



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 121

Date of Decision: 2023-07-17

IN THE MATTER OF AN OPPOSITION

Opponent: 130872 Ontario Inc. o/a Factory Direct Medical, HPU Rehab and
HPU Medical Wholesale

Applicant: Canadian Home Medical Group Inc.

Application: 1,958,034 for EASYFOLD PORTABLE POWER WHEELCHAIR &
Design

INTRODUCTION

[1] 130872 Ontario Inc. o/a Factory Direct Medical, HPU Rehab and HPU Medical Wholesale (the Opponent) opposes registration of the trademark EASYFOLD PORTABLE POWER WHEELCHAIR & Design (the Mark), shown below, which is the subject of application No. 1,958,034 (the Application) in the name of Canadian Home Medical Group Inc. (the Applicant) filed on April 17, 2019.



[2] The Application is based on use of the Mark in Canada since as early as July 4, 2017 in association with the following goods (the Goods), set out together with the associated Nice class (CI):

CI 12 (1) Motorised wheelchairs for the disabled and those with mobility difficulties; motorized wheelchairs; wheelchairs

[3] The Application was advertised for opposition purposes in the *Trademarks Journal* on January 12, 2022.

[4] On May 11, 2022, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[5] The Opponent raises grounds of opposition based upon non-distinctiveness under section 2, non-registrability under [section 12\(1\)\(b\)](#), non-entitlement under section 16(1)(a), and non-entitlement under section 38(2)(f).

[6] With respect to the section 16(1)(a) ground of opposition, the Opponent alleges a likelihood of confusion with its trademark EZee Fold, previously used or made known in Canada in association with motorized wheelchairs and scooters.

[7] In support of its opposition, the Opponent filed the affidavit of William Greg Castagner, paralegal candidate in good standing with the Law Society of Ontario. Mr. Castagner was not cross-examined on his affidavit. The Applicant elected not to file any evidence.

[8] Only the Opponent filed written arguments. An oral hearing was not held.

ONUS AND MATERIAL DATES

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited*, 1990 CanLII 11059 (FC) at 298].

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

- Sections 38(2)(b) and 12(1)(b) – the filing date of the Application, namely, April 17, 2019 [*General Housewares Corp v Fiesta Barbeques Ltd*, 2003 FC 1021];
- Sections 38(2)(c) and 16(1) of the Act – the filing date of the application or the date of first use of the trademark in Canada, whichever is earlier [section 16(1) of the Act];
- Sections 38(2)(d) and 2 of the Act – the filing date of the opposition, namely, February 27, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185];
- Section 38(2)(f) of the Act – the filing date of the application in Canada [section 38(2)(f) of the Act].

SECTION 16 GROUND OF OPPOSITION

[11] The Opponent raises a ground of opposition based on section 38(2)(c) in conjunction with section 16 of the Act, alleging that the Applicant is not the party entitled to register the Mark since the filing date of the application because it was confusing with the trademark EZee Fold, previously used or made known by the Opponent in Canada in association with motorized wheelchairs and scooters.

[12] However, the Opponent's evidence does not demonstrate any use or making known of EZee Fold as a trademark in Canada in association with any goods at any time. As the Opponent has not met its initial evidential burden, the section 16 ground of opposition is dismissed.

SECTION 38(2)(F) GROUND OF OPPOSITION

[13] The Opponent also pleads that contrary to section 38(2)(f) of the Act, the Applicant was not entitled to use the Mark in Canada in association with the Goods given its prior knowledge of the Opponent's trademark EZee Fold and the apparent likelihood of confusion between the two marks.

[14] The Opponent has not filed any evidence or arguments in support of this ground. From the statement of opposition, I understand that it considers the basis underlying this ground of opposition to be an allegation of confusion with its trademark. However, section 38(2)(f) does not address an applicant's entitlement to register the mark relative to another person's trademark, pursuant to section 16 of the Act. Instead, this section addresses an applicant's lawful entitlement to use the trademark, for example, in compliance with relevant federal legislation and other legal obligations prohibiting "use" of the trademark within the meaning of section 4 of the Act [see *Methanex Corporation v Suez International, société par actions simplifiée*, 2022 TMOB 155]. Accordingly, this ground of opposition is rejected.

SECTION 12(1)(B) GROUND OF OPPOSITION

[15] The Opponent further pleads that the Mark is not registrable because whether depicted, written or sounded, it is either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used.

[16] The registrability of the Mark under section 12(1)(b) of the Act must be assessed as of the filing date of the application – in this case, April 17, 2019.

[17] The issue as to whether a mark is clearly descriptive or deceptively misdescriptive of the character or quality of the goods and services must be considered

from the point of view of the average purchaser of the goods and services. "Character" means a feature, trait or characteristic of the goods and services and "clearly" means "easy to understand, self-evident or plain" [see *Drackett Co of Canada v American Home Products Corp* (1968), 55 CPR 29 (Can Ex Ct) at 34]. Further, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Canada (Registrar of Trade Marks)* (1978), 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Canada (Registrar of Trade Marks)* (1984), 2 CPR (3d) 183 (FCTD) at 186]. Finally, the purpose of the prohibition in section 12(1)(b) is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [see *Canadian Parking Equipment v Canada (Registrar of Trade Marks)* (1990), 34 CPR (3d) 154 (FCTD) at para 14].

[18] In the present case, the key issue with respect to the section 12(1)(b) ground of opposition is whether the Opponent has satisfied its initial evidential burden. That is to say, has the Opponent provided sufficient evidence from which it could reasonably be concluded that the Mark EASYFOLD PORTABLE POWER WHEELCHAIR Design is clearly descriptive of the character or quality of the Goods to the average Canadian purchaser of these goods. For the reasons set out below, I am satisfied that the Opponent has met its evidential burden.

[19] On or about September 9, 2022, Mr. Castagner was instructed to conduct online searches for dictionary definitions for each of the following words: easy, fold, portable, power and wheelchair. The most pertinent search results from the *Merriam Webster* dictionary are as follows:

- Easy: causing or involving little difficulty or discomfort
- Fold: to lay one part over another part
- Portable: capable of being carried or moved about
- Power: operated mechanically or electrically rather than manually

- Wheelchair: a chair mounted on wheels, especially for the use of disabled persons

[20] Mr. Castagner was also asked to carry out a search of the Internet for folding wheelchairs available for purchase in Canada. Some examples of product descriptions of wheelchairs found on the websites located by Mr. Castagner include the following:

- light folding wheelchair
- WHILL Model F Folding Power Chair
- Travel Buggy CITY 2 Plus Folding Power Chair
- Light Portable Electric Power Wheelchair
- Super Lightweight, Easy to Fold
- Very Easily Portable When Disassembled

[21] I note that the Opponent's evidence includes references from outside of Canada. This does not necessarily render them irrelevant, as the issue is not whether the mark has been used in a clearly descriptive manner in Canada, but whether the mark is clearly descriptive in the English or French language [see *Canadian Inovatech Inc v Burnbrae Farms Ltd* (2003), 31 CPR (4th) 151 (TMOB) at para 13; *Guess? Inc v Slide Sportswear Inc* (2005), 44 CPR (4th) 380 (TMOB)].

[22] Relying on the decision in *Best Canadian Motor Inns Ltd v Best Western International, Inc* (2004), 30 CPR (4th) 481 (*Best Canadian Motor Inns*), the Opponent submits that composite trademarks which include both word and design elements are not registrable pursuant to section 12(1)(b) of the Act if the trademark contains word elements that are: a) clearly descriptive or deceptively misdescriptive of the character or quality of the goods; and b) the dominant feature of the trademark. The Opponent submits that in the present case, the Mark consists of the words "Easy Fold Portable Power Wheelchair" with the text "Fold" in a white colour positioned in front of an oval design element. The Opponent submits that there is nothing distinctive about the oval

design element in the Mark to suggest that consumers would identify the Mark by the oval element rather than the word portion which, when sounded, is Easy Fold Portable Power Wheelchair.

[23] I agree with the Opponent that the design elements are not the dominant feature of the Mark. Here, the design elements are limited to a circular wheel shape on which the word FOLD is imposed as well as stylization of the remaining word elements. Even if EASY FOLD is regarded as consumers as one word, as noted in the *Best Canadian Motor Inns* case, section 12(1)(b) of the Act stipulates that trademark is registrable if it is not, whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the associated goods. In my view, regardless of how the words EASY and FOLD appear to the average consumer, as a matter of immediate impression the words EASY and FOLD would be sounded as two separate words.

[24] I consider this case similar to *Ottawa Athletic Club v Athletic Club Group Inc*, 2014 FC 672, where the dominant and influential feature of the mark were the words that appeared inside the oval design. In this regard, Russell J. stated as follows at para. 186:

The Respondent argues that the word portion of the Trade-mark is not dominant and that it is the design as a whole that is distinctive. In my view, however, the Applicant is correct that the dominant and influential feature on first impression is the declaimed words "The Athletic Club." There is nothing distinctive about the oval backer portion of the Trade-mark or the script to suggest that consumers would identify the Trade-mark by those design aspects rather than the words. The Respondent has declaimed the words, but the words remain the dominant and influential feature of the Trade-mark. The oval and script do not stimulate visual interest in a way that removes visual dominance from the words, and simply enclosing the words in a simple border cannot create a right to prevent others from doing so: see *Westfair Foods*, above, at para 20.

[25] After considering the Opponent's evidence in its entirety, I am satisfied that the Opponent has met its initial evidential burden to provide facts which suggest that the terms EASY and FOLD in the wheelchair industry clearly describes a type of wheelchair that is easy to fold. Keeping in mind that the purpose of section 12(1)(b) is to prevent a single trader from acquiring a monopoly in a term that is clearly descriptive, I am

satisfied that the Opponent has provided sufficient evidence to meet its initial evidential burden for this ground and thus shift the legal burden to the Applicant. As the Applicant has not filed any evidence or submissions to refute the suggestion that the Mark is clearly descriptive in respect of the Goods, in my view, the Applicant has not satisfied its legal burden and the Opponent succeeds on the section 12(1)(b) ground.

SECTION 2 GROUND OF OPPOSITION

[26] The relevant date for this ground of opposition is the date of filing the statement of opposition, namely, May 11, 2022.

[27] As I have found that the Opponent has met its initial evidential burden to demonstrate that the Mark is clearly descriptive under section 12(1)(b), I similarly find that the Opponent has met its initial evidential burden for the distinctiveness ground of opposition under section 2. That is to say, the Opponent has met its evidential burden to suggest that the Mark is clearly descriptive of the Goods and thus is not distinctive of the Applicant. A trademark which is clearly descriptive of the character or quality of the goods cannot serve to distinguish an applicant's goods from those of others [see *Canadian Council of Professional Engineers v APA - The Engineered Wood Assn*, 2000 CanLII 15543 (FC), 7 CPR (4th) 239 (FCTD)].

[28] As the Applicant filed no evidence to address this ground of opposition, the Opponent similarly succeeds under the section 2 ground of opposition.

DISPOSITION

[29] In view of the above, 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.

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: Darryl Joseph Bilodeau

For the Applicant: David D. Lyons