



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 20

Date of Decision: 2025-01-31

IN THE MATTER OF AN OPPOSITION

Opponent: Flex Ltd.

Applicant: PRYSMIAN S.PA.

Application: 1938535 for FLEX-FLEX

INTRODUCTION

[1] Flex Ltd. (the Opponent) opposes registration of the trademark FLEX-FLEX (the Mark), which is the subject of application No. 1,938,535 (the Application), filed by PRYSMIAN S.PA. (the Applicant).

[2] The Mark is applied for in association with:

(1) Telecommunications cables, namely, cables for electrical and optical signal transmission, data transmission cables, modem cables, telephone cables; electric cables; fibre optic cables; electronic connectors; optical transmitters; optical fibre connectors; Optical electronic components, namely, optical transceivers; fibre optic couplings; cable coupling for electric cables.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's registered FLEX trademarks, previously used in Canada in association with a range of services related to computer and

telecommunications electronics manufacturing, distribution, and engineering. Particulars of the Opponent's FLEX Marks are attached as Schedule A.

[4] For the reasons that follow, the Application is refused.

THE RECORD

[5] The Application was filed on December 31, 2018, claiming a priority date of December 18, 2018. It was then advertised for opposition in the *Trademarks Journal* on August 31, 2022.

[6] On October 27, 2022, the Opponent opposed the Application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T 13 as amended June 17, 2019 (the Act).

[7] The grounds of opposition relate to compliance with sections 38(2)(e) and 38(2)(f), entitlement under section 16(1)(a), registrability under section 12(1)(d), and distinctiveness under section 2 of the Act. As previously indicated, the grounds of opposition are predominantly based on an allegation that the Mark is confusing with the Opponent's previously used and registered FLEX Marks (the FLEX Marks).

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

[9] In support of its opposition, the Opponent filed the affidavit of Kristin Russell, sworn on September 19, 2023, together with Exhibits 1 to 13.

[10] On January 22, 2024, the Applicant filed a statement that it did not wish to file evidence. The Applicant did not cross examine the Opponent's affiant.

[11] Only the Opponent filed written representations. An oral hearing was not requested.

OVERVIEW OF THE EVIDENCE

Opponent's Evidence – the Russell Affidavit

[12] Ms. Russell is an employee of the Opponent's wholly owned subsidiary Flextronics International USA, Inc. and a Director in its Marketing and Communications organization, in charge of Brand and Creative Services for the Opponent [para 1].

[13] The Opponent is the owner of a family of FLEX-formative trademarks, including:

- FLEX (TMA1,118,455);



- FLEX Design: (TMA1,118,453);
- FLEX PULSE (TMA1,094,031); and
- FLEX CREATE THE EXTRAORDINARY (application No. 2,144,969).

[14] Particulars of the corresponding registrations and application as obtained from the Canadian Trademarks Database on September 13, 2023, are attached to the affidavit as Exhibits 1, 2, 3, and 4 respectively [paras 3 to 11]. The three registered trademarks are the relied-upon registrations under several grounds of opposition previously identified as the Opponent's FLEX Marks, per Schedule A to this decision.

[15] On or about September 18, 2023, Ms. Russell accessed and viewed the Opponent's homepage at *flex.com* and three other pages of this website [para 13]. She attaches screenshots of those pages under Exhibits 5 and 6. Those pages display the Opponent's FLEX Marks and describe the services offered by the Opponent.

[16] On or around September 18, 2023, Ms. Russell also accessed the Opponent's *LinkedIn* page, including the Opponent's *LinkedIn* page for "Flex

Power Modules” [paras 14 and 15]. She attaches screenshots of those pages respectively as Exhibits 7 and 8, which display the FLEX and FLEX Design registered marks, and describe certain of the Opponent’s services.

[17] Ms. Russell then provides data tables regarding the Opponent’s website users in Canada during the period from January 1, 2015 to June 18, 2023 [Exhibit 9], and a yearly breakdown of the Opponent’s website users in Canada for the years 2016, 2018, 2020, and 2022 [Exhibit 10].

[18] Ms. Russell attests that, according to Opponent’s records, the Opponent’s sales revenues in Canada exceeded \$20 million USD in fiscal 2022 and in fiscal 2023 [para 17].

[19] I note however, that Ms. Russell does not specify whether these sales revenues were with respect to sales in association with the FLEX Marks. Indeed, despite the reproduction of the aforementioned exhibits, Ms. Russell makes no clear assertion of use or substantive statements otherwise regarding the Opponent’s use of the FLEX Marks.

[20] With respect to the applied-for Mark, on or about September 18, 2023, Ms. Russell conducted several searches on Google for “flex-flex” related search terms (“flex-flex”, “flex-flex Canada”, “flex-flex Prysmian”, and “flex-flex Prysmian Canada”) [para 18]. She attaches screenshots of pages resulting from those searches under Exhibit 11.

[21] Also around September 18, 2023, Ms. Russell accessed and viewed the homepage of the Applicant’s North America page on its website at *na.prysmiangroup.com*, as well as several other pages from this website [para 19]. She attaches as Exhibits 12 and 13 the aforementioned webpage screenshots of the Applicant’s website.

ONUS

[22] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its Application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could be reasonably concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059 (FC)].

ASSESSMENT OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) Ground

[23] The Opponent pleads that the Mark is not registrable due to a likelihood of confusion with one or more of the Opponent's registered FLEX Marks.

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

[25] An opponent's initial burden is met with respect to a section 12(1)(d) ground of opposition if one or more of the registrations relied upon remain in good standing as of the date of the opposition decision. The Registrar has the discretion to check the register and having exercised that discretion, I confirm that all three of the Opponent's FLEX Marks remain in good standing [see *Quaker Oats Co of Canada Ltd/La Compagnie Quaker 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 onus.

[26] In considering this ground, I will focus on the Opponent's word mark FLEX (TMA1,118,455), as I consider this to represent the Opponent's best chance of success under this ground.

Test for Confusion

[27] In determining whether two trademarks are confusing, all the surrounding circumstances should be considered, including those listed in section 6(5) of the Act, namely: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54; and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the degree of resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

[28] 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 the applicant's trademark at a time when they have no more than an imperfect recollection of the opponent's trademark. This casual, hurried consumer does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot, supra*, at para 20].

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

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

[30] Neither parties' trademark is inherently strong, as the word FLEX is an ordinary dictionary word, which when used in association with the parties' electrical and telecommunications goods and services is highly suggestive of 'flexible' goods, such as flexible cables, cords, or wiring systems. The repetition of the word flex gives the Mark some nominal greater inherent distinctiveness.

[31] The strength of a trademark may be increased by means of it becoming known through promotion or use.

[32] It is in this vein that the Opponent submits the Russell affidavit shows that its FLEX Marks have become known to a significant extent in Canada. Specifically, the Opponent points to the data tables concerning Internet users in Canada that accessed the Opponent's website between July 2015 and June 18, 2023 [para 16, Exhibits 9 and 10]. Further, it submits that its FLEX and FLEX Design trademarks have appeared directly on the Opponent's website as the trademarks which the services of the Opponent are advertised and promoted [para 13, Exhibit 6], and that Canadian sales revenues were over \$20 million USD in the years 2022 and 2023.

[33] The Opponent submits, that by contrast, there is no indication that the Applicant's Mark has become known in Canada as the Applicant did not file any evidence.

[34] I note, however, that while the screenshots of the Opponent's website [Russell affidavit, Exhibits 5 and 6] display the FLEX word mark and advertise/describe certain of the associated registered services, the screenshots were captured on September 18, 2023, and Ms. Russell does not attest that they are representative of their appearance prior to that date. Indeed, she does not make any meaningful or direct statements regarding the Opponent's use of its FLEX Marks or the extent to which they had

become known in Canada. These omissions are compounded by the further fact that the sales figures provided by Ms. Russell are not linked to any specific service or trademark, but are broadly of the “Opponent’s sales revenues in Canada” [Russell affidavit, para 17].

[35] Consequently, I am unable to determine or to draw any meaningful inferences as to the extent of use of the Opponent’s FLEX word mark (or any of the Opponent’s FLEX Marks) in association with any particular registered service.

[36] Accordingly, the section 6(5)(a) factor does not materially favour either party.

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

[37] The Opponent submits that its evidence shows that it has adopted its FLEX Marks as of July 2015. In this regard, the Opponent relies on the website screenshots appended to the Russell affidavit under Exhibit 6, and provides a list of services and related goods that it submits have at least been offered under the FLEX Marks as follows:

- Advanced communications solutions for 5G, satellite, IP and optical networks
- 5G RAN infrastructure
- Optical networking systems
- Optical transceivers
- Carrier routers
- High-bandwidth network switching
- Supply chain network services
- Electronic components for Battery Electric Vehicles (BEV), including converter, charger, inverter and BMS.

[38] Once again, the Opponent submits that as the Applicant has provided no evidence, this factor concludes in its favour.

[39] As previously indicated, while I accept that the screenshots of the Opponent's website display the FLEX word mark and advertise/describe certain of the associated registered services, the website screenshots were captured on September 18, 2023, and Ms. Russell does not attest that they are representative of their appearance prior to that date. Indeed, Ms. Russell does not provide any sworn statements of fact that would assist in assessing the extent or duration of use (let alone prior to September 2023) of any of the FLEX Marks in association with any services, including the particular services identified by the Opponent in its written representations.

[40] Further, I would add that the Federal Court has cautioned against giving even *de minimis* weight to the dates of use claimed in a registration certificate [see *Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951], and such claims are not evidence that the trademark has been used continuously since the claimed date [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[41] Consequently, this factor only nominally favours the Opponent.

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

[42] When considering sections 6(5)(c) and (d) of the Act, it is the statements of services as defined in the Application for the Mark and in the Opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[43] The Opponent submits that a comparison of the statement of goods in the Application with the statement of services in the Opponent's registrations shows significant overlap between the Applicant's goods and

the Opponent's services. The Opponent provides a table of comparison of the Applicant's goods versus the Opponent's services [para 32 of written argument]. In summary, the Opponent submits that its services include the manufacturing and distribution of telecommunications products, computer networking products, electrical power supplies, and lighting, parts supply for electronics, and other electronics and telecommunication-related goods and services – all of which the Opponent submits overlap with the description of goods specified in the Application.

[44] The Opponent submits that the potential for confusion is therefore due to the Opponent's manufacturing and distribution services being performed under the FLEX Marks and the Applicant's intention to sell, under the Mark, many of the same products that the Opponent manufactures and distributes.

[45] In addition, the Opponent submits that the Applicant's channels of trade overlap with the Opponent's preexisting channels of trade in the technology, networking, and telecommunication sectors. In this regard, the Opponent submits that both parties manufacture equipment to be used by large technology, networking and telecommunication companies in their products and services.

[46] In any event, the Opponent submits that it is not necessary to prove that the goods in question are sold in the same place as long as the parties are entitled to do so and there is no restriction or limitation of trade in the statement of goods and services [citing *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (3d) 68 at 72; *Eminence SA v Registrar of TradeMarks* (1977), 39 CPR (2d) 40 at 43]. In addition, the Opponent submits, per section 6(2) of the Act, that the use of a trademark will cause confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks derive from the same source, whether or not the goods or

services are of the same general class or appear in the same class of the Nice classification. Thus, the Opponent submits that this factor concludes in its favour.

[47] The Opponent submits that even if there was a difference in the channels of trade, the parties' trademarks would still be confusing, analogous to a situation in which an opponent had used its trademarks for a lengthy period of time and had acquired a reputation in those trademarks, there was overlap in the nature of the parties' goods, and there was a significant degree of resemblance between the parties' trademarks [citing in support, *Caplan Industries Inc v Stanley Black & Decker, Inc*, 2019 TMOB 79 at para 45].

[48] While I have not concluded that the Opponent has used its FLEX word mark (or any of the FLEX Marks) extensively, I agree that the evidence shows that the Opponent's FLEX word mark is used with the services of manufacturing and distributing various technical goods (cables, etc) that overlap with, and in some instances are the same as those listed in the statement of goods associated with the applied-for Mark. Further, the Applicant has not provided any evidence regarding its channels of trade or the nature of its business, and there are no restrictions or limitations in its statement of goods in this regard. However, as evidenced in the Russell affidavit [Exhibits 12 and 13, screenshots of Applicant's website], the Applicant, similar to the Opponent, appears to operate globally in the manufacture of cables, optical fibres, and related goods for customers across various industries. Furthermore, given the technical nature of the Applicant's goods, and in the absence of evidence to the contrary, it is conceivable that these goods could be sold to the same consumers in the technology and telecommunications sectors in which the Opponent operates.

[49] Having regard to the aforementioned, I find these factors favour the Opponent.

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

[50] In *Masterpiece*, the Supreme Court of Canada indicates that often the most important factor amongst those listed under section 6(5) of the Act is the degree of resemblance between the trademarks.

[51] 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 an imperfect recollection in the mind of a consumer of an opponent's trademark. Furthermore, in considering the degree of resemblance, it is preferable to start by considering whether there is an aspect of the trademark that is particularly striking or unique [*Masterpiece, supra* at paragraph 64].

[52] The Opponent submits that the degree of resemblance between the parties' trademarks strongly favours a finding of confusion.

[53] The Opponent submits that the Registrar has held that in cases where an applicant incorporates the entirety of an opponent's trademark into its own trademark, this indicates a high degree of resemblance and supports a finding of confusion [citing *Caplan Industries Inc v Stanley Black & Decker, Inc*, 2019 TMOB 79 at para 45; *Sally Beauty International, Inc v ADA International Beauty Inc*, 2015 TMOB 38 at para 30; *Hardex Brakes Corp v Hardex Corporation Sdn Ghd*, 2018 TMOB 159 at para 24]. In the present case, the Opponent submits that as the Applicant has done just that, it gives rise to an extremely high level of similarity in appearance, sound and idea suggested. I agree.

[54] Furthermore, there is no evidence to support that the repetition of the word FLEX in the Mark, changes the idea suggested behind the Mark. Indeed, there is no other element to the Mark – it is merely a repetition of the term that comprises the entirety of the Opponent’s mark.

[55] Accordingly, I conclude that the parties’ trademarks share a strong degree of resemblance, and, as such, this factor strongly favours the Opponent.

Conclusion

[56] 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 Opponent’s FLEX word mark and the Mark. I reach this conclusion in view of the high degree of resemblance between the parties’ trademarks, in combination with the overlap between the Applicant’s goods and the Opponent’s services and the potential for overlap in the parties’ channels of trade. I recognize that comparatively small differences will suffice to distinguish between weak trademarks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 15 CPR (4th) 345 (FCTD) at para 66; *Provigo Distribution Inc v Max Mara Fashion Group SRL*, 2005 FC 1550, 46 CPR (4th) 112 (FCTD) at para 31]. However, in the present case, simply the iteration of the dominant and sole element of the Opponent’s FLEX word mark in the Applicant’s Mark is insufficient in this regard; indeed, the Mark contains no other distinguishing elements and there is no evidence to support that this simple repetition alters the meaning or idea suggested by the Mark.

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

Section 16(1)(a) Ground

[58] The Opponent pleads the following:

The Applicant is not the person entitled to registration of the [Mark] pursuant to sections 38(2)(c) and 16(1)(a) of the Trademarks Act because, as of the filing date of the Application, the date of first use of the [Mark], and at all other material times, the use of the [Mark] in association with the applied-for goods was and is confusing with the Opponent's FLEX Registered Marks [...], all of which had been previously used or made known in Canada by the Opponent in association with a range of goods and services related to: computers; electronics; the manufacturing and distribution of telecommunications products, computer networking products, electrical power supplies, lighting; parts supply for electronics; and, other electronics and telecommunication-related goods and services of a similar nature to the goods specified in the Application.

[59] To meet its initial burden in respect of this ground, the Opponent must show that one or more of the Opponent's FLEX Marks was used in Canada prior to the material date for this ground. The Opponent must also show that the Opponent's FLEX Marks had not been abandoned as of the date of advertisement of the Application. If this initial evidential burden is met, the Applicant will bear the onus of showing that the parties' trademarks are not confusing.

[60] The material date for this ground of opposition is the earlier of (i) the date of first use of the Mark in Canada; or (ii) the priority filing date of the Application (namely, December 18, 2018). As the Applicant did not file any evidence to support use of the Mark in Canada, the material date is the priority filing date of December 18, 2018.

[61] The Opponent submits that its evidence shows that it adopted its FLEX Marks as of July 2015. In this regard, it relies on:

- the analytics report concerning Internet users in Canada that accessed the Opponent's website between July 2015 and June 18, 2023 [Exhibits 9 and 10];
- printouts from its website displaying the FLEX Marks advertising its associated services [Exhibits 5 and 6]; and

- the Opponent's Canadian sales revenues for the years 2022 and 2023 [para 17].

[62] However, as previously noted in the section 6(5)(a) analysis under the ground of opposition based on section 12(1)(d) of the Act, the above-noted website screenshots were captured on September 18, 2023, and Ms. Russell does not attest that they are representative of their appearance prior to that date.

[63] Additionally, as also noted, the sales figures provided by Ms. Russell are not linked to any specific service or trademark, but are generally and broadly of the "Opponent's sales revenues in Canada". In any event, the sales figures pertain to the years 2022 and 2023, which post-dates the material date under this ground.

[64] Lastly, while the Russell affidavit provides evidence that the Opponent's website at *flex.com* existed and was visited by Canadians during the period from January 1, 2015 to June 18, 2023, there is no evidence as to the contents of that website prior to what is shown on the September 18, 2023 printouts. Furthermore, Ms. Russell does not attest that the printouts are representative of their appearance at that time, and the mere appearance of the relied-upon trademark in the domain name is insufficient [see *Sun Media Corporation v The Montreal Sun (Journal Anglophone) Inc*, 2011 TMOB 15].

[65] In fact, nowhere in Ms. Russell's affidavit does she clearly attest that the Opponent used its relied-upon FLEX Marks since prior to the material date, and any reference to use in any of the Opponent's registrations is not sufficient to satisfy the Opponent's evidential burden under this ground.

[66] Accordingly, this ground of opposition is rejected.

Section 2 Ground

[67] The Opponent pleads that pursuant to sections 38(2)(d) and section 2 of the Act, the Mark is not distinctive because it does not actually distinguish the goods specified in the Application from the goods and services of the Opponent, nor is it adapted to distinguish them.

[68] To meet its initial burden for this ground of opposition, the Opponent must show that as of the date of filing the statement of opposition, namely, October 27, 2022, that one or more of its relied-upon FLEX Marks was known to some extent at least and the reputation of one or more of these trademarks was substantial, significant or sufficient so as to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6* (2006), 48 CPR (4th) 427 (FC)]. The Opponent has not done so, with the result that it fails to meet its initial burden.

[69] Accordingly, this ground of opposition is also rejected.

Section 38(2)(e) Ground

[70] The Opponent pleads that the Application does not comply with sections 38(2)(e) and 30(1) of the Act, because, at the filing date of the Application in Canada, without taking into account section 34(1) of the Act, the Applicant was not using and did not propose to use the Mark in Canada in association with the goods specified in the Application.

[71] The material date for assessing this ground is the priority filing date, namely, December 18, 2018.

[72] The Opponent submits that it has adduced evidence that the Applicant is not using the Mark. In this regard, the Opponent relies on Ms. Russell's Google search [Exhibit 11] and excerpts from the Applicant's website [Exhibits 12 and 13]. Further to this, the Opponent submits that the

Applicant could not have intended to use the Mark because the proposed use would be in contravention of sections 7(b), 19, 20, and 22 of the Act as it would directly infringe upon the Opponent's registered FLEX Marks.

[73] I first note that, whether or not I consider this ground to have been sufficiently pleaded, the aforementioned deficiencies in the Russell affidavit are at issue with respect to this ground as well. In this respect, Ms. Russell makes no meaningful sworn statements regarding the Applicant's use of the Mark or whether the Applicant proposed or was capable of proposing to use the Mark as of the material date or otherwise.

[74] In any event, I am not satisfied that the Opponent has met its evidentiary burden with respect to this ground. An applicant is not required to have used its trademark, and there is no evidence to support that the Applicant did not propose to use the Mark in Canada.

[75] Accordingly, this ground of opposition is rejected.

Section 38(2)(f) Ground

[76] The Opponent pleads that the Application does not comply with sections 38(2)(f) and 30(1) of the Act, because, at the filing date of the Application in Canada, determined without taking into account section 34(1) of the Act, the Applicant was not entitled to use the Mark in Canada in association with the goods specified in the Application since such use would be contrary to the Opponent's rights in its registered FLEX Marks under sections 7(b), 19, 20, and 22 of the Act.

[77] The material date for this ground is the priority filing date, namely, December 18, 2018.

[78] In its representations, the Opponent simply submits that the Application should be refused based on the “Federal Law Violation Ground”. The Opponent otherwise made no representations in support of this ground.

[79] Even if I were to consider the ground as pleaded to be a valid ground of opposition, at a minimum, the Opponent has failed to adduce evidence of the elements required to show a violation of section 7(b) of the Act [see the three elements set forth in *Ciba-Geigy Canada Ltd v Apotex Inc*, [1992] 3 SCR 120 at para 33 cited by *Pharmacommunications Holdings Inc v Avencia International Inc*, 2008 FC 828 at para 41]. Furthermore, to the extent that this ground relies on an allegation of likely confusion with the Opponent’s registered FLEX Marks, it is worthwhile to point out that section 38(2)(f) of the Act addresses an applicant’s lawful entitlement to *use* an applied-for trademark as opposed to that applicant’s entitlement to *register* the trademark. As such, the Registrar has held that likely confusion with an opponent’s trademark is not a fact that can alone support a non-entitlement to use ground of opposition [see *Magna International Inc v Magnacharge Battery Corporation*, 2024 TMOB 202, which cites for e.g., *Methanex Corporation v Suez International, société par actions simplifiée*, 2022 TMOB 155 at paras 82-83; see also *Catherine Sidonio and Chanel Limited*, 2023 TMOB 166 and *Oasis Fashions Online Limited and RH US, LLC*, 2023 TMOB 124].

[80] Accordingly, the section 38(2)(f) ground of opposition is rejected.


DISPOSITION

[81] Having regard to the aforementioned, 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.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The Opponent's FLEX Marks:

Trademark and Registration No.	Goods/Services
FLEX TMA1,118,455	Services : (1) Supply chain management services; logistics management in the field of electronics manufacturing including input supply, manufacturing and product distribution logistics; procuring of contracts for the purchase and sale of goods of others; inventory management services for others; distributorships in the field of electronics, namely, agricultural electronics in the nature of monitoring instruments, namely, water sensor levels, temperature sensors, and humidity sensors, control instruments for operating agricultural machinery, conveyors, lights, light management systems, monitoring systems, irrigation and air conditioning systems (other than for use in security systems and remote starters for tractors), lighting, computers, computer storage devices, telecommunications products being computer hardware for telecommunications, modems, frequency synthesizers, terminal boxes, manual switching apparatus, automatic switching apparatus, transmitters, electrical transformers, radio transmitters, radio receivers, optical fibers (fibres)(light conducting filaments), electronic transistors, voltage surge protectors, microphones for communications devices (other than for use in security systems and remote starters for vehicles), mobile phones, computer networking products (other than for use in security systems and remote starters for vehicles), circuit boards, batteries, electrical power supplies, battery chargers, battery monitors and medical device electronics, namely, sensors, actuators, smart devices with the power to read temperature, pressure, motion,
FLEX Design  TMA1,118,453	

	<p>acceleration, and advanced environmental data such as magnetic images and biofeedback, computed tomography (ct) apparatus, electronic vital sign monitors, neural stimulators, electronic sleep support devices</p> <p>(2) Packaging services namely the packaging of articles for others to their order and specification; packaging services namely design and manufacturing of packaging material for others</p> <p>(3) Custom manufacture of goods to others to their specification, namely, automotive parts and automotive electronics, agricultural equipment, namely, control instruments for operating agricultural machinery, conveyors, lights, light management systems, monitoring systems, irrigation and air conditioning systems (other than for use in security systems and remote starters for tractors), lighting, computers, computer storage devices, telecommunication products, namely, computer hardware for telecommunications, modems, frequency synthesizers, terminal boxes, manual switching apparatus, automatic switching apparatus, transmitters, electrical transformers, radio transmitters, radio receivers, radio pagers, optical fibers (fibres)(light conducting filaments), transistors (electronic), voltage surge protectors (other than for security systems and remote starters for vehicles), mobile phones, computer networking products, namely, computer networking hardware, computer hardware for network access servers, computer network adapters, computer network bridges, computer network hubs, switches and routers, computer network server, computer network switches (other than for use in security systems and remote starters for vehicles), plastics, circuit boards, electronics, chemical coatings, ceramic coatings, apparel, battery parts, solar equipment and parts, electrical power supplies, battery chargers, battery monitors, power line conditioners, aerospace equipment and parts and medical devices and equipment, namely, blood sugar testers, medical X-ray apparatus, gloves</p>
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	<p>for medical use, computed tomography (ct) apparatus, blood glucose meters, inhalers for medical purposes sold empty, pipettes, medical ventilators, catheters, endoscopic equipment, MRI diagnostic apparatus, smart devices with the power to read temperature, pressure, motion, acceleration, and advanced environmental data such as magnetic images and biofeedback, and information, consultancy and advisory services relating to all the aforementioned services; manufacturing services for others in the field of electronics, namely custom manufacturing of electronic components and equipment being wearable activity trackers, sensors, actuators, smart devices with the power to read temperature, pressure, motion, acceleration, and advanced environmental data such as magnetic images and biofeedback, displays, touchscreen monitors, secure keypads, biometric voice recognition systems, voice recognition software, cameras, batteries, computers, peripheral buses, embedded microprocessors, flexible circuit boards, electric circuits, electronic circuits, printed circuit boards, integrated circuits, mobile phones, smart phones, wireless modules, game consoles, printers, copiers, computers, all-in-one PC desktops, notebook and netbook computers and PC and media tables, communications servers, light emitting diodes (LEDs), LED circuit boards, gateway routers in the nature of computer control hardware, set top boxes, scanners, radar apparatus, radar receivers with amplifiers, amplifiers, GPS navigation device, tachometers, sound systems comprising remote controls, loudspeakers, magnetic data carriers, recording discs, automatic vending machines, cash registers, calculators, data processing equipment, battery chargers, battery monitors, power line conditioners, aerometers, altimeters, ammeters, anemometers, barometers, galvanometers, meters, electric wires and cables, electric cable connectors, electricity conduits, junction boxes, electric limiters, electric control panels, couplings for machines, voltage-surge</p>
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	<p>protectors, CD and DVD players, semiconductor scanners, electrical controllers, transistors, motor car seat controls, cruise controls for motor vehicles, electronics controls for gasoline engines for land vehicles (other than for use in security systems and remote starters for use in vehicles) for others and information, consultancy and advisory services relating to all the aforementioned services</p> <p>(4) Engineering services, namely, mechanical engineering services, chemical engineering services and electrical engineering services and information, consultancy and advisory services relating to all the aforementioned services; product development services and information, consultancy and advisory services relating to all the aforementioned services; design, engineering, research, development and testing services in the field of electronics and information, consultancy and advisory services relating to all the aforementioned services; design services and testing services for others in connection with new product development and information, consultancy and advisory services relating to all the aforementioned services</p>
<p>FLEX PULSE TMA1,094,031</p>	<p>Goods:</p> <p>(1) Computers; mobile applications and computer software for use in supply chain management, manufacturing logistics including input supply, manufacturing and product distribution logistics, quality control in manufacturing, procurement and product distribution, inventory management and management of manufacturing operations, including supply chain, quality control, logistics and inventory management.</p> <p>Services:</p> <p>(1) Supply chain management services; logistics management in the field of electronics namely logistics management in electronic manufacturing and parts supply for electronics and distribution of electronics; procurement services for others namely procurement of products, supply and services for others and inventory management services for others; wholesale distribution</p>

	<p>services provided for others in the field of electronics, namely, agricultural electronics (other than for use in security systems and remote starters for tractors), lighting, computers, computer storage devices, telecommunications products (other than for use in security systems and remote starters for vehicles), mobile phones, computer networking products (other than for use in security systems and remote starters for vehicles), circuit boards, energy storage and conservation equipment, electrical power supplies, battery chargers, battery monitors, security and defense system electronics, and medical device electronics; inventory control and inventory management services</p> <p>(2) Packaging services namely the packaging of articles for others to their order and specification</p> <p>(3) Packaging services namely the manufacturing of packaging materials for others</p> <p>(4) Engineering services, namely, mechanical engineering services, chemical engineering services and electrical engineering services and information, consultancy and advisory services relating to all the aforementioned services; product development services, design, engineering, research, development and testing services in the field of electronics, design services and testing services for others in connection with new product development, information, consultancy and advisory services relating to all the aforementioned services; providing temporary use of non-downloadable computer software for supply chain management, manufacturing logistics including input supply, manufacturing and product distribution logistics and management of manufacturing operations, including supply chain, quality control, logistics and inventory management, inventory control, inventory, management and tracking of documents and products over computer networks, intranets and the internet in the field of supply chain management; packaging services namely the design of packaging material for others</p>
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Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: John R. Sanche (Burnet, Duckworth & Palmer LLP)

For the Applicant: Smart & Biggar LP