



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 157

Date of Decision: 2021-01-30

IN THE MATTER OF AN OPPOSITION

Caterpillar Inc.

Opponent

And

PUMA SE

Applicant

1,556,304 for procat

Application

INTRODUCTION

[1] PUMA SE (the Applicant) is a premium sport-lifestyle company whose leaping cat design logo has been one of the world's top three brands in the sporting product industry. The Applicant has applied for the mark procat (the Mark) in association with various sport and leisure bags as well as various types of athletic, sports and casual clothing.

[2] Caterpillar Inc (the Opponent) has been involved in the manufacture, sale and distribution of a wide variety of vehicles, transporting devices, equipment and parts, in association with its CAT trademarks, for many decades. The Opponent's philosophy in regards to its brand has been to create a strong brand which can be licensed beyond the core products and services that the Opponent offers. As an important part of the Opponent's brand awareness and its business, the

Opponent has licensed trademark merchandise bearing the CAT trademarks including footwear, headgear, clothing and other goods. The Opponent opposes this application primarily on the basis that the applied for procat Mark is confusing with the Opponent's trademarks and trade name.

[3] As the Applicant has proven on a balance of probabilities that there is no reasonable likelihood of confusion with any of the Opponent's CAT trademarks or trade name, the opposition is rejected for the reasons that follow.

THE RECORD

[4] Filed on December 14, 2011, the application is based on proposed use in Canada in association with the following goods:

Bags, namely sport and leisure bags, clutch bags, purses, pocket wallets, briefcases, suitcases, key cases, travel bags, golf bags, luggage grip bags, toilet bags, trunks and travelling cases; clothing, namely athletic, sports and casual wear, rainwear, all-weather suits, namely, rain suits, snow suits, wind suits, socks, stockings, belts, underwear, scarves, gloves, bathing costumes, swimming trunks, bikinis.

[5] The application was advertised in the *Trademarks Journal* on December 18, 2013. The Opponent filed its statement of opposition on February 10, 2014.

[6] The Opponent alleges that (i) the Mark is not registrable under section 12(1)(d) of the *Trademarks Act*, RSC 1985, c T-13 (the Act); (ii) the Applicant is not the person entitled to the registration of the Mark under two different subsections of section 16 of the Act; and (iii) the Mark is not distinctive under section 2 of the Act. All of the grounds are related to the Opponent's allegation that the Mark is confusing with the use and registration of its CAT and CAT & Design trademarks or CAT trade name used in association with a variety of goods and services set out in the attached schedule A, including leather and imitation leather goods, clothing and footwear ("the Opponent's Goods").

[7] 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).

[8] The Applicant filed and served a counter statement on June 3, 2014, denying all grounds of opposition.

[9] In support of its opposition, the Opponent filed that affidavit of Kenneth J. Beaupre. Mr. Beaupre was cross-examined. His cross-examination transcript, as well as responses to questions taken under advisement and undertakings and related documents form part of the record.

[10] The Applicant filed the affidavit of Shannon Young and the affidavit of Neil Narriman. Both Ms. Young and Mr. Narriman were cross-examined. Their cross-examination transcripts, responses to questions taken under advisement and undertakings and related documents all form part of the record.

[11] Leave was granted to the Opponent on August 24, 2017, to amend its section 12(1)(d) ground to include its CAT word trademark, (registration No. TMA934,244) which had issued to registration on April 8, 2016.

[12] Both parties filed written submissions. A hearing was also held at which both parties participated.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[13] 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].

PREVIOUS DECISION BETWEEN THE PARTIES

[14] The parties are not strangers to one another as the Applicant and the Opponent have previously been involved in an opposition proceeding against one another.

[15] The earlier opposition between the parties involved the Applicant's application No. 1558723 to register the trademark procat in association with footwear and headgear [*Caterpillar Inc v Puma SE*, 2017 TMOB 114 ("the first proact decision")]. In that proceeding, no reasonable probability of confusion was found between the Applicant's trademark procat and various of the Opponent's CAT trademarks (including CAT & Triangle Design (TMA382,234) and application No. 1,588,026 for the trademark CAT), both of which cover a variety of goods, including footwear and headgear. This decision is presently under appeal.

[16] While recognizing that the facts in the present proceeding are different, and that each case must be decided on its own merits [*Sunny Crunch Foods Ltd v Robin Hood Multifoods Inc* (1982) 70 CPR (2d) 244 (TMOB) at 249], I will refer to the previous decision where it is appropriate to do so.

PREVIOUS DECISIONS INVOLVING THE OPPONENT

[17] The Opponent also referenced the following decisions in its oral argument: *Caterpillar Inc v Supacat*, 2011 TMOB 161, *Caterpillar Inc v Ertmer*, 2012 TMOB 126, and *Caterpillar Inc v Western Belting Ltd*, 2014 TMOB 176. Each of these proceedings involved oppositions by the opponent to various applied for marks including SUPACAT, ERKAT and BLACK CAT CONVEYOR COMPONENTS.

[18] The decisions cited by the Opponent are of interest to the extent that they concern opposition proceedings involving various CAT or CAT & Design marks of the Opponent and address the principles that govern the test for confusion between trademarks. However, as noted above, it is trite law that each case must be decided on its own merits. Further, there are other factors which distinguish the present proceeding from these decisions.

[19] In *Caterpillar Inc v Supacat*, 2011 TMOB 161, the mark SUPACAT was applied for in association with various types of vehicles. A reasonable likelihood of confusion was found in

that case in view of the lack of evidence of any use of the applicant's mark contrasted with the substantial evidence of use by the Opponent in association with similar types of goods. It was also found that the average consumer would focus on the CAT element of the mark SUPACAT because the prefix "supa" was considered to be non-distinctive and suggestive of a superior product.

[20] In *Caterpillar Inc v Ertmer*, 2012 TMOB 126, the mark ERKAT was applied for in association with milling machines for milling rock and ground layers as well as engineering services, technical consultancy and construction drafting for construction machines. A reasonable likelihood of confusion was found in that case in view of the lack of evidence of any use of the applicant's mark contrasted with the notoriety of the Opponent's mark in the construction industry as well as the nexus between the parties' goods and services.

[21] In *Caterpillar Inc v Western Belting Ltd*, 2014 TMOB 176, the mark BLACK CAT CONVEYOR COMPONENTS was applied for in association with goods described as "idlers and pulleys used with conveyor belting to convey products" and services described as "distribution and sales of conveyor components". A reasonable likelihood of confusion was found in part because in that case the applicant had not established any reputation in association with its mark and proposed to use it in association with goods and services which either directly overlapped with or were closely related to those of the opponent.

[22] In view of the above, I do not consider these cases of much assistance to the Opponent in the present case.

OPPONENT'S BUSINESS/CORPORATE STRUCTURE

[23] In order to better understand the evidence furnished in these proceedings, it is helpful to understand those parts of the corporate structure of the Opponent relevant to this proceeding. I acknowledge that Mr. Beaupre (Marketing Manager, Customer Services Support for the Retail Business Development of the Opponent) did not provide information regarding the Opponent's entire corporate structure when asked about it on cross-examination [Beaupre, Q.61,124,155-157]. However, as I do not consider details regarding the Opponent's entire corporate structure

necessary for my decision, I will not draw a negative inference from Mr. Beaupre's refusal to provide these details.

[24] The Opponent is a corporation incorporated and subsisting under the laws of the State of Delaware [Beaupre, para. 5]. In addition to being engaged in the manufacture, sale and distribution of a wide variety of vehicles, transporting devices, equipment and parts, an important part of the Opponent's business is the licensing of trademark merchandise, or "soft goods", which is described by Mr. Beaupre as clothing and apparel, bags and luggage, footwear, caps and hats, toys and models, stationery and accessories (such as key chains), bearing the Opponent's CATERPILLAR and CAT trademarks [Beaupre, para. 6].

[25] The Opponent has a number of licensees, known as trademark merchandise licensees, that are licensed to produce and market merchandise bearing the Opponent's trademarks in Canada, including the CAT trademarks [Beaupre, para. 14]. These trademark merchandise licensees are licensed by the Opponent for promotional sales, retail sales or both. Promotional sales mean sales to the Opponent, subsidiaries of the Opponent and/or the Opponent's dealers who then sell to the public through dealer locations or their websites. Retail sales mean sales to the general public either in retail stores or through websites and exclude promotional sales [Beaupre, para. 23].

[26] In Canada the majority of the promotional sales made by the Opponent's trademark merchandise licensees are made to the Opponent's Canadian dealers [Beaupre, para. 26]. The Opponent's Canadian dealers include: Finning International Inc., Toromont Industries Ltd., Hewitt Equipment Limited and Atlantic Tractors & Equipment Ltd. [Beaupre, para. 27]. Each of the Opponent's Canadian dealers are licensed by the Opponent to use the Opponent's trademarks, including its CAT trademarks. The Opponent's Canadian dealers can purchase licensed merchandise directly from the Opponent's trademark merchandise licensees and sell the Opponent's soft goods either at their respective dealer locations across Canada or on their websites [Beaupre, para. 27-32].

OPPONENT'S EVIDENCE OF USE OF ITS MARKS

[27] Mr. Beaupre states that the Opponent, itself and/or through its authorized licensees, has continuously used the CAT & Design mark (registration No. TMA382,234), shown below, and the applied for CAT mark (application No. 1,588,026, now registration No. TMA934,244) in Canada since 1991 [Beaupre, para. 13].



The goods and services of these marks are set out in the attached Schedule A. Both of these marks are based on use in Canada since at least as early as January 31, 1991, in association with, *inter alia*, the following goods:

leather and imitation leather goods namely, wallets, credit card cases, business card cases, key holders, coin holders, briefcases, garment bags for travel, duffle bags, flight bags and tote bags, umbrellas, traveling bags, purses; glassware, cups and coasters; work, sport and casual clothing namely, caps, belts, ties, scarves, headwear namely, stocking caps, ear muffs and head bands; t-shirts, shorts, sweat pants, sweat shirts, wrist bands, jackets, vests, gloves, mittens, rain wear, one-piece jump suits and socks, footwear namely, work boots and athletic shoes (the Caterpillar Goods)

[28] The Opponent refers to these two marks collectively as “the CAT registered marks”. These marks are part of an alleged family of fifteen other CAT trademarks owned and used by the Opponent and its authorized licensees in association with various goods and services. Mr. Beaupre refers to the two CAT registered marks, as well as the fifteen other CAT marks (listed in paragraph 11 of his affidavit) collectively as “the CAT trademarks”.

[29] The Opponent has three trademark merchandise licensees who sell promotional merchandise in association with one or more of the CAT trademarks in Canada. Sales of the Opponent’s licensed headgear for each of these companies ranged between \$20,000 U.S. in 2005 to \$470,00 in 2012 [Beaupre, paras. 34-36].

[30] The Opponent has five trademark merchandise licensees who sell retail merchandise in association with one or more of the CAT trademarks in Canada. The approximate sales of

licensed headgear by one of these licensees for retail sales ranged between \$95,000 and \$330,000 between 2008 and 2012, while sales of footwear ranged between \$8.3 and \$11.88 million U.S. between 2005 and 2012 [Beaupre, para 38-39]. In 2013, the Opponent's licensed headgear was sold to over 430 retail stores in Canada and the Opponent's licensed clothing to over 170 retail stores in Canada including Mark's Work Wearhouse, Sears, Work N Play and the North West Company [Beaupre, para 37]. Also in 2013, the Opponent's licensed footwear was sold to over 800 retail stores in Canada.

[31] The Opponent's licensed merchandise including men's, women's and children's clothing, hats, footwear, bags, gloves, belts, golf gear, toys and games and stationary, is also sold on the website at *www.shopcaterpillar.com* [Beaupre, para. 40-41]. Mr. Beaupre states that the approximate sales for "soft goods" in Canada ranged between \$14,000 in 2010 to \$47,000 in 2012 [Beaupre, para. 42].

HAS THE OPPONENT COMPLIED WITH SECTION 50 OF THE ACT?

[32] The only way that third party use of a trademark is deemed to be that of the registered trademark owner is when section 50 of the Act is satisfied. Sections 50(1) and (2) are reproduced below:

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trademark to use the trademark in a country and the owner has, under the license, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trademark in that country as or in a trademark, trade name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trademark in that country by the owner.

(2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trademark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trademark and the character or quality of the wares or services is under the control of the owner.

[33] There are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control;

or third, by providing a copy of a license agreement that provides for the requisite control [*Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102 at para 84].

[34] The Applicant submits that the evidence does not prove that the Opponent had the requisite control over the character and quality of the goods and refutes the claim that there was a proper license arrangement in place. In making this argument, the Applicant relies on the evidence of both Mr. Beaupre and Mr. McCullough.

[35] Mr. McCullough, managing director of a private investigation firm, visited the websites of *www.shopcaterpillar.com*, *www.catmerchandise.com*, *www.boutiquecat.ca*, *www.heavydutygear.ca* and *www.catfootwear.com*. Three of these five websites belong to three of the Opponent's four Canadian dealers including Finning International Inc. (*www.heavydutygear.ca*), Toromont Industries Ltd. (*www.catmerchandise.com*), and Hewitt Equipment Limited (*www.boutiquecat.ca*). Mr. McCullough details various purchases he made of CAT branded products from the websites in September of 2014. In particular, he describes the purchases of bags, clothing, luggage accessories, gloves, footwear and headgear from one or more of these websites. Attached to his affidavit as exhibits are screenshots taken of the homepages of the websites, copies of the packing sheets for the items he purchased, copies of photographs of the items he purchased, including the hang tags and/or labels (where applicable) on these products.

[36] The Applicant notes that the *www.catmerchandise.com* website includes the following legal statement: "Toromont owns and operates the *catmerchandise.com* website. Toromont, Toromont Cat and related words, domain names and logos are trademarks and the property of Toromont, used by Toromont Cat under the license from Toromont Industries Ltd." [Beaupre, para. 30, Exh. H]. The Applicant submits that by allowing public notice to be given of ownership of the CAT marks by another entity, the Opponent effectively destroyed any distinctiveness of the CAT marks when used in association with bags and clothing.

[37] The Applicant also notes that the pages printed from the *heavydutygear.ca*, *boutiquecat.ca* and *atlcat.ca* websites include copyright notices which reference the dealer names on each of the web pages (Finning, Hewitt Equipment and Atlantic Tractors and

Equipment Ltd.) and not the Opponent [Beaupre, paras 29, 31; Exh. G, I, J; McCullough, Exh. K].

[38] Relying on the decision in *Empressa v Shapiro Cohen, supra*, the Opponent's agent submits that since its trademark licensee agreement shows how the Opponent has the requisite control over the character or quality of the goods sold in association with the mark, that should be sufficient to satisfy section 50(1). In this regard, the Opponent's agent notes that Mr. Beaupre clearly attests to the fact that the Opponent exercises control over the quality and character of the trademark merchandise sold in association with the Opponent's CAT trademarks that the trademark merchandise licensees produce [Beaupre, para. 15]. He also produces a representative copy of the Opponent's merchandise license agreement [Beaupre, Exh. C] in which the terms show that the Opponent exercises control over the character and quality of the merchandise of its trademark licensees as follows:

- the Opponent establishes trademark usage and brand identity guidelines with respect to the character and quality of the merchandise sold in association with the Opponent's CAT marks;
- all licensed merchandise is to be identified by the Opponent's circular licensed merchandise logo;
- under the agreement, the Opponent requires trademark merchandise licensees to submit concept samples, pre-production samples and production samples of the licensed merchandise that the trademark merchandise licensees propose to produce; and
- the Opponent has the right to enter the premises where the products are manufactured to inspect licensed merchandise to ensure the standard and quality of such products.

[39] In the first procat decision, I was not prepared to infer that the Opponent had the requisite control over the character or quality of the goods at issue in view of the evidence furnished in that proceeding. In this case, however, there is additional evidence that must be considered.

[40] I will begin by saying that I agree with the Applicant that the evidence from the *www.catmerchandise.com* website appears to indicate that Toromont holds itself out as the owner of the trademarks on the *www.catmerchandise.com* website [Beaupre, Exh. H].

[41] I also acknowledge that the copyright notices of three of the dealer websites (Finning, Hewing Equipment and Atlantic Tractor and Equipment Ltd.) do not reference the Opponent [McCullough, Exh. K & O; Beaupre, Exh. G, I, J]. However, due to the small size and location of these copyright notices on the very bottom of the webpages, I do not consider them by themselves to amount to any clear indication of the owner of the mark or the source of the goods [*Wonderful Citrus LLC v Sunkist Growers, Inc.*, 2016 TMOB 108]. In fact, on two of the websites there are notifications which reference the Opponent. For example, on the Finning *heavydutygear.ca* website, there is a reference at the bottom of many of the pages which includes the Opponent's circular licensed merchandise logo and also indicates that CAT and CATERPILLAR are the trademarks of Caterpillar and may not be used without permission. Also, on the Hewitt website, under the heading "About Hewitt Equipment Ltd.," it states the following: "The Company is the authorized Caterpillar Dealer for the province of Quebec and Western Labrador, and since 1995, through its subsidiary Atlantic Tractors & Equipment Ltd., is also the Cat Dealer for the Maritime provinces." Finally, I note that the appearance of the dealer name or trademark beside the Opponent's mark on the websites (*e.g.* FINNING CAT, HEWITT CAT or ATLANTIC CAT) is permitted as it is well established that two trademarks can be used together on a single product [*AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (Fed TD), at 272].

[42] As noted above, section 50(1) of the Act requires the owner to control either directly or indirectly the character or quality of the goods sold under that trademark in order to benefit from the use of its trademark by a licensee. While Toromont may hold itself out as the owner of the bags and clothing sold in association with the CAT marks through the *www.catmerchandise.com* website, I am not sure this means that section 50(1) of the Act cannot operate to have the use enure to the Opponent [see *Alltemp Products Company Limited v Bit Holder Inc* 2007 CanLII 80869 (TMOB)]. Regardless, I am satisfied that the remaining evidence of the Opponent is sufficient to show that the use enures to the benefit of the Opponent for the purposes of section 50(1) of the Act. In this regard, in addition to providing a copy of the license agreement

which does establish how the Opponent exercises its control over the character and quality of the clothing goods manufactured by the licensees and sold in association with the Opponent's CAT marks, the Opponent has provided photos of the goods sold in association with its CAT marks by its dealers as well as hang tags and labels which show the Opponent's circular licensed merchandise logo which shows the Opponent's CAT & Design mark in the middle, and around the circle read the words "Licensed Merchandise Caterpillar Inc." [McCullough, Exhibits J, N & R]. The Opponent has also attached excerpts from the Opponent's 2014 style guides which pertain to quality standards for various CAT branded soft goods including for apparel, headgear, bags and hard goods, including such goods that are sold in Canada [Beaupre UT1, Tab I]. In my view, the Opponent's evidence is sufficient to show that the Opponent had the requisite control over the character and quality of the goods sold by most of the licensees in association with the Opponent's CAT marks.

[43] In view of the foregoing, I am satisfied that the majority of the evidence of use by the Opponent's licensees did enure to the benefit of the Opponent.

GROUND OF OPPOSITION

Non-Registrability – Section 12(1)(d)

[44] The Opponent has pleaded that the Mark is not registrable because it is confusing with the CAT registered trademarks. The goods and services for these registrations are set out in the attached Schedule A.

[45] The material date to assess the section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[46] The Opponent filed particulars of its registration No. TMA382,234 as Exhibit A-1 and particulars of its application No. 1,588,026, (now registration No. TMA934,244) as Exhibit A-2 to the Beaupre affidavit. I have exercised my discretion and checked the register to confirm that both of the Opponent's registrations are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[47] As the Opponent’s evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between its trademark and the Opponent’s CAT registered trademarks.

[48] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods or services are of the same general class or appear in the same Nice Class [see also *Obsidian Group Inc v Attorney General of Canada*, 2020 FC 586].

[49] 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 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), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[50] The Opponent’s CAT registered marks consist of the word CAT alone and the word CAT and a triangle design component (shown above).

[51] In previous decisions concerning the Opponent’s CAT and CAT & Design trademarks, these marks were considered to possess a high degree of inherent distinctiveness because they were considered to have no significance in relation to the Opponent’s goods and services. In this case, however, there is evidence that CAT is the short form for the Opponent’s corporate name, Caterpillar, Inc. [Beaupre, Exh. B and F-6]. The printout from the Opponent’s website page in Exhibit B states the following:

“The Cat brand is the cornerstone of the Caterpillar brand portfolio, representing products and services made by Caterpillar. While Caterpillar was founded in 1925, “Cat” was not

used as a trademark until 1949 when it began appearing on machine trade dress. Over time, the level of familiarity with the Cat brand made it possible to rely on it as a primary public-facing brand name.”

I therefore think that consumers would recognize CAT as being the short form for the Opponent’s corporate name as a matter of first impression in the marketplace.

[52] The Opponent submits that the Mark is less inherently distinctive than its marks because the prefix PRO is suggestive and laudatory in relation to the applied for goods. In this regard, the Opponent submits that the prefix “pro” is a short form of the word professional and therefore suggests that the Applicant’s goods are of a professional quality.

[53] In *The Canadian Oxford Dictionary* (2 ed.), the word PRO is indeed defined as an abbreviation for the word “professional” [see *Tradall SA v Devil’s Martini Inc*, 2011 TMOB 65 (CanLII) at para 29 which provides that the Registrar can take judicial notice of dictionary definitions]. However, the Mark as a whole is the coined word “procat”. I agree with the Applicant that the Mark as a whole is inherently distinctive because it is comprised of components which typically do not appear together. Further, I do not find that the Mark has any significance in relation to the Applicant’s goods.

[54] The extent to which a trademark has become known is referred to as its acquired distinctiveness. A trademark can acquire distinctiveness by becoming known in Canada through promotion or use.

[55] While the Applicant filed considerable evidence regarding its products sold under its world renown PUMA word and Jumping Cat Design trademarks, for the years 2000 – 2016, its evidence regarding use of the applied for procat Mark is not nearly as extensive. In this regard, the evidence of Mr. Narriman regarding the use of Mark in Canada that is most pertinent to this opposition may be summarized as follows:

- starting in December 2012 until approximately 2015, goods, including but not limited to footwear bearing the Mark, were sold by the Applicant in Canada with total net revenue of at least \$300,000 U.S. [Narriman, para. 14; Cross-ex, Q.76];

- sales of procat branded products in Canada were through the retailer Target Canada Co.; and
- Target Canada Co. also offered sales and shipments of goods bearing the procat Mark to customers in Canada through its website.

[56] Mr. Narriman also confirmed on cross-examination that one will always find the Applicant's Jumping Cat Design on each and every product of the Applicant, and that the Leaping Cat Design is always depicted right next to the PUMA trademark [Narriman, Q.42-44].

[57] With respect to the Opponent's registered CAT marks, the Applicant submits that the Opponent has not been able to show continuous use of the registered CAT trademarks in association with all of the Opponent's Goods since at least as early as January 31, 1991 [Beaupre, Q.175-188].

[58] I agree with the Applicant that the evidence of Mr. Beaupre is not as clear as it could be. In this regard, it would have been preferable had the Opponent provided a breakdown of the total sales in Canada of each of the Opponent's Goods sold in association with either each of its CAT marks or at least one of its registered CAT marks on an annual basis since their claimed date of first use. Having said that, I am still satisfied from the evidence furnished that the Opponent's CAT registered trademarks have become known to a considerable extent in association with footwear and to a lesser extent in association with headgear. The evidence also shows that the CAT registered trademarks have become known to some extent in association with the Opponent's soft goods.

[59] In view of the above, I find that the Opponent's CAT registered trademarks have become known to a greater extent than the Mark in association with headgear and footwear but to a lesser extent in association with the Opponent's soft goods.

Section 6(5)(b) – the length of time each has been in use

[60] The Applicant has shown use of its Mark since December 2012, while the Opponent has shown use of its CAT registered marks since at least as early as 2005. This factor therefore also favours the Opponent.

Section 6(5)(c) & (d) – nature of the goods, business and channels of trade

[61] As noted previously, the goods at issue in the present case are slightly different from the goods that were at issue in the previous procat decision. In this regard, the applied for goods in the first procat decision comprised: (1) Footwear, namely athletic, sports and casual shoes and boots; headgear, namely hats and caps, whereas the applied for goods in the present case, reproduced below for ease of reference, are as follows:

Bags, namely sport and leisure bags, clutch bags, purses, pocket wallets, briefcases, suitcases, key cases, travel bags, golf bags, luggage grip bags, toilet bags, trunks and travelling cases; clothing, namely athletic, sports and casual wear, rainwear, all-weather suits, namely, rain suits, snow suits, wind suits, socks, stockings, belts, underwear, scarves, gloves, bathing costumes, swimming trunks, bikinis.

[62] The Opponent's CAT registered trademarks have been used and registered in Canada in association with, *inter alia*, bags, including bags for travel, and sport and casual clothing and apparel. I agree with the Opponent that there is an overlap between these goods and the applied for goods of the Applicant.

[63] The nature of the parties' businesses, however, are different. In this regard, the Opponent is primarily engaged in the manufacture, sale and distribution of a wide variety of vehicles, transporting devices, equipment and parts. As noted above, the Opponent's CAT mark began appearing in 1949 on machine trade dress. While the Opponent is also involved in the licensing of trademark merchandise or soft goods such as clothing and apparel, bags and luggage, etc. bearing the CAT marks, it appears from the evidence that while some of these goods are sold to the general public, many of these sales are promotional in nature [Beaupre, cross-ex. Q.51].

[64] The Applicant, on the other hand, is a premium sport-lifestyle company and was one of the world's top three brands in the sporting product industry in 1993 [Narriman, para. 4]. In addition to sportswear and sport footwear, the Applicant produces casual wear and lifestyle clothing and footwear products and distributes its products in more than 120 countries including Canada, with worldwide sales in the billions of pounds [Narriman, para. 4 & 5].

[65] With respect to the parties' channels of trade, the majority of the promotional sales made by the Opponent's trademark merchandise licensees in Canada are made to the Opponent's

Canadian dealers, either online or through their dealer locations. While the Applicant's customers for its PUMA products include sporting good retailers and department stores, the Applicant's procat products have to date only been sold through Target Canada. However, in view that the Applicant's applied for goods are not limited to any particular channel of trade, and the fact that the Opponent's goods have also been sold in retail stores, I find that, although unlikely, the parties channels of trade could overlap.

Degree of resemblance between the marks

[66] In considering the Mark and the Opponent's CAT trademarks, I do not find a high degree of resemblance in appearance or sound. There is of course some resemblance between the parties' marks as a result of their common use of the word CAT. However, in *Masterpiece*, *supra*, the Supreme Court of Canada stated that it is more important to consider whether there is an aspect of the trademark that is particularly striking and unique.

[67] In the present case, I do not consider the fact that the Applicant has essentially incorporated the Opponent's mark as the second component into its Mark to be decisive, because the most striking feature of the Mark is that it consists of a unique coined word. One would not typically associate the component "pro" together with the component "cat".

[68] With respect to the ideas suggested by the parties' marks, I find that both of the Opponent's marks suggest a short form of the Opponent's corporate name CATERPILLAR and signal goods emanating from the Opponent due to its long and extensive use of the CAT trademarks. On the other hand, I do not find that the Applicant's Mark has any apparent meaning because it is a coined word.

Surrounding circumstance - The Opponent's family of CAT trademarks

[69] In both the Beaupre affidavit and the Opponent's statement of opposition, reference was made to the fact that the Opponent owns a family of other CAT trademarks, in addition to the CAT and CAT & Design trademark registrations No. TMA382,234 and TMA934,244. A list of the Opponent's other CAT trademark registrations is described in Mr. Beaupre's affidavit at paragraph 11, and is shown in the attached Schedule B.

[70] In order for the benefits of a family of trademarks to apply, an opponent must evidence use of the members of an alleged family of trademarks [see *Ultramar Ltd v Gold Eagle Co* 2011 TMOB 149 at para 26]. In this case, Mr. Beaupre states in his affidavit at paragraph 12 that attached as Exhibit B to his affidavit are printouts of select pages from Caterpillar’s websites for North America which demonstrate the use of the CAT trademarks in association with some of the goods and services found in the registrations set out in paragraph 11 of his affidavit. While Exhibit B shows various machines that make up the CAT equipment product line, there is no evidence of use of any of these marks in the normal course of trade pursuant to section 4(1) of the Act.

[71] As the Opponent has not evidenced the use of the members of its alleged family of trademarks, it cannot rely on any cumulative effect of its CAT trademarks. This factor therefore does not benefit the Opponent.

Surrounding circumstance – The Applicant’s family of trademarks

[72] The Applicant submits that it has shown use of a family of registered and unregistered trademarks containing or comprising the term CAT or a CAT Design (“the Applicant’s CAT trademarks”). Relying on the decision in *McDonald’s Corp v Yogi Yoghurt Ltd* (1982), 66 CPR (2d) 101 FCTD, the Applicant submits that if an owner can point to a family of marks, broader protection for the common component shared by the family may be expected.

[73] The Applicant’s alleged family of marks includes the PUMA word mark, the PUMA word and jumping cat design mark, the jumping cat design mark and various form strip design marks [Narriman, para. 4]. Mr. Narriman states that all of the Applicant’s products sold in Canada bear one or more of the Applicant’s CAT trademarks and that the Jumping Cat Design trademark appears in association with each and every product manufactured by the Applicant and sold in Canada.

[74] Mr. Narriman also presented evidence of product names incorporating the term CAT which appear in the Applicant’s catalogues distributed in Canada and on product packaging and hang tags. Mr. Narriman confirmed on cross-examination that there are different style names on different products, some of which are descriptive, e.g. Big Cat Beanie [Narriman, cross-ex.

Q.275-286, 303]. He also confirmed that the Applicant uses the following product names: SPORTS CAT, GRASS CAT, ADVOCAT, SPEED CAT and FUTURE CAT [Narriman cross-ex. Q.328].

[75] As the Applicant's evidence and argument on this surrounding circumstance is similar to that which was before me in the first procat decision, I reproduce below and apply what I said in that case to the present case:

[63] In the present case, the evidence shows that the Applicant has been using its family of Jumping Cat Design trademarks in Canada since as early as 1969 and Mr. Narriman has provided evidence of significant sales and advertising for these marks. Mr. Narriman also states that the Jumping Cat Design trademark appears in association with each and every product which is manufactured by the Applicant and sold in Canada in association with all of the members of its family of trademarks [Narriman affidavit, para. 12].

[64] I do not find that the Applicant's family of Jumping Cat Design marks is a significant factor that may decrease the likelihood of confusion in this case for two reasons. First, the common component in the Applicant's family of marks which the Applicant has shown use of is the design of a jumping cat. As the Mark is a word mark with no design features, I do not find that consumers familiar with the Jumping Cat Design marks of the Applicant would be likely to assume that the Mark is part of the Applicant's family of marks. Second, even if I did find that there was some resemblance between the Mark and the Applicant's other marks in sound and idea suggested, section 19 of the Act does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration [see *Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc* (1984), 4 CPR (3d) 108 (TMOB) at 115 and *Groupe Lavo Inc v Procter & Gamble Inc* (1990), 32 CPR (3d) 533 (TMOB)].

[76] I will also add here that I did not consider the use of the Applicant's product names as part of the Applicant's family of trademarks because I agree with the Opponent that the use of these product names does not amount to use of trademarks by the Applicant that identify the source of the goods.

Surrounding circumstance – state of the register evidence and state of the marketplace evidence

[77] As a further surrounding circumstance, the Applicant has relied on the state of the register evidence of Ms. Shannon Young, trademark agent at the firm representing the Applicant.

[78] State of the register and marketplace evidence favours an applicant when the presence of a common element in marks causes consumers to pay more attention to the other features of the marks, and to distinguish between them by those other features [*McDowell v Laverana GmbH & Co. KG*, 2017 FC 327 at para 42]. For an inference to be drawn that a word or element is common to the trade, there must be evidence of a sufficient number of relevant marks on the register [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[79] The Opponent objected to the relevance of many of the marks found by Ms. Young for various reasons. For example, the Opponent submits that many of the marks differ significantly from the Mark. The Opponent also submits that Ms. Young provides limited evidence of the existence on the register of trademarks containing the word element CAT with a prefix applied to bags and clothing.

[80] It has previously been held that relevant trademarks include those that (i) are registered or are allowed and based on use; (ii) are for similar goods and services as the marks at issue, and (iii) include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197]. In this case, in view that the only word element of both of the Opponent's CAT registered marks is the word CAT, and the Applicant's Mark is the word procat, I would find that third party marks containing the word element CAT in a material way applied to bags and/or clothing goods would be relevant.

[81] I agree with the Opponent that not all of the over 40 marks relied upon by the Applicant in its written argument are relevant as not all of them are registered or allowed, and not all of them include the component CAT in a material way. My review of Ms. Young's evidence, however, shows that there are at least 30 marks which do include the component CAT in a material way which are registered in association with the same types of goods as those of the parties. Given the number of relevant marks, I do not find that the lack of evidence of third party CAT marks to mean no inference about the ability of consumers to distinguish between CAT marks can be drawn.

[82] I therefore find from the evidence furnished that it is appropriate to reach the same conclusion on this issue as I did in the first procat decision at para. 71:

In view of the above, I do not think it can be said that the use of the word mark CAT is particularly distinctive of any one trader when used in association with clothing. The evidence suggests that consumers are somewhat accustomed to seeing CAT word marks in the clothing trades and are therefore used to distinguishing such marks based on their other components. This factor therefore favours the Applicant.

Conclusion re likelihood of confusion

[83] As indicated above, section 6(2) of the Act is not concerned with the confusion of the marks themselves, but confusion of goods from one source as being from another source. The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees procat on the Applicant's bags and clothing, at a time when he or she has no more than an imperfect recollection of the Opponent's marks used in association with similar goods, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20]. The question posed is whether this individual would be likely to conclude that the Applicant's goods are manufactured, sold, or otherwise authorized by the Opponent.

[84] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, and notwithstanding the acquired distinctiveness of the Opponent's registered CAT marks in association with footwear and to some extent headgear, and the overlapping nature of the goods, I find that the overall differences in the nature of the parties' businesses, the state of the register evidence, as well as the differences between the marks sufficient to shift the balance of probabilities regarding confusion in favour of the Applicant. I am of the view that the ordinary consumer would not, as a matter of first impression, be likely to think that the goods associated with the Mark would emanate from the same source as those associated with the Opponent's CAT or CAT & Design trademark or vice versa. Consequently, I find that there is no reasonable likelihood of confusion between the parties' trade marks.

Non-Entitlement - Section 16(3)(a)

[85] In its statement of opposition as amended, the Opponent pleads 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 since at the filing date of the application, the Mark was confusing with the Opponent's

trademark CAT & Design, which is the subject of registration No. TMA382,234, and with its trademark CAT, which is now the subject of registration No. TMA934,244, both of which were allegedly previously used in Canada by the Opponent.

[86] An opponent meets its evidential burden with respect to a section 16(3)(a) ground if it shows that its trademarks had been used in Canada prior to the filing date of the application for the applicant's trademark and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act].

[87] Mr. Beaupre has provided sales figures for the Opponent's licensed headgear, footwear and soft goods sold in association with its CAT marks prior to the filing date of the application. However, while Mr. Beaupre has also provided many examples of how the CAT registered marks appear on the Caterpillar Goods, there are only 3 exhibits (Exhibits F-8 – F-10) dated prior to the material date for this ground and these exhibits only show the display of the Opponent's mark in association with footwear. I therefore am only satisfied that the Opponent has met its burden under this ground with respect to footwear.

[88] In view that the parties' goods overlap to a lesser extent than under the section 12(1)(d) ground, I find that the Opponent's case is even weaker under this ground. The section 16(3)(a) ground is therefore not successful.

Non-entitlement – Section 16(3)(c)

[89] The Opponent has also pleaded that the Applicant is not the person entitled to registration of the Mark under section 16(3)(c) of the Act in that it is confusing with the Opponent's trade name CAT, which had been previously used in Canada by the Opponent.

[90] An opponent meets its evidential burden with respect to a section 16(3)(c) ground if it shows that its trade name was used prior to the filing date of the application for the applicant's trademark and had not been abandoned at the date of advertisement of the applicant's application [section 16(5) of the Act].

[91] As noted above, Mr. Beaupre states in his affidavit that the Opponent, itself or through its authorized licensees, has continuously used the CAT registered marks in association with the

Caterpillar Goods since at least as early as January 31, 1991. However, Mr. Beaupre's affidavit is silent with respect to when the Opponent commenced use of the trade name CAT in connection with its business. While Mr. Beaupre provided many examples of how the CAT registered marks appear on the Caterpillar Goods, there are only three exhibits (Exhibits F-8 – F-10) which are dated prior to the filing date of the application (*i.e.* December 14, 2011). The references to CAT in these exhibits generally appear to be references to the Opponent's footwear sold by its trademark merchandise licensee Wolverine Canada Inc. rather than references to the Opponent's business.

[92] I therefore conclude that the Opponent has not met its evidential burden. The section 16(3)(c) ground of opposition is therefore unsuccessful.

[93] I will add that even if the Opponent had met its burden under this ground, it would not have been successful for most of the same reasons the section 12(1)(d) ground did not succeed.

Distinctiveness – Section 2

[94] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[95] In order to meet its evidential burden, the Opponent is under an obligation to show that, as of the date of filing of the statement of opposition, one or more of its trademarks had become known sufficiently to negate the distinctiveness of the Mark. The reputation of the Opponent's trademarks should be substantial, significant or sufficient [*Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC)].

[96] In addition to providing some examples of how the CAT registered marks appeared on the Opponent's footwear at the filing date of the statement of opposition (*i.e.* February 10, 2014), Mr. Beaupre also provided sales figures for licensed headgear, licensed footwear and "soft goods" dated prior to the material date for this ground. Sales of the Opponent's licensed

footwear sold in association with its CAT mark have been significant since 2005 (e.g. ranging between \$8.3 million U.S. and \$11.88 million U.S. between 2005 and 2012). Retail and promotional sales of the Opponent's licensed headgear have also been notable, amounting to almost \$3 million U.S. over the same time period. The only sales figures provided for the Opponent's soft goods, however, were for the years 2010 to 2012, and those sales ranged between \$14,000 U.S. in 2010 to \$47,000 U.S. in 2012.

[97] While there is also some evidence regarding how the Opponent's goods are promoted in association with its trademarks through catalogues, point of sale displays, shelving and towers bearing the CAT registered trademark, and on the Opponent's and its dealers' websites, Mr. Beaupre has not provided any circulation data for its brochures nor any information pertaining to how many hits the websites had received from Canadians as of the material date. Further, no figures for annual advertising or promotional expenditures have been provided.

[98] In view of the above, I am only able to conclude that the Opponent's reputation in its CAT trademarks was substantial, significant or sufficient as of the material date with respect to headgear and footwear. I therefore find that the Opponent has only met its burden under this ground with respect to these goods.

[99] In view that the parties' goods overlap to a lesser extent than under the section 12(1)(d) ground, I find the Opponent's case even weaker under this ground. The section 2 ground of opposition is therefore not successful.

DISPOSITION

[100] 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.

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

OPPONENT’S “CAT REGISTERED TRADEMARKS”

TMA934244 – CAT

Goods

(1) Greases, lubricants and oils for land vehicles for use in the fields of agriculture, construction, earth moving, earth conditioning, forestry, general industry, marine, material handling, mining, paving and electric power generation; greases, lubricants and oils for engines; industrial greases and lubricants; hydraulic oils; greases, lubricants and oils for industrial machinery; non-chemical engine treatments and additives for engine oils, gasoline and diesel fuels, transmission fluids and coolants.

(2) Cements for bonding various types of materials; chemical compositions for industry namely, rust inhibitor for cooling systems (for use with engine coolant, fuel, hydraulic fluid, transmission fluid, air, HVAC working fluid and air-to-air aftercoolers), metal surfaces, and electrical connections; paints, namely coatings for use on machines and vehicles and on parts of vehicles; anti-seize and sealing lubricant for machinery and vehicles for use in the fields of agriculture, construction, earth moving, earth conditioning, forestry, general industry, marine, material handling, mining, oil and gas industry, paving and electric power generation; articles of non precious metal namely, key tags, key chains, money clips, and name plates; hardware, namely bolts, nuts, washers, springs, ground engaging tools such as rippers and tips; machinery for earth moving, earth conditioning and material handling namely, track-type tractors, wheel tractors, loaders, track-type loaders, wheel loaders, backhoe loaders, pipe layers, lift trucks, motor graders, standard wheel tractor-scrappers, elevating scrapers, tandem powered scrapers, push-pull scrapers landfill compactors, single drum and double drum vibratory compactors, pneumatic tired compactors, rippers and tool bars, cable controls and hydraulic controls for the foregoing goods and replacement parts, and attachments for the foregoing goods; engines, internal combustion engines, diesel engines and natural gas engines for use in the fields of agriculture, construction, forestry, general industry, marine, material handling, mining, oil and gas industry and electric power generation and replacement parts, and attachments for the foregoing goods, namely alternators, transmissions, generators, electric pumps, hydraulic pumps, pressure pumps and air pumps; electric power generation sets for supplying electrical power to home, industry and hospitals, namely diesel electric generator sets and natural gas electric generator sets; front shovels for excavators; forest product swing machines, feller bunchers; skidders; integrated tool carriers, namely wheel loaders with couplers for engaging attachments (namely augers, blades, brooms, buckets, clamps, cold planers, cutters, forks, loaders, material handling arms, plows, rakes, snow blowers, snow push, stump grinders, tillers, trenchers, drum compactors and saws) for use in earth moving, earth conditioning and material handling; pavement profilers; asphalt pavers; road reclaimer/soil stabilizer; pocket knives, manicure sets and nail clippers, screw driver sets and table spoons; load signal systems, brake accumulator buzzers; low air pressure alarms, turn signal flashers, meters and gauges namely speedometers, odometers, tire wear gauges, tire pressure gauges, hydraulic system filter indicators, air cleaner service indicators, fuel pressure gauges, torque converter temperature gauges, water temperature gauges, and service meters, namely meters for indicating total operation time of machinery or vehicle; computer software

and programs (namely (i) software application for assisting customers in selecting gas engines for machinery used in oil and gas industry and for providing technical information on such engines, (ii) software application for providing technical information on parts for, and the maintenance and repair of, vehicles, equipment and machinery used for agriculture, construction, earth moving, earth conditioning, forestry, general industry, marine, material handling, mining, paving and electric power generation, and (iii) software application for diagnosing the maintenance and repair needs of vehicles, equipment and machinery used for agriculture, construction, earth moving, earth conditioning, forestry, general industry, marine, material handling, mining, paving and electric power generation), calculators, compasses being direction determining instruments, barometers and tape measures; eyeglasses; vehicles for earth and material hauling and handling namely, trucks, articulated dump trucks and tractors, engines for vehicles, replacement parts, and attachments for all the foregoing, namely augers, backhoes, blades, brooms, brushcutters, buckets, cold planers, compactors, couplers, delimiters, felling heads, forks, grapples, hammers, harvester heads, material handling arms, mulchers, multi-processors, pulverizers, rakes, rippers, saws, scarifiers, scoops, slashers, snow push, shears, snow blowers, stump grinders, thumbs, tillers, trenchers, truss booms and winches; articles of precious metal namely, cuff links, tie tacks, tie bars, bracelets, pendants, belt buckles, earrings, charms, key chains, stick pins, lapel pins and necklaces, watches and clocks; watch fobs; company magazines, newsletters, and bulletins, books, instructional and teaching material namely, books, work books, pre-recorded videocassettes and videodiscs and scale models for teaching, all on the topics of equipment operation, maintenance and safety; note pads, binders, stationery-type portfolios, calendars, pencils, pens, decals, coloring and game books, playing cards, paper coasters, photo albums and check book holders; hydraulic hose and couplings therefore; rubber ring seals for vehicles and machinery; leather and imitation leather goods namely, wallets, credit card cases, business card cases, key holders, coin holders, briefcases, garment bags for travel, duffle bags, flight bags and tote bags, umbrellas, traveling bags, purses; glassware, cups and coasters; work, sport and casual clothing namely, caps, belts, ties, scarves, headwear namely, stocking caps, ear muffs and head bands; t-shirts, shorts, sweat pants, sweat shirts, wrist bands, jackets, vests, gloves, mittens, rain wear, one-piece jump suits and socks, footwear namely, work boots and athletic shoes; cloth, iron-on and sew-on patches; belt buckles made of non-precious metal; toy vehicles, board games, basketballs, baseballs, footballs, soccer balls and stress/squeeze balls, sports equipment namely, golf clubs; sports towels; matches, cigarette lighters and ash trays; hydraulic hose; filters namely air filters for engines and motors, filters for air conditioners, gas filters for engines and motors, oil filters for engines and motors; o-ring seals; tubing and clamps, namely hydraulic hoses and couplings therefor, hydraulic circuits and hydraulic adapters, oil hoses, couplings and joints for use with hoses, pipes and tubes, namely extensions for exhaust pipes and air intake pipes, and clamps, adapters and flanges for hoses.

(3) Computer game disks; video games; children's books; board games; battery-operated ride-on toys; toy model (die cast and micro die cast) vehicles; toy model (die cast and micro die cast) vehicles and related accessories sold as units; battery-operated toy vehicles; and puzzles.

(4) Bicycles

(5) Attachments (namely, asphalt cutters, augers, blades, block-handling tools, hydraulic brooms, buckets, cold planers, vibratory compactors, couplers, crushers, cutting jaws, de-limiters, forks,

pallet forks, grapples, hammers, hoppers, lift groups, lifting hooks, material handling arms, multi-processors, plows, pulverizers, pulverizing jaws, rakes, rippers, saws, scarifiers, scoops, shears, snow blowers, snow plows, snow wings, stump grinders, thumbs, tillers, trenchers, truss booms) for use with machinery for earth moving, earth conditioning and material handling.

(6) Machinery for earth moving, earth conditioning and material handling, and structural, repair and replacement parts for all of the foregoing; structural, repair and replacement parts for engines for all of the foregoing; ground engaging tools; attachments for use with the foregoing machinery, namely, material handling arms; electric, industrial, diesel, gas and natural gas generators and gensets, and structural, repair and replacement parts for all of the foregoing; oil, gas and air filters for motors and engines; vehicles for earth moving, earth conditioning and material handling; pallet movers; locomotives; agricultural tractors; combines; windrowers; balers; disc mowers and conditioners; sickle mowers and conditioners; bale accumulators and structural, repair and replacement parts for all of the foregoing; structural, repair and replacement parts for engines for the foregoing vehicles; transmissions for land vehicles and structural, repair and replacement parts therefor.

(7) Chemicals for use in photography, agriculture, horticulture, and forestry; unprocessed artificial resins, unprocessed plastics; manures; chemical substances for preserving foodstuffs; industrial adhesives used to bond wood, metal, glass, rubber, plastic, cork, leather and ceramic; cement for repairs, namely, adhesive cement for bonding, sealing and patching cork, leather, rubber, and metal; anti-freeze; coolants for vehicle engines; conditioners and cleaners for cooling systems (for use with engine coolant, fuel, hydraulic fluid, transmission fluid, air, HVAC working fluid and air- to-air aftercoolers); sealants, namely, moisture wicking sealant for fasteners, silicone-based sealant, adhesive sealant for industrial use, pipe sealant for use in sealing pipe joints and fittings; chemical preparations for locking screw threads; battery fluid; colour brightening chemicals for use on machines and vehicles; filtering materials, namely, chemical preparations for use in machines and engines; hydraulic fluids; fuel additives; compositions for repairing vehicle tires, namely, rubber cement for repairing pneumatic tires.

(8) Paints for use on machines and vehicles, varnishes for use on machines and vehicles, lacquers for use on machines and vehicles; preservatives against rust and against deterioration of wood; mordants used in the manufacturing of coatings; raw natural resins; metals in foil and powder form for painters, decorators, printers, and artists; primers and thinners; metal preservatives; coatings, namely, paints for use on vehicles and on parts of vehicles.

(9) Industrial oils and greases; all-purpose lubricants; dust absorbing, wetting, and binding compositions all for use on unpaved roads; candles and wicks for lighting; diesel oil; motor oil; anti-seizure compounds for machinery and vehicles for use in the fields of agriculture, construction, earth moving, earth conditioning, forestry, general industry, marine, material handling, mining, oil and gas industry, paving and electric power generation; waxing compositions, namely, paraffin wax; lubricant designed for use in ball and roller bearings and bushings.

(10) Common metals and their alloys; materials of metal for railway tracks; pipes and tubes of metal, namely, extensions for exhaust pipes and air intake pipes; safes; ores; fastening, securing,

and sealing devices namely metal threaded fasteners, metal sealing rings, metal seals, non-metal seals for use on pipe joints and flanges, sealing plugs made primarily of rubber; metal plugs for protecting machine parts against damage, dirt, moisture and corrosion during storage, shipping and repair, metal straps for handling loads, metal pipe clips, metal nuts, metal hardware bolts, metal hardware screws, metal sealing rings, metal ball lock pins, metal washers, metal seals, metal tie downs, metal pipe nipples, binding strips of metal used on packaging, metal bungs, metal caps for tubing ends, metal caps and buckles for storage containers, metal pipe collars, metal clamps, metal couplings for use with hoses, metal fastener nails, pegs, rivets, metal storage tanks, drain plugs, cotter pins, drawbar pins, clevis pins, locking pins, eye bolts, snap rings; thread inserts; rain traps and drain caps; pipe extensions; metal debris deflectors, namely radiator guards, hydraulic line guards, crankcase (belly) guards, chassis guards and final drive guards; grids, namely, steel reinforcing grids for use in paving processes; plates, namely, clad steel plates, product identification/serial number plates; hand tool vices; welding rods; cables, namely, battery cables and wires of common metals; metal chains for hoisting objects, metal slings for loading and metal pulleys for hoisting objects; badges, namely pin plates that can be fixed to engines, machinery, and parts therefor which contain the manufacturer's information; padlocks; non-luminous and non-mechanical signs; non-luminous and non-mechanical signal display panels; parts and fittings for all the aforesaid goods; parts for land vehicles, agricultural machinery, and earth moving machinery, namely: bolts, metal pipe clips, metal sealing, metal gaskets, metal rings, metal pipe collars, metal bolts, metal pipe connectors, metal caps for tubing ends, metal pipe fittings, metal cylinders for compressed gas or liquids sold empty, metal threaded fasteners, rivets, gaskets, metal hose clamps, and metal hose fittings.

(11) Engine motors not for land vehicles; machine coupling and transmission components not including machine coupling and transmission components for land vehicles; incubators for eggs; valves for industrial machinery; air filters, namely, air filters for machines or engines; water regulators; couplings, namely, couplings for machines and transmission components except for land vehicles, shaft couplings for machines, couplings for electrical wiring, trailer couplings for vehicles; assembly presses; starters for motors and engines; pumps, namely oil pumps, pressure pumps, lubricating pumps, machine pumps, air pumps, fuel injection pumps, gear pumps, centrifugal pumps, circulating pumps, concrete pumps, diaphragm pumps, axial pumps, heat pumps, electric pumps, engine driven water pumps, pneumatic pumps, pumps for cooling engine, vacuum pumps, pumps for extraction of liquids and gas and self-regulating pumps; diggers; feller bunchers; pavers; skidders; filters, namely, air filters for motors, gas filters for motors and engines, oil filters for motors and engines; belts for machinery; blades being attachments for machinery and vehicles for material handling and moving; road making machines; steam rollers; buckets for earth moving machines; hydraulic jacks; welding machines and welding apparatus, namely, welding torches, welding respirators, welding helmets, welding goggles, welding jackets, welding gloves, welding coats, welding blankets, hand-held gas welding apparatus, namely, heat welding guns; pavement profilers; scarifiers; motor graders, fuel/air ratio controls for engines; fuel nozzles; water separators; fuel heaters for engines; cultivating and harvesting machines, threshing machines, heading machines, reaping machines, binding machines, mowing machines, and harrows; ploughs and rakes; agitators for circulating liquid media; air condensers; alternators for land vehicles; anti-friction bearings for machines; anti-friction pads for machines; anti-pollution exhaust systems for motors and engines; axles for machines; ball rings for bearings; bearing brackets for machines; engine bearings; conveyor belts; engines and motors for

boats; brake linings other than for vehicles; brake segments for machines other than for vehicles, namely brake pads, brake rotors, brake plates, brake drums, expanding shoes, caliper discs, wet discs and expander tubes; brake shoes other than for vehicles; brushes being parts of machines, namely, dynamo brushes, rotary brushes and electric brushes; carburetors; compressed air machines; compressed air pumps; compressors for machines; condensing installations, namely, air condensers and axial fan condensers; connecting rods for machines, motors, and engines; electronic control modules for controlling the operation of machines, engines, or motors; direct and alternating current generators; milling cutters; cylinder heads for engines; cylinders for machines; cylinders for motors and engines; drilling bits for machines; drilling heads being parts of machines; drilling machines, drills, namely, power drills, hand drills, and drill bits for hand drills; dynamo belts; dynamo brushes; dynamos; engines, other than for land vehicles, namely, engines for generators; fan belts for motors and engines; fans for motors and engines; fuel processors for internal combustion engines; fuel economizers for motors and engines, namely control modules for controlling fuel flow and air flow into internal combustion engines; gear boxes other than for land vehicles; transmission gears for machines, other than for land vehicles; grinding machines, namely, gear grinding machines and precision grinding machines; guards, namely, metal hardware used to protect machinery, vehicles, and components from being damaged by debris during operation; hammers for machines; pneumatic hammers; mechanically operated hand held tools, namely sanders and polishers, air grinders, air drills, air hammer, air ratchets, shears and air engravers; mechanical discharging hoppers; machine jacks; machine lawnmowers; loading ramps; lubricating pumps; lubricators for machines; machine fly wheels; metal working machines; spray guns for paints; painting machines; pistons; pneumatic transporters; industrial machine presses; pulleys being parts of machines; machine rammers; reduction gears other than for land vehicles; mechanical shovels; shaft couplings; bearings for transmission shafts; speed governors for machines, engines, and motors; water tankers; superchargers; tarring machines; threading machines; threshing machines; transmission chains and shafts, other than for land vehicles; transmissions for machines; turbine generators; turbo compressors; machine waste disposers; watering machines for agricultural purposes; parts and fittings for all the aforesaid goods; mechanical engine parts for land vehicles, agricultural machinery, and earth moving machinery, namely, starting motors, alternators, pistons, cylinder heads, cooling systems parts, turbochargers, lubricating systems parts, air compressors, and engine blocks.

(12) Cutlery; razors; hand tools, namely, taps and dies; jacks; cable cutters; cutters, namely, wire cutters and glass cutters; wrenches; knives, namely, putty knives and utility knives; glass installation tools; crimping tools; cutting tools; fan blade reversing tools; hose cutters; drills and drill bits; grease guns; sockets; torque wrenches; parts and fittings for all the aforesaid goods.

(13) Cash registers, computer software for sensing and recording operational data to monitor the performance and maintenance needs of vehicles, equipment, and machinery used for earth moving, earth conditioning, material handling, construction, mining, paving, agriculture, and forestry, testing apparatus and instruments, namely, probes for testing integrated circuits; electric cable and electric wire; electricity conduits, electric switches, pressure switches, electric connectors, jump leads, electric fuses, circuit testers, voltage testers; fuse holders, power transformers; thermostats, pressure gauges, and leveling rods; tape measures and rules; microscopes, tachometers; anti-intrusion vehicle alarms, horns, namely, electronic warning horns

and horns for vehicles, flasher units, reflectors, namely, optical reflectors and reflectors for vehicles, mirrors, namely, rear view mirrors, side view mirrors and reflective mirrors for vehicles, and battery chargers for batteries for cordless tools, machines and vehicles; petrol pumps; surveyor's levels; electronic locks; radios; industrial batteries for heavy machinery, vehicles, generators and engine gen-sets; speed checking apparatus for vehicles, namely, sensors; battery cables; electric connectors for sale in kit form; electrical terminals; electrical tape; water temperature regulators, probes for testing integrated circuits; ammeters; battery testers, electric terminals, gas detectors; flow meters; cutting torches; ohmmeters; pressure measurement tools; battery ground strap connectors; battery tie down connectors; conduit and wire protectors; emergency jump start apparatus, namely, jumper cables; voltage converters for radios; parts and fittings for all the aforesaid goods; parts and fittings for land vehicles, agricultural machinery, and earth moving machinery, namely: amplifiers for wireless communications, antennas for wireless communications apparatus for global positioning system (GPS) data, radio signals and operational data for monitoring machinery and vehicle performance; audio equipment for vehicles, namely, stereos, speakers, amplifiers, equalizers, crossovers, and speaker housings, batteries for vehicles, devices for wireless radio transmission system, namely, connector cables, wireless communications adapter, PCMCIA radio card, and computer software to allow for remote monitoring of machinery and vehicle performance, electric control panels, electric luminescent display panels, electric relays; electronic and optical communications instruments and components, namely, optical transmitters; electronic and optical communications instruments and components, namely, optical receivers; electronic and optical communications instruments and components, namely, digital transmitters, electronic control systems for machines, global positioning systems, laser object detectors for use on vehicles, global positioning system (GPS) apparatus for tracking equipment and power systems used in the fields of agriculture, construction, forestry, general industry, marine, mining, material handling, oil and gas industry and electric power generation, and electronic control hardware and software related thereto, radios for vehicles, voltage regulators, voltage stabilizers, and voltmeters.

(14) Light bulbs, head lamp bulbs, tail lamp bulbs, direction indicator bulbs, dashboard lamp bulbs; flashlights; lights, namely, lights for vehicles and flashing safety lights, lamps for vehicles and heavy machinery; air conditioners; air conditioning filters; defrosters; parts and fittings for all the aforesaid goods; parts and fittings for land vehicles, agricultural machinery, and earth moving machinery, namely: backup lights for land vehicles, coolant recovery systems comprising reservoirs, pumps, filters, and cleaners; electric light bulbs, LED light bulbs, rear lights for vehicles, and valves as part of radiators.

(15) Tractor engines; haulage trucks and trailer wagons; vehicle chassis; wheels for land vehicles; metal tracks for vehicles for earth moving, earth conditioning, construction, material handling, mining, paving, agriculture, and forestry; dump trucks; land vehicles incorporating loading, compacting, pipe laying, and grading apparatus, namely, buckets, forks, grapples, compactors, winches, booms, and blades; tire valves; mufflers; exhaust caps; silencers; radiators and radiator caps; hydraulic circuits and hydraulic adapters; air pumps; mirrors; mudguards, spray guards, spray flaps; seats; windscreen wiper blades, anti-skid chains; brakes for vehicles; brake linings for vehicles; exhausts, namely, exhausts for engines and exhaust silencers for engines; hydraulic apparatus for land vehicles and not for engines or motors, namely, hydraulic drives, hydraulic gears, hydraulic pumps, and hydraulic shock absorbers; vehicle covers; parts

and fittings for all the aforesaid goods; parts and fittings for land vehicles, agricultural machinery, and earth moving machinery, namely: cranks, camshafts, engines, bearings, rods, namely, connecting rods for vehicles other than parts of motors and engines, levelling rods, metal liners for engines, transmissions for land vehicles, and structural, repair, and replacement parts therefor.

(16) Cylinder jointing of rubber, cylinder jointing of gum, gutta-percha, asbestos, mica; plastics in extruded form for use in manufacture; plastic tapes used as packing, stopping, and insulating materials; goods made from plastic, namely, cylinder jointing of plastics, tool handles of plastic; insulation tapes; adhesive tapes; semi-processed brake linings; clutch linings; cylinder jointing; insulating gloves; coupling and joints not of metal; rings of rubber or of plastic for use as pipe connection seals; parts and fittings for all the aforesaid goods; parts and fittings for land vehicles, agricultural machines, and earth moving machines, namely: connecting hoses for vehicle radiators, electrical insulating tape, flexible plastic hoses for use in ventilation, hoses for air conditioners made of rubber, hydraulic hoses made of rubber, and non-metal oil hoses.

(17) Picture frames; non-metal storage bins; table clips, not of metal; cable or pipe clips of plastic; plastic key cards; display cases of wood or plastic; caps and buckles for storage containers; containers, namely, non-metal storage containers for commercial use; ladders of wood or plastic; plastic pulleys for machines; tool handles, not of metal; non-metal transport pallets, not of metal.

Services

(1) Providing technical assistance, market analysis and marketing research services, and business consulting in connection with application engineering, systems analysis, job analysis, seismic analysis, material handling analysis, equipment specification and custom engineering services, machine customizing services, computer application services namely, order processing and parts and machine locating in the field of earthmoving, construction, materials handling, and power generating equipment, service and preventive maintenance programs; providing financial counseling services in the field of business, equipment economics and maintenance and cost record systems, financing equipment inventories and purchases; maintenance and repair services in the field of earthmoving, construction, materials handling and power generating equipment; leasing services in the field of earthmoving and material handling equipment; education services namely, conducting training classes and seminars concerned with management and maintenance training and finance; inspection life prediction services for earthmoving, construction, materials handling and power generating equipment; parts exchange services, component exchange services and oil sampling services.

(2) Warehousing services, product distribution operations management services; logistics consulting services, namely, providing contract logistics services and consulting in the areas of inventory management, freight transportation management, and warehouse and product distribution operations management; designing and managing complete logistics solutions for others; design of computerized information systems for managing logistics and product distribution processes for others.

(3) Rental of construction equipment, mining equipment, farming equipment, materials handling equipment and generators.

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Goods

(1) Cements and adhesives for bonding various types of materials; chemical compositions for industry namely, rust inhibitor for cooling systems, metal surfaces, and electrical connections; paints; oil, grease, anti-seize and sealing lubricant; articles of nonprecious metal namely, key tags, key chains, money clips, and name plates; hardware, namely bolts, nuts, washers, springs, ground engaging tools such as cutting edges, rippers, scrapers and tips; machinery for earth moving, earth conditioning and material handling namely, track-type tractors, wheel tractors, loaders, track-type loaders, wheel loaders, backhoe loaders, pipe layers, lift trucks, motor graders, scrapers, standard wheel tractor-scrapers, elevating scrapers, tandem powered scrapers, push-pull scrapers, bulldozers, compactors, landfill compactors, single drum and double drum vibratory compactors, pneumatic tired compactors, rippers and tool bars, cable controls and hydraulic controls for the foregoing goods and replacement parts, and attachments for the foregoing goods; internal combustion engines, diesel engines, natural gas engines, and marine engines and replacement parts, and attachments for the foregoing goods; marine gears, track group assemblies for tractors including track links, track shoes and track pins; electric generators, and electric sets for supplying electrical power to home, industry, hospitals, and the like, including diesel electric sets and natural gas electric sets; excavators and front shovels therefore; forest product swing machines, feller bunchers; skidders; integrated toolcarriers; pavement profilers; asphalt pavers; road reclaimer/soil stabilizer; hand tools, pocket knives, manicure sets and nail clippers, screw driver sets and table spoons; batteries, fuses, electrical cables, conduits, fasteners and terminals; switches, engine starting systems, spark plugs, spark plug firing indicators, load signal systems, flashers, brake accumulator buzzers; low air pressure alarms, turn signal flashers, meters and gauges namely speedometers, odometers, tire wear gauges, tire pressure gauges, hydraulic system filter indicators, air cleaner service indicators, fuel pressure gauges, torque converter temperature gauges, water temperature gauges, and service meters; computer software and programs, calculators, compasses being direction determining instruments, barometers and tape measures; eyeglasses; vehicles for earth and material hauling and handling namely, trucks, articulated dump trucks and tractors, engines for vehicles, replacement parts, and attachments for all the foregoing; articles of precious metal namely, cuff links, tie tacks, tie bars, bracelets, pendants, belt buckles, earrings, charms, key chains, stick pins, lapel pins and necklaces, watches and clocks; watch fobs; company magazines, newsletters, and bulletins, books, instructional and teaching material namely, books, work books, films, videos and models; note pads, binders, stationery-type portfolios, calendars, pencils, pens, decals, coloring and game books, playing cards, paper coasters, photo albums and check book holders; hydraulic hose and couplings therefore; rubber ring seals for vehicles and machinery; leather and imitation leather goods namely, wallets, credit card cases, business card cases, key holders, coin holders, briefcases, garment bags for travel, duffle bags, flight bags and tote bags, umbrellas, traveling bags, purses; glassware, cups and coasters; work, sport and casual clothing namely, caps, belts, ties, scarves, headwear namely, stocking caps, ear muffs and head bands; t-shirts, shorts, sweat pants, sweat shirts, wrist bands, jackets, vests, gloves, mittens, rain wear, one-piece

jump suits and socks, footwear namely, work boots and athletic shoes; cloth, iron-on, sew-on and pressure sensitive patches; belt buckles made of non-precious metal; toy vehicles, board games, game balls, sports equipment namely, golf clubs; sports towels; matches, cigarette lighters and ash trays; hydraulic hose; filters namely, air filters, fuel filters and oil filters; o-ring seals; hose, tubing and clamps; V-belts.

Services

(1) Providing technical assistance, marketing and marketing research services, and business consulting in connection with application engineering, systems analysis, job analysis, seismic analysis, material handling analysis, equipment specification and custom engineering services, machine customizing services, computer application services namely, order processing and parts and machine locating the field of earthmoving, construction, materials handling, and power generating equipment, service and preventive maintenance programs; providing financial counseling services in the field of business, equipment economics and maintenance and cost record systems, financing equipment inventories and purchases; maintenance and repair services in the field of earthmoving, construction, materials handling and power generating equipment; leasing services in the field of earthmoving and material handling equipment; education services namely, conducting training classes and seminars concerned with management and maintenance training and finance; inspection life prediction services for earthmoving, construction, materials handling and power generating equipment; parts exchange services, component exchange services and oil sampling services.

OPPONENT'S FAMILY OF CAT TRADEMARKS

TRADEMARK	Registration No./Application No.
CAT	UCA31304
CAT	TMA165,286
CAT	TMA167,499
CAT	TMA205,367
CAT & Design	TMA678,523
CAT & Design	TMA549,693
CAT & Design	TMA546,439
CAT & Design	TMA578,640
CAT & Design	TMA682,842
CAT & Design	TMA682,843
CAT & Design	TMA682,846
CAT & Design	TMA682,847
CAT & Design	TMA682,848
CAT & Design	TMA886,578
CAT	TMA886,580

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

HEARING DATE 2020-11-02

APPEARANCES

Sydney E. Young	For the Opponent
David S. Lipkus	For the Applicant

AGENTS OF RECORD

Osler, Hoskin & Harcourt	For the Opponent
Kestenberg Siegal Lipkus, LLP	For the Applicant