



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 49

Date of Decision: 2024-03-20

IN THE MATTER OF AN OPPOSITION

Opponent: Honor Device Co., Ltd.

Applicant: Shenzhen Honor Electronic Co., Ltd

Application: 1,974,478 for HONOTO

OVERVIEW

[1] Shenzhen Honor Electronic Co., Ltd (the Applicant) has filed to register the trademark HONOTO (the Trademark), in association with the following goods:

High-frequency switching power supplies; plug adapters; mobile phone chargers; USB chargers; electric transformers; automotive battery chargers; inverters for power supply; printed circuit boards incorporating integrated circuits; cell phone battery chargers for use in vehicles; computer power supplies; uninterruptible power supplies; DC/DC converters; voltage stabilizing power supply; converters for electric plugs; rectifier modules; programmable electronic data acquisition and control apparatus for environmental monitoring, environmental control, energy management, plant irrigation, plant nutrient management, alarm monitoring and alarm event management within horticultural production; high voltage transformers; semiconductors; integrated circuits; microwave antennas.

[2] Honor Device Co., Ltd. (the Opponent) has opposed the application primarily based on an alleged likelihood of confusion with the Opponent's HONOR and HONOR-formative trademarks.

[3] For the reasons that follow, the opposition is rejected.

THE RECORD

[4] Application No. 1,974,478 was filed in Canada on July 9, 2019, and advertised for opposition purposes in the *Trademarks Journal* of June 15, 2022. On August 9, 2022, the Opponent opposed the application by filing a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[5] The Applicant filed a counter statement.

[6] Neither party filed evidence. Only the Applicant filed written representations and no hearing was requested.

ONUS AND LEGAL BURDEN

[7] 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 registration of the Trademark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298, 1990 CanLII 11059; *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29].

REASONS

Section 38(2)(b) ground of opposition

[8] The Opponent pleads that the Trademark is not registrable in view of section 12(1)(d) of the Act because it was confusing with each of the Opponent's 38 registered trademarks identified at paragraph 3 of its statement of opposition and listed in Schedule A to this decision (the Opponent's Marks).

[9] The material date to assess this ground is the date of my decision.

[10] Each of the Opponent's Marks include or are comprised of the term HONOR. The range of goods specified in the registrations is relatively broad, notably covering home appliances, furniture and home goods, vehicles such as motor cars, electric scooters and unicycles, televisions, cameras, smart watches, humanoid robots with artificial intelligence, portable media players, computers and computer-related goods such as monitors, keyboards and software. Some of the registrations also cover related services such as "quality control, namely, providing quality assurance in the field of computer software".

[11] I will start by considering the likelihood of confusion between the Trademark and the Opponent's word mark HONOR, registration Nos. TMA921,525, TMA1,066,405 and TMA1,088,997 (the HONOR Registrations). I consider the HONOR Registrations to represent the Opponent's strongest case under this ground.

[12] I have exercised the Registrar's discretion to confirm that the HONOR Registrations are extant. Hence, the Opponent has met its evidential burden. The Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Trademark and those registered trademarks.

Test for confusion

[13] The test for confusion is set out in section 6(2) of the Act which provides 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 associated with those trademarks are manufactured or sold by the same person, whether or not the goods are of the same general class or appear in the same class of the Nice Classification. Therefore, section 6(2) of the Act does not deal with confusion between trademarks themselves, but with the likelihood that goods from one source will be perceived as being from another source.

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

[15] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods and 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 [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54].

Nature of the goods or business; and nature of the trade

[16] Under a registrability ground of opposition, the statements of goods and services in an applicant's application and in an opponent's registration must be assessed having regard to the channels of trade that would normally be associated with such goods and services [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Henkel Kommandit-gesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)].

[17] As indicated above, the Opponent's registrations cover a fairly broad range of goods. Of particular interest in this proceeding, I note the following goods which are listed in at least one of the HONOR Registrations:

- batteries, namely, general purpose batteries and batteries for mobile phones;
- rechargeable batteries for smart phones, tablet computers and portable computers;
- electric batteries for cellular phones;
- battery chargers;
- battery chargers for cellular phones, smartphones, tablet computers and portable computers;
- wireless chargers for vehicles, namely, wireless cell phone battery chargers for use in vehicles;
- electrical plugs and sockets;
- USB adapters;
- USB cables for cellular phones;
- USB chargers;
- plug contacts (electric connections), namely, converters for electric plugs;
- converters, electric;

- electronic chips for the manufacture of integrated circuits; and
- electric monitoring apparatus, namely, electric monitors for security purposes.

[18] The Applicant's application covers identical and similar goods such as "mobile phone chargers", "USB chargers", "cell phone battery chargers for use in vehicles", "converters for electric plugs", and "DC/DC converters". The application also covers what appear to be goods related to those of the Opponent, such as "plug adapters", "electric transformers", "integrated circuits", and "printed circuit boards incorporating integrated circuits".

[19] In light of the above, at a minimum, I consider that the parties' goods overlap.

[20] In the absence of evidence regarding their businesses and channels of trade, and without the benefit of written submissions from either party on this point, I find it reasonable to infer that the nature of the parties' businesses and channels of trade could also overlap.

[21] Accordingly, these factors favour the Opponent.

Inherent distinctiveness of the trademarks

[22] Both parties' trademarks possess at least some inherent distinctiveness in view of the fact that neither HONOR nor HONOTO are descriptive of any aspect of the relevant goods.

[23] I consider the Trademark to possess more inherent distinctiveness given that it is a coined word having no meaning, whereas HONOR is a dictionary word with an arguably laudatory connotation.

[24] As such, I find that this factor favours the Applicant.

Extent known and length of time in use

[25] There is no evidence before me regarding use of the parties' trademarks or the extent to which these have become known in Canada.

[26] While I note that the Opponent's registration No. TMA921,525 includes a declaration of use dating back to November 27, 2015, in the absence of any evidenced use of the Opponent's trademark and of a certified copy of its relied-upon registration, I would refrain from even inferring *de minimis* use [see *Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951 at para 37]. In any event, *de minimis* use would not support a conclusion that the trademark has become known to any significant extent, nor that the trademark has necessarily been used continuously since the declared date [see *Krauss-Maffei Wegmann GmbH & Co KG v Rheinmetall Defence Electronics GmbH*, 2017 TMOB 50].

[27] As such, these factors are neutral.

Degree of resemblance between the trademarks

[28] When considering the degree of resemblance, the law is clear that the marks must be considered in their totalities; it is not the correct approach to lay the trademarks side by side and compare and observe similarities or differences among the elements or components of the marks.

[29] According to the Supreme Court of Canada, while the first portion of a trademark is often considered more important for assessing the likelihood of confusion, the preferable approach is to begin by determining whether there is an aspect of the trademark that is particularly striking or unique [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD); and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 64].

[30] The trademarks at issue are each comprised of a single word and I consider no specific aspect of them to particularly stand out when each is taken in its entirety. In other words, the striking aspect of the parties' trademarks HONOR and HONOTO are the trademarks as a whole, respectively.

[31] While the trademarks bear at least some degree of similarity to each other owing to their identical first portion, I do not consider that the shared HONO- element is sufficient to conclude that the marks are similar. In my view, such a conclusion would fail to take into account the totalities of the marks and the different overall impressions they create, as further discussed below.

[32] First, when sounded in their totalities, the trademarks share a low degree of resemblance. The Trademark is likely to be pronounced "ho-no-to", starting with a sounded letter H, followed by a long "O" sound (as in the words *boat* or *snow*) repeated in each of the three syllables. On the other hand, the Opponent's trademark is likely to be pronounced like the English word *honor* ("ahn-uhr"), that is to say, a two-syllable word starting with a silent letter H and without any long "O" sounds.

[33] Moreover, given that HONOR is a common dictionary word, I find it unreasonable to conclude that ordinary consumers would be particularly drawn to only the first four letters of the Opponent's trademark. In any event, to consider only those letters would be tantamount to engaging in an improper side-by-side comparison, and dissecting that trademark into its component parts rather than considering it as a whole.

[34] As for the ideas conveyed, the Opponent's trademark conveys the meaning ascribed to the word *honor*, whereas the Trademark – as submitted by the Applicant – is a coined word with no apparent meaning in the English

or French languages. As such, there is no resemblance in the ideas conveyed by the marks at issue.

[35] On balance, I find that the differences between the trademarks outlined above, and particularly the phonetic and conceptual differences, outweigh the similarities resulting from the shared first portion.

[36] Accordingly, this important factor favours the Applicant.

Conclusion on likelihood of confusion

[37] Considering all of the surrounding circumstances discussed above, I find that the Applicant has met its onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Trademark and the HONOR Registrations. I come to this conclusion bearing in mind the Supreme Court of Canada's guidance in *Masterpiece*, namely that the degree of resemblance between the trademarks will often have the greatest effect on the confusion analysis [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49].

[38] Indeed, I find that as a matter of first impression and imperfect recollection, the differences between the trademarks at issue are sufficient to avoid a likelihood of confusion as to the source of the parties' respective goods. I come to this conclusion despite the substantially similar nature of the parties' goods and the potential for overlap in their channels of trade.

[39] As I consider the HONOR Registrations to represent the Opponent's strongest case, it follows that the Opponent would not succeed with respect to any of the Opponent's pleaded registrations. Consequently, the registrability ground of opposition under section 12(1)(d) of the Act is rejected.

Sections 38(2)(c) and (d) grounds of opposition

[40] The Opponent pleads that:

- the Applicant is not entitled to registration of the Trademark in view of section 16(1)(a) of the Act because the Trademark was confusing with the HONOR Trademarks previously used by the Opponent in Canada;
- the Applicant is not entitled to registration of the Trademark in view of section 16(1)(c) of the Act because the Trademark was confusing with the Opponent's trade name Honor Device Co., Ltd. used by the Opponent in Canada; and
- contrary to section 2 of the Act, the Trademark is not distinctive of the Applicant's goods because the Trademark does not actually distinguish those goods from those of the Opponent, nor is it adapted to so distinguish them.

[41] The material date for assessing the section 16 non-entitlement grounds here is the filing date of the application. The material date for assessing the section 2 non-distinctiveness ground is the date of filing of the statement of opposition.

[42] As indicated above, the Opponent has provided no evidence whatsoever. Therefore, there is no evidence of record with which the Opponent could meet its initial evidential burden for the section 2, 16(1)(a) and 16(1)(c) grounds of opposition, nor would *de minimis* use satisfy that burden if I were even prepared to infer it.

[43] Accordingly, these grounds of opposition are dismissed.

Section 38(2)(a) ground of opposition

[44] The Opponent pleads that the application does not comply with the requirements of section 30, namely to contain a statement in ordinary

commercial terms, because the term “programmable electronic data acquisition and control apparatus for environmental monitoring, environmental control, energy management, plant irrigation, plant nutrient management, alarm monitoring and alarm event management within horticultural production” does not have the degree of specificity required by the Act.

[45] The material date to assess this ground is the filing date of the application.

[46] Although the Opponent’s evidential burden is light under this ground, there is no evidence in this proceeding and the Opponent did not provide submissions detailing why this description does not meet the requirements of section 30(2)(a) of the Act.

[47] Accordingly, this ground of opposition is dismissed.

Section 38(2)(e) ground of opposition

[48] The Opponent pleads that the Applicant was not using and did not propose to use the Trademark in Canada, the Applicant never having the “specific intention” to use the Trademark in association with each of the goods specified in the application, nor the “commercial/industrial/scientific capacity/means to use same” in association with those goods.

[49] The material date to assess this ground is the filing date of the application.

[50] It is not clear that the Opponent’s speculative allegation regarding the Applicant’s *intention* to use the Trademark falls within the scope of section 38(2)(e) of the Act. Indeed, when an applicant applies for a trademark that it has not used, pursuant to section 30(1) of the Act, that applicant proposes to use the trademark. The allegation that an applicant

has no intention to use that trademark, *e.g.* trademark “squatting”, is more appropriately pled as a bad faith ground.

[51] In any event, no evidence has been filed in this proceeding. As such, there is no evidence to support the Opponent’s allegations and, as a result, the Opponent has failed to meet its evidential burden in respect of this ground of opposition.

[52] Accordingly, this ground is also dismissed.

Section 38(2)(a.1) ground of opposition

[53] The Opponent pleads that the application was filed in bad faith because:

- the Applicant was aware of the Opponent’s Marks and the Opponent’s trade name which are confusingly similar to the Trademark;
- the Applicant filed the application for trafficking purposes, not having used the Trademark in Canada or not having a true intent to do so;
- the Applicant filed the application for defensive purposes only, not having used the Trademark in Canada or not having a true intent to do so in association with each of the goods covered by the application;
- the Applicant is a competitor of the Opponent and applied for the registration of the Trademark only in order to disturb the Opponent in its use of its trademarks and/or trade names;
- the Applicant filed the application with the intent to usurp the legitimate rights of the Opponent, and with the intent to disrupt the business of the Opponent and create confusion with the goods and/or services of the Opponent; and

- the Applicant filed the application with the intent to disrupt the business of the Opponent and divert traffic to the website and business of the Applicant.

[54] The material date to assess this ground of opposition is the filing date of the application.

[55] I note that 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]. Otherwise, while circumstances where an applicant is attempting to take advantage of the reputation of another can form a successful ground of opposition, such assertions must be supported by evidence [*Yiwu Thousand Shores E-Commerce Co Ltd v Lin*, 2021 FC 1040].

[56] In the present case, there is no evidence from which the Opponent can meet its initial evidential burden under this ground.

[57] Accordingly, this ground of opposition is dismissed.

Section 38(2)(f) ground of opposition

[58] The Opponent pleads that, at the filing date of the application in Canada, the Applicant was not entitled to use the Trademark in Canada. The Opponent's specific allegations under this ground of opposition, summarized below, mirror many of those under the bad faith ground and rely essentially on its allegation that the parties' trademarks are confusingly similar:

- the Applicant was aware or is deemed to have been aware of the Opponent's Marks and filed the application with knowledge that use of the Trademark would create confusion with the "trademarks and/or trade names" of the Opponent;

- that use of the Trademark by the Applicant would be contrary to sections 7(b), 20, and 22 of the Act; and
- that the Applicant filed the application for trafficking purposes, for defensive purposes, and in order to disturb the Opponent in its use of its trademarks and/or trade names.

[59] The material date to assess this ground is the filing date of the application.

[60] As was the case for the bad faith ground, there is no evidence with which the Opponent could meet its initial evidential burden.

[61] Accordingly, this ground is also dismissed.

DISPOSITION

[62] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Eve Heafey
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A***The Opponent's Marks***

Reg. No.	Type	Trademark
TMA921,525	Word mark	HONOR
TMA1,047,399	Word mark	HONOR 8C
TMA1,047,400	Word mark	HONOR 6X
TMA1,047,401	Word mark	HONOR 5X
TMA1,047,410	Word mark	HONOR 10X
TMA1,047,411	Word mark	HONOR 10C
TMA1,047,412	Word mark	HONOR 7C
TMA1,047,413	Word mark	HONOR 9C
TMA1,047,414	Word mark	HONOR 8X
TMA1,047,415	Word mark	HONOR 9A
TMA1,047,416	Word mark	HONOR 5A
TMA1,047,417	Word mark	HONOR 7A
TMA1,047,429	Word mark	HONOR 7X
TMA1,047,430	Word mark	HONOR 9X
TMA1,047,431	Word mark	HONOR 6A
TMA1,047,446	Word mark	HONOR 6C
TMA1,047,447	Word mark	HONOR 8A
TMA1,047,454	Word mark	HONOR 5C
TMA1,047,455	Word mark	HONOR 10A
TMA1,056,449	Design	Honor View
TMA1,066,405	Word mark	HONOR
TMA1,074,004	Design	honor Play
TMA1,077,671	Word mark	HONOR MAGICBOOK
TMA1,088,997	Word mark	HONOR

TMA1,108,143	Design	HONOR MagicLink
TMA1,114,883	Design	HONOR
TMA1,115,396	Word mark	HONOR VERA
TMA1,116,586	Design	HONOR MagicWatch
TMA1,116,633	Design	HONOR MagicPad
TMA1,116,689	Word mark	HONOR MY WORLD
TMA1,127,364	Design	HONOR Xtra
TMA1,127,479	Design	HONOR Vpad
TMA1,127,481	Design	HONOR MagicBuds
TMA1,127,482	Design	HONOR ViewBand
TMA1,127,490	Design	HONOR ViewPad
TMA1,127,560	Design	HONOR MagicBand
TMA1,127,561	Design	HONOR Magic-Pencil
TMA1,127,569	Design	HONOR Watch ES

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: Robic Agence PI S.E.C./Robic IP Agency LP

For the Applicant: Xin Xu