



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 096

Date of Decision: 2022-05-11

IN THE MATTER OF AN OPPOSITION

Caterpillar Inc.

Opponent

and

Ohmland Holdings, LLC

Applicant

1,743,698 for CARLIN

Application

CATERPILLAR

INTRODUCTION

[1] Caterpillar Inc. (the Opponent) opposes registration of the trademark CARLIN CATERPILLAR (the Mark), the subject of application No. 1,743,698 (the Application), applied for by Ohmland Holdings, LLC (the Applicant).

[2] Filed on August 27, 2015, the Application claims proposed use and use of the Mark in Canada in association with goods and services (the Goods and Services) as follows:

- (1) Toys and games, namely plush toys, doll figurines, plush dolls, educational toys, musical toys, children's multiple activity toys, electronic learning toys, board games, card games, educational games for children, toy musical instruments; souvenir programs; tote bags; children's clothing; children's dress up clothing; reusable plastic water bottles sold

empty; pre-recorded audio CDs featuring musical performances for children; pre-recorded DVDs containing audio and video recordings of children's shows

- (2) Activity cards for children printable from a website; posters; novelty stickers
- (3) Downloadable application software program for use with handheld mobile computers to audio sync users with a television program in real time to allow users to interactively participate in program
- (4) Downloadable digital audio recordings featuring musical performances for children

Services

- (1) Providing a website featuring recipes and instructions for play activities for children and featuring videos and webisodes of children's television program
- (2) Television entertainment services in the nature of a children's program
- (3) Entertainment in the form of live shows for children

Claims

- Used in CANADA since at least as early as December 22, 2014 on goods (2) and on services (2)
- Used in CANADA since at least as early as March 09, 2015 on goods (3)
- Used in CANADA since at least as early as June 20, 2015 on goods (4)
- Used in CANADA since at least as early as December 19, 2014 on services (1)
- Used in CANADA since at least as early as June 13, 2015 on services (3)
- Proposed Use in CANADA on goods (1)

[3] The Application was advertised in the *Trademarks Journal* of April 20, 2016.

[4] The Opponent alleges the following:

- (i) the application for the Mark does not conform to the requirements of section 30(b) of the Act;
- (ii) the Mark is not registrable for use in association with the Applicant's Goods and Services pursuant to section 12(1)(d) of the Act;
- (iii) the Applicant is not the person entitled to registration of the Applicant's Mark in association with Goods (2), (3), and (4) and all of the Applicant's Services, pursuant to section 16(1)(a);

- (iv) the Applicant is not the person entitled to registration of the Applicant's Mark in association with Goods (2), (3), and (4) and all of the Applicant's Services pursuant to section 16(1)(c);
- (v) the Applicant is not the person entitled to registration of the Applicant's Mark in association with Goods (1) pursuant to section 16(3)(a);
- (vi) the Applicant is not the person entitled to registration of the Applicant's Mark in association with Goods (1) pursuant to section 16(3)(c); and
- (vii) the Applicant's Mark, when used in association with the Applicant's Goods and Services, is not distinctive pursuant to section 2 of the Act.

[5] The majority of the grounds of opposition revolve around an allegation of confusion of the Applicant's Mark with one or more of the Opponent's registered and/or used trademarks, as well as the Opponent's trade names "Caterpillar" and "Caterpillar Inc.". Particulars of the Opponent's trademarks (the Opponent's Marks) relied upon have been included under Schedule A to this decision. More specifics regarding the Opponent's pleadings will be provided in the decision when necessary.

[6] For the reasons that follow, I refuse the application with respect to the Goods, but reject the opposition with respect to the Services.

THE RECORD

[7] The Opponent filed its statement of opposition on June 20, 2017. The Applicant filed and served its counter statement on August 14, 2017, denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavits of Kenneth J. Beaupre, sworn December 13, 2017, and Simon McCullough, sworn December 12, 2017. Neither affiant was cross-examined.

[9] In support of its application, the Applicant filed the affidavit of Seth A. Goldstein, sworn October 22, 2018. Mr. Goldstein was also not cross-examined.

[10] Only the Opponent filed written representations. An oral hearing was not requested.

ANALYSIS

Section 30(b) Ground of Opposition

[11] The Opponent has plead that the Application does not conform with the requirements of section 30(b) of the Act because the Mark:

- a) Has not been used by the Applicant in Canada since at least as early as the dates claimed in association with the Goods and Services; and
- b) Has not been used as a trademark by the Applicant within the meaning of sections 2 and 4 of the Act in Canada since at least as early as the dates claimed in association with the Goods and Services.

[12] The material date with respect to a ground of opposition based upon section 30(b) of the Act, is the filing date of the application; in this case, the application was filed on August 27, 2015 [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 at 296 (FCTD)].

[13] At the outset, I note that this ground does not apply to Goods (1), as the filing basis for those goods is proposed use in Canada. Thus, any reference to Goods and Services under this ground excludes Goods (1).

[14] Section 30(b) of the Act requires that there be continuous use of the applied-for trademark in the normal course of trade from the date claimed to the filing date of the application [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262]. While the legal burden is upon an applicant to show that its application complies with section 30 of the Act, there is an initial evidential burden on an opponent to establish the facts relied upon by it in support of its section 30 ground [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); and *John Labatt, supra*]. With respect to section 30(b) of the Act in particular, an opponent's initial burden has been characterized as light due to

an opponent's limited access to information regarding use relative to the applicant. While an opponent can meet its initial burden by reference to its own evidence, its burden can in some cases be met with reference to the applicant's evidence [*Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FCTD)].

[15] If an opponent succeeds in discharging its initial evidential burden, the applicant must then, in response, substantiate its claim of use during the material time. However, while an opponent is entitled to rely on the applicant's evidence, if any, to meet its evidential burden, the applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by an opponent meeting its evidential burden [see *Kingsley v Ironclad Games Corporation*, 2016 TMOB 19 at para 63].

[16] In the present case, the Opponent is mainly relying on the Applicant's evidence in order to meet its burden, but has included Internet search results for the Mark under its own evidence as well (per the McCullough affidavit).

[17] As previously indicated, the Applicant's evidence consists of the affidavit of Mr. Goldstein. In his affidavit, Mr. Goldstein provides information concerning the relationship between the Mark and the Applicant's children's television series, *The Moblees*. In this regard, in brief, Mr. Goldstein explains that the Mark is the name of a character that appears on *The Moblees* television series, and he provides evidence concerning the history of the television program, viewership, etc.

[18] Beginning with the second prong of the Opponent's pleading, the Opponent submits that the Applicant's evidence focuses on a different trademark entirely, namely, THE MOBLEES, and has sought to imply 'strength in the Mark' through use within the Applicant's television series, *The Moblees*.

[19] To illustrate, the Opponent points to the Goldstein affidavit, which indicates that "Carlin Caterpillar" is one of five lead characters in the Applicant's *The Moblees* television series, and wherein the affiant states that the Applicant is the owner of "the intellectual property rights in *The Moblees*, including the applied-for trademark CARLIN CATERPILLAR". The Opponent

submits that Mr. Goldstein's aforementioned statement inaccurately suggests that the Mark should benefit from any intellectual property rights in *The Moblees*.

[20] As a further example, the Opponent highlights another statement of Mr. Goldstein in his affidavit, that "[b]ased on my experience, I am of the view that the public associates the Applicant's *The Moblees* brand and the trademark CARLIN CATERPILLAR with the Applicant, and that these trademarks have become very well-known in Canada." Once again, the Opponent submits that the Applicant's trademark *The Moblees* is a separate trademark and irrelevant to this proceeding.

[21] The Opponent then continues its submissions by providing a summary of the Applicant's evidence, pinpointing examples wherein the evidence relates to *The Moblees* show, with the Applicant's Mark CARLIN CATERPILLAR having minimal mention within the evidence and as simply a character within a list of characters on the show.

[22] With respect to the first prong of the Opponent's pleading, in addition to further relying on the above-noted submissions, the Opponent goes through the Goldstein affidavit and gives examples of where such evidence fails to show use of CARLIN CATERPILLAR as a trademark in respect of a number of the applied-for goods and services. For example, the Opponent directs attention to images of *The Moblees*-branded clothing and a toy ball, none of which the Opponent submits bear the Mark, but rather display a cartoon drawing of a boy dressed as a caterpillar, without any wording (Goldstein affidavit, Exhibit 6). Another example is that of a screenshot of the description for *The Moblees* app, which does not mention CARLIN CATERPILLAR (Goldstein affidavit, Exhibit 2). The Opponent also refutes the Applicant's evidence regarding social media posts, and *The Moblees* videos/show viewership figures. In this regard, the Opponent submits that the Applicant's social media posts relate to *The Moblees* and not Carlin Caterpillar itself, and submits that they are not reliable given that they show insignificant numbers of user interactions, in their view. Further, the Opponent submits that with respect to the viewership figures for *The Moblees* videos/shows (which feature the Carlin Caterpillar character), the Applicant has failed to specify the breakdown of views by year and province and territory, and by unique visitors/individuals. For these reasons, the Opponent submits that the Applicant's evidence, at a minimum, puts compliance with section 30(b) of the Act into issue.

[23] In addition, the Opponent's submissions review of a number of Internet search results from its own evidence (per the McCullough affidavit) including, among others, searches for "the moblees", the Canadian Broadcasting Corporation's webpage for *The Moblees*, and of the Applicant's website. The Opponent that the Mark either did not appear, or was in the context of indicating "Carlin Caterpillar" is the name of a character on *The Moblees* TV show or program credits.

[24] As previously indicated, the Opponent's burden under a ground of opposition based upon section 30(b) of the Act is less onerous. However, I find the Opponent has failed to raise sufficient doubt as to the veracity of the Applicant's claimed dates of first use. While much of the Applicant's evidence relates to *The Moblees* television show, there is no evidence to support or cast doubt that the Mark was not used as a trademark in Canada pursuant to sections 2 and 4 of the Act. What the evidence does indicate is that the Applicant's Mark is inherently related to the trademark *The Moblees*, given that the Mark is the name of a character portrayed on the Applicant's *The Moblees* television show. Indeed, Mr. Goldstein states explicitly in his affidavit that "the applied-for trademark CARLIN CATERPILLAR relates directly to a character in a preschool children's entertainment program, namely, *The Moblees*" [para 2 of Goldstein affidavit].

[25] It is true that the merchandise featured in the Goldstein affidavit at Exhibit 6 (*i.e.* clothing, a hat and a ball), do not bear the Mark but instead display a cartoon drawing of a boy dressed as a caterpillar. However, Mr. Goldstein does not attest that this merchandise shows use of the Mark, but that the exhibit contains "representative photos of merchandise depicting *The Moblees*, including the Carlin Caterpillar character." Furthermore, the goods depicted in this exhibit appear to relate to Goods (1), which are not subject to this ground of opposition, being based upon proposed use.

[26] Having regard to the aforementioned, the section 30(b) ground of opposition is rejected, as the Opponent has failed to meet its burden under this ground of opposition.

Confusion Grounds

Section 12(1)(d) Ground of Opposition

[27] The Opponent pleads that the Applicant's Mark is not registrable for use in association with the Applicant's Goods and Services pursuant to section 12(1)(d) of the Act, because the use of the Mark would cause confusion with its CATERPILLAR Marks [per Schedule A – registration Nos. TMA167, 386 (CATERPILLAR), TMA896,405 (CATERPILLAR), and TMA382,235 (CATERPILLAR & Design)].

[28] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the discretion to check the register in order to confirm the existence of any registrations relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised the Registrar's discretion, I confirm that the Opponent's registrations relied upon under this ground of opposition are in good standing as of the date of this decision.

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

[30] For the reasons that follow, this ground of opposition is successful with respect to the Goods, but rejected with respect to the Services.

[31] 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.

[32] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

[33] In *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act [see para 49]:

...the degree of resemblance, although the last factor listed in s.6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start...

[34] Under the circumstances of the present case, I consider it appropriate to analyze the degree of resemblance between the parties' marks first.

[35] Furthermore, in considering the issue of confusion, I will primarily focus on the Opponent's CATERPILLAR trademark registration No. TMA896,405 as I consider this trademark to represent the Opponent's best chance of success, or at least an equivalent chance of success, in view of its associated registered goods (see Schedule A attached to this decision). If the Mark is not confusing with this trademark, it will not be confusing with any of the remaining trademarks relied upon by the Opponent.

Section 6(5)(e) – the degree of resemblance

[36] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality; it is not correct to lay them side by side and compare and observe

similarities or differences among the elements or components of the trade-marks. Furthermore, while the first portion of the trademark is usually the most important for the purpose of distinguishing [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d), 183 (FCTD)], the Supreme Court of Canada in *Masterpiece* has advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[37] The Opponent submits that although the Mark has a different first portion, it ends in “CATERPILLAR”, which is the entirety of, and the distinctive element of the parties’ trademarks. In my view, the word “CATERPILLAR” is the most striking element of the Mark, and the only and therefore dominant portion of the Opponent’s trademark. The word “CATERPILLAR” has no inherent meaning with respect to the goods and services of the parties. Furthermore, the Opponent submits that the term “Carlin” in the Mark, is a recognizable first name. Whether it is recognizable as a first or otherwise as a surname, I am of the view that the inclusion of an ordinary name preceding the term CATERPILLAR does not serve to diminish the dominance of the word CATERPILLAR; rather its inclusion would be understood as the name of the caterpillar. Thus, I find as a whole that the parties’ marks share a high degree of similarity in appearance and when sounded. Furthermore, both parties’ trademarks invoke the idea of a caterpillar, with the Mark possibly invoking the idea of particularly-named caterpillar.

[38] Accordingly, this factor favours the Opponent.

[39] Having found a high degree of similarity between the parties’ marks, I will now assess the remaining relevant surrounding circumstances to determine whether any of these other factors are significant enough to shift the balance of probabilities in favour of the Applicant [see *Masterpiece, supra* at para 49].

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

[40] Both parties’ trademarks have some degree of inherent distinctiveness in that they include words that have no direct relationship to their associated goods and services. However, I find

that the Mark is inherently stronger with the inclusion of CARLIN, which may be perceived as the name of the caterpillar.

[41] In any event, the strength of a trademark may be increased by means of it becoming known in Canada through promotion or use.

[42] I will begin with a brief review of the Applicant's evidence (the Goldstein affidavit) in this regard.

[43] As touched upon earlier, Mr. Goldstein explains that the Mark relates directly to a character in a preschool children's entertainment program, namely, *The Moblees*. He attests that this program was created to promote healthy, active living for kids aged 3 to 6 years old and their families, whether through its TV show, original stage musicals, concerts, or albums. He further explains that *The Moblees* series is led by a cast of five characters, one of which is Carlin Caterpillar.

[44] Mr. Goldstein states the Carlin Caterpillar character appears in every single episode of *The Moblees* television series, a consistently top-rated show on CBC Kids, including reaching the number one spot within the first six weeks of its premiere. He states that approximately 3.5 million Canadians tune in, with an average weekly viewing of 355,000 in the first nine months after the premiere.

[45] Mr. Goldstein explains that *The Moblees* musical television series debuted in Canada on December 22, 2014 and the series is comprised of fifty, 11-minute episodes that air on the CBC at 8:40 am on weekdays and 11am on Saturdays. To date, he attests, the series has reached over 10 million views on television. He states that the series is also available for online streaming through the CBC app and YouTube platforms on which the series has reached over 2 million views. He attests that *The Moblees* series has received significant industry recognition, and provides a list of numerous industry award nominations for the program between the years 2015 to 2017.

[46] In addition to the television program, Mr. Goldstein attests that *The Moblees* is also available through an award-winning mobile application, having received both an award and nomination in 2016. He explains that this application places the viewer directly inside the setting

of *The Moblees*, performing activities in real-time alongside *The Moblees* characters, including Carlin Caterpillar.

[47] Mr. Goldstein attests that *The Moblees* are also involved in music, theatrical and live performances, wherein the characters, including Carlin Caterpillar, performed at numerous events in Canada between 2014 and 2018, including character meet-and-greets. He attests that *The Moblees* performances have been seen by over 85,000 Canadians in four provinces, with audiences of over 50,000 in the summer of 2015. He also attests that *The Moblees* released a JUNO Award-winning album in 2017, attaching as Exhibit 3, a printout from the JUNO Awards website which includes a description of the album that features *The Moblees* cast, including reference to Carlin Caterpillar.

[48] Lastly, Mr. Goldstein provides details regarding the Applicant's advertising and promotion of the Mark. Specifically, he attests that the Applicant maintains an active social media presence for *The Moblees*, with over 5 million social impressions. In support, he provides the following:

Exhibit 4 – a selection of Facebook posts featuring the Carlin Caterpillar character and the Mark.

Exhibit 5 – representative examples of Instagram posts featuring the Carlin Caterpillar character and the Mark.

Exhibit 6 – representative photos of merchandise depicting *The Moblees*, including the Carlin Caterpillar character.

Exhibit 7 – screenshots of television appearances and a selection of articles about *The Moblees*, including one specifically about Carlin Caterpillar.

Exhibit 8 – a copy of a research paper on the efficacy of *The Moblees* curriculum, published in the journal *Frontiers in Public Health* on July 25, 2018, with reference to Carlin Caterpillar.

Exhibit 9 – a YouTube screenshot playlist of *The Moblees Move* videos, which he attests have now reached over 100,000 views.

Exhibit 10 – a YouTube screenshot of a public service announcement video centering on *The Moblees* brand, including Carlin Caterpillar, created in partnership with ParticipACTION, and having reached over 550,000 views.

[49] Having regard to the foregoing, and that the Mark is linked to *The Moblees* television program, I accept that the Mark has acquired some distinctiveness since *The Moblees* television program series debut in December of 2014. This acquired distinctiveness, however, is limited to goods and services related to the Applicant's *The Moblees* mobile application, music, live performances, and television program, of which Carlin Caterpillar has become known as a character. These goods and services would appear to encompass CDs and DVDs (from Goods (1)), Goods (3) and (4), as well as Services (1), (2), and (3). While the Goldstein affidavit evidences some clothing goods (per Goods (1)) related to *The Moblees* characters, the Mark itself was not displayed on such goods.

[50] The Opponent on the other hand, has provided evidence of significant use of its trademark CATERPILLAR over a much lengthier period of time, through the Beaupre and McCullough affidavits.

[51] In his affidavit, Mr. Beaupre describes the Opponent as the world's leading manufacturer of a wide variety of construction, mining, agriculture and forestry equipment and related equipment. Serving customers in over 190 countries including Canada, Mr. Beaupre states, the Opponent is also engaged in the sale and distribution of such goods (para 7).

[52] More pertinent with respect to the present proceedings, however, Mr. Beaupre explains that an important part of the Opponent's global business is the licensing of the Opponent's branded merchandise, or "soft goods" (the Opponent's merchandise). These goods, he explains, include clothing and apparel, bags and luggage, footwear, caps and hats, toys, models and games, books, stationery and the like, that bear the Opponent's CATERPILLAR Marks (para 8). The bulk of Mr. Beaupre's evidence focuses on these goods, which I note are collectively encompassed by the Opponent's various relied-upon trademark registrations.

[53] Mr. Beaupre attests that the Opponent has developed and continues to develop, a family of CATERPILLAR trademarks that the Opponent and/or its licensees use in association with the Opponent's licensed merchandise business. He provides a chart (para 12) detailing the Opponent's "CATERPILLAR Marks" and attaches particulars of those trademarks under Exhibits A-1 to A-3. These are the three trademark registrations relied upon under this ground of opposition. He states that the Opponent has continuously used itself and/or through its licensees,

the trademarks identified under these exhibits in association with the registered goods (the Caterpillar Goods), since at least as early as the dates noted in the chart at paragraph 12 of his affidavit.

[54] In addition to the above-noted trademarks, Mr. Beaupre attests that the Opponent has also used the tradename CATERPILLAR in Canada since approximately 1925 in association with the Opponent's heavy equipment business as well as with the Opponent's licensed merchandise business. While the evidence does not date back that far, I do note that the Opponent's trade names "Caterpillar" and "Caterpillar Inc." appear throughout much of the evidence in association with the Opponent's licensed merchandise.

[55] Mr. Beaupre explains that the Opponent has a number of licensees, known as trademark merchandise licensees, that are licensed to produce, market and sell merchandise bearing the Opponent's trademarks, including the CATERPILLAR Marks. Mr. Beaupre confirms that the Opponent exercises control over the quality and character of the Caterpillar trademark merchandise that the licensees produce (paras 18 to 22).

[56] With respect to notice of association with goods, Mr. Beaupre states that the CATERPILLAR Marks have been prominently marked and displayed on licensed merchandise that have been sold and distributed in Canada, including on the Caterpillar Goods, and/or on the packaging for such merchandise. He attaches, as Exhibits F1 to F51, excerpts of product catalogues published by the Opponent's trademark merchandise licensees that are licensed for Canada (para 29). These date from 1997 to 2018, and include the depictions of the following goods: a variety of children's apparel, a variety of men's and ladies' apparel, headwear, accessories (*e.g.*, watches, glasses, keychains), toys, bags, water bottles and glassware, videos (DVD and VHS), and books. The Opponent's CATERPILLAR Marks can be clearly seen marked on the products. The context of all of the merchandise appears to be heavy equipment, as related to the Opponent's core business of heavy industrial construction, mining, agriculture and forestry equipment. Mr. Beaupre states that these catalogues show the variety of different Caterpillar trademark merchandise that were offered for sale in Canada at the applicable times, including the Caterpillar Goods, and are representative of the wide range of trademark merchandise that have been sold and distributed in Canada in the past. He further states that, in

addition, the images of the products shown in these catalogues are examples of the ways in which the CATERPILLAR Marks have been displayed on such merchandise that have been sold and distributed in Canada over the years (para 30). He confirms that these catalogues were distributed by the trademark merchandise licensees to customers and potential customers (which include distributors, retailers and Caterpillar dealers) in Canada via online download requests for mail or electronic delivery.

[57] Mr. Beaupre further states that he has reviewed the affidavit of the Opponent's other deponent, Mr. McCullough, and attests that the uses shown in that affidavit are representative of how the CATERPILLAR Marks have been displayed on the Caterpillar Goods that have been sold and distributed in Canada over the years. I will briefly summarize Mr. McCullough's evidence in due course.

[58] Mr. Beaupre explains that there are two types of sales that a Caterpillar trademark merchandise licensee could be licensed for: "promotional sales" (meaning sales to the Opponent's divisions and employees, subsidiaries and dealers) and "retail sales" (meaning sales to the general public excluding promotional sales).

[59] Mr. Beaupre provides two charts listing such licensees in association with specific licensed goods (paras 35 and 36). The licensed goods noted in these charts include: apparel and headwear, books, bags, decals, scale models and kits, plastic toys, puzzles, battery operated and remote controlled toy vehicles and scale models, train sets and cars, swingsets, children's videos and DVDs, and mobile game applications.

[60] In addition, Mr. Beaupre provides evidence with respect specifically to mobile game apps. In this regard, Mr. Beaupre explains in his affidavit that, to users in Canada, a publisher named Astragon has been distributing two mobile app games that allow such users to build their own construction company and work on simulated construction projects using a variety of construction vehicles from real life, including Caterpillar's vehicles. Mr. Beaupre provides data on the number of downloads of the apps in Canada (>15,000). The CATERPILLAR trademark appears in the description for the app in the Google Play and Apple app stores.

[61] Mr. Beaupre states that the majority of the promotional sales made by licensees are made to the Opponent's Canadian dealers, who then re-sell the merchandise to the general public as part of their business. He provides a list of four of the Opponent's Canadian dealers (para 38), and states that all Canadian dealers are required to purchase Caterpillar merchandise directly and only from the Opponent's licensees that are licensed for Canada. He attests that three of these dealers specifically have been operating websites to re-sell Caterpillar merchandise to Canadian consumers, and that these dealers have also been re-selling to Canadian consumers at their dealer locations in Canada (para 42 – info re: dealers and websites, and Exhibits G, H, and I – screenshots from those sites). With respect specifically to toys and scale models, Mr. Beaupre provides a long list of who he attests are the top retail accounts or retail chains in Canada to which Caterpillar's licensees sell such merchandise (para 46).

[62] Mr. Beaupre states that in 2011, 2013 and 2016, worldwide sales of the Opponent's merchandise were in excess of USD \$1.1 billion, \$1.7 billion and \$2.8 billion respectively, with sales in Canada accounting for approximately 1 to 5% of worldwide sales (para 9). He provides approximate sales of the CATERPILLAR Goods in Canada with respect to the various trademark merchandise licensees of the Opponent, with sales figures for various years from 2006 to 2017 in both units and dollar amounts. Exhibits J to Q of his affidavit include royalty reports submitted by various licensees to the Opponent for sales of Caterpillar licensed merchandise, and sample invoices issued by various licensees for the sale of Caterpillar licensed merchandise to customers in Canada, again, all ranging from 2006 to 2017. Lastly, he also provides a table listing the number of orders and approximate sales made to customers located in Canada for "soft goods", including the Caterpillar Goods, via the *shopcaterpillar.com* website (covering the years 2010 to 2017, ranging from \$14,000 to over \$53,000 and 225 orders to 1981) (para 55).

[63] Mr. McCullough's evidence details various purchases he made of CATERPILLAR-branded products from websites and retail stores, including screenshots of product searches, orders and payment details, emails, invoices, packing slips, and photographs of purchased merchandise, including the packaging for, or hangtags and labels on the products as applicable. These purchases, orders, and/or deliveries were made in November 2017. The retailers and websites at which Mr. McCullough made such purchases included *shopcaterpillar.com*, *catmerchandise.com*, *boutiquecat.ca*, *heavydutygear.ca*, *Walmart.ca*, *toysrus.ca*, Toys 'R' Us

retail locations (in Mississauga), Mastermind Toys (*mastermindtoys.com*), Canadian Tire (*canadiantire.ca*), and Home Hardware (*homehardware.ca*).

[64] The Caterpillar merchandise noted in Mr. McCullough's purchases included: various men's, women's and children's apparel and accessories, footwear, and headwear; a variety of children's toys (including model kits, die cast toys, games, train sets, construction vehicle toy sets, accessories and models), decals, bags, golf items and drinkware, books, and DVDs. The various CATERPILLAR Marks can be clearly seen on the goods.

[65] In view of the above, I accept that the Opponent's CATERPILLAR trademark, registration No. TMA896,405, has acquired distinctiveness and become known to an extent in association with the Opponent's merchandise, which includes among other goods, various toys, apparel, books, etc. I also accept that the Opponent's CATERPILLAR Marks have become known in association with many of the other registered goods set out in registration Nos. TMA167,386 and TMA382,235, as those registrations encompass the registered goods in registration No. TMA896,405.

[66] Accordingly, this ground favours the Opponent with respect to goods. However, the Opponent's evidence does not refer to any services.

Section 6(5)(b) – the length of time of use

[67] As noted above, the Opponent has provided extensive evidence of use of its CATERPILLAR trademark registration No. TMA896,405 in association with goods over a much lengthier period of time than the Applicant's use of the Mark.

[68] This factor thus also favours the Opponent with respect to goods.

Section 6(5)(c) and (d) – the nature of the goods and services and channels of trade

[69] 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 [see *Henkel*

Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[70] The trademarks of both parties are associated with various toys, books and games, clothing and related articles, tote bags, various beverageware items, DVDs, and mobile game apps. Consequently, there is considerable overlap in these goods. The remainder of the Opponent's goods however, are largely of an industrial nature and, in my view, have no relationship to the Applicant's Goods or Services.

[71] The Opponent submits that there is clearly a direct overlap between the Applicant's Goods and Services and the Caterpillar Goods, and both parties' businesses relate to the sale and distribution of such goods. Further to this, the Opponent submits that not only do the goods and services of the parties directly overlap, but so too do the customers to whom the parties' goods and services are directed. In this regard, the Opponent submits that both the Applicant's Goods and Services and the Opponent's Caterpillar Goods are generally for use by children and are sold in the same channels of trade, including online and bricks and mortar department and children's stores. As an example, the Opponent points to a licensee that had over \$2.4 million USD worth of sales between 2015 and 2017 to Toys R Us Canada and Canadian Tire [per Beaupre affidavit, para 47(c)].

[72] While there is undoubtedly overlap in the goods of the Applicant with the goods of Opponent, and potential overlap with the channels of trade, the nature of the parties' businesses is different. In this regard, the Opponent's core business is with respect to heavy equipment as related to industrial construction, mining, agriculture and forestry equipment. The Opponent's licensing of Caterpillar merchandise relates to this core business – *i.e.* – among other examples, the Opponent's toys are in the nature of toy construction trucks, and clothing items are work-wear related or in many cases include other indicia that relate back to the Opponent's core business. The Applicant's Goods and Services, on the other hand, are all in relation to a children's television program intended to promote healthy, active living for kids aged 3 to 6 years old and their families, whether through its TV show, original stage musicals, concerts, or albums.

[73] Ultimately, 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 Caterpillar Goods have also been sold in retail stores, I find that the parties' channels of trade could overlap.

[74] On the other hand though, I arrive at a different conclusion with respect to the Services. In this regard, I find no overlap. The Services, although also geared towards children, are in an entirely different area; they relate to a children's television program and live performances in nature of musical and theatrical productions designed to encourage healthy and active living in preschool-aged children. The Opponent's registered services have no overlap, being of an industrial nature, and the Opponent's goods have no relationship to children's television programs and live musical and theatrical productions.

[75] Having regard to the aforementioned, I find these factors favour the Opponent, but with respect to goods only.

Conclusion

[76] The degree of resemblance factor set out in section 6(5)(e) of the Act is often likely to have the greatest effect in deciding the issue of confusion and, in this case, favours the Opponent.

[77] Furthermore, while the evidence shows that both parties' trademarks are somewhat inherently distinctive, the Opponent's CATERPILLAR Marks have acquired a substantial reputation in association with the CATERPILLAR merchandise, including among other goods, toys and clothing, books, games, bags, DVDs, and mobile game apps. In my view, the Applicant has not adopted a mark that is sufficiently different from the Opponent's CATERPILLAR Marks to be used in association with the same and/or similar goods, which travel through the same channels of trade, notwithstanding the nature of the parties' businesses are different. In any event, the presence of the onus on the Applicant means that if a determinate conclusion cannot be reached, then the issue must be decided against the Applicant [see *John Labatt, supra*]. Having considered all of the relevant factors, I conclude that the probabilities regarding confusion, are at best, equally balanced. The section 12(1)(d) ground therefore succeeds with respect to the Goods, but is rejected with respect to the Services. I reach the same conclusion

with respect to the Opponent's relied-upon registrations TMA167,386 and TMA382,235 for the same reasons as above.

Non-entitlement Grounds

Sections 16(1)(a) and 16(1)(c)

[78] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark in association with Goods (2), (3), and (4) and all of the Services pursuant to section 16(1)(a) of the Act, since on the various alleged dates of first use the Mark it was confusing with the Opponent's CATERPILLAR Marks, which have been previously used and/or made known in Canada by the Opponent [per Schedule A – registration Nos. TMA167, 386 (CATERPILLAR), TMA896,405 (CATERPILLAR), and TMA382,235 (CATERPILLAR & Design)].

[79] The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark in association with Goods (2), (3), and (4) and all of the Services pursuant to section 16(1)(c) of the Act, since on the various alleged dates of first use of the Mark it was confusing with the Opponent's Caterpillar tradenames ("Caterpillar" and "Caterpillar Inc.") which have been previously used in Canada by the Opponent.

[80] With respect to the ground of opposition based on section 16(1)(a) of the Act, the Opponent has an initial burden of establishing that the trademarks alleged in support of this ground of opposition were used or made known prior to the Applicant's claimed date(s) of first use [that is, December 22, 2104 for Goods (2) and Services (2), March 9, 2015 for Goods (3), June 20, 2015 for Goods (4), December 19, 2014 for Services (1) and June 13, 2015 for Services (3)] and were not abandoned at the date of advertisement of the application for the Mark (April 20, 2016) [section 16(5) of the Act].

[81] Similarly with respect to the ground of opposition based on section 16(1)(c) of the Act, the Opponent must show that one or more of its trade names had been used in Canada prior to the claimed date(s) of first use of the Mark (see dates in preceding paragraph). The Opponent must also demonstrate that it had not abandoned its trade name(s) at the date of advertisement of the Mark (April 20, 2016) [section 16(5) of the Act].

[82] Having regard to the foregoing, and also to the Opponent's evidence summarized in the ground of opposition based on section 12(1)(d) of the Act, I accept that the Opponent has met its burden under these grounds.

[83] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with any of the Opponent's CATERPILLAR Marks and/or trade names.

[84] The difference in material date under this ground of opposition does not affect my ultimate conclusion regarding confusion between the parties' trademarks. As such, my findings under the ground of opposition based on section 12(1)(d) of the Act are equally applicable and also extend to the Opponent's trade names for the same reasons.

[85] Consequently, these grounds of opposition are successful with respect to Goods (2), (3), and (4); however, the grounds are rejected with respect to the Services.

Sections 16(3)(a) and 16(3)(c)

[86] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark in association with Goods (1) pursuant to section 16(3)(a) of the Act, since on the date of filing of the application (namely, August 27, 2015), the Mark was confusing with the Opponent's CATERPILLAR Marks, which have been previously used and/or made known in Canada by the Opponent [per Schedule A – registration Nos. TMA167, 386 (CATERPILLAR), TMA896,405 (CATERPILLAR), and TMA382,235 (CATERPILLAR & Design)].

[87] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark in association with Goods (1) pursuant to section 16(3)(c) of the Act, since on the date of filing of the application (namely, August 27, 2015), the Mark was confusing with the Opponent's trade names ("Caterpillar" and "Caterpillar Inc"), which have been previously used and/or made known in Canada by the Opponent.

[88] In order to meet its initial burden under section 16(3)(a) of the Act, the Opponent must show that the trademarks alleged in support of this ground of opposition was used or made known in Canada prior to the date of filing of the application for the Mark (August 27, 2015) and

had not been abandoned at the date of advertisement of the application for the Mark (April 20, 2016) [section 16(5) of the Act].

[89] Similarly, in order to meet its initial burden under section 16(3)(c) of the Act, the Opponent must show that its trade names were used in Canada prior to the date of filing of the application for the Mark (August 27, 2015) and had not been abandoned at the date of advertisement of the application for the Mark (April 20, 2016) [section 16(5) of the Act].

[90] As previously indicated, these grounds of opposition only apply to Goods (1), being the only Goods applied-for on the basis of proposed use in Canada.

[91] Having regard to the Opponent's evidence summarized in the ground of opposition based on section 12(1)(d) of the Act, I accept that the Opponent has met its burden under these grounds.

[92] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with any of the Opponent's CATERPILLAR Marks and/or trade names.

[93] The difference in material date under this ground of opposition does not affect my ultimate conclusion regarding confusion between the parties' trademarks. As such, my findings under the grounds of opposition based on sections 12(1)(d) of the Act are also equally applicable and extend to the Opponent's trade names (as in the section 16(1)(c) ground) for the same reasons.

[94] Consequently, these grounds of opposition are successful with respect to Goods (1); however, the grounds are rejected with respect to the Services as was held in the section 12(1)(d), 16(1)(a), and 16(1)(c) grounds.

Section 2 Ground of Opposition

[95] The Opponent pleads that by reason of the use of its CATERPILLAR Marks and the CATERPILLAR trade names in Canada, the Mark, when used in association with the Applicant's Goods and Services, is not distinctive within the meaning of section 2 of the Act;

this being so, since it neither distinguishes nor is adapted to distinguish the Applicant's Goods and Services from the CATERPILLAR Goods.

[96] In order to meet its initial burden under this ground of opposition, the Opponent must establish that one or more of its pleaded trademark(s) and/or trade name(s) had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Applicant's Mark [see *Bojangles International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) and *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)].

[97] I am satisfied that the Opponent has met its initial evidential burden in view of the evidence of use of its CATERPILLAR Marks and trade names (as detailed in the section 12(1)(d) ground of opposition) prior to the material date for this ground, namely, June 20, 2017 [see *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) for a discussion of an opponent's initial evidential burden under section 2]. As this ground ultimately turns on the issue of confusion between the Mark and the Opponent's CATERPILLAR Marks and trade names, I come to the same conclusion as above for the section 12(1)(d) and non-entitlement grounds, notwithstanding the different material date for the section 2 ground. The section 2 ground of opposition therefore succeeds, but once again, with respect to the Goods only.

DISPOSITION

[98] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to all of the Goods, but reject the opposition with respect to all of the Services, pursuant to section 38(12) of the Act [see *Produits Menagers Coronet v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Trademarks plead under sections 12(1)(d), 16(1)(a) and 16(3)(a) of the Act (collectively, the CATERPILLAR Marks):

<u>Trademark</u>	<u>Goods and/or Services</u>
<p>CATERPILLAR (TMA167,386) Registration date: 1970-01-16</p>	<p><i>Goods</i></p> <p>(1) Toys, namely miniature replicas of earthmoving and material handling equipment.</p>
<p>CATERPILLAR (TMA896,405) Registration date: 2015-02-12</p>	<p><i>Goods</i></p> <p>(1) Greases, lubricants and oils for land vehicles; greases, lubricants and oils for engines; industrial greases, lubricants and oils; 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.</p> <p>(2) 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</p>

	<p>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, namely (1) 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, (2) 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 (3) 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; 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</p>
--	----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

	<p>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.</p> <p>(3) Computer game disks; video games; bicycles; 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; puzzles and toy vehicles.</p> <p><i>Services</i></p> <p>(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 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 records 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 seminar 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</p> <p>(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;</p>
--	-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

	design of computerized information systems for managing logistics and product distribution processes for others
<p>CATERPILLAR</p> <p>(TMA382,235)</p> <p>Registration date: 1991-03-29</p>	<p><i>Goods</i></p> <p>(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 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,</p>

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 materials 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, 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 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 records 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 seminar 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
--	--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

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

HEARING DATE: No hearing held

AGENTS OF RECORD

Osler, Hoskin, & Harcourt LLP

For the Opponent

Smart & Biggar LLP

For the Applicant