



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 064

**Date of Decision:** 2023-03-31

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Max-Quip Inc.

**Applicant:** JLG Industries, Inc.

**Application:** 1,779,991 for MAXQUIP

### **INTRODUCTION**

[1] Max-Quip Inc. (the Opponent) opposes registration of the trademark MAXQUIP (the Mark) filed by JLG Industries, Inc. (the Applicant).

[2] The application was filed on April 29, 2016, for use in association with the following Goods, together with the associated Nice classes (CI). The application claims a priority filing date of January 29, 2016 and is based on proposed use of the Goods in Canada.

CI 7 (1) Parts, fittings, attachments and accessories for construction machines and equipment, earth moving machines and equipment, industrial machines and equipment, agricultural machines and equipment, loaders, hoists and hoisting equipment, lifting equipment, aerial lift platforms, personnel lifts, vertical lifts, boom lifts, scissor lifts, trailer lifts, stock pickers, cranes and telehandlers, namely, axles, bearings, brakes and brake parts, cables and cable parts, couplings, vehicle engine valve covers, engine parts, filters for motors and engines, tractor-towed forks, electricity generators, speed governors, hydraulic hoses of rubber and of plastic, gas

hose, radiator hose, air vent hose, air hose, boom hose, vacuum hose, fuel hose, brake hose, telehandler cab enclosures, motors not for land vehicles and parts and accessories therefor, elevating work platforms, elevating and lift platforms and parts therefor, vacuum pumps, mechanical seals, seal kits comprised primarily of mechanical seals, switches, pressure switches, tools namely metalworking machine tools and power tools, power-operated tools, valves, anti-friction wear pads, welding machines including saws and cutters, electrodes for welding machines, electric welding machines

CI 9 (2) Parts, fittings, attachments and accessories for construction machines and equipment, earth moving machines and equipment, industrial machines and equipment, agricultural machines and equipment, loaders, hoists and hoisting equipment, lifting equipment, aerial lift platforms, personnel lifts, vertical lifts, boom lifts, scissor lifts, trailer lifts, stock pickers, cranes and telehandlers, trailers, utility trailers, drop deck trailers, enclosed trailers and cargo trailers, vehicles, trucks, forklifts, lift trucks and fork lift trucks, namely, battery chargers, circuit breakers, electric connectors, electric contactors, electric control boxes, fuses, computer hardware, electric sensors, electric switches, electric toggle switches, burglar alarms, security and antitheft alarms, electronic warning horns, electrical controller parts, electrical controller, electrical components in the nature of protection relays, engine parts, filters for motors and engines, tractor-towed forks, fuses, electricity generators, speed governors, printed circuit boards (pcbs), regulators, electric relays, electric sensors, electric switches, fuel gauges, vacuum gauges, pressure gauges, mechanical and vehicle wheel hubs

CI 11 (3) Parts, fittings, attachments and accessories for construction machines and equipment, earth moving machines and equipment, industrial machines and equipment, agricultural machines and equipment, loaders, hoists and hoisting equipment, lifting equipment, aerial lift platforms, personnel lifts, vertical lifts, boom lifts, scissor lifts, trailer lifts, stock pickers, cranes and telehandlers, trailers, utility trailers, drop deck trailers, enclosed trailers and cargo trailers, vehicles, trucks, forklifts, lift trucks and fork lift trucks, namely, utility lights namely portable utility lights in the nature of portable work lamps, floodlights, spot lights and light bars, machine lights namely light used for attachments and mounting on industrial machinery to enhance visibility, vehicle lights and accessories therefor

CI 12 (4) Parts, fittings, attachments and accessories for trailers, utility trailers, drop deck trailers, enclosed trailers and cargo trailers, namely, vehicle alarms, vehicle security and antitheft alarms, vehicle backup alarms, vehicle horns, axles, bearings, brakes and brake parts, brake cables and cable parts, engines for land vehicles, engine parts for land vehicles, forks for trucks, telehandlers and lifting equipment, connecting rods for land vehicles other than parts of motors and engines, power steering hoses, hubs and hub assemblies for vehicle and trailer wheels, cab enclosures, motors for land vehicles and parts and accessories therefor, power steering hoses and air brake hoses, motors for land vehicles and parts and accessories therefor, vehicle wheel hub and tire assemblies

[3] The application was advertised in the *Trademarks Journal* of August 21, 2019. On October 17, 2019, the Opponent filed a statement of opposition pursuant to section 38 of the

*Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to the Act came into force on June 17, 2019. As the application in this case was advertised after June 17, 2019, the Act as amended applies [section 69.1 of the Act].

[4] The Opponent raises grounds of opposition based on non-entitlement under sections 16(1)(a) and (c) and non-distinctiveness under section 2 of the Act.

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

### **THE RECORD**

[6] In support of its opposition, the Opponent filed the affidavit of Cameron Stewart, its President and Chief Executive Officer. In support of its application, the Applicant filed the declaration of Sally Hooper, its Senior Manager – Marketing Communications. Ms. Hooper was cross-examined on her affidavit. The Opponent filed evidence in reply by way of the affidavit of Cameron Stewart. The Applicant objected to the admissibility of the evidence. On November 22, 2022, I ruled that the affidavit of Mr. Stewart was proper reply evidence. Mr. Stewart was cross-examined on his evidence and while the Registrar’s cross-examination order was specific to Mr. Stewart’s reply evidence, questions regarding both of his affidavits were asked and answered.

[7] Both parties filed written representations and were represented at a hearing.

### **EACH PARTY’S RESPECTIVE BURDEN OR ONUS**

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

### **ANALYSIS**

#### ***Section 16(1)(c) Ground of Opposition***

[9] I will first begin with the section 16(1)(c) ground of opposition.

[10] The Opponent alleges that pursuant to section 16(1)(c) of the Act, that the Applicant is not the person entitled to registration of the Mark as it was, at the priority filing date, confusing

within the meaning of Section 6 of the Act with the Opponent's trade names MAXQUIP and MAX-QUIP INC. used in Canada by the Opponent "in the provision of goods and services including those goods and services of the Opponent's Trade-marks". The goods and services for which use was claimed with respect to the Opponent's trademarks in the section 16(1)(a) ground of opposition are set out at Schedule A.

[11] The Opponent has an initial evidential burden of establishing that one of its trade names alleged in support of this ground of opposition was used prior to the earlier of the priority filing date of the application, namely, January 29, 2016, or the date of first use of the Mark in Canada, and was not abandoned at the date of advertisement of the application (in this case, August 21, 2019) [section 16(3) of the Act]. As the Applicant's evidence is that it commenced use after the priority filing date (Ms. Hooper's affidavit, para 9), the priority filing date is the material date.

#### Scope of the pleading

[12] After evidence is filed, the Registrar considers the pleadings with regard to the evidence [*Novopharm Ltd v Astrazeneca AB*, 2002 FCA 387]. Here, the pleading covers "the provision of goods and services including those goods and services of the Opponent's trademarks and which trade names have not been abandoned by the Opponent". As such, the Opponent is not limited to the goods and services in Schedule A and may rely on the use of its trade names in association with other goods and services so long as this is supported by the evidence.

[13] A trade name, as defined in section 2 of the Act, is the name under which a business is carried on. Accordingly, an opponent relying on prior use of a trade name must demonstrate its use in the normal course of a functioning business and in relation to the class or classes of persons with whom such business is to be conducted [*Mr Goodwrench Inc v General Motors Corp* (1994), 55 CPR (3d) 508 (FCTD)]. In accordance with the principles of section 4 of the Act, the display of a trade name in the performance or advertising of services available in Canada will suffice [*Carbon Trust v Pacific Carbon Trust*, 2013 FC 946, at para 68]. Further, section 16 of the Act does not require that an opponent prove a certain level of use or reputation. If an opponent demonstrates that its use meets the requirements of section 4 of the Act, that such use occurred prior to the material date, and that its trade name was not abandoned at the date of advertisement of an applicant's application, an opponent will have met its initial evidential burden. This is the case even if that proof is limited to a single sale or single event, so long as it is in the normal course of trade [see by analogy the following cases related to challenges based

on an opponent's trademark *7666705 Canada Inc v 9301-7671 Québec Inc*, 2015 TMOB 150; *Olive Me Inc, et al v 1887150 Ontario Inc*, 2020 TMOB 26].

### Opponent evidences use of its trade name

[14] Mr. Stewart explains that the Opponent is a distributor of equipment for the storage, transfer, process, application and measurement of compressed gasses, along with distributing equipment to the alternative fuels industry. The Opponent supplies, parts, components and systems for propane distribution, the agricultural sector and oil and natural gas field facilities, and alternative fuel systems for a large variety of vehicles (para 4). At Exhibit K to Mr. Stewart's affidavit is a copy of part of a presentation given by the Opponent describing its First-in-Class Technologies as being suitable for a variety of fuel-injected vehicles (Exhibit K). Furthermore, advertisements for the products the Opponent distributes include the Prins brand which are fuel systems for trucks and automobiles (Qs 82-83).

[15] The trade name is used in the following ways in association with the advertising and performance of the Opponent's services:

[16] Advertisements – Mr. Stewart provides advertisements in the trade magazines Propane Canada and Energized which include the trade name MAXQUIP. At least one advertisement, shown below, advertises the Opponent's business as “supplying and servicing your propane equipment needs” (Exhibit D).



[17] Directory Listings – Mr. Stewart provides directory listings for the Opponent in Propane Canada under its trade name MAXQUIP such as the one set out below which references a variety of equipment (Exhibit J):

**MAXQUIP**

ADDRESS: 6235A 86 Avenue SE,

Calgary, AB T2C 2S4

PH: (403) 258-3685 / 1-866-MAXQUIP (629-7847)

FAX: (403) 279-3099

WEBSITE: www.maxquip.ca

E-MAIL: sales@maxquip.ca

OFFICERS: Cameron Stewart - President

MARKETING/SALES MANAGER:

Dan Giasson - Business Development Manager

BRANCHES/PLANTS: Calgary, AB -

Wayne Gustafson 1-866-629-7847;

Edmonton, AB - Bruce Osborne 1-800-661-7770;

Surrey, BC - Willie Stephen 1-877-574-3835;

Saskatoon, SK - Lance Hartman 1-800-667-5886;

Montreal, QC - Michel Gaulin 1-877-629-7847;

Winnipeg, MB - Dave Neufeld (204) 770-2667;

Oakville, ON - Garnet Fox (905) 339-2948

AFFILIATED/SUBSIDIARY COMPANIES:

Galaxy Gas Products

INDUSTRY CATEGORY: Equipment Distributor,

Carburetion/Conversion, Manufacturer

PRODUCTS PRODUCED/MARKETED/SERVICES:

Alternative Fuel Conversion Systems, Cylinders

&amp; Tanks, Gauges, Regulators &amp; Valves, Pumps &amp;

Compressors, Vapourizers, Meters &amp; Registers,

Hose Reels, Hose &amp; Fittings, Falk Lights, Heaters

OTHER SERVICES OFFERED: Repair of Pumps,

Compressors &amp; Meters

[18] Invoices – Mr. Stewart provides sample invoices which include the Opponent’s trade name MAXQUIP INC. distributed from 2010 onwards (Exhibit L). Given Mr. Stewart’s use of “sample” to describe the invoices, I infer that the invoices distributed by the Opponent at the material date would have included the trade name. In his reply evidence, Mr. Stewart states that the display of the trade name on the sample invoices was similar to the invoices provided to United Rentals prior to the material date for which the Opponent had over \$40,000 sales for its rental equipment which uses propane as a fuel source (reply evidence, paras 3, 5, 10). Mr. Stewart identifies the following equipment as being sold to United Rentals: adapters, couplings, hoses, seal kits, maintenance kits, and valves (including service valves, evacuation valves and relief valves), propane cylinders, fill connectors, and level gauges (para 3).

[19] Mr. Stewart’s evidence shows use of the trade name in association with the following services: distribution of equipment for the storage, transfer, process, application and measurement of compressed gasses, distributing equipment into the alternative fuels industry, and the supply of parts, components and systems for propane distribution, the agricultural sector, oil and natural gas field facilities, and alternative fuel systems and equipment and parts for vehicles which use propane.

## Confusion test

[20] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees an applicant's mark, at a time when he or she has no more than an imperfect recollection of an opponent's trade name, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the mark and trade name [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[21] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: a) the inherent distinctiveness of the trademark and trade name and the extent to which they have become known; b) the length of time the trademark and trade name have 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 trademark and trade name, including in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22; *Veuve Clicquot, supra*; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

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

[22] In its written submissions, the Applicant concedes that the trademarks/trade names of the parties are identical or quasi-identical (para 117).

## Section 6(5)(a) – the inherent distinctiveness of the trademark and trade name and the extent to which they have become known

[23] Both parties' trademark and trade name are inherently distinctive as they consist of a coined word. I do not agree with the Applicant's submissions that the Opponent's trade name has a low degree of inherent distinctiveness. While the derivation of the parties' trade name/trademark may be MAXIMUM EQUIP or MAXIMUM EQUIPMENT, there is no evidence that this would occur as a matter of first impression. Furthermore, as a matter of first impression, it is difficult to ascertain what MAXQUIP or even MAXIMUM EQUIPMENT would suggest to consumers.

[24] The strength of a trademark or trade name may be increased by means of it becoming known in Canada through promotion or use.

[25] The Applicant's evidence is that it only commenced use of the Mark after the material date (Hooper affidavit, para 9). In contrast, the Opponent has evidenced use of its trade name on sample invoices and advertisements and has provided sales information showing considerable annual sales (ranging from over \$9 M in 2010 to over \$20 M in 2015). However, as there is no information which allows me to ascertain the extent known or the reputation of the Opponent's trade name, this factor only slightly favours the Opponent. In particular, there is no evidence of the reach of the Opponent's advertising and promotion with respect to the different types of services and customers of the Opponent.

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

[26] The Applicant only commenced use of the Mark after the material date (Hooper affidavit, para 9). On the other hand, as the Opponent has shown use of its trade name since 2010 (Stewart affidavit, Exhibit L), this factor favours the Opponent.

#### Section 6(5)(c)– the nature of the goods and services and business

[27] The nature of the Goods overlaps in part with the Opponent's services and business.

[28] The Goods are parts, fittings, attachments and accessories for construction machines and equipment, earth moving machines and equipment, industrial machines and equipment, agricultural machines and equipment, loaders, hoists and hoisting equipment, and lifting equipment. The Applicant's evidence is that it provides MAXQUIP parts for over 70+ popular brands including CAT, Genie, JCB, Kubota, Simon, and Skyjack (Hooper affidavit, Exhibit B, page 21). While the Applicant's evidence post dates the material date for this ground of opposition, the Registrar may take into account such evidence insofar as it may indicate a situation existing at the material date [see, for example, *George Weston Ltd v Corporate Foods Ltd* (1988), 19 CPR (3d) 566 (TMOB)], in this case the overlap in the nature of goods, business and trade.

[29] The Applicant's evidence provides that (Hooper affidavit, Exhibits A, C):

(page 9)

The MaxQuip line is currently comprised of parts for 67 competitive models of aerial equipment and is made up of more than 18,000 SKUs in over 50 product categories from 71 manufacturers. The new line is intended to provide an additional parts solution to JLG customers with mixed fleets.



(page 20)

When you're managing a mixed fleet, juggling parts sources can be a challenge. You need the best pricing, best quality and best availability. With MaxQuip from JLG, you can purchase high-quality parts for your entire fleet from a single, industry-leading source. Partner with JLG and work with a committed team of product, purchasing and customer support experts to save you time and money.

[30] The Opponent supplies, parts, components and systems for propane distribution, the agricultural sector and oil and natural gas field facilities, and alternative fuel systems and equipment and parts for vehicles which utilize propane as a fuel source (Stewart affidavit, para 4, Stewart reply evidence, para 3). The Opponent's line card from 2015, which is described as representative and having been distributed, outlines the goods it sells and services including: alternative fuels systems, compressed and cryogenic cylinders and tanks, hose tube pipe and fittings, reels, gauges, dials, and vapourizers (Exhibit F). One of the Opponent's advertisements from 2014 is set out below (Exhibit B) with similar advertisements appearing in the trade publications Propane Canada and Energized:



In his cross-examination, Mr. Stewart explains that LPG is the same thing as propane liquified petroleum gas (Q66) and that the brand PRINS is a fuel system for trucks and automobiles (Q82). Finally, a copy of part of a presentation given by the Opponent describes its First-in-Class Technologies as being suitable for a variety of fuel-injected vehicles (Exhibit K).

[31] The Applicant's evidence includes the "offering by category" set out below which shows several goods which directly overlap with the goods distributed by the Opponent including:

connectors, gauges, filters, cylinders, hoses, LPG Accessories and regulators (Hooper affidavit, Exhibit C, page 53).

**OFFERING BY CATEGORY:**

Offering a complete array of parts based on your needs and includes parts in over 50 categories:

Alarms & Horns	Cylinders	Lights & Accessories	Seal Kits
Axles	Decals	LPG Accessories	Sensors
Bearings	Electrical Components	Manual Enclosures	Switches
Brakes & Accessories	Engines & Accessories	Manuals	Tools
Cables & Accessories	Filters	Miscellaneous	Toggle Switches
Chargers	Forks	Module	Paint
Circuit Breakers	Fuses	Motors & Accessories	Tape
Connectors	Gauges	O-Rings	Valves
Contactors	Generators	PCB	Wear Pads
Control Boxes	Governors	Pins	Weldments
Controller Parts	Hardware	Platforms & Accessories	Wheel & Tire Assemblies
Controllers	Hoses	Pumps	
Couplings	Hubs	Regulators	
Covers	Keys	Relays	

At the hearing, the Applicant submitted that its focus was on equipment for lifts (ie) forklifts and the like and this would assist consumers distinguishing its Mark from the Opponent's trade name. Given that the application, however, is not restricted and covers a wide variety of parts for a wide variety of equipment, any particular focus does not assist the Applicant.

Section 6(5)(d) – channels of trade

[32] At paragraph 94 of the Applicant's written submissions, it discusses the customers of the Applicant and the channels of trade:

94. In the present case, the users of Applicant's Products would be (i) any enterprise or individual that possesses access vehicles and equipment used in the course of their commercial activities for their businesses (ii) any enterprise or rental companies of access equipment who either sell or rent the Applicant's Products and utilize the Applicant's parts and accessories on the equipment that they own and rent or sell.

[33] At para 97, the Applicant submits the following:

97. There is no evidence showing that the public or enterprise possessing access equipment (re: scenario (i)) would deal with the Opponent. On the contrary, by definition, a distributor, appears in the chain of commerce as an intermediary. A distributor is an agent who supplies products to stores and other businesses.

[34] I find that while there are differences in the channels of trade, there are also points of overlap. The evidence is that the parties share at least two customers – United Rentals and

Sunbelt Rentals (Hopper affidavit, Q32; Stewart reply affidavit). The Applicant submits the following in its written submissions (para 109):

The rental companies who are knowledgeable about the products they rent out or buy for their own equipment and if they deal with both the Applicant and the Opponent, they can easily differentiate them because of the nature of their respective field of activity and the trademarks appearing on them. ...

[35] While I agree with the Applicant that some of the parts and fittings in its application are far removed from being used for the fuel related aspects of vehicles, for example, burglar alarms, security and antitheft alarms, electronic warning horns, floodlights, spot lights and light bars, brakes and brake parts, brake cables and cable parts, both parties operate in the field of supplying vehicle parts to consumers with fleets. While at the hearing, the Applicant submitted that its parts were for lifts, there is no such restriction in the application.

Surrounding circumstance – goods sold by the Opponent would be branded with third party marks

[36] In its submissions at the hearing, the Applicant submits that the Opponent distributes goods under the trademarks of third parties and that this diminishes the likelihood of confusion. At the hearing, the Applicant submitted that consumers would understand the difference between the Opponent, a distributor of products produced by third parties under various trademarks and the Goods sold in association with the Mark. The fact that there is no evidence that the Opponent sells goods branded with its trademarks is a factor that favours the Applicant to a very slight extent. Confusion as to source can still occur if a consumer knows of the Opponent's business under its trade name and sees the Applicant's Goods with the Mark, and as a matter of first impression, thinks that the source of those Goods is the Opponent. This is even the case if the consumer is aware that the Opponent's business sells third party goods.

Surrounding circumstance – sophisticated consumers

[37] The Applicant submits that because the parties' fields of business and the parties' consumers are sophisticated, consumers will pay extra attention and be less likely to be confused between the Mark and the Opponent's trade name.

[38] The evidence shows that the parties' average consumers are sophisticated and the Goods in the application and the goods sold by the Opponent themselves are specialized or relate to specialized machinery and equipment. However, the test for confusion is one of first

impression [*Polo Ralph Lauren Corp v United States Polo Assn* 2000 CanLII 16099]. Any subsequent steps taken by sophisticated consumers in an attempt remedy a potential instance of confusion when they are exercising time and due diligence in the purchasing decision are irrelevant [by analogy see paragraphs 68-74 of *Masterpiece*, supra].

## **CONCLUSION**

[39] The Applicant submits in its written submissions that (para 45):

... United Rentals and the other retailers know with whom they do business and would not be confused if there is on one hand a MAXQUIP distributor of propane and gas equipment and on the other hand MAXQUIP products as in the application ...

[40] I do not agree. Having considered all of the surrounding circumstances, I find that as of January 29, 2016 that the balance of probabilities weighs equally for both parties on whether there is a likelihood of confusion and that there is an equal chance as not that a consumer upon seeing the Mark would be likely to infer that the Goods associated with the Mark are somehow approved or licensed by the Opponent. As such, the Applicant has not met its legal onus of proving that there is no reasonable likelihood of confusion. I reach this conclusion because of the high degree of similarity between the Mark and the Opponent's trade name MAXQUIP, only the Opponent had acquired a reputation in association with its trade name as of material date, and the goods and services of the parties overlap. As the legal burden is on the Applicant to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's trade name and it has not done so, the section 16(1)(c) ground of opposition succeeds.

## ***Section 2 Ground of Opposition***

[41] The Opponent alleges that the Mark is not distinctive, having regard to the provisions of sections 38(2)(d) and 2 of the Act, because it does not distinguish, nor is it adapted so as to distinguish, the Goods of the Applicant from the Opponent's goods and services:

the services of the Applicant as described in the Application from the goods and services of others and, more particularly, from the goods and services in association with which the Opponent's MAXQUIP and MAX-QUIP INC. Trade-marks and MAXQUIP and MAX-QUIP INC. Trade-names have been previously used in Canada. Through extensive use in Canada, the Opponent's MAXQUIP and MAX-QUIP INC. Trade-marks and MAXQUIP and MAX-QUIP INC. Trade-names have become distinctive in Canada in association with the Opponent's goods and services including those goods and services of the Opponent's MAXQUIP Trademarks. The Opposed Trade-mark is not capable of distinguishing the Applicant's goods and services from the goods and services of the

Opponent, since it is confusing with the Opponent's MAXQUIP and MAX-QUIP INC. Trade-marks and MAXQUIP and MAX-QUIP INC. Tradenames.

[42] The material date for this ground of opposition is October 18, 2019, the date the statement of opposition was filed [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[43] To succeed, an opponent relying on its own trademark or trade name must establish that its trademark or trade name was known in Canada to some extent at least, i.e. that its reputation was “substantial, significant or sufficient” to negate the established distinctiveness of another trademark, or else that it was well known in a specific area of Canada [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657; *1648074 Ontario Inc v Akbar Brothers (PVT) Ltd*, 2019 FC 1305]. In this respect, the opponent must demonstrate that its trademark or trade name had acquired a reputation among consumers as an indicator of source [*Akbar Brothers, supra*; *Scott Paper Ltd v Georgia-Pacific Consumer Products LP*, 2010 FC 478]. Moreover, there must be clear evidence of the extent to which the trademark or trade name was known [*Bojangles, supra*; *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10].

[44] While the Opponent’s sales numbers at the material date are quite large, I am unable to determine whether the reputation of the Opponent’s trademarks and trade names meets the distinctiveness standard. In particular, there is no evidence on the reach of promotion and advertising with respect to the different types of services and customers of the Opponent. As such, this ground of opposition is rejected.

### **Section 16(1)(a) Ground of Opposition**

[45] The Opponent pleads that the Applicant was not entitled to register the Mark in view of the fact that the Opponent's MAXQUIP and MAX-QUIP INC. trademarks were previously used or made known in Canada by the Opponent in association with the goods and services at Schedule A.

[46] With respect to the ground of opposition based on section 16(1)(a) of the Act, the material date is January 29, 2016. In order to meet its initial evidential burden with respect to this ground, the Opponent must show that it had used or made known its trademarks in accordance with sections 4 and 5 of the Act.

### Allegation based on making known is rejected

[47] The making known requirements set out in section 5 require a finding that a trademark has become well known in Canada by reason of the distribution or advertising of an opponent's goods and services in Canada such that a substantial area in Canada knows its trademark [*Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)]. Even though the Opponent has demonstrated that its MAXQUIP brand has been advertised in the trade periodicals Propane Canada and Energized, this evidence fails to show that its mark was made known by virtue of advertising as required by section 5 [*Williams Companies Inc et al v William Tel Ltd* (2000), 4 CPR (4th) 253 (TMOB)].

### Allegation based on use is rejected

[48] I do not find that the Opponent has met its evidential burden with respect to showing use of its trademark MAXQUIP in association with the goods set out in Schedule A. First, while Mr. Stewart states that the MAXQUIP trademark is embossed into the collar of propane cylinders and is stamped onto pumping equipment (Stewart reply affidavit, para 4), no evidence showing this has been provided. Second, while Mr. Stewart states that the products sold to United Rentals were all sold under the MAXQUIP trademark and trade name, with MAXQUIP appearing on the invoices and other documentation, such as packing slips (para 4), only sample invoices are in evidence. While the MAXQUIP trademark is on the invoices, Mr. Stewart does not confirm that they were so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred as required by section 4(1) of the Act. Further, the evidence is also not clear on whether the Opponent's trademark is used as an indicator of source with the goods listed in this ground of opposition as opposed to its distribution services.

[49] With respect to the services in Schedule A, the Opponent meets its evidential burden of showing that it had advertised its services in association with its trademark MAXQUIP through the advertisements placed in Propane Canada (Exhibit J). However, I also find that the Applicant meets its legal onus of proving no confusion because these services are more restricted in scope than those at issue with respect to the section 16(1)(c) ground of opposition. As such, this ground of opposition is rejected.

**DISPOSITION**

[50] Having regard to the aforementioned, 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

## **SCHEDULE A**

The Opponent alleges with respect to the section 16(1)(a) ground of opposition that it has previously used its trademarks MAXQUIP and MAX-QUIP INC. in Canada or made known these trademarks in association with the following goods and services:

CI 6 Cylinders for propane; fluid storage tanks of metal; tanks of metal for the storage of compressed gas namely liquefied petroleum gas (LPG), compressed natural gas (CNG) and ammonia (NH<sub>3</sub>) used in the propane and ammonia industry; hose fittings, hose clips, hose reels, hose couplings, and hose clamps of metal; clips of metal for pipes; stainless steel tubing; stainless steel pipe fittings; adapter plugs; electric, water bath, and direct fired liquefied petroleum gas (LPG) and ammonia (NH<sub>3</sub>) vaporizers; explosion-proof electric motors used in the propane and ammonia industry; manifold kits; metal valves used for compressed gas storage vessels; water tanks; stainless steel braided and stainless steel hoses for agricultural purposes; gas storage tanks of metal; liquefied petroleum gas (LPG) conversion kits; compressed natural Gas (CNG) conversion kits;

CI 7 Electric compressors; compressors, pumps, namely, pumps for liquefied gases; gasoline gauges; pressure gauges; gas flow monitors;

CI 9 Metering of compressed natural gas (CNG); analyzing, measuring and regulating devices, namely, hydrometers, level indicators, pressure gauges, flow meters, recorders; tank level monitoring systems that connect with all types of truck engines and chassis controls; programmable electronic monitoring systems for fuel delivery trucks;

CI 11 Patio heaters; outdoor fire pits; gas, electric, and copper lighting; liquefied petroleum gas (LPG) and compressed natural gas (CNG) indoor gas lighting;

CI 16 Decals;

CI 17 Plastic and rubber hoses for agricultural purposes; propane and ammonia markets;

CI 35 Retail sale of oil and gas equipment for transport trucks namely, remote-controlled shut down systems, tank monitoring systems that hold diesel fuel, propane, lubricants, farm chemicals and waste oil, used in the field of oil and gas;



# Appearances and Agents of Record

**HEARING DATE:** 2022-12-07

## **APPEARANCES**

**For the Opponent:** David Reive

**For the Applicant:** Chantal Desjardins

## **AGENTS OF RECORD**

**For the Opponent:** Miller Thomson LLP

**For the Applicant:** Lavery, de Billy, LLP