



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2024 TMOB 50

**Date of Decision:** 2024-03-20

## IN THE MATTER OF AN OPPOSITION

**Opponent:** Ralf Hütter

**Applicant:** Emily Shultz Inc.

**Application:** 1,893,137 for KRAFTWURK

### INTRODUCTION

[1] Emily Shultz Inc. (the Applicant) has applied to register the trademark KRAFTWURK (the Mark) in association with specialized skin care products and services.

[2] The application for the Mark is being opposed by Ralf Hütter (the Opponent), who is the owner of the trademark KRAFTWERK, which is also the name of his musical band. The Opponent asserts that the trademark KRAFTWERK has accrued considerable fame and goodwill as a result of the band and its reputation for arranging and organizing concerts and musical performances since at least as early as 1975.

[3] The Opponent opposes this application primarily on two basis: that the Mark falsely suggests a connection with a musical band pursuant to section 9(1)(k) of the

*Trademarks Act*, RSC 1985, c. T-13 (the Act) and/or that the Mark is confusing with the Opponent's prior use and registration of its trademark KRAFTWERK.

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

### **THE RECORD**

[5] The application for the Mark was filed on April 11, 2018, on the basis of proposed use in Canada in association with the with the goods and services in the Nice Classes noted in Schedule A attached to this decision (the Goods and Services). The Mark was advertised in the *Trademarks Journal* on December 1, 2021.

[6] The Opponent filed a statement of opposition against the Mark pursuant to section 38 of the Act on January 18, 2022. The Applicant filed and served a counter statement generally denying the grounds of opposition on March 1, 2022.

[7] In support of its opposition, the Opponent submitted the affidavits of Günter Spachtholz and Meghan Carlin. In support of its application, the Applicant submitted the affidavits of Emily Shultz and Rachel Sombach. None of the affiants were cross-examined.

[8] Both parties submitted written representations. Only the Applicant was represented at the hearing.

### **GROUND OF OPPOSITION**

[9] The grounds of opposition may be summarized as follows:

- Pursuant to section 38(2)(a.1) of the Act, the Mark is not registrable as the Applicant applied for registration in Canada with a view to misappropriating the goodwill existing in Canada in association with the Opponent's KRAFTWERK mark (the Opponent's trademark) previously used in Canada in association with the Opponent's goods and services registered under No. TMA1,011,616;

- Pursuant to section 12(1)(d) of the Act, the Mark is not registrable as it is confusing with the Opponent's trademark, registered under registration No. TMA1,011,616;
- Pursuant to section 12(1)(e) of the Act, the Mark is not registrable because it falsely suggests a connection with a musical band pursuant to section 9(1)(k) of the Act, namely the band KRAFTWERK, which had a significant public reputation in Canada;
- Pursuant to section 16(1)(a) of the Act, the Applicant is not the person entitled to registration in that at either the filing date or the date of first use in Canada, the Mark was confusing with the Opponent's trademark previously used or made known in Canada;
- Pursuant to section 16(1)(b) of the Act, the Applicant is not the person entitled to registration of the Mark applied for in that, at the date of filing of the Application or the date of first use of the trademark in Canada, it was confusing with the Opponent's trademark for which an application for registration had been previously filed in Canada;
- Pursuant to section 2 of the Act, the Mark does not actually distinguish nor is adapted to distinguish the Applicant's Goods and Services from those of the Opponent owing to the Opponent's prior use of the Opponent's trademark;
- Pursuant to section 38(2)(e) of the Act, at the filing date of the application the Applicant was not using and did not intend to use the Mark in Canada in association with each of the Goods and Services; and
- Pursuant to section 38(2)(f) of the Act, at the filing date of the application, the Applicant was not entitled to use the Mark in Canada in association with the Goods and Services since the Mark was confusing with the Opponent's trademark.

### **LEGAL ONUS AND EVIDENTIAL BURDEN**

[10] An applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, an opponent

must first adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

**REGISTRABILITY GROUND – SECTION 12(1)(D)**

[11] The Opponent has pleaded that the Mark is not registrable because, contrary to section 12(1)(d), the Mark is confusing with the Opponent's trademark KRAFTWERK registration No. TMA1,011,616.

[12] At the hearing, the Applicant's agent brought to my attention the recently issued section 45 decision in *Emily Shultz Inc v Ralf Hütter*, 2023 TMOB 199, in which the Opponent's KRAFTWERK registration was amended to delete certain goods and services. The amended goods and services of this registration are as follows:

Goods

- (1) 3D glasses.
- (2) Clothing, namely, sportswear; headgear, namely, hats.
- (3) Games, namely, video games.
- (4) T-shirts.
- (5) Cycling jerseys; backpacks; pre-recorded DVDs containing musical performances.
- (6) 3-D books.
- (7) Photo books.

Services

- (1) Arranging and organization of concerts and musical performances.

[13] As the Opponent's registration covering the above goods and services remains extant, the Opponent has met its initial burden. The Applicant must therefore prove on a

balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark.

[14] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd*, 1991 CanLII 11769 (FCA)].

[15] In determining whether two trademarks are confusing, all the surrounding circumstances should be considered, including those listed in section 6(5) of the Act: 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 and 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. 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; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23].

Inherent distinctiveness of the trademarks and the extent to which they have become known

[16] The inherent distinctiveness of a trademark refers to its uniqueness when considered with its associated goods and/or services. In this case, the parties' trademarks possess a fair degree of inherent distinctiveness because they contain the foreign word KRAFTWERK, or its phonetic equivalent KRAFTWURK, which holds no meaning in English or French in relation to the parties' goods or services [*Bedessee Imports Ltd v Compania Topo Chico*, 2014 TMOB 200].

[17] As for the extent known of the trademarks in Canada, the Mark is based on proposed use and the Applicant has not shown any use of the Mark in association with the Goods or Services. While Rachel Sombach, articling student with the Applicant's agent, did provide printouts from the Applicant's website showing the promotion primarily of the Applicant's Services in association with the Mark, there is no data on the number of Canadian visitors to this website. I am therefore unable to conclude that the Mark has become known to any extent in Canada.

[18] As for the Opponent's KRAFTWERK trademark, the Opponent has provided the affidavits of Gunter Spachtholz and Meghan Carlin to show the extent known of the KRAFTWERK trademark in Canada. Gunter Spachtholz is Manager of Kling Klang Konsum Produkt GmbH, a company solely and entirely owned by the Opponent that was incorporated to sell and market goods and services associated with the Opponent's KRAFTWERK band. Pertinent portions of the Spachtholz affidavit are summarized below:

- The band Kraftwerk was founded in Dusseldorf, Germany by the Opponent and Florian Schneider.
- In 1974, the Opponent released an album and song, both titled "Autobahn", which peaked at number five in the Canadian album charts and was the 35th bestselling album of 1975 in Canada.
- The Opponent has regularly performed live in Canada since 1975. The Opponent incorporates themes from its music into its live performances and since 2009, has been performing in 3D, with background graphics which complement the songs being performed. Most recently, the Opponent played in Toronto, Montreal and Vancouver in the summer of 2022.
- The Opponent also operates a website which advertises its music, tours and merchandise, and has a strong social media presence on YouTube, Twitter and Instagram.
- The Opponent has won three Grammy awards, including a lifetime achievement award from the Recording Industry Association of America in 2014 and was inducted into the Rock & Roll Hall of Fame in 2021.
- While Mr. Spachtholz does not have access to record sales of the Opponent in Canada, he confirms that the Opponent has sold its music in various formats including more than 115,960 CDS in Canada since 1997.
- The Opponent also sells goods related to the subject matter of its music including KRAFTWERK branded pocket calculators and cycling merchandise, most of which is sold at concerts.

- Sales of items bearing the KRAFTWERK trademark sold at KRAFTWERK'S three concerts in Canada in 2022 were over \$20,000 per concert.
- Since 1997, the Opponent has sold over 190,000 physical recordings or downloads of its music and since 2010, the Opponent's music has been streamed more than 12 million times in Canada.

[19] Meghan Carlin is an articling student with the Opponent's agent. Her affidavit consists of print-outs of over 500 articles from various publications and newspapers available to Canadians regarding the Opponent. In addition to international magazines and publications available to Canadians, such as The New York Times, The Washington Post, and Rolling Stone, the Carlin Affidavit includes over 160 articles from Canadian publications dating back to as early as 2005, including local and national newspapers, such as the Calgary Sun, the National Post, The Globe and Mail, The Toronto Star, The Vancouver Sun, and The Toronto Sun. While the Opponent has not provided any evidence of the circulation of the magazines and newspapers referred to in Ms. Carlin's affidavit, I can take judicial notice that there is some circulation in Canada of the newspapers and magazines set out above [see, for example, *Northern Telecom Ltd v Nortel Communications Inc* (1987), 15 CPR (3d) 540 (TMOB) at 543; *Timberland Co v Wrangler Apparel Corp*, 2005 CanLII 78532 (TMOB), 46 CPR (4th) 201 (TMOB) at 207; *Carling O'Keefe Breweries of Canada Ltd v Anheuser Busch, Inc* (1985), 4 CPR (3d) 216 (TMOB)].

[20] Based on the above, I conclude that the Opponent's KRAFTWERK trademark has become known to a considerable extent in Canada in association with the Opponent's arranging and organization of concerts and musical performances. Although the Opponent's evidence also refers to use of the Opponent's trademark with some goods, I find this evidence to be too vague to demonstrate conclusive use of the Opponent's goods contained in the Opponent's registration. I also note that the Opponent's evidence references use of its trademark with certain goods, including posters, pins and totes, that are not covered by the Opponent's registration. I therefore find that the Opponent's trademark has become known to a much lesser extent in association with the Opponent's goods than its services.

[21] In view of the above this factor favours the Opponent, at least with respect to the Opponent's services.

Length of time the trademarks have been in use

[22] The Applicant has not provided any evidence or statements regarding how long it has used the Mark in association with its goods and services in Canada.

[23] The Opponent's registration, on the other hand, is based on use in Canada since at least as early as 1975 in association with the registered services. While the Opponent's evidence does not show use dating back this far, I am satisfied from the Opponent's evidence that its mark has been used for a considerably longer period of time than the Applicant's Mark.

[24] This factor therefore favours the Opponent.

Nature of the goods and services and the channels of trade

[25] Ms. Schultz deposes that the specialized skin care products and services that she provides under the Mark include cosmetic injectables for wrinkle reduction, double chin reduction, fillers and skin boosters. Her clientele are primarily women in their 30s and 40s.

[26] As noted above, the Opponent's registered services comprise the arranging and organization of concerts and musical performances. The Opponent's registered goods, as noted above, are: (1) 3D glasses; (2) Clothing, namely, sportswear; headgear, namely, hats; (3) Games, namely, video games; (5) T-shirts; (7) Cycling jerseys; backpacks; pre-recorded DVDs containing musical performances; (8) 3-D books; (9) Photo books; (8) 3-D books; and (9) Photo books.

[27] The Opponent concedes in its written representations that the parties' goods and services are not closely related to one another. I agree. The Opponent primarily relies on the fame of its trademark which will be discussed below.

[28] With respect to the parties' channels of trade, the Opponent sells its goods through a website directly to consumers, through record companies which produce



physical copies of the musical recordings and sell in record stores and online, and via touring, selling its goods directly to consumers attending KRAFTWERK branded concerts. The Opponent's arranging and organization of concerts and musical performances have been provided in various concert venues in Canada.

[29] On the other hand, Ms. Schultz explains that due to the sophisticated and highly specialized nature of her cosmetic injectables, her services may only be performed by a licensed Health Care Professional based on their credentials and scope of practice. She further states that she first ran her patient practice through a local plastic surgeon's office before opening her brick and mortar location, and her consulting and training work is remote in other clinics.

[30] In view of the diversity between the parties' goods and services, I would not expect their channels of trade to overlap.

[31] This factor therefore favours the Applicant.

#### Similarity in appearance, sound or idea suggested

[32] The resemblance between the trademarks is often the statutory factor likely to have the greatest influence on the confusion analysis [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49].

[33] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks.

[34] The marks of each party are almost identical in terms of appearance, sound and ideas suggested. The only visual difference is the use of a "u" as opposed to an "e" in the "werk" element of the marks.

[35] Ms. Shultz deposes that she chose the Mark because of its phonetic meaning in German which is "power station" or "power house". These words reflect her core values of empowerment, namely, empowering patients to seek a high and unique standard of

care based on their individual aesthetic goals. She adds that the Mark also honours the strong German history of the Kitchener-Waterloo region in Ontario, which is where her services are offered. The Opponent also notes that the Opponent's trademark also refers to the German word for "power station".

[36] However, in the absence of evidence showing that the average Canadian would be aware of the meaning of the German word KRAFTWERK or its phonetic equivalent, I conclude that neither party's mark suggests any idea in particular.

[37] In view of the above, I find that this factor favours the Opponent.

#### Surrounding circumstances - fame of the Opponent's KRAFTWERK Trademark

[38] The Opponent submits that this case can be distinguished from the decision in *Mattel, supra*, because in this case, the Opponent's mark is well known both for its musical live performances as well its original and innovative goods which are tied to the themes and lyrics of its music. Examples of the types of original goods tied to themes and lyrics of the Opponent's music, as noted in the Spachholz affidavit, include KRAFTWERK pocket calculators to promote the Opponent's song "Pocket Calculator" and KRAFTWERK biking apparel to promote its "Tour de France" soundtrack.

[39] The Opponent appears to be suggesting that its KRAFTWERK mark has acquired a significant amount of distinctiveness in Canada to the point where it may be regarded as a well-known mark which transcends, to some extent, the goods and services covered by its registration. For example, the Opponent submits that in view of the popularity of the Opponent's song called "The Model", the fact that models are associated with cosmetics and cosmetic procedures, and the Opponent's reputation for selling unconventional and innovative merchandise not necessarily associated with a musical act, an average consumer aware of the Opponent's KRAFTWERK trademark would assume that the Applicant's specialized skin care products and services would somehow be connected or associated with the Opponent.

[40] In this case, even if I were to accept that the Opponent's trademark has become famous in Canada, the evidence does not establish that it has become famous for

anything other than the Opponent's registered services. While there is some evidence of use of the Opponent's trademark with goods (some covered by the Opponent's registration as well as others), the evidence falls short of establishing that the Opponent's trademark has achieved a level of notoriety in association with any goods that would support the conclusion that the Opponent's trademark has become famous in association with goods of any kind.

[41] Specifically, even though Mr. Spachholz states that the Opponent has sold "thousands of individual items in association with the KRAFTWERK trademark in Canada in the last decade", he does not identify what any of those products were or provide the total sales for these products. The only evidence he provides is an invoice demonstrating the sales of five different t-shirts, a tote bag, pins and posters, bearing the KRAFTWERK Trademark sold at Kraftwerk's three concerts in Canada in 2022. He confirms that on average, over 500 items were sold per concert with a value of over \$20,000 per concert. In my view, this evidence is not sufficient to show that the Opponent's trademark has achieved any level of fame in association with any goods as it has with its live musical performances.

[42] Therefore, while I find the Opponent's evidence establishes that the Opponent's trademark is well-known in association with its arranging and organization of concerts and musical performances, the Opponent's evidence does not establish that this renown would extend beyond these very specific services, such that an association would be made by the average consumer with the Goods and Services of the Applicant, which are unrelated to the goods, services, and business of the Opponent [see *Joseph E. Seagram & Sons Ltd v Seagram Real Estate Ltd* (1990), 33 CPR (3d) 454 at pp 467-68 where MacKay J. noted that consideration of possibilities of diversification is properly restricted to the potential expansion of existing operations and should not include speculation as to diversification into entirely new ventures, including new kinds of goods, services or businesses, also cited in *Mattel*, *supra* at para 82].

### Conclusion – confusion

[43] In considering whether or not there is a likelihood of confusion in this case, I have had regard to the following comments of former member Reynolds in *Ate My Heart Inc v Shortbread Bakery Ltd*, 2015 TMOB 198 at para 57 – 59:

While the fame of the Opponent's trade-mark is certainly a "surrounding circumstance" of importance, the scope of its protection requires a consideration of all of the surrounding circumstances, including the factors enumerated under section 6(5) of the Act [*Mattel, Inc v 3894207 Canada Inc* (2006) 49 CPR (4th) at 354].

The Court in *Mattel* agreed with an earlier quote from Professor McCarthy that "a relatively strong trade-mark can leap vast product line differences at a single bound". However, it also noted that implicit in this statement is the fact that the "product line" will generally represent a significant obstacle for even a famous mark to leap over [*Mattel, supra* at 355-356]. The Court stated that when all of the surrounding circumstances are taken into consideration, in some cases, some circumstances (such as a difference in goods), will carry greater weight than others [*Mattel, supra* at 354].

[44] Having considered all of the surrounding circumstances in this case, I am satisfied that the Applicant has established that there is no reasonable likelihood of confusion between the parties' goods and services associated with their respective trademarks. There is no overlap between the Goods and Services associated with the Mark and the goods and services associated with the Opponent's trademark and the Opponent has not established that there is any connection in the mind of the average Canadian consumer between the Opponent's trademark and the Applicant's specialized skin care products and services.

[45] Thus, despite how well-known KRAFTWERK may be in association with the Opponent's arranging and organization of concerts and musical performances, and despite the Opponent's lengthier use of its trademark, I have come to the conclusion that on a balance of probabilities, there is no likelihood of confusion between the parties' trademarks.

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

## **PROHIBITED MARKS – SECTION 12(1)(E)**

[47] The Opponent has pleaded that the Mark is not registrable under section 12(1)(e) of the Act, as it is a mark, the adoption of which is prohibited by section 9(1)(k) of the Act. While there is a legal burden on the Applicant to establish that its Mark is registrable and that its adoption is not prohibited by section 9(1)(k) of the Act, there is an initial evidential burden on the Opponent to adduce sufficient evidence from which it may be concluded that the band KRAFTWERK is so identified with the Opponent that the adoption and use of the Mark by the Applicant would be likely to lead to an inference that the parties' goods and services are in some way connected.

[48] The material date for assessing this ground of opposition is the date of decision [ *Villeneuve v Mazsport Garment Manufacturing Inc*, [2005] TMOB 120, at para 48].

[49] The relevant sections of the Act read as follows:

12(1) Subject to section 13, a trademark is registrable if it is not

(e) a mark of which the adoption is prohibited by section 9 or 10

9(1) No person shall adopt in connection with a business, as a trademark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for...

(k) any matter that may falsely suggest a connection with any living individual...

[50] In asserting that that paragraph 9(1)(k) applies equally to musical bands as it does to living individuals, the Opponent relies on section 4.7.7.3 of the *Trademarks Examination Manual*. Section 4.7.7.3 states the following:

### 4.7.7.3 Musical bands

Where a trademark consists of any matter which would falsely suggest a connection with a musical band, an objection may be raised pursuant to paragraph 9(1)(k) of the Trademarks Act if it is determined through research that the musical band has a significant public reputation in Canada.

The word “band” is defined in the Canadian Oxford Dictionary as “a group of musicians playing jazz, rock, or pop music”. Given on the Interpretation Act provides that “words in the singular include the plural, and words in the plural include the singular”, paragraph 9(1)(k) of the Trademarks Act applies equally to a living individual and to living individuals that have a significant public reputation in Canada.

[51] I will begin by noting that manuals, though useful, do not have legislative authority, and are not intended to, nor can they supersede the provisions of the Act [*Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266 at para 24; *Wordex Inc v Wordex*, [1983] 2 FC 570, 70 CPR (2d) 28 at 31]. As noted by the Applicant’s agent at the hearing, the Opponent in this case is Mr. Ralf Hütter. I will begin by noting that, according to the definition above, I do not think one person can be a band. Further, while Mr. Hütter is a living individual, the musical act which he is a part of is the band KRAFTWERK, which has had numerous different members over time. This is not a case where the name of the musical act is also the name of one particular living individual, such as Lady Gaga [*Ate My Heart Inc v Shortbread Bakery Ltd*, 2015 TMOB 198].

[52] Therefore, even if the Mark did falsely suggest a connection with the musical band KRAFTWERK, it is not clear to me that such connection would extend to the individual members of the band, and specifically the Opponent, for the purposes of being found unregistrable pursuant to section 9(1)(k) of the Act [for similar reasoning distinguishing an opponent’s trademark from the associated living individual under section 9(1)(k) [see *Waltrip v Boogiddy Boogiddy Racing Inc*, 2007 CanLII 80867 (TMOB)]. This ground is therefore unsuccessful.

### **ENTITLEMENT GROUND – SECTION 16(1)(B)**

[53] The Opponent pleads that the Applicant is not entitled to registration of the Mark in that, at the date of filing of the Application or the date of first use, it was confusing with the Opponent’s trademark for which an application had been previously filed.

[54] With a ground of opposition based on section 16(1)(b) of the Act, an opponent may rely on a previously filed application to register a trademark, provided that

previously filed application is still pending at the time the opposed application is advertised [section 16(2) of the Act].

[55] In this case, the application was advertised on December 1, 2020. As the Opponent's application for KRAFTWERK issued to registration on December 20, 2018, it was not pending as of the date of advertisement of the Mark.

[56] As the Opponent has not met the statutory requirements for this ground, it is accordingly dismissed.

### **ENTITLEMENT TO REGISTER – SECTION 16(1)(A) AND DISTINCTIVENESS**

[57] The section 16(1)(a) and section 2 grounds of opposition pleaded by the Opponent are based on a likelihood of confusion between the applied for Mark and the Opponent's prior use and registration of its KRAFTWERK mark.

[58] The material date for a ground of opposition under section 16(3)(a) is the date of filing of the application. The material date for a section 2 ground of opposition is the date of filing of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. Both of these grounds turn on the issue of a likelihood of confusion.

[59] In this case, the date at which the issue of confusion is assessed does not change the result of my analysis set out above in respect of the section 12(1)(d) ground. Accordingly, to the extent that the Opponent has met its initial burden in respect of these grounds, I would reach the same conclusion as with the section 12(1)(d) ground of opposition. These grounds are therefore unsuccessful.

### **NO USE OR INTENTION TO USE – SECTION 38(2)(E)**

[60] The Opponent pleads that the Applicant either was not using or did not intend to use the Mark in Canada in association with each of the Goods or Services. With respect to this ground of opposition, the Applicant is under no obligation to prove that it has used the Mark or intends to use the Mark unless the Opponent meets its evidential burden.

[61] The Opponent has failed to meet its evidential burden with respect to this ground of opposition as there is no evidence that the Applicant did not intend to use or was not using the Mark. As such, this ground of opposition is rejected.

**No RIGHT TO USE -SECTION 38(2)(F)**

[62] The Opponent pleads that contrary to section 38(2)(f) of the Act, the Applicant was not entitled to use the Mark in Canada in association with the Goods and Services as of the filing date because it was confusing with the Opponent's trademark. However, section 38(2)(f) does not address an applicant's entitlement *to register* a mark relative to another person's trademark, pursuant to section 16 of the Act. Instead, this section addresses an applicant's lawful entitlement *to use* the trademark, for example, in compliance with relevant federal legislation and other legal obligations prohibiting "use" of the trademark within the meaning of section 4 of the Act [see *Methanex Corporation v Suez International, société par actions simplifiée*, 2022 TMOB 155].

[63] As the facts pleaded by the Opponent cannot support a section 38(2)(f) ground of opposition, this ground is rejected.

**BAD FAITH – SECTION 38(2)(A.1)**

[64] The Opponent pleads that the Mark is not registrable as the Applicant applied for registration in Canada with a view to misappropriating the goodwill existing in Canada in association with the Opponent's trademark previously used in Canada in association with the Opponent's goods and services registered under No. TMA1,011,616.

[65] The material date for assessing this ground of opposition is the filing date of the application.

[66] The Opponent submits in its written representations that in view of its extensive use of the Opponent's trademark prior to the filing date of the application, it appears highly unlikely that the Applicant was unaware of the reputation of the Opponent's trademark and/or the fame of the Opponent prior to the material date. The Opponent further submits that as the Applicant has not submitted any evidence to rebut that the



application for the Mark was filed in bad faith, this ground of opposition must be decided in favour of the Opponent.

[67] The initial evidential burden, however, is on the Opponent to show that the Applicant applied for registration of the Mark in Canada in bad faith. Further, it has also been previously held that an allegation of awareness of a confusingly-similar trademark cannot form the basis of a section 38(2)(a.1) ground of opposition in the absence of other bad faith being alleged [see *Oasis Fashions Online Limited and RH US, LLC*, 2023 TMOB 124].

[68] In this case, the Opponent has not filed any evidence of bad faith on behalf of the Applicant. As the Opponent has failed to meet its initial evidential burden for the section 38(2)(a.1) ground, this ground is accordingly rejected.

### **DISPOSITION**

[69] For the reasons provided above and 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.

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Cindy Folz  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## **SCHEDULE A**

### ***Application No. 1893137 for KRAFTWURK***

#### **Goods (Nice class & Statement)**

- CI 3 (1) Non-medicated skincare and personal grooming products namely, skin tightening and firming creams for face and body, anti-aging, anti-acne, anti-wrinkle, and age spot reducing creams, emollients, cleansers, conditioning solutions, non-medicated glycol gels for exfoliating and clarifying skin and reducing the dullness of skin, rejuvenating face and body masks, astringents, glycolic and acid skin peels, cosmetics, namely face make-up products

#### **Services (Nice class & Statement)**

- CI 44 (1) Skincare, nursing and consulting services in the field of skin treatments, namely, medical skin care and health spa services, namely, nonsurgical cosmetic skin care rejuvenation programs applying a combination of topical treatments, injections of medication, laser treatments and skin peels; health spa services, namely laser treatments for acne, rejuvenation, scars, tattoo removal and for facials and massages; laser and intense pulse light skin enhancement procedures; skin treatments, namely, the injection of dermal filling agents and neuromuscular blocking agents to reduce the appearance of facial lines and wrinkles; dermatology services, namely, the application of radiofrequency energy for internal and external female genital rejuvenation, the application of external radiofrequency energy for skin tightening and rejuvenation and the application of cryolipolysis for subcutaneous fat reduction; skin care salons; hairdressing; manicuring; body art; beauticians' services namely colour analysis; depilatory waxing; cosmetic analysis; cosmetic body care services; consulting services namely in the field of cosmetic facial and body treatment services; consulting services in the fields of hair styling and makeup for human beings; providing information in the fields of hair styling, makeup and nail care, all via private websites, social media websites and social networking websites; consultation services relating to skin care; consultancy services relating to cosmetics; providing information in the field of hair styling; providing information relating to beauty salon services; tanning salons; hair salon services; beauty salon services; application of cosmetic products to the body; application of cosmetic products to the face; make-up consultation services provided on-line or in-person; eyebrow tinting services; eyelash tinting services; cosmetic make-up services; manicure and pedicure services; spas; nail salon services; make-up services; permanent makeup services; micropigmentation services; services for the care of the skin; services for the care of the scalp; services for the care of the face; beauty care services provided by a health spa; cosmetics consultancy services; visagists' services; cosmetic body treatment services; facial beauty treatment services; depilatory treatment; cosmetic treatment; cosmetic treatment services for the body, face and hair

# Appearances and Agents of Record

**HEARING DATE:** 2024-03-04

## **APPEARANCES**

**For the Opponent:** No one appearing

**For the Applicant:** Ricard Whissell

## **AGENTS OF RECORD**

**For the Opponent:** Fasken Martineau Dumoulin LLP

**For the Applicant:** Perley-Robertson, Hill & McDougall LLP