



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 66

Date of Decision: 2024-03-28

IN THE MATTER OF AN OPPOSITION

Opponent: Omni Powertrain Technologies, LLC

Applicant: Gienanth GmbH

Application: 1,983,661 for G Design

OVERVIEW

[1] The Protocol application for the Mark below was filed on August 1, 2019, based on a request for an extension of protection for international registration No. 1443540 under the Madrid Protocol, in association with the following Goods and Services:



Class 6 - Common metals and their alloys; eye bolts of metal; rings of metal, in particular pressure-actuated rings of metal; metal girders; metal supports for machines, motors and engines; sheets and plates of metal; manhole covers of metal

Class 7 - Shafts [parts of machines], in particular balance shafts, crank shafts and transmission shafts; housings for machines, motors and engines, namely, bearing housings, differential housings, gearbox housings, oil pump housings; machine parts, namely, bearing housings; pump housings, in particular oil pump housings; cylinder crankcases; shift forks; flywheels; machine parts, namely, shock absorbers for gears; machine parts, namely, mechanical wheel hubs; clutch thrust plates; machine tools for the cutting, casting and forming of materials used in the metalworking industry; engines and motors for aircrafts and boats; engines and motors for the generation of electricity; machine coupling and transmission components (except for land vehicles); crankcases for machines; cylinders for machines; cylinders for motors and engines; cylinders pistons; cylinder heads for motors and engines; cylinder blocks for diesel and gas engines; neck rings being parts of machines; machine parts, namely, metal machine consoles; crankcases for oil pumps; balance shafts; brake housings; pressure plates; gearshift forks; gear levers; main bearing covers; oil pump housings; machine pulleys; machine belt pulleys; machine parts, namely, grease rings; bearing covers for machines; covers of metal for crankshaft bearings; crankshaft bearing covers; metal machine consoles

Class 9 - Housings for electrical control, testing and monitoring apparatus, namely, electricity distribution consoles

Class 12 – Housings for parts, namely axle bearings, of motor vehicles (except for motors and engines)

Class 40 – Metal casting services; heat treatment of metals and alloys; consultancy services relating to the treatment of metal

Class 42 – Technological services and research and design of metal casting; industrial analysis and research services in the field of metal casting; engineering services relating to cast metal forming systems; engineering services relating to cast metal handling systems; technological consultancy relating to the casting and custom construction of metals; technical consultancy on the design and development of metal castings; engineering services relating to metal forming machines; design and planning of installations for use in casting of molten metal; design services relating to the treatment of metal; creation of drawings through CAD (computer-aided design) as part of technological consultancy on the design and development of metal castings; technical engineering in the field of simulation regarding mold filling, solidification, hardening and warping in technical metal casting processes; metal casting design

[2] For the reasons that follow, the application is refused.

THE RECORD

[3] The Protocol application was advertised for opposition in the *Trademarks Journal* of March 2, 2022. On September 2, 2022, the predecessor of 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).

[4] The Opponent raises a number of grounds of opposition including grounds based on sections 12(1)(d) and 16(1)(a) of the Act and non-distinctiveness primarily on the basis of confusion with the Opponent's trademarks G & Design (TMA969,713) and Omni Gear Design (TMA982,509), used in association with a variety of goods including power transmissions and gear boxes.

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

[6] The Opponent filed as its evidence the affidavit of Jeff Daniel, its President and CEO. The Applicant did not file any evidence in support of its application. Neither party filed written representations.

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 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].

REASONS FOR DECISION

Section 12(1)(d) Ground of Opposition

[8] The material date to assess a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks*, 1991 CanLII 11769 (FCA)].

[9] Pursuant to section 12(1)(d) of the Act, the Opponent pleads that the Mark is not registrable because it is confusing with one or more of its trademarks set out below. As I consider the Opponent's best chance of success to be with respect to registration No. TMA969,713, for G & Design, I will concentrate my analysis on this trademark.

| Registration No. Trademark | Goods |
|--|--|
| TMA969,713 G & DESIGN  | (1) Gear boxes, gear drives and gear drive lines for agricultural, industrial and commercial machines, and parts therefore, namely, loose gears, drive line shields and driveline couplers. |
| TMA982,509 OMNI GEAR DESIGN  | (1) Power transmissions for agricultural, industrial and commercial machines, consisting of gear boxes, gear drives, power drive lines and power trains; Power auger drives for excavation; Disk mower boxes, consisting of gear boxes for power lawn mowers in the nature of disk mowers, disk mower cutting heads, and drive shafts; rotary tables; Gear boxes, gear drives and gear drive lines for agricultural, industrial and commercial machines, and structural parts therefore, namely, loose gears, drive line shields and driveline couplers; Planetary drive gear boxes for agricultural and industrial equipment; Air compressors, compressed air pumps, motor driven air compressor units, engine driven air compressor units, and tank mounted air compressor units, compressed air pump units; tractor drive lines; tractor drive line safety shields and guards; mechanically and electrically powered drive lines and drive line safety shields and guards as structural parts of agricultural, industrial and commercial machines |

[10] I have exercised my discretion to check the Register and confirm that the Opponent's registrations remain extant. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition. As a result, the Applicant bears the legal onus of demonstrating on a balance of probabilities that there is no

reasonable likelihood of confusion between the Mark and any of the Opponent's registered trademarks.

Test for confusion

[11] 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 and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services 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 the goods or services from one source will be perceived as being from another source.

[12] 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 [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54].

[13] 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, supra*, at para 20].

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

[14] The overall consideration of this factor involves a combination of inherent and acquired distinctiveness of the trademarks.

[15] The parties' trademarks all have a low degree of inherent distinctiveness as the dominant feature of each trademark is the letter G. Notably, the Mark and the Opponent's G & DESIGN trademark have a very low degree of inherent distinctiveness as they have very minimal design features. The Opponent's OMNI GEAR DESIGN trademark has a slightly higher degree of inherent distinctiveness due to the globe and gear design features.

[16] The Opponent's trademarks have acquired some distinctiveness in association with gear boxes as shown in the affidavit of Mr. Daniel. In contrast, there is no evidence that the Mark has acquired any reputation in Canada.

- (a) The Opponent is a global provider of product solutions for powertrains used in agriculture, construction, mining, commercial vehicles and motorsports, amongst others (para 6). Both of the Opponent's registered trademarks have appeared on gearboxes distributed in Canada (Exhibit B).
- (b) Sales of gearboxes with the Opponent's registered trademarks in Canada are set out below (para 16).

Year Total Sales (USD)

2018 Over 180,000
2019 Over 190,000
2020 Over 310,000
2021 Over 520,000
2022 Over 1,250,000

Length of time the trademarks have been in use

[17] The Opponent's registered trademarks have been used in Canada since at least 2018 with gear boxes (para 16). In contrast, there is no evidence that use of the Mark has commenced.

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

[18] The Applicant's goods and services overlap with the Opponent's gear boxes for agricultural, industrial and commercial machines to a large extent. I find this as the Applicant's goods and services also include parts for machines including some goods which appear highly related to gearboxes including gearbox housings, shock absorbers for gears, engines and motors for aircrafts and boats; engines and motors for the generation of electricity; gearshift forks; gear levers. With respect to the remaining goods, I infer that there is some overlap as both parties make parts for machines. With respect to the services, I infer that there is overlap with the Opponent's goods. First, the Applicant's metal casting services could cover gear boxes. Second, the Opponent manufactures custom gears and sells to original equipment manufacturers (paras 11, 15). In the absence of evidence to the contrary, I assume that the parties' channels of trade would also overlap.

Degree of resemblance between the trademarks

[19] The degree of resemblance is often considered to have the greatest effect on the confusion analysis [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49].

[20] When considering the degree of resemblance, 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.

[21] As both parties' marks are comprised primarily of the letter G, I find that there is a high degree of resemblance between the marks in sound and appearance, in particular with respect to the Opponent's G & DESIGN trademark as both trademarks include a G with similar stylization surrounded by a simple circle. With respect to the ideas suggested by the Mark and the Opponent's G & Design trademark, there is no evidence on which I could infer that the trademarks would suggest anything other than the letter G to consumers or perhaps gears when used in association with gears and gear related goods.

[22] Accordingly, this factor favours the Opponent.

CONCLUSION ON LIKELIHOOD OF CONFUSION

[23] The confusion issue to be decided is whether a typical consumer with an imperfect recollection of either of the Opponent's trademarks, upon seeing the Mark in association with the Goods and Services, would be likely to think that the parties' goods and services share a common source.

[24] Having considered all of the surrounding circumstances, I find that the Applicant has not satisfied its legal burden to show that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trademark G & Design. The section 12(1)(d) ground of opposition therefore succeeds. I reach this conclusion particularly in view of the degree of resemblance between the parties' marks, the acquired distinctiveness and length of time the Opponent's G & Design trademark has been in use, the overlap or similarity in the parties' goods and services and the potential for overlap in the channels of trade. I note that given the low degree of protection afforded to trademarks consisting primarily of a single letter, the outcome may well have been different had the Applicant submitted evidence or argument in support of its application.

Non-entitlement ground

[25] As there is no evidence of use of the Mark, the material date for this ground of opposition is the filing date of the application [section 16(1)(a) of the Act].

[26] The Opponent's evidence described at paragraph 16 of this decision is sufficient to meet its burden of demonstrating use of its registered trademarks, including its G & Design trademark, prior to the filing date of the application with respect to gear boxes.

[27] The difference in the material date for this ground of opposition and the material date for the section 12(1)(d) ground does not change my prior finding that the Applicant failed to meet its legal onus of proving no reasonable likelihood of confusion. Accordingly, the section 16(1)(a) ground of opposition succeeds.

Unnecessary to consider the remaining grounds

[28] Having refused the application on the basis of two grounds of opposition, I find it unnecessary to consider the remaining grounds of opposition.

DISPOSITION

[29] In view of all of the foregoing, 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.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

No hearing held.

AGENTS OF RECORD

For the Opponent: CABINET JURIDIQUE ST. LAWRENCE S.E.N.C.R.L.

For the Applicant: RICHES, MCKENZIE & HERBERT LLP