



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

**Citation: 2011 TMOB 226**  
**Date of Decision: 2011-11-21**

**IN THE MATTER OF AN OPPOSITION**  
**by SMART Technologies ULC**  
**application No. 1,353,752 for the trade-**  
**mark SMARTECHS in the name of**  
**Sunrise Technology, Inc. dba**  
**smarTECHS.NET**

[1] On June 21, 2007, Sunrise Technology, Inc. dba smarTECHS.NET (the Applicant) filed an application to register the SMARTECHS trade-mark (the Mark). The application was filed on the basis of the Applicant's use and registration abroad and proposed use in Canada in association with "computer services, namely, web application development and hosting, multimedia services, and on-site technology services". The services were subsequently amended to:

Computer services, namely, web application development and hosting, multimedia design services, and on-site technology services in the nature of technical support services, namely troubleshooting of computer hardware and software (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 12, 2009.

[3] On October 13, 2009, SMART Technologies ULC (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) contrary to s. 30(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Applicant had not used the Mark in another country;
- (b) contrary to s. 30(e) of the Act, the Applicant did not intend to use the Mark;
- (c) contrary to s. 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Mark as it knew of the Opponent and the Opponent's trade-marks;
- (d) contrary to s. 12(1)(d) of the Act, the Mark is not registrable because it is confusing with registration Nos. TMA491,424; TMA659,668; TMA632,026 and TMA666,317;
- (e) contrary to s. 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date it was confusing with the Opponent's use of the following trade-marks: SMART, SMART Design (set out below), SMART TECHNOLOGIES, SMART IDEAS, SMART BOARD Design (set out below); SMART BOARD and smarttech.com;



- (f) contrary to s. 16(3)(c) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date it was confusing with the Opponent's use of the following trade-names: SMART and SMART TECHNOLOGIES; and
- (g) contrary to s. 2 of the Act, the Mark is not distinctive of the Applicant.

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

[5] In support of its opposition, the Opponent filed an affidavit of Robert Abbott. No cross-examination of Mr. Abbott was conducted. The Applicant did not file evidence in support of its application. Only the Opponent filed a written argument. An oral hearing was not requested.

#### Onus and Material Dates

[6] 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].

[7] The material dates with respect to the grounds of opposition are as follows:

- s. 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 38(2)(b)/12(1)(d) of the Act - the date of my decision [*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)/16(3) of the Act - the filing date of the application;

- s. 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

#### Section 30 Grounds of Opposition

[8] The Opponent has pleaded that the application is contrary to s. 30(d), 30(e) and 30(i) of the Act.

[9] There is no evidence that supports the grounds of opposition based on s. 30(d) and 30(e) of the Act. Contrary to the Opponent's submissions, the fact that the Applicant indicates in its application that it is doing business as smarTECHS.NET does not suggest that the Mark is neither used on its own, nor intended to be used on its own. Consequently, these grounds are dismissed on the basis that the Opponent has not satisfied its initial burden.

[10] The s. 30(i) ground alleges that the Applicant could not have been properly satisfied that it was entitled to use the trade-mark in Canada in association with the Services because the Applicant had knowledge of the Opponent and its trade-marks. 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 [see *Sapodilla Co. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the s. 30(i) ground is dismissed.

Section 12(1)(d) Ground of Opposition

[11] I have exercised my discretion and checked the register to confirm that the registrations relied on by the Opponent, and set out below, are extant [*Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. Therefore, the Opponent has met its initial burden with respect to this ground.

Registration No.	Trade-mark	Wares and Services
TMA491,424	SMART IDEAS	Computer programs for concept mapping.
TMA659,668	SMART BOARD Design	Electronic whiteboard, compatible with all major computer operating systems, ... software for use with the whiteboard and its intended uses
TMA632,026	SMART BOARD	
TMA666,317	SMART Design	Touch-enabled computerized systems for capturing coordinate inputs, namely graphics, script, drawings and gestures, for interaction with a computer generated display utilizing a pen, stylus, finger or hand. Touch-enabled coordinate input capturing devices comprising a pen, stylus, or used with a finger or hand for use with front projection, rear projection, and direct view displays. Absolute and relative position detection devices that utilize mechanically and optically based sensors which enable interaction with a digitizer, touch surface, touch

Registration No.	Trade-mark	Wares and Services
		panel, image display, or within a region of interest relative to a display. Scalable position detection systems with input generated via passive and/or active input tools. Imaging systems comprising computerized display systems for capturing text and graphical images. Software for processing text and graphical images, and sharing and/or storing text and graphical images over a computer network. Software for sharing collaboration data and images locally or in geographically dispersed locations. Software for viewing, editing, and sharing data and images locally or in geographically dispersed locations.

[12] The test to determine the issue of confusion is set out in s. 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): 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 and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[13] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 (S.C.C.) at para. 54]. I also refer to *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.) at para. 49, where the Supreme Court of Canada states that s. 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis. As I find that the Mark most resembles the SMART Design trade-mark, the Opponent has the best chance of success with registration No. TMA666,317. If I find that there is no confusion

between the Mark and this registration, then there can be no confusion between the Mark and the Opponent's other registrations.

*Inherent distinctiveness and extent known*

[14] A trade-mark is not inherently distinctive if it is suggestive of a characteristic of the associated wares or services. I can take judicial notice of the meaning of the words comprising the trade-marks of each party [*Tradall S.A. v. Devil's Martini* (2011), 92 C.P.R. (4th) 408 (T.M.O.B.) at para. 29]. The Canadian Oxford Dictionary includes the following definitions of SMART: "intelligent, keen, bright"; "(of device) capable of independent and seemingly intelligent action"; and TECH: "technology". The Opponent's SMART Design trade-mark is highly suggestive of wares which are capable of automated and seemingly intelligent operation. The Mark is highly suggestive of services which are performed by those intelligent and knowledgeable about technology. Therefore, neither party's mark has a high degree of inherent distinctiveness. As the Opponent's SMART Design trade-mark is stylized it has a slightly greater degree of inherent distinctiveness than the Mark.

[15] A trade-mark may acquire distinctiveness by becoming known through use or promotion. There is no evidence that the Mark has acquired distinctiveness. In contrast, the evidence of Mr. Abbott, Director, Product Management of the Opponent, provides that:

- On August 28, 2007, Smart Technologies Inc. amalgamated with 1331248 Alberta ULC and changed its name to Smart Technologies ULC. Therefore, any use of a trade-mark by Smart Technologies Inc. prior to amalgamation is use by the Opponent [*Molson Breweries, A Partnership v. John Labatt Ltd.* (1994), 56 C.P.R. (3d) 107 (T.M.O.B.) at para. 13].
- The SMART Design trade-mark appears on packaging for SMART BOARD interactive whiteboards (Exhibit L), stylus (Exhibit G) and remotes (Exhibit J). I note that I do not consider use of the SMART TECHNOLOGIES Design trade-mark set out below to be use of the SMART Design trade-mark.



- That over 17,000 SMART BOARD interactive whiteboards were sold in Canada in 2008 (Exhibit T). As noted in the point above, the packaging for SMART BOARD interactive white boards includes the SMART Design trade-mark (Exhibit G).
- The SMART Design trade-mark appears in association with brochures advertising various products. It is not clear to what extent these brochures were distributed in Canada. Given that only 20 out of the Opponent's 380 dealers are located in Canada, I cannot conclude there has been any significant distribution.
- That over 600,000 hits from Canada were received to the *www.smarttech.com* web-site which features the SMART Design trade-mark.
- More than \$750,000 was spent on Internet, print and electronic newsletter advertising resulting in 23 million impressions in 2009. I am unable to ascribe much weight to this evidence as it is not clear what proportion of this advertising was directed at Canadians.

[16] Based on the above, I conclude that the SMART Design trade-mark was known to at least some extent in Canada. This factor favours the Opponent.

*The length of time each has been in use*

[17] Mr. Abbott asserts that the SMART Design trade-mark has been used in Canada since at least as early as 1987 and provides examples of use from at least 2004 forward; there is no evidence that the Applicant has commenced use. This factor favours the Opponent.

*Degree of resemblance*

[18] The SMART Design trade-mark and the Mark share a moderate degree of resemblance. While the Mark incorporates SMART, the inclusion of the TECHS component does assist in changing the overall appearance of the Mark. Furthermore, the idea suggested by each mark is different. The SMART Design trade-mark suggests that the Opponent's products appear capable

of intelligent and independent action. In contrast, the Mark suggests that the Services are performed by people who are knowledgeable about technology. This factor slightly favours the Opponent

*The nature of the wares, services or business; the nature of the trade*

[19] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *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.)].

[20] The Opponent argues that there is a great deal of overlap between the Services and the Opponent's registered wares. Specifically, the Opponent argues that "generally speaking, the overlap stems from both parties offering computer or computer-based wares or services" and "that customers of the Opponent's products are likely to require services in the nature of those offered by the Opponent."

[21] I find that the only potential overlap indicated by the evidence is with the Services described as "on-site technology services in the nature of technical support services, namely troubleshooting of computer hardware and software". As these services are not limited to any particular area it is possible that these will pertain to the Opponent's registered wares.

[22] With respect to the remaining services: "computer services, namely, web application development and hosting, multimedia design services", I do not find that there is any overlap in the nature of these services and the registered wares. A review of the evidence confirms that the Opponent's products are for use in training, teaching and the conducting of meetings. The Opponent's products are not used for application development, hosting or multimedia design services. Nor is there any evidence that these services are required in the use of the Opponent's products which relate to the processing, viewing and sharing of data and images. While it is true that the Opponent's registered wares and the Services are all computer-related, this field is very



broad and this does not in itself indicate overlap [*VDO Road Digital Inc. v. @Road, Inc.*; 2004 CarswellNat 4706 (T.M.O.B.) at para. 17].

*Surrounding circumstance: family of marks*

[23] The Opponent argues that it owns a family of SMART trade-marks and as such is entitled to a broader ambit of protection [*McDonald's Corp. v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)]. A party seeking to establish use of a family of marks must also establish that it is using more than one or two trade-marks within the alleged family [*Yogi Yogurt, supra*]. Mr. Abbott has done this. However, I do not consider that the Opponent's family of trade-marks to be sufficient to extend the ambit of protection of its marks to result in a likelihood of confusion with the Mark for use in association with "computer services, namely, web application development and hosting, multimedia design services" as the Opponent has not demonstrated any nexus between its wares and these services.

*Conclusion for the s. 12(1)(d) ground of opposition*

[24] I conclude that, on a balance of probabilities, there is a reasonable likelihood of confusion between the SMART Design trade-mark and the Mark for use in association with "on-site technology support services, namely troubleshooting of computer hardware and computer software". Accordingly, this ground of opposition is successful for these services. This ground of opposition is dismissed with respect to "computer services, namely, web application development and hosting, multimedia design services".

Section 16(3)(a) Ground of Opposition

[25] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with its prior use of the trade-marks: SMART, SMART Design, SMART TECHNOLOGIES, SMART IDEAS, SMART BOARD, SMART BOARD Design and smarttech.com. The Opponent has an initial evidential burden to prove prior use of its trade-marks in Canada and that such use was not abandoned at the advertisement date of this application [see s. 16(5) of the Act]. Use means use according to s. 4 of the Act:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

Given the requirements of s. 4(1), I do not propose to discuss the Opponent's brochures and handouts advertising its wares in detail. First, the use of trade-marks in this manner does not constitute use as there is no evidence that these brochures and handouts were provided to customers at the time of transfer. Second, there is no evidence to the extent of circulation of these brochures in Canada.

*SMART, SMART Design, SMART TECHNOLOGIES, SMART BOARD, SMART BOARD Design and SMART IDEAS trade-marks*

[26] At the outset, I confirm that use of the SMART Design trade-mark constitutes use of the SMART trade-mark, that use of the SMART BOARD Design trade-mark constitutes use of the SMART BOARD trade-mark and that use of the *www.smarttech.com* trade-mark constitutes use of the *smarttech.com* trade-mark. The Opponent's evidence shows use of its trade-marks as of the relevant date (June 21, 2007) as set out below:

- The SMART trade-mark appears on a registration card for concept mapping software (Exhibit G).
- The SMART Design and SMART TECHNOLOGIES trade-marks are featured in advertising for the Opponent's training services for its interactive products (Exhibit G).
- The SMART TECHNOLOGIES trade-marks appear on packaging and/or labeling of concept mapping software, conferencing, computer lab instruction software, interactive white board software, classroom management software (Exhibit G) and cameras and projectors (Exhibit L) and are featured in the advertising of web-resources concerning teaching and increasing the effectiveness of meetings using interactive whiteboard technology (Exhibit Q).

- The SMART IDEAS trade-mark appears on packaging and/or labeling for concept mapping software and advertisements for this software (Exhibit G).
- The SMART BOARD Design trade-mark appears on packaging and labeling software for interactive whiteboards, and on stylus (Exhibit G), on packaging for interactive whiteboards and display panels (Exhibit H) and advertisements for these products.
- The SMART BOARD trade-mark appears on reference materials discussing the use of interactive whiteboards (Exhibit S).

[27] The Opponent therefore meets its burden of demonstrating use of each of these trade-marks in association with the specific products and services set out above.

[28] I consider the Opponent's best chance of success with respect to this case to be the use of SMART TECHNOLOGIES trade-mark due to the resemblance in sound, ideas and appearance between it and the Mark. I consider that these marks have a high degree of resemblance due to the similarities in their second components. Even though the SMART TECHNOLOGIES trade-mark has acquired at least some distinctiveness, due to the difference in the wares and services as discussed with respect to the s. 12(1)(d) ground of opposition, I do not find that there is a likelihood of confusion between it and the Mark for use in association with "computer services, namely, web application development and hosting, multimedia design services". Due to the potential overlap in the Opponent's wares and services and the Applicant's services described as "on-site technology services in the nature of technical support services, namely troubleshooting of computer hardware and software", I find that a likelihood of confusion exists with respect to these services.

*www.smarttech.com trade-mark*

[29] In its Written Argument, the Opponent emphasized the importance of the *www.smarttech.com* domain name and trade-mark in the confusion analysis. As such, I will consider it separately. Section 16(3)(a) of the Act precludes the registration of a trade-mark which is confusingly similar to a trade-mark previously used or made known in Canada. This section does not preclude the registration of a trade-mark which is confusingly similar with a

domain name. As such, I will only be considering the Opponent's evidence of use of *www.smarttech.com* as a trade-mark. I will not be considering the use of the *www.smarttech.com* domain name *per se* such as where *www.smarttech.com* appears as the domain name on print-outs from the Opponent's web-site, as part of the Opponent's corporate information, or as part of a specific web-site address (such as *www.education.smarttech.com/professional*).

[30] With respect to use of the *www.smarttech.com* trade-mark in association with wares in accordance with s. 4(1) of the Act, the Opponent's evidence provides very few examples of *www.smarttech.com* on packaging or product. On the packaging and labeling of various software products sold on CD there is reference to *www.smarttech.com* following the corporate, address and email information of the Opponent (Exhibit G). I do not consider the use of *www.smarttech.com* here to be use of a trade-mark for the purposes of distinguishing the Opponent's wares from the wares of others. Rather, I find that it is use of the domain name to direct users of this software product to the Opponent's web-site and appears as part of the corporate information [*Lavo Inc. v. WD-40 Co.* (2009), 79 C.P.R. (4th) 141 (T.M.O.B.) at para. 40]. As such, this use of *www.smarttech.com* does not qualify as trade-mark use.

[31] With respect to the use of the *www.smarttech.com* trade-mark in association with services in accordance with s. 4(2) of the Act, the Opponent provides examples of documents and presentations, for example the Making a Difference SMART Professional Development Opportunities brochure (Exhibit G), which include use of *www.smarttech.com* as a trade-mark in association with the advertising of the Opponent's training services on interactive teaching tools. Although there is no evidence to confirm the extent of circulation in Canada, I consider it reasonable to assume that there has been at least some distribution in Canada for the purposes of this ground of opposition. Therefore, the Opponent has met its burden of demonstrating use of *www.smarttech.com* as a trade-mark for use in association with training services related to interactive software.

[32] Given the similarities of the Mark and the *smarttech.com* trade-mark and the related nature of the services described as "on-site technology services in the nature of technical support services, namely troubleshooting of computer hardware and software", I find that there is a likelihood of confusion between Mark for use in association with these services and the

*smarttech.com* trade-mark. I do not find that there is a likelihood of confusion with the Mark for use in association with the remaining services.

*Conclusion for the s. 16(1)(a) ground of opposition*

[33] Accordingly, this ground of opposition is successful for “on-site technology services in the nature of technical support services, namely troubleshooting of computer hardware and software” and is dismissed with respect to “computer services, namely, web application development and hosting, multimedia design services”.

Section 16(3)(c) Ground of Opposition

[34] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with its trade-names SMART and SMART TECHNOLOGIES. The Opponent has an initial evidential burden to prove prior use of its aforementioned trade-names in Canada and that such use was not abandoned at the advertisement date of this application [see s. 16(5) of the Act].

[35] The Opponent’s evidence includes several examples of use of “Smart Technologies Inc.” or “Smart Technologies” including on a registration card included with software (Exhibit G), packaging and/or labels for computer software for concept mapping and for synchronicity software (Exhibit H) and its interactive whiteboards (Exhibit H). The Opponent’s evidence also includes the use of “Smart Technologies Inc.” in association with the advertising of an online resource centre which includes articles on presenting, meeting and collaborating and lesson activities created by educators (Exhibit G). The Opponent’s evidence also shows use of “Smart Technologies Inc.” in association with a buyer’s checklist for interactive whiteboards and an article on training technology (Exhibit G).

[36] I accept that Smart Technologies Inc. is use of the trade-name Smart Technologies and that the Opponent has evidenced use of this trade-name in association with computer software for use in concept mapping and collaborative learning and providing educational resources on the use of interactive technology for training, teaching and conducting meetings. I do not find that the Opponent has used the trade-name SMART. Rather, use of SMART appears to be use as

a trade-mark since it does not appear in conjunction with the identification of the business or related corporate information [*Markus Cohen Law Office v. Café Napoléon Inc.* (2009), 77 C.P.R. (4th) 94 (T.M.O.B.) at para. 11]. I note that even if I had found use of the trade-name SMART, I would not have found confusion with the services described as “computer services, namely, web application development and hosting, multimedia design services”.

[37] For the reasons set out in the s. 16(3)(a) ground of opposition, I only find that there is a likelihood of confusion between the services described as “on-site technology services in the nature of technical support services, namely troubleshooting of computer hardware and software” and use of the SMART TECHNOLOGIES trade-name. I do not find that there is a likelihood of confusion between the Mark for use in association with the remaining services.

#### *Conclusion for the s. 16(3)(c) Ground of Opposition*

[38] Accordingly, this ground of opposition is successful for “on-site technology services in the nature of technical support services, namely troubleshooting of computer hardware and software” and is dismissed with respect to “computer services, namely, web application development and hosting, multimedia design services”.

#### Distinctiveness

[39] I will not discuss this ground of opposition in detail as it does not favour the Opponent any more than the three grounds on which it has already partially succeeded. As discussed above, given the difference in the Opponent’s wares and services, the Opponent’s use and advertising of its relied upon trade-marks and trade-names is insufficient to negate the distinctiveness of the Mark for use in association with computer services, namely, web application development and hosting, multimedia design services.

[40] Accordingly, this ground of opposition is successful for “on-site technology services in the nature of technical support services, namely troubleshooting of computer hardware and software” and is dismissed with respect to “computer services, namely, web application development and hosting, multimedia design services”.

## Disposition

[41] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition with respect to computer services, namely, web application development and hosting, multimedia design services and I refuse the application with respect to the remainder of the services, pursuant to s. 38(8) of the Act [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Ménagers Coronet Inc.* (1986), 10 C.P.R. (3d) 482 (F.C.T.D.) as authority for a split decision].

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Natalie de Paulsen  
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