

TRADUCTION/TRANSLATION



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

Citation: 2012 TMOB 37
Date of Decision: 2012-02-27

**IN THE MATTER OF AN OPPOSITION by
Bombardier Inc. to application No. 1,288,759 for
the trade-mark DEHAVILLAND produced by
Jean-Daniel Carrard**

The Proceedings

[1] On January 25, 2006, Jean-Daniel Carrard (the Applicant) filed application No. 1,288,759 to register the trade-mark DEHAVILLAND (the Mark) in association with: clocks and timepieces, namely watches for aircraft pilots (the Wares).

[2] The application is based on proposed use in Canada, and the Applicant claims the priority set out in section 34 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), on the ground that an application for registration of the same or substantially the same Mark was filed in Switzerland by the Applicant on July 25, 2005, under No. 56069/2005.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 3, 2007. Bombardier Inc. (the Opponent) filed a statement of opposition on March 2, 2007, which the Registrar forwarded to the Applicant on March 12, 2007. The Applicant filed on June 29, 2007, a counter statement denying all the grounds of opposition described below.

[4] The Opponent's evidence under rule 41 of the *Trade-marks Regulations* [SOR/2007-91, s. 1] (the Regulations) consists of affidavits from Guy Dionne, Lance Kessler, Isabelle Metzger and Frédéric Beaulieu Patenaude as well as a certified copy of the registrations for the marks DE HAVILLAND and DE HAVILLAND & Design. However, Ms. Metzger's affidavit was replaced by that of Philippe Borms. All of the Opponent's affiants were cross-examined, with the exception of Ms. Metzger, and transcriptions of these cross-examinations were filed on record.

[5] The Applicant, under rule 42 of the Regulations, filed the affidavit of Line Abecassis.

[6] Only the Opponent filed a written argument and was represented at the oral hearing.

The grounds of opposition

[7] The various grounds of opposition pleaded by the Opponent in its statement of opposition can be summarized as follows:

1. The Mark is not registrable pursuant to the provisions of paragraph 12(1)(d) of the Act because it is confusing with the following of the Opponent's registered marks:

DE HAVILLAND, certificate of registration TMA457308 for aircraft;
DE HAVILLAND & Design, illustrated hereafter, certificate of
registration TMA664499 for clothing and caps



2. The Applicant is not the person entitled to the registration of the Mark pursuant to the provisions of paragraph 16(2)(a) of the Act because on the priority date of this application, the Mark was confusing with the marks DE HAVILLAND and DE HAVILLAND & Design, previously used in Canada by the Opponent or its predecessor-in-title;

3. The Applicant is not the person entitled to the registration of the Mark pursuant to the provisions of paragraph 16(3)(a) of the Act because on the priority date of this application, the Mark was confusing with the marks DE HAVILLAND and DE HAVILLAND & Design, previously used in Canada by the Opponent;
4. The Mark is not distinctive within the meaning of section 2 of the Act in that it does not distinguish the Wares from the wares and services of others and more specifically of the Opponent because, at the filing date of the statement of opposition, the Mark created confusion with the Opponent's DE HAVILLAND and DE HAVILLAND & Design marks.

Burden of proof when opposing registration of a trade-mark

[8] In the context of trade-mark opposition proceedings, the opponent must present sufficient evidence related to the grounds of opposition that it raised to make it apparent that facts exist to support said grounds of opposition. If the opponent satisfies this obligation, the applicant must then convince the Registrar, on a balance of probabilities, that the grounds of opposition raised should not prevent the registration of the mark [see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.), and *John Labatt Ltd. v. Molson Companies Limited*, (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)].

[9] In its written argument and during the oral hearing, the Opponent admitted that it had not succeeded in demonstrating prior use of its DE HAVILLAND trade-mark in association with aircraft and aircraft parts. However, it maintains the grounds of opposition based on paragraphs 16(2)(a) and 16(3)(a) in association with clothing and accessories by reason of prior use of said mark in association with said wares.

Grounds of opposition based on paragraph 12(1)(d) of the Act

[10] The Opponent alleges in its first ground of opposition that the Mark is confusing with the registered trade-marks listed above. The Opponent filed a certificate of authenticity for each of its marks. I exercised my discretion to check the register [see *Quaker Oats Co. of Can. v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)] and confirm that the registrations are extant. Thus, the Opponent met its initial evidential burden.

[11] The Applicant must therefore show, on a balance of probabilities, that on the date of the Registrar's decision, there is no risk of confusion between the Mark and any one of the marks cited by the Opponent [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413, at 424 (F.C.A.)]. The applicable test is described in subsection 6(2) of the Act. Thus, the use of the Mark will cause 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. A non-exhaustive list of relevant circumstances is set out in subsection 6(5) of the Act, namely: 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, services, or business; the nature of the trade; the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[12] The Supreme Court of Canada in *Masterpiece Inc. v. Alavida Lifestyles Inc. et al.*, 2011 SCC 27, interpreted subsection 6(2) and shed light on the implications of the various criteria listed in subsection 6(5) of the Act. This analysis indicates that the degree of resemblance between marks at issue often remains the most important factor.

Inherent distinctiveness of the marks and the extent to which they have become known

[13] The Opponent claims that the Mark does not benefit from a strong distinctiveness when it is used in association with watches for aircraft pilots. It bases this claim on the fact that the Mark is a known family name in the field of aviation. To this end, it filed, as an annex to its written arguments, an excerpt from the *Wikipedia* encyclopedia, which can be found on the Internet. My colleague Cindy Folz studied the admissibility of content from this encyclopedia in *Canadian Council of Professional Engineers v. Alberta Institute of Power Engineers* (2008), 71 C.P.R. (4th) 37. As it is an encyclopedia, I may use my discretion to consult it. I consulted the former, but I also consulted the *Oxford Dictionary of English* [see *Scottish Cashmere Assn. Ltd. v. Fraas Manufacturing Inc.* (1988), 22 C.P.R. (3d) 185]. Therefore, I dismiss any disputes related to the admissibility of the *Wikipedia* excerpt filed by the Opponent on the ground that it was not filed as evidence.

[14] Mr. De Havilland was a British aviation pioneer and aeronautical engineer. There is no doubt that his name is known throughout the aviation world, specifically by aircraft pilots. The Registrar recognizes that in cases where the trade-mark represents the name of an actual historical person, it possesses a low degree of inherent distinctiveness [see *Becker Milk Co. Ltd. v. Interstate Brands Co.* (1996), 67 C.P.R. (3d) 76]. The degree of inherent distinctiveness is further reduced when the Mark is used in association with wares for aircraft pilots. This trade-mark is the property of the Opponent, as evidenced by certificate of registration TMA457,308.

[15] Further, Mr. Kessler, employed by the Opponent, indicated during his cross-examination that DE HAVILLAND is also a renowned mark in the field of aviation. It is a propeller-based model that only requires a short distance for takeoff and landing. Mr. Kessler confirmed that the DE HAVILLAND model is an icon in the field of aviation.

[16] There is no evidence of use of the DE HAVILLAND trade-mark by the Opponent in association with aircraft. However, there is evidence of use of the DE HAVILLAND & Design trade-mark in association with clothing and accessories as described below.

[17] Mr. Kessler has worked in the Opponent's Toronto factory since 1978. Presently, he acts as quality representative for the Opponent's clients. As such, he acts as a liaison between the Opponent's clients, namely those who purchase its aircraft, and the Opponent's representatives, who are responsible for building them. On a voluntary basis, he also acts as manager of the boutique located in the main cafeteria of the aforementioned factory, which sells wares bearing the Opponent's marks, including the marks DE HAVILLAND and DE HAVILLAND and various designs. This commerce began in 1986. The items sold include T-shirts, sweaters, coats, caps, insignia, stickers and key chains.

[18] He filed photographs of the business's storefront as well as photographs of various items offered for sale bearing the above-mentioned marks, including clothing and caps. He mentioned that the clientele is mainly made up of the Opponent's employees as well as those who frequent the Flight Safety International centre adjacent to the Opponent's factory in Toronto. Members of the general public may also purchase these wares.

[19] He provided total sales figures from August 1, 2001, onward. However, he could not provide exact figures for the sale of wares bearing the marks DE HAVILLAND and DE HAVILLAND and various designs. According to him, these sales figures are estimated to be roughly 10% of the total sales. Thus, sales of wares bearing these marks varied between \$18,000 and \$40,000 annually from August 1, 2001, to July 31, 2007.

[20] With this evidence, the Applicant attempted to attack the inherent distinctiveness of the Opponent's DE HAVILLAND mark. Line Abecassis works as a lawyer in the firm of the Applicant's agents. She received instructions from another member of the firm to perform an Internet search to find references made to the word "dehavilland". She performed these searches, and using the Google search engine obtained close to 2.5 million results. She filed excerpts from websites in which the word "dehavilland" appeared or in which products associated with the word "dehavilland" were offered in Canada.

[21] One cannot lose sight of the fact that the validity of the marks registered by the Opponent is not in question in this opposition proceeding. Further, there is no evidence on record for use in Canada, within the meaning of subsection 4(1) of the Act, of the DE HAVILLAND mark by others in association with the wares appearing on these sites.

[22] I note that the majority of these excerpts correspond to sites that the Applicant's agent presented to Mr. Dionne, Senior Director of Legal Services at Bombardier Aerospace, a division of the Opponent, during his cross-examination. In response to the undertakings given by Mr. Dionne in his cross-examination, he indicated that the majority of the entities that can be identified on these websites have been, over the years, the Opponent's suppliers for wares bearing its DE HAVILLAND mark.

[23] There is no evidence of use of the Mark in Canada. Under these circumstances, I find that the first factor listed in paragraph 6(5)(a) favours the Opponent.

The length of time the trade-marks have been in use

[24] Given the evidence described above, this factor favours the Opponent with respect to its DE HAVILLAND & Design trade-mark, used in association with clothing and caps. With respect to the DE HAVILLAND mark, certificate of registration TMA457,308, it does not favour either of the parties because there is no evidence on record for use of this mark by the Opponent in association with aircraft.

The nature of the wares, services, or business; the nature of both parties' trades

[25] At first glance, there does not appear to be any connection between watches and aircraft. In regards to clothing and accessories on one hand and watches on the other, they are both wares associated with fashion in general.

Degree of resemblance

[26] The Mark is phonetically identical to the mark DE HAVILLAND, certificate of registration TMA457,308. I am not taking into account the fact that the Mark is written as a single word. That distinction is too minor for the average consumer with an imperfect recollection to differentiate between the marks at issue on this basis alone. As the marks at issue are identical, there can be no differences in the ideas they suggest. In regards to the DE HAVILLAND & Design mark illustrated above, certificate of registration TMA664,499, the dominant elements are the word DE HAVILLAND and the design of an aircraft. Therefore, there is a certain phonetic resemblance between the Mark and this trade-mark of the Opponent.

Additional circumstances

[27] Nevertheless, I must return to the evidence presented by the Opponent to establish a specific connection between the Wares and Opponent's aircraft models.

[28] Mr. Dionne alleges in his affidavit, and this evidence is uncontradicted, that the Opponent is a global leader in the field of aircraft and rail transportation equipment manufacturing. Thus, the BOMBARDIER mark is globally known in the fields of aeronautics and rail transportation.

[29] Mr. Dionne affirms that, to promote its trade-marks in association with its aircraft, the Opponent markets and distributes promotional objects including high-end watches. These objects are given to clients, suppliers, or employees, or are sold by the Opponent or by its licensees/distributors.

[30] On March 24, 2004, the Opponent concluded an exclusive licensing agreement with B-Watches SARL (B-Watches) in which the Opponent authorized the latter to manufacture, distribute, sell, and promote watches of the BOMBARDIER mark in Canada and other countries. The watches are sophisticated, high-end, and aviation-style. The target clientele consists of aircraft pilots, engineers, consumers, and travellers who are prepared to spend close to \$5000 for a watch. The price of these watches varies according to model, and ranges from \$2000 to \$40,000. The Opponent controls the quality of the BOMBARDIER watches manufactured by its licensee through the approval of design sketches, samples, packaging, and promotional materials.

[31] The promotional material emphasizes the connection between aircraft manufactured by the Opponent and its watches bearing the BOMBARDIER mark (see Exhibit GD-3 attached to Mr. Dionne's affidavit). Also attached are specific excerpts from the B-Watches website showing BOMBARDIER brand watches that have been distributed in Canada and in other countries since 2004.

[32] Mr. Dionne filed an excerpt from the Canadian Trade-marks Database regarding the registration of the BOMBARDIER mark in association with watches (TMA665,599). Prior to 2006, Time to Go Imports was the Canadian distributor for these watches. In 2006, Valangin Inc. was selected as the Canadian distributor. Mr. Dionne listed the retail establishments where consumers could purchase these watches in Canada. He filed invoices issued by Valangin to retailers to illustrate the sale of these watches.

[33] He provided the number of watch units bearing the BOMBARDIER mark sold in Canada and elsewhere in the world. Though at first glance the number of units sold is not impressive, one must take into account their sales price, as mentioned above.

[34] Mr. Dionne claimed that in 2005, the Opponent authorized B-Watches to manufacture watches bearing the trade-marks LEARJET, CHALLENGER, and GLOBAL, which correspond

to trade-marks associated with aircraft models manufactured by the Opponent. He claimed that the LEARJET watch was offered on the Opponent's website at a price of \$1999.95 and filed an excerpt from the website.

[35] Watches bearing the trade-marks LEARJET, CHALLENGER and GLOBAL were sold solely by B-Watches to the Opponent, who then distributed them to its clients or suppliers. The Opponent plans to put these watches on the market through its licensees and distributors. Mr. Dionne filed photographs illustrating models of watches bearing the CHALLENGER and GLOBAL marks, which are representative of those distributed by the Opponent since 2005. He provided the number of watches sold by B-Watches to the Opponent since 2005 in association with one of said three marks.

[36] To promote the sale of these watches, B-Watches placed advertising in the magazine *Experience*, published by the Opponent and distributed to its clients. 300 copies are distributed in Canada. Mr. Dionne filed a copy of the first advertisement from 2005 as well as a more recent example, which appeared in 2008. He also filed samples of advertisements placed by B-Watches in certain specialized magazines distributed in Canada.

[37] Philippe Borms is the founder of B-Watches SARL, which is a Swiss company that works in the field of timepieces under the names B-Watches and/or BOMBARDIER Swiss Chronographs. B-Watches acts as the Opponent's exclusive licensee for the manufacture, distribution, sale, and promotion of watches bearing the BOMBARDIER trade-mark for certain areas, including Canada.

[38] Mr. Borms claims that B-Watches became associated with the Opponent in 2004 due to its international renown in the field of aviation. He filed various excerpts from the B-Watches website, illustrating various BOMBARDIER watch models that are manufactured and sold under license by B-Watches. Since 2005, B-Watches, upon the Opponent's request, has also manufactured watches bearing the marks CHALLENGER, LEARJET and GLOBAL.

[39] Thus the evidence shows that the Opponent has been marketing its BOMBARDIER, CHALLENGER, LEARJET and GLOBAL trade-marks, normally associated with aircraft, in

association with high-end watches since 2004 by associating itself with a watch manufacturer to whom it granted a license for use of its trade-marks.

[40] Hence, there is tangible evidence that the sale of watches in association with trade-marks normally known in the field of aviation constitute not a possible extension, but a very real one with respect to products sold by the Opponent in association with its trade-marks. Therefore, I conclude that in the present case, by reason of the evidence on record, there exists a connection between the names of the Opponent's aircraft models and the watches bearing the same names.

[41] I consider that the association between the Opponent's marks for its aircraft models and the watches bearing these marks as an additional relevant factor favouring the Opponent, particularly since the Wares are intended for aircraft pilots. It is a case where, by reason of the evidence described above, subsection 6(2) of the Act is most relevant. Indeed, as previously mentioned, a 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 associated with those trade-marks are from the same person, "...whether or not the wares or services are of the same general class." The possibility of a connection between the watches bearing the Mark and the Opponent's aircraft bearing the DE HAVILLAND mark has been demonstrated.

Conclusion

[42] In light of the analysis of the several factors relevant to this case, I conclude that the Applicant has not fulfilled his burden of showing, on a balance of probabilities, that the Mark does not create confusion with the Opponent's DE HAVILLAND and DE HAVILLAND & Design marks. Indeed, the Mark has a low distinctiveness. The DE HAVILLAND & Design mark illustrated above, certificate of registration TMA664,499, was used in Canada whereas there is no evidence of the use of the Mark. In the present case, there exists a certain connection between the Wares and the wares covered by certificate of registration TMA457,308 because the Wares, according to their description, are intended for aircraft pilots. In any event, there is a link between clothing and watches, which are fashion accessories. Finally, the marks at issue resemble each other phonetically. As the common denominator is the word "De Havilland", I do not see how ideas suggested by these marks could differ.

[43] I would like to add that if I was wrong about the weight I placed on the degree of connection between the Wares and the Opponent's aircraft, this despite the evidence on file with regard to this matter, this evidence would be sufficient in my opinion to affirm that there are as many reasons to conclude that the Mark could create confusion with the Opponent's marks as there are to arrive at a contrary conclusion. As the burden of proof rests on the Applicant's shoulders, he would not have fulfilled this legal burden.

[44] Under the circumstances, I maintain the first ground of opposition.

Ground of opposition based on the lack of distinctiveness of the Mark

[45] The Opponent must first show that its trade-marks were sufficiently known as of the relevant date [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)]. I recall that the relevant date for the analysis of this issue is the filing date of the statement of opposition, in this case, March 2, 2007. There is evidence of use of the DE HAVILLAND & Design mark prior to March 2, 2007. Further, all evidence from the Applicant contained in the affidavit of Line Abecassis that aims to minimize the distinctiveness of the DE HAVILLAND mark is inadmissible under this ground of opposition as it falls after the relevant date. I am satisfied from the Opponent's evidence summarized above that the Opponent has met its initial evidential burden.

[46] The Applicant must therefore show that as of March 2, 2007, the Mark was distinctive or adapted to distinguish the Wares from the wares sold by the Opponent in association with its trade-marks DE HAVILLAND and DE HAVILLAND & Design. In other words, the Applicant must prove, on a balance of probabilities, that at that date, the use of the Mark in association with the Wares did not create confusion with the Opponent's aforementioned marks.

[47] I fail to see how the results of the analysis of the various relevant criteria previously performed with regard to the paragraph 12(1)(d) of the Act ground of opposition, as of the date of my decision, would be different at an earlier date, namely March 2, 2007.

[48] For the same reasons as those detailed in the previous ground of opposition, I conclude that as of March 2, 2007, the Mark used in association with the Wares was not distinctive within

the meaning of section 2 of the Act because it created confusion with the marks cited by the Opponent.

[49] I therefore maintain the fourth ground of opposition.

Remaining Grounds of Opposition

[50] The Opponent having been successful under two separate grounds of opposition, I do not see the relevance of ruling on the remaining grounds of opposition.

Disposition

[51] Pursuant to the authority delegated to me under subsection 63(3) of the Act, I refuse the application for registration of the Mark pursuant to subsection 38(8) of the Act.

Jean Carrière
Member of the Trade-Marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
[Jane Kuna]