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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 23**

**Date of Decision: 2020-03-03**

**IN THE MATTER OF AN OPPOSITION**

**Illuminacion Especializada De  
Occidente, S.A. De C.V.**

**Opponent**

**and**

**Voltech International Inc.**

**Applicant**

**1,760,221 for Technilight et dessin**

**Application**

INTRODUCTION

[1] Illuminacion Especializada De Occidente, S.A. De C.V. (the Opponent) opposes registration of the trademark Technilight et dessin (the Mark), set out below, that is the subject of application No. 1,760,221 filed by Voltech International Inc. (the Applicant).



[2] Filed on December 18, 2015, the application is based on use of the Mark in Canada in association with the following goods: “luminaires DEL, barres rigides DEL, tubes de lampe

DEL, panneaux lumineux DEL, projecteurs DEL, ampoules DEL, lampes DEL” (LED light fixtures, rigid LED bars, LED light tubes, LED light displays, LED projectors, LED light bulbs, LED lamps) since March 1, 2011 and on proposed use of the Mark in Canada in association with: “lumières DEL antidéflagrantes” (explosion-proof LED lights). The application was advertised in the *Trademarks Journal* of January 11, 2017.

[3] The Opponent alleges that (i) the application does not conform to section 30(i) of the *Trademarks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to the registration of the Mark under section 16 of the Act, and (iv) the Mark is not distinctive under section 2 of the Act.

[4] At the outset of my decision, I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[5] For the reasons that follow, I refuse the application.

#### THE RECORD

[6] The Opponent filed its statement of opposition on March 8, 2017. The Applicant filed and served its counter statement on May 23, 2017 denying all of the grounds of opposition.

[7] In support of its opposition, the Opponent filed the affidavit of Deanna Shannon, registered trademark agent employed by Nexus Law Group LLP, the Opponent’s trademark agent on record.

[8] In support of its application, the Applicant filed the affidavit of Michel Talbot, President and one of the administrators of the Applicant, as well as the affidavit of Camille Miconnet, lawyer employed by Brouillette Legal Inc., the Applicant’s trademark agent on record.

[9] None of the affiants were crossed-examined.

[10] Only the Applicant filed a written argument. Neither party requested a hearing.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities that the application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. 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 [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

ANALYSIS

[12] As a preliminary matter, I note that in her capacity as a trademark agent employed by the agent of record for the Opponent in this proceeding, Ms. Shannon provided information pertaining to the Opponent's business. In particular, paragraph 2 of Ms. Shannon's affidavit discusses when the Opponent was founded and what it does while paragraph 9 of her affidavit introduces an invoice issued by the Opponent, attached as Exhibit G. Ms. Shannon explains that "the information is obtained from the [Opponent's] business records made and maintained in the ordinary course of business".

[13] In its written argument, the Applicant takes issue with the invoice attached as Exhibit G to Ms. Shannon's affidavit because (1) the document is in Spanish and no translation is provided, and (2) it is hearsay evidence given that the document was issued by the Opponent in Mexico, not by Ms. Shannon or her employer.

[14] The Opponent has not provided any explanation as to why it was necessary for its Canadian trademark agent to provide evidence on its business operations, presumably in Mexico, and why the evidence should be considered reliable considering that Ms. Shannon provided no information as to how she obtained the invoice and no indication as to whether she can speak to the Opponent's business or its maintenance of business records.

[15] Under these circumstances, I will not have regard to paragraphs 2 and 9 of Ms. Shannon's affidavit, nor the copy of the invoice attached as Exhibit G.

[16] I will now consider each of the grounds of opposition.

#### Sections 16(1)(b) and 16(3)(b) Grounds Dismissed

[17] In its statement of opposition, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(1)(b) and (3)(b) of the Act, on the ground that the Mark is confusing with the Opponent's registered trademark TECNO LITE & Design (TMA935,102), which had been previously filed in Canada by the Opponent.

[18] The Opponent has the initial burden of establishing that its application was filed prior to the filing date of the Applicant's application, and that it was pending at the date of advertisement of the application for the Mark [section 16 of the Act].

[19] The Registrar has the discretion to check the register in order to confirm the existence of registrations and applications relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and I note that application No. 1,540,601 for the Opponent's trademark TECNO LITE & Design, which led to registration No. TMA935,102, was not pending as of the date of the advertisement of the subject application, namely January 11, 2017, as it was registered on April 18, 2016.

[20] As such, I dismiss the grounds of opposition based on sections 16(1)(b) and 16(3)(b) of the Act for failure by the Opponent to meet its initial evidential burden.

#### Section 30(i) Ground Dismissed

[21] In its statement of opposition, the Opponent alleges that the application does not conform to section 30(i) of the Act as the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as it was and is confusing with the Opponent's registered trademark TECNO LITE & Design. The material date for assessing a section 30 ground is the filing date of the application, namely December 18, 2015 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[22] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the Registrar has previously found that an applicant has failed to substantively comply with section 30(i) where, for example:

- there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155] which has been found where a licensee or distributor has attempted to register their principal's trademark or a confusingly similar variant [see *Suzhou Parsun Power Machine Co Limited v Western Import Manufacturing Distribution Group Limited*, 2016 TMOB 26; *Flame Guard Water Heaters, Inc v Usines Giant Inc*, 2008 CanLII 88292; see also *McCabe v Yamamoto & Co (America) Inc* (1989), 23 CPR (3d) 498 at 503 (FCTD)];
- there is evidence of a prima facie case of non-compliance with a federal statute such as the *Copyright Act* RSC 1985, c C-42 or *Food and Drugs Act*, RSC 1985, c F-27 [see *Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB) at 542-543]; and
- there is evidence that a contractual relationship such as licensor-licensee existed and that the registration of a trademark would constitute a breach of the relationship [see *AFD China Intellectual Property Law Office v AFD China Intellectual Property Law (USA) Office, Inc*, 2017 TMOB 30].

[23] In the present case, the Opponent did not refer to any evidence nor present any arguments in support of its allegation set out in this ground of opposition. Moreover, the fact that the Opponent has alleged confusion between the Mark and its trademark registered in association with the same type of goods or services as those of the Applicant is not by itself sufficient to put into question the statement that the Applicant has made in accordance with section 30(i) of the Act [see *Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197].

[24] Consequently, I dismiss the section 30(i) ground of opposition for the Opponent's failure to meet its initial evidential burden.

#### Section 2 Ground Dismissed

[25] The Opponent alleges that the Mark is not distinctive within the meaning of section 38(2)(d) of the Act having regard to the Opponent's registered trademark TECNO LITE & Design.

[26] The material date for assessing distinctiveness is generally accepted as being the date of filing of the opposition, which is March 8, 2017 in this case [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[27] In order to meet its initial burden with respect to the non-distinctiveness ground of opposition, the Opponent is required to show that its trademark had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Applicant's Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[28] The Opponent failed to demonstrate the extent to which the trademark TECNO LITE & Design has become known in Canada and it did not present any arguments in support of this ground of opposition.

[29] Accordingly, the section 2 ground is dismissed for the Opponent's failure to satisfy its initial evidential burden.

#### Section 12(1)(d) Ground Accepted

[30] In its statement of opposition, the Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act on the ground that it is confusing with the Opponent's registered trademark TECNO LITE & Design (TMA935,102), set out below, the particulars of which are reproduced in Schedule "A" to this decision.

# **Tecno Lite**

[31] The material date for considering this issue is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[32] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the discretion to check the register in order to confirm the existence of the registration relied upon by an opponent [see *Quaker Oats of Canada*]. Having exercised the Registrar's discretion, I confirm that registration No. TMA935,102 is in good standing.

[33] Since the Opponent has satisfied its initial evidential burden for this ground of opposition, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trademark.

[34] For the reasons that follow, I accept this ground of opposition.

[35] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that 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.

[36] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 each has 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, including in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

[37] I will now turn to the assessment of the section 6(5) factors.

*Section 6(5)(a) - the inherent distinctiveness of the trademarks and the extent to which they have become known*

[38] The parties' trademarks have a low degree of inherent distinctiveness as they are both highly suggestive of the character of the lighting products.

[39] In this respect, the Opponent's trademark consists of the terms "tecno" and "lite", written in a font that is not particularly unique or striking. The term "tecno" is not an English or French dictionary word. However, it appears to be a variation of the English term "techno". Attached as CM-10 to CM-12 to Ms. Miconnet's affidavit are numerous definitions of "techno-" from websites belonging to Dictionary.com, Collins Dictionary and MacMillan Dictionary. I note the first definition from each of the three websites, respectively:

- "a combining form borrowed from Greek where it meant 'art', 'skill', used in the formation of compound words with the meaning of 'technique', 'technology', etc.";
- "is used at the beginning of words that refer to technology"; and
- "technology: used with some nouns".

[40] As for the term "lite", when viewed in association with the registered goods, the most pertinent definition in *The Canadian Oxford Dictionary* is "a light, esp. a courtesy light in a motor vehicle" [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 at para 29 which provides that the Registrar can take judicial notice of dictionary definitions].

[41] In view of the dictionary meanings, the Opponent's mark clearly suggests that its lighting products are of a technological nature.

[42] In comparison, the Mark consists of an oval containing a simple geometric pattern followed by the terms "techni" and "light", with the first term in bold. Once again, I do not consider the design component of the Mark to be particularly unique or striking. The term "techni" is not an English or French dictionary word. However, it appears to be a contraction of the English word "technical" or the French word "technique". When viewed in association with the applied for goods, the most pertinent definitions in *The Canadian Oxford Dictionary* for the term "technical" include "of or relating to a particular subject or craft etc." and "of or relating to technological equipment". Similarly, *Le Petit Robert* defines "technique" as "qui appartient à un domaine particulier, spécialisé, de l'activité ou de la connaissance".



[43] In view of the dictionary meanings, the Mark clearly suggests that the Applicant's lighting products are of a technical or technological nature.

[44] The strength of a trademark may be increased by means of it becoming known in Canada through promotion or use. In the present case, no evidence was filed with respect to the extent the Opponent's mark has become known, whereas the Applicant filed evidence of use and promotion of the Mark in Mr. Talbot's affidavit.

[45] In this respect, Mr. Talbot states that the Applicant is in the business of importing, manufacturing and selling electronic and electrical supplies, with a branch specialized in the field of outdoor and indoor lighting systems. Mr. Talbot further states that the trademark TECHNILIGHT has been created for the Applicant's LED lighting products and has been used in the normal course of trade in association with all of the applied-for goods since at least as early as March 1, 2011.

[46] Mr. Talbot explains that in the normal course of trade, the Mark appears on the lighting products or on the packaging in which they are distributed. Attached as Exhibit MT-1 to Mr. Talbot's affidavit is a photo of cardboard boxes for LED light fixtures and a copy of a technical sheet said to be given to the consumer at the moment of the purchase dated March 15, 2011. I note that the Mark appears on the boxes and on the technical sheet. Attached as Exhibit MT-2 is a document showing the pattern of a cardboard box with its dimensions and inscriptions dated September 27, 2010, said to have been used for the distribution of LED lighting products by the Applicant at least as early as 2010. I note that the word TECHNILIGHT appears on the cardboard design, without the figurative elements.

[47] In terms of promotion, attached as Exhibit MT-3 to Mr. Talbot's affidavit are printouts from the Applicant's website located at [www.technilight.ca](http://www.technilight.ca) as they appeared in January 2018. The Mark appears on the top left corner of the webpages with photos of various indoor and outdoor LED lighting systems. In some places, the Mark appears instead of a photo of the lighting fixture. Attached as Exhibit MT-4 is a copy of a brochure dated 2017 bearing the Mark providing the specifications of a number of lighting fixtures. Attached as Exhibit MT-5 is a printout from an authorized distributor's website accessed on January 12, 2018 promoting the Applicant's LED lighting products. The Mark appears on the webpage.

[48] Finally, Mr. Talbot states that the combined total for the sale of lighting products in association with the Mark and the value of advertising was approximately \$20,000 each year since March 1, 2011 and that it has nearly increased six-fold between 2011 and 2016. However, as the Applicant did not provide separate sales and advertising figures, I am unable to determine to what extent its lighting products were actually sold in Canada and whether the Applicant was spending more on advertising than it was making in sales during the entire period.

[49] In the end, while both parties' trademarks have a similar degree of inherent distinctiveness, in view of the Applicant's evidence of use and promotion of the Mark in association with the applied-for goods and in the absence of evidence establishing the extent to which the Opponent's trademark has become known, this factor favours the Applicant.

*Section 6(5)(b) - the length of time the trademarks have been in use*

[50] The application for the Mark is based upon use in Canada since March 1, 2011 in association with "LED light fixtures, rigid LED bars, LED light tubes, LED light displays, LED projectors, LED light bulbs, LED lamps" and proposed use in association with "explosion-proof LED lights". As per my review of Mr. Talbot's affidavit above, I am satisfied that the Applicant has shown some use of the Mark in association with the applied-for goods since at least March 2011.

[51] In comparison, the Opponent's registration No. TMA935,102 claims use of the trademark in Mexico in association with a list of lighting products and a declaration of use in Canada was filed on March 29, 2016 in association with "light bulbs, lighting fixtures, ceiling lights". However, having set aside the evidence introduced by Ms. Shannon in her affidavit in this regard, the Opponent did not provide any meaningful evidence of actual use of its mark. As such, I am unable to make any assessment regarding the use of the Opponent's trademark within the meaning of the Act.

[52] Under these circumstances, the section 6(5)(b) factor favours the Applicant.

*Sections 6(5)(c) and (d) - the nature of the goods, business and trade*

[53] When considering sections 6(5)(c) and (d) of the Act, the statements of goods as defined in the application for the Mark and in the Opponent's registration govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *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)].

[54] The Opponent's trademark is registered for use in association with light bulbs, lighting fixtures, ceiling lights, table and floor lamps, projector lamps, lamp reflectors, lighting diffusers, luminous tubes for lighting, sockets for electric lights and light switches. The Opponent has not provided any evidence of the actual trade it is engaged in.

[55] In comparison, the Mark is applied for use in association with LED light fixtures, rigid LED bars, LED light tubes, LED light displays, LED projectors, LED light bulbs, LED lamps and explosion-proof LED lights. In terms of the nature of the trade, Mr. Talbot states that the Applicant's main business is the sale of outdoor and indoor lighting solutions to businesses in all trade areas and to manufacturers in North America, in particular in Canada, but that the Applicant also supplies lighting solutions to a number of distributors that in turn resell them to individuals in Canada. Mr. Talbot further states that the Applicant has developed a series of LED lighting products specifically adapted to commercial, industrial and other large spaces. The Applicant's main markets are in the agricultural, medical and manufacturing sectors. As such, Mr. Talbot states that the channels of trade for the Applicant's goods are specifically and specially designed for professionals and manufacturers looking for lighting solutions for their professional spaces. The printout attached as Exhibit MT-5, that was extracted from one of the Applicant's authorized distributors' websites, identifies potential applications for the Applicant's lighting fixtures as lighting for computer server rooms, warehouses, conference rooms, garages, indoor pools, car washes, shopping centers, etc.

[56] There is clear overlap between some of the parties' goods while others appear to be closely related as both are in the business of lighting. While the Applicant has provided evidence of its channels of trade, neither the Opponent's registration nor the subject application contains any restriction on the parties' channels of trade. Given that the parties' goods clearly overlap or

are closely related, for the purpose of assessing confusion, I conclude that there is potential for overlap between the parties' channels of trade.

[57] Accordingly, these two factors favour the Opponent.

*Section 6(5)(e) - the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them*

[58] In its written argument, the Applicant submits that the length, the number of characters and the structure of the parties' marks are different such there are important visual differences. The Applicant further submits that the terms TECHNILIGHT and TECHNO LITE are sounded differently. In terms of ideas suggested, the Applicant is of the view that the Mark evokes the idea of lights while the Opponent's trademark suggests the use of technology. As such, the marks are not confusingly similar.

[59] I disagree with the Applicant.

[60] The trademarks need not be identical to one another for there to be resemblance. Furthermore, when considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. It is not correct to lay them side-by-side and compare and observe similarities or differences among the elements or components of the trademarks.

[61] When the marks are assessed in their totality, as a matter of first impression and imperfect recollection, I consider the parties' marks to have significant similarities in appearance and sound, as well as some similarities in ideas suggested. Both parties' trademarks start with the sound "tech" and end with the sound "light". The visual differences between the parties' written components are minor. Moreover, as mentioned above, I do not consider the design elements of either trademark to be particularly unique or striking. As such, the written components remain the dominant part of each parties' marks. Finally, both suggest lights of a specialized nature.

[62] As such, this factor favours the Opponent.

*Additional surrounding circumstance - State of the register evidence*

[63] In its written argument, the Applicant submits that one key surrounding circumstance in this case is the existence of “hundreds” of active trademarks on the register that contain the prefixes “tech-” and “techno”, as well as the suffixes “-light” and “-lite”, some of which are in association with lighting products. As such, the Applicant contends that this is a case where the presence of a common element causes purchasers to pay more attention to the other features of the marks and to distinguish between them by those features.

[64] In her affidavit, Ms. Miconnet attaches the results of a number of keyword searches that she had conducted on the Canadian Trademarks Database maintained by the Canadian Intellectual Property Office:

- Exhibit CM-1: copy of the results of a search for active trademarks containing the term “TECHNO\*” in association with goods in class 11 of the Nice Classification, with a listing of 296 entries;
- Exhibit CM-2: copy of the results of a search for active trademarks containing the term “TECHNO\*” in association with goods in class 11 of the Nice Classification with the keyword “lighting” in the statement of goods or services, with a listing of 38 entries;
- Exhibit CM-3: copy of the results of a search for active trademarks containing the term “TECHNI\*” in association with goods in class 11 of the Nice Classification, with a listing of 39 entries;
- Exhibit CM-4: copy of the results of a search for active trademarks containing the term “TECH\*” in association with goods in class 11 of the Nice Classification, with a listing of 442 entries;
- Exhibit CM-5: copy of the results of a search for active trademarks containing the term “TECH\*” in association with goods in class 11 of the Nice Classification with the keyword “lighting” in the statement of goods or services, with a listing of 54 entries;
- Exhibit CM-6: copy of the results of a search for active trademarks containing the term “\*LIGHT” in association with goods in class 11 of the Nice Classification, with a listing of 318 entries;
- Exhibit CM-7: copy of the results of a search for active trademarks containing the term “\*LITE” in association with goods in class 11 of the Nice Classification, with a listing of 337 entries;

- Exhibit CM-21: copy of the particulars of registration No. TMA758,198 for the trademark TECHNILUM & Dessin registered in association with a variety of goods and services in the field of construction materials including urban lighting sets and light fixtures, as well as material processing in the field of manufacturing process including the manufacturing of roadway lighting and signaling; and
- Exhibit CM-22: copy of the particulars of registration No. TMA589,972 for the trademark TECHNALIGHT registered in association with light source optimizer used in the projection of motion picture film.

[65] Similarly, the Opponent introduced state of the register evidence via Ms. Shannon's affidavit, presumably to show that there is no common adoption of the elements in the parties' marks in the trade :

- Exhibit B: copy of the results of a search for trademarks containing the term "tecno lite", with two results belonging to the Opponent;
- Exhibit C: copy of the results of a search for trademarks containing the term "technolite", with one active registration for LA SENZA TECHNOLITE in class 25 of the Nice Classification;
- Exhibit D: copy of the results of a search for trademarks containing the terms "TECH" and "LITE" in association with goods in classes 9 and 11 of the Nice Classification, with two active registrations in class 9 of the Nice Classification; and
- Exhibit E: copy of the results of a search for active trademarks containing the terms "TECH\*" and "LIGHT\*" with no other restrictions; the Mark appears as part of the results.

[66] State of the register evidence is often introduced to show the commonality (or the lack thereof) of a trademark or portion of a trademark in relation to the register as a whole. However, the evidence is only relevant insofar as inferences may be made with respect to the state of the marketplace. The inferences being that at a particular relevant date, the common element in question is in fairly extensive use in the market in which the trademarks under consideration are being used or will be used such that consumers will distinguish the trademarks by paying more

attention to other features [see *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[67] Such inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Kellogg Salada Canada*; and *Welch Foods*].

[68] In the present case, I am unable to draw any meaningful inferences from the state of the register evidence filed by both parties about the marketplace with respect to the use of terms that are in both parties' trademarks. With the exception of registration Nos. TMA758,198 for TECHNILUM & Dessin and TMA589,972 for TECHNOLIGHT attached as CM-21 and CM-22 respectively, neither party attached the particulars of the registrations that they intended to rely on in support of their respective position. Without information on the goods and services registered in association with any of those registrations, I am unable to determine whether the trademarks would be used in the same trade or marketplace as those of the parties. In this regard, while the Registrar will exercise its discretion to confirm the existence of third-party applications and registrations identified in a statement of opposition, it will not do so in other instances [see *John Labatt Limited/John Labatt Limitée v WCE Western Canada Water Enterprises Inc* (1991), 39 CPR (3d) 442 and *Quaker Oats of Canada*].

[69] I also note that there is no information on actual use, the length of time or the extent to which any of the third-party registrations have been in use in Canada. Finally, I question the relevance of much of the search results presented by the parties. In *Ecletic Edge Inc v Gildan Apparel (Canada) LP*, 2015 FC 1332, the Court cautioned that "it is not the quantity or sheer numbers that count but rather the quality of evidence showing actual use of the common [element] in the relevant industry in Canada" [para 91]. The vast majority of the trademarks listed in the search results presented in Ms. Miconnet's affidavit has very little resemblance to the parties' trademarks. Moreover, classes 9 and 11 of the Nice Classification encompass a vast variety of goods that are not related to the parties' goods.

[70] In view of the foregoing, the state of the register evidence provided by Ms. Miconnet and Ms. Shannon is of no assistance to either party in terms of the likelihood of confusion between the Opponent's trademark and the Mark.

*Additional surrounding circumstance – Decision from the Benelux office*

[71] Attached as Exhibits CM-16 to CM-20 to Ms. Miconnet's affidavit are copies of a decision issued by the Benelux Office of Intellectual Property dated June 29, 2010 in the Dutch language, accompanied by a French translation obtained via Google Translate. In its written argument, the Applicant explains that, in this decision, the Benelux Office found that there is no likelihood of confusion between the trademarks TECHNILIGHT & Design and TECNOLIGHT Design, both in connection with lighting products, given the narrow scope of protection for TECNOLIGHT in view of the descriptive nature of the written components.

[72] First, I note that foreign decisions are not binding upon the Registrar. Nevertheless, they may be considered for their persuasive value where appropriate [see *Neutrogena Corp v Guaber SRL* (1993), 49 CPR (3d) 282 (TMOB); *Origins Natural Resources v Warnaco US* (2000), 9 CPR (4th) 540 (TMOB) at 548]. Even so, foreign law is considered to be facts that must be proven [*Waterford Wedgwood PLC v Forma-Kutzscher GmbH*, 2006 CanLII 80364 (TMOB)]. In the present case, there is no evidence of the law of trademarks applied by the Benelux Office. In the absence of such evidence, it is difficult to give any weight to this decision. In any event, I note that there appears to be considerable discussion surrounding the figurative element of the applicant's trademark in that case as it appears to be the dominant portion, which has no relevance to the marks in question in this case. Under these circumstances, I do not find this foreign decision to be persuasive in the context of the present proceeding.

*Conclusion on the likelihood of confusion*

[73] In *Masterpiece*, the Supreme Court of Canada indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the parties' trademarks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC), at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)]. Specifically, the Court noted that the degree of resemblance is the statutory factor that is often likely to have the greatest effect on the confusion analysis; the other factors become significant only once the trademarks are found to be identical or very similar [at para 49].



[74] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, despite the Applicant's evidence of use and promotion of the Mark, in view of the clear overlap and the close connection between the parties' goods, the potential for overlap in their channels of trade, as well as the strong similarities of the parties' marks in appearance and sound, and potentially in ideas suggested, I am not satisfied that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trademark TECNO LITE & Design.

[75] In the end, I am of the view that the average Canadian consumer, when faced with lighting products sold in association with the trademark TECHNILIGHT et dessin, would likely think that they originate from the same source as the lighting products sold in association with trademark TECNO LITE & Design, or vice versa.

[76] Accordingly, the 12(1)(d) ground of opposition is successful.

#### DISPOSITION

[77] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

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Pik-Ki Fung  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE:** No hearing was held.

**AGENTS OF RECORD**

Nexus Law Group LLP

FOR THE OPPONENT

Brouillette Legal Inc.

FOR THE APPLICANT

## Schedule "A"

### Trademark

# Tecno Lite

Registration No. TMA935,102

### Statement of Goods

(1) Apparatus for lighting namely, light bulbs, lighting fixtures, ceiling lights, table and floor lamps, lamp reflectors, lighting diffusers, luminous tubes for lighting, projector lamps, sockets for electric lights, light switches.

(2) Light bulbs, lighting fixtures, ceiling lights.

### Claims

Used in MEXICO on goods (1).

Registered in or for MEXICO on February 24, 2011, under No. 1203566 on goods (1).

Declaration of Use filed March 29, 2016 on goods (2).