 17); and
- a copy of a brochure located on the Internet by Mr. Caron showing what companies and products use FIAMM automotive batteries as original equipment (Exhibit J).

[9] The content of Mr. Caron’s affidavit set out above is hearsay and there is no evidence setting out why it was necessary for him to provide such evidence, nor any evidence concerning its reliability. In these circumstances, I am not prepared to find this evidence admissible albeit with diminished weight [*R v Khan*, [1990] 2 SCR 531 (SCC); *Gowling Lafleur Henderson LLP v Guayapi Tropical* (2012), 104 CPR (4th) 65 (TMOB) at paras 7-9].

Section 30 Grounds of Opposition

[10] The Opponent pleads that the application is contrary to sections 30(b) and 30(i) of the Act.

section 30(b) ground of opposition

[11] The Opponent alleges that the application contravenes section 30(b) of the Act since the Applicant had not used the Mark in association with each of the Wares since the date claimed.

[12] To meet its evidential burden, the Opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support the ground exist [*John Labatt Ltd, supra*]. The Opponent's burden is, however, lighter with respect to the issue of non-compliance with section 30(b) because the facts supporting no use of the Mark are particularly within the knowledge of the Applicant [*Tune Masters v Mr. P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89].

[13] In support of this ground of opposition, the Opponent first relies on Internet printouts obtained by Mr. Caron which demonstrate “that the Applicant appears to be active in the marketplace as a manufacturer and supplier of automotive batteries thus shifting the burden to the Applicant to demonstrate that it has used the Mark in Canada since at least as early as June 2007” (Opponent’s Written Argument, para 45). Such evidence is not sufficient to meet the Opponent’s burden since it does not lead to the inference that the trade-mark was not in use with the Wares as of the date claimed.

[14] The Opponent also relies on the certified copy of the decision in the section 45 proceeding concerning registration No. TM556,552 owned by the Applicant in which the registration was maintained for most registered wares. At the time of the section 45 decision, this registration included the following wares: Battery jars, acidimeters for batteries, batteries, apparatus for recharging batteries, namely battery chargers and acid refilling equipment; grids for batteries, plates for batteries, batteries for vehicles. In this decision, the Registrar states the following:

- (at para 10) “In his affidavit, Mr. Vitali attests that the Registrant manufactures and has sold each of the registered wares bearing the [registered mark] in Canada, since at least as early as 2008”.
- (at para 20) “... it is true that a variation of the [registered mark] appears on the invoices ... and on the products depicted in the brochures ... The trade-mark as used however, differs solely in that the letters F and M have been slightly embellished.”

[15] I do not find that the certified copy of the decision and the statements of the Registrar summarized above are sufficient to meet the Opponent's burden. First, there is no evidence that the variation of the registered mark is the Mark. While the Registrar will check the status of a registration relied upon in the statement of opposition is, the Registrar will not exercise its discretion to check other documents or files at the Trade-marks Office [*Broadway Sound Plus Ltd v M & K Stereo Plus Ltd* (1984), 3 CPR (3d) 410 (TMOB) at 412]. Second, it is not clear that the statement that the Registrant has manufactured and has sold each of the registered wares bearing the registered mark since at least as early as 2008 leads to the inference that the June 2007 date in the subject application is inaccurate.


[16] Accordingly, this ground of opposition is rejected as the Opponent has not met its burden.

section 30(i) ground of opposition

[17] The section 30(i) ground of opposition may be summarily dismissed since the Applicant has provided the statement required by section 30(i), and this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); *Multi-Marques Inc v Gesfor Aktiengesellschaft* (2008), 74 CPR (4th) 15 (TMOB) at 19]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, this ground of opposition is rejected.

Section 12(1)(d) Ground of Opposition

[18] I have exercised my discretion and checked the register to confirm that the registration relied on by the Opponent for its FIAMM Design trade-mark, set out below, is extant [*Quaker Oats Co Ltd 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.

Registration No.	Trade-mark	Wares
TMA225,583		(1) Horns for vehicles. (2) Horns for vehicles; ignition coils; electrical parts for cars and motorcycles, namely relays; and storage batteries (the Opponent's Wares).

[19] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment, 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.

[20] These criteria 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 and extent known; length of time in use

[21] The Opponent's FIAMM Design trade-mark and the Mark have a similar degree of inherent distinctiveness as neither are dictionary words and both appear in a stylized format. I consider both to be relatively weak marks which consist of a combination of letters or initials

[*Alfred Grass Gesellschaft mbH Metallwarenfabrik v Grant Industries Inc* (1991), 47 FTR 231 (FCTD)].

[22] Trade-marks may acquire distinctiveness by becoming known through use or promotion. Given my finding that Mr. Caron's evidence regarding the Opponent's use of its FIAMM Design mark in Canada is inadmissible, there is no evidence that the Opponent's mark has acquired any distinctiveness. Although Mr. Caron visited a Canadian Tire and located FIAMM brand horns, the fact that these horns were for sale in a single Canadian Tire (Q 192-195) does not lead to the conclusion that they were known to any significant extent.

[23] Likewise, there is no evidence that the Mark has been in use in Canada. I note that any findings the Registrar made in the section 45 proceeding are not evidence of use in the subject opposition. Each opposition decision before the Registrar must be decided on its own merits having regard to the evidence submitted in the particular case, which may differ from the evidence adduced in a prior case involving the same parties [*Sunny Crunch Foods Ltd v Robin Hood Multifoods Inc* (1982) 70 CPR (2d) 244 (TMOB) at 249.]

[24] Finally, while the Opponent's registration and the subject application are based on use, this only entitles me to assume *de minimis* use [*Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that a mark has become known to any significant extent, nor that the marks have necessarily been used continuously since the date stated. Therefore, these factors favour neither party.

degree of resemblance

[25] In considering the degree of resemblance, the Supreme Court of Canada in *Masterpiece*, supra sets out that the approach to assessing resemblance should involve a consideration of whether there is an aspect of a trade-mark that is particularly striking or unique (para 64). I find the striking features of both parties marks to be the same, specifically, that they are both short coined words consisting of initials beginning with a F and ending with a M, have a duplicated letter and are stylized in a thick block letter format. As such, I find that the trade-marks have a very high degree of resemblance in appearance and significant resemblance when sounded.

Furthermore, there is nothing in the evidence leading to a finding that the trade-marks suggest different ideas to consumers.

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

[26] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under section 12(1)(d). These statements must be read with a view to determining the probable type of business or trade intended by the parties [*Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB) at 98-99]. I find the wares described as “electrical parts for cars and motorcycles, namely relays; and storage batteries” are somewhat ambiguous as it could be interpreted that the registration covers storage batteries generally or that the registration only covers storage batteries for cars and motorcycles. As the Opponent has not filed any evidence of use and the statement of wares was selected by the Opponent, I conclude that the Opponent’s registration should be interpreted as covering only storage batteries for cars and motorcycles [*Panzani Milliat Frères, SA v Vago's Importers & Distributors Ltd* (1988), 19 CPR (3d) 463 at 466 (TMOB)].

[27] The Opponent submits that the Applicant and the Opponent operate in the same field. Mr. Caron’s affidavit includes the following:

- A print-out from the *www.jgdarden.com* web-site of the “Battery Manufacturers and Brand Names List” by Bill Darden last updated on March 14, 2010 (Exhibit D) which lists the Applicant and Opponent on page 40.
- The *Battery Power Products & Technology* publication 2009 Resource Guide (Exhibit E) which lists both the Applicant and Opponent on page 22 in the category “Primary Batteries”.
- A print-out from *researchmarkets.co.uk* entitled Lead Acid Batteries (Automotive) – Global Strategic Business Report (Exhibit F) which identifies both the Applicant and the Opponent. I note that the complete report has not been provided.
- A print-out of a “masterseek” Internet search for “14545” (Exhibit G) which revealed both the Applicant and the Opponent.

[28] The print-outs from the *www.jgdarden.com* and *researchmarkets.co.uk* websites and masterseek Internet search results are not admissible since there is no evidence of the reliability

of these websites or the masterseek search [*Institut National des Appellations d'Origine v Kohler Co*; 2010 TMOB 162 at para 11]. In the absence of other evidence, the fact that both the Applicant and Opponent are listed in the category “Primary Batteries” in the 2009 Resource Guide does not necessarily lead to the inference that the channels of trade and nature of each of the Wares overlaps with the Opponent’s Wares.

[29] Based on the statement of wares of the subject application and the Opponent’s registration, I find that there is significant overlap between the Opponent’s Wares and the Wares described as batteries for automobiles, rechargers for automotive batteries, batteries for vehicles, automotive battery chargers, electric accumulators for automobiles, buses, taxis, dump trucks, golf buggy and that with respect to these wares there is an overlap in the channels of trade. In the absence of evidence, I am unable to conclude that any overlap in the nature of wares or channels of trade for the remaining wares which include a variety of battery related components (including liquids) and batteries and chargers for non-automotive uses, electric engines and vehicles.

surrounding circumstances: use of FRAM

[30] Lesley Gallivan, an employee of the Applicant’s agent, performed searches to obtain information regarding the availability of automotive air, oil and fuel filters and related products bearing the trade-mark FRAM in Canada. Ms. Gallivan’s evidence includes the following:

- print-outs from the FRAM website *www.ca.fram.com* detailing the FRAM products available in Ontario, including oil, air, and fuel filters, and a list of where to buy one of these products in Canada (Exhibits A-B);
- print-outs from the following websites: *www.autopartsnerd.com*, *www.canadiantire.com*, *www.summitracing.com*, *www.amazon.com*, and *www.walmart.ca* showing FRAM products for sale; Ms. Gallivan states that these are available to be shipped to Canada (paras 5-9; Exhibits C-G); and
- packaging of FRAM air and oil filters from a Canadian Tire and Wal-Mart purchased by Ms. Gallivan (paras 10-11; Exhibits H and I).

[31] Unlike Mr. Caron who provided evidence that should have been properly adduced by a party to the proceeding, Ms. Gallivan has provided evidence about what appears to be a third party. Given the manner in which Ms. Gallivan’s investigation was conducted, I find that Ms.

Gallivan's evidence was both necessary and reliable and is admissible as an exception to the hearsay rule. I do note that the evidence of availability from on-line retailers does not assist the Applicant to any great extent as there is no evidence that products were actually purchased by Canadians [*Ruko of Canada Ltd v Home Hardware Stores Ltd* (2012), 100 CPR (4th) 379 (TMOB) at paras 25-26].

[32] At most this evidence shows that within the automotive field generally there is one other user of a trade-mark beginning with a F and ending with AM in a block letter stylization. However, this evidence does not assist me in determining that in the field of automotive batteries specifically that a consumer could distinguish between the Mark and the Opponent's FIAMM Design trade-mark.

surrounding circumstance: prior registration

[33] The Applicant has provided a certified copy of registration No. 556,552. I do not consider this registration to be a significant additional circumstance as it does not give the Applicant the automatic right to obtain a further registration no matter how closely the application may be related to it [see *American Cyanamid Co v Stanley Pharmaceuticals Ltd* (1996), 74 CPR (3d) 571 (TMOB) at 576; *Courtyard Restaurant Inc v Marriott Worldwide Corp*; 2006 CarswellNat 5371 (TMOB) at para 58.]

surrounding circumstance – co-existence in other jurisdictions

[34] Mr. Statti, a brand consultant for the Applicant, evidences that both parties' marks have been registered in various jurisdictions including the United States, Argentina and Italy (Statti affidavit, sworn August 31, 2010). However, the mere coexistence of marks on foreign registers is not relevant to the issue of the likelihood of confusion in Canada [*Vivat Holdings Ltd v Levi Strauss & Co* (2005), 41 CPR (4th) 8 (FC) at para 65].

conclusion

[35] I conclude that, on a balance of probabilities, there is a reasonable likelihood of confusion between the FIAMM Design trade-mark and the Mark for use in association with the following wares: batteries for automobiles, rechargers for automotive batteries, batteries for vehicles,

automotive battery chargers, electric accumulators for automobiles, buses, taxis, dump trucks, golf buggy. I conclude this based on the high degree of resemblance between the marks and the significant overlap in the nature of these wares with the Opponent's registered wares.

Accordingly, this ground of opposition is successful for these wares. This ground of opposition is rejected with respect to the remaining wares since the differences in the nature of the remaining wares shifts the balance of probabilities in the Applicant's favour.

Section 16(1)(a) Ground of Opposition

[36] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with its prior use of the FIAMM Design trade-mark. In order to satisfy its evidential burden, the Opponent must evidence that it has made known or used its FIAMM Design trade-mark prior to the Applicant's claimed date of use of June 2007 and that such trade-mark had not been abandoned at the date of advertisement of the application of the Mark. The requirements for use are set out in section 4(1) of the Act; the requirements for making known are set out in section 5 of the Act. As there is no evidence that the Opponent had made known or had used its trade-mark in Canada as of June 2007, this ground of opposition is rejected.

Distinctiveness

[37] The Opponent has alleged that the trade-mark is not distinctive. There is an initial burden on the Opponent to establish that, as of November 25, 2008, its FIAMM Design trade-mark was known to such an extent that it could negate the distinctiveness of the Mark. The Opponent will have met its burden if its mark is known in Canada to some extent or if it is well known in a specific area of Canada [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at para 33]. Finally, an attack based on non-distinctiveness is not restricted to the sale of goods in Canada. It may also be based on evidence of knowledge or reputation of the Opponent's trade-mark spread by means of word of mouth and evidence of reputation and public acclaim [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58 -59].

[38] Mr. Caron's affidavit includes two items which pre-date November 25, 2008: (i) FIAMM Horn Catalogue including a price list dated 2004 which references shipping to Canada (Exhibit H) and (ii) a single invoice from Fiamm Technologies, LLC to Canadian Tire Corp dated

February 2, 2008 (Exhibit I). At paragraph 6 of this Affidavit, Mr. Caron indicates that he has performed an Internet search for FIAMM and “discovered that the FIAMM Group, which is a single enterprise owns, FIAMM Technologies, L.L.C. in America.” As indicated above, I have found this evidence inadmissible as it is hearsay and there is no information regarding its necessity and/or reliability. I note that even if I had found it admissible, Mr. Caron’s evidence predating November 25, 2008 would have been insufficient to meet the Opponent’s burden of demonstrating that its mark was known to such an extent that it could negate the distinctiveness of the Mark.

Disposition

[39] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to batteries for automobiles, rechargers for automotive batteries, batteries for vehicles, automotive battery chargers, electric accumulators for automobiles, buses, taxis, dump trucks, golf buggy and I reject the opposition with respect to the remainder of the wares, pursuant to s. 38(8) of the Act [*Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1986), 10 C.P.R. (3d) 482 (F.C.T.D.) as authority for a split decision].

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