



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 172

Date of Decision: 2023-10-05

IN THE MATTER OF OPPOSITIONS

Opponent: Garmin Switzerland GmbH

Applicant: Vivo Mobile Communications Ltd.

Applications: 1,863,258 and 1,861,990, both for VIVO

INTRODUCTION

[1] Garmin Switzerland GmbH (the Opponent) opposes registration of the trademark VIVO (the Mark), that is subject of application Nos. 1,863,258 (the 258 Application) and 1,861,990 (the 990 Application) (collectively, the Applications), filed by Vivo Mobile Communication Ltd. (the Applicant).

[2] The Applications for the Mark are based upon proposed use in association with telecommunications products and services. A complete listing of the applied-for goods and services, together with their associated Nice classes (CI) is attached under Schedule A to this decision.

[3] The opposition to the Mark is primarily based on an allegation of confusion with one or more of the Opponent's VIVO-formative trademarks (registered or otherwise). A complete listing of the Opponent's relied-upon trademarks can be found at Schedule B to this decision.

[4] For the reasons that follow, the Applications are refused.

THE RECORD

[5] The 258 Application was filed on October 17, 2017 and advertised for opposition purposes in the *Trademarks Journal* of December 2, 2020. The 990 Application was filed on October 10, 2017 and advertised for opposition purposes in the *Trademarks Journal* of March 3, 2021.

[6] On January 13, 2021 and March 25, 2021, the Opponent filed statements of opposition respectively against the 258 Application and the 990 Application under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. As the Applications for the Mark were advertised after June 17, 2019, the Act as amended applies to both Applications (see section 69.1 of the Act).

[7] With respect to both Applications, the Opponent raises grounds of opposition based on section 38(2)(a.1), section 12(1)(d), sections 16(1)(a) and (b), section 38(2)(d)/2, section 38(2)(e), and section 38(2)(f) of the Act.

[8] The Applicant filed and served its counter statements on March 10, 2021 (for the 258 Application), and May 12, 2021 (for the 990 Application), denying the grounds of opposition.

[9] In support of its oppositions, the Opponent filed:

- certified copies of its registrations as follows: TMA1,081,876 (VIVOSPORT), TMA909,532 (VIVOFIT), and TMA899,032 (VIVOSMART);
- the affidavit of David V. Ayres, Associate General Counsel – IP of Garmin International, Inc., a related company of the Opponent. Mr. Ayres' affidavit provides evidence concerning the Opponent's business and relied-upon trademarks; and
- the affidavit of Mary P. Noonan, a trademark searcher employed by the agent for the Opponent. Ms. Noonan's affidavit provides printouts of the particulars of the Opponent's following trademark registrations and applications: VIVOFIT (TMA909,532),

VIVOSMART (TMA899,032), VIVOSPORT (TMA1,081,876), VIVOMOVE (App. No. 1,804,350), and VIVOACTIVE (App. No. 1,705,536).

[10] In support of its Application, the Applicant filed the affidavit of Luo Xuehong, the Intellectual Property Manager for the Applicant. Ms. Xuehong's affidavit provides evidence concerning the Applicant's business globally and statements concerning the Applicant's proposed business and trademark use in Canada.

[11] None of the affiants were cross examined on their affidavits, and the Opponent did not file reply evidence.

[12] Only the Opponent filed written representations and attended an oral hearing.

ANALYSIS

Section 12(1)(d) Ground of Opposition

[13] The material date for the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[14] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent's following registered trademarks: TMA909,532 (VIVOFIT), and TMA899,032 (VIVOSMART), and TMA1,081,876 (VIVOSPORT). As previously indicated, particulars of these relied-upon trademarks are included in Schedule B to this decision.

[15] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition, if one or more of the registrations relied upon are in good standing. Furthermore, 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 are in good standing as of the date of this decision.

[16] Since the Opponent has satisfied its initial onus, 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 Marks and any of the Opponent's relied-upon trademarks.

Test for Confusion

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

[18] Applying the test for confusion is an exercise in finding facts and drawing inferences [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 102]. All surrounding circumstances of the case must be considered, including those listed at section 6(5) of the Act, namely: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks including in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, although they are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54; and *Veuve Clicquot, supra* at para 21].

Section 6(5)(a) – inherent distinctiveness and extent known

[19] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' marks.

[20] The Opponent submits that the striking or dominant element of its relied upon trademarks is the component VIVO. The Opponent further submits that this element is not in any way descriptive or suggestive of the associated personal electronic devices. I agree. The inherent distinctiveness of the Opponent's marks is lessened owing to the suffix components FIT, SMART, and SPORT, as these components are suggestive, if not descriptive, of products that relate to fitness, smart technology, and sport. The Applicant's Mark, on the other hand, possesses a higher degree of inherent distinctiveness, as it is comprised of only the term VIVO, which has no particular connotation in respect of the associated goods or services.

[21] In any event, the strength of a trademark may be increased by means of its becoming known through promotion or use.

[22] While the Application for the Mark is based upon proposed use in Canada, the Applicant, through the Xuehong affidavit, has provided evidence regarding its “VIVO brand” globally. In particular, Ms. Xuehong describes the Applicant as a global technology company that develops and manufactures smartphones and smartphone accessories, including headphones and charging chords. She attests that while the Applicant originated in China, the VIVO brand has expanded globally and has a significant reputation worldwide. In support, she provides articles and press releases published on the Applicant’s website regarding the Applicant’s expansion into eight European countries, international partnerships, the international debut of new technology from the Applicant in Thailand and India, the Applicant’s presence at the FIFA World Cup in Russia (2018), and the Applicant’s sponsorship of the UEFA EURO 2020 and 2024 football competitions (Exhibit B).

[23] Ms. Xuehong attests that as of the date of her affidavit, the Applicant has ten percent of the global smartphone market share. As support, she attaches an article published by Forbes on April 29, 2021, which discusses the dominant sellers in the global smartphone marketplace (Exhibit C), and “various articles from third parties extolling the global popularity and reputation of the Applicant and its products” (Exhibit E).

[24] Ms. Xuehong further attests that the Applicant operates many social media accounts (see Exhibit D screenshots) which are followed by millions of people globally, including:

- Facebook: more than 26 million likes and more than 26 million followers;
- Instagram: about 541,000 followers;
- YouTube: about 23,500 subscribers;
- LinkedIn: 79,707 followers.

[25] While Ms. Xuehong’s evidence speaks to the Applicant’s global presence, there is no evidence of use, advertising or promotion of the Applicant’s Mark in Canada. Indeed, all of the evidenced articles and press releases discuss the Applicant’s activities in other jurisdictions. Furthermore, no Canadian distribution/viewership statistics have been provided for any of the evidenced articles, nor have Canadian social media user/subscriber statistics been provided. As a result, I am not prepared to infer from Ms. Xuehong’s evidence, that the Applicant’s global presence and use of its VIVO trademarks globally are such that any meaningful conclusions can be made with respect to the extent the Applicant’s Mark has become known *in Canada*.

[26] The Opponent's evidence, however, shows extensive use of its registered VIVO trademarks in Canada since 2014 (and 2017 in the case of VIVOSPORT). In this regard, Mr. Ayres attests that Garmin sells activity tracking devices and smartwatch devices in Canada in association with its registered VIVO trademarks. Supportive evidence as provided by Mr. Ayres includes:

- Representative sales invoices and purchase orders for VIVO products (Exhibits 10 and 33), including VIVOFIT, VIVOSMART, and VIVOSPORT products;
- Images of VIVO products (including VIVOFIT, VIVOSMART, and VIVOSPORT activity trackers/smartwatches) (Exhibits 11-13), and associated representative packaging clearly bearing these marks (Exhibits 18-20);
- Images of owner's manuals and guides that accompanied the VIVO products (including VIVOFIT, VIVOSMART, and VIVOSPORT activity trackers/smartwatches) representative of those distributed at their time of transfer, and which clearly bear the marks (Exhibits 23-25);
- Canadian sales revenue figures for VIVO products, broken down by product and year. Sales revenues for VIVOFIT and VIVOSMART products date back to 2014, and are in excess of \$21 million each as of 2020, while sales revenues for VIVOSPORT products date to 2017, and total more than \$1.1 million as of 2020;
- Canadian sales volume figures for VIVO products, also broken down by product and year. Unit sales for VIVOFIT and VIVOSMART products date to 2014, and total 374,000 and 200,000 individual units respectively as of 2020. Unit sales for VIVOSPORT products date to 2017, and total 9,200 individual units as of 2020;
- A "conservative estimate" that hundreds of thousands of dollars have been spent each year on marketing expenditures related to Canadian-specific advertising, promotional and marketing activities (para 60); and
- Representative examples of promotional materials bearing the registered VIVO trademarks, including in catalogues distributed in Canada, in-store and point of sale displays, magazine advertisements, online advertisements, television advertisements,

and online and social media (Facebook, Twitter, YouTube, Instagram, and Pinterest) (Exhibits 34-50).

[27] In view of Mr. Ayres' evidence, I accept that the Opponent's relied upon VIVO-formative registered trademarks have become known to some extent in Canada.

[28] Having regard to the aforementioned, while the inherent distinctiveness factor slightly favours the Applicant, the acquired distinctiveness factor favours the Opponent.

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

[29] As previously indicated, the Applicant's Applications are based on proposed use and the Applicant has not filed any evidence of use of the Mark in Canada since the dates of filing of the Applications.

[30] The Opponent, on the other hand, has provided evidence of use of its relied upon VIVO-formative registered trademarks since 2014 (for VIVOFIT and VIVOSMART) and 2017 (for VIVOSPORT). Thus, this factor favours the Opponent.

Sections 6(5)(c) and (d) – the nature of the goods, services, business, and trade

[31] When considering the nature of the goods and services, it is the statements of goods and services in the subject application and registrations that govern [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 (3d) 3 (FCA)]; *Miss Universe, Inc v Dale Bohna*, (FCA), [1995] 1 FCR 614]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the goods and services set out in the subject application or registrations [*McDonald's Corp v Coffee Hut Stores Ltd*, 1996 CanLII 3962 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[32] In this case, the Applicant's goods (app. No. 1,863,258) encompass computers and a variety of computer related components and accessories, including accessories for telecommunication devices such as smartphones (for a full statement of goods, see Schedule A). Also noteworthy in the Applicant's goods is the GPS-related good "Electronic devices used to locate lost articles employing the global positioning system or cellular communication

networks, namely, wireless global tracking devices system comprised of radio transceivers used in communicating to and monitoring the distance to a mobile phone.”

[33] The Applicant’s services (app. No. 1,861,990) are related to the advertising, promotion and sale of related goods, including such goods for others. Once again, for a full statement of the services, see Schedule A to this decision. Indeed, I agree with the Opponent’s submission that the services in this application are described as being in the field of “mobile phones, mobile phone accessories, computers, computer software, computer peripherals and consumer electronics”, which is closely related to the field in which the Opponent operates – consumer electronic products. While there are some services that do not indicate a defined field, I further agree with the Opponent that read in context of the specification of services as a whole, and in the absence of evidence to the contrary, there is nothing to suggest that these services would be in an unrelated field.

[34] The Opponent’s registered goods encompass devices, such as wearable activity trackers and smart watches, for monitoring health and exercise, wherein such devices incorporate GPS tracking capabilities.

[35] The Applicant’s affiant, Ms. Xuehong, makes several statements to support her allegation that there is no overlap in trade. In this regard, she states that the Applicant makes its smartphones available to the public through specialized channels of trade as follows:

- on its official website to countries in the following regions: Africa, Asia Pacific, Europe, Latin America, and the Middle East. She states that the Applicant does not sell third party products through its website; and
- through brick-and-mortar retail stores in some countries, where the stores are authorized VIVO retail stores that sell only VIVO smartphones. She provides as Exhibit H, sample photographs of such retail stores.

[36] Ms. Xuehong attests that when the Applicant enters the Canadian marketplace, it intends to distribute its phones through a dedicated VIVO website and authorized VIVO retail stores.

[37] Lastly, Ms. Luehong attests that smartphone consumers carefully research competing technologies before purchasing a smartphone and that the Opponent’s products are also

valuable goods for which consumers will conduct research and take great care before deciding to purchase. However, I note that the Federal Court has previously rejected this very argument in a previous related case [see *Vivo Mobile Communication Co, Ltd v Garmin Switzerland GmbH*, 2022 FC 1410 at para 59].

[38] The Opponent submits that while its goods are not mobile phones or smart phones themselves, they are personal electronic devices (such as wearable activity trackers and smart watches) that are nonetheless intended to be used and integrated with a user's smartphone or other mobile device. Indeed, Mr. Ayres attests that "users of our VIVO products can enjoy various smart features (such as smart notifications, contactless payment, and communication capabilities such as the ability to send text replies directly through their VIVO products) when paired with compatible smartphones" (para 20). As such, as was held in *Garmin Switzerland GmbH v VIVO MOBILE COMMUNICATION CO, LTD*, 2021 TMOB 34 (aff'd 2022 FC 1410), I agree that there is a similarly strong connection between the Applicant's goods (and services related to such goods) and the Opponent's registered goods.

[39] In addition, the Opponent notes further overlap in the parties' goods with respect to Application 258, as this application includes GPS-related goods. The Opponent submits that both of its VIVOSMART and VIVOSPORT products specifically include GPS-tracking capabilities (Ayres affidavit, para 16 and Exhibits 4 and 5). I agree.

[40] With respect to channels of trade, Ms. Xuehong attests that the Applicant's products are available in other jurisdictions through specialized channels. She states that the Applicant offers its smartphones for sale through the Applicant's own website, and through authorized VIVO brick and mortar retail stores, which only sell VIVO smartphones. She further attests that when the Applicant enters the Canadian marketplace, it intends to distribute its phones through a dedicated VIVO website and authorized VIVO retail stores (Xuehong affidavit, paras 16-17). However, I agree with the Opponent, that there are no such restrictions in the Applications for the Mark, and nowhere in Ms. Xuehong's affidavit does she state that the Applicant's website is the only or exclusive manner in which the Applicant's products would be sold in Canada, nor does she state that authorized VIVO retail stores in Canada would sell only VIVO products. Furthermore, there are no restrictions in the Opponent's registrations as to channels of trade, and as the Opponent submits, Mr. Ayres' evidence confirms that the Opponent's VIVO-formative branded products are widely distributed in Canada through a full range of trade

channels, including, through electronics retailers, mass market retailers, sporting goods stores, and online (Ayres affidavit, paras 11-12 and 46-47).

[41] As reminded by the Supreme Court in *Masterpiece, supra*, at paragraphs 53 to 59, one must not lose sight of the full scope of the rights conferred by the trademark registration sought by the Applicant. The focus must be on the terms set out in the Application for the Mark and on what “the registration would authorize the [Applicant] to do, not what the [Applicant] happens to be doing at the moment.” While actual use is not irrelevant, “it should not be considered to the exclusion of potential uses within the registration.”

[42] Consequently, I find these factors favour the Opponent.

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

[43] The Opponent submits that the “VIVO” element of its relied upon registered trademarks should be regarded as the dominant r striking element of each of those marks, as the suffix portions of these trademarks are arguably suggestive. I agree with the Opponent that it is the VIVO portion which will “allow consumers to distinguish”; the second component of the Opponent’s marks “do not meaningfully diminish the resemblance between the Mark and the Opponent’s trademarks in appearance and sound” [*Garmin, supra, aff’d 2022 FC 1410*].

[44] The Opponent further submits, and I agree, that the Applicant’s Mark shares a high degree of resemblance, given that it is identical to the dominant and striking element of the Opponent’s relied upon marks. Indeed, the Applicant has incorporated the dominant portion of the Opponent’s marks as the Mark in its entirety. However, there is less similarity with respect to the ideas suggested between the parties’ marks as there is no clear meaning of VIVO in association with the parties’ goods, and the Opponent’s marks incorporate components in addition to VIVO which are suggestive if not descriptive.

Family of Trademarks – Opponent

[45] The Opponent relies on a family of VIVO marks as a surrounding circumstance that it submits increases the likelihood of confusion. In this regard, the Opponent has evidenced use of its registered VIVO marks, including VIVOFIT, VIVOSMART, and VIVOSPORT. The Ayres’ affidavit also shows use of several other VIVO-formative marks, namely, VIVOACTIVE, VIVOMOVE, VIVOKI, and VIVOHUB (Ayres’ affidavit, invoices under Exhibits 10 and 33,

images of products and packaging under Exhibits 14-17 and 20-22, and sales figures under paras 51-52).

[46] Where there is a family of trademarks, there may be a greater likelihood that the public would consider a trademark that is similar, to be another trademark in the family and, consequently, assume that the product or service that is associated with that trademark is manufactured or performed by the same person. There is, however, no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must show that it is using more than one or two trademarks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn* (1998), 145 FTR 59 (FCTD), aff'd (1999), 3 CPR (4th) 298 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB) at para 35]. In addition, a relevant consideration when a family of marks is pleaded is whether the feature common to the Opponent's marks is found in trademarks owned by others [*Techniquip, supra*].

[47] I am satisfied that the Opponent has substantiated its family of VIVO marks, and there is no evidence that the family's common feature VIVO is registered or used by others. Therefore, I consider this to be an additional surrounding circumstance in the Opponent's favour. Furthermore, as in *Garmin, supra*, I have accounted for the fact that unlike each of the Opponent's VIVO trademarks, the Mark only consists of VIVO and does not include a suffix component suggestive of its Goods.

Co-existence in Other Jurisdictions

[48] Ms. Xuehong attests that the Applicant's trademarks consisting of or incorporating the word VIVO for smartphones and the Opponent's trademarks incorporating the prefix VIVO for wearables and athletic technologies co-exist on the trademark registers and in the markets of Singapore, Russia, Australia, Malaysia, the European Union, and Taiwan of China. She provides a chart listing the trademarks of each party for each of these jurisdictions, including registration numbers and associated Nice classes (Exhibit F). She then provides copies of the Applicant's trademark registration certificates which correspond to these markets (Exhibit G).

[49] The Opponent offers a number of criticisms of what it submits is the Applicant's purported evidence of coexisting foreign rights. To begin with, it submits that the Xuehong affidavit fails to provide full particulars of the Applicant's foreign registrations, such as the associated goods and services. Furthermore, the Opponent submits that the Applicant has

failed to show actual marketplace coexistence in any foreign jurisdiction through proof of contemporaneous sales of both parties' goods in those jurisdictions. In any event, the Opponent submits that mere coexistence of marks on foreign registers is irrelevant and immaterial to the question of trademark confusion in Canada. Indeed, I agree with the Opponent's submissions and the mere fact that the parties' marks may coexist on foreign trademarks registers does not result in the inference that the trademarks are not confusing in Canada, since registrations in other jurisdictions have their basis in foreign law and procedure [*Sun-Maid Growers of California v Williams & Humbert Ltd* (1981), 54 CPR (2d) 41 (FCTD); and *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707, 41 CPR (4th) 8 (FCTD)].

Conclusion

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

16(1)(a) Ground of Opposition

[51] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act because, at the filing date of the Application, or any other relevant date, the Mark was and is confusing with the Opponent's VIVO trademarks previously used and/or made known by the Opponent in association with the Opponent's goods of a very similar if not identical nature to those listed in the Applications. The Opponent's VIVO trademarks under this ground include VIVOFIT, VIVOSMART, VIVOSPORT, VIVOACTIVE, VIVOMOVE, VIVOHUB, and VIVOKI (see Schedule B to this decision for a complete listing of and particulars of these marks).

[52] The Opponent has an initial burden of establishing that one or more of its trademarks alleged in support of these grounds of opposition were used or made known prior to the earlier of the filing date of the Application, namely, October 17, 2017 (for app. 258) and October 10,

2017 (for app. 990), or the dates of first use of the Mark in Canada, and was not abandoned at the date of advertisement of the Applications for the Mark (in this case, December 2, 2020 for app. 258 and March 3, 2021 for app. 990) [section 16(3) of the Act]. As the Applicant has not filed any evidence of use of the Mark in Canada, the material dates for the Opponent under this ground are the dates of filing of the Applications.

[53] As discussed under the section 12(1)(d) ground of opposition, I am satisfied that the Opponent has shown use of each of its relied upon trademarks. Furthermore, Mr. Ayres' affidavit shows that each of the Opponent's relied upon VIVO-formative trademarks under this ground were used prior to the dates of filing of the Applications for the Mark.

[54] As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that as of the dates of filing of the Applications, there was not a reasonable likelihood of confusion between the Marks and any of the Opponent's relied upon trademarks.

[55] The differences in material dates under this ground of opposition do not alter my ultimate conclusion regarding the likelihood of confusion as was determined under the section 12(1)(d) ground of opposition. While the earlier material dates have an impact on the level of acquired distinctiveness of the Opponent's relied upon marks, the fact remains that several of the Opponent's VIVO marks (including, VIVOFIT and VIVOSMART) have been used in Canada extensively since 2015. Furthermore, although there is also less impact of the additional surrounding circumstance of a family of trademarks as an influencing factor in the determination of likelihood of confusion due to the earlier material dates, a family of marks nonetheless still exists. In any event, the remaining surrounding circumstances, as per similar reasons held in the section 12(1)(d) ground, weigh in the Opponent's favour, such that, I am not satisfied that the Applicant has discharged its legal onus to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's relied upon VIVO-formative trademarks. As such, the section 16(1)(a) ground of opposition is also successful.

Remaining Grounds of Opposition

[56] As I have already found in favour of the Opponent under two separate grounds of opposition, I will not discuss the remaining grounds of opposition.

DISPOSITION

[57] Having regard to the aforementioned, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse both application Nos. 1,863,258 and 1,861,990, pursuant to section 38(12) of the Act.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Application No. 1,863,258 for VIVO:

Goods (Nice class and statement):

- CI 9 (1) Data processing apparatus, namely, central processing units; Tablet computers; Interactive touch screen terminals; Humanoid robot with artificial intelligence; Smartglasses; USB card readers; Touch screen pens; Fingerprint scanners; Face recognition devices to unlock mobile phones; Mobile telephones; Cell phone straps; Cell phone cases; Covers of cell phones; Protective films adapted for mobile phone screens; Electronic devices used to locate lost articles employing the global positioning system or cellular communication networks, namely, wireless global tracking devices system comprised of radio transceivers used in communicating to and monitoring the distance to a mobile phone; Keyboards for mobile phones; Hands-free device for mobile phone, namely, hands-free electronic earpieces, hands-free microphones; Portable audio speaker; Headphones; Virtual reality headsets; Earphones adapted for mobile phones; Wireless headsets for smart phones; Microphones for telecommunication apparatus; Selfie sticks [hand-held monopods]; USB cables; USB cables for cell phones; Conversion plug, namely, converters for electric plugs; Plug adapters; Screens for mobile phones; Batteries, electric, namely, batteries for mobile phones; Battery chargers, namely, battery chargers for mobile phones; Mobile power banks.

Claims:

Proposed use in CANADA.

Application No. 1,861,990 for VIVO:

Services (Nice class and statement):

- CI 35 (1) Publicity agency services in the field of mobile phones, mobile phone accessories, computers, computer software, computer peripherals and consumer electronics; Presentation of goods for others on communication media, for retail purposes, namely on the Internet, on broadcast TV, in print publications, namely magazines, newspapers, on advertisement boards, on displays, and on point-of-sale displays in the field of mobile phones, mobile phone accessories, computers, computer software, computer peripherals and consumer electronics; Provision of space on websites for advertising goods and services in the field of mobile phones,

mobile phone accessories, computers, computer software, computer peripherals and consumer electronics; On-line advertising for others via a computer communications network in the field of mobile phones, mobile phone accessories, computers, computer software, computer peripherals and consumer electronics; Providing business information in the fields of business management, business organization, and accounting via a website; Organization of exhibitions for commercial and advertising purposes in the field of mobile phones, mobile phone accessories, computers, computer software, computer peripherals and consumer electronics; Import-export agency services; Sales promotion for others, namely, promoting the sales of goods and services through a consumer loyalty program in the field of mobile phones, mobile phone accessories, computers, computer software, computer peripherals and consumer electronics; Provision of an on-line marketplace for buyers and sellers of goods and services; Management and compilation of computerized databases; Arranging subscriptions for local and long distance telephone services, telephone conferencing services and videoconferencing services for others; Updating and maintenance of data in computer databases; Web indexing for commercial or advertising purposes in the field of mobile phones, mobile phone accessories, computers, computer software, computer peripherals and consumer electronics

Claims:

Proposed Use in CANADA.

SCHEDULE B

The Opponent's relied-upon trademarks:

<u>Trademark</u>	<u>Application/ Registration No.</u>	<u>Goods/services</u>
VIVOFIT VIVOSMART	TMA909,532 TMA899,032	(1) Monitoring devices for medical and non-medical purposes, namely, electronic monitor that monitors, records and displays physical activity levels, physical inactivity periods, steps walked or ran, distances covered in exercise, exercise levels achieved compared with exercise level goals, calories burned, exercise goal levels based on past exercise, quality of rest and sleep patterns.
VIVOSPORT	TMA1,081,876	(1) Monitoring devices namely wearable activity trackers not for medical purposes used to monitor body movements and speed; Global Positioning System (GPS) tracking devices namely wearable activity trackers; monitoring devices namely wearable activity trackers for calculating, monitoring, recording and displaying physical activity levels, physical inactivity periods, steps walked and ran, distances covered in exercise, exercise levels achieved compared with exercise level goals, calories burned, exercise goal levels based on past exercise, and the quality of rest and sleep patterns; devices incorporating a horological function and being used for calculating, monitoring, recording and displaying physical activity levels, physical inactivity periods, steps walked and ran, distances covered in exercise, exercise levels achieved compared with exercise level goals, calories burned, exercise goal levels based on past exercise, and the quality of rest and sleep patterns, namely, activity trackers; wearable digital electronic devices in the form of a wrist smartwatch for providing software and display

		<p>screens for viewing, sending and receiving texts, emails, physical activity and exercise data, distance and location information; electronic devices in the form of a wristband and bracelet incorporating a display screen and software for viewing, sending and receiving texts, emails, physical activity and exercise data, distance and location information, namely, activity trackers; Global Positioning Systems (GPS) software and hardware for use in navigation; Global Positioning System (GPS) tracker incorporating a watch, and parts of and fittings for the aforesaid goods.</p> <p>(2) Watches incorporating a Global Positioning System (GPS) and incorporating a GPS function; watches incorporating software and display screens for viewing, sending and receiving texts, emails, physical activity and exercise data, distance and location information; watches incorporating a Global Positioning System (GPS) tracker, parts and fittings for all the aforesaid.</p>
VIVOACTIVE	1,705,536	<p>(1) Monitoring devices (not for medical purposes); tracking devices; devices for calculating, monitoring, recording and displaying physical activity levels, and physical inactivity periods, and steps walked and ran, and distances covered in exercise, and exercise levels achieved compared with exercise level goals, and calories burned, and exercise goal levels based on past exercise, and the quality of rest and sleep patterns; apparatus and instruments for calculating, monitoring, tracking, recording and display purposes; devices incorporating a horological functions and being for calculating, monitoring, recording and displaying physical activity levels, and physical inactivity periods, and steps walked and ran, and distances covered in exercise, and exercise levels achieved compared with exercise level goals, and calories</p>

		<p>burned, and exercise goal levels based on past exercise, and the quality of rest and sleep patterns; apparatus and instruments incorporating a horological function for calculating, monitoring, tracking, recording and display purposes; Wearable digital electronic devices in the form of a wristwatch for providing software and display screens for viewing, sending and receiving texts, emails, data and information; Global Positioning Systems (GPS); software and hardware for use in navigation and for use in GPS; GPS incorporating a watch, GPS being in the nature of incorporating watches and horologic instruments; watches and horologic instruments incorporating and being in the nature of GPS; and parts of and fittings for the aforesaid goods.</p> <p>(2) Watches incorporating a Global Positioning System (GPS) and incorporating a GPS function; watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; Wearable digital electronic devices in the nature of a wristwatch incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; Horologic instruments being in the nature of incorporating a Global Positioning System (GPS); Watches incorporating a GPS; parts and fittings for all the aforesaid.</p>
VIVOMOVE	1,804,350	<p>(1) Monitoring devices (not for medical purposes); tracking devices; devices for calculating, monitoring, recording and displaying physical activity levels, physical inactivity periods, steps walked and ran, distances covered in exercise, exercise levels achieved compared with exercise level goals, calories burned, exercise goal levels based on past exercise, and the quality of rest and sleep patterns; apparatus and instruments for</p>

		<p>calculating, monitoring, tracking, recording and display purposes; devices incorporating a horological function and being for calculating, monitoring, recording and displaying physical activity levels, physical inactivity periods, steps walked and ran, distances covered in exercise, exercise levels achieved compared with exercise level goals, calories burned, exercise goal levels based on past exercise, and the quality of rest and sleep patterns; apparatus and instruments incorporating a horological function for calculating, monitoring, tracking, recording and display purposes; wearable digital electronic devices in the form of a wristwatch for providing software and display screens for viewing, sending and receiving texts, emails, data and information; electronic devices in the form of a wristband and bracelet incorporating a display screen and software for viewing, sending and receiving texts, emails, data and other information; Global Positioning Systems (GPS); software and hardware for use in navigation and for use in GPS; GPS incorporating a watch, GPS being in the nature of and incorporating watches and horologic instruments; watches and horologic instruments incorporating and being in the nature of GPS; and parts of and fittings for the aforesaid goods.</p> <p>(2) Watches incorporating a Global Positioning System (GPS) and incorporating a GPS function; watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; wearable digital electronic devices in the nature of a wristwatch incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; horologic instruments being in the nature of and incorporating a</p>
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		Global Positioning System (GPS); watches incorporating a GPS; parts and fittings for all the aforesaid.
VIVOHUB	N/A	
VIVOKI	N/A	

Appearances and Agents of Record

HEARING DATE: 2023-07-11

APPEARANCES

For the Opponent: James Green

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Gowling WLG (Canada) LLP

For the Applicant: NEOMARK Ltd.