



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 7

Date of Decision: 2020-01-24

IN THE MATTER OF AN OPPOSITION

**Miller Industries Towing Equipment
Inc.**

Opponent

and

**Kawasaki Jukogyo Kabushiki Kaisha,
doing business as Kawasaki Heavy
1,596,381 for VULCAN**

Applicant

Application

INTRODUCTION

[1] Miller Industries Towing Equipment Inc. (the Opponent) opposes registration of the trademark VULCAN (the Mark), filed by Kawasaki Jukogyo Kabushiki Kaisha, doing business as Kawasaki Heavy (the Applicant).

[2] For the reasons that follow, I reject the opposition.

THE RECORD

[3] On September 28, 2012 the Applicant filed the application bearing serial No. 1,596,381 (the Application) for the registration of the Mark. The application has been amended on July 13, 2018 and now covers the following goods:

(1) Motorcycles.

(2) Motors and engines for land vehicles, namely motorcycles, bicycles, scooters and mopeds; Couplings and transmission components for land vehicles, namely motorcycles, bicycles, scooters and mopeds; hovercrafts; Non-electric prime movers for land vehicles not including their parts namely, internal combustion engines, steam engines, jet engines, turbines, all of the foregoing motorcycles, bicycles, scooters and mopeds; machine elements for land vehicles namely, transmission components for motorcycles, bicycles, scooters and mopeds; Parachutes; Anti-theft alarms for vehicles; Wheelchairs; AC motors or DC motors for land vehicles not including their parts all of the foregoing for motorcycles, bicycles, scooters and mopeds; motorized personal water crafts, canoes, kayaks; Ships; Boats; Aircrafts; Railway rolling stock; bicycles and their parts and fittings; Scooters; Mopeds; Handle bars for two-wheeled vehicles; Handle pads for two-wheeled vehicles; Front forks for two-wheeled vehicles; Wheel rims for two-wheeled vehicles; Wheel hubs for two-wheeled vehicles; Spokes for two-wheeled vehicles; Frames for two-wheeled vehicles; Saddle for two-wheeled vehicles; Stands for two-wheeled vehicles; Drive chains for two-wheeled vehicles; Drive belts for two-wheeled vehicles; Fairings for two-wheeled vehicles; Mudguards for two-wheeled vehicles; Side covers for two-wheeled vehicles; Tail covers for two-wheeled vehicles; Pedals for two-wheeled vehicles; Brake pads for two-wheeled vehicles; Luggage racks for two-wheeled vehicles; Warning horns for two-wheeled vehicles; Steering damper for two-wheeled vehicles; Engines for land vehicles, namely motorcycles, bicycles, scooters and mopeds; Rickshaws; Sleighs and snow sleds, bobsleighs; Horse drawn carriages; Bicycle trailers; Baby carriages.

(3) Motorcycles. (the Goods).

[4] The application is based on use and registration in Japan for goods (3) and on proposed use in Canada for goods (2); use in Canada since at least as early as 1984 on goods (1); and claims a priority filing date of August 24, 2012, in Japan for application No. 2012-068610 in association with the same kind of goods (2). It was registered in or for JAPAN on June 27, 2014, under No. 5680591 on goods (3).

[5] On August 25, 2015 the Opponent filed a statement of opposition which was forwarded to the Applicant by the Registrar on September 4, 2015.

[6] The grounds of opposition pleaded are based on sections 30(a) and (i) (compliance), 12(1)(d) (registrability), 16(3)(a) and 16(3)(c) (entitlement) and 2 (distinctiveness) of the Act as it read immediately before the CIF date (both the Act and CIF date will be defined hereinafter).

[7] Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13, (the Act) came into force on June 17, 2019 (CIF date). In the context of opposition proceedings, the date that

determines which version of the Act applies is the date on which the application being opposed was advertised in the *Trademarks Journal* for opposition purposes. In the present case, the Application was advertised on March 25, 2015 prior to the CIF date. Consequently, pursuant to the transitional provisions in section 70 of the Act as amended, the grounds of opposition will be assessed in accordance with the Act as it read immediately before CIF date, with the exception that, in assessing confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[8] All other references to the Act in these reasons are to the Act as amended on CIF date, unless otherwise indicated.

[9] For reasons that will become obvious from a reading of this decision, it is not necessary to detail each of the grounds of opposition pleaded by the Opponent.

[10] The Applicant filed a counter statement on November 4, 2015.

[11] The Opponent filed a statement that it did not wish to submit evidence.

[12] The Applicant filed as its evidence certified copies of the following Canadian registrations:

- VULCAN, TMA463,819;
- VULCAN NOMAD, TMA501,521
- V DESIGN WITH KAWASAKI, TMA501,995
- V DESIGN WITH CLASSIC, TMA508,487
- VULCAN DRIFTER & DESIGN, TMA531,708.

[13] Neither party filed written arguments nor was a hearing held.

EVIDENTIARY BURDEN

[14] The legal onus is on the applicant to show that the application complies with the provisions 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. Once this initial burden is met, the applicant has to prove, on a balance of probabilities, that the particular ground of opposition should not prevent the registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd*

(1984), 3 CPR (3d) 325 (TMOB), *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD), and *Wrangler Apparel Corp v The Timberland Company* [2005] FCJ No 899, (FC)].

GROUND OF OPPOSITION SUMMARILY DISMISSED

[15] As mentioned earlier the Opponent did not file any evidence or submissions. Consequently there is no basis on which I could find that the Opponent has met its evidential burden with respect to the following grounds of opposition:

- Section 30(a): there is no evidence that the Goods are not described in ordinary commercial terms, nor has the Opponent made any submissions in this regard;
- Section 30(i): the application contains a statement that the Applicant is satisfied that it is entitled to use the Mark in Canada in association with the Goods. There is no evidence that would lead to an opposite conclusion;
- Section 16(3)(a) and (c): there is no evidence of prior use and making known in Canada of any of the Opponent`s trademarks listed in its statement of opposition and no evidence of prior use in Canada of any of the Opponent`s tradenames listed therein;
- Section 2 of the Act (distinctiveness); there is no evidence of use of any of the Opponent`s trademarks and/or tradenames listed in its statement of opposition such that any of them would have become known in Canada or well-known in a region of Canada such that it would negate the distinctiveness of the Mark.

[16] For all these reasons, I dismiss each of these grounds of opposition as the Opponent has failed to meet its initial burden of proof.

GROUND OF OPPOSITION BASED ON SECTION 12(1)(D) OF THE ACT

[17] The only remaining ground of opposition is based on section 12(1)(d) of the Act. The Opponent alleges that the Mark is not registrable as it would be confusing with the Opponent`s following registered trademarks:

VULCAN, TMA213,375 (registration`375) in association with (1) Vehicle tire repair equipment, namely:-sectional tire vulcanizers including, components therefor, namely, air bags, heat bags, mandrels, clamps and molds. (2) Automobile vehicle hoists. (3) Towing units for mounting on vehicle bodies and accessories therefor including slings, dollies, and light bars . (4) Frame jacks and ramp hoists. (5) Tow trucks. (6) Vehicle tire

retreading equipment, namely:-curing chambers, tread molders, tread cutters, tread splicers, and tire spreaders.

- VULCAN & Design, TMA558,948 in association with: (1) Tire vulcanizing equipment namely, moulds, bonders, stichers and builders; (2) Tire repair and retreading equipment.
- VULCAN & Design, TMA 584,142 in association with: (1) Towing units namely, tow trucks and car carrier chassis; accessories for such towing units including slings, dollies and light bars; (2) Vehicle tire retreading equipment namely, curing chambers, tread molders, tread cutters, tread splicers, and tire spreaders; vehicle towing equipment namely, tow trucks and towing units for mounting on vehicle bodies and accessories including slings and light bars.

[18] The Opponent has its best chances of success with registration 375. If it is not successful with this registration, it would not achieve a better result with its other two cited registrations.

[19] As mentioned earlier, the Opponent has not filed any evidence. However under this ground of opposition, to maintain the purity of the register, the Registrar has discretion to check the register to see if the registrations cited in the statement of opposition are still extant [see *Quaker Oats Co of Canada Ltd/Cie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[20] I checked the register and they are indeed extant.

[21] This ground of opposition must be assessed at the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[22] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trademarks are described in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks or tradenames have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Mattel Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC

623(CanLII), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc et al*, 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC)].

[23] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether a consumer, with an imperfect recollection of the Opponent's VULCAN mark, who sees the Applicant's Goods in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

[24] Given the absence of written representations from each of the parties and nonattendance at a hearing, where the parties could have developed their respective arguments, I shall limit myself to a straightforward analysis of the relevant criteria under section 6(5) of the Act.

[25] Also, in the absence of evidence of use of the parties' marks, the following factors do not have an impact on the analysis of the likelihood of confusion between the marks in issue: the extent to which the marks are known and the period of time they have been used. As the parties' marks are identical, their inherent distinctiveness is also a non-factor.

Degree of resemblance

[26] As stated in *Masterpiece, supra*, in most instances the degree of resemblance is considered to be the most important factor. In this case the marks in issue are identical. Therefore, I must determine if the other relevant factors (nature of the goods and the parties' channels of trade) favour the Applicant in such a way that they outweigh the degree of resemblance factor.

Nature of the goods and their channels of trade

[27] In the absence of evidence of use of the parties' marks and promotion of the parties' goods, it is difficult to assess those criteria. I am limited to the description of the goods in the Application and the list of goods covered by the Opponent's registration³⁷⁵ [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel*

Kommadnitgellschaft v Super Dragon (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)].

[28] The Opponent's goods appear to be equipment to repair tires, vehicles to repair vehicles or parts thereof, as well as tow trucks. Some of the Goods are related to the general category of motor vehicles such as motorcycles for example. Goods include also parts of motorcycles as well as two-wheeled vehicles' accessories. However, I consider those Applicant's Goods to be different in nature than the Opponent's goods. Finally, the Goods also include unrelated goods to the Opponent's goods such as for example boats, wheelchairs, aircrafts, snow sleds, baby carriage.

[29] In all, the difference in the nature of the parties' respective goods leads me to believe that their channels of trade would also be different. Those two factors favour the Applicant.

Conclusion

[30] Despite the fact that the parties' marks are identical, I am satisfied that the Applicant has met its burden to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion as to the source of the Applicant's Goods because of the difference in the nature of the Goods and their channels of trade. Had there been some evidence in the file to the contrary, I would have reached a different conclusion.

[31] Consequently, I dismiss this ground of opposition.

DISPOSITION

[32] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

Finlayson & Singlehurst

FOR THE OPPONENT

Aventum IP Law LLP

FOR THE APPLICANT