IN THE MATTER OF AN OPPOSITION by Automaxi S.A. to application No. 560,247 for the trade-mark AUTOMAX filed by UAP Inc.

On April 11, 1986, the applicant, UAP Inc., filed an application to register the trade-mark AUTOMAX based upon proposed use of the trade-mark in Canada in association with "antigel, lave-glace, batteries, filtres à air, filtre à huile, filtres à essence, courroies de ventilateur, alternateurs, démarreurs, pompes à eau, peintures, liquide à moteur, huile de transmission, bicyclettes, pneus et sacs de couchage" and in association with "l'exploitation d'une entreprise traitant de distribution, de vente au détail et de magasin offerts relativement à des pièces et accessoires automobiles; articles de quincaillerie et de peinture; articles et accessoires de sport; appareils et accessoires électriques et électroménagers; appareils et accessoires audio et vidéo; articles, ustensils et accessoires de jardin; articles, ustensils et accessoires de ménage et articles, ustensils et accessoires de camping; services de réparations de véhicules et d'installations de pièces automobiles".

On January 18, 1988, Jacques Maby filed a statement of opposition in which he alleged that the applicant's trade-mark AUTOMAX is not registrable and not distinctive in that it is confusing with his registered trade-mark AUTO MAXI & Design, registration No. 317,757.

The applicant served and filed a counter statement in which it denied the allegations set forth in the statement of opposition. Further, the applicant submitted that the opponent is estopped from opposing the applicant's application in view of the opponent's earlier submission to the Registrar made during the prosecution of his trade-mark application that the trade-mark AUTO MAXI & Design is not confusing with the registered trade-mark MAXI AUTO & Design, registration No. 271,308. Further, on March 8, 1988, the applicant requested leave pursuant to Rule 42 of the Trade-marks Regulations to file an amended counter statement. The opponent subsequently advised the Opposition Board that he accepted the applicant's amended counter statement. As a result, this will confirm that leave was granted by the Board to the applicant to amend its counter statement. In its amended counter statement, the applicant, in addition to the allegations set forth in its original counter statement, pleaded that the opponent has not used the trade-mark AUTO MAXI & Design, registration No. 317,757, in association with any of the wares identified in the registration or listed in his statement of opposition.

On September 26, 1988, the opponent sought leave pursuant to Rule 42 of the Trade-marks Regulation to amend its statement of opposition. However, by way of an Office letter dated December 16, 1988, the opponent's request for leave was refused on the basis that the opponent was, in effect, attempting to replace the original opponent and to rely on new grounds of opposition which

were not asserted in the original statement of opposition.

In view of the assignment of rights in the registered trade-mark AUTO MAXI & Design, registration No. 317,757, from Jacques Maby to Automaxi S.A., the Opposition Board, by way of an Office letter dated May 5, 1989, advised the parties that the opposition proceeding would continue in the name of Automaxi S.A. as opponent. However, the grounds of opposition asserted in the original statement of opposition remain unchanged.

The opponent failed to file evidence in a timely manner and, as a result, the applicant elected not to file evidence in the opposition.

Both the applicant and the opponent submitted written arguments and neither party requested an oral hearing.

The only issue for determination in this opposition is whether there would be a likelihood of confusion between the applicant's trade-mark AUTOMAX as applied to the wares and services covered in its application and the registered trade-mark AUTO MAXI & Design, registration No. 317,757, a representation of which appears below, covering "automotive accessories, namely, headlights, rear lights, fog lights; automotive article carriers, namely, roof racks, bicycle carriers, baggage racks, ski racks, sailboard carriers, and security straps for automotive article carriers; automotive security devices, namely, alarm systems, locking and anti-theft devices, and sirens; cables and security straps for use during towing; partitioning devices used for transporting animals; mirrors, wind deflectors, body mouldings, and convertible roofs".

Registration No. 317,757

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically set forth in Section 6(5) of the Trade-mark Act. Further, the Registrar must bear in mind

that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the date of decision, the material date in respect of a determination of the registrability of a trade-mark under Section 12(1)(d) of the Trade-marks Act (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Mark, (F.C.A. File No. A-263-89, dated June 24, 1991, yet unreported).

With respect to the inherent distinctiveness of the trade-marks at issue, I consider that both the applicant's trade-mark AUTOMAX as applied to the wares and services covered in the applicant's application and the registered trade-mark AUTO MAXI & Design as applied to the wares covered in the opponent's registration possess some inherent distinctiveness when considered in their entireties although both trade-marks include the element AUTO which clearly indicates that certain of the wares and services associated with the trade-marks at issue are related to or are for use in association with automobiles. Further, the inherent distinctiveness of the registered trade-mark is augmented by the design features which form an element of the trade-mark.

As neither party filed evidence in this opposition, neither the extent to which the trade-marks have become known nor the length of time that the trade-marks have been in use are relevant criteria in assessing the likelihood of confusion between the trade-marks at issue in this opposition.

As for the nature of the wares of the parties and the respective channels of trade associated with these wares, I consider the opponent's automotive accessories, namely, headlights, rear lights, fog lights; automotive article carriers; automotive security devices; mirrors and wind deflectors to be clearly overlapping with the applicant's antifreeze, windshield washer, batteries, air, oil and gas filters, fan belts, alternators, starters, water pumps, motor oil, transmission fluid and tires and the applicant's services relating to the operation of a business to distribute, retail and store automotive parts and accessories and vehicle repair services and the installation of automotive parts. On the other hand, there appears to be little similarity between the opponent's wares and the applicant's paint, bicycles and sleeping bags, as well as its services with the exception of the services relating to automotive parts and accessories, vehicle repairs and the installing of automotive parts. Further, to the extent that the wares and services of the parties are overlapping, I consider the channels of trade associated with these wares and services would likewise overlap.

Considering the degree of resemblance between the trade-marks at issue, I consider there to be some similarity in appearance and an even greater degree of similarity in sounding between the trade-marks AUTOMAX and AUTO MAXI & Design when considered in their entireties as a matter

of first impression and imperfect recollection. Further, while both trade-marks suggest that the respective wares and services of the parties are related to automobiles, I do not consider that either party would be entitled to a monopoly in respect of such an idea as applied to their respective wares and services which are for use in or are related to automobiles.

In view of the above, I have concluded that the applicant has failed to meet the burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark AUTOMAX as applied to "antigel, lave-glace, batteries, filtres à air, filtre à huile, filtres à essence, courroies de ventilateur, alternateurs, démarreurs, pompes à eau, liquide à moteur, huile de transmission, pneus" and its services identified as "l'exploitation d'une entreprise traitant de distribution, de vente au détail et de magasin offerts relativement à des pièces et accessoires automobiles; services de réparations de véhicules et d'installation de pièces automobiles; services de réparations de véhicules et d'installations de pièces automobiles" and the registered trade-mark AUTO MAXI & Design. On the other hand, I do not consider that there would be any reasonable likelihood of confusion between the opponent's trade-mark AUTO MAXI & Design and applicant's trade-mark AUTOMAX as applied to "peintures, bicyclettes et sacs de couchage" or as applied to the applicant's services relating to "l'exploitation d'une entreprise traitant de distribution, de vente au détail et de magasin offerts relativement à des articles de quincaillerie et de peinture; articles et accessoires de sport; appareils et accessoires électriques et électroménagers; appareils et accessoires audio et vidéo; articles, ustensils et accessoires de jardin; articles, ustensils et accessoires de ménage et articles, ustensils et accessoires de camping". In this regard, I would note the finding of the Federal Court, Trial Division in respect of there being authority to render a split decision in Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH, 10 C.P.R. (3d) 492.

In view of the above, I refuse the applicant's application in respect of "antigel, lave-glace, batteries, filtres à air, filtre à huile, filtres à essence, courroies de ventilateur, alternateurs, démarreurs, pompes à eau, liquide à moteur, huile de transmission, pneus" and in relation to the applicant's services identified as "l'exploitation d'une entreprise traitant de distribution, de vente au détail et de magasin offerts relativement à des pièces et accessoires automobiles; services de réparations de véhicules et d'installations de pièces automobiles" and otherwise reject the opponent's opposition to registration of the applicant's application in view of the provisions of Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 31st DAY OF OCTOBER 1991.

G.W. Partington,
Chairman,
Trade Marks Opposition Board.