



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

Citation: 2013 TMOB 77
Date of Decision: 2013-04-26

**IN THE MATTER OF AN OPPOSITION
by Fariborz Rahbar-Dehghan to
application No. 1,479,355 for the trade-
mark LENS PEN SENSORKLEAR
LOUPE in the name of Parkside Optical
Inc.**

[1] On April 30, 2010, Parkside Optical Inc. (the Applicant) filed an application to register the trade-mark LENS PEN SENSORKLEAR LOUPE (the Mark) based on use in Canada since at least as early as March 12, 2009 in association with “camera inspection instruments, namely, optical lenses for inspecting digital camera image sensors” (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 20, 2010.

[3] On November 8, 2010, Fariborz Rahbar-Dehghan (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Pursuant to sections 38(2)(a) and 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the application does not comply with the requirements of section 30(b) of the Act as the Mark has not been used in Canada since the claimed date of first use in association with the Wares and the Applicant could not be satisfied that it was entitled to use the Mark in Canada in association with the Wares since at the date of filing the application for the Mark the Applicant was well aware of the Opponent’s trade-mark described in the remaining grounds of opposition and the Opponent’s use thereof.

- Pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable as it is confusing with the Opponent's registered trade-mark SENSOR LOUPE subject to registration No. TMA763,290.
- Pursuant to sections 38(2)(c) and 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Mark as at all material dates and at the date of filing the statement of opposition the Mark was confusing with the Opponent's trade-mark SENSOR LOUPE which had been used in Canada in association with the wares "magnifying glass for dust detection".
- Pursuant to sections 38(2)(d) and 2, the Mark is not distinctive since it does not actually distinguish and it is neither adapted to distinguish nor capable of distinguishing the Wares from the wares of others and more particularly from the wares of the Opponent in association with which the Opponent has used and is still using its trade-mark SENSOR LOUPE in Canada.

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

[5] The Opponent did not file any evidence in support of its opposition. The Applicant filed an affidavit of Kenneth Murray Keating, the Applicant's CEO, and an affidavit of Jeannine Summers, a paralegal employed by the Applicant's agent.

[6] Only the Applicant filed a written argument. An oral hearing was not conducted.

Onus and Material 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 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 CPR (3d) 293 (FCTD) at 298].

[8] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].

- sections 38(2)(b)/12(1)(d) - the date of my decision [see *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) - the claimed date of first use [see section 16(1) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Summary Dismissal of Grounds of Opposition

[9] The Opponent has not provided any evidence or submissions in support of its section 30(b) ground of opposition and thus I find that the Opponent has failed to meet its evidential burden and I dismiss this ground of opposition accordingly.

[10] With respect to the ground of opposition based on section 30(i) of the Act, I note that where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

[11] The Opponent has failed to provide any evidence of use of or reputation in Canada for its pleaded SENSOR LOUPE trade-mark. I note that any reference to use in the Opponent's registration for the trade-mark SENSOR LOUPE (TMA763,290) is not sufficient to satisfy the Opponent's evidential burden under section 16(1)(a) of the Act [see *Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)]. The same is true with respect to the non-distinctiveness ground. Accordingly, I find that the Opponent has failed to meet its evidential burden with respect to both the non-entitlement and non-distinctiveness grounds of opposition.

[12] Based on the foregoing, I dismiss the grounds of opposition based on sections 38(2)(a) and 30(b); 38(2)(a) and 30(i); 38(2)(c) and 16(1)(a); and 38(2)(d) and 2 of the Act.

Non-registrability Ground – section 12(1)(d) of the Act

[13] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. The Applicant submits that in the present case, where the Opponent has not filed any evidence (not even a certified copy of its registration), the Opponent has failed to meet its evidential burden. I do not agree.

[14] The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Specifically, I refer to the following passage:

The general position of the registrar is that, having regard to the realities of available manpower, he will not in opposition proceedings exercise his discretion and have regard to anything appearing on the register that is not properly proved by evidence. However, where, as in this case, reference is made in the statement of opposition to a trade mark registration and that registration forms the basis of an allegation that the applicant's trade mark is not registrable pursuant to s. 12(1)(d) *Trade Marks Act*, R.S.C. 1970, C. T-10, the registrar, having regard to the potential public interest in having such a ground of opposition raised, does consider it appropriate to exercise his discretion to check the register. [see *Quaker Oats, supra* at 411-412]

[15] I have exercised my discretion and I confirm that the registration for the Opponent's SENSOR LOUPE mark (TMA763,290) remains valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[16] 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.

[17] 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. [See, in general, *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) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[18] In his affidavit, Mr. Keating states that the coined word LENS PEN, the first portion of the Mark, is the Applicant's main trade-mark which it uses in association with many of its products and its business generally. The Mark also includes the coined word SENSORKLEAR. While I agree with the Applicant that this is a coined word, I do find that it is somewhat suggestive of the Wares as it appears to be a contraction of the words SENSOR and KLEAR (phonetically equivalent to the word CLEAR) which is suggestive of the Wares which include the word "sensor" in the description thereof. Notwithstanding this finding, I am satisfied that the presence of the coined words LENS PEN and SENSORKLEAR in the Mark serve to create a high degree of inherent distinctiveness for the Mark.

[19] The Applicant has provided definitions, including dictionary definitions, for the word LOUPE in the Summers affidavit. The *Canadian Oxford Dictionary* defines "loupe" as "a small magnifying glass used by jewellers, etc."

[20] The Applicant also relies on printouts from the Opponent's website in support of its submissions. While I appreciate that evidence of a third party's website cannot be relied upon as 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. As a result, I am willing to place some weight on the printouts from the Opponent's website.

[21] As the Opponent explains on its website, its loupes (magnifying glasses) are used to view sensors in DSLR (digital single-lens reflex) cameras to detect whether there is dust on the sensors (Exhibit J to the Keating affidavit). The word LOUPE is thus descriptive of the Opponent's wares.

[22] The *Canadian Oxford Dictionary* defines SENSOR as a “device giving a signal for the detection or measurement of a physical property to which it responds”. The word SENSOR therefore merely describes the type of “loupe” (i.e. a loupe for viewing sensors). Thus the word SENSOR is also descriptive of the Opponent’s wares.

[23] The Applicant submits, and I agree, that the Opponent himself uses the term “sensor loupes” descriptively on his website to refer to a product category (see Exhibit J to the Keating affidavit).

[24] I agree with the Applicant that the Opponent’s mark possesses very little inherent distinctiveness as it is descriptive of the associated wares. I further agree with the Applicant that by virtue of this finding the Opponent’s mark should be afforded a narrow scope of protection.

[25] Based on the foregoing, I find that the Mark possesses a much higher degree of inherent distinctiveness than the Opponent’s mark.

[26] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[27] The registration for the Opponent’s SENSOR LOUPE trade-mark (TMA763,290) claims use in Canada since May 2007. However, in the absence of evidence of actual use and reputation for the mark I can only infer *de minimis* use thereof [see *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 the Opponent’s SENSOR LOUPE mark has become known to any significant extent.

[28] By contrast, the Applicant has provided evidence of use and advertising of the Mark in Canada including not insubstantial sales figures for the Wares for the years 2009 – 2011.

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

[29] The application is based on claimed use of the Mark in Canada since at least as early as March 12, 2009. The Applicant has provided evidence of sales figures for the years 2009 – 2011

along with supporting evidence in the form of invoices and sample packaging which clearly displays the Mark on the Wares (see Exhibits D, E and F to the Keating affidavit).

[30] The Opponent's registration for the trade-mark SENSOR LOUPE (TMA763,290) claims use in Canada since at least May 2007; however, in the absence of evidence of use I am only able to infer *de minimis* use thereof [see *Entre Computer, supra*].

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

[31] It is the Applicant's statement of wares and services as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)].

[32] The Wares are "camera inspection instruments, namely, optical lenses for inspecting digital camera image sensors" and the Opponent's wares are "magnifying glass for dust detection".

[33] In his affidavit, Mr. Keating provides printouts from the Opponent's website including a printout from the "Products Guide" section of the Opponent's website which refers to the use of the Opponent's loupes for inspecting sensors in DSLR digital cameras (Exhibit K).

[34] I find that this evidence supports a finding that the parties' wares share some degree of similarity.

[35] The Applicant submits that the relevance of any similarity between parties' wares will be diminished where an opponent's mark is descriptive of the wares associated therewith. While I agree that the Opponent's mark should be afforded only a narrow ambit of protection, I find that the evidence supports a finding that there is some similarity between the parties' wares.

[36] The Applicant submits that the only evidence we have regarding the nature of the Opponent's channels of trade is that the Opponent's products may be sold through the Opponent's website. The evidence shows that the Applicant's Wares are sold through retailers like Future Shop and London Drugs and they would clearly not be sold through the Opponent's website.

[37] While I agree with the Applicant that this serves to create a distinction between the parties' actual channels of trade, there is no restriction in the Opponent's registration for the SENSOR LOUPE mark that restricts the Opponent to selling its wares only through its website. Furthermore, there is no restriction in the application for the Mark with respect to the channels of trade for the Wares. In light of the similarity in the nature of the parties' wares there is also a possibility that the parties' wares could travel through the same channels of trade and thus be sold in the same retailers.

6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[38] In *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in section 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar. As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[39] As set out in further detail above in the analysis of the section 6(5)(a) factor, I have found that the Opponent's mark is descriptive and therefore deserving of only a narrow ambit of protection. As a result, relatively small differences between the parties' marks will be sufficient to distinguish between the parties' marks [see *Kellogg Canada Inc v Weetabix of Canada Ltd* (2002), 20 CPR (4th) 17 (FC); and *American Cyanamid Co v Record Chemical Co Inc* (1972), 7 CPR (2d) 1 (FCTD)].

[40] The Supreme Court in *Masterpiece* advised that 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 [see *Masterpiece, supra* at para 64]. While the parties' marks share the descriptive element LOUPE and the highly suggestive element SENSOR (albeit as part of a coined word in the case of the Mark), I note that the Mark also includes the striking and unique

element LENS PEN (and to a lesser extent SENSOR KLEAR) which does not share any similarity with the Opponent's mark.

[41] In terms of ideas suggested, by virtue of the inclusion of the coined words in the Mark it has no particular meaning whereas the Opponent's mark is essentially the name of the associated wares. As a result, there is no significant similarity between the parties' marks in terms of ideas suggested either.

[42] Based on the foregoing, I find that the parties' marks do not share any significant degree of similarity in appearance, sound or ideas suggested. Specifically, I find that the most distinctive element of the Mark, LENS PEN, which happens to be the first portion of the Mark, creates significant differences between the parties' marks in terms of appearance, sound and ideas suggested.

Other Surrounding Circumstances

[43] In its written argument, the Applicant puts forward additional surrounding circumstances which it submits further support a finding of no likelihood of confusion between the parties' marks. For the reasons set out above, and as will be summarized in my conclusion, I need not consider any of these additional surrounding circumstances in order to find in the Applicant's favour.

Conclusion

[44] As discussed above, in *Masterpiece* the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found significant differences between the parties' marks in terms of sound, appearance and ideas suggested such that, notwithstanding the similarity in the nature of the parties' wares and trades, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties' marks. Having regard to the foregoing, the ground of opposition based on section 12(1)(d) of the Act is dismissed.

Disposition

[45] 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.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office