



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 33

Date of Decision: 2020-05-12

IN THE MATTER OF AN OPPOSITION

Medical Specialties, Inc.

Opponent

And

Superfeet Worldwide, Inc.

Applicant

1,764,439 for E EVOLYTE & Design

Application

INTRODUCTION

[1] On January 21, 2016, Superfeet Worldwide Inc. (the Applicant) filed an application to register the trademark E EVOLYTE & Design (the Mark), shown below.



[2] The application is based on use of the Mark in Canada since at least as early as September 23, 2013, in association with “carbon fibres and polymer composite for manufacture of footwear and orthotic insoles” (the Goods).

[3] The application was advertised for opposition purposes in the *Trademarks Journal* of December 28, 2016.

[4] Medical Specialties, Inc. (the Opponent) filed a statement of opposition on August 25, 2017. The grounds of opposition are pleaded pursuant to sections 30, 16, 12 and 2 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). As 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 (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 before this date).

[5] The Applicant filed and served a counter statement on September 19, 2017. The Opponent’s evidences comprises the affidavit of Christoph Heinemann. As its evidence, the Applicant filed and served the affidavit of Dan Wakeland. Neither affiant was cross-examined. Only the Applicant filed a written argument; an oral hearing was not requested.

ONUS

[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

GROUND OF OPPOSITION SUMMARILY DISMISSED

Section 30(i) Ground of Opposition

[7] The Opponent alleges in its statement of opposition that the Applicant could not have been satisfied that it is entitled to use the Mark as the Applicant was or should have been aware of the Opponent’s mark at the date of filing of the application.

[8] Where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases, such as where 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]. In this case, there is no evidence of bad faith or exceptional circumstances. Furthermore, even if the Opponent had shown that the Applicant knew of its trademarks at the filing date of its applications, I note that it has been held that mere knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use a mark at the time that it filed its application [*Woot, Inc v WootRestaruants Inc Les Restaurants Woot Inc*, 2012 TMOB 197].

[9] This ground of opposition is therefore dismissed.

Section 30(b) Ground of Opposition

[10] The Opponent also pleads that the Mark has not been used in Canada by the Applicant in association with the Goods since the claimed date of first use, September 23, 2013.

[11] No evidence has been filed nor submissions made by the Opponent which support its allegation that the Applicant has not used the Mark in association with the Goods since the date of first use claimed in the application.

[12] Accordingly, the section 30(b) ground of opposition is dismissed as the Opponent has not met its evidential burden.

Section 16(1)(a) Ground of Opposition

[13] The Opponent alleges in its statement of opposition that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada given that as of the Applicant's claimed date of first use or making known, it was confusing with the Opponent's EVO mark that had been previously used and made known in Canada in association with "athletic ankle braces for medical use; braces for limbs and joints, for medical use; medical braces for ankles; orthopedic braces" (the Evo Goods).

[14] In order to meet its initial burden with respect to its section 16(1)(a) ground of opposition, the Opponent must show that its mark had been used before September 23, 2013, and had not been abandoned as at the date of advertisement of the application for the Mark, namely, December 28, 2016 [section 16(5) of the Act].

[15] The only evidence submitted by the Opponent was the affidavit of Christophe Heinemann, a law clerk employed by the Opponent's agent. Mr. Heinemann performed various internet searches and attached to his affidavit print-outs from various websites, including *www.medspec.com* (the Opponent's company), *www.poportho.com* (the website of Professional Orthopedic Products, an alleged distributor of the Opponent's products), *www.superfeet.com* (the Applicant's company), *www.en.oxforddictionaries.com* (the Oxford Dictionary website) and the Canadian Trademarks Database.

[16] The web pages of the Opponent's company and its Canadian distributor attached to Mr. Heinemann's affidavit are only proof, at best, that they existed at the time the searches were performed and that these websites advertised various types of ankle braces in association with the Opponent's mark. There is no evidence that the goods were sold in Canada, nor any evidence that Canadians viewed these websites.

[17] As the Heinemann affidavit contains no information regarding use of the Opponent's mark in Canada prior to the Applicant's claimed date of first use, this ground of opposition is accordingly dismissed for the Opponent's failure to meet its evidential burden.

Section 16(1)(c) Ground of Opposition

[18] The Opponent alleges in its statement of opposition that the Applicant is not the person entitled to the registration having regard to section 16(1)(c) on the ground that the Mark, as at the Applicant's date of first use, was confusing with the trade name EVO that had been previously used in Canada by the Opponent.

[19] In order to meet its initial burden with respect to its section 16(1)(c) ground of opposition, the Opponent must show that its pleaded trade name had been used in Canada prior to September 23, 2013.

[20] The Heinemann affidavit contains no information regarding use of the Opponent's trade name in Canada prior to the Applicant's claimed date of first use. Accordingly this ground is also dismissed as a result of the Opponent's failure to meet its evidential burden.

Section 2 Ground of Opposition

[21] The Opponent alleges in its statement of opposition that the Mark is not distinctive because the Mark does not actually distinguish the goods in association with which it is used by the Applicant from the goods or services of others, namely the EVO Goods sold in association with the EVO Mark, nor is the Mark adapted so as to distinguish the Applicant's goods.

[22] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that, as of the date of filing its statement of opposition, August 25, 2017, the EVO mark was known to some extent at least and the reputation of this mark in Canada was substantial, significant or sufficient [*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)].

[23] As discussed above, the affidavit of Mr. Heinemann is not sufficient to show that the Opponent's EVO mark had been previously used or made known by the Opponent at all in Canada. This ground is therefore also dismissed as a result of the Opponent's failure to meet its evidential burden.

REMAINING GROUND OF OPPOSITION - SECTION 12(1)(D)

[24] The Opponent alleges in its statement of opposition that the Mark is not registrable in view of section 12(1)(d) of the Act because it is confusing with the EVO mark, registration No. TMA754,272, which had been previously registered and used in Canada by the Opponent since at least as early as February 22, 2008.

[25] An opponent's initial evidential burden is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon in the statement of opposition is in good standing as of the date of the decision. The Registrar has discretion to check the register in order to confirm the existence of a registration relied upon by an opponent [*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 the Registrar's discretion and have confirmed that the Opponent's registration remains in good standing. The Opponent has therefore met its initial evidential burden in respect of this ground with respect to this mark. Accordingly, I must go on to determine whether the Applicant has met the legal onus upon it to establish that there is no likelihood of confusion between this mark and the applied for Mark.

Meaning of Confusion between Trademarks

[26] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services . . . associated with those trademarks are manufactured . . . 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.

[27] Thus, section 6(2) does not concern mistaking one mark for the other, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the goods, sold under the Mark would believe that those goods were produced or authorized or licensed by the Opponent who sells its goods under the EVO trademark.

Test for Confusion

[28] 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 or trade names 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 or trade names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22 and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC) [*Masterpiece*]]. However, as noted in *Masterpiece*, although the degree of resemblance is the

last factor cited in section 6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Section 6(5)(a) – the inherent distinctiveness of the marks at issue and the extent to which they have been known

[29] In considering the inherent distinctiveness of the respective parties' trademarks, I have exercised my discretion to refer to dictionary definitions [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]. Although EVO is not defined in the dictionary, the Opponent's own advertising suggests that EVO is an abbreviation for the word "evolutionary". In this regard, Exhibit C to the Heinemann affidavit states as follows "The ASO EVO ankle stabilizer is an EVOLutionary step forward in ankle protection". I further note that the word "evolutionary" is defined in the *Oxford Dictionary* as: "connected with slow, steady, development and change". I would therefore characterize the Opponent's trademark as somewhat laudatory as it suggests that the Opponent's goods are an improvement over similar type goods. Accordingly, although I do not find the Opponent's mark to be inherently strong I do find that it possesses some degree of inherent distinctiveness.

[30] The Applicant's Mark, on the other hand, is a composite mark that consists of the design of a bullseye with a capital letter E in the middle on the top portion of the mark with the word EVOlyte at the bottom half. The component EVO is also suggestive of the word "evolution" or "evolutionary" while the component "lyte" suggests that the Applicant's specialized materials are light in weight. I therefore also do not consider the Mark to be inherently strong but I do find that it possesses some degree of inherent distinctiveness.

[31] With respect to the degree to which the parties' marks have become known, the only evidence submitted by the Opponent was the affidavit of Mr. Christoph Heinemann. As noted above, I am not satisfied from this evidence that the Opponent has shown any use or making known of its mark in Canada in association with any of its registered goods.

[32] The Applicant, on the other hand, has shown that its Mark has become known to some extent in Canada. In this regard, the Applicant relies on the affidavit of Dan Wakeland, Business

Unit Manager Insole and Footwear of the Applicant. Some of the pertinent evidence of Mr. Wakeland includes the following:

- A copy of the Applicant's 2018 spring/summer catalogue displaying a minor deviation of the Mark (and which I accept as use of the Mark) with the descriptive words "carbon fibre" underneath on various pages to identify the insoles that contain the carbon fiber blend materials branded under the Mark [Wakeland, para. 12, Exh. 4];
- Pictures of seven of the Applicant's insole products offered for sale under the trademarks CARON, CARBON Pro Hockey, Custom CARBON All-Season, EVERYDAY Pain Relief, TRAILBLAZER Comfort Max, RUN Comfort Thin and GO PREMIUM COMFORT, featuring the Mark or minor variations of the Mark to identify that the insoles are made with carbon fiber blend materials branded under the Mark [Wakeland, para. 13, Exh. 5];
- A table entitled "sales of Evolyte Products in Canada", together with yearly breakdowns from 2013-2018 of the number of insole products that contain the carbon fiber blend material branded under the Mark and were shipped to Canada during that time [Wakeland, para. 14, Exh. 7];
- A list of over 500 retail distributors of insole products containing the carbon fibre material branded under the Mark, identified by account number, in Canada from 2013 until the date of his affidavit, May 17, 2018 [Wakeland, para. 16, Exh. 8]; and
- Representative samples of invoices issued by the Applicant to Canadian distributors evidencing sales of insoles containing the carbon fibre blend material branded under the Mark in Canada between 2014 and 2018 [Wakeland, paras 17-21, Exh. 9-13].

[33] In view of the above, I find that, overall, this factor favours the Applicant.

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

[34] As noted above, I am not satisfied that the Opponent’s evidence shows any use of its mark in Canada. I therefore find that this factor favours the Applicant, as it has shown use of its Mark in Canada since at least as early as September 20, 2013.

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

[35] It is the statement of the goods in the application and the statement of goods in the registration that must be taken into consideration when assessing the factors set forth at section 6(5)(c) and (d) of the Act [*Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA) and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[36] The Applicant’s goods comprise specialized materials for the manufacture of footwear and orthotic insoles. The Opponent’s registered goods cover various types of athletic, medical and orthopedic braces.

[37] I agree with the Applicant’s submissions that the parties’ goods are different. The Applicant’s product is used to refer to the *material for the manufacture of* end products (i.e. the Mark is associated with carbon fiber blend materials used to manufacture insoles sold under other marks such as CARBON or TRAILBLAZER Comfort Max). This is illustrated in Exhibit 5 to the Wakeland affidavit which shows the packaging for a SUPERFEET CARBON insole in which one of the features is described as follows: “EVOLyte® carbon fibre cap provides structure and stability in the foam layer.” The Opponent’s mark, on the other hand, is used in association with a *specialized end product*, i.e. athletic, medical and orthopedic braces.

[38] With respect to the parties’ channels of trade, the Applicant submits that the purchase of the Opponent’s products would likely involve the assistance of health care professionals, whereas the materials branded under the Mark are for everyday purchases which require no prescription and are for retail. The Applicant points to the printout from the Opponent’s alleged Canadian distributor’s website, Professional Orthopedic Products, which states as follows: “Our products are designed to be fitted by health care professionals, and are not directly available to

the public. Please contact your health care professional if you could benefit from the use of our products” [Heinemann affidavit, Exh. C].

[39] I note, however, that neither of the parties’ statements of goods is restricted to any particular channel of trade. In *Masterpiece*, supra, the Court stated at para 59 that while actual use is not irrelevant, “it should not be considered to the exclusion of potential uses within the registration.” As there is no restriction to the Opponent’s channels of trade, it is open for the Opponent to sell its goods by retail or directly to the consumer. I therefore conclude that the parties’ channels of trade could overlap.

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

[40] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totality; it is not correct to lay the trademarks side by side and compare and observe similarities or differences among the elements or components of the marks. The Supreme Court in *Masterpiece* [at para 64] advises that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trademarks that is particularly striking or unique.

[41] In this case, the Applicant has adopted the Opponent’s mark in its entirety as the first and arguably one of the most distinctive features of the Mark. As a result, there is a fair degree of resemblance between the marks when sounded.

[42] However, I also find that the E bullseye design in the Mark is as unique and distinctive as the component EVO. I therefore do not find there to be as much resemblance between the marks in appearance as in sound. With respect to ideas suggested, while both marks suggest that their goods are “evolutionary” in nature, the Mark also suggests that its associated product is of low weight. There is therefore only a fair degree of resemblance between the marks in ideas suggested.

Conclusion re: Likelihood of Confusion

[43] Section 6(2) of the Act does not concern confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether there would be confusion of the goods sold under the Mark such that they are thought to be provided by the Opponent. I conclude that, on a balance of probabilities, given all the surrounding circumstances there is not a reasonable likelihood of confusion. The differences between the marks and their associated goods are sufficient to make confusion unlikely.

[44] The section 12(1)(d) ground of opposition is therefore not successful.

DISPOSITION

[45] In view of the above, 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 Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE - No hearing held.

AGENTS OF RECORD

Gowling WLG (Canada) LLP

For the Opponent

Vanguard Intellectual Property LLP

For the Applicant