

**IN THE MATTER OF AN OPPOSITION by  
CommScope Solutions Properties, LLC to  
application No. 1,208,696 for the trade-mark  
GIGAMEDIA filed by Rexel Canada Electrical  
Inc./Rexel Canada Électronique Inc.**

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[1] On March 5, 2004, Rexel Canada Electrical Inc./Rexel Canada Électronique Inc. (the Applicant) filed an application to register the trade-mark GIGAMEDIA (the Mark), based upon proposed use of the Mark in Canada. The statement of wares currently reads: “telecommunication supplies, devices and apparatus namely patch cords, switches, routers, media converters, cables, fiber optic patch cords, cabinets, relay racks; apparatus and instruments, modular or non-modular, for electric current supply, for conducting, transmitting, distributing, branching, transforming, accumulating, adjusting or controlling electronic current namely patch cords, switches, routers, media converters, cables, fiber optic patch cords, cabinets, relay racks; electrical fittings and wiring accessories, namely, electrical connectors, coaxial adapters, electric switches, electrical and electronic wires, key switches, network switches, electric or electronic patch cords; computer cables, electrical, coaxial, fiber optic cables.” (the Wares)

[2] The application was advertised for opposition purposes in the Trade-marks Journal of September 27, 2006. On November 27, 2006, CommScope Solutions Properties, LLC (the Opponent) filed a statement of opposition. The Opponent has pleaded grounds of opposition under s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

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

[4] The Opponent elected to not file any evidence in support of its opposition.

[5] The Applicant filed affidavits from the following individuals in support of its application: René Mérat, Richard Ferguson, Véronique Wattiez-Larose.

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

Grounds of opposition

[7] I reproduce below the grounds of opposition as pleaded by the Opponent:

1. The Application does not conform to the requirements of Section 30(e) because the Applicant's Mark was in use by the Applicant (or a predecessor-in-title of the Applicant) prior to the Filing Date.
2. In the alternative..., the Applicant's Mark is not, and cannot be, distinctive within the meaning of Section 2. The Applicant's Mark is not distinctive because it does not actually distinguish, is not adapted to distinguish, and is not capable of distinguishing the Applicant's Wares from the wares of others, and in particular the wares "patch cords, switches, routers, media converters, cables, fiber optic patch cords, cabinets, relay racks; electrical fittings and wiring accessories, namely. electrical connectors, coaxial adapters, electric switches, electrical and electronic wires, key switches, network switches, electric or electronic patch cords; computer cables, electrical, coaxial, fiber optic cables" provided by Conectis in association with the trade-marks GIGAMEDIA and GIGAMEDIA & Design (a representation of which is attached hereto...) (collectively referred to as the "Conectis Marks") used or made known in Canada since prior to the Filing Date.
3. In the alternative..., the Applicant's Mark is not registrable because it is confusing with the trade-mark GIGASPEED registered under No. TMA577964.
4. In the alternative..., the Applicant is not the person entitled to registration of the Applicant's Mark because, at the Filing Date, and at all other times, the Applicant's Mark was and is confusing with the Opponent's trade-mark GIGASPEED. The Opponent's trade-mark GIGASPEED was previously used in Canada by the Opponent or its predecessor-in-title in association with

“telecommunications network products, namely copper cable, wire, cords, patch cords and patch panels” (the “Opponent’s Wares”) since at least as early as March 12, 2003 and has not been abandoned. Further, the Opponent’s predecessor-in-title filed an application for registration of the Opponent’s said trade-mark GIGASPEED in Canada on March 12, 1998 (i.e. prior to the Filing Date), the application for which was not abandoned and which resulted in the issuance of Registration No. TMA577964 on March 24, 2003.

5. In the alternative..., the Application does not comply with the provisions of Section 30(i). The Applicant, contrary to the statement made in the Application, could not have been satisfied at the Filing Date that it was entitled to use the Applicant’s Mark in Canada in association with the Applicant’s Wares because at the Filing Date the Applicant was, or through reasonable diligence should have been, aware either that: (i) the Applicant’s Mark was confusing with the Conectis Marks; or, in the alternative, (ii) the Applicant’s Mark was confusing with the Opponent’s registered trade-mark GIGASPEED.

[8] The GIGAMEDIA & Design mark attached to the Opponent’s statement of opposition is shown below:



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[9] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[10] Given that the Opponent has not filed any evidence in these proceedings, I will first assess whether it has met its evidential burden with respect to any of the grounds of opposition.

[11] Regarding the first ground of opposition, there is no evidence that the Mark was in use in Canada before March 5, 2004. To the contrary, we have an uncontested sworn statement that the Mark had not been used or made known in Canada in association with the applied-for wares as of March 5, 2004 [see affidavit of Mr. Ferguson, Vice-President of the Nedco Division of the Applicant]. The first ground is accordingly dismissed.

[12] Regarding the second ground of opposition, the Opponent needs to have shown that as of the filing of the opposition, the pleaded mark had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)]. The mark relied upon by the Opponent is not its mark but rather the mark of an entity that it refers to as Conectis. Mr. Mérat, the Applicant's Vice-President, General Counsel and Secretary, explains that Conectis is "a member of the REXEL group and distributes wares similar to the wares covered by the Mark, but Conectis does not operate or use the Mark in Canada. The section of the connectis.fr or conectis.com website entitled Conectis Worldwide redirects users who select Canada to the www.nedco.ca website, Nedco being an operating division of the Applicant." The Opponent has not met its initial burden in support of this ground and the second ground is therefore dismissed.

[13] Regarding the third ground of opposition, the Opponent's initial burden is met if the pleaded registration is extant. When an opponent does not evidence a pleaded registration, the

Registrar has discretion to check the register in order to confirm the existence of the registration and I have done so [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. Registration No. TMA 577964 is extant. It is currently in the name of CommScope, Inc. but was owned by the Opponent when the statement of opposition was filed. The change of ownership is not an issue. In the present case, the registered mark is owned by the Opponent's successor-in-title but that is not a prerequisite to the ground of opposition being considered as an opponent may rely upon a third party's registered mark under s. 12(1)(d).

[14] Regarding the fourth ground of opposition, the Opponent must evidence use of its mark prior to March 5, 2004 and non-abandonment of its mark as of the date of advertisement of the Applicant's application (s. 16(5)). The Opponent has done neither. Further, it cannot rely upon the pleaded application in support of this ground as that application was not pending at the date of advertisement of the Applicant's application as required by s. 16(4) [*Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.) at 528]. The fourth ground is accordingly dismissed.

[15] Regarding the fifth ground of opposition, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the Opponent has not evidenced any bad faith on behalf of the Applicant, this ground is also dismissed.

#### Third ground of opposition – s. 12(1)(d)

[16] The only ground for which the Opponent has met its initial burden is the one that pleads that the Mark is not registrable because it is confusing with the trade-mark GIGASPEED registered under No. TMA577964 for telecommunications network products, namely copper cable, wire, cords, patch cords and patch panels. I will therefore now assess the evidence with a

view to determining if the Applicant has met the legal burden on it to demonstrate that, based on a balance of probabilities, confusion between GIGAMEDIA and GIGASPEED is not likely.

[17] The material date for assessing the likelihood of confusion under this ground is the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

[18] 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.

[19] In applying the test for confusion, the Registrar 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 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 C.P.R. (4th) 321 (S.C.C.)]

*(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[20] Neither mark has a great degree of inherent distinctiveness due to their suggestive character. There is no evidence that GIGASPEED has become known through use or promotion. In contrast, Mr. Ferguson attests that Canadian sales of GIGAMEDIA Wares have been as follows: 2005 - \$645,204; 2006 - \$855,997; January-August 2007 - \$738,367 and that the Applicant has spent approximately \$20,000 annually advertising the Wares in association with GIGAMEDIA. (Mr. Ferguson has provided examples of packaging and advertisements that

display the Mark.) I am therefore able to conclude that the Applicant's Mark has become known to a certain extent in Canada in association with the Applicant's Wares.

*(b) the length of time each has been in use*

[21] Mr. Ferguson attests that the Applicant began using GIGAMEDIA on April 3, 2004. The registration for GIGASPEED indicates that a declaration of use was filed on March 12, 2003.

*(c) the nature of the wares, services or business*

[22] Both marks are associated with telecommunications wares, some of which overlap.

*(d) the nature of the trade*

[23] It is not apparent that there would be any significant differences between the trades associated with each mark.

*e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[24] Although marks are to be considered in their entirety, the first component of a mark is often considered more important for the purpose of distinction [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)]. However, a word that is a common, descriptive word, is entitled to a narrower range of protection than an invented or unique word [*Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[25] Overall, I find that there is a fair degree of resemblance between GIGASPEED and GIGAMEDIA in appearance and sound but that the marks suggest different ideas. However, the words in each mark are common dictionary words that are suggestive of the associated wares.

*other surrounding circumstances*

[26] Ms. Wattiez-Larose has provided evidence that the prefix "giga-" means billions. She has also evidenced the existence of registrations for 51 GIGA prefix trade-marks, including 11 for

telecommunications supplies, devices and apparatus.

[27] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located. [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)] Therefore, the evidence before me allows me to conclude that the public at large is used to seeing marks that begin with the descriptive prefix GIGA, but not that GIGA prefix marks are commonly used in the telecommunications field.

*conclusion re s. 12(1)(d)*

[28] Having considered all of the surrounding circumstances, I dismiss the s. 12(1)(d) ground of opposition. I am satisfied that confusion between the marks is not likely. The fact that both marks incorporate the descriptive prefix GIGA is insufficient to make confusion likely in view of the differences between the remainders of the marks and the fact that the Opponent has not evidenced that its inherently weak mark has acquired any distinctiveness. Overall, based on the evidence at hand, it does not appear that GIGASPEED should be entitled to more than a rather narrow scope of protection

#### Disposition

[29] Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition, pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 23rd DAY OF OCTOBER 2009.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board