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

**Citation: 2018 TMOB 119**

**Date of Decision: 2018-10-24**

**IN THE MATTER OF AN OPPOSITION**

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|---|---|
| **G&W Electric Company** | **Opponent** |
| **and** | |
| **Littelfuse, Inc.** | **Applicant** |
| **1,657,066 for ENGINEERED TO PERFORM. BUILT TO LAST.** | **Application** |

FILE RECORD

[1] On December 19, 2013, Littlefuse Inc. filed an application to register the trade-mark ENGINEERED TO PERFORM. BUILT TO LAST. The application is based on use of the mark in Canada since April 30, 2013, in association with the following goods:

> trailer-mounted and skid-mounted diesel generators for use in the mining industry, oil and gas industry . . . ;
>
> prefabricated modular buildings and e-houses sold as a housing component of . . . electrical equipment for use in the mining industry, oil and gas industry . . . for electrical distribution, protection, and control;
>
> portable . . . electric power centers for power distribution . . . for use in the mining industry, oil and gas industry . . . ;

> . . . skid mounted . . . portable . . . electric power centers for monitoring and controlling mining operations . . . electronic motor control centers, namely, control consoles and programmable logic controllers . . . for monitoring . . . and controlling the distribution and flow of electrical power . . . ;
>
> custom designed electrical equipment, custom built switch-gear, industrial automation equipment, and diagnostic equipment, namely: portable power cable couplers . . . for use in mining;
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> electronic controls for motors and custom-built switchgear for use in the mining industry, oil and gas industry . . . ;
>
> electric generator controls and electrical equipment . . . for use in the mining industry, oil and gas industry . . . ;
>
> electric relays . . . for use in the mining industry, oil and gas industry, and other industrial applications.

[2] The application claims June 19, 2013 as a priority filing date based on the applicant's filing of a corresponding trademark application in the United States of America: see section 34 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated July 29, 2015 and was opposed by G&W Electric Company on December 9, 2015. The Registrar forwarded a copy of the statement of opposition to the applicant on December 30, 2015 as required by s.38(5) of the *Trade-marks Act.* The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[4] The opponent's evidence consists of the affidavit of Anthony Locker. The applicant elected not to file evidence in support of its application. Both parties filed a written argument. Only the opponent was represented at an oral hearing.

STATEMENT OF OPPOSITION

[5] The opponent pleads that it is the owner of the trademark ENGINEERED TO ORDER. BUILT TO LAST. which the opponent has used and/or made known in Canada in association with the following goods:

> power cable terminations and joints, namely, pre-molded terminations and joints for use on dielectric cable systems; cable splice boxes; splicing kits primarily comprised of lead sleeve, Novoid compound, dry cotton tape, saturated flax twine, solder, stearine candle, varnished cambric tapes, paper pasters, tinned shielding braid, split tinned solder copper connectors, saturated webbing and compression connectors; SF6 electric circuit switches; solid dielectric switches; vacuum switches, namely, switches and switch gears used in transmission and distribution of electrical power; automatic transfer switches for use in connection with electrical distribution and transmission systems; current limiting protectors; single and three phase reclosers, namely, electric circuit closers to reclose interrupted high voltage electrical circuits; and microprocessor-based power management systems comprised of power distribution switchgear with protective electric relays for controlling automatic switching operations in overhead and underground loop distribution circuits; custom designed electrical controls; automatic circuit reclosers; solid dielectric reclosers; fault interrupting switches; current limiters; commutating current limiters; triggered current limiters; Is-Limiters; electronic fuses; medium voltage circuit breakers; manual or automated load break[sic].

[6] I note that some of the parties' goods are the same and otherwise the parties' goods are related in that both parties' goods are for the purpose of distributing and controlling electrical power.

[7] The grounds of opposition may be summarized as follows:

1. The applicant is not entitled to register the applied-for mark ENGINEERED TO PERFORM. BUILT TO LAST. because at the claimed date of first use (April 30, 2013) it was confusing with the opponent's mark previously used and/or made known Canada.

2. The applied-for mark is not distinctive of the applicant's goods owing to the opponent's prior use of its mark ENGINEERED TO ORDER. BUILT TO LAST.

3. The application does not comply with section 30(b) in that the subject mark has not been used since the date claimed, or alternatively that such use has ceased or has not been continuous.

4. The application does not comply with section 30(i) because the applicant was aware of the prior use "and/or notoriety" of the opponent's mark in Canada.

[8] Before assessing the grounds of opposition, I will first review the opponent's evidence, the evidential onus on the opponent, the legal onus on the applicant, and the meaning of confusion in the context of the *Trade-marks Act*.

OPPONENT'S EVIDENCE

*Anthony Locker*

[9] Mr. Locker identifies himself as a senior executive of the opponent company. His testimony may be summarized as follows.

[10] The opponent "G&W" is located in Bolingbrook, Illinois in the United States and has been a global supplier of electric power equipment since 1905. The opponent has about 800 employees worldwide "and global revenue of approximately $300 million" - presumably annually. The opponent has manufacturing facilities in various countries as well as in Brampton, Ontario. The opponent has been operating in Brampton since 1982 where it currently employs 90 people. The opponent's Brampton facility operates as G&W Canada Corporation. Mr. Locker discusses the relationship between the two corporate entities at para. 2 of his affidavit:

> . . . My company's Canadian facility, G&W Canada Corporation (formerly Canada Power Products Corporation) (hereinafter "G&W Canada"), is approximately 210,000 square feet in size. G&W and G&W Canada are under common ownership. G&W Canada is authorized by G&W to use the mark ENGINEERED TO ORDER. BUILT TO LAST. and G&W controls all use of the trademark by G&W Canada. G&W has direct or indirect control of the character and quality of the goods in association with which the mark is used. G&W supervises the use of such mark by G&W Canada by providing all product specifications, all marketing and advertising materials, and reviewing and approving all of G&W Canada's uses of the mark. G&W Canada does not have its own marketing department and uses G&W's marketing department.

[11] The opponent's mark ENGINEERED TO ORDER. BUILT TO LAST. has been used in the United States since 2008 and was registered in that jurisdiction in 2013. The mark has also been used in Canada since 2008. Initially, the opponent itself sold and shipped goods to Canadian customers. Beginning in 2012 orders for the opponent's goods were handled by G&W Canada. Canadian customers include electric utilities, universities, government, military, as well

as Suncor, Shell, Imperial Oil and Exxon. Exhibits C to E of Mr. Locker's affidavit illustrate how the opponent's mark has since 2008 appeared on Canadian invoices, sales order acknowledgements, packing slips and instruction manuals.

[12] Sales in Canada for the opponent's goods sold under the mark ENGINEERED TO ORDER. BUILT TO LAST. averaged $US 27.5 million for the years 2012-2013 rising to an average of $US 41.7 million for the years 2014-2016. The opponent promotes its goods bearing its mark by placing ads in print magazines, online websites and advertising at trade shows. Marketing and advertising expenses in Canada averaged about $US 60,000 for the years 2012-2013 rising to an average of about $US 123,000 for the years 2014-2016.

[13] An example of advertising and promotion activity is discussed at para. 11 of Mr. Locker's affidavit:

> G&W advertises Goods sold bearing the trademark ENGINEERED TO ORDER. BUILT TO LAST. in Transmission & Distribution World magazine, its supplements and annual buyer's guide and their online counterparts and has done so on a regular basis since 2008. Transmission & Distribution World magazine is the premier magazine for users of equipment for high- and medium- voltage electrical transmission and distribution. According to the Transmission & Distribution World media guide, its readers believe that it is the most valuable and credible publication in the process of purchasing equipment for electrical transmission and distribution. This magazine is distributed in Canada. Now produced and shown to me and marked as Exhibit F to this my affidavit are copies of my company's advertisements in this magazine dated September 2011, March 2012, April 2012, February 2013, March 2013, April 2015 and March 2016 and the Annual Buyer's Guide 2009, 2010, 2011, 2012, 2013 and 2014 which are representative of those ads placed in this magazine since 2008 for Goods sold bearing the trademark ENGINEERED TO ORDER. BUILT TO LAST. Now produced and shown to me and marked as Exhibit G to this my affidavit are copies of the circulation figures for this publication from 2008 to 2015, provided to my company by the publication, listing Canadian circulation figures.

[14] It appears from Exhibit G that the circulation figures in Canada (for the month of May) for the above-mentioned magazine averaged 823 for the years 2008-2009 and 1104 for the years

2101-2014. The costs to advertise in the magazine over the five year period 2102-2016 amounted to $US 367,000 with a high of $US 100,000 in 2013 and a low of $US52,000 in 2012.

[15] Mr. Locker also details the opponent's attendance at trade shows in Toronto in 2012 and 2014, each show having over 3,000 attendees; in Vancouver in 2008 and in Montreal in 2010, each show having over 1,500 attendees.

[16] Mr. Locker discusses the opponent's presence on the Internet at para. 14 of his affidavit. The website has been in operation since 2004 and the opponent's mark ENGINEERED TO ORDER. BUILT TO LAST. has been displayed on the website since 2008. The website has had over 29,000 unique visitors from Canada for the period January 1, 2012 to August 29, 2016.

## LEGAL ONUS AND EVIDENTIAL BURDEN

[17] 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.

[18] 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

[19] The third ground of opposition may be dismissed summarily because the opponent has not met the evidential onus on it to put the third ground into issue. The fourth ground may also be dismissed summarily but for a different reason namely, the opponent has not pleaded any facts to support a ground of opposition based on section 30(i): see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 CPR (2d) 152 at 155 (TMOB) and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 CPR (3d) 221.

[20] The determinative issue with respect to the first ground of opposition (alleging non-entitlement) and second ground (alleging non-distinctiveness) is whether the applied-for mark ENGINEERED TO PERFORM. BUILT TO LAST. is confusing with the opponent's mark ENGINEERED TO ORDER. BUILT TO LAST. The material dates to assess the issue of confusion are, respectively, the claimed date of first use in Canada (April 30, 2013) and the date of opposition (December 9, 2015).

MEANING OF CONFUSION BETWEEN TRADE-MARKS

[21] 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 ENGINEERED TO PERFORM. BUILT TO LAST. would believe that those goods were produced or authorized or licensed by the opponent who sells its goods under the mark ENGINEERED TO ORDER.

BUILT TO LAST. 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 section 6(5)(a) to section 6(5)(e) of the *Trade-marks 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 section 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] Neither of the parties' marks possesses a high degree of inherent distinctiveness. In this regard, both marks consist of two descriptive (if not clearly descriptive) phrases. The opponent's evidence establishes that its mark had acquired a fairly substantial reputation in Canada (at least in the target group for such goods) by the earliest material date, and continued to acquire distinctiveness thereafter. The first factor, which is a combination of inherent and acquired distinctiveness, therefore favours the opponent.

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

[25] The second factor also favours the opponent as its mark has been in use in Canada since 2008 and there is no evidence showing that the applicant has used its mark in Canada.

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

[26] The opponent's submissions with respect to the third and fourth factors are found at paras. 47-58 of its written argument, shown below:

> 48. The mark ENGINEERED TO ORDER. BUILT TO LAST. is used in Canada in association with various electrical power equipment including power cable terminations and joints, distribution switches, reclosers, current limiting systems, distribution and transmission cable accessories junction bars and wind tower switchgears . . . The Opponent's Goods are sold to customers in Canada including in the electric utilities, mining, oil and gas, wind power supply, universities and colleges, government, military and other industries . . .
>
> 49. The Applicant's Goods are also electric power equipment and include electric power distribution centers, electric substations, relays, switchgear, couplers voltage monitors, transformers and generators.
>
> 50. The parties' goods are related in that they are all electrical goods used in the distribution and controlling of electrical power. In addition, we note that some of the goods are directly overlapping such as switches and switch gears, current limiting protectors and protection relays. Where the goods do not directly overlap, they are complementary. For example, the Applicant's Goods include modular building and e-houses sold as a housing component of custom-designed, medium and low voltage electrical equipment for electrical distribution, protection and control and portable low-to-medium voltage electric power centers for power distribution and electric substations. These goods are clearly related to the electric power, control and distribution goods of the Opponent. In sum, the goods of both parties have the same purposes, namely to facilitate the provision, distribution and control of electricity.
>
> 51. As set forth in *BAB Holdings, Inc. v. The Big Apple Ltd.* (2002) 16 C.P.R. (4th) 427 at 431:
>
> > It is settled law that where it is likely the public will assume the applicant's goods are approved, licensed or sponsored by the opponent so that a state of doubt and uncertainty exists in the minds of the purchasing public, it follows that the trade-marks are confusing . . .

. . . . .

> 53. The parties are using essentially the identical mark in association with the same or generally the same types of goods . . . the goods are in the same general class and are marketed to the same general consumer - one who seeks to purchase electrical goods for the supply, control and distribution of electricity. Accordingly, we submit, the public will likely assume that the goods covered by the Opposed Application are approved, licensed or sponsored by the Opponent, which is not the case.
>
> . . . . .
>
> 57. The field of use for the Applicant's Goods is specified as for use in the "mining industry, oil and gas industry and other industrial applications." Accordingly, not only do some of the channels of trade directly overlap, namely the mining, oil and gas industries, the Applicant is claiming use of its mark for goods of the same general class for other industrial applications. We submit that this is analogous to saying for "any industry" and therefore the channels of trade directly overlap.
>
> 58. For the above reasons, we submit that these factors favour the Opponent.

[27] I agree with the opponent that the parties' goods overlap or are related. Further, in the absence of evidence to the contrary, I infer that the parties' goods would travel through overlapping channels of trade. I therefore find that the third and fourth factors favour the opponent.

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

[28] The opponent's submissions with respect to the fifth factor are found at paras. 36-40 of its written argument, shown below:

> 37. The Opponent's trade-mark is ENGINEERED TO ORDER. BUILT TO LAST. The Applicant's trade-mark is ENGINEERED TO PERFORM. BUILT TO LAST.
>
> 38. We submit that the marks are nearly identical in appearance, sound and idea suggested. With respect to appearance and sound, both marks consist of six words, with five of the words being identical. The marks are also presented in the same structure, in that each mark consists of two sentences of three words each and each sentence ends in a period.

> 39. The only difference between the marks is the third word, namely "order" in the Opponent's Mark and "perform" in the Applicant's mark. Regardless, we submit that the connotation of the marks is essentially the same. The Opponent's Goods are engineered to order, and therefore to "perform." Both marks include the identical phrase "built to last."
>
> 40. Accordingly, we submit that Section 6(5)(e) favours the Opponent.

[29] I agree that the parties' marks resemble each other to a high degree visually, in sounding and in ideas suggested. I therefore find that the fifth factor strongly favours the opponent.

DISPOSITION

[30] Having regard to the section 6(5) factors discussed above, each of which favours the opponent, I find that the applied-for mark was, at all material times, confusing with the opponent's mark with respect to all of the goods specified in the subject application.

[31] The application is therefore refused.

[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*.

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** 2018-07-18

**APPEARANCES**

| | |
|---|---|
| Terry Edwards | FOR THE OPPONENT |
| No one appearing | FOR THE APPLICANT |

**AGENTS OF RECORD**

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|---|---|
| Bereskin & Parr | FOR THE OPPONENT |
| Kirby Eades Gale Baker | FOR THE APPLICANT |