



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 183

Date of Decision: 2023-10-30

IN THE MATTER OF AN OPPOSITION

Opponent: PEMAC Asset Management Association of Canada

Applicant: PMI Software Ltd

Application: 1779249 for PEMAC Design

INTRODUCTION

[1] PEMAC Asset Management Association of Canada, a non-profit professional organization (the Opponent), opposes registration of the trademark PEMAC Design (the Mark) which is the subject of application No. 1779249 filed by PMI Software Ltd (the Applicant). The Mark is show below:

PEMAC

[2] The Mark is applied for in association with the following goods and services:

CI 9 (1) Computer software, generated in house, for use in the management of health and safety, in the field of monitoring, management and maintenance of industrial

and manufacturing equipment, machinery and inventory; computer software, generated in house, for use in connection with stock control, tracking EHS (environmental health and safety) events and site inductions, managing contractors, audits, risk assessments, reporting and storage of data associated with the monitoring, management and maintenance of industrial and manufacturing equipment, machinery and inventory

CI 42 (1) Providing temporary use of web-based software for use in the management of health and safety in the field of monitoring, management and maintenance of industrial and manufacturing equipment, machinery and inventory; Providing temporary use of non-downloadable software for use in connection with stock control, tracking EHS (environmental health and safety) events and site inductions, managing contractors, audits, risk assessments, reporting and storage of data collected from the monitoring, management and maintenance of industrial and manufacturing equipment, machinery and inventory

[3] The opposition is based on various grounds which are primarily rooted in the assertion that the Mark is confusing with the Opponent's registered trademarks, PEMAC (TMA899076) and PEMAC & Design (TMA899030) (the Opponent's Trademarks) which are registered in association with the following services covering Nice classes 35, 37, 41 and 42:

- (1) Association services providing leadership, education and certification in the area of plant engineering, maintenance and physical asset management.
- (2) Providing a web site with information in the area of plant engineering, maintenance and physical asset management practices.
- (3) Courses, conferences and seminars in the area of plant engineering, maintenance and physical asset management practices.

[4] For the reasons set out below, I refuse the application.

THE RECORD

[5] The application for the Mark was filed on April 26, 2016, claiming a priority filing date of April 25, 2016. Several amended applications for the Mark were filed during the examination stage. These amendments deleted all filing bases and modified the statements of the remaining goods and services. A further amended application was filed during the opposition stage on May 25, 2022 which deleted the Class 41 services

and deleted numerous goods and services in Classes 9 and 42, such that the goods and services associated with the Mark read as reproduced in paragraph 2 above.

[6] The application, as amended, was advertised for opposition in the *Trademarks Journal* on May 5, 2021.

[7] On July 5, 2021, the Opponent opposed the application for the Mark by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T13, as amended June 17, 2019 (the Act).

[8] The grounds of opposition are based on sections 30(2)(d), 38(2)(a.1), 12(1)(d), 16(1)(a), 2, 38(2)(e) and 38(2)(f) of the Act. The grounds of opposition can be summarized as follows:

- (a) The application did not conform to the requirements of subsection 30(2)(d) when it was filed, in that the application did not contain the prescribed information or statement, in particular, the application did not contain an accurate date from which the applicant had used the trademark in association with each of the general classes of goods or services described in the application;
- (b) The application was filed in bad faith as the Applicant was, or ought to have been, fully aware of the Opponent's prior rights in the Opponent's Trademarks, which were previously registered, used and/or made known in Canada, but nevertheless filed the application for the Mark knowing that it could not lawfully use the Mark in Canada in association with the applied-for goods and services;
- (c) The Mark is not registrable as it is confusing with the Opponent's Trademarks which were previously registered in Canada;
- (d) The Applicant is not the person entitled to registration of the Mark as it is confusing with the Opponent's Trademarks which had previously been used and/or made known in Canada;

- (e) The Mark is not distinctive in view of the prior registration, use and/or making known of the Opponent's Trademarks;
- (f) The Applicant was not using and did not propose to use the Mark in Canada as of the filing date or any other relevant date in accordance with section 4 of the Act, or for the purposes of distinguishing or so as to distinguish the applied-for goods and services from those of others pursuant to section 2 of the Act;
- (g) The Applicant was not entitled to use the Mark in Canada in association with the applied-for goods and services as, as of the filing date, the Mark was confusing with the Opponent's Trademarks which were previously used and/or made known in Canada.

[9] The Applicant filed a counter statement denying the grounds of opposition.

[10] Only the Opponent filed evidence, with the Applicant filing a statement that it did not wish to file evidence. No cross-examinations were conducted.

[11] Both parties filed written representations.

[12] Only the Opponent requested and attended an oral hearing.

OVERVIEW OF THE EVIDENCE

Opponent's Evidence – The Snedden Affidavit

[13] Ms. Snedden is the Executive Director of the Opponent. She describes how the Opponent was founded in 1990 as "PEMAC Plant Engineering and Maintenance Association of Canada", a national non-profit having the objectives, *inter alia*, of becoming recognized as a centre for excellence in plant engineering and maintenance and forming positive and constructive links with industry and service sectors. Her responsibilities include overseeing the Opponent's trademark matters [paras 1 and 3].

[14] In her affidavit, Ms. Snedden provides general information on the corporate history and development of the Opponent's 1990 outward-facing mission statement, as

well as printouts of the Canadian registrations for the Opponent's Trademarks [paras 3 to 7, Exhibits 1, 2 and 17].

[15] Ms. Snedden also provides a description of the Opponent's range of products and services, including the types of memberships and networking opportunities offered by the Opponent, which include chapter events, conferences and education services, as well as certifications for program completions and an annual awards program which commenced in 1998 [para 8, Exhibits 5 to 14].

[16] Details of the Opponent's financials, including a summary of the Opponent's annual revenues for the years 2003 to 2021, which range from over \$56,000 to over \$1,000,000 for a total of over \$8.6 million cumulatively for those years, are provided [paras 9 and 10, Exhibit 15]. These revenues are generally derived from the Opponent's annual conference, courses, educational material sales, membership fees and advertising in the Opponent's publications, with all of these activities involving the use and display of the Opponent's Trademarks [para 11].

[17] Ms. Snedden describes the Opponent as "a not-for-profit providing opportunities to those who have some role in realizing value from physical assets to network, learn and contribute to professional practice", with the Opponent's target audience described as follows [paras 12 and 13]:

PEMAC members are actively coordinating effort to realize value from physical assets when physical assets are central to the mission of the organization. The organizations we support (individually and collectively) through our knowledge, skills, products & services have at least one of the following characteristics:

- (i) High consequence of failure such as airports;
- (ii) Capital intensive such as municipal infrastructure; and
- (iii) Process intensive such as water, chemical, or manufacturing plants.

[18] According to Ms. Snedden, the Opponent's courses approach the subject of software without reference to a specific brand or product. However, the type of computer software associated with the Mark is the same type of computer software addressed by the Opponent's courses and the goods and services associated with the

Mark would be targeted to the same audience targeted by the Opponent [paras 14 and 15].

[19] The Opponent has distributed promotional materials since its inception in 1990. A selection of promotional materials of the Opponent since 2006 is provided [para 16, Exhibit 16].

[20] Ms. Snedden provides a description of the Opponent's name change to the current name of PEMAC Asset Management Association of Canada, as well as the updated vision and mission statement from 2020 which "was intended to reflect the reality of the wider breadth of industries, service sectors, and disciplines represented by individuals who have shown interest in and identification" with the Opponent's aims. One of the considerations for this name change was to ensure that the Opponent retained its hard-earned reputation associated with the Opponent's Trademarks [paras 17 and 18, Exhibits 3 and 4].

[21] Finally, Ms. Snedden attests to the fact that she has received reports from a director of the Opponent who has been asked on "more than one occasion" whether the Opponent is selling software. Ms. Snedden considers these to be instances of actual confusion between the goods and services associated with the Mark and those of the Opponent [para 19].

PARTIES' RESPECTIVE BURDEN OR ONUS

[22] The legal onus is on the Applicant to show that the application complies with the provisions 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. Once this initial burden is met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Sections 38(2)(a) and 30(2)(d) – Non-conformance

[23] Pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application for the Mark does not conform with the requirements of section 30(2)(d) of the Act, in that the application does not contain an accurate date from which the Applicant had used the Mark in association with the applied-for goods and services, nor has the Mark been used in association with the applied-for goods and services.

[24] Section 30(2)(d) of the Act provides that an application shall contain “any prescribed information or statement”. However, the Act does not require information or a statement setting out a date of first use. Section 31 of the *Trademark Regulations*, SOR/2018-227, lists the specific information and statements that are prescribed for the purposes of section 30(2)(d) of the Act, none of which relate to a date of first use or actual use of an applied-for mark.

[25] Consequently, this ground of opposition is dismissed.

Section 38(2)(e) –Not Using and Did Not Propose to Use

[26] The Opponent pleads that the Mark is not registrable in view of section 38(2)(e) because, as of the filing date, the Applicant was not using the Mark in association with the applied-for goods and services, and the Applicant did not propose to use the Mark in Canada in association with the applied-for goods and services.

[27] The material date for this ground is the filing date of the application, namely, April 26, 2016.

[28] I find that this ground is insufficiently pleaded. The Opponent has provided no details in the statement of opposition to support this ground and the ground as pleaded is no more than a rearrangement of the wording in section 38(2)(e) of the Act, with reference to sections 2 and 4 of the Act, but no additional information.

[29] While pleadings must be read in conjunction with the evidence, there is no evidence of record that the Opponent can rely on to meet its initial evidential burden for

this ground as pleaded [see *Novopharm Ltd v Astrazeneca AB*, 2002 FCA 387 at para 8].

[30] Accordingly, the section 38(2)(e) ground is dismissed.

Section 38(2)(a.1) – Bad Faith

[31] The Opponent pleads that, as of the filing date of the application for the Mark (being the material date for this ground) or any other relevant date, the Applicant was, or ought to have been, fully aware of the Opponent's Trademarks which were previously registered, used and/or made known in Canada, yet proceeded to file the application for the Mark in a deliberate and bad faith attempt to take advantage of the reputation developed by the Opponent in the Opponent's Trademarks.

[32] It is well established that mere knowledge of another's trademark does not, in and of itself, support an allegation of bad faith [*Woot Inc v Woot Restaurants Inc / Les Restaurants Woot Inc*, 2012 TMOB 197]. Moreover, wilful blindness or a failure to inquire into a competitor's rights in a trademark is also insufficient to constitute bad faith [*Norsteel Building Systems Ltd v Toti Holdings Inc*, 2021 FC 927 (CanLII); *Blossman Gas Inc v Alliance Autopropane Inc*, 2022 FC 1794 (CanLII)]. While circumstances where an applicant is deliberately attempting to take advantage of the reputation of another can form a successful ground of opposition, this assertion must be supported by evidence [*Yiwu Thousand Shores E-Commerce Co Ltd v Lin*, 2021 FC 1040 (CanLII)].

[33] In the present case, the Opponent has not filed any evidence or provided any submissions to support its allegation of bad faith in general, or more specifically in respect of the claim that the Applicant attempted to take advantage of the Opponent's reputation. The Opponent has therefore failed to meet its initial evidential burden and the ground of opposition is rejected.

Section 12(1)(d)- Registrability

[34] The relevant date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd*, (1991), 37 CPR (3d) 413 (FCA)].

[35] An opponent's initial burden is met with respect to a section 12(1)(d) ground of opposition if the registrations relied upon remain in good standing as of the date of the opposition decision. The Registrar has discretion to check the register and I have exercised this discretion to confirm the Opponent's Trademarks remain extant [see *Quaker Oats Co of Canada Ltd./La Compagnie Quakers Oats du Canada Ltée v Menu Foods Ltd.* (1986), 11 CPR (3d) 410 (TMOB)]. I therefore find that the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[36] In considering this ground, I will focus on the Opponent's word trademark PEMAC as I consider this to represent the Opponent's best chance of success under this ground. Further, I consider use of the Opponent's PEMAC & Design trademark to also be use of the word mark PEMAC, as, in my view, the word element of the PEMAC & Design trademark stands out sufficiently within the composite trademark to maintain its identity and be recognizable as a separate trademark [see *Nightingale Interloc Limited v ProDesign Limited*, [1984] TMOB No 52, 2 CPR (3d) 535 at paras 7-8; *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA*, 1985 CanLII 5537 (FCA)]. I will assess this ground based on the Opponent's PEMAC word trademark (the Opponent's PEMAC Trademark); if the Mark is not confusing with the Opponent's PEMAC Trademark, it will not be confusing with the Opponent's composite PEMAC & Design trademark.

The Test for Confusion

[37] The test to determine the issue of confusion is set out in section 6(2) of the Act, which stipulates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods 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.

[38] Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but of the goods or services from one source as being from another. Essentially, the question here is whether a casual consumer, with an imperfect recollection of the Opponent's PEMAC Trademark, would think that the goods and services contained in the application for the Mark emanate from, are sponsored by, or are approved by the Opponent.

[39] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed 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 they 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 trademarks including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, where the Supreme Court of Canada states at paragraph 49 that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

Degree of Resemblance

[40] The Supreme Court of Canada suggested in *Masterpiece*, at paragraph 49, that a consideration of the resemblance between the marks is where most confusion analyses should start. If the marks do not resemble each other, it is unlikely that even a strong finding on other factors would lead to a finding that there is a likelihood of confusion.

[41] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but rather a matter of first impression in the mind of a casual consumer

somewhat in a hurry who sees the Mark displayed, at a time when he or she has no more than an imperfect recollection of the Opponent's PEMAC Trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor closely examine the similarities and differences between the marks [*Veuve Clicquot*, at para 20]. The preferable approach when comparing trademarks is to begin by determining whether there is an aspect of a trademark that is particularly striking or unique [see *Masterpiece* at para 64].

[42] The Mark and the Opponent's PEMAC Trademark are nearly identical in appearance, the only differences being the specific font and stylized letter E utilized in the Mark. However, by virtue of the registration of the Opponent's PEMAC Trademark, the Opponent is entitled to depict its trademark in any font, style or colour [see *Pizzaiolo Restaurants Inc v Restaurants La Pizzaiolle Inc*, 2016 FCA 265, 142 CPR (4th) 329 at paras 24-25]. The Mark and the Opponent's PEMAC Trademark are identical in sound. These factors alone support a finding that there is a high degree of resemblance between the Mark and the Opponent's PEMAC Trademark.

[43] With respect to the ideas suggested by the trademarks at issue, as noted by the Applicant, the PEMAC element of the Opponent's PEMAC Trademark appears to have originated as an acronym for the Opponent's original name – PEMAC Plant Engineering and Maintenance Association of Canada, with the PEMAC element being an acronym for Plant Engineering and Maintenance Association of Canada [Applicant's written representations, para 30].

[44] However, the Opponent changed its name in early 2020 to PEMAC Asset Management Association of Canada to better represent the scope of services it offered, making the PEMAC element of the Opponent's PEMAC Trademark arguably less recognizable as an acronym (given that the Opponent's name no longer included the wording that corresponds with the acronym). In my view, since the Opponent's name change, despite the fact that PEMAC may have originated as an acronym and some consumers may be aware of this, PEMAC would be as, if not more, likely to be viewed on first impression as a coined word than as an acronym, meaning that the idea

suggested by the Opponent's PEMAC Trademark is not particularly clear. In my view, it is likely the word PEMAC in both the Opponent's PEMAC Trademark and the Mark does not convey any particular idea, as the term in the trademarks of both parties is likely to be viewed as a coined word.

[45] Given that the Mark and the Opponent's PEMAC Trademark are identical in sound, nearly identical in appearance and, in my view, both likely to be viewed as coined words with no clear difference in idea suggested, this factor favours the Opponent.

Length of Time the Trademarks Have Been in Use

[46] The Opponent's uncontested evidence, namely the Snedden Affidavit, states that the Opponent's PEMAC Trademark has been consistently and extensively used by the Opponent since the 1990s [Snedden Affidavit, para 8].

[47] More specifically, the Opponent's evidence provides the following dates of first use for its various services:

- Courses, conferences and seminars in the area of plant engineering, maintenance and physical asset management practices – since at least as early as 1998 [Snedden Affidavit, para 6];
- Educational programs – since 1999 [Snedden Affidavit, para 8(c)];
- Operation of the website *pemac.org* – since 1996 [Snedden Affidavit, para 5].

[48] As there is no evidence of record of use of the Mark, this factor favours the Opponent.

Inherent and Acquired Distinctiveness

[49] The Opponent submits that the Opponent's PEMAC Trademark has relatively high inherent distinctiveness as well as significant acquired distinctiveness and is therefore entitled to a wide ambit of protection [Opponent's written representations, para 58].

[50] The Applicant submits that the Opponent's PEMAC Trademark is an acronym and that, as acronym marks are generally considered to be weak in inherent distinctiveness, the Opponent's PEMAC Trademark is entitled to a very narrow scope of protection [Applicant's written representations, para 12].

[51] In support of its position, the Applicant relied on several cases in its written representations where the trademarks at issue (both those of the opponents and those of the applicants) were acronyms, or coined terms that could be considered acronyms, for the assertion that acronym marks are inherently weak marks that are not entitled to a broad ambit of protection [see *Chartered Professional Accountants of Ontario v American Institute of Certified Public Accountants*, 2021 FC 35; *Information Technology Association of Canada v Siemens Aktiengesellschaft* (1996), 67 CPR (3d) 71; and *ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056]. While it is true there is a generally accepted principle that acronym trademarks are inherently weak subject to other factors such as acquired distinctiveness, as noted above and discussed further below, while the term PEMAC in the Opponent's PEMAC Trademark may have originated as an acronym, it is not clear that it would be seen as such by the average consumer.

[52] In any event, having reviewed the acronym cases relied on by the Applicant, and considering the Opponent's submissions at the oral hearing, I am satisfied that each of these cases is distinguishable from the present case. Most importantly, none of the cited cases deal with acronyms that would appear to also be considered, structurally, a word, coined or otherwise (the acronyms at issue were CPA, CFER and ITV respectively). I also find the fact that PEMAC consists of five letters pronounceable as a single word to be significant, as it makes PEMAC appear to be more of a coined word than an acronym.

[53] Accordingly, while I agree that the Opponent's PEMAC Trademark may have originated as an acronym, I do not agree that it would necessarily be easily identifiable as such [see *CFER Technologies inc v Réseau québécois des CFER*, 2003 CanLII 70315 (CA TMOB), citing *Information Technology Association of Canada*]. I also note

that there is no evidence to specifically support the assertion that consumers would consider PEMAC as an acronym as a matter of first impression [see *Titan Capital Ventures Inc v Titan Equity Group Ltd*, 2015 TMOB 106 at para 27].

[54] In my view, it is at least as likely, if not more likely, that the Opponent's PEMAC Trademark would be considered to be a coined word. Coined words are generally considered to have a fair degree of inherent distinctiveness [see for example *Fonorola Inc v Motorola Inc*, 1998 CanLII 7365 (FC)]. With the Opponent's name change in 2020 from PEMAC Plant Engineering and Maintenance Association of Canada to the current name, the fact that PEMAC may have originally been an acronym is less apparent, which is a relevant consideration given that the material date for this ground of opposition is the date of my decision. Since an average consumer would not necessarily be aware that the Opponent's PEMAC Trademark originated as an acronym, it would likely be considered a coined word. As such, the Opponent's PEMAC Trademark has at least a fair degree of inherent distinctiveness.

[55] With respect to the Mark, as it is comprised of the same PEMAC letters as the Opponent's PEMAC Trademark, I do not find the level of inherent distinctiveness to be materially greater than that of the Opponent's PEMAC Trademark. Although the Mark does have a design element in that the letter E is depicted as three parallel lines with no adjoining vertical line, in the context of the Mark as a whole, I am of the view that this design element would be construed as the letter E, particularly as it is situated between other, easily recognizable letters. Accordingly, neither party is favoured in respect of inherent distinctiveness.

[56] As for acquired distinctiveness, as the Applicant did not file evidence of use of the Mark and the Opponent did file evidence of use of the Opponent's PEMAC Trademark, I find that only the Opponent's PEMAC Trademark has acquired some distinctiveness, through use in Canada since the dates in the 1990s listed above under the length of time in use factor.

[57] As a result, this factor favours the Opponent.

Nature of the Goods/Services or Business and Nature of the Trade

[58] When considering these factors in the assessment of confusion, it is the statement of goods and services as defined in the registration relied upon by the Opponent and the statement of goods and services in the application for the Mark that govern the assessment of the likelihood of confusion [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[59] Both parties made submissions regarding their respective goods and services as well as the nature of the businesses associated with their respective trademarks.

[60] The Opponent submits that “the specific industries that the Applicant and Opponent target are the same” and that “the type of computer software that is offered in association with [the Mark] is, in fact, the same type of computer software” addressed in the Opponent’s courses [Opponent’s written representations, paras 53 and 54, Snedden Affidavit, para 15].

[61] As the Opponent noted in its submissions, Ms. Snedden was not cross-examined on her affidavit and the evidence contained in the Snedden Affidavit is uncontroverted [Opponent’s written representations, para 11]. The Opponent also noted that the Applicant failed to file any evidence in this proceeding and, therefore, the record contains no evidence of the nature of the Applicant’s business or trade.

[62] For its part, the Applicant submits that the services of the parties “are so dissimilar that they are not likely to be sold in the same setting or business transaction and they are not within the same or similar category of goods or services” [Applicant’s written representations, para 122].

[63] Based on a reading of the goods and services in the application for the Mark and the services in the registration for the Opponent’s PEMAC Trademark, as well as considering the only evidence on file is the Snedden Affidavit, I am unable to conclude that there is a notable difference in the nature of the trades of the parties.

[64] I note that although the Applicant amended the application for the Mark during the opposition proceeding to narrow and further specify the applied-for goods and services, I consider there to still be an overlap in the nature and potential channels of trade of the goods and services of the parties.

[65] Specifically, the services associated with the Opponent's PEMAC Trademark, being educational, information and association services, are all qualified by the words "...in the area of plant engineering, maintenance and physical asset management practices". The amended application for the Mark has qualified the associated goods and services as being computer software, *inter alia*, "for use in the management of health and safety, in the field of monitoring, management and maintenance of industrial and manufacturing equipment, machinery and inventory". In the absence of evidence to the contrary, I am of the view that the industrial and manufacturing equipment, machinery and inventory referred to in the statement of goods and services for computer software in the application for the Mark are the types of "physical assets" that would be covered by the educational, information and association services in the registration for the Opponent's PEMAC Trademark.

[66] The fact that the Applicant has narrowed the statement of goods and services in the application for the Mark to the area of health and safety does not affect this apparent overlap, given that the statements of services in the registration for the Opponent's PEMAC Trademark are broad enough to cover this operational aspect of plant engineering, maintenance and physical asset management practices. While the type of goods and services of the parties may themselves appear initially distinguishable (i.e. software vs educational, informational and association services), the overlap in the specific, and arguably overlapping, fields and channels of trade, is significant.

[67] These factors therefore favour the Opponent.

Surrounding Circumstances – Opponent's Family of Trademarks

[68] The Opponent submits that its use of its PEMAC and PEMAC & Design trademarks establishes a family of trademarks and, accordingly, there is an increased

likelihood that a consumer would assume that the Mark, which contains the same PEMAC element, is simply another product or line of the Opponent [Opponent's written representations, para 60].

[69] The law is clear that a party seeking to establish a family of marks must establish that it is using more than one or two trademarks within the alleged family [see *Techniquip Ltd v Canadian Olympic Assn* (1998), CanLII 7573 (FC); and *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)].

[70] The Opponent's reliance on only two trademarks containing the PEMAC element to support its assertion of a family of marks is insufficient. This is therefore not a factor that assists the Opponent.

Surrounding Circumstances – Actual Confusion

[71] The Opponent refers to the following statement in the Snedden Affidavit to support the assertion that there has been actual confusion in the marketplace, in that consumers thought the goods and services associated with the Mark were being offered by the Opponent [para 19]:

I have received reports from [a director of the Opponent] who has been asked whether [the Opponent] is selling software on more than one occasion. As [the Opponent] is not selling software, this appears to be instances [sic] of actual confusion between [the Opponent] and [the Applicant] as a source of the software which is being offered for sale.

[72] Hearsay issues aside, the fact that the Opponent may have received more than one inquiry as to whether it sells software, without any actual connection to the Applicant, is insufficient to be considered an instance of actual confusion between the parties and their respective goods and services. Rather, this statement in the Snedden Affidavit is pure speculation and, as such, is not a factor that benefits the Opponent.

Conclusion

[73] Having considered all of the surrounding circumstances, I find that the Applicant has failed to meet its burden of establishing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's PEMAC

Trademark. Accordingly, pursuant to section 6(2) of the Act, I find that the use of the Mark and the Opponent's PEMAC Trademark in the same area would likely lead to the conclusion that the goods and services associated with these trademarks are manufactured, sold, leased, hired or performed by the same person even though these goods and services are not in the same general classes or in the same classes of the Nice Classification.

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

Sections 38(2)(c) and 16(1)(a) - Entitlement

[75] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark as the Mark is and was confusing with the Opponent's Trademarks, which were previously used and/or made known in Canada.

[76] As the Applicant has not filed any evidence of use of the Mark, the material date for this ground of opposition is the priority filing date of the application, being April 25, 2016. The Opponent has met its initial burden for this ground through its evidence of use of each of the Opponent's Trademarks since the 1990s. There is no evidence that either of the Opponent's Trademarks had been abandoned as of the date of advertisement of the Mark, being May 5, 2021.

[77] The assessment of likelihood of confusion for this ground of opposition is based on the same factors as those under section 12(1)(d) and, for the same reasons set out above, I will focus the assessment of this ground on the Opponent's PEMAC Trademark. However, the applicable material date is roughly seven and a half years earlier for this ground. This earlier material date may affect the assessment of the factors of degree of resemblance (in particular, idea suggested) and length of time in use, as well as that of inherent and acquired distinctiveness. I will assess these factors in turn below.

Degree of Resemblance

[78] The earlier material date for this ground does not impact my assessment in respect of the appearance and sound of the trademarks at issue, as these remain the

same as in the above assessment under section 12(1)(d). However, the earlier material date for the present ground could arguably affect the idea suggested by the Opponent's PEMAC Trademark given that the average consumer may have had a higher level of awareness that the Opponent's PEMAC Trademark represented an acronym for Plant Maintenance and Engineering Association of Canada, i.e. PEMAC, as opposed to it being a coined word. Despite that this may lead to the conclusion the Mark and the Opponent's PEMAC Trademark differed to some extent in idea suggested as of the material date, I do not consider this difference to be sufficient to tip this factor in favour of the Applicant.

Length of Time in Use

[79] In the present case, the Opponent's evidence of use dates back to the 1990s. With no evidence of use of the Mark on record, the Opponent remains favoured by the factor of length of time in use, albeit for a lesser period of time.

Inherent and Acquired Distinctiveness

[80] As the Opponent did not change its name until 2000, at the material date it was operating under the name PEMAC Plant Engineering and Maintenance Association of Canada. While I believe it is more likely an average consumer may have had a higher awareness that the Opponent's PEMAC Trademark represented an acronym for the wording Plant Engineering and Management Association of Canada in 2016 than currently in 2023, I remain of the view that it is at least as likely an average consumer would view PEMAC in the Opponent's PEMAC Trademark as a coined word. Therefore, although the inherent distinctiveness of the Opponent's PEMAC Trademark may have been somewhat lower at the material date for this ground, the Opponent's PEMAC Trademark still had at least a fair amount of inherent distinctiveness.

[81] Further, even if I were to find that the Mark had a higher level of inherent distinctiveness than the Opponent's PEMAC Trademark at the material date, there is no evidence of use of the Mark and therefore no evidence to support a finding of acquired distinctiveness. In contrast, the Opponent has provided evidence of use of the

Opponent's PEMAC Trademark commencing from various dates in the 1990s and therefore remains favoured by this factor.

[82] As the earlier material date for this ground does not have a substantive impact on my conclusion regarding the assessment of confusion, I find the opposition is also successful on the section 16(1)(a) ground.

Remaining Grounds of Opposition

[83] As I have already found in the Opponent's favour in respect of the section 12(1)(d) and 16(1)(a) grounds of opposition, I will refrain from addressing the remaining grounds of opposition raised under sections 38(2)(d) and 38(2)(f).

DISPOSITION

[84] 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.

Leigh Walters
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-07-18

APPEARANCES

For the Opponent: Harvey Lim

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Gowling WLG (Canada) LLP

For the Applicant: Cynthia D. Mason