



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

Citation: 2011 TMOB 48
Date of Decision: 2011-03-14

**IN THE MATTER OF AN OPPOSITION
by Aspen Custom Trailers, a partnership,
to application No. 1,235,424 for the trade-
mark ASPEN in the name of Chrysler
Group LLC**

[1] On October 28, 2004, Daimlerchrysler Corporation filed an application to register the trade-mark ASPEN (the Mark) on the basis of proposed use in Canada in association with “motor vehicles, namely sport utility vehicles, and their structural parts and engines” (the Wares).

[2] Further to changes of names and assignment recorded by the Canadian Intellectual Property Office (CIPO), the application currently stands in the name of Chrysler Group LLC. The term “Applicant” shall be used throughout to refer to the owner of the application for the Mark at the relevant time.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 25, 2007.

[4] On September 4, 2007, Aspen Custom Trailers, a partnership (the Opponent) filed a statement of opposition. On February 11, 2009, the Registrar granted leave to file an amended statement of opposition dated December 3, 2008. The grounds of opposition can be summarized as follows:

1. The Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) since it is confusing with the Opponent's trade-mark ASPEN of registration No. TMA435,243 for "trailers, trucks, gantrys, axle boosters, hydraulic ramps" and " design and manufacture of heavy duty equipment transportation trailers designed to customer specifications".
2. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act since, at the material date, the Mark was confusing with the trade-mark ASPEN previously used or made known in Canada by the Opponent or the Opponent's predecessor in title, Aspen Trailer Company Ltd., or their licensees.
3. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(c) of the Act since, at the material date, the Mark was confusing with the trade-name ASPEN previously used in Canada by the Opponent or the Opponent's predecessor in title, Aspen Trailer Company Ltd., in association with the design, manufacture and sale of trailers and trailers accessories.
4. The Mark is not distinctive having regard to the use of the trade-mark and trade-name referred to in the statement of opposition.
5. The application does not conform to the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in association with the Wares.

[5] The Applicant filed and served a counter statement essentially denying each allegation contained in the statement of opposition.

[6] In support of its opposition, the Opponent filed affidavits of Phil Johnston and Mihaela Hutanu. Only Mr. Johnston was cross-examined by the Applicant. The transcript of the cross-examination and reply to undertakings were filed by the Applicant on November 28, 2008. On September 29, 2009, the Registrar received a copy of a letter of even date sent to the Applicant's agent by the Opponent's agent for correcting a reply to an undertaking.

[7] In support of its application, the Applicant filed affidavits of Donna L. Berry, Pearl Davies and Lynda Palmer. None of the Applicant's affiants was cross-examined.

[8] Both parties filed written arguments and were represented at an oral hearing.

[9] At the beginning of the oral hearing, I noted that while the transcript of the cross-examination mentions Exhibit 1 (a copy of the Johnston affidavit with pages of all the exhibits numbered from 1 through 112), there was no exhibit to the transcript filed by the Applicant. In addition, further to the Applicant's request, I accepted that the copy of the letter received by the Registrar on September 29, 2009 be of record in the present proceeding. In that regard, I note that the party conducting the cross-examination has the responsibility to file the replies to undertakings [see Rule 44(4) of the *Trade-marks Regulations*, SOR/96-195].

Onus

[10] The Applicant bears the legal onus of establishing on a balance of probabilities that the 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. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.), *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

Material Dates

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

- s. 38(2)(a)/s. 30 – the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];

- s. 38(2)(b)/s. 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 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(3)(a) and s. 16(3)(c) – the filing date of the application; and
- s. 38(2)(d)/non-distinctiveness – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Review of the Evidence

Opponent's Evidence

Affidavit of Phil Johnston, dated May 16, 2008, and his cross-examination

[12] Mr. Johnston is the Opponent's Vice-President.

[13] As a first matter, I note that according to paragraph 4 of the Johnston affidavit, references to the Opponent therein “include the Opponent's predecessors-in-title, including Aspen Trailer Company Ltd.”. As per the Johnston affidavit, and unless indicated otherwise, I will use the term “Opponent” to refer to the owner of the trade-mark ASPEN at the relevant time. However, I note that any ambiguities resulting from the affiant's collective reference to Aspen Custom Trailers and its predecessors in title will be resolved against the Opponent [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)]. Also, I will refer to the cross-examination of Mr. Johnston only to the extent that it is relevant to my review of his affidavit as well as to the issues at hand and the parties' arguments.

[14] Mr. Johnston provides a printout of registration No. TMA435,243 for the trade-mark ASPEN in the name of Aspen Custom Trailers, a partnership [Exhibit A]. The footnote on the registration printout shows that CIPO recorded Aspen Custom Trailers, a partnership, as owner of registration No. TMA435,243 on April 4, 2006 further to an assignment of March 17, 2006 from Aspen Trailer Company Ltd. In reply to undertakings the Opponent indicates that Aspen Trailer Company Ltd. was incorporated on September 23, 1977 and the Opponent provides a copy of the assignment registered by CIPO [U1 to U3].

[15] Mr. Johnston states that the Opponent designs, manufactures and sells trailers and associated wheeled vehicles, such as trucks and boosters, of the types illustrated in the exhibits to his affidavit [par. 5]. The Opponent has manufacturing facilities in Leduc (Alberta); it has corporate sales offices in Richmond, Surrey and Prince-George (British Columbia) and Calgary (Alberta) [par. 6].

[16] Paragraph 7 of the Johnston affidavit reads as follows:

Since at least as early as March 1980, the Opponent has used the trademark (*sic*) ASPEN in association with the trailers manufactured and sold by it in Canada and as a trade-name to designate the Opponent. The Opponent continues to do so to this day.

[17] On cross-examination, Mr. Johnston was asked about the entities having used ASPEN since 1980, including in which capacity. The testimony of Mr. Johnston on the user of the trade-mark ASPEN under the ownership of the partnership Aspen Custom Trailers is direct, in that he testifies that Aspen Custom Trailers “has not licenced (*sic*) any of its intellectual property to anybody else” [p. 6 of the transcript]. However, the testimony of Mr. Johnston on the users of the trade-mark since March 1980 is not as direct and comprehensive. As I will discuss this point later on in my decision, for the time being I note the following reply to undertakings:

- The users have included Aspen Metal Products & Fabricators Ltd., Aspen Trailer Inc., Aspen Custom Trailers Inc., Aspen Trailer Company Ltd., Aspen Trailer Company (Alberta) Ltd., Aspen Trailer Group and Aspen Custom Trailers. One or more of these may be previous names of others listed entities. “The entitlement to the use of the word ASPEN as between the Aspen entities themselves is not relevant. However, all users were at least under common ownership, control and management at all material times.” [U5].
- Aspen Metal Products & Fabricators Ltd. used ASPEN as a trade-name or a trade-mark in 1980 [U6]. The Opponent indicates that whether or not Aspen Metal Products & Fabricators Ltd. assigned trade-mark rights to Aspen Trailer Company Ltd. (as far back as 1980) is not relevant to any issue” in the present opposition proceeding [U7].

- The trade-mark was licensed to Aspen Custom Trailers Inc. by Aspen Trailer Company Ltd. [U8]. The Opponent provides a copy of the Trademark Licence Agreement dated April 17, 2003 between Aspen Trailer Company Ltd. (licensor) and both Aspen Custom Trailers Inc. and Aspen Trailer Inc. (licensees) [U10].
- Aspen Trailer Group referred to Aspen Trailer Company Ltd., Aspen Custom Trailers Inc. and Aspen Trailer Inc. (previously known as Aspen Trailer Company (Alberta) Ltd.). If the designation Aspen Trailer Group subsists, it refers to the related Aspen entities as they may exist from time to time [U9].
- Alberta Trailer Company (Alberta) Ltd. “did have a license” [U17].

[18] The following exhibits are appended to the Johnston affidavit to show use of ASPEN as the Opponent’s trade-mark or trade-name or as both trade-mark and trade-name:

- Exhibit B: Samples of “marketing and other materials” distributed in Canada; the year annotations indicate the approximate year of distribution [par. 8]. I note that the materials are for the years 1980’s up to the early 2000’s. I also note that depending on the year, the entity whose name appears on the material is Aspen Metal Products & Fabricators Ltd., Aspen Metal Products, Aspen Trailer Co. Ltd. (or Aspen Trailers Co. Ltd.), Aspen Trailer Group, Aspen Custom Trailers, Inc., Aspen Trailer Company Ltd. or Aspen Custom Trailers.
- Exhibit C: Representative invoices and “other documentation” provided to potential customers and customers when securing or concluding a sale in Canada “of ASPEN trailers and related accessories and components” [par. 9]. I note that the exhibit consists of three invoices, one dated 4/3/01 issued by Aspen Trailer Company (Alberta) Ltd. and two dated 11/18/07 issued by Aspen Custom Trailers. One of the invoices from Aspen Custom Trailers establishes the price of the trailer sold at \$187,716.
- Exhibit D: Images of typical trailers manufactured and sold by the Opponent since 1980 [par. 10]. I note that the images show ASPEN on trailers themselves and/or on mud guards.

[19] Extracts of the Opponent's website "illustrating some of the trailers and wheeled accessories designed, manufactured and sold by the Opponent" are filed as Exhibit E to the Johnston affidavit [par. 13]. The website pages were apparently printed on November 19, 2007. In reply to undertakings, the Opponent indicates that "all of the pages have been in use for at least 5 years" [U16]; at the date of its reply, the date the website was created was not available to the Opponent, nor was the date it was posted [U15]. I would remark that there is no evidence establishing that Canadians had visited the website at any time [see *Candrug Health Solutions Inc. v. Thorkelson* (2008), 64 C.P.R. (4th) (F.C.A.)].

[20] An important part of the cross-examination of Mr. Johnston was devoted to the nature of the Opponent's wares. For one thing, counsel for the Applicant questioned Mr. Johnston on the terms (dolly, tag dolly, float, docks, low beds, goosenecks, transporters, crane brooms, hydraulic goosenecks, jeeps and trailers) used in the Opponent's materials to designate the Opponent's products. Mr. Johnston testifies: "The marketing material in here is exemplary of what we used to describe our products. It's not exhaustive of all the words we've ever used." [p. 12 of the transcript]. In reply to an undertaking, the Opponent indicates: "The witness declines to review the exhibits to his affidavit to determine whether the words 'trucks', 'cars' or 'autos' are used in the exhibits, as the documents speak for themselves." [U14]. I will further discuss the Johnston cross-examination on the subject of the Opponent's wares when analyzing the grounds of opposition.

[21] According to the yearly breakdown provided at paragraph 11 of the Johnston affidavit, the Opponent's sales of ASPEN trailers in Canada from 1986 to 2007 totaled approximately \$420,000,000. Further, Mr. Johnston states at paragraph 12:

To date, Aspen has manufactured and sold in Canada approximately 7,235 trailer units or trailer wheeled accessories. The majority of those trailers would still be on the road in Canada and displaying the ASPEN trademark (*sic*), as the trailers can typically remain in service for 15 to 25 years.

[22] On cross-examination, Mr. Johnston specifies that the word "trailer" has been generalized in paragraphs 11 and 12 of his affidavit "so that this data could be provided in some kind of general term". He testifies that 7,235 trailer units or trailer-wheeled accessories would be a good estimation of the number of "rolling units" that has been manufactured [p. 32 of the transcript].

Affidavit of Mihaela Hutanu, dated May 21, 2008

[23] Ms. Hutanu files a Certificate of Authenticity of registration No. TMA435,243.

Applicant's Evidence

Affidavit of Donna L. Berry, dated March 20, 2009

[24] Ms. Berry is "Chief Trademark Counsel" of the Applicant.

[25] At paragraph 3 of her affidavit, Ms. Berry states that Chrysler Canada Inc. (Chrysler Canada) is licensed "by and with the Applicant's authority" to use the Mark in Canada in association with the Wares. She goes on to state that, under the licence, the Applicant has direct and indirect control of the character and quality of the Wares sold by Chrysler Canada, that the Applicant establishes the standards to be met by Chrysler Canada in connection with its use of the Mark and ensures that such standards are in fact met.

[26] Ms. Berry states that she has not been made aware of a single instance of confusion or possible confusion between the Wares and the Opponent or any of its wares, even after specific inquiries regarding the same to senior members of Chrysler Canada's legal, marketing and dealer relations departments [par. 5].

[27] I am not affording any significance to Ms. Berry's reference to an expunged registration for the trade-mark ASPEN, which was owned by a predecessor of the Applicant [par. 4].

Affidavit of Pearl Davies, dated March 20, 2009

[28] Ms. Davies has been Senior Manager, National Advertising/Direct Marketing at Chrysler Canada and its predecessors since 2004.

[29] Ms. Davies states that the worldwide sales of motor vehicles by the Applicant's group of companies generated revenues of over \$50 billion in 2008, of which over \$5 billion were attributable to Canada [par. 2]. At paragraph 2 of her affidavit, Ms. Davies states: "The Applicant (by itself and through its predecessors and licensees) has been a prominent member of the Canadian automobile industry for over 82 years."

[30] To the extent that Canada is concerned, Ms. Davies explains that the Applicant's motor vehicles are sold through a network of approximately 448 dealers (the Dealers) and that "[t]ypical end users of such vehicles are individuals from all walks of life". The purchase price of the sport utility vehicles associated with the Mark is approximately \$50,500 to \$59,000. [par. 3]. So as to use the same terminology of Ms. Davies, I will continue my review of her affidavit by referring to the Wares associated with the Mark as Aspen SUVs.

[31] Ms. Davies explains that Aspen SUVs are manufactured in the United States by the Applicant. The Applicant ships Aspen SUVs to the Dealers for sales to customers, who typically take possession of the vehicles on the Dealers' premises. Ms. Davies goes on to explain that pursuant to an agreement between the Applicant and Chrysler Canada, the latter receives the purchase orders from the Dealers and transmit them to the Applicant who then ships Aspen SUVs to the Dealers. The Applicant invoices the Dealers in the name of Chrysler Canada and the latter pays the Applicant for vehicles it ships each month [par. 4].

[32] Ms. Davies states that the first sale of Aspen SUVs in Canada occurred in September 2006 [par. 5]. From 2007 to the date of her affidavit, Chrysler Canada had sold approximately 3677 Aspen SUVs in Canada [par. 6].

[33] The Davies affidavit displays an image showing the Mark on the rear of an Aspen SUV [par. 7]. Ms. Davies files samples of adhesive stickers that are typically affixed to Aspen SUVs at the time of transfer to Dealers and then to customers [par. 8, Exhibit A].

[34] Ms. Davies files copies of representative invoices issued in the name of Chrysler Canada for Aspen SUVs sold to Dealers [par. 9, Exhibit B].

[35] The section of Chrysler Canada's website devoted to Aspen SUVs has attracted in excess of 27,750 unique Internet visitors from September 2006 to the date of her affidavit [par. 10, Exhibit C].

[36] According to the Davies affidavit [pars. 11 to 14], Aspen SUVs have been promoted in Canada through attendance at several trade shows, advertisements in Canadian periodical publications [Exhibits D and E], catalogues and flyers mailed to Canadian households [Exhibits F1 to F4], and through a television advertisement for the 2007 Aspen SUV [Exhibits G and H].

The Applicant, Chrysler Canada and the Dealers have expended in excess of \$1.5 million to promote Aspen SUVs in Canada since 2006, including approximately \$460,000 in connection with the aforementioned television advertisement [par. 15].

Affidavit of Lynda Palmer, dated February 3, 2009

[37] Ms. Palmer, a trade-mark searcher, conducted a search of the trade-marks register for the word “aspen” for wares in class 12, not including the parties’ trade-marks [par. 2]. According to Exhibit A to the affidavit, the search yielded three entries in the name of distinct entities, namely registration No. TMA443,091 for ASPENCADE, registration No TMA555,000 for ASPEN and application No. 1,398,489 for ASPEN.

Analysis of the Grounds of Opposition

[38] I shall now consider the grounds of opposition.

Registrability pursuant to s. 12(1)(d) of the Act

[39] I have exercised the Registrar’s discretion to confirm that registration No. TMA435,243 for the trade-mark ASPEN is in good standing as of today’s date and so the Opponent has discharged its evidential burden with respect to this ground of opposition. The burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s registered trade-mark ASPEN (the Opponent’s Mark).

[40] 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.

[41] 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 the trade-marks have 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 *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) (*Mattel*) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[42] Obviously, there are no differences between the trade-marks in appearance, sound and in the ideas suggested by them.

[43] Having referred myself to the *Oxford Canadian Dictionary*, I note that “aspen” is not an invented word. It is a noun designating “any of several poplars characterized by leaves which tremble in the slightest wind”. It is also the name of “a resort in south central Colorado [...] a thriving recreational centre, noted particularly for its skiing facilities”. That being said, “aspen” is neither descriptive nor suggestive of the Wares or of the Opponent’s registered wares and services. In the end, the inherent distinctiveness of the trade-marks at issue is the same.

[44] The Applicant’s evidence establishes that the Mark has been used and promoted in Canada since September 2006, which is not disputed by the Opponent. By the same token, the Applicant does not dispute that the Opponent’s Mark has been used for a longer period of time than the Mark.

[45] I agree that the Opponent’s evidence establishes that the Opponent’s Mark has been used for a longer period of time. However, it is difficult to reconstruct the chain of events that occurred since March 1980 involving the use of the Opponent’s Mark as the evidence described above refers to different entities. I would add that the following submission in the Opponent’s written argument does not shed light on this point [par. 9]: “The mark has also been used from time to time by other related companies involved in the same business and under common ownership and control, under an implied license until 2003 and since 2003 under license in writing.”

[46] Reverting to my previous comment that the testimony of Mr. Johnston on the entities having used the Opponent's Mark since March 1980 is far from being direct and comprehensive, I first remark that the use of the term "Opponent" throughout the Thompson affidavit coupled with the affiant's reference to *predecessors* in title of the Opponent, *including* Aspen Trailer Company Ltd., suggests that the latter is not the only predecessor in title to the partnership Aspen Custom Trailer. This suggestion is reinforced by the exhibits to the Thompson affidavit and the Opponent's reply to undertakings as to use of the Opponent's Mark by Aspen Metal Products & Fabricators Ltd. starting in 1980. For instance, it could be that Aspen Metal Products & Fabricators Ltd. was a predecessor in title of Aspen Trailer Company Ltd. Hence, I find the Johnston affidavit to be somewhat ambiguous. Even if it must be concluded that Aspen Metal Products & Fabricators Ltd. used the Opponent's Mark solely as a licensee of Aspen Trailer Company Ltd., there is no evidence to conclude that such use met the requirement of s. 50(1) of the Act. Indeed, it is trite law that a corporate relationship, on its own, is insufficient to satisfy the requirement of s. 50 of the Act [see *MCI Communications Corp. v. MCI Multinet Communications Inc.* (1995), 61 C.P.R. (3d) 245 (T.M.O.B.); *Dynatech Automation Systems Inc. v. Dynatech Corp.* (1995), 64 C.P.R. (3d) 101 (T.M.O.B.)].

[47] Second, even if Aspen Trailer Company Ltd. confirmed in the Trademark Licence Agreement that it had granted a licence to Aspen Custom Trailers Inc. and Aspen Trailer Inc. "effective the date of first use of the Marks by the Licensees", the corporate relationship between the parties would not suffice to satisfy the requirement of s. 50 of the Act when considering the use of the Opponent's Mark prior to the formal license agreement. I would add that the date of first use of the Opponent's Mark by Aspen Custom Trailers Inc. and Aspen Trailer Inc. has not been provided.

[48] Finally, though a reply to an undertaking suggests that Aspen Trailer Company (Alberta) Ltd. is the former name of Aspen Trailer Inc., we do not know the incorporation date of Aspen Trailer Inc. nor do we know the date the change of name occurred. Considering the ambiguity of the Johnston affidavit, I am not prepared to infer that the name Aspen Trailer Company (Alberta) Ltd. shown on the invoice dated 4/03/01 is a reference to Aspen Trailer Inc.'s former name and not to a separate entity.

[49] In the end, I am not satisfied that it can be concluded that the evidence establishes that the use of the Opponent's Mark since March 1980 has continuously accrued to the benefit of its owner. I am satisfied that the Opponent's evidence establishes continuous use of the Opponent's Mark by Aspen Custom Trailer and its predecessor in title Aspen Trailer Company Ltd. since February 17, 2003 at the utmost. Hence, although the overall consideration of the s. 6(5)(a) factor favours the Opponent, in my view it does not do so as significantly as has been argued by the Opponent. Likewise, the length of time the trade-marks have been in use is not as significant as has been argued by the Opponent.

[50] When considering the nature of the parties' wares, services and business and the nature of the parties' trade, it is the statement of wares in the application and the statement of wares and services in the Opponent's registration that govern the assessment of the likelihood of confusion under s. 12(1)(d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is ambiguity as to the wares or services covered in the application or registration at issue [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[51] The Opponent's Mark is registered in association with the wares "trailers, trucks, gantrys, axle boosters, hydraulic ramps" and the services "design and manufacture of heavy duty equipment transportation trailers designed to customer specifications". The Mark is applied for registration in association with "motor vehicles, namely sport utility vehicles, and their structural parts and engines".

[52] The Opponent contends that the parties' wares are "virtually identical", in that they are vehicles that travel on and are seen on road, and sometimes off road. Further, it submits that notwithstanding differences in the size of its trailers and of the Wares, "both types of vehicles

must comply with regulatory requirements, safety requirement, customer preferences and they share the same roads”. Finally, it appears that the Opponent attempts to establish a connection between its registered services and the Wares by submitting in its written argument [par. 35]: “The manufacture of any road vehicles (the Opponent’s registered services) is known by the public to be a massive undertaking requiring a high degree of commitment and resources. The public is unlikely to expect that there are two manufacturers of ASPEN vehicles [...]”

[53] In oral argument, the agent for the Applicant noted that the Opponent did not cite any cases in support of its contention that the nature of the wares supports a finding of confusion. He noted that, by contrast, the Applicant referred to cases where this Board or the Court had “refused to find a likelihood of confusion where identical or practically identical trade-marks” were used on modes of transportation (motorcycles and trucks; bicycles and automobiles; bicycles and motorcycles). In reply, the agent for the Opponent argued that the cases cited by the Applicant are distinguishable in that the wares at issue in these cases were not vehicles as in the present case.

[54] The issue of confusion between the Mark and the Opponent’s Mark is a question of probabilities and surrounding circumstances based on the particular facts of this case. In other words, each case must be decided upon its own merit. The fact that the parties’ wares may both be considered modes of transportation does not necessarily lead to a finding that the wares are similar [see *Ford Motor Co. v. Engines Specialties Inc.* (1974), 15 C.P.R. (2d) 83 (T.M.O.B.); *Dr. Ing h.c.f. Porsche AG v. Procycle Inc.* (1982), 45 C.P.R. (3d) 432 (T.M.O.B.); *Groupe Procycle Inc. v. DaimlerChrysler Corp* (2008), 72 C.P.R. (4th) 332; aff’d 2010 FC 918 (F.C.)].

[55] There is no evidence to support the Applicant’s submission that car companies do not make trailers and that trailer companies do not make cars. However, as discussed hereafter, there is no evidence that the Opponent designs and manufactures vehicles for transporting passengers.

[56] Having reviewed the exhibits to the Johnston affidavit, in particular Exhibits B and E, I conclude that the trailers associated with the Opponent’s Mark are used for the transport of equipment (often overweight and over-dimensional) and not for the transport of passengers. Also, the trailers are not self-propelled. In that regard, Mr. Johnston testifies that “[t]here is no

instances [in the marketing material filed with his affidavit] where a motor is used [on its own] to move a trailer down a highway” [p. 22 of the transcript].

[57] Insofar as the registered wares “trucks” are concerned, I find the following excerpt of the Johnston cross-examination to be noteworthy [p. 22 of the transcript]:

Q [...] the first picture at the top of [page 46 of Exhibit 1] shows a truck or tractor cab attached to a trailer. I take it you do not design, manufacture or sell the truck -- motorized truck at the front here?

A By “truck” you’re defining the actual tractor?

Q Right.

A There are other definitions of “truck.” I want to be clear that by “truck” you’re meaning the tractor at the front?

Q But you agree with me the words “truck” and “tractor” are interchangeable?

A Truck is also used quite often in our industry, as well as in railroads, to define undercarriage with running gear on it. So in this instance --

[...]

Q I’m talking about your products then.

A. Okay. So what I want to try to clarify is you’re pointing out to the tractor on the front. We do not design or manufacture that tractor.

[58] Having considered the exhibits to the affidavit of Mr. Johnston as well as his cross-examination, I conclude that the trucks associated with the Opponent’s Mark are what the *Oxford Canadian Dictionary* defines as “any of a variety of wheeled carts and platforms used to transport goods”.

[59] On cross-examination Mr. Johnston explains that a gantry is a crane-like structure that is mounted on the ground; it could have wheels. He also explains that an axle booster “is a generic name for something that is put on either the front or the back of another piece of equipment to attach additional suspension components or wheels”. Finally, he explains that a hydraulic ramp is a powered ramp that helps move from a lower grade to a higher grade or vice-versa [pp. 9-10 of the transcript].

[60] Both parties agree that the wares at issue are expensive and that care would be taken in purchasing them, but this is where their agreement ends. Indeed, the Applicant submits that the price of the parties’ wares favours a finding of no likelihood of confusion whereas the Opponent contends that it does not decrease the likelihood of confusion.

[61] More particularly, the Opponent submits that it is not only the ultimate end users of the parties' wares that must be considered, but also the member of the public who is familiar with the Opponent's Mark from "having rented or used and (*sic*) ASPEN trailer or having worked on a worksite that used ASPEN trailers. The familiarity may also come from having seen ASPEN trailers on the road, or from having seen Aspen marketing materials." The Opponent argues that the "concern of many consumers in purchasing vehicles is with the brand and its features rather than the particular manufacturer". The Opponent therefore submits that a purchaser of the Wares "imbued with an imperfect recollection of the Opponent's trailers and trade name [...] may well assume that whoever is offering for sale the ASPEN SUV must be the entity that made the Opponent's trailers (even if the purchaser thinks that was Chrysler)".

[62] I disagree with the Opponent's contention that the price of the parties' respective wares does not reduce the likelihood of confusion. In *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 at 261-32, the Federal Court of Appeal has stated:

The relevant factors under [the nature of the wares, services or business] will include not only the general class of goods that are involved, but also the quality and price of those goods. The consideration of price stems from the assumption that a consumer will be more careful when purchasing an expensive item, such as an automobile, than where inexpensive goods are concerned. In the former case, there is less likelihood of confusion even in the case of identical marks because a shopper will be assumed to undertake a judicious inquiry of the wares or service that he or she is purchasing, and not rely simply upon the hasty impression of a trade-mark or trade-name. With less expensive goods or services, more reliance may be placed on those marks and less care taken to ensure that the product is truly from the source which the consumer expects.

[63] In elaborating on the consumer in question, Mr. Justice Binnie stated in *Mattel*:

57 [...] I fully agree with Linden J.A. in *Pink Panther* that in assessing the likelihood of confusion in the marketplace "we owe the average consumer a certain amount of credit" (para. 54). A similar idea was expressed in *Michelin & Cie v. Astro Tire & Rubber Co. of Canada* (1982), 69 C.P.R. (2d) 260 (Fed. T.D.), at p. 263:

...one must not proceed on the assumption that the prospective customers or members of the public generally are completely devoid of intelligence or of normal powers of recollection or are totally unaware or uninformed as to what goes on around them.

[64] Even though the Applicant's sport utility vehicles and the Opponent's trailers and trucks are both modes of road transportation, the evidence of record satisfies me that they are specifically different and are used for different purposes. Further, I have no difficulties concluding that the Applicant's sport utility vehicles are not similar at all to the gantrys, axle boosters and hydraulic ramps listed in the registration, whether or not these are wheeled and powered by an engine. Likewise, I find that there is not a direct connection between the Applicant's sport utility vehicles and the registered services.

[65] Considering the differences between the parties' respective wares and the fact that they would not be purchased hastily or without due consideration, I find that the factor listed at s. 6(5)(c) of the Act significantly favours the Applicant.

[66] As to the nature of the trade, the evidence establishes that the Wares are sold through the Applicant's network of dealers. As rightly submitted by the Applicant, there is no clear statement in the Johnston affidavit as to the Opponent's channels of trade. Having closely reviewed Exhibits B and E to the Johnston affidavit, I find it can be fairly concluded that the primary markets for the Opponent's wares and services are the heavy haul transport, construction, logging, oilfield and mining industries. I would add that the Applicant rightly argues that there is no evidence to establish that the trailers associated with the Opponent's Mark were rented by member of the public.

[67] The evidence of record satisfies me that the Wares and the Opponent's wares and services are directed towards different markets and so I am satisfied that the s. 6(5)(d) factor significantly favours the Applicant.

[68] The evidence advances two additional surrounding circumstances: the state of the register/marketplace and the absence of actual confusion.

[69] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [see *Kellogg Salada*

Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R. (3d) 349 (F.C.A.)). In oral argument, the Applicant conceded that the two registrations introduced into evidence by the Palmer affidavit are insufficient to make any inference about the state of the marketplace.

[70] It has often been said that an opponent does not need to prove instances of confusion. The burden is on an applicant to demonstrate the absence of a likelihood of confusion. In other words, neither the testimony of Ms. Berry, nor the absence of evidence of confusion relieves the Applicant from its burden of proof. While the co-existence of the parties' marks since September 2006 without any evidence of confusion may lend support to the Applicant's case, I find it unnecessary to consider that additional circumstance in order to find in favour of the Applicant.

[71] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in particular the nature of the wares, services and business and the nature of the trade, I find that there is not a reasonable likelihood that the Mark will prompt the consumers to think that the Wares come from the same source as those covered by the Opponent's Mark or that the Wares are otherwise associated with the Opponent. Therefore, I find that the Applicant has discharged its burden of showing, on a balance of probabilities, that the Mark is not confusing with the Opponent's Mark.

[72] Having regard to the foregoing, I dismiss the ground of opposition based upon s. 12(1)(d) of the Act.

[73] I would like to add that even if I was wrong in considering that the Opponent's evidence did not establish use of the Opponent's Mark accruing to the benefit of its owner since March 1980, the outcome of the ground of opposition would have been the same. Indeed, I would still have found that the factors set forth at s. 6(5)(c) and 6(5)(d) of the Act served to shift the balance of probabilities in favour of the Applicant.

Non-entitlement

[74] I am satisfied that the Opponent has discharged its initial evidentiary burden with respect to each of the non-entitlement grounds of opposition.

[75] As I am of the view that the factors set forth at s. 6(5)(c) and 6(5)(d) of the Act are most significant, the difference in the material date under the non-entitlement ground of opposition based upon s. 16(3)(a) of the Act does not impact my previous analysis of the surrounding circumstances under the registrability ground of opposition.

[76] My analysis of the surrounding circumstances under the non-entitlement ground of opposition based upon s. 16(3)(c) of the Act would generate the same results as those obtained under the non entitlement ground of opposition based upon s. 16(3)(a) of the Act.

[77] Having regard to the foregoing, I find that the Applicant has discharged its onus to establish on a balance of probabilities that the Mark, as of October 28, 2004, was not confusing with the Opponent's trade-mark and trade-name ASPEN. Accordingly, I dismiss the grounds of opposition based upon s. 16(3)(a) and s. 16(3)(c) of the Act.

Non-distinctiveness

[78] The outcome of the non-distinctiveness ground of opposition essentially turns on the issue of confusion between the Opponent's trade-mark and trade-name ASPEN.

[79] The Opponent's position is no stronger as of the filing date of the statement of opposition, than it is as of the today's date or as of the filing date of the application. Accordingly, I find that the Applicant has discharged its onus to establish on a balance of probabilities that the Mark, as of September 4, 2007 was not confusing with either the Opponent's trade-mark ASPEN or the Opponent's trade-name ASPEN. Therefore, I dismiss the ground of opposition based upon non-distinctiveness.

Non-conformity to s. 30(i) of the Act

[80] The Opponent is essentially alleging that, at the filing date of the application, the Applicant could not have been satisfied that it was entitled to use the Mark in association with the Wares in view of the allegations contained in the statement of opposition. The Opponent has not claimed that the Applicant was aware of the Opponent's alleged prior rights. In any event, mere awareness of prior rights alleged by an opponent does not preclude an applicant from truthfully making the statements required by s. 30(i) of the Act.

[81] Where an applicant has provided the statement required by s. 30(i) of the Act, a ground of opposition based upon non-conformity to s. 30(i) should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant, which is not the case here [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The ground of opposition based upon non-conformity to s. 30(i) of the Act is accordingly dismissed.

Disposition

[82] Having regard to the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office