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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 34

Date of Decision: 2021-02-25

IN THE MATTER OF AN OPPOSITION

Garmin Switzerland GmbH

Opponent

and

**VIVO MOBILE COMMUNICATION
CO., LTD.**

Applicant

1,674,127 for vivo

Application

INTRODUCTION

[1] Garmin Switzerland GmbH (the Opponent) opposes registration of the trademark vivo set out below (the Mark) filed by BBK COMMUNICATION TECHNOLOGY CO., LTD. and subsequently assigned to VIVO MOBILE COMMUNICATION CO., LTD. (the Applicant).

The word "vivo" is displayed in a bold, lowercase, sans-serif font. The letters are thick and black. The 'i' has a small diamond shape above it. The 'o' is a simple circle.

[2] Filed on April 24, 2014, the application is based on proposed use of the Mark in Canada with the Goods: telephone apparatus, namely, telephones, portable telephones, mobile telephones, cellular telephones and smartphones.

[3] The Opponent alleges that (i) the application does not conform to section 30 of the *Trademarks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to the registration of the Mark under section 16 of the Act, and (iv) the Mark is not distinctive under section 2 of the Act. Many of the grounds of opposition are related to the Opponent's allegation that the Mark is confusing with the use and registration of its trademarks VIVOFIT and VIVOSMART in association with an electronic monitor that monitors, records and displays physical activity levels, steps walked or ran and distances covered when exercising.

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

RECORD

[5] The Opponent filed its statement of opposition on May 13, 2016. In accordance with section 70 of the Act all references to sections of the Act pertaining to the grounds of opposition are to the Act as it read before June 17, 2019. During the course of the opposition, the Opponent was granted leave to amend its statement of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of David V. Ayres, Associate General Counsel-IP of Garmin International, Inc., a related company of the Opponent and the affidavit of Mary P. Noonan, a trademark searcher employed by the agents for the Opponent. Ms. Noonan's evidence includes printouts from the Canadian Intellectual Property Office's website, the register, and a copy of the Examiner's report for this application and the Applicant's response. The Applicant did not file evidence. Both parties filed written submissions and attended a hearing.

EVIDENTIAL BURDEN AND LEGAL ONUS

[7] While there is an initial evidential burden on an opponent, the legal burden or onus remains on the applicant, on a balance of probabilities [*John Labatt Ltd v Molson Co*, [1990] FCJ No 533, aff'd [1992] FCJ No 525 (FCA)].

ANALYSIS

[8] I will consider the grounds of opposition beginning with the section 12(1)(d) and section 2 grounds of opposition.

SECTION 12(1)(D) GROUND OF OPPOSITION

[9] The Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the Opponent's registered trademarks VIVOFIT and VIVOSMART:

Reg. No.	Trademark	Goods
TMA909,532	VIVOFIT	Monitoring devices for medical and non-medical purposes, namely, electronic monitor that monitors, records and displays physical activity levels, physical inactivity periods, steps walked or ran, distances covered in exercise, exercise levels achieved compared with exercise level goals, calories burned, exercise goal levels based on past exercise, quality of rest and sleep patterns.
TMA899,032	VIVOSMART	

[10] I have exercised the Registrar's discretion to confirm that these registrations are in good standing [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[11] The material date for considering this issue 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)].

[12] Since the Opponent has satisfied its initial evidential burden for this ground of opposition, the issue is whether the Applicant has met its legal onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and each of the Opponent's registered trademarks. For the reasons that follow, this ground of opposition succeeds.

[13] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or

services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[14] 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. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

Inherent distinctiveness of the trademarks

[15] The Mark possesses a high degree of inherent distinctiveness because it is a word without any particular connotation to the Goods since the word vivo is defined in *www.dictionary.com* as “music (in combination) with life and vigour: *allegro vivo*”. Similarly, the Opponent’s trademarks VIVOFIT and VIVOSMART possess a relatively high degree of inherent distinctiveness since these trademarks are coined words including the prefix VIVO which does not appear to relate to the Opponent’s registered goods. However, the inherent distinctiveness of the Opponent’s trademarks is lessened owing to the suffix components FIT and SMART which describe features of the Opponent’s monitors, namely, that they encourage fitness and are intelligent devices.

Extent known and length of time in use

[16] This factor favours the Opponent as only it has evidenced that its trademarks VIVOFIT and VIVOSMART have been used in Canada. Mr. Ayres’ evidence is that:

- a) The Opponent has under license, direct or indirect control over the character or quality of the products sold, promoted and advertised in Canada in association with the VIVO Trademarks including VIVOFIT, VIVOSMART, VIVOACTIVE, VIOKI, VIVOMOVE, and VIVOHUB (paras 15, 23).
- b) The Opponent has used the trademark VIVOFIT since at least as early as February 26, 2014 and the trademark VIVOSMART since at least as early as

September 22, 2014 (para 25) in association with electronic monitors which consumers wear on their wrists which track a variety of parameters including steps taken, distance travelled, calories burned and heart rate (Exhibits 16, 17).

- c) Both the VIVOFIT and VIVOSMART brand monitors can be paired with a consumer's own computer or smartphone.

1. The manual for the vivofit3 explains (Exhibit 16):

Everyday Use

Make your vivofit 3 device part of your active lifestyle by wearing it all day, and syncing your data often with your Garmin Connect account. Syncing allows you to analyze steps and sleep data, view totals and get insights into your activity. You can use your Garmin Connect account to participate in challenges and compete with your friends.

2. The manual for vivosmart3 explains (Exhibit 17):

Bluetooth Connected Features

The vivosmart 3 device has several Bluetooth connected features for your compatible smartphone using the Garmin Connect Mobile app.

Notifications: Alerts you to notifications from your smartphone including calls, texts, social network updates, and more ...

Weather updates: Displays the current temperature and weather forecast from your smartphone.

Music controls: Allows you to control the music player on your smart phone ...

- d) The trademarks VIVOFIT and VIVOSMART appear on packaging (Exhibits 11-12), on the owner's manual (Exhibits 16-17) and in print and online advertisements (Exhibits 28-33).
- e) The VIVOFIT and VIVOSMART trademarks are also featured on the Garmin *www.garmin.com* website which has hundreds of thousands visits from Canadian internet users in each of the years 2014-2017 (paras 66-68; Exhibit 35).

- f) The VIVO products are sold directly through the Garmin website, though major retail chains specializing in sale of personal electronics including Best Buy and The Source, major full-service retail chains such as Wal-Mart and Canadian Tire, and major sporting goods chains such as SportChek and The Running Room (paras 42-43). From 2014-2016, sales revenues in USD in Canada for VIVOFIT exceeded \$12M and for VIVOSMART exceeded \$14M (para 47), representing sales volumes of 172,000 and 135,000 devices respectively (para 48).

Nature of the goods, business and trade

[17] When considering sections 6(5)(c) and (d) of the Act, the statements of goods and services as defined in the application for the Mark and in the Opponent's registration govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. The evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[18] These factors favour the Opponent whose trademarks are registered for use in association with an electronic monitor that monitors, records and displays physical activity levels, physical inactivity periods, steps walked or ran and distances covered in exercise. The Opponent's evidence is that its VIVOSMART device is designed to be paired with a consumer's smartphone and gently vibrates and displays texts, calls, emails and calendar alerts from compatible Bluetooth® enabled devices (Exhibit 17). The Opponent's VIVOFIT trademark can be connected to a consumer's smartphone or computer through the Garmin Connect Mobile App (Exhibit 16).

[19] The Mark is for use with telephone apparatus, namely, telephones, portable telephones, mobile telephones, cellular telephones and smartphones. The Applicant submits that the

Opponent's activity monitors are of a different nature than telephones and would be used for different purposes. The Applicant submits at paragraphs 46-48 of its written submissions:

- 46 ... Where there appears to be no connection between the goods or services of the parties, this factor is often determinative of a finding of non-confusion. ...
- 47 The Opponent has not submitted any evidence to suggest that its VIVOFIT or VIVOSMART activity monitors are telephones, could be used as telephones, or have any communication capabilities. The Opponent's monitors do not compete with telephones in the marketplace, nor are they substitutes for telephones. ...
- 48 The differences in the nature of the parties' goods further supports the position that their goods would be likely to be sold through different channels of trade. Further, a consumer in the market for the Opponent's goods would be distinct from a consumer in the market for the Applicant's goods.

[20] While the Opponent's goods are not telephones and cannot be used as telephones, some of them are intended to be integrated with a user's smart phone. As such, there is a strong connection between the goods described as mobile telephones, cellular telephones and smart phones and the Opponent's registered goods. Furthermore, I find that the consumers of these goods overlap since consumers of the Applicant's goods must also be owners of a mobile, cellular or smart phone to obtain full functionality out of the Opponent's VIVOSMART monitors. Finally, with respect to the nature of trade, I find there to be overlap as the Opponent's evidence is that its "products dealers and distributors include major retail chains specializing in the sale of personal electronics such as Best Buy and The Source [...]" (para 43) which, I infer, would also sell the Applicant's products (even if not in the same section of the stores).

[21] In the absence of evidence from the Applicant, I am unable to find that the goods described as "telephones" and "portable telephones" would not include mobile, cellular or smartphones – all of which are types of telephones which are portable. Even assuming that these goods do not include mobile, cellular or smart phones, I still find that there is some degree of overlap in the nature of goods and channels of trade as they all are electronic devices which may have communication capabilities such as the VIVOSMART monitors which include communication capabilities.

Degree of resemblance

[22] The degree of resemblance between the trademarks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot* at para 20].

[23] There is a high degree of resemblance in appearance and sound between the trademarks in issue as the Applicant has incorporated the dominant part of the Opponent's trademarks VIVOFIT and VIVOSMART as the Mark in its entirety. The second component in the Opponent's trademarks, the words SMART and FIT, do not meaningfully diminish the resemblance between the Mark and the Opponent's trademarks in appearance and sound. Likewise, the stylization of the Mark does not materially affect the degree of resemblance. With respect to ideas suggested, I find there to be less resemblance as it is not clear what the parties' trademarks may suggest to consumers.

Surrounding circumstance - family of marks

[24] The Opponent relies on its family of VIVO trademarks as a surrounding circumstance which increases the likelihood of confusion (Opponent's written submissions, paras 77-80). The Opponent has evidenced at least some use of its other marks including VIVO, namely, VIVOACTIVE, VIVOKI, and VIVOMOVE (Ayres Affidavit, paras 25, 48 and Exhibits 8-10). The use of a small family of trademarks does increase the likelihood of consumers assuming that the Applicant's VIVO goods are another one of the Opponent's VIVO products or related to them [*McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD); *Air Miles International Trading BV v SeaMiles LLC* (2009), 76 CPR (4th) 369 (TMOB) at para 46]. Further, there is no evidence that the family's common feature VIVO is registered or used by others [*Thomas J Lipton Inc v Fletcher's Fine Foods Ltd* (1992), 44 CPR (3d) 279 (TMOB) at 286-7]. Therefore, as an additional surrounding circumstance, albeit one with a small impact, I have considered the Opponent's family of marks. In including this factor as one of the surrounding circumstances, I have accounted for the fact that unlike each of the

Opponent's VIVO trademarks, the Mark only consists of VIVO and does not include a suffix component suggestive of its Goods.

Conclusion on the likelihood of confusion

[25] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in view of the Opponent's use of its trademarks VIVOFIT and VIVOSMART, the potential for overlap in the parties' channels of trade and the nature of the parties' goods, as well as the strong similarities of the parties' marks in appearance and sound, I am not satisfied that the Applicant has discharged its legal onus to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and either of the Opponent's registered trademarks VIVOFIT or VIVOSMART. As such, the section 12(1)(d) ground of opposition succeeds.

SECTION 2 GROUND OF OPPOSITION

[26] The Opponent pleads that the Mark is not distinctive of the Applicant. At paragraph 3(f) of the statement of opposition, the Opponent alleges:

... [the Mark] is confusingly similar to the trademarks of the Opponent ... registered and/or used ... in Canada ... in association with various personal electronic devices, software, downloadable software, batteries, antenna for mobile devices, intercommunication apparatus to link mobile electronic devices to computers, personal electronic devices intended to be linked to portable telephones and smart phones ...

[27] The material date for assessing distinctiveness is the date of filing of the opposition, which is May 13, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[28] In order to meet its initial evidential burden with respect to the non-distinctiveness ground of opposition, the Opponent is required to show that one or more of its trademarks had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. To do so, the Opponent must establish that one of its trademarks is either known to some extent in Canada or is well known in a specific area of Canada [*Bojangles* at paras 33-34].

[29] Mr. Ayres' evidence satisfies the Opponent's initial burden with at least the trademarks VIVOFIT and VIVOSMART. Although the material date for distinctiveness is approximately four years earlier than today's date, the difference in dates does not result in a different outcome. The section 2 ground succeeds on the basis that the Applicant fails to meet its legal onus of proving no reasonable likelihood of confusion between the Mark and the Opponent's trademarks VIVOFIT and VIVOSMART, on a balance of probabilities, for similar reasons as those set out under the section 12(1)(d) ground. In so finding, I acknowledge that the Opponent's evidence of the use of its family of trademarks at the earlier material date does not favour it to a significant extent as sales of the VIVOMOVE smartwatch had not yet commenced and sales of the VIVOKI activity tracker appear to be relatively limited (Ayres affidavit, paras 15, 25 and 48). Nevertheless, this ground of opposition succeeds.

REMAINING GROUNDS OF OPPOSITION

[30] Having already refused the application under two grounds, I will not discuss the remaining grounds of opposition.

DISPOSITION

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

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2020-11-24

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