



LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 67

Date of Decision: 2017-06-12

IN THE MATTER OF OPPOSITIONS

Alliance Mercantile Inc.

Opponent

and

Vetex, a joint stock company

Applicant

1,523,653 for VETEX

1,523,700 for VETEX (& Design)

Applications

INTRODUCTION

[1] Alliance Mercantile Inc. (the Opponent) opposes registration of the trade-marks VETEX and VETEX (& Design) (reproduced below) (sometimes hereinafter collectively referred to as the Marks) that are the subject of application Nos. 1523,653 and 1,523,700 respectively:



[2] Each application is based upon proposed use in Canada in association with the following goods and services, as revised by the Applicant:

Goods: Textile and textile products for medical and surgical use, namely, shirts, lab coats, scrub shirts, caps and pants, t-shirts, gowns, towels, bed sheets and covers for medical exam tables; fibers for medical applications, namely, impregnated, laminated, and coated fibers all used for surgical gowns and drapes; ribbons and braid, namely, for thermal welding seams of textile material (seam sealing tape); sealing elements for textile and garments, namely, buttons, hooks and eyes, zip fasteners, fasteners and hook and pile fastening tapes.

Services: Treatment of textile material for medical and surgical use, namely, finishing, coating, and laminating of textile material for medical and surgical use.

[3] The application for the VETEX (& Design) trade-mark is also based upon registration of the mark in the Benelux Office for IP and use of the mark in Belgium, Luxembourg and the Netherlands. The application further includes the following colour claim:

Colour is claimed as a feature of the trade-mark. The outer lining of the circle is white with some black on the left side and on the right side and at the bottom. The inner lining of the circle is white. The back of the inner circle is green. The 3 wavy lines, the tick sign and the dot in the inner circle are white. The shade under the circle is green. The word VETEX is black.

[4] The oppositions were brought by the Opponent under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and raise grounds of opposition based upon sections 2 (non-distinctiveness); 12 (non-registrability); 16 (non-entitlement); and 30 (non-conformity) of the Act. The central issues are whether the application complies with section 30(a) of the Act on the basis that certain of the goods listed in the application, namely “fibers for medical applications, namely, impregnated laminated, and coated fibers all used for surgical gowns and drapes” are not described in ordinary commercial terms, and whether there is a likelihood of confusion between each of the Marks and the Opponent’s trade-mark V-TECH registered under Nos. TMA679,711 and TMA927,586 in association with the following goods respectively:

Reg. No. TMA679,711: Waterproof breathable fabrics made of nylon, polyester, or other fabrics coated with waterproof breathable polyurethane coatings.

Reg. No. TMA927,586: Clothing, namely jackets, hoods for jackets and pants; rainwear; outerwear for industrial and recreational use, namely jackets, hoods for jackets, pants and bibbed pants

and which has been used by the Opponent in Canada in association with such goods.

[5] For the reasons that follow, the oppositions succeed in part.

THE RECORD

[6] The applications were both filed on April 14, 2011. The application for VETEX (& Design) was advertised for opposition purposes in the *Trade-marks Journal* on January 28, 2015, and that for VETEX, on May 13, 2015.

[7] The Opponent opposed each application by a statement of opposition filed with the Registrar on June 26, 2015. Each of the statements of opposition was subsequently amended a few times by the Opponent, with leave of the Registrar, the last time being on February 18, 2016 (see in each case, Office letter dated April 7, 2016).

[8] The Applicant filed and served a counter statement in each case denying each of the grounds of opposition set out in the statement of opposition.

[9] In support of each of its oppositions, the Opponent filed an affidavit of its President and one of its directors, Douglas Bell, sworn January 13, 2016 (the Bell affidavit). I will use the singular to refer to these two affidavits, because they are basically identical. The Opponent also filed a Certificate of Authenticity for registration No. TMA679,711 and a copy of the certificate of registration No. TMA927,586.

[10] The Applicant elected not to file any evidence.

[11] Only the Opponent filed a written argument in each case, but both parties made submissions at an oral hearing. I will use the singular to refer to both written arguments of the Opponent, which are almost identical.

ANALYSIS

The parties' respective burden or onus

[12] The Applicant bears the legal onus of establishing on a balance of probabilities that each of its applications 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

Grounds of opposition revolving around the issue of non-compliance of the applications with section 30 of the Act

Non-compliance with section 30(a) of the Act.

[13] The Opponent has pleaded that the applications do not comply with section 30(a) of the Act because they do not contain a statement in ordinary commercial terms of the specific goods with which each of the Marks is proposed to be used in Canada. Specifically, the Opponent submits that each of the applications should be refused in respect of the following:

...fibers for medical applications, namely, impregnated, laminated, and coated fibers all used for surgical gowns and drapes...

[14] Generally, the material date for considering a ground of opposition based on section 30(a) of the Act is the date the application was filed. However, when an application has been amended to conform to ordinary commercial terms in response to a preliminary report by the Examiner, the amended application date will be considered as the material date for considering grounds of opposition that are based on section 30(a) of the Act [see *Eaton Williams (Millbank) Ltd v Nortec Air Conditioning Industries Ltd* (1982), 73 CPR (2d) 70 (TMOB)]. Applying similar reasoning to the present cases, the material dates are November 28, 2014 and June 26, 2014, that is the date each application for the VETEX word mark and design mark respectively, was last amended.

[15] Both in its written argument and at the hearing, the Opponent submitted that the specific nature of the goods cannot be determined from the above-mentioned description.

[16] The Opponent submits that reference can be made to dictionary definitions of the word “fiber” (or “fibre”). It submits there are two different meanings for “fiber” in the field of textiles (the field relevant to the Applicant’s goods): firstly, threads or filaments that may be used to make yarn, cloth or fabric, and secondly, material made from fibers. In the context of the Applicant’s goods, one cannot discern whether the goods described are fibers in the sense of raw filaments or fibrous materials that will be used to create textile goods, or whether it is intended to refer to materials made of fibers, such as yarns and thread, cloth, fabric or other materials.

[17] The Opponent submits that the lack of specificity is highlighted when one considers the Nice classification applicable to the goods:

(a) Raw fibrous textile materials fall into Nice Class 22. Examples of such goods that fall into Nice Class 22 according to the Canadian Intellectual Property Office Goods and Services Manual (CIPO Goods and Services Manual) are:

- carbon fibers for textile use;
- cotton fibers;
- glass fibers for textile use;
- hemp fiber;
- metallic fibers for textile use;
- polyester fibers;
- raw flax fiber;
- raw textile fibres;
- filaments for use in fabric;
- synthetic fibres for textile use

(b) Fibers that are formed into yarns and threads, for textile use are in Nice Class 23. The CIPO Goods and Services Manual provides the following examples of fibers in Class 23:

- chemical-fiber threads and yarns for textile use;
- fiberglass thread for textile use;

- glass fiber thread and yarn;
- regenerated fiber thread and yarn
- semi-synthetic fiber thread and yarn

(c) Fibers that are textiles and textile goods, not included in other classes, are in Nice Class 24. Examples of fibers in Nice Class 24 provided in the CIPO Goods and Services Manual are as follows:

- chemical fiber fabrics;
- fiberglass fabrics for textile use;
- mixed fiber fabrics;
- regenerated fiber yarn fabrics
- semi-synthetic fiber fabrics;
- synthetic fiber fabrics;
- chemical fiber fabrics;
- fabrics for textile use;
- inorganic fiber mixed fabrics;
- textile fabrics;
- fabrics impervious to gases;
- cotton fabric.

[18] The Opponent submits that the definition of the English word “fiber” in the textile context refers to goods in these three Nice Classes, all distinct types of goods. It submits that the services description in each of the applications, which refers to treatment of textile materials for medical and surgical use, suggests that the goods, which are described as treated materials, may be fabrics. However, the Opponent submits that as can be seen above, “fibers” is not an ordinary commercial term for fabrics in Class 24 so as to distinguish from fiber goods in Classes 22 or 23.

[19] The Opponent further submits that the certified copy of Benelux registration No. 0899404 filed in support of the Applicant’s foreign use and registration basis relied upon in the application for VETEX (& Design), supports the position that the goods described as “fibers”

were intended to refer to fabrics in Class 24. The Opponent points out that this certified copy shows registration of the trade-mark VETEX (& Design) in Benelux in Class 24, but not 22 or 23. The Opponent submits that the English translation provided by the Applicant uses the word “fibres”, however it is apparent that this particular English translation does not use ordinary commercial terms for the subject goods in Class 24. The Opponent submits that the type of fibers that would be in Class 24 would be fabrics and use of the word fibers is not use of ordinary commercial terms to describe these goods in Class 24 so as to distinguish them from fibers of the type in Classes 22 or 23. The Opponent notes in this regard in its written argument that online translations tools give the translation of “weefsels” from Dutch to English as “tissue, gauze, fabric, cloth, material” but not fibers.

[20] Lastly, the Opponent submits that while the applications with respect to the description of goods have been approved during examination, this Board has the right to decide whether the goods or services are in ordinary commercial terms, regardless of whether an Examiner has already approved the applications [see *Novopharm Ltd v Burroughs Wellcome Inc* (1994), 58 CPR (3d) 513 (FCTD), at 520].

[21] In reply, the Applicant submits that each case must be decided on its own particular facts. Here, the statement of goods describes both the characteristics of the fibers (in that they consist of impregnated, laminated, and coated fibers) and their intended purpose (in that they are all used for surgical gowns and drapes in the medical field). The Applicant submits that, when considered in context, the monopoly sought by it is sufficiently precise in terms of its scope. Thus, the Applicant submits that however interesting the Opponent’s argument based on the Nice classification might be, there are no reasons to conclude that the statement of goods does not conform to the requirements of section 30(a) of the Act. The Applicant further questions whether the Opponent’s argument based on Dutch to English dictionaries should have been sustained by supporting evidence filed at the evidence stage.

[22] While some of the Applicant’s submissions are not without merit, I nonetheless disagree.

[23] As set out by the Opponent, the word “fiber” may have two different meanings in the field of textiles. Despite the fact that the characteristics of the Applicant’s fibers as well as their intended use is provided, the fact remains that in the context of the Applicant’s goods, one

cannot discern whether the goods described are fibers in the sense of raw filaments or fibrous materials that will be used to create textile goods, or whether it is intended to refer to materials made of fibers, such as yarns and thread, cloth, fabric or other materials.

[24] As observed by the Opponent, the services description in each of the Applicant's applications, which refers to treatment of textile materials for medical and surgical use, suggests that the goods, which are described as treated materials, are fabrics.

[25] However, the CIPO Goods and Services Manual provides that:

In some cases, the context of a statement of goods or services may serve to specify an otherwise unacceptable statement of goods or services. Goods or services may be acceptable when they are understood as being sufficiently specific in the context of the entire statement of goods or services.

For example, "cases" alone are not acceptable as they could include any type of "cases" from camera cases to pillowcases. However, in an application for "cameras, tripods, and cases", the goods "cases" would be acceptable as it is clear from the context that the "cases" would be restricted to camera cases. Similarly "delivery" services alone is not acceptable as the service could include any type of delivery from flower delivery to furniture delivery. However, an application for "restaurant services" including the service "delivery" would be acceptable as the service would be understood to mean food delivery.

Note: Goods or services which are separated by semi-colons (;) are generally considered to stand on their own and therefore must meet the requirements of paragraph 30(a) of the Trade-marks Act without regard to the other listed goods or services. [My underlining]

[26] Here, the "fibers" in question are separated by semi-colons from the other categories of goods and services covered by the Applicant's applications. Furthermore, the other three categories of goods described in each application, namely (1) textile and textile products for medical use and surgical use (such as shirts, lab coats, gowns, towels, bed sheets and covers for medical exam tables); (2) ribbons and braid, namely for thermal welding seams of textile material (seam sealing tape); and (3) sealing elements for textile and garments (such as buttons and zip fasteners), do not necessarily suggest that the "fibers" are "fabrics" to the exclusion of anything else, like raw filaments or fibrous materials, or yarns and threads for textile use. In other words, it is not possible to readily determine the specific nature of the goods described as

“...fibers for medical applications, namely, impregnated, laminated, and coated fibers all used for surgical gowns and drapes...”

[27] In this respect, it is worth noting that at the hearing, the Applicant’s agent always referred to the Applicant’s fibers in question with the French word “*fibres*”. This presumably comes from the informal French translation of the statement of goods and services of each of the Applicant’s applications, as published in the *Trade-marks Journal*. However, I note that the meaning ascribed to the French word “*fibres*” in the field of textile is that of an “*élément d’aspect filamenteux qui constitue certains tissus*”. While I acknowledge that it was not up to the Applicant’s agent to reformulate the statement of goods, this by no means elucidates the specific nature of the Applicant’s fibers.

[28] It is also worth noting that neither of the present applications groups and classes the goods and services according to the Nice classification. Thus, the fact that the certified copy of Benelux registration No. 0899404 filed in support of the Applicant’s foreign use and registration basis relied upon in the application for the VETEX (& Design) mark refers to Class 24 cannot remedy the ambiguity contained in the statement of goods described in the proposed use basis claimed in each of the Applicant’s applications.

[29] In view of the foregoing, I agree with the Opponent that it has satisfied the initial burden upon it and that the Applicant has failed to establish, on a balance of probabilities, that the goods described as “...fibers for medical applications, namely, impregnated, laminated, and coated fibers all used for surgical gowns and drapes...” in each of its applications were described in ordinary commercial terms as of the applicable material dates.

[30] Accordingly, the section 30(a) ground of opposition succeeds in each case with respect to these goods.

Non-compliance with section 30(d) of the Act

[31] The Opponent has pleaded that the application for VETEX (& Design) does not comply with section 30(d) of the Act because at the date of filing of the application, the Applicant had not used the VETEX (& Design) mark in Belgium, Luxembourg, or the Netherlands in association with the goods and services described in the application.

[32] This ground of opposition can be summarily dismissed for the Opponent's failure to meet its evidential burden. There is no evidence to support this ground of opposition. I shall add in this regard that contrary to the Opponent's position contained in its written argument, the difficulty in ascertaining the specific nature of the goods described as "...fibers for medical applications, namely, impregnated, laminated, and coated fibers all used for surgical gowns and drapes..." is not sufficient in itself for the Opponent to satisfy its initial evidential burden under this ground of opposition. The fact that these goods are not described in ordinary commercial terms does not lead to a conclusion that there has been no use of the VETEX (& Design) mark in the Benelux.

[33] Accordingly, the section 30(d) ground of opposition is dismissed in this case.

Non-compliance with sections 30(b) and (e) of the Act

[34] The Opponent has pleaded that each of the applications does not comply with the requirements of sections 30(b) and (e) of the Act, because at the time each of the applications were filed, the Applicant or its predecessors in title had used the Marks in Canada. For this reason, each of the Marks is not a proposed trade-mark under section 30(e) of the Act. Further, each of the applications does not contain the date from which the Applicant or its predecessors in title had used the Marks in association with the applied-for goods and services, and therefore each of the applications does not conform to the requirements of section 30(b) of the Act.

[35] The Opponent has further pleaded in the alternative, that each of the applications does not conform to the requirements of section 30(e) of the Act, because the Applicant, by itself and/or through a licensee, did not intend to use the Marks at the time the applications were filed with each of the applied-for goods and services, specifically the Applicant did not intend to use the Marks in association with the goods described as "...fibers for medical applications, namely, impregnated, laminated, and coated fibers all used for surgical gowns and drapes..."

[36] The section 30(e) ground of opposition can be summarily dismissed in each case for the Opponent's failure to meet its evidential burden. There is no evidence to support this ground of opposition. Again, the difficulty in ascertaining the specific nature of the goods described as "...fibers for medical applications, namely, impregnated, laminated, and coated fibers all used for surgical gowns and drapes..." is not sufficient in itself for the Opponent to satisfy its initial

evidential burden under this ground of opposition. The fact that these goods are not described in ordinary commercial terms does not necessarily mean that the Opponent did not intend to use each of the Marks in Canada at the time of filing its applications.

[37] Accordingly, the section 30(e) ground of opposition is dismissed in each case.

[38] The section 30(b) ground of opposition can also be summarily dismissed in each case for the Opponent's failure to meet its evidential burden. There is no evidence to support this ground of opposition. Suffice it to say that the excerpts from the Applicant's website filed under Exhibit P to the Bell affidavit were apparently printed on January 11, 2016, which is more than five years after the material date to assess this ground of opposition, and that they do not show any contact information whatsoever in Canada.

[39] Accordingly, the section 30(b) ground of opposition is dismissed in each case.

Grounds of opposition revolving around the likelihood of confusion

Non-registrability of the Marks based on section 12(1)(d) of the Act

[40] The Opponent has pleaded that the Marks are not registrable having regard to the provisions of section 12(1)(d) of the Act in that they are confusing with the Opponent's registered trade-mark V-TECH referred to above.

[41] I have exercised the Registrar's discretion to confirm that the two registrations for the Opponent's trade-mark V-TECH relied upon are in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[42] As the Opponent's evidential burden has been satisfied, the Applicant must therefore establish on a balance of probabilities that there is not a reasonable likelihood of confusion between the Marks and the Opponent's registered trade-mark V-TECH.

The test for confusion

[43] Section 6(2) of the Act provides 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 be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[44] Thus, this section does not concern the confusion of the trade-marks themselves, but confusion of goods or services from one source as being from another source.

[45] The test for confusion is one of first impression and imperfect recollection. As stated by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD) at 369:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[46] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 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 goods, 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 and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 2006 SCC 22, 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 2006 SCC 23, 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 2011 SCC 27, 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

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

[47] The Opponent contends that as a coined term its trade-mark V-TECH is an inherently distinctive trade-mark deserving a broad range of protection.

[48] Conversely, the Applicant contends that the Opponent's trade-mark V-TECH is of extremely low inherent distinctiveness as the mark is made of a single letter of the alphabet combined with the descriptive or suggestive suffix "TECH" standing for "technology", as amply demonstrated by the Opponent's own product catalogues filed under Exhibits C to H to the Bell affidavit, which extensively refer to the Opponent's "V-TECH waterproof/breathable technology".

[49] I am in general agreement with the Applicant. While the letter "V" has no relationship to the goods, marks comprised of letters of the alphabet with little additional distinctive indicia are generally considered to be inherently weak [see *GSW Ltd v Great West Steel Industries Ltd. et al* (1975), 22 CPR (2d) 154 (FCTD.)]. Here, the suffix "TECH", which is defined in the *Oxford Canadian Dictionary* as standing for "technology", adds little, if any, inherent distinctiveness to the Opponent's mark. The trade-mark V-TECH is therefore a relatively weak mark.

[50] In comparison, each of the Marks possesses a higher degree of inherent distinctiveness as they are made of the coined word VETEX having no relationship to the applied-for goods and services. The VETEX (& Design) mark further includes a design element comprised of a circle and a tick sign, as more fully described in the colour claim reproduced above in the introductory paragraphs of my decision.

[51] The strength of a trade-mark may be increased by making it known through promotion or use. There is no evidence that either of the Marks has become known to any extent whatsoever in Canada. In comparison, the Opponent's evidence filed through the Bell affidavit establishes, *inter alia*, the following:

- i. The Opponent is a manufacturer and distributor of (among other things) industrial and recreational waterproof outerwear and protective clothing, boots and gloves selling at all levels of distribution including distributors, retailers and consumers [Bell affidavit, para 2].
- ii. The customers for the Opponent's workplace products are in a wide range of industries, including health, medical and emergency responders such as firemen and ambulance staff as well as other industries [Bell affidavit, paras 4 and 5].

- iii. The Opponent manufactures fabrics using coating and lamination of textiles designed to allow heat vapour to physically pass through, while preventing water molecules or other liquids from penetrating the fabric from the outside. Since 2006, the Opponent has continued to develop waterproof breathable fabrics, and products using these waterproof breathable fabrics. The natural expansion of the Opponent's sales for its waterproof breathable fabrics lies in the continuing development of the Opponent's textile technologies and new garments utilizing these fabrics within the workwear and recreational clothing markets [Bell affidavit, paras 9-11].
- iv. The Opponent sells into the specialty clothing industry and in particular protective clothing. Hospitals, medical industry and emergency responders are existing customers and targets for its products [Bell affidavit, para 12].
- v. In order to market and sell its waterproof breathable fabrics (hereinafter referred to as the "V-TECH Fabrics" or a "V-TECH Fabric") and the garments made from these fabrics, the Opponent has invented and used the trade-mark V-TECH to identify and differentiate these fabrics and garments from the ones of others [Bell affidavit, para 13] .
- vi. As part of the Opponent's marketing strategy, the Opponent creates consumer awareness of what V-TECH Fabrics are and what value they have for a garment. The Opponent does this by featuring the V-TECH trade-mark and its fabric technology on its website, in its product catalogue (which is distributed in print form and electronically), in sales presentations, at trade shows, and by attaching to its clothing wares manufactured from this fabric, hang tags bearing the V-TECH mark and describing the fabric feature [Bell affidavit, paras 13-22, Exhibits A and B – printouts from the Applicant's website as it existed in 2012, and as of today; Exhibits C through H – copies of pages excerpted from the Opponent's product catalogues for the years 2010-2015/16; Exhibits I through K – photographic copies of actual hang tags, some of which in use since at least 2009-2010; and Exhibit J – photographic copy of an actual fabric swatch attached to some of the Opponent's hand tags].
- vii. As at the Applicant's filing date of the present applications, the Opponent had approximately 400 customers in Canada for its garment lines constructed of its V-TECH Fabrics. Today, the Opponent has over 500 such customers. In that the Opponent's own customers for these products are principally distributors or resellers, the actual number of

purchasers and consumers of the Opponent's products is of course much higher [Bell affidavit, para 23].

viii. During the period 2006-2015 the Opponent had sales in Canada of garments made of its V-TECH Fabrics, and associated with the V-TECH mark, in excess of \$2,890,000 [Bell affidavit, paras 24-29, Exhibits L through O – copy of invoices evidencing sales of garments which were constructed from V-TECH Fabric during the years 2009-2015].

[52] In view of the foregoing, I agree with the Opponent that its trade-mark V-TECH has become known to some extent in Canada.

[53] In the end, I find that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' marks does not significantly favour one party over the other. On the one hand, the Marks are more inherently distinctive than the Opponent's mark, which is inherently relatively weak. On the other hand, the distinctiveness of the Opponent's mark has been increased by making it known to some extent through promotion and use, while there is no evidence that either of the Marks has become known in Canada.

The length of time the trade-marks have been used.

[54] As indicated above, the Opponent's trade-mark V-TECH has been used in Canada since 2006, whereas there is no evidence that either of the Marks has been used in this country.

[55] Accordingly, this factor favours the Opponent.

The nature of the goods, services or business, and the nature of the trade

[56] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods in the registrations relied upon by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. 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), 1996 CanLII 3963 (FCA), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[57] As described above, the Opponent has registered the trade-mark V-TECH for both waterproof breathable fabrics, and clothing for industrial and recreational use. On the other hand, the Applicant has applied for its Marks for textile and textile products for medical and surgical uses, impregnated, laminated and coated fibers for medical applications, seam sealing tape and sealing elements for garments. The Applicant has also applied for its Marks in association with services, namely treatment of textile materials for medical and surgical use.

[58] As observed by the Opponent, both the Applicant's and the Opponent's goods are in the textile field. Both include clothing for the industrial or work markets. The Opponent's registered goods include fabrics and the Applicant's goods include textiles and fibers. Both the Applicant's and the Opponent's goods comprise technical fabrics using coating technology.

[59] Except for the sealing elements and fasteners, the Applicant's goods and services are confined to medical applications. While this is a limited field, I agree with the Opponent that it is nonetheless an industrial use. The Opponent's clothing goods include clothing for industrial use generally and their fabric goods are not limited in their field of use. As noted in the Bell affidavit, waterproof breathable fabrics have applications beyond rainwear in that such fabrics are liquid-proof/breathable and therefore have application in a wide range of contexts requiring liquid-proof/splash-proof/breathable fabric [Bell affidavit, paras 9-12].

[60] With respect to the Applicant's goods that are not confined to medical applications, namely the seam sealing tapes, and other sealing elements and fasteners, I agree with the Opponent that they are common elements of many garments, including the garments covered by the Opponent's registrations for the trade-mark V-TECH [Bell affidavit, para 31].

[61] As stressed by the Opponent, the Applicant has not provided any evidence regarding the nature of the trade, although the field of use of certain of the Applicant's goods is limited by the specification to medical and surgical use. On the other hand, the Bell affidavit evidences that the

Opponent sells its products unto the workplace/industrial and recreational markets at all levels of distribution including distributors, retailers and consumers. Mr. Bell attests that this business takes the Opponent into a wide range of industries and in particular the specialty clothing industry and protective clothing. More particularly, he attests at paragraph 12 of his affidavit that:

Hospitals, medical industry and emergency responders are existing customers and targets for [the Opponent's] products and, as such, these work places and industries are a natural area of expansion for [the Opponent's] work wear garments utilizing waterproof breathable fabrics.

[62] Again, as stressed by the Opponent, the Opponent's registrations are not limited as to industry. The Opponent is not limited from the medical field and in fact the evidence is that the Opponent's lines of trade for its workplace garments already take it into hospitals and other medical environments. There is no reason to conclude that the parties' goods would not travel through the same channels of trade and be directed, at some point, to the same customers.

[63] Far from contradicting this point, the website excerpts filed under Exhibit P to the Bell affidavit describe the Applicant's business as "coating and lamination of textile in various industries such as the medical, industrial and food industry". The Applicant's products are described as "windproof", "waterproof" and "breathable". The site describes products for safety and protective clothing and footwear for work and sports use.

[64] Lastly, it is worth reiterating that it is not necessary that the parties operate in the same general field or industry or that their respective goods and services be of the same type or quality for there to be a likelihood of confusion. As stated in section 6(2) of the Act, confusion may occur "whether or not the goods or services are of the same general class."

[65] Having regard to the foregoing, I find that the overall consideration of these third and fourth factors lends support to the Opponent's case.

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

[66] As noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, “the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion”.

[67] Moreover, as previously mentioned, it is well-established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, “[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it” [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 1998, CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA), at para 34]. Even though the first word or portion of a trade-mark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique [see *Masterpiece, supra*, at para 64].

[68] Here, the Opponent’s trade-mark V-TECH is made-up of two terms “V” and “TECH”, separated by a dash. While not particularly inherently distinctive in itself, the letter “V” appears in the first most dominant part of the mark. As such, and given the descriptive or suggestive nature of the suffix element “TECH” in the context of the Opponent’s technical fabrics as acknowledged by the Opponent itself both in its written argument and at the hearing, I tend to agree with the Opponent that the letter “V” is arguably the most striking element of the mark.

[69] In comparison, I do not find that any one part of the Applicant’s word mark VETEX stands out as being more striking or unique. The trade-mark VETEX consists of a single coined word that has no clear meaning in relation to the Applicant’s applied-for goods and services. Contrary to the Opponent’s position, I do not find that the second syllable “TEX” is likely to be readily perceived as referring to the descriptive word “textile”. The trade-mark is not broken down in this manner. It must be considered in its entirety, not dissected. In any event, the idea

possibly suggested by the so-called suffix element “TEX” standing for “textile” shares no similarity with the one suggested by the suffix “TECH”.

[70] As indicated above, the Applicant’s VETEX (& Design) mark further includes a design element comprised of a circle and a tick design. Contrary to the Opponent’s position, I find the design element to be equally dominant with the word element VETEX. The design element is of equal size and prominence to the word VETEX. It is made up of graphic elements and colours, the combination of which is sufficiently distinctive and can be distinguished from the Federal Court of Appeal’s decision in *Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc*, 2016 FCA 265 [see by analogy *Domaines Pinnacle Inc v Constellation Brands Inc.*, 2016 FCA 302].

[71] In view of the foregoing, I do not find any similarity between the parties’ marks visually and conceptually. While “V-TECH” and “VETEX” start with a “V”, the Marks are not to be dissected that way.

[72] The only similarity between the parties’ marks is phonetically. They are composed of two syllables, the first of which is pronounced the same in English, namely “VEE”. However, the second syllable in each of the parties’ marks differs in pronunciation in the final sound “TEX” vs. “TECH”.

[73] Overall, when all three aspects of resemblance are considered together, I find that the parties’ marks are quite different.

Conclusion regarding the likelihood of confusion

[74] As noted by the Federal Court of Appeal in *Dion Neckwear, supra*, at page 163, the Registrar “need not be satisfied beyond doubt that confusion is unlikely. Should the ‘beyond doubt’ standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity.”

[75] I find that the Applicant has established, according to the balance of probabilities, that a consumer having an imperfect recollection of the Opponent’s trade-mark V-TECH would be

unlikely to conclude that the Applicant's goods and services originate from the same source or are otherwise related to or associated with the Opponent's registered goods.

[76] As indicated above, each of the Applicant's Marks is more inherently distinctive than the Opponent's mark, especially the VETEX (& Design) mark. While the distinctiveness of the Opponent's trade-mark V-TECH may have been reinforced through use and promotion, and the overall consideration of the nature of the parties' goods/services and channels of trade favours the Opponent, I find that the differences existing between the parties' marks are sufficient to avoid any reasonable likelihood of confusion in each of the present cases.

[77] Accordingly, the section 12(1)(d) ground of opposition is dismissed in each case.

Non-distinctiveness of the Marks based on section 2 of the Act

[78] The Opponent has pleaded that each of the Marks does not distinguish the applied-for goods and services of the Applicant from the goods of the Opponent, nor is it adapted so as to distinguish them in view of the Opponent's prior use and registration in Canada of its trade-mark V-TECH.

[79] An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing date of the opposition, its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As per my review above of the Bell affidavit, the Opponent has met its evidential burden.

[80] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition.

[81] Accordingly, the non-distinctiveness ground of opposition is dismissed in each case.

Non-entitlement of the Applicant based on section 16(2)(a) and (3)(a) of the Act.

[82] The Opponent has pleaded that the Applicant is not the person entitled to registration of each of the Marks having regard to the provisions of section 16(2)(a) and (3)(a) of the Act in that at the date of filing of the Applicant's applications, each of the Marks was confusing with the

trade-mark V-TECH of the Opponent that has been previously used or made known in Canada by the Opponent since 2006.

[83] An opponent meets its evidential burden under such a ground if it shows that as of the date of filing of the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act]. As per my review above of the Bell affidavit, the Opponent has met its evidential burden.

[84] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition.

[85] Accordingly, the non-entitlement ground of opposition is dismissed in each case.

DISPOSITION

[86] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse each of the applications with respect to the goods "...fibers for medical applications, namely, impregnated, laminated, and coated fibers all used for surgical gowns and drapes..." and I reject the oppositions with respect to the remainder of the goods and services pursuant to section 38(8) of the Act [see *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2017-05-11

APPEARANCES

Eve Munro

FOR THE OPPONENT

Barry Gamache

FOR THE APPLICANT

AGENT(S) OF RECORD

Miller Thomson

FOR THE OPPONENT

Robic

FOR THE APPLICANT