



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

**Citation: 2018 TMOB 72**

**Date of Decision: 2018-07-16**

**IN THE MATTER OF AN OPPOSITION**

**Fishman Transducers, Inc.**

**Opponent**

**and**

**MUSIC Group IP Limited**

**Applicant**

**1,582,812 for AURATONE**

**Application**

**FILE RECORD**

[1] On June 19, 2012, MUSIC Group IP Limited filed an application to register the trademark AURATONE, based on proposed use in Canada, in association with sound equipment specified as:

apparatus for creating, recording, transmission, processing, retrieval, manipulation and reproduction of sound, namely, microphones, microphone preamplifiers, direct input boxes, mixing consoles, dynamic processors, effects and signal processors, equalizers, crossovers networks for audio apparatus, namely electrical wiring and connectors and frequency crossovers for use in audio systems and audio amplifiers;

audio controllers, audio interfaces, signal distribution devices, namely audio signal processors;

signal converters, headphone amplifiers, headphones, power amplifiers, loudspeakers,

apparatus for controlling lighting, namely, consoles, dimmer packs, luminaires, halogen lamps, lamps and rack lights;

computer software for creating, recording, transmission, processing, retrieval, manipulation and reproduction of sound, namely music;

manuals in electronic format.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated June 23, 2014 and was opposed by Fishman Transducers, Inc. on September 23, 2014. The Registrar forwarded a copy of the statement of opposition to the applicant on October, 2014 as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of the affidavit of Michael Stephan. The applicant's evidence consists of the affidavit of Jane Buckingham. Both parties filed a written argument and both were represented at an oral hearing.

#### STATEMENT OF OPPOSITION

[4] The opponent pleads that it is the owner of the mark AURA, registration No. TMA728,866, covering the following goods:

audio signal conditioners for use with acoustic musical instruments, namely, amplifiers, acoustic mixer, and tone controllers

The registration indicates that the opponent has used the mark in Canada since February 17, 2004.

[5] It is not entirely clear whether the applicant's goods "power amplifiers" are included in the opponent's goods "amplifiers" or whether the applicant's goods "audio controllers, audio

interfaces, signal distribution devices, namely audio signal processors” and “mixing consoles” are included in the opponent’s goods “acoustic mixer and tone controllers.”

[6] The opponent alleges numerous grounds of opposition (including confusion between the parties’ marks) which I will address after reviewing the parties’ evidence, the evidential burden on the opponent to support the grounds of opposition, and the legal onus on the applicant to overcome the opponent’s allegations.

#### OPPONENT’S EVIDENCE

##### *Michael Stephan*

[7] Mr. Stephan identifies himself as a private investigator. His affidavit serves to introduce into evidence the exhibit materials discussed below:

##### *Exhibit A*

[8] The exhibit is a copy of the opponent’s registration for the mark AURA referred to in para. 4 above.

##### *Exhibit B*

[9] The exhibit is a copy of a page taken from the opponent’s website, as it existed on May 29, 2012, obtained through the Internet Wayback Machine. The exhibit shows various AURA audio signal controllers available for purchase.

##### *Exhibit C*

[10] The exhibit is a copy of a page taken from the opponent’s website, as it existed on July 2, 2014, obtained through the Internet Wayback Machine. The exhibit shows various AURA audio signal controllers available for purchase.

APPLICANT'S EVIDENCE

*Jane Buckingham*

[11] Ms. Buckingham identifies herself as a trademark searcher employed by the agent for the applicant. Her affidavit serves to introduce into evidence the exhibit materials discussed below:

*Exhibit A*

[12] The exhibit presents the result of a search of the trademarks register for active marks that contain the element AURA. In excess of 80 such registrations were found, presented *en liasse* and without commentary by Ms. Buckingham (nor were the results of the search analysed in any depth by the applicant's agent in written or oral submissions). I have concluded, from my cursory inspection of Exhibit A, that too few relevant marks were found to have any probative value for assessing the issue of confusion between the parties' marks.

*Exhibit B*

[13] The exhibit reproduces dictionary definitions for the words "aura" and "aural." The primary meanings of the word "aura" are:

- a distinctive . . . sensory stimulus . . .
- a distinctive atmosphere . . . attributed to a given source
- distinctive appearance or impression

[14] The primary and secondary meanings of the word "aural" are, respectively:

- of or relating to the ear
- of or relating to the sense of hearing

[15] I have exercised judicial discretion to consult the online *Merriam-Webster Dictionary* for the meaning of the word "tone." The primary and secondary meanings are, respectively:

- vocal or musical sound of a specific quality

- a sound of definite pitch and vibration

#### LEGAL ONUS AND EVIDENTIAL BURDEN

[16] As mentioned earlier, before assessing the grounds of opposition, it is necessary to review (i) the initial evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case. With respect to (i) above, there is in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition - for those allegations for which the opponent has met its evidential burden. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached (on the usual civil balance of probabilities standard) once all the evidence is in, then the issue must be decided against the applicant.

#### DISCUSSION OF THE STATEMENT OF OPPOSITION

[17] The statement of opposition pleads numerous grounds of opposition. At the commencement of the oral hearing the opponent withdrew the grounds based on sections 30(a), 30(e), 30(i) and 50 of the *Trade-marks Act*. Most of the remaining grounds may be summarily dismissed either because the opponent has failed to adduce relevant evidence to support the grounds (i.e., to meet its eventual burden) or because the opponent has failed to satisfy statutory requirements of the *Trade-marks Act* necessary to plead the grounds. Most notably, the opponent has failed to support the grounds of opposition based on its mark AURA having acquired a

reputation in Canada. In this regard, I agree with the applicant's submissions at paras. 42-44 and 68-70 of its written argument:

42. The evidence must establish a "reputation in trade" where prior use is being alleged:

But before an opponent can base an objection on prior use under s.16 the opponent must establish a reputation in the trade under a style with which confusion may result. That to me is not an onus but a burden of proof. An onus never shifts but a burden of proof does. The applicant may rebut the proof proffered by the opponent. *British American Bank Note Co. v Bank of America National Trust & Saving Assn. (1983), 71 CPR (2d) 26 at 35.*

43. A "reputation in trade" requires evidence that the mark has actually functioned as a trademark and is capable of distinguishing the associated goods and services from the goods and services of others. *Domtar Inc. v Ottawa Perma-Coating Ltd. (1985), 3 CPR (3d) 302 at 307-310 (TMOB).*

44. As the Opponent has filed no evidence of use of its prior AURA Mark, no reputation in trade can be established, and the Section 16(3)(a) ground of opposition must fail.

.....

68. While the information regarding trademark use contained in the AURA registration of the Opponent supports a *de minimus* presumption of use, in the absence of evidence confirming such trademark use since the date asserted in the trademark registration, little weight should be attributed to this factor in assessing the issue of confusion.

*Molson Companies Ltd. v Scottish & Newcastle Breweries Ltd. (1985), 4 CPR (3d) 124 at 130 (TMOB).*

69. Aside from the information contained in the Opponent's registration, no other evidence has been provided regarding use of the Opponent's AURA Mark in Canada. The Stephan affidavit provides printouts from the Opponent's www.fishman.com website but does not provide any information on whether the AURA products are available to be shipped to Canada.

*Affidavit of Michael Stephan at paras 3-4 and Exhibits B-C.*

70. Furthermore, the Opponent has offered no information on sales of the AURA products in Canada. No proof of use of the Opponent's AURA trademark in Canada within the meaning of Section 4 of the Act has been evidenced by the Opponent.

[18] The determinative issue for decision is pleaded in para. 7(ii) of the statement of opposition:

Pursuant to Section 12(1)(d) of the *Act*, the impugned application is not registrable by the Applicant in association with the wares set out in the impugned application since the alleged trade-mark AURATONE is confusing with the opponent's trade-mark, namely:

(a) Registration No. TMA 728,866 for AURA, which has previously been used in Canada by the Opponent and/or a predecessor in title and/or a licensee of the Opponent, and which has not been abandoned.

[19] The above allegation is supported by evidence of the opponent's registration found in Exhibit A of the Stephan affidavit referred to in para. 8 above. As the material date for deciding the issue of confusion arising pursuant to section 12(1)(d) is the date of my decision, I have exercised my discretion to verify that the registration is extant as of today: see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 CPR(3d) 410 at 411 (TMOB). I would add that there is no statutory requirement for the opponent to show that its registered mark has acquired a reputation in Canada in order to support a ground of opposition pursuant to section 12(1)(d).

[20] I would also mention that in the opponent's written argument, and at the oral hearing, counsel for the opponent relied on other registered marks owned by the opponent (identified in Exhibit A of the Buckingham affidavit) as additional support for the section 12(1)(d) ground of opposition. However, as those registrations were not relied upon in the statement of opposition, I am without jurisdiction to consider them: see *Imperial Developments Ltd. v. Imperial Oil Limited* (1984) 79 CPR(2d) 12 at 21 (FC).

#### MEANING OF CONFUSION BETWEEN TRADE-MARKS

[21] As mentioned earlier, the determinative issue for decision is whether the applied-for mark AURATONE, for the goods covered in the subject application, is confusing with the opponent's registered mark AURA for the goods specified in the opponent's registration. Trade-marks are

confusing when there is a reasonable likelihood of confusion within the meaning of s.6(2) of the *Trade-marks Act*, shown below:

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.

[22] Thus, s.6(2) does not concern mistaking one mark for the other, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether purchasers of the applicant's goods, sold under the mark AURATONE, would believe that those goods are produced or authorized or licensed by the opponent who owns the mark AURA (assuming use of both trade-marks in the same area). The legal onus is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

#### TEST AND FACTORS FOR ASSESSING CONFUSION

[23] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are “ all the surrounding circumstances including” those specifically mentioned in s.6(5)(a) to s.6(5)(e) 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. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.



## CONSIDERATION OF FACTORS FOR ASSESSING CONFUSION

### *Factor 1 - Inherent and Acquired Distinctiveness*

[24] The applied-for mark AURATONE is a coined word and ordinarily such words possess a relatively high degree of inherent distinctiveness. However, the inherent distinctiveness of the mark AURATONE is lessened owing to (i) the perception of the mark as the combination of two dictionary words namely, AURA and TONE and (ii) the laudatory connotation of the mark namely, that the applicant's goods will produce a "distinctive sound of a specific quality." The opponent's mark AURA, although a dictionary word, possesses a fair degree of inherent distinctiveness as there is no direct connection between the mark and the opponent's goods. However, the inherent distinctiveness of the mark is lessened owing to its laudatory connotation namely, that the opponent's goods will produce a "distinctive" sound. I find that the applicant's mark AURATONE possesses a slightly higher degree of inherent distinctiveness than the opponent's mark AURA. As neither party has evidenced any acquired distinctiveness for its mark, and as the first factor is a combination of inherent and acquired distinctiveness, I find that the first factor favours the applicant - but only slightly.

### *Factor 2- Length of Time the Parties' Marks have been In Use*

[25] The second factor favours neither party as neither party has evidenced use of its mark over an extended period of time.

### *Factors 3 and 4 - Nature of the Goods and Trades*

[26] As alluded to earlier, it is not entirely clear from a review of the goods specified in the subject application and in the opponent's registration whether, or to what extent, the parties' goods overlap. The applicant's submission on this issue is found at para. 72 of its written argument:

While there is some overlap between the Opponent's and the Applicant's goods, the AURATONE Goods extend beyond the goods associated with the opponent's AURA registration.

[27] In the absence of evidence on this issue, and based on my own limited understanding of the parties' goods, I accept the applicant's above submission. Further, I assume there will be some overlap in the parties' channels of trade but that the applicant's channels of trade will extend beyond those of the opponent. The third and fourth factors therefore favour the applicant with respect to the majority of the applicant's goods.

*Factor 5 – Resemblance between the Parties' Marks Visually, in Sounding, and in Ideas Suggested*

[28] The marks in issue necessarily resemble each other to some extent visually, and in sounding, as the first component of the applied-for mark AURATONE incorporates the whole of the opponent's mark AURA. Further, it is an accepted principle of trademark law that the first portion or first syllable of a mark is the more important for the purposes of distinction: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 CPR(2d) 183 at 188 (FCTD). However, when the first term is a common, descriptive word, its importance diminishes: see, for example, *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 CPR (3d) 247 at 263 (FCA). In the instant case, the term AURA is a dictionary word having a somewhat laudatory connotation, lessening its importance for the purpose of distinguishing between trademarks. Considering the parties' marks in their entireties, I find that they are more different than alike visually, and in sounding, owing to the suffix TONE comprising the applied-for mark AURATONE.

[29] I also find that the ideas suggested by the parties' marks overlap but are different. The applicant's mark AURATONE suggests a distinctive and particular sound while the opponent's mark AURA suggests something that is distinctive. When all three aspects of resemblance are considered, I find that the parties' marks are somewhat more different than alike. The fifth factor therefore favours the applicant to some extent.

DISPOSITION

[30] Having regard to the section 6(5) factors discussed above, I find that the applied-for mark AURATONE is not confusing with the opponent's mark AURA with respect to any of the applicant's goods (despite some overlap in the parties' goods and channels of trade) as of today's date.

[31] The opposition is therefore rejected.

[32] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

[33] I would add that had the opponent been able to establish a significant reputation for its mark AURA in Canada, then the issue of confusion might well have been decided in the opponent's favour, at least for the parties' overlapping goods.

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Myer Herzig  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2018-05-02

**APPEARANCES**

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