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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 181

Date of Decision: 2017-12-22

IN THE MATTER OF AN OPPOSITION

JMA ALEJANDRO ALTUNA, S.L.U.

Opponent

and

John Mezzalingua Associates, LLC d/b/a/

Applicant

JMA

1,638,703 for JMA

Application

INTRODUCTION

[1] The Applicant has applied to register the trade-mark JMA (the Mark) in association with the following goods:

Electrical connectors to be used in telecommunication networks; wireless communications and power systems equipment, namely directional and omnidirectional antennas; cable installation accessories, namely, insulating covers for cable connectors; cable boots; crimp tools, namely hand-held crimping tools used to attach cable connectors to coaxial cables; grounding units, namely, metal grounding bushings and metal grounding clamps, both for use only as parts and fittings for coaxial cables, and not for non-electric cable or machinery or machine parts; lightning arrestors for shunting electrical surges in coaxial cables; adapters,

namely coaxial cable adapters used to adapt one type of radio frequency interface to another (the Goods).

[2] The determinative issue in this proceeding is whether the Mark is confusing with the Opponent's trade-mark JMA & Design, shown below, which was filed under application No. 1,561,739 and has now issued to registration. The colours 'red' and 'black' are claimed as essential features of the Opponent's trade-mark, with the letters JMA in black and the triangle-like segment to the right of the letter 'A' in red:



[3] The Opponent's registration covers the following goods:

- (1) Metal keys for locks; (2) Metal bolts; metal key blanks; metallic iron works, namely, metal nails, locks, knobs, padlocks, nuts, rivets, and bolts; machines for the reproduction and duplication of keys; remote control transmitters and receivers for remotely operating access doors and gates; magnetic personal identification cards; magnetically encoded chip cards for building access and attendance control; semiconductor chips; anti-intrusion alarms, electronic door alarms; electric and electronic locks for doors, windows, gates, vault doors and safe doors; magnetic encoded card readers, electric strikes for remote control of door ingress and egress; encoded electronic transponder keys and key cards; electronic devices for reading, encoding and programming transponder keys; transponders (the Opponent's Goods).

[4] For the goods "metal keys for locks", the registration is based on a claim of use in Canada since at least as early as September 2004; the remainder of the goods are based on a claim of use and registration in Spain under No. 3006071.

[5] For the reasons that follow, I find that the opposition ought to be rejected.

THE RECORD

[6] The application for the Mark was filed on August 8, 2013 on the basis of proposed use in Canada, and claims priority from United States application No. 85/853,188, filed on February 19, 2013.

[7] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 25, 2015. On April 27, 2015, GRUPO JMA ALTUNA AGRUPACION EUROPEA DE INTERES ECONOMICO (Grupo) opposed it by filing a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). On March 8, 2016, Grupo sought leave to file an amended statement of opposition to reflect a change of name to JMA ALEJANDRO ALTUNA, S.L.U. The Applicant did not object to the amended statement of opposition, and leave was granted by the Registrar on April 14, 2016. Thus, the Opponent is now JMA ALEJANDRO ALTUNA, S.L.U.

[8] The Applicant filed and served a counter statement denying the allegations in the statement of opposition.

[9] The grounds of opposition pleaded by the Opponent are summarized below:

- a) the application does not comply with section 30(a) of the Act because the description of goods contained in the application does not meet the requisite degree of specificity nor does it comprise ordinary commercial terminology.
- b) contrary to section 30(e) of the Act, the Applicant did not intend to use the Mark in Canada in association with the Goods. More specifically, the Applicant could not have intended to use the Mark in Canada because, as of the filing date or the priority filing date, the Applicant must be deemed to have been aware of the Opponent's and/or its predecessor in title's, prior rights in the trade-mark JMA & Design, previously used in Canada by the Opponent and/or its predecessor in title, in association with the goods "metal keys for locks", and previously applied for in Canada under Application No. 1,561,739 in association with the Opponent's Goods and therefore could not have had a *bona fide* intention to use the Mark which is confusing with the Opponent's trade-mark JMA & Design.
- c) contrary to section 30(e) of the Act, the Applicant could not have had a *bona fide* intention to use the Mark in association with the Goods as of the date of filing, since it had, in fact, at the time of filing, already commenced use of the Mark in association with the Goods.

- d) contrary to 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Goods in view of the following: (i) the Applicant was well aware or should be deemed to have been aware of the Opponent's trade-mark JMA & Design; (ii) having regard to the allegations set forth in the grounds of opposition set out below; and (iii) the Applicant's use of the Mark in association with the Goods would violate the Federal legislation set out at section 7 of the Act.
- e) The Applicant is not the person entitled to the registration of the Mark in view of section 16(3)(a) of the Act since it was confusing with the Opponent's trade-mark JMA & Design, which has been used in Canada by the Opponent, and/or its predecessor in title, and continues to be used without abandonment in association with the goods "metal keys for locks".
- f) The Applicant is not the person entitled to registration of the Mark in view of section 16(3)(b) since it was confusing with the Opponent's trade-mark JMA & Design, in respect of which an application for registration in association with the Opponent's Goods had previously been filed on January 27, 2012.
- g) The Applicant is not the person entitled to registration of the Mark in view of section 16(3)(c) since it was confusing with the Opponent's trade names previously used in Canada in association with the carrying on of business related to the promotion and sale of the Opponent's Goods.
- h) The Mark is not distinctive within the meaning of section 2 of the Act because it is not adapted to distinguish the Goods from the goods and services of others and in particular, (i) from the Opponent's Goods associated with its previously used and applied for trade-mark JMA & Design, and; (ii) the goods sold and services provided in association with the trade names of the Opponent and its predecessor in title.

[10] In support of its opposition, the Opponent filed a certified copy of its registration No. TMA906,006 for the trade-mark JMA & Design, which issued from application No. 1,561,739.

[11] In support of its application, the Applicant filed the affidavit of Shawn M. Chawgo. Mr. Chawgo was not cross-examined.

[12] Only the Applicant filed a written argument, and no hearing was held.

ONUS AND MATERIAL DATES

[13] The legal onus is on the Applicant to show, on a balance of probabilities, that the application does not contravene the provisions of the Act as alleged in the amended statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an initial evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

[14] The material dates with respect to the grounds of opposition are:

- Sections 38(2)(a)/30 – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(c)/16(3) – the priority filing date of the application [see section 16(3) of the Act].
- Sections 38(2)(d)/2 – the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at 324].

Grounds of opposition which can be summarily dismissed

Section 30 Grounds of Opposition

[15] The Opponent has not met its initial burden with respect to the grounds of opposition based on sections 30(a), 30(e), and 30(i) of the Act. In particular:

- For the section 30(a) ground: no evidence or argument was filed in support of this ground of opposition [see *McDonald's Corporation v MA Comacho-Saldana International Trading Ltd c/o/b/a Macs International* (1984), 1 CPR (3d) 101 (TMOB) at 104];

- For the section 30(e) ground: no evidence was filed in support of this ground of opposition.
- For the section 30(i) ground: no evidence was filed in support of this ground of opposition, including for the allegation of non-compliance with section 7 of the Act. Moreover, where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith [see *Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Here, the application includes the requisite statement, and there is no allegation or evidence of bad faith or other exceptional circumstances.

[16] Accordingly, each of these grounds of opposition is rejected.

Sections 16(3)(a) and 16(3)(c) and 2 Grounds of Opposition

[17] The grounds of opposition based on sections 16(3)(a) and 16(3)(c) of the Act are rejected because the Opponent has not met its evidential burden. There is no evidence of use by the Opponent and/or its predecessor in title of the trade-mark JMA & Design or of any of the pleaded trade-names in Canada as of the applicable material date. Although the Opponent's registration for the trade-mark JMA & Design refers to use, that is not sufficient for the Opponent to meet its burden for these grounds of opposition [see *Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268].

[18] The grounds of opposition based on section 2 of the Act are also rejected on the basis that the Opponent has failed to meet its evidential burden. The Opponent has not filed any evidence to establish that its trade-mark or its trade names had become known sufficiently in Canada as of the material date, so as to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

Remaining ground of opposition

Section 16(3)(b) Ground of Opposition

[19] The Opponent has pleaded that the Applicant is not entitled to registration under section 16(3)(b) of the Act because at the material date of February 19, 2013 (the priority filing date of the application) the Mark was confusing with the Opponent's trade-mark JMA & Design, which is the subject of its previously filed application No. 1,561,739.

[20] To meet its initial evidential burden under section 16(3)(b), the Opponent must show that its application for the trade-mark JMA & Design was filed prior to the priority filing date of the Applicant's application, and that its application was still pending at the advertisement date of the Mark, namely February 25, 2015 [see section 16(4) of the Act]. Having reviewed the certified copy of the registration submitted by the Opponent, I confirm that the application for the Opponent's trade-mark JMA & Design was filed prior to the priority filing date of the Applicant's application and that this application was pending as of the date of advertisement of the Mark, having not proceeded to registration until June 11, 2015. The Opponent has therefore met its initial burden.

[21] As the Opponent has met its burden, it is now incumbent on the Applicant to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties' trade-marks.

[22] The test for confusion is one of first impression and imperfect recollection. Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

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 . . . or performed by the same person, whether or not the goods or services are of the same general class.

[23] Accordingly, the issue to be considered is not that of confusion between the trade-marks themselves, but confusion of goods from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether purchasers of the Applicant's

Goods, provided under the Mark, would believe that those goods were provided or authorized or licensed by the Opponent who sells its goods under the trade-mark JMA & Design.

[24] Factors to be considered in making an assessment as to whether two marks are confusing are “all the surrounding circumstances” including those specifically set out in section 6(5) of the Act: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. However, as noted by Mr. Justice Rothstein in *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 2011 SCC 27, although the degree of resemblance is the last factor cited in section 6(5) of the Act, it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Inherent Distinctiveness

[25] I do not consider either party’s trade-mark to hold a high degree of inherent distinctiveness since trade-marks consisting of combinations of letters or initials are generally considered to be weak marks with low inherent distinctiveness [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD) at 163-164; *Alfred Grass Gesellschaft mbH Metallwarenfabrik v Grant Industries Inc.* (1991), 47 FTR 231 (FCTD)].

[26] While the Opponent’s trade-mark includes colour and design features, namely stylized lettering and an embellishment beside the letter ‘A’, I consider that these features do little to add to the overall inherent distinctiveness of the trade-mark which, in its entirety, clearly reads JMA.

Extent Known and Length of Time in Use

[27] The Opponent has filed no evidence that its trade-mark JMA & Design has become known to any extent. While the application for the Opponent’s trade-mark JMA & Design claims use in Canada for the goods “metal keys for locks” since at least as early as September 2004, with the remainder of its listed goods claiming use and registration in Spain, the Opponent has

filed no evidence of use of its trade-mark. Accordingly, I am unable to conclude that the Opponent's trade-mark has become known to any significant extent or has had any more than *de minimis* use [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430].

[28] The application for the Mark was filed on a proposed use basis. The Applicant's evidence, namely the affidavit of Shawn Chawgo, the Vice President of Product Management of the Applicant, confirms that the Applicant's use of the Mark did not start until "soon after" the filing of the application on August 8, 2013 (paragraph 15). While Mr. Chawgo attests to the use of the Applicant's JMA trade-mark (paragraphs 15-19 and Exhibits E and F), and provides information including approximate Canadian sales covering the period of 2014 – May 5, 2016 (paragraph 30), I do not consider this evidence to be relevant to the section 16(3)(b) ground of opposition as it falls outside the material date of February 19, 2013 (the priority filing date of the application). Accordingly, I do not consider these factors to significantly favour either party.

Nature of the Goods and Trade

[29] It is the Applicant's statement of goods as defined in its application versus the Opponent's Goods as set out in its registration (or application) that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc.* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, these 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 CPR (3d) 168 (FCA) at 169].

[30] A general description of the Applicant's products and business is set out in the Chawgo affidavit. According to Mr. Chawgo:

- the Applicant is a leading global innovator in mobile wireless connectivity solutions that assure infrastructure reliability, streamline service operations, and maximize wireless performance (paragraph 5).

- the Applicant manufactures wireless antennas, transmission line connectors and components, RF Repeaters, and Active Distributed Antenna System (DAS) technology (paragraph 6).
- the Applicant's products are all used for protecting and enhancing the integrity of wireless signals (paragraph 7).
- the Applicant's solutions cover macro infrastructure, outdoor and indoor distributed antenna systems, and small cell solutions (paragraph 8).

[31] In support of these assertions, Mr. Chawgo attaches as exhibits copies of various pages from the Applicant's website <http://www.jmawireless.com>, as well as its LinkedIn and Twitter pages (Exhibits A,B, and C, respectively).

[32] In its written argument, the Applicant generally characterizes its Goods as "antennas, connectors and components used in telecommunications networks", and those of the Opponent as "metal keys, key cutting machines, alarms, transponders and associated keys and cards" (paragraphs 72 and 74, respectively). The Applicant submits that the nature of the parties' respective goods is different, and that they both target highly specialized markets - telecommunication networks versus security (paragraphs 75, 76).

[33] I agree with the Applicant that the nature of the goods of the parties appears to be different. Whereas the Opponent's Goods pertain to security (eg. metal keys for locks; magnetic personal identification cards; magnetically encoded chip cards for building access and attendance control; anti-intrusion alarms; encoded electronic transponder keys and key cards; electronic devices for reading, encoding and programming transponder keys; transponders) the Applicant's Goods are in the nature of equipment (eg. electrical connectors; antennas; cable installation accessories; adapters) for establishing telecommunication networks, which appear more specifically to involve mobile wireless connectivity solutions. While a number of the Opponent's Goods also appear to involve and/or integrate wireless technology, the underlying nature of the parties' goods and their respective applications appears to be distinct.

[34] With respect to the nature of the trade, the Applicant has filed some evidence to suggest that the nature of the parties' trade would likely differ (Chawgo affidavit, paragraphs 24-29; 31-33). In particular, regarding the Applicant's nature of trade, the evidence indicates that most of

the sales of the Applicant's Goods in Canada are made via direct sales between the Applicant and the various cellular carriers (eg. Rogers, Bell Mobility) and cellular distribution partners in Canada (Chawgo affidavit, paragraph 24). The Applicant has also attempted to file evidence of the Opponent's channels of trade, namely the website of the Opponent's purported Canadian distributor, obtained through a Google search performed by Mr. Chawgo (paragraphs 32, 33). However, I note that there are hearsay issues with respect to this portion of the Applicant's evidence.

[35] In any event, I am of the view that based on the disparate nature of the parties' goods, and in the absence of evidence to the contrary from the Opponent, it seems unlikely that there would be any overlap in the parties' channels of trade.

[36] These factors therefore favour the Applicant.

Degree of Resemblance

[37] There is a very high degree of resemblance between the parties' trade-marks. Both are comprised of the letters JMA, and there is no evidence of any phonetic differences between the parties' trade-marks, such that they are identical when sounded, as well as in the ideas suggested. While the Opponent's trade-mark features colour and some design features – namely stylized lettering and a design element beside the letter A – I consider these to be minor in nature. Further, the Mark has no limitations on colour, font or style of lettering. This factor thus favours the Opponent.

Surrounding Circumstance: Applicant's Prior Registration

[38] The Applicant has identified as a relevant surrounding circumstance that the Opponent's trade-mark co-exists on the Register and in the marketplace with the Applicant's "JMA WIRELESS" registration. The Applicant has submitted a copy of the Certificate of Registration for this trade-mark, which issued to registration on April 11, 2016, and is listed for use in association with goods nearly identical to the Goods (Chawgo affidavit, paragraph 20 and Exhibit G).

[39] It is well established that an applicant's ownership of one or more trade-marks does not give it an automatic right to obtain a further registration [see *Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1984), 4 CPR (3d) 108 at 115 (TMOB); 385229 *Ontario Limited v ServiceMaster Company*, 2012 TMOB 59 (CanLII) at para 47]. While the existence of a prior registration may in some cases constitute a relevant surrounding circumstance, without evidence of significant use of this registered trade-mark prior to the material date, I do not consider this to be a surrounding circumstance favouring the Applicant.

Surrounding Circumstance: Co-existence of United States Registrations

[40] The Applicant has submitted evidence of co-existence of the parties' trade-marks on the United States Register for the same/similar goods (Chawgo affidavit, paragraphs 21–23, Exhibits H-J).

[41] The Applicant argues that the co-existence of the trade-marks at issue in the United States is an indication of the lack of possible confusion. Citing *Weetabix of Canada Ltd. v Kellogg Canada Inc.*, 2002 FCT 724; 20 CPR (4th) 17, the Applicant submits that the fact the parties' trade-marks co-exist on the US register, while not binding upon the Registrar, is still a factor that can be considered (paragraph 107, Applicant's written argument).

[42] However, in *Weetabix, supra*, there was evidence of use of both parties' trade-marks in the United States over a long period of time. In the instant case, no such evidence is on the record. It has been established that evidence of mere co-existence on foreign registers is not relevant to the issue of likelihood of confusion in Canada [see *Vivat Holdings Ltd v Levi Strauss & Co.* (2005), 2005 FC 707 (CanLII), 41 CPR (4th) 8 (FC) at para 65]; accordingly, I do not consider this to be a relevant surrounding circumstance.

Surrounding Circumstance: No Instances of Confusion

[43] In its written argument, the Applicant submits as a surrounding circumstance that the businesses and goods of the Applicant and the Opponent have, to date, co-existed in Canada without any instances of confusion (paragraph 108; Chawgo affidavit, paragraph 34). The Applicant also submits that the Opponent has never raised the issue of any of its customers being

confused or unable to distinguish between the Opponent and the Applicant's goods in Canada or anywhere in the world (paragraph 108).

[44] It is of course unnecessary for the Opponent to evidence confusion in order for me to find that there is a likelihood of confusion. It has also been established that an adverse inference based on a lack of evidence of confusion may only be drawn where there is extensive concurrent use of the trade-marks at issue [see *Christian Dior, SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA) at 19]. Considering that the Opponent has provided at best, no more than *de minimis* use of its trade-mark, and that the Applicant's application was filed on a proposed use basis, I do not consider this to be a relevant surrounding circumstance.

Conclusion

[45] While the degree of resemblance factor set out in section 6(5)(e) of the Act is often likely to have the greatest effect in deciding the issue of confusion, and strongly favours the opponent in this case, I consider that the jurisprudence on weak marks has a mitigating effect on the Opponent's advantage under this factor. As noted in *GSW, supra*, trade-marks based on combinations of letters or initials are weak trade-marks and are generally only entitled to a narrow ambit of protection.

[46] While it is possible for the degree of distinctiveness attributable to a weak mark to be enhanced through extensive use [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 at para 6 (FCTD)], the Opponent has filed no such evidence of use. Further, a party adopting a weak trade-mark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 10 CPR 101 at 115-116 (SCC)].

[47] In addition, considering that there is no evidence that the parties' nature of goods or channels of trade overlap, I find that the Applicant has met its legal onus to establish that, on a balance of probabilities, there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark JMA & Design.

DISPOSITION

[48] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Jennifer Galeano
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No Hearing Held

AGENTS OF RECORD

Marks & Clerk

FOR THE OPPONENT

MBM Intellectual Property Law LLP

FOR THE APPLICANT