



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 88

Date of Decision: 2021-05-12

IN THE MATTER OF AN OPPOSITION

Huawei Technologies Co., Ltd.

Opponent

and

UBISOFT ENTERTAINMENT

Applicant

1,732,982 for FOR HONOR et dessin

Application

OVERVIEW

[1] Huawei Technologies Co., Ltd. (the Opponent) opposes registration of the trademark FOR HONOR et dessin (the Mark), reproduced below, which is the subject of application No. 1,732,982 in the name of UBISOFT ENTERTAINMENT (the Applicant).

The logo for the video game "For Honor" is displayed. The word "FOR" is in a smaller, bold, sans-serif font above the word "HONOR", which is in a larger, bold, sans-serif font. The letters have a metallic, 3D appearance with shadows and highlights.

[2] Colour, [TRANSLATION] “light brown and dark brown” (*marron clair et marron foncé*), is claimed as a feature of the Mark.

[3] The application for the Mark was filed on June 15, 2015 on the basis of proposed use in Canada and covers the following goods and services:

Goods:

(1) Pre-recorded software video games on CD-ROMs, digital video discs, and cartridges for console and individual, portable gaming systems; prerecorded software video games that are downloadable from a remote computer site.

(2) Computer game instruction manuals and published guides containing suggestions on how to play the computer games; printed matter, namely, books featuring works of fiction; printed matter, namely, comics featuring works of fiction.

(3) Toys and playthings, namely dolls, toy action figures, plush toys and accessories thereof, playsets for dolls and toy action figures, toy vehicles [*sic*], and hand held units for electronic games.

Services:

(1) Entertainment services, namely, providing an on-line computer game for others over global and local area computer networks and providing information on-line relating to computer games and video games.

[4] The Mark was advertised for opposition purposes in the *Trademarks Journal* on April 6, 2016 and on June 2, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). All references in this decision are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition which refer to the Act before it was amended.

[5] The grounds of opposition pleaded by the Opponent allege that the application does not conform to sections 30(e) and (i) of the Act, that the Mark is not registrable under section 12(1)(d) of the Act, that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act, and that the Mark is not distinctive under section 2 of the Act.

[6] The Applicant filed and served a counter statement denying the grounds of opposition.

[7] In support of its opposition, the Opponent filed a certified copy of its registration No. TMA921,525 for the trademark Honor. The Applicant elected not to file any evidence.

[8] Only the Applicant filed written representations. I note that the Applicant's written argument comprises references to matters which have not been properly set out in evidence and as such, I confirm having disregarded all such portions of this document.

[9] No oral hearing was held.

MATERIAL DATES AND ONUS

[10] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a) and 30 of the Act – the filing date of the application, namely, June 15, 2015 [*Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 at 94 (TMOB); *Tower Conference Management Co v Canadian Exhibition Management Inc*, (1990) 28 CPR (3d) 428 at 432 (TMOB)];
- Sections 38(2)(b) and 12(1)(d) of the Act– the date of the Registrar's decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c) and 16 of the Act – the filing date of the application, namely, June 15, 2015 [section 16(3) of the Act]; and
- Sections 38(2)(d) and 2 of the Act – the filing date of the opposition, namely, June 2, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185].

[11] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)]. If this burden is met, the Applicant then bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act.

GROUNDINGS SUMMARILY REJECTED

[12] The grounds of opposition below can be rejected on the basis that the Opponent has failed to meet its evidential burden:

- Section 30(e) – Section 30(e) of the Act requires that an applicant for a trademark based on proposed use include a statement in its application that, by itself and/or through a licensee, it intends to use said trademark in Canada. The application for the Mark contains the required statement and there is no evidence that such statement is untrue.
- Section 30(i) – Mere knowledge of the existence of the Opponent’s relied upon marks or confusion with the Opponent’s relied upon marks alone, does not support the allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [*WOOT Inc v WootRestaurants Inc*, 2012 TMOB 197]. Section 30(i) of the Act requires that an applicant include a statement in its application that it is satisfied that it is entitled to registration of its trademark. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith [*Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. The application for the Mark contains the required statement and there is no evidence that this is an exceptional case.
- Section 16(3)(a) – There is also no evidence of use or making known of the Opponent’s relied upon marks in Canada at the filing date of the application [see section 16(5) of the Act] and an inference of *de minimis* use based on a certified copy of an opponent’s trademark registration does not meet the requirements of section 16 of the Act [*Roos, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 at 268 (TMOB)].
- Section 2 – Lastly, there is no evidence that any of the Opponent’s relied upon marks had acquired a reputation in Canada that was sufficient to negate the Mark’s distinctiveness at the date of filing of the statement of opposition [see *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 25-34 which sets out the Opponent’s evidential burden], nor is there any evidence that the Mark was used outside the scope of the licensed use provided for by section 50 of the Act.

REMAINING GROUND OF OPPOSITION

[13] The remaining ground of opposition turns on the issue of confusion between the Mark and the trademark Honor, registered under No. TMA921,525.

Section 12(1)(d)

[14] An opponent meets its initial burden with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. In this regard, the Registrar has the discretion to check the register in order to confirm the existence of the 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)]. Having exercised my discretion, I confirm that registration No. TMA921,525 is in good standing.

[15] The Applicant must now establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trademark.

The test for confusion

[16] 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, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but confusion of the goods or services from one source as being from another.

[17] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which the trademarks have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to

each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49, where the Supreme Court of Canada states that the resemblance between the marks will often have the greatest effect on the confusion analysis.

Inherent distinctiveness and extent known

[18] The trademarks at hand possess a similar degree of inherent distinctiveness. They are both composed of ordinary English terms which hold no meaning in relation to the goods and/or services that they respectively cover. The added stylization and the colour claim in the Mark somewhat contribute to its inherent distinctiveness as a whole, however not in a significant way.

[19] While the strength of a trademark may be increased by it becoming known through promotion or use, as mentioned above, neither party submitted evidence showing that the marks at issue have been used or become known to any extent in Canada.

[20] Consequently, the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trademarks, does not significantly favour either party.

Length of time in use

[21] As indicated above, the application is based on proposed use and the Applicant has not adduced any evidence that use of the Mark has commenced since its filing.

[22] The Opponent's registration for the trademark Honor shows that a declaration of use was filed on November 27, 2015. Absent any other evidence, I can only infer *de minimis* use of the Opponent's trademark from the certificate of registration adduced [*Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951 at para 37; *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. Such an inference, however, does not support the finding that the Opponent's trademark was known to any significant extent or that it has been continuously used since the date declared [*Krauss-Maffei Wegmann GmbH & Co KG v Rheinmetall Defence Electronics GmbH*, 2017 TMOB 50 at para 20].

[23] Consequently, the section 6(5)(b) factor also does not favour either party.

Nature of the goods, services, businesses and trade

[24] When considering the nature of the goods and services and the nature of the trade, I must compare the Applicant's statement of goods and services with the one contained in the registration relied upon by the Opponent [*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)]. However, these statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. 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)].

[25] As indicated above, the statement of goods and services for the Mark essentially covers pre-recorded software video games, computer game instruction manuals and published guides, books and comics featuring works of fiction, toys including hand held units for electronic games and entertainment services consisting in providing an on-line computer game as well as providing information on-line relating to computer games and video games.

[26] The Opponent's relied upon trademark, on the other hand, is registered in association with the following goods:

Mobile phones; video telephones; set-top boxes; telephones for remote telephone conferencing; digital photo frames; computer software for video conferencing; batteries, namely, general purpose batteries and batteries for mobile phones; battery chargers; headphones; software in communication field, namely, computer software for managing, operating and maintaining video conferencing, computer software for data communication, namely, software to facilitate electronic transmission of text, email, graphics and video material among users of computers and mobile electronic devices, computer software for use in database management and network management, computer software for use as a spreadsheet and word processing; microphones.

[27] The Applicant submits that none of the Opponent's goods above are identical or similar to the goods and services covered by the application for the Mark. Although the Mark is applied

for in association with software goods, the Applicant submits that the Opponent's relied upon registration does not cover software similar to video game software or any software used, more largely, for entertainment purposes.

[28] I am in general agreement with the Applicant's submissions on this point. While there is a connection between the parties' goods to the extent that the trademarks at hand both cover software and electronic devices, it is apparent that the precise nature of the parties' goods and services is different (toys in the form of hand held units for electronic games and software video games versus telephones, digital photo frames, headphones, microphones and software for managing, operating and maintaining video conferencing, software for data communication, software for use in database management and network management, software for use as a spreadsheet and word processing). In the absence of any evidence of use filed by the parties, it is difficult to assess if there is similarity or overlap in the nature of their channels of trade.

Degree of resemblance

[29] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality and not dissected into their component parts. 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]. Nevertheless, in some cases, the first portion of a trademark may prove the most important for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[30] When considered as a whole, I find that the parties' trademarks are more different than alike. The marks resemble each other to the extent that the second component of the Mark comprises the entirety of the Opponent's trademark Honor. That said, there are visual, phonetic and conceptual differences between the marks seen as the Mark features stylization as well as a colour claim and is not similarly structured (given the additional word that it contains). The Applicant submits that adding "for" before "honor" not only visually and phonetically distinguishes the marks, but also adds meaning to the term "honor" by adding a notion of purpose and action which is lacking in the Opponent's trademark. I agree and would add that, in my view, it follows that the Mark connotes ideas of righteousness and justice (such as in actions taken in the name of honor or with one's honor at stake), whereas the Opponent's trademark

Honor suggests privilege, high regard and/or renown. Overall, I find that the differences between the trademarks in appearance and sound and particularly the differences in the ideas they suggest as a whole outweigh their similarities.

[31] Consequently, this factor favours the Applicant.

Conclusion on the likelihood of confusion

[32] Taking all of the above into consideration, particularly the differences between the trademarks at hand in terms of appearance, sound and suggested ideas, as well as those existing between the parties' goods and services, I find that the Applicant has met its onus to establish, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's trademark Honor.

[33] Accordingly, the section 12(1)(d) ground of opposition is rejected.

DISPOSITION

[34] Having regard to the foregoing, 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.

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

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For the Opponent

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For the Applicant