

IN THE CANADIAN TRADEMARKS OFFICE

In The Matter of Trademark Application:

Applicant(s) : Primera Technology, Inc.
Appln No. : 2007701
Filing Date : December 16, 2019
Trademark : SIGNATURE
Examiner : Jacqueline Szwarc

To: The Registrar of Trademarks
CIPO, Trademarks Office
Ottawa-Gatineau, Canada, K1A 0C9.

Dear Sir/Madam:

This is in response to the Examiner's Report of May 20, 2021.

REMARKS

The Examiner has stated that In view of paragraph 12(1)(d) of the *Trademarks Act*, the trademark does not appear to be registrable since it is considered confusing with registered trademark no. TMA1,093,109 for the mark LG SIGNATURE.

Furthermore the Examiner has stated that in view of paragraph 37(1)(c) of the *Trademarks Act*, the trademark does not appear to be entitled to registration. Specifically, the priority entitlement date of June 20, 2019 of the subject Protocol application is later than the entitlement date of April 1, 2019 of co-pending and confusing application no. 1,954,621 for the mark CRAYOLA SIGNATURE.

For the reasons set out below we respectfully believe that the cited mark and application are not so confusingly similar to the herein mark to prevent registration and thus the objections under Section 12(1)(d) and 37(1)(c) should be withdrawn.

Firstly, the Examiner is reminded that the application is filed in respect of the following goods:

Electronic printers for printing information onto laboratory slides and tissue cassettes.

The Examiner has referred to Section 6 of the Trademarks Act and the notion that the Registrar must consider all the surrounding circumstances and has stated generally without making specific allegations of confusion that: "Confusion is tested in terms of the average consumer's first impression of the one trademark and imperfect recollection of the other mark, and not by a side-by-side scrutiny. The "average consumer" is a likely buyer of the associated goods or services who has an average education in English and/or French."

The Examiner is reminded that the factors listed in subsection 6(5) are not exhaustive, and do not necessarily receive equal weight. When considering the surrounding circumstances and relevant factors (discussed below in detail) there is no likelihood of confusion and the objections should be withdrawn.

Degree of resemblance between the marks

In most cases, it is the degree of resemblance between the trademarks in appearance, sound or in the ideas suggested by them that is the dominant factor in assessing a likelihood of confusion. If the trademarks do not resemble one another, it is unlikely that a finding on the remaining factors would lead to a likelihood of confusion: the other factors become significant only if the trademarks are found to be identical or very similar.

When assessing confusion between trademarks, the first word or first syllable in a trademark is generally the most important for the purpose of confusion (Conde Nast Publications Inc. v. Union des Editions Modernes (1979), 46 C.P.R. (2d) 183).

In the herein matters, each of the cited marks has a dominant highly distinctive first word (LG and CRAYOLA). Each of these words are obviously not present in the applicant's mark and are the primary distinctive distinguishing elements of the cited marks. CRAYOLA and LG are highly distinctive ubiquitous brands in the retail consumer space. The applicant's mark is for SIGNATURE, and is not in the direct retail consumer space. The fact that each of the cited marks has dominant distinctive brands as their first word eliminates any likelihood of confusion when considering visual similarity and the impression created. Furthermore, there are 717 registered trademarks at CIPO which include the word SIGNATURE. These SIGNATURE marks are registered across various different products and services by various entities. Many of these are registered for only the word SIGNATURE. This implies that the

word SIGNATURE is not unique or distinctive to any one party and multiple different parties may secure registration to a mark for the word SIGNATURE provided that the goods and services are sufficiently different from those registered to avoid confusion. The applicant's mark is such a case – it is different enough when considering the associated goods. The cited marks are not confusingly similar to the applicant's mark when considering the significant difference in appearance, the presence of SIGNATURE generally on the register of trademarks owned across various different goods and services by various owners and the specific nature of the applicant's goods. For these reasons alone the objection under Section 12(1)(d) and 37(1)(c) should be withdrawn.

Nature of Goods and Nature of the trade:

When considering the nature of the goods and nature of trade, the likelihood of confusion is further diminished. When making a decision concerning the issue of confusion, examiners must consider the nature of the goods or services associated with the trademarks. Therefore, examiners must clearly understand the description of goods or services as it appears in the applications or registrations.

In general, the greater the similarity in the goods or services of two trademarks, the greater the likelihood of confusion. While differences in goods or services may not always be the main consideration in a determination of confusion, they always remain an important consideration.

Similar to the nature of the goods or services themselves is the consideration of the nature of the trade in which those goods or services circulate. The risk of confusion is greater where the goods or services, even if they are dissimilar, are distributed or provided in the same types of stores or venues.

The nature of the trade extends the consideration of the type of trading environment as well. This relates both to the environment and to the nature of the consumer. For example, examiners must take into account situations in which the goods of one owner is traded to one set of consumers such as specific sophisticated commercial businesses, or on a wholesale level, versus sold to casual retail consumers through retail outlets. A professional commercial business consumer purchasing for his/her company and/or a commercial wholesale purchaser is less likely to be confused than a casual shopper in a retail setting. The electronic printers of the herein application

are sold through entirely different channels of trade, to entirely different consumers (sophisticated laboratory consumers) rather than the casual consumers of the cited application and registration.

Furthermore, the applicant's mark is used with a very specific product, used explicitly to print on laboratory slides and tissue cassettes. This is by no means a typical printer and the traditional type of printer such as is listed in the cited registration and application and is not in any way related to or overlapping in specific function or channel of trade. A printer is defined as: a machine for printing text or pictures onto paper, especially one linked to a computer. A printer does not encompass/entail a specialized printing device design particularly to print on a laboratory slide or tissue cassette. The printers of the cited application and registration are meant for paper or paper products and cannot be considered to cover the type of printer listed in the herein application. This further distinguishes the herein mark and reduces the likelihood of confusion such that there is no likelihood of confusion when considering the factors of nature of goods and channel of trade.

We request favourable reconsideration and approval of this application for advertisement.

We submit that this application is in good standing. If, however, any action is required to be taken to maintain or to put this application in good standing, we request that any other necessary action be taken and any related fee be charged to our Deposit Account No. 600000242.

Respectfully Submitted,
Primera Technology, Inc.

By: *Ridout & Maybee LLP*

RIDOUT & MAYBEE LLP
Trademark Agents for the Applicant

November 11, 2021
Toronto, Ontario, Canada
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