

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 94

Date of Decision: 2019-09-11

IN THE MATTER OF AN OPPOSITION

Spectrum Brands, Inc.

Opponent

And

Schneider Electric Industries SAS

Applicant

1,556,162 for WISER

Application

INTRODUCTION

[1] Schneider Electric Industries SAS (the Applicant) has applied to register the trademark WISER (the Mark), on the basis of proposed use in Canada, in association with a long list of goods and services, covering among other things, various electric apparatus and instruments, and various services in the fields of electric installations, electric energy management and building management. I am reproducing in Schedule A to my decision, the statement of goods and services, as revised by the Applicant, together with an unofficial English translation.

[2] Spectrum Brands, Inc. (the Opponent) opposes the application based on various grounds, including that the Mark is confusing with its registered trademark WEISER.

[3] For the reasons that follow below, I find the application ought to be refused in part.

THE RECORD

[4] The application was filed on December 14, 2011 and claims a priority filing date of June 22, 2011. It was advertised for opposition purposes in the *Trademarks Journal* on February 13, 2013. By way of a revised application ultimately filed by the Applicant a few days before the oral hearing held in this matter and accepted by the Registrar, the statement of goods and services was voluntarily revised by the Applicant so as to delete some of the goods initially covered by the application and limit some of the remaining goods by adding the phrase “excluding for door locks, door keys and related door hardware”.

[5] The opposition was brought under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) by way of a statement of opposition filed by Kwikset Corporation (Kwikset) with the Registrar on April 30, 2014. By way of a merger of Kwikset with and into Spectrum Brands, Inc., the Registrar’s record was updated to reflect that the Opponent is now Spectrum Brands, Inc. (per the Opponent’s letter dated October 5, 2016).

[6] Numerous amendments to the Act came into force on June 17, 2019. The date for identifying which version of the Act applies to opposition proceedings is the date on which the application being opposed was advertised. As the present application was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read on June 16, 2019, with the exception of confusion for which subsections 6(2) to (4) of the Act as they currently read will be applied.

[7] The grounds of opposition pleaded by the Opponent initially alleged that the Mark is not registrable under section 12(1)(d) of the Act, that the Mark is not distinctive under section 2 of the Act and that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act because the Mark is confusing with the Opponent’s WEISER word and design trademarks listed in Schedule B attached to my decision (hereinafter sometimes collectively referred to as the WEISER Trademarks), and further alleged that the application for the Mark does not comply with section 30(i) of the Act because the Applicant could not be satisfied that it was entitled to use the Mark in Canada in view of the Applicant’s knowledge of the Opponent’s prior use and registration of the WEISER Trademarks. However, the

section 30(i) ground of opposition was voluntarily withdrawn by the Opponent during the oral hearing held in this matter.

[8] In support of its opposition, the Opponent filed the affidavit of Sydney W. Pell, sworn on December 30, 2015 (the Pell affidavit), and certified copies of each of the trademarks identified in Schedule B referred to above and of the following trademarks also in the name of the Opponent: KEVO (TMA913,325); KEVO (application No. 1,646,841); HOME CONNECT & Design (TMA915,025); and SECURITY & INNOVATION SINCE 1904 (TMA819,386).

[9] In support of its application, the Applicant filed a certified copy of its application for the Mark, as it was pending as of August 24, 2016.

[10] Each party filed a written argument and was represented at an oral hearing.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

[12] Each of the three grounds of opposition relied upon by the Opponent turns on the issue of the likelihood of confusion between the Applicant's Mark and the Opponent's WEISER Trademarks. As the material date with respect to the registrability ground of opposition is the latest date at which the issue can be considered, I will address it first.

Section 12(1)(d)

[13] The Opponent has pleaded that the Mark is not registrable in view of the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's WEISER Trademarks identified in Schedule B.

[14] I have exercised the Registrar's discretion to confirm that each of the registrations identified in Schedule B is in good standing as of today's date, which is the material date for assessing this ground of opposition [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[15] In this regard, I note that registration Nos. TMA306,155 and TMA582,240 for the trademarks WEISERBOLT and BASICS BY WEISER LOCK were automatically expunged for failure to renew on March 31, 2016 and January 10, 2019 respectively. I will not, therefore, consider these two registrations.

[16] I further note that registration No. TMA129,747 for the trademark WEISER was amended by the Registrar on June 7, 2016. More particularly, the goods (3) to (10) enumerated in Schedule B to my decision were added to the registration when application No. 263,593(1) filed on May 29, 2013 for extending the statement of goods covered by existing registration No. TMA129,747 matured to registration on June 7, 2016. At the hearing, the Applicant submitted that I should consider the statement of goods as it read at the time the statement of opposition was filed. The Applicant takes the position that the Opponent should have sought leave to amend its statement of opposition in order to reflect the fact that application No. 263,593(1) had matured to registration. I respectfully disagree.

[17] As indicated above, I must ensure that each of the registrations relied upon by the Opponent in support of the present ground of opposition is extant as of the date of my decision. In the present case, application No. 263,593(1) to extend the statement of goods covered by registration No. TMA129,747 has been pleaded by the Opponent in support of its section 12(1)(d) ground of opposition along with the Opponent's existing registrations listed at Schedule B. The Applicant is not taken by surprise, nor does this result in a *new* ground of opposition *per se*, as registration No. TMA129,747, into which application No. 263,593(1) matured to registration, has been pleaded by the Opponent. In my view, the present case is distinguishable from the situation where an opponent, relying on a trademark in respect of which an application for registration had been previously filed, attempts to rely on the registration that issued from the same application, without having properly pleaded the existence of that registration in its statement of opposition, thus resulting in the addition of a completely new

ground of opposition. I will therefore consider registration No. TMA129,747 as amended. I wish to add that if I am wrong in so doing, this does not change the ultimate outcome of the present opposition, especially in view of my finding under the section 2 (non-distinctiveness) ground of opposition discussed later.

[18] As the Opponent has met its evidential burden in respect of the present ground of opposition, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trademarks that are still extant.

[19] As I consider the Opponent's case to be strongest with respect to the Opponent's word mark WEISER that is the subject of registration No. TMA129,747, I will focus my discussion on that one mark of the Opponent, unless indicated otherwise.

The test for confusion

[20] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

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

[22] 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 trademarks and the extent to which they have become known; (b) the length of time the trademarks 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 trademarks 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 SCC 22, 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23, 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* 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 trademarks and the extent to which they have become known

[23] I assess the inherent distinctiveness of the parties' marks as about the same and relatively low, owing to the somewhat laudatory connotation of the ordinary dictionary word "wiser" in the context of the Applicant's applied-for goods and services, and the surname significance of the word "Weiser".

[24] The strength of a trademark may be increased by means of it becoming known through promotion or use.

[25] There is no evidence that the Applicant's proposed use Mark has been used in Canada pursuant to section 4 of the Act or that it has become known to any extent in Canada.

[26] In contrast, I am satisfied from my review of the salient points of the Pell affidavit discussed below, that the Opponent's WEISER word mark has been used and become known to a significant extent in Canada in association with, generally speaking, residential locks, lock systems, and door hardware.

The Pell affidavit

[27] As noted by the Applicant at the hearing, there are some ambiguities in the way Mr. Pell refers to the Opponent as well as to the Opponent's WEISER trademark and goods in his affidavit.

[28] As indicated before, Mr. Pell's affidavit was executed before Kwikset merged with Spectrum Brands, Inc.

[29] At paragraph 1 of his affidavit, Mr. Pell asserts that:

I am the Marketing Director, Locks at Spectrum Brands [my underlining]. I have held this position since February 2015. In the conduct of my duties as Marketing Director, I have become familiar with the history, sales, marketing, and distribution of my company's products in Canada. I have also had access to the records that my company keeps in the usual and ordinary course of business. I thus have personal knowledge of the facts herein, save where stated to be based on information and belief, and where so stated I verily believe such facts to be true.

[30] However, at paragraph 3 of his affidavit, Mr. Pell asserts that:

Kwikset Corporation (hereinafter "Kwikset" or "the Opponent"), is a lock and lockset manufacturer owned by Spectrum Brands Hardware and Home Improvement Group, a Division of Spectrum Brands Holdings, Inc. [My underlining]

[31] The Applicant submitted at the hearing that it is unclear how Mr. Pell could have access to Kwikset's records given that the entity named in paragraph 1 of his affidavit is not named as such in paragraph 3 thereafter. I cannot but agree with the Applicant that this part of Mr. Pell's affidavit is poorly written. However, I note that in its written argument, the Applicant had not taken any issue with respect to Mr. Pell's personal knowledge of the facts deposed to. Moreover, the Applicant elected not to cross-examine Mr. Pell on his affidavit, and I therefore have no reason to discount Mr. Pell's evidence. That being said, the fact that Mr. Pell was not cross-examined does not prevent me from assessing the value of his evidence.

[32] Turning to Mr. Pell's manner of referring to the Opponent's WEISER trademark and goods, Mr. Pell asserts at paragraph 4 of his affidavit that the Opponent "is the owner of the WEISER® Trademarks in Canada" [my underlining] and that "WEISER® has been used for locks and related door hardware in Canada since at least as early as 1938". He further asserts at paragraph 5 that "WEISER® is, and has been for years, the #1 selling residential lock brand in Canada for consumers, as well as 'Top 100' builders" and that it "currently enjoys 48% of the market share for these goods in Canada."

[33] Mr. Pell goes on and asserts at paragraph 6 of his affidavit that "[t]he WEISER® trademark has been in use in Canada continuously, by the Opponent, its predecessors in title, and their licensees for the last 75 years".

[34] At paragraph 7 of his affidavit, Mr. Pell attaches as Exhibit A to his affidavit, what he describes as "a printout of the WEISER® trademarks currently active on the Canadian Register

(hereinafter referred to as the “WEISER® Trademarks”) [my underlining]”. However, the trademarks listed in Exhibit A include, in addition to the trademarks listed in Schedule B referred to in my decision, trademarks that do not comprise *per se* the word “WEISER”, namely the four other trademarks in the name of the Opponent mentioned above in my review of the record: KEVO (TMA913,325); KEVO (application No. 1,646,841); HOME CONNECT & Design (TMA915,025); and SECURITY & INNOVATION SINCE 1904 (TMA819,386).

[35] At paragraph 8 of his affidavit, Mr. Pell then includes a listing of the trademarks that he considers to be “of particular relevance to this proceeding”. I note that the trademarks so listed match the ones listed in Exhibit A attached to his affidavit, with one exception, namely the trademark SECURITY & INNOVATION SINCE 1904, which has not been included.

[36] At paragraph 9 of his affidavit, Mr. Pell attests that:

A wide variety of goods are sold in association with the WEISER® Trademarks, including door handles, door handle sets, door levers, face plates, door knobs, deadbolts, padlocks, pocket locks, electronic locks, and keyless locks and locks systems (hereinafter the “WEISER® Goods”). All WEISER® Goods are marked and sold in packaging that bear the house mark WEISER®, including the SMARTCODE™ series of electronic locks and the WEISER® KEVO® smart lock.

[37] Both in its written argument and at the hearing, the Applicant has taken issue with the fact that Mr. Pell does not discriminate between the various goods and the various trademarks of the Opponent. Without going into the detail of the Applicant’s arguments, the Applicant submits, among other things, that it is not possible to determine the extent to which the WEISER trademark has been used and become known in Canada, nor in association with which goods precisely. In response, the Opponent submitted at the hearing that Mr. Pell’s affidavit must be considered as a whole and can be comprehended by “a mind willing to understand”. In this regard, the Opponent submitted that the “WEISER® Goods” can be understood as consisting of the ones enumerated at paragraph 9 of Mr. Pell’s affidavit, in that the word “including” in that paragraph was meant to mean “namely”. Upon review of Mr. Pell’s affidavit as a whole, I agree with the Opponent.

[38] For example, at paragraphs 10 to 30 of his affidavit, Mr. Pell goes over each of the goods sold under the “WEISER® Trademarks”. While he does not necessarily discriminate between the

various trademarks, he does attach to his affidavit representative images for each of the “WEISER® Goods” showing, for each of them, which of the WEISER® Trademarks is/are marked thereon or associated therewith.

[39] In this regard, upon my careful review of Mr. Pell’s assertions of use and accompanying Exhibits B to J, and N, attached to his affidavit, I am satisfied that the Opponent has shown use of the WEISER word mark in Canada in association with residential locks, lock systems, and door hardware, and more particularly with each of the “WEISER® Goods”, namely door handles, door handle sets, door levers, face plates, door knobs, deadbolts, padlocks, pocket locks, electronic locks, and keyless locks and lock systems. I will return to the nature of the Opponent’s keyless locks and lock systems later when considering the nature of the parties’ goods under the section 6(5)(c) factor. Suffice it to note, at this point, that in each case, the WEISER word mark is prominently displayed on the product packaging (in addition to being marked on some of the goods themselves), either alone or in combination with another separate and distinct trademark of the Opponent, like the trademarks SMARTKEY, SMARTCODE, and KEVO. On this latter point, it is well established that multiple trademarks may be used together on the same product [*AW Allen Ltd v Warner Lambert Canada Inc* (1985), 6 CPR (3d) 270 at 272 (FCTD)].

[40] At paragraphs 31 to 41 of his affidavit, Mr. Pell turns to the sales and promotion of the WEISER® Goods. He asserts that the WEISER® Goods are available, and were available long prior to 2011, for purchase across Canada through local hardware stores and major retailers, as well as through residential access security distributors. I will return to the nature of the Opponent’s channels of trade under the section 6(5)(d) factor.

[41] Mr. Pell provides at paragraph 34 of his affidavit the approximate annual sales of the WEISER® Goods in Canada from 2010 to 2015, which were in excess of 500 million dollars (namely 2010: \$99,400,000; 2011: \$79,000,000; 2012: \$83,000,000; 2013: \$81,000,000; 2014: \$88,000,000; and 2015 (Jan. to Nov.): \$96,000,000). While Mr. Pell does not discriminate between each of the WEISER® Goods, he does specifies at paragraph 35 of his affidavit that the approximate annual sales of the WEISER® KEVO ® “smart” locks in 2014 and 2015 amounted to over 3 million and 1.8 million dollars respectively. Furthermore, on a fair reading of the affidavit as a whole, it remains that all of these sales are attributable to, generally speaking,

residential locks, lock systems, and door hardware all displaying the WEISER word mark, as discussed above.

[42] Mr. Pell further asserts that the WEISER® Goods are actively promoted in Canada. Relying on a two page excerpt from a “Brand Awareness study conducted by the Canadian consumer research company Vision Critical” attached as Exhibit Q to his affidavit, Mr. Pell asserts that “WEISER® is the most recognized brand of locks in Canada”. However, I am not prepared to give weight to this survey, if not only because the methodology used to justify this brand awareness is unexplained. Still, Mr. Pell asserts that from 2012 to November 2015, over 8.7 million dollars was invested in advertising the WEISER® Goods. In support, Mr. Pell attaches numerous exhibits, including samples of print advertisements circulated in Canadian publications from 2007 and 2008 (such as *Chatelaine*, *Canadian Architect*, *Canadian House & Home*, *Toronto Life*, *Vancouver Magazine*, *Canadian Home & Country*, *Decormag*, *Les Idées de ma Maison*; etc.) [Exhibit R] and industry publications from 2012 and 2015 (such as *Timbermart Magazine*) [Exhibit S]; photos of in-store displays of the WEISER® Goods [Exhibit N]; printouts showing a selection of WEISER® Goods currently available from online retailers [Exhibit O]; etc.

[43] Commenting on these materials, Mr. Pell stresses that one of the central marketing themes for promoting and advertising the WEISER® Goods is the word play of “Weiser” and “wiser”. He asserts that the themes “Locks are wise. Smart Locks are WEISER®” and “Get smart...Get WEISER®” have been in use for many years and that these themes have been particularly effective in promoting the compatibility of WEISER® Goods with home automation systems and other smart technology equipped goods [para 41].

[44] To sum up, when the Pell affidavit is viewed in its entirety, I am satisfied that the WEISER word mark has acquired significant reputation through extensive use and promotion in association with, generally speaking, residential locks, lock systems, and door hardware. Therefore, such use and promotion increases the distinctiveness of the WEISER word mark and prevents, contrary to the Applicant’s position, the application of the “narrow protection” doctrine governing inherently weak trademarks.

Conclusion – Re The inherent distinctiveness of the trademarks and the extent to which they have become known

[45] In view of all the foregoing, I find that the overall assessment of the section 6(5)(a) factor, which is a combination of the inherent distinctiveness of the parties' trademarks and the extent to which they have become known favours the Opponent.

The length of time the trademarks have been in use

[46] In view of my comments above, this factor favours the Opponent.

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

[47] When considering the nature of the goods and the nature of the trade, I must compare the Applicant's statement of goods and services with the statement of goods in the registration relied upon by the Opponent [*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. Evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 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)].

[48] As shown in Schedule A, the application for the Mark covers quite a wide range of goods and services relating to, among other things, electrical energy management. I agree with the Applicant that none of these goods and services directly overlap with the registered goods of the Opponent. In this regard, and contrary to the Opponent's position, the mere fact that some of the Applicant's applied-for goods can be found within a building, as do the Opponent's registered goods, does not suffice to render the parties' goods similar.

[49] However, based on my review of the evidence, I am prepared to find an indirect overlap between the Applicant's goods described as [TRANSLATION]: "temperature controllers; electric apparatus and installations for the control, remote control, radio control and management of

household electric apparatus and installations; control interfaces and displays for household apparatus and installations” (in French: “*contrôleurs de température; appareils et installations électriques de commande, de télécommande, de radiocommande et de gestion pour les appareils et installations électriques domestiques; écrans et interfaces de commande pour les appareils et installations électriques domestiques*”) and the Opponent’s lock systems.

[50] As explained by Mr. Pell in his affidavit, the product line covered by the Opponent’s registration for the word mark WEISER has evolved over the years to include innovative offerings such as electronic locks, and keyless locks and locks systems, which can be integrated with home energy management and automation devices.

[51] More particularly, Mr. Pell asserts at paragraphs 24 to 28 of his affidavit that:

24. The WEISER® SMARTCODE™ deadbolt with WEISER® HOME CONNECT® technology allows a user to remotely check the door lock status, lock or unlock the door, and receive text or email notifications with information (door status, who is home, etc.) from any internet enabled device. The WEISER® SMARTCODE™ Deadbolt with WEISER® HOME CONNECT® technology uses Zigbee and Z-Wave shortwave wireless technology. This permits the lock to wirelessly communicate with other “smart” devices in the home and be integrated into home automation systems. For instance, working with a security system, locking or unlocking the door can enable or disable the home alarm. Working with “smart” lights, entering or exiting the house can prompt the lights to turn on or shut off. Similarly, working with a smart thermostat, locking or unlocking the door will tell the thermostat to adjust the home’s temperature accordingly. The lock can be coordinated with an unlimited number of devices including “smart” fans, appliances, entertainment systems, landscaping systems etc.

25. By way of example, the WEISER® SMARTCODE™ Deadbolt is compatible with the WINK smart home/home automation platform. The WINK home automation platform can manage and control a wide variety of smart home products including lights, power, security and climate. The WINK home automation system is co-marketed with the WEISER® SMARTCODE™ Deadbolt at Home Depot Canada.

26. The WEISER® KEVO® smart lock can also be integrated with home automation systems. For instance, the WEISER® KEVO® Mobile App seamlessly works with the NEST home automation system. [...]

28. Using the WEISER® KEVO® smart lock’s Touch-To-Open technology, the NEST thermostat will recognize when a user has entered their home and offer to adjust the temperature accordingly. When a user leaves the home and locks the door, a notification will appear, allowing the user to adjust the NEST thermostat to the desired temperature specified with the WEISER® KEVO® Mobile App.

[52] These uncontroverted statements of Mr. Pell are supported by product images and descriptions of the WEISER® KEVO® smart locks [Exhibits J and M] and photographs of in store displays taken at major retailers including Home Depot, Home Hardware and Lowe's stores showing, among other things, the WEISER® KEVO® smart locks, and the WEISER® SMARTCODE™ deadbolts alongside the WINK automation platform [Exhibits L and N].

[53] This brings me to turn to the parties' channels of trade.

[54] Mr. Pell asserts that the Opponent's WEISER Goods are available, and were available long prior to 2011, for purchase across Canada through local hardware stores and major retailers, including Home Depot, Rona, Lowe's, Canadian Tire, Timbermart, Walmart, Réno-Dépôt, Best Buy, The Source, Costco Wholesale, and Home Hardware [para 31 of his affidavit; Exhibit N]. He further asserts that the WEISER electronic locks are also sold, and have been sold since long prior to 2011, by residential access security distributor across Canada. More particularly, Mr. Pell explains that in the last two years (prior to the signing of his affidavit), sales to these distributors has more than doubled. He asserts that AARTech is a Canadian distributor of home automation, security and smart home products to retail and wholesale customers, contractors and resellers across Canada and the United States and that such customers include security companies such as ADT, Rogers, Fluent, Liberty, Bell Canada, and Eastlink Cable [para 33 of his affidavit; Exhibit P].

[55] In the absence of evidence to the contrary, there is no reason to conclude that some of the parties' goods would not travel through the same channels of trade, especially those goods for which I have concluded to an indirect overlap. However, by reason of the apparently very different and specialized nature of many of the Applicant's applied-for goods (like for instance, those goods described as [TRANSLATION]: "apparatus for measuring the electricity generated by photovoltaic panels or wind turbines; electrical charge controllers; apparatus for testing electric car batteries; apparatus for testing electric generators; apparatus and instruments for measuring and monitoring the consumption of electricity, water, gas" (in French: "*appareils de mesure de l'électricité produite par panneaux photovoltaïques ou par éoliennes; contrôleurs de charge électrique; appareils de contrôle de batterie de voitures électriques; appareils de contrôle de générateurs électriques; appareils et instruments de mesure et de surveillance de la*

consommation d'électricité, d'eau, de gaz") and all of the Applicant's applied-for services, I am not prepared to reach the same conclusion with respect to those other goods and services.

[56] In view of all the foregoing, I find that the overall assessment of the sections 6(5)(c) and 6(5)(d) factors lends support to the Opponent's case as far as the Applicant's applied-for goods described as [TRANSLATION]: "temperature controllers; electric apparatus and installations for the control, remote control, radio control and management of household electric apparatus and installations; control interfaces and displays for household apparatus and installations" (in French: "*contrôleurs de température; appareils et installations électriques de commande, de télécommande, de radiocommande et de gestion pour les appareils et installations électriques domestiques; écrans et interfaces de commande pour les appareils et installations électriques domestiques*") are concerned.

The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them

[57] 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".

[58] Moreover, as previously mentioned, it is well-established in the jurisprudence 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" [*Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA), at para 34]. Even though the first word or portion of a trademark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trademark is particularly striking or unique [*Masterpiece*, at para 64].

[59] Applying these principles to the present case, I find there is a fair degree of resemblance between the parties' trademarks.

[60] In this regard, I am in general agreement with the Opponent's position outlined at paragraphs 47 and 48 of its written argument reproduced below:

47. Visually, the only difference between WISER and WEISER is the additional letter "e". Phonetically, the marks are equivalent.

48. Notionally, while the marks can be distinguished on the basis that "wiser" is a dictionary word, derivative of "wisdom", whereas "Weiser" has significance as a surname, this distinction is negated by the significant marketing endeavours of the Opponent, wherein the Opponent has based its advertisements on the homophonous significance of the words "Weiser" and "wiser". For instance, the slogan "Locks are wise. Smart Locks are WEISER. GET SMART...GET WISER" was used by the [Opponent] well before the filing date of the Application. As a result, notionally the marks are associated with the same idea.

[61] As I understand the Applicant's written argument, it does not contradict this finding. Indeed, the Applicant contends that:

29. Nevertheless, the fact the Opponent's trade-marks is almost identical to the common English word "wiser" (aside from the presence of an additional letter "E") does not enable the Opponent to claim a wide ambit of protection for his [sic] WEISER trade-marks in Canada. In his affidavit, Mr. Pell claims that: "one of the central marketing themes [...] is the word play of "weiser" and "wiser" (paragraph 41 of the affidavit). This play on word suggests that one would be "wise" to buy WEISER locks. Thus, although the WEISER mark does possess a certain degree of distinctiveness due to the fact that it does not describe the products with which it is associated, the trademark is nonetheless a weak mark which should be easily distinguished from the [Mark] [...]"

30. Furthermore, Weiser is a family name, a fact that the Registrar make take judicial notice of, therefore lowering its ambit of protection.

[62] While these comments of the Applicant were made under the section 6(5)(a) factor, the fact remains that the Applicant itself acknowledges that the Opponent's trademark WEISER "is almost identical" to the Mark.

[63] Accordingly, this factor favours the Opponent, especially when the parties' trademarks are viewed and sounded.

Conclusion regarding the likelihood of confusion

[64] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

[65] In view of my analysis above, I arrive at the conclusion that the Applicant has not discharged the ultimate onus upon it to show that there is no reasonable likelihood of confusion between the Mark in association with the goods described as [TRANSLATION]: “temperature controllers; electric apparatus and installations for the control, remote control, radio control and management of household electric apparatus and installations; control interfaces and displays for household apparatus and installations” (in French: “*contrôleurs de température; appareils et installations électriques de commande, de télécommande, de radiocommande et de gestion pour les appareils et installations électriques domestiques; écrans et interfaces de commande pour les appareils et installations électriques domestiques*”) and the Opponent’s registered goods. At best for the Applicant, I find the balance of probabilities to be evenly balanced.

[66] In reaching this conclusion, I have had special regard to the following facts: i) by reason of its long and extensive use in association with, generally speaking, residential locks and locks systems, the Opponent’s WEISER trademark has acquired a very significant reputation; ii) there is a fair degree of resemblance between the parties’ trademarks, especially when they are viewed and sounded; and iii) there is an indirect overlap between these particular goods of the Applicant and the Opponent’s registered goods, as shown by the compatibility of the WEISER lock systems with third-party home automation systems.

[67] Accordingly, the section 12(1)(d) ground of opposition succeeds, except for the remaining applied-for goods and services, as explained below.

[68] However, I am satisfied that the Applicant has discharged its legal onus of establishing that there is no reasonable likelihood of confusion between the Mark in association with the remaining applied-for goods and services and the Opponent’s registered goods, as these goods and services differ substantially from the Opponent’s, and as the reputation of the Opponent’s

WEISER trademark has been restricted to the very limited range of goods consisting of, generally speaking, residential locks, lock systems, and door hardware, and there is no reason to believe that this could change.

[69] Accordingly, the section 12(1)(d) ground succeeds partially insofar as it is based on registration No. TMA129,747.

[70] As this registration presented the Opponent's strongest case, it follows that the Opponent would not achieve a more favourable result based on its other pleaded registrations.

Section 2

[71] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act in that:

[...] at all material times, WISER was confusing with the WEISER [Trademarks]. As such, the applied-for mark neither distinguishes nor is it adapted to distinguish the wares of the Applicant from the wares of the Opponent [used in association with the WEISER Trademarks].

[72] I note that this ground of opposition is limited to the Applicant's applied-for goods only. In other words, the Opponent has not alleged that the Mark is not adapted to distinguish the services of the Applicant from the goods of the Opponent.

[73] To meet its evidential burden in respect of this ground, the Opponent must show that its WEISER Trademarks had become known in Canada as of the filing date of the statement of opposition (in this case, April 30, 2014) so as to negate the distinctiveness of the Mark [*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[74] Based on my review above of the Pell affidavit, I am satisfied that the Opponent has met its burden insofar as its word mark WEISER being the subject of registration No. TMA129,767 is concerned. However, I am not satisfied that the Opponent has met its burden with respect to its other trademarks listed in Schedule B.

[75] In this regard, the Pell affidavit does establish use of the WEISER® KEVO® smart lock dating back to 2013.

[76] More particularly, Mr. Pell asserts at paragraph 18 of his affidavit that:

The WEISER® KEVO® Bluetooth Electronic Deadbolt Door Lock was the first Bluetooth enabled, touch-to-open “smart lock” in Canada. In [*sic*] has been available in Canada since 2013. Using Bluetooth technology, the WEISER® KEVO® smart lock functions by detecting a user’s compatible Smartphone or tablet in the nearby vicinity, and allowing a user to lock or unlock the door by simply touching the lock face. The lock is equipped with inside/outside intelligence, which detects whether a verified device is inside or outside of the home. For non-Smartphone users, the WEISER® KEVO® smart lock comes with a keychain fob providing the same touch-to-open access, as well as a regular key. Users can send electronic “e-keys” to others in order to grant unrestricted or temporary access to other phones as well. Attached as Exhibit J are images that are representative of the WEISER® KEVO® smart lock that is for sale and has been sold since use commenced. [...]

[77] As mentioned earlier, Mr. Pell also provides the approximate annual sales of the WEISER® KEVO® smart locks in 2014 and 2015, which amounted to over 3 million and 1.8 million dollars respectively. While no breakdown per month is provided, on a fair reading of Mr. Pell’s affidavit as a whole, I am prepared to infer that a portion of these impressive sales occur prior to April 30, 2014, especially in view of Mr. Pell’s statements at paragraphs 22 and 23 of his affidavit reproduced below:

22. The WEISER® KEVO® Bluetooth Electronic Deadbolt Door Lock has also won significant recognition in the industry. In 2013 it won the *CE PRO* “Best Award”. *CE Pro* is a leading trade publication for professionals in the custom electronics business. That same year it was also recognized by This Old House, a home improvement media brand with television shows, a magazine and a website, as one of the “100 Best New Products” of the year.

23. In 2014 the WEISER® KEVO® smart lock won the award for “Product of the year” from *Electronic House*, a leading information site on the subject of the connected home; the “2014 MASHABLE CHOICE AWARD” from *Mashable.com*, a global media company reporting on new technologies to its audience of 45 million monthly unique visitors and 25 million social followers; and the *CES 2014 INNOVATIONS AWARD* and the *CES 2014 LAST GADGET STANDING*. The *CES Innovation Awards* is an annual competition honoring outstanding design and engineering in consumer technology products.

[78] I consider the evidence filed in respect of the WEISER® KEVO® smart locks sufficient to discharge the Opponent’s burden under the present ground of opposition.

[79] The difference in material dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition. As a result, my finding made above concerning the likelihood of confusion between the Mark and the Opponent's trademark WEISER remains applicable. Accordingly, the non-distinctiveness ground of opposition succeeds partially.

[80] As an aside, I find it is impossible to determine the extent to which consumers had become accustomed to seeing the Opponent's WEISER® SMARTCODE™ deadbolt with WEISER® HOME CONNECT® technology prior to the material date to assess the present ground of opposition as the approximate annual sales of the WEISER® Goods in Canada provided by Mr. Pell at paragraph 34 of his affidavit discussed above do not discriminate between each of the WEISER Goods. But as noted above, this does not affect the outcome of this ground.

Section 16(3)(a)

[81] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the provisions of section 16(3)(a) of the Act in that:

[...] as of all material dates, the [Mark] is confusing with the Opponent's WEISER Trademarks, all of which have been previously used in Canada by the Opponent [...] and which have not been abandoned by the Opponent as of the date of advertisement of the [a]pplication.

[82] To meet its evidential burden in respect of this ground, the Opponent must show that as of the date of filing of the Applicant's application (that is the priority filing date of June 22, 2011), its WEISER Trademarks had been previously used in Canada and had not been abandoned as of the date of advertisement of the Applicant's application [see section 16(5) of the Act].

[83] Based on my review above of the Pell affidavit, I am satisfied that the Opponent has met its burden insofar as its word mark WEISER being the subject of registration No. TMA129,767 is concerned. However, I am not satisfied that the Opponent has met its burden with respect to its other trademarks listed in Schedule B.

[84] In this regard, the difference in material dates does substantially affect my analysis above under the section 12(1)(d) ground of opposition and section 2 ground of opposition (non-distinctiveness) in that there had been no use of the WEISER® KEVO® smart locks at the material date of June 22, 2011. Furthermore, while the Pell affidavit does establish use of the WEISER® SMARTCODE™ deadbolt with WEISER® HOME CONNECT® technology in the recent years, I am not satisfied that it does establish such use prior to June 22, 2011.

[85] Accordingly, the section 16(3)(a) ground of opposition is rejected.

DISPOSITION

[86] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the goods:

“contrôleurs de température; appareils et installations électriques de commande, de télécommande, de radiocommande et de gestion pour les appareils et installations électriques domestiques; écrans et interfaces de commande pour les appareils et installations électriques domestiques” ([TRANSLATION]: “temperature controllers; electric apparatus and installations for the control, remote control, radio control and management of household electric apparatus and installations; control interfaces and displays for household apparatus and installations”)

and I reject the opposition with respect to the remaining goods and all of the services, pursuant to section 38(12) of the Act.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Statement of goods and services, as revised by the Applicant, and unofficial English translation

Produits

- Appareils et instruments électriques, à savoir: interrupteurs, boutons-poussoirs, permutateurs, commutateurs, all the foregoing excluding for door locks, door keys and related door hardware; fiches, prises, blocs multiprises; transformateurs; programmeurs; minuterics; variateurs électriques, excluding for door locks, door keys and related door hardware; variateurs de lumière; compteurs; indicateurs électriques, excluding for door locks, door keys and related door hardware; afficheurs électriques, excluding for door locks, door keys and related door hardware; appareils de mesure de l'électricité produite par panneaux photovoltaïques ou par éoliennes; contrôleurs de charge électrique; appareils de contrôle de batteries de voitures électriques; appareils de contrôle de générateurs électriques; appareils et instruments de mesure et de régulation de la température, nommément capteurs de température, thermostats, sondes pour thermostats, contrôleurs de température; appareils et instruments de mesure et de surveillance de la consommation d'électricité, d'eau, de gaz; appareils et installations électriques de commande, de télécommande, de radiocommande et de gestion pour les appareils et installations électriques domestiques; écrans et interfaces de commande pour les appareils et installations électriques domestiques; émetteurs, récepteurs, radio-émetteurs; appareils de communication par terminaux d'ordinateur, nommément modems, cartes modem, ordinateurs, serveurs informatiques, cartes interfaces informatiques, cartes d'interface réseau, cartes mémoire vierges pour ordinateurs, câbles de connexion nommément câbles audio, câbles vidéo, câbles d'ordinateur, concentrateurs de réseau (hub), routeurs, passerelles Internet; logiciels pour la conception, le chiffrement, la gestion, la commande et la télécommande des installations électriques, all the foregoing excluding for door locks, door keys and related door hardware.

Services

- Services de communication dans les domaines des installations électriques, de la gestion de l'énergie électrique et de la gestion du bâtiment nommément transmission d'informations dans les domaines des installations électriques, de la gestion de l'énergie électrique et de la gestion du bâtiment par navigateurs web, Ethernet, bus de communication et serveurs de communication, transmission de données, nommément textes, sons, images fixes et animées, signaux analogiques et numériques par navigateurs web, Ethernet, bus de communication et serveurs de communication, formatage de données, nommément textes, sons, images fixes et animées, signaux analogiques et numériques et mise en ligne d'informations dans les domaines des installations électriques, de la gestion de l'énergie électrique et de la gestion du bâtiment en temps réel par navigateurs web, Ethernet, bus de communication et serveurs de communication. Conseils et audits en matière d'efficacité

énergétique ; programmation pour ordinateurs, élaboration de logiciels et conception de bases de données dans les domaines de la gestion de l'énergie électrique et de la gestion du bâtiment ; conception de portails informatiques ; fourniture en ligne d'applications informatiques et de logiciels dans les domaines de la gestion de l'énergie électrique et de la gestion du bâtiment.

[UNOFFICIAL ENGLISH TRANSLATION]

Goods

- Electric apparatus and instruments, namely switches, press buttons, transfer switches, selector switches, all the foregoing excluding for door locks, door keys and related door hardware; plugs, sockets, power bars; transformers; programmers; timers; electric selectors excluding for door locks, door keys and related door hardware; light dimmers; meters; electric indicators excluding for door locks, door keys and related door hardware; electric displays excluding for door locks, door keys and related door hardware; apparatus for measuring the electricity generated by photovoltaic panels or wind turbines; electrical charge controllers; apparatus for testing electric car batteries; apparatus for testing electric generators; apparatus and instruments for measuring and regulating temperature, namely temperature sensors, thermostats, thermostat sensors, temperature controllers; apparatus and instruments for measuring and monitoring the consumption of electricity, water, gas; electric apparatus and installations for the control, remote control, radio control and management of household electric apparatus and installations; control interfaces and displays for household apparatus and installations; transmitters, receivers, radio transmitters; apparatus for communication by computer terminal, namely modems, modem cards, computers, computer servers, computer interface cards, network interface cards, blank memory cards for computers, connection cables, namely audio cables, video cables, computer cables, network hubs, routers, Internet gateways; computer software for the design, encryption, management, control and remote control of electric installations, all the foregoing excluding for door locks, door keys and related door hardware.

Services


- Communication services in the fields of electric installations, electrical energy management and building management, namely transmission of information in the fields of electric installations, electrical energy management and building management via web browsers, Ethernet, communications buses and communications servers, transmission of data, namely texts, sounds, still and animated images, analog and digital signals via web browsers, Ethernet, communications buses and communications servers, formatting of data, namely texts, sounds, still and animated images, analog and digital signals and uploading of information (online) in the fields of electric installations, electrical energy management and building management in real time via web browsers, Ethernet, communications buses and communications servers. Consulting and audits related to energy efficiency; computer programming, computer software development and database design in the fields of electrical energy management and building management; design of computer portals; online



provision of computer applications and computer software in the fields of electrical energy management and building management.

SCHEDULE B

Opponent's WEISER Trademarks

Trademark	Reg. No.	Goods / Claims
WEISER	TMA129,747	<p>(1) Inside latch sets, inside lock sets, inside emergency bath lock sets, inside closet latch sets, key-in-knob lock sets, cylinder grip handle lock sets, cylinder knob lock sets, cylinder spring latches, cylinder dead locks, dead bolts, entrance latch and cylinder dead lock combinations, entrance latch and cylinder spring latch combinations and key blanks.</p> <p>(2) Cabinet hardware, door closers, hinges, door trim and decorative trim.</p> <p>(3) Door bolts; fastener bolts; hardware bolts; door handles; door levers; door knobs; door locks; door hardware; door hardware, namely faceplates, back plates; door hardware, namely latches; lock washers; key cylinders for doors; keys; keying kit, namely key blank, key gauge, pins, plug follower, retaining ring, retaining washer, tail piece, cylinder cap tool, master wafers; key blanks; installation tools for locks, namely, jigs, in-line arm guides, spade bits, multi spur bits, hole saw bits, hole saw mandrel and snap rings; hardware screws; nuts and bolts.</p> <p>(4) Door locks, namely electronic door locks; electronic door lock hardware, namely keypads; electronic door locks activated remotely by fobs.</p> <p>(5) Metal door hardware, namely, knobs, levers, lever sets, handles, handle sets, and deadbolts that permit a lock to be securely re-keyed without removal from the door.</p> <p>(6) Door lock, namely biometric lock.</p> <p>(7) Computer software for the remote control of electronic locks.</p> <p>(8) Electronic door locks controlled remotely via wireless local area networking, global computer networks, and wireless telephone networks.</p> <p>(9) Home automation lock systems, namely electronic door</p>

		<p>locks controlled remotely via wireless local area networking, global computer networks, and wireless telephone networks.</p> <p>(10) Touch screens, namely, electronic visual displays for use in association with electronic locks.*</p> <p><u>Claims:</u></p> <p>Used in CANADA since 1938 on goods (1)</p> <p>Used in CANADA since at least as early as 1938 on goods (3)</p> <p>Used in CANADA since at least as early as 1996 on goods (4)</p> <p>Used in CANADA since at least as early as 2006 on goods (5)</p> <p>Used in CANADA since at least as early as 2008 on goods (6)</p> <p>Used in CANADA since at least as early as 2009 on goods (7), (8)</p> <p>Registered in or for UNITED STATES OF AMERICA on July 10, 1962, under No. 734144 on goods (1)</p> <p>Declaration of Use filed February 14, 1977 on goods (2)</p> <p>Declaration of Use filed May 19, 2016 on goods (9), (10)</p> <p>Registrability Recognized under Section 14 of the Trade-marks Act(evidence on file) on goods (1), (2)</p> <p>Note*: As discussed in my decision, the goods (3) to (10) were added to the registration when application No. 263,593(1) filed on May 29, 2013 for extending the statement of goods covered by existing registration No. TMA129,747 matured to registration.</p>
	TMA219,321	<p>(1) Locks; cabinet hardware; door closers, hinges, door trim and decorative trim.</p> <p>Declaration of Use filed February 14, 1977</p>
BASICS BY	TMA582,240	(1) Door hardware, namely locks, door knobs, door levers

WEISER LOCK	(expunged)	and parts thereof. Used in CANADA since at least as early as June 12, 2000
	TMA439,779	(1) Door locks, padlocks, lock hardware, escutheons for locks; installation tools for locks. Declaration of Use filed January 10, 1995
	TMA181,671	(1) Locks. (2) Door closers. Used in CANADA since at least as early as May 04, 1970 on goods (1) Declaration of Use filed February 14, 1977 on goods (2)
WEISERBOLT	TMA306,155 (expunged)	(1) Locks, bolts, locks and bolt hardware. Declaration of Use filed May 24, 1985

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2019-02-19

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