

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

Citation: 2012 TMOB 57
Date of Decision: 2012-03-21

**IN THE MATTER OF OPPOSITIONS by
88766 Canada Inc. to application
Nos. 1,295,775; 1,295,776; and 1,300,736 for
the trade-marks OMEGA Design;
OMEGA.CA; and E-OMEGA respectively,
in the name of Omega Engineering, Inc.**

[1] On March 29, 2006, Omega Engineering, Inc. (the Applicant) filed applications to register the trade-marks OMEGA Design (shown below) and OMEGA.CA based on proposed use of the marks in Canada in association with the following wares:

OM€GA

Timers and periodic timers industrially and/or scientifically employed for measuring or controlling variable parameters, such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow; computer controlled timing apparatus exclusively intended for science or industry, namely clocks and timers.
(the Wares)



[2] The application for the OMEGA.CA trade-mark includes a disclaimer of the right to the exclusive use of “.CA” apart from the mark.

[3] The Applicant further filed on May 8, 2006, a third application to register the trade-mark E-OMEGA, also based on proposed use of the mark in Canada in association with the Wares.

Unless indicated otherwise, the trade-marks OMEGA Design, OMEGA.CA and E-OMEGA will be collectively referred to in my decision as the Marks.

[4] The applications were advertised for opposition purposes in the *Trade-marks Journal* of November 15, 2006 (with respect to application No. 1,295,775 for the OMEGA Design trade-mark), January 17, 2007 (with respect to application No. 1,300,736 for the E-OMEGA trade-mark), and March 14, 2007 (with respect to application No. 1,295,776 for the OMEGA.CA trade-mark).

[5] 88766 Canada Inc. (the Opponent) filed essentially identical statements of opposition against each application on the following dates: April 16, 2007 with respect to application No. 1,295,775; May 14, 2007 with respect to application No. 1,295,776; and June 18, 2007 with respect to application No. 1,300,736. The statements of opposition, as last amended by the Opponent and accepted by the Registrar on October 13, 2009 (with respect to application No. 1,295,775) and December 3, 2009 (with respect to application Nos. 1,295,776 and 1,300,736) respectively, claim that the applications do not conform to the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act); that the Marks are not registrable pursuant to s. 12(1)(d) and 38(2)(b) of the Act, and that they are non-distinctive of the Applicant pursuant to s. 2 and 38(2)(d) of the Act in view of the fact that the Marks are confusing with the following registered trade-marks owned by a third party, namely Omega SA (Omega AG) (Omega Ltd.) (I will refer to that third party simply as Omega SA):

	
Registered on July 24, 1894 under	Registered on November 1, 1985 under

<p>No. TMDA05009. The registration, as last amended on March 1, 2006, covers the following wares : (1) <i>Montres et boîtes pour montres</i>; (2) <i>Chaînes de montres, outils et accessoires ainsi que toutes fournitures et parties détachées employées dans l'horlogerie et la bijouterie y soient inclus</i>; (3) <i>Etuis et emballages, nommément: contenants sous forme de housses en tissus et boîte; compteurs et chronographes qui servent au chronométrage sportif; et appareils techniques et scientifiques pour l'électricité, l'optique, la télégraphie, le cinéma, la radio, la téléphonie, la télégraphie, nommément: la [sic]cellules photo-électriques, portails à contact, compteurs enregistreurs sur bande de papier, pistolets de start à contacts électriques.</i> First use of the mark with wares (1)1895; 1939 with wares (2) and 1950 with wares (3).</p>	<p>No. TMA307,956 in association with the following wares and services : <i>Appareils relatifs aux activités sportives, nommément: chronomètres, tableaux de pointage et tableaux indicateurs, pour le pointage, le contrôle et la mesure du temps, des distances, des scores, des heures et des dates</i> and <i>Services de conseil relativement à la planification et installation d'appareils de pointage, de contrôle et de mesure de temps et de distances, destinées principalement au domaine sportif.</i> Declaration of use of the mark filed July 11, 1985.</p>
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[6] The Applicant filed and served a counter statement in each case in which it denied the Opponent's allegations.

[7] As its evidence in each case, the Opponent filed the solemn declarations of Iana Alexova, an articling student with the law firm representing the Opponent in the instant proceedings, sworn May 28, 2008; Karine Jarry, also an articling student with the same law firm, sworn June 3, 2008; and Rita Goedike, an administrative assistant with the same law firm, sworn May 30, 2008. The Opponent also filed certified copies of:

- registration Nos. TMDA05009 and TMA307,956 for the OMEGA Design trade-marks owned by Omega SA;
- the following documents from the opposition and file history of application No. 849,631 for the OMEGA OE & Design trade-mark, which became registration No. TMA675,419:
 - statement of opposition filed by Omega SA;
 - Office letter dated October 12, 2000 and attachment thereto consisting of a copy of an amended trade-mark application filed on August 29, 2000 by the Applicant;

- letter dated April 22, 2002 from the law firm Ridout & Maybee LLP and accompanying affidavit of Ralph S. Michel filed on behalf of the Applicant pursuant to r. 42 of the *Trade-marks Regulations*, SOR/96-195;
- Office letter dated May 16, 2006 enclosing copy of the decision of the Registrar dated April 24, 2006; and
- Office letter dated June 15, 2006 enclosing copy of a corrected page of the aforementioned decision of the Registrar;
- registration No. TMA675,419 for the OMEGA & OE Design trade-mark owned by the Applicant;
- registration Nos. TMA444,181 and TMA385,165 respectively for the ST. TROPEZ and TROUSSEAU trade-marks owned by Bijoux Continental Inc.; and
- Quebec Enterprise Register information regarding Bijoux Continental Inc.

[8] As its evidence in each case, the Applicant filed the affidavit of B. Christine Riggs, In-House Counsel of the Applicant, sworn January 29, 2009. The Opponent filed in each case, reply evidence consisting of a certified copy of the Quebec Enterprise Register relating to Omega Environmental Inc. and a further affidavit of Ms. Goedike, sworn June 30, 2009. I will use the singular form to refer to the three affidavits (that is one per file) of each of the aforementioned affiants filed in the instant cases as they are identical.

[9] Both parties filed written arguments in each case and both were ably represented by counsel at an oral hearing held on February 1, 2012. I will use the singular form to refer to the three written arguments filed by each party in the instant cases as they are either identical or almost identical.

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[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements of the Act. However, there is an initial evidentiary 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*

Ltd v. Molson Companies Ltd. (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[11] Applying these principles to the instant cases, the only grounds of opposition the Registrar must decide on are those based on non-conformity pursuant to s. 30(a) of the Act, and non-registrability of the Marks pursuant to s. 12(1)(d) of the Act. The other s. 30 grounds of opposition as well as the non-distinctiveness ground of opposition can be summarily dismissed as follows.

Non-compliance with s. 30(e) of the Act

[12] As put forward by the Applicant in its written argument, although not specifically pleaded with reference to an actual subsection of s. 30 of the Act, the grounds of opposition pleaded by the Opponent in subparagraphs 1.1 to 1.3 of each of its re-amended statements of opposition all purport to take issue with the Applicant's claim that it intends to use the Marks in Canada in association with the Wares.

[13] I do not wish to discuss in detail each and every of the specific grounds of opposition contained in the aforementioned subparagraphs 1.1 to 1.3. Suffice it to say that, as stressed by the Applicant in its written argument, there is no evidence whatsoever that puts into issue the correctness of the proposed use basis claimed in each of the Applicant's applications. Accordingly, each of the grounds of opposition pleaded by the Opponent in subparagraphs 1.1 to 1.3 of its re-amended statements of opposition is dismissed as the Opponent has failed to meet its initial evidentiary burden in respect thereof.

Non-compliance with s. 30(i) of the Act

[14] As put forward by the Applicant in its written argument, although not specifically pleaded with reference to an actual subsection of s. 30 of the Act, the ground of opposition pleaded by the Opponent in subparagraph 1.4 of each of its re-amended statements of opposition is based on s. 30(i) of the Act in that it purports to take issue with the Applicant's statement in its

applications that it is satisfied that it is entitled to use the Marks in Canada in association with the Wares.

[15] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. There is no such evidence in the instant cases. Indeed, the mere fact that the Applicant's prior trade-mark application No. 849,631 for the OMEGA & OE Design mark has been refused by the Registrar with respect to the wares "clocks" and "timers" [see the Registrar's unreported decision in *Omega S.A. v. Omega Engineering, Inc.* dated April 24, 2006 (*Omega*), a certified copy of which has been filed by the Opponent as mentioned above] does not preclude it from making the statement in each of its applications required by s. 30(i) of the Act. Suffice it to say that, as stressed by the Applicant in its written argument and at the oral hearing, the statement of wares that was in issue in the Applicant's prior trade-mark application No. 849,631 differs from the one covered by the instant applications. Furthermore, the instant applications were filed prior to either the issuance or the sending of the Registrar's aforementioned decision. Accordingly, the ground of opposition pleaded by the Opponent in subparagraph 1.4 of each of its re-amended statements of opposition is dismissed as the Opponent has failed to meet its initial evidentiary burden in respect thereof.

Non-distinctiveness of the Marks

[16] The non-distinctiveness ground of opposition, as pleaded by the Opponent in subparagraphs 3.1 to 3.3 of each of its re-amended statements of opposition, has three prongs.

[17] The first prong can be summarily dismissed on the basis that the Opponent has failed to show that as of the filing date of each of its statements of opposition the OMEGA & Design trade-marks owned by Omega SA had a substantial, significant or sufficient reputation in Canada so as to negate the distinctiveness of the Marks [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. The Opponent has not filed any evidence demonstrating the extent to which these two trade-marks of OMEGA SA have been used or

become known in Canada. The mere existence of registration Nos. TMDA05009 and TMA307,956 can establish no more than *de minimis* use of Omega SA's trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)].

[18] The second and third prongs can also be summarily dismissed on the basis that the Opponent has not met its initial evidentiary burden in respect thereof. There is no evidence whatsoever revolving around the use of the Marks by other entities, be it by the indefinite entity “*Omega de Laval, Québec, Canada*” alleged in the statements of opposition or the Applicant's wholly-owned subsidiary Omega Environmental Inc., Quebec, Canada, that puts into issue the distinctiveness of the Marks pursuant to s. 48(2) or 50 of the Act. Suffice it to say that the instant applications are based on proposed use of the Marks in Canada and that there is no evidence of use by third parties of the Marks, or that such use is not properly licensed. Regardless, the relationship between the Applicant and its licensee Omega Environmental Inc. has been clarified by the Riggs affidavit.

Other grounds of opposition

[19] There remains the grounds of opposition based on non-conformity pursuant to s. 30(a) of the Act, and non-registrability of the Marks pursuant to s. 12(1)(d) of the Act.

Section 30(a) ground of opposition

[20] The Opponent has pleaded that each of the applications does not comply with the requirements of s. 30(a) of the Act because each of them does not describe the Wares in ordinary commercial terms, notably the general category of “computer controlled timing apparatus” does not have as broad a scope as the terms it defines (“clocks and timers”), and the applied-for wares “timers and periodic timers” are not designed to measure or control the parameters listed in the statement of Wares.

[21] Concerning more particularly the applied-for wares described as “computer controlled timing apparatus exclusively intended for science or industry, namely clocks and timers”, I agree

with the Applicant that on a plain reading of the Wares, the phrase “namely clocks and timers” would be understood to be narrower than the “computer controlled timing apparatus” which precedes it. As stressed by the Applicant in its written argument, the Canadian Intellectual Property Office (CIPO)’s *User Guide of the Wares and Services Manual* expressly provides at s. 2.1 that “the context may serve to specify an otherwise unacceptable identification of wares”. In the instant cases, “clocks and timers” would be understood in the context of “computer controlled timing apparatus” and would not be interpreted as broader than “computer controlled timing apparatus”, not to mention that there is no indication that the identification of the wares “clocks and timers” in that context would be unacceptable.

[22] It is worth noting that the Opponent did not file evidence to support its allegation that the applied-for wares described as “computer controlled timing apparatus exclusively intended for science or industry, namely clocks and timers” are not described in ordinary commercial terms. By contrast, the Riggs affidavit supports the Applicant’s position that such wares are defined in ordinary commercial terms. Indeed, Ms. Riggs states in her affidavit that the Applicant is a world leader, including in Canada, for the manufacture and distribution of measuring and data acquisition apparatus designed and intended for science and industry. Ms. Riggs states that included within the products offered by the Applicant are a line of computer controlled timing apparatus, namely clocks and timers, which are exclusively intended for science and industry. She attaches to her affidavit as Exhibit A copies of sample specification sheets of some of the Applicant’s timers and computer controlled timing apparatus products, which include computer controlled timers [see Exhibit A, page M-127 featuring “Panel-Mount Programmable Timer and Real-Time Clock”]. As Ms. Riggs explains in her affidavit, these products are indicative of the types of timers and computer controlled timing apparatus that are intended to be sold in association with the Marks.

[23] Likewise, the Opponent’s allegation that the applied-for wares described as “timers and periodic timers” are not designed to measure or control the parameters listed in the statement of Wares is without evidentiary foundation. As the instant applications are based on proposed use, I agree with the Applicant that the Opponent’s allegation is mere speculation. Regardless, Ms. Riggs explains in her affidavit that the Applicant’s timers and periodic timers, indicative of

the type intended to be sold in Canada in association with the Marks, are industrially and/or scientifically employed by engineers, technicians and scientists for measuring or controlling variable parameters, such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow. They offer many features and performance capabilities that suit a wide range of industrial applications. For example, some of these timers are designed for use with other products of the Applicant, including thermostats and meters [see Exhibit A to the Riggs affidavit].

[24] Accordingly, the s. 30(a) ground of opposition is dismissed in each case on the basis that the Opponent has not satisfied its evidentiary burden in respect thereof.

Section 12(1)(d) ground of opposition

[25] The Opponent has pleaded that the Marks are not registrable having regard to the provisions of s. 12(1)(d) of the Act in that they are confusing with Omega SA's OMEGA Design trade-marks identified above. I have exercised the Registrar's discretion to confirm that registration Nos. TMDA05009 and TMA307,956 are in good standing as of today's date.

[26] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between each of the Marks and either of Omega SA's OMEGA Design trade-marks.

[27] 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.

[28] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.)].

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

[29] The trade-marks at issue are all made up of the word “OMEGA” combined with either another word or a design element.

[30] As I may refer myself to dictionaries to determine the meaning of a word, I have looked into the *Canadian Oxford Dictionary* and found the following definition for the word “OMEGA”: “*n.* 1 the last (24th) letter of the Greek alphabet (Ω,ω). 2 the last of a series.”

[31] I assess the inherent distinctiveness of each of the Applicant’s Marks and Omega SA’s OMEGA Design marks as about the same. Neither the design element consisting of the symbol Ω standing for OMEGA, nor the suffix “.CA” nor the prefix “E-” materially add to the inherent distinctiveness of the marks at issue.

[32] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. However, as indicated above, there is no evidence that Omega SA’s OMEGA Design marks have been used or become known to any extent whatsoever in Canada; the mere existence of registration Nos. TMDA05009 and TMA307,956 can establish no more than *de minimis* use of Omega SA’s trade-marks. As also indicated above, there is no evidence that the Applicant’s proposed use Marks have been used or become known in Canada.

[33] The Applicant submits in its written argument that:

[...] in the field of science and industry, the [Marks] would have a higher degree of distinctiveness than those of Omega SA, given the extent to which its other OMEGA trade-marks are known, as shown by the [Applicant]'s history and the Michel affidavit.

I disagree for the following reasons.

[34] The Riggs affidavit by no means allows me to determine the extent to which the Applicant's so alleged "other OMEGA trade-marks" have been used and become known in Canada. As for the "Michel affidavit", the evidence of record includes two affidavits of Mr. Ralph S. Michel, which have both been filed by the Opponent in the instant proceedings, namely a certified copy of an affidavit sworn April 17, 2002, that was filed on behalf of the Applicant in support of its application No. 849,631 for the trade-mark OMEGA & OE Design, which became registration No. TMA675,419 (upon review of that affidavit, I note that the title of the affidavit apparently refers to application No. 849,629 for the trade-mark OE Design whereas the Certificate of Authenticity and accompanying letter enclosing copy of the affidavit refer to application No. 849,631); and a copy (filed as Exhibit RG-1 in support of the first Goedike affidavit) of another affidavit, also sworn April 17, 2002, that was filed on behalf of the Applicant in support of its application No. 849,631 for the trade-mark OMEGA & OE Design (upon review of that affidavit, I note that except for the title of the affidavit, which correctly refers to application No. 849,631, and the numbering of the six first paragraphs, it is identical to the other Michel affidavit mentioned above). For the ease of my discussion, I will collectively refer to these two affidavits as the Michel affidavit.

[35] As it will become apparent later on in my analysis when assessing the nature of the trade under s. 6(5)(d) of the Act, the Michel affidavit was filed by the Opponent in order to evidence the sale of the Applicant's products to a jeweller named Bijoux Continental Inc. so as to support the Opponent's argument that the nature of the Applicant and Omega SA's trade overlaps. Relying on the decision of this Board in *Bacardi & Company Limited v. Havana Club Holdings S.A.*, 2009 CarswellNat 5023, the Opponent argues that the Michel affidavit contains an admission against the Applicant's interest. While the Applicant seemingly does not object to the admissibility and reliability of the Michel affidavit as filed by the Opponent, I am of the view

that the Applicant cannot rely on that affidavit in the instant proceedings so as to support its contention that the Marks would have a higher degree of distinctiveness than those of Omega SA, given the extent to which its other OMEGA trade-marks are known. First, while the extent to which the “other OMEGA trade-marks” are known might have been a relevant surrounding circumstance to the confusion analysis, it is not relevant to the consideration of the acquired distinctiveness of the Applicant’s proposed use Marks *per se*. Second, the Michel affidavit is dated April 17, 2002. Thus, I would have to assume that there has been continuous use of the trade-marks referred to therein as of today’s date. Third, the Applicant did not make representations to that effect at the oral hearing. Rather, the Applicant indicated that the overall consideration of the s. 6(5)(a) factor in the instant cases “is a wash”.

[36] In view of the foregoing, the overall consideration of the inherent distinctiveness of the trade-marks at issue and the extent to which they have become known does not significantly favour either party.

b) the length of time the trade-marks have been in use

[37] According to the dates of first use or declarations of use alleged in Omega SA’s registrations described above, the OMEGA Design marks would have been used in Canada for a considerable length of time, whereas the Applicant’s applications are based on proposed use of the Marks. However, as the Opponent has not evidenced continuous use of the OMEGA Design marks since such alleged dates, the length of time the marks have been in use is not a material circumstance in the instant cases [see *Entre Computer Centers, supra*, at paras 9 and 10].

c) the nature of the wares, services or business; and d) the nature of the trade

[38] As for the nature of the wares and the nature of the trade, I must compare the Applicant’s statement of Wares with the statement of wares and services in the Omega SA’s registrations [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (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. The evidence of the parties' actual trades is useful in this respect [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.); and *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[39] As indicated above, the Opponent has not submitted any evidence of use of Omega SA's trade-marks nor as to the channels of trade of Omega SA's wares. In support of its submission that the nature of the Applicant's Wares and Omega SA's wares and their corresponding channels of trade overlap, the Opponent relies on dictionary definitions of the terms "horlogerie", "chronometer", "industrial", "industry", "science", "scientific", "clock", and "timer" from a variety of French and English dictionaries referred to in the Alexova affidavit. The Opponent further relies on the Michel affidavit referred to above, which evidences a sale made on June 27, 1995 by the Applicant to a jeweller named Bijoux Continental Inc. [see invoice No. 118865 included in the bundle of invoices attached as Exhibit C to the Michel affidavit]. While such invoice only refers to code numbers and abbreviations for the wares, Mr. Michel states in his affidavit that Exhibit C consists of "sample invoices showing sales of [the Applicant's] computer controlled timer wares *for science and industry* from 1987 to date" [my emphasis]. The Opponent further relies on the findings made by Board Member Carrière in the *Omega* decision according to whom there was a potential overlap in the channels of trade of the Applicant's wares covered by its application No. 849,631 for the OMEGA & OE Design trade-mark and the wares identified as "*appareils techniques et scientifiques pour l'électricité*" covered by Omega SA's registration No. TMA05009 insofar as "clocks and timers" were concerned.

[40] In support of its submission that there is little likelihood of overlap in the nature of the Applicant's Wares and Omega SA's wares and their corresponding channels of trade, the Applicant relies for its part on the Riggs affidavit. Ms. Riggs states in her affidavit that she is familiar with the company Omega SA, which offers a line of watches and sports timing apparatus in Canada, and throughout the world, in association with a variety of trade-marks incorporating the word "OMEGA". She further states that in order to delineate the respective rights of the Applicant and Omega SA with regard to trade-marks incorporating the word

“OMEGA” and/or the Greek letter Ω, or other elements colourably resembling either of those two elements, the Applicant and Omega SA entered into a worldwide agreement in 1994 which, in part, attempted to define the areas in which each party was permitted to use its trade-marks. She attaches as Exhibit B to her affidavit a copy of the 1994 Agreement between the Applicant and Omega SA (the 1994 Agreement).

[41] More particularly, Ms. Riggs states in paragraphs 5 and 6 of her affidavit that:

5. As noted in [paragraph 4(a)] of the 1994 Agreement, the Applicant is specifically permitted to use and register any trade-mark consisting of or containing the word “Omega” or the Greek letter Ω or any mark containing elements colourably resembling either of those two elements in respect of computer controlled measuring, timing and display apparatus intended for science or industry. This matches the second part of the statement of wares in the application[s] which [are] presently opposed.

6. In paragraph 4(c) of the [1994 Agreement], Omega SA specifically agrees not to object to the use or registration by the Applicant, of any trade-mark consisting of or containing the word “Omega” or the Greek letter Ω or any mark containing elements colourably resembling either of those two elements for any apparatus industrially and/or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow. Thus timers and periodic timers industrially and/or scientifically employed for those stated reasons, as set forth in the first part of the statement of wares in [these] application[s], fall within the scope of paragraph 4(c) of the 1994 Agreement.

[42] In addition, the Applicant stresses the differences existing between the statement of Wares covered by the instant applications and the statement of wares that was partly objected to by Omega SA in the Applicant’s prior trade-mark application No. 849,631 for the OMEGA & OE Design mark, which read as follows:

Apparatus industrially and/or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain, time and flow as well as computer controlled measuring, timing and display apparatus all exclusively intended for science or industry, namely:

(...)
(g) clocks; (...) timers (...).

[43] I agree with the Applicant that there is little likelihood of overlap in the nature of the

Applicant's timers and periodic timers as these wares are defined in the first part of the statement of Wares, and Omega SA's wares and their corresponding channels of trade.

[44] The Applicant's timers and periodic timers and Omega SA's wares and services covered by TMA307,956 are significantly different. TMA307,956 covers a variety of sports timing apparatus and ancillary services, which significantly differ from the Applicant's timers and periodic timers, which are specifically focussed on the scientific and industrial trade for measuring or controlling a set of variable parameters, such as temperature, pressure, force, load, etc.

[45] The Applicant's timers and periodic timers are also substantially different than Omega SA's wares covered by TMDA05009. As indicated above, the Applicant's timers and periodic timers are meant for very specific purposes. As such they totally differ from the wares « (1) *Montres et boîtes pour montres; (2) Chaînes de montres, outils et accessoires ainsi que toutes fournitures et parties détachées employées dans l'horlogerie et la bijouterie y soient inclus; (3) Etuis et emballages, nommément: contenant sous forme de housses en tissus et boîte; compteurs et chronographes qui servent au chronométrage sportif; ». Furthermore, while they arguably fall within the general category of « *appareils techniques et scientifiques* » described in Omega SA's registration, such category is expressly restricted to « *pour l'électricité, l'optique, la télégraphie, le cinéma, la radio, la téléphonie, la télégraphie, nommément: la [sic]cellules photo-électriques, portails à contact, compteurs enregistreurs sur bande de papier, pistolets de start à contacts électriques* ».*

[46] While the 1994 Agreement is not binding upon the Registrar, I further note that the Applicant's timers and periodic timers, as these wares are defined in the first part of the statement of Wares, would seemingly fall within the scope of paragraphs 4(a) and (c) of the Agreement, which provide that:

4 Henceforth from the signing of this Agreement and effective in all countries of the World:

a. [The Applicant] undertakes not to use, register or apply to register any [trade-mark] consisting of or containing the word "OMEGA" or the Greek letter Ω or any mark containing elements colourably resembling either of those two elements in respect of

computer controlled measuring, timing and display apparatus, unless intended for science or industry.

[...]

c. OMEGA SA will not object to the use or registration by [the Applicant] of any [trade-mark] consisting of or containing the word “OMEGA” or the Greek letter Ω or any element colourably resembling either of those two elements in respect of apparatus industrially and/or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow. [my underlining]

[47] I further note that a similar finding was made by Mr. Justice Blais in *Omega Engineering Inc. v. Omega SA* (2006), 56 C.P.R. (4th) 210 (F.C.) involving the Applicant and Omega SA. In that decision, the Applicant had brought an application pursuant to s. 57 of the Act for an order amending Omega SA’s registration No. TMDA05009 or in the alternative, a declaration that the trade-mark had been abandoned. One of the arguments raised by the Applicant was that the 1994 Agreement proved Omega SA was prohibited from using the trade-mark. Here is what Mr. Justice Blais had to say about that argument:

[24] Regarding the first argument, I am not satisfied that the 1994 Co-existence Agreement proves the respondent is prohibited from using the trade-mark as argued by the applicant.

[25] Paragraph 4(b) of the Co-existence Agreement states:

[...]

[26] In my opinion, the products that are listed in this agreement are not similar to the wares that are described in the register. While the agreement prohibits the use of the products for scientific purposes, it does so in the context of measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow. The description of wares at issue in this application are for "appareils techniques et scientifiques pour l'électricité, l'optique, la télégraphie, le cinéma, la radio, la téléphonie, la télégraphie". Therefore, the wares are not similar to those whose use is prohibited by the agreement.

[48] Turning to the Applicant’s “computer controlled timing apparatus exclusively intended for science and industry, namely clocks and timers”, I agree with the Opponent that as such wares are described in the second part of the statement of Wares, there is a potential overlap with the Opponent’s wares. While the Applicant’s “clocks and timers” are “exclusively intended for

science and industry”, and as such would arguably not be prohibited by the 1994 Agreement, such limitation does little to differentiate the Applicant’s clocks and timers from the Opponent’s meters, chronographs, and technical and scientific apparatus covered by Omega SA’s registrations.

[49] As evidenced by the Opponent, the phrase “science and industry” can cover many different types of industries. The context of measuring or controlling variable parameters such as temperature, pressure, force, load, etc., as defined in the first part of the Applicant’s statement of Wares, is missing in the second part thereof.

[50] Furthermore, while the Applicant’s sample product specification sheets attached as Exhibit A to the Riggs affidavit provide an indication that the Applicant’s Wares are likely to be sold by catalogue or online through the website *omega.com*, the Michel affidavit supports the Opponent’s position that the Applicant’s clientele is not necessarily restricted to engineers, technicians and scientists and may well encompass the “jewelry industry” for instance. The diversity of the Applicant’s products is further illustrated in the Applicant’s sample product specification sheets attached as Exhibit A to the Riggs affidavit, under the heading “*More than 100,000 Products Available!*”.

[51] To sum up, I find that there is a potential overlap in the nature of the Applicant’s “computer controlled timing apparatus exclusively intended for science and industry, namely clocks and timers” and Omega SA’s meters, chronographs, and technical and scientific apparatus and their corresponding channels of trade.

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

[52] The Applicant’s OMEGA Design mark and Omega SA’s OMEGA Design marks are identical when sounded as their word portions both consist of the dictionary word OMEGA. As indicated above, while their design elements differ, neither of these designs materially adds to the inherent distinctiveness of the marks at issue. This is particularly true of Omega SA’s design

consisting of the Greek letter Ω standing for OMEGA. As such, there is a high degree of resemblance between the marks in appearance and in the ideas suggested by them.

[53] There is also a high degree of resemblance between the Applicant's OMEGA.CA and E-OMEGA marks and Omega SA's OMEGA Design marks in appearance, sound, and in the ideas suggested by them, as neither the suffix ".CA" nor the prefix "E-" materially adds to the inherent distinctiveness of the Applicant's marks. The suffix ".CA" is descriptive of the domain name extension ".CA", hence the disclaimer of the right to the exclusive use of ".CA" provided by the Applicant, whereas the prefix "E-" is suggestive of "electronic".

Additional surrounding circumstances

[54] As an additional surrounding circumstance, the Applicant points out that Omega SA has not opposed the instant applications and submits that such fact strongly suggests that the Applicant's Wares and Omega SA's wares do not overlap in commerce and that Omega SA does not consider there to be an overlap in their respective channels of trade. However, one can only speculate as to the reason why Omega SA has not opposed the instant applications. Furthermore, as stressed by the Applicant itself, the primary purpose of the Act is not the protection of the commercial interest of the owner of a trade-mark, but rather the protection of the public against the use of confusing marks in the marketplace, so that the purchaser will not be misled into buying products of one manufacturer thinking that it is the product of another manufacturer whose product he intended to buy [see *Deere & Co. v. Four Pillars Enterprises Co.* (1985), 7 C.P.R. (3d) 339 at 350 (F.C.T.D.)].

[55] As a further surrounding circumstance, the Applicant points out that the instant applications were not objected to by the Examiner at the examination stage. However, a decision by the examination section of the Trade-marks Office is not binding on this Board and does not have a precedential value for this Board given that the examination section does not have before it evidence that is filed by the parties in an opposition proceeding. Furthermore, the burden on an applicant differs whether the application is at the examination stage or at the opposition stage [see *Now Communications Inc. v. CHUM Ltd.* (2003) 32 C.P.R. (4th) 68 (T.M.O.B.); *Interdoc*

Corporation v. Xerox Corporation, unreported decision of the Trade-marks Opposition Board dated November 25, 1998 re application s.n. 786,491; *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 at 277; *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 at 386].

[56] The Applicant also submits that the Applicant's OMEGA OE & Design mark (of registration No. TMA675,419) and the two registered trade-marks of Omega SA have coexisted in the Canadian marketplace since at least 1967. However, there is no evidence that the said marks have indeed coexisted in the marketplace as submitted by the Applicant. More importantly, the statement of wares covered by registration No. TMA675,419 differs from the one covered by the instant applications. Section 19 of the Act does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.* (1984), 4 C.P.R. (3d) 108 (T.M.O.B.); *Groupe Lavo Inc. v. Proctor & Gamble Inc.* (1990), 32 C.P.R. (3d) 533 (T.M.O.B.)].

Conclusion regarding the likelihood of confusion

[57] In view of my findings made above, I find that the Applicant has failed to satisfy its burden that there is not a reasonable likelihood of confusion between the marks in issue in respect of the Applicant's wares described as: "computer controlled timing apparatus exclusively intended for science or industry, namely clocks and timers" and Omega SA's meters, chronographs, and technical and scientific apparatus.

[58] As for the remaining wares covered by the Applicant's applications, I find that the differences existing between the said wares and those of Omega SA are sufficient to preclude a likelihood of confusion.

[59] Accordingly, the s. 12(1)(d) ground of opposition based upon the likelihood of confusion between Omega SA's marks and the Marks succeeds partially in each case.

Disposition

[60] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the applications in respect of the wares described as “computer controlled timing apparatus exclusively intended for science or industry, namely clocks and timers”, and I reject the oppositions with respect to the wares described as “timers and periodic timers industrially and/or scientifically employed for measuring or controlling variable parameters, such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow”, pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) as authority for a split decision].

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office