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RIDOUT & MAYBEE LLP
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Attention: Elliott J. Gold

RE: Trademark: SIGNATURE
Applicant: Primera Technology, Inc.

This examiner's report concerns the above identified Protocol application. To avoid abandonment proceedings, a proper response must be received by this office by July 25, 2024. All correspondence respecting this Protocol application must indicate the file number.

The applicant's correspondence dated April 28, 2023 is acknowledged. The revised application has been placed on file.

Your comments have been carefully considered, however, notwithstanding your comments, it is maintained that the subject trademark SIGNATURE is not registrable pursuant paragraph 12(1)(d) of the Trademarks Act as it is confusing within the meaning of section 6 of the same Act with registered trademark TMA 1,093,109, LG SIGNATURE.

With respect to applicant's comment on the difference of the nature of goods and the nature of the trade, the examiner respectfully submits that what must be considered are the goods or services as registered and as stated in the subject application. The cited trademark contains "printers, Portable printers" which could include the applicant's specialized printers, since "printers" in the cited registered trademark is not limited to merely non-specialized commercial printers, and as such, could be sold side by side in the marketplace. In this respect, your attention is directed to *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.) and also *Imasco Retail Inc. v. Purity Life Health Products Ltd.* (1990), 34 C.P.R. (3d) 113 (T.M.O.B) at 120:

As there is no restriction as to the channels of trade through which the applicant's wares would be made available to the public, I must conclude for the purposes of deciding this opposition that the trades of the parties would, or could, be identical. In this regard, and in assessing the likelihood of confusion between trade marks, the registrar must consider the channels of trade which would normally be associated with the wares as set forth in the applicant's application since it is the statement of wares as covered in the application which determines the scope of the monopoly to be accorded to an applicant should its trade mark proceed to registration. As with a registered trade mark in an infringement action, the scope of an applicant's trade is to be determined by reference to the statement of wares covered in the application rather than the applicant's actual trade to date: see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 at pp. 10-2, [1988] 3 F.C. 91, 16 C.I.P.R. 282 (F.C.A.). Thus, the fact that an applicant may be selling its wares through a particular type of retail outlet or through a particular channel of trade is irrelevant when considering the issue of confusion: see *Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc.* (1984), 2 C.P.R. (3d) 361 at p. 372, 3 C.I.P.R. 286, 29 A.C.W.S. (2d) 80 (F.C.T.D.); and 12 C.P.R. (3d) 110 at p. 112, 69 N.R. 234, 1 A.C.W.S. (3d) 434 (F.C.A.).

According to the goods statements of the cited registrations, the owner of the cited registration provide products of printer, portable printer, and digital photo printers, so the products include multiple kinds of printers.

With respect to the applicant's comment that the applicant's goods are used explicitly to print on laboratory slides and tissue cassettes and not in any way related to, or overlapping in a specific function or channel of trade of the cited registration, the examiner respectfully submits that the goods or services do not have to be identical in order for there to be a likelihood of confusion. It is sufficient that they be similar enough so that the average consumer of average intelligence would be likely to believe that they emanate from the same source. In this respect, your attention is directed to the decision of the Federal Court of Canada in *Clorox Co. v. E.I. Du Pont de Nemours and Co. et al.* (1995), 64 C.P.R. (3d) 79, where IMPACT for chemicals for treating swimming pool and spa water was held confusing with IMPACT for insecticides.

With respect to the applicant's comments that a professional business consumer purchasing for his/her company and/or a commercial wholesale purchaser being less likely to be confused that a casual shopper in retail setting, the examiner respectfully submits that sophisticated consumers are not totally immune to confusion and cannot be credited with total recall. Confusion may occur notwithstanding a higher caliber of purchaser. In this respect, your attention is respectfully directed to the following decisions that illustrate confusion may exist despite a higher caliber of purchaser:

- *System Development Corp. v. Acorn Computers Ltd.* (1986), 11 C.P.R.(3d) 401 - ORBIS for inter alia computers and computer programs held confusing with ORBIT for computer accessed information retrieval system.
- *Nelmetal Ltd. v. Personal Software Inc.* (1986), 12 C.P.R.(3d) 496 - VISIDEX for computer programs recorded on discs and tapes held confusing with a family of VISI marks including VISIRECORD and VISIRECORD Design for a variety of office equipment including information and storage display products.
- *Mitac Inc. v. Mita Industrial Co. Ltd* (1992), 40 C.P.R.(3d) 387 - MITAC for use in association with computers and computer components held confusing with MITA for use in association with a wide variety of wares applicable to photography and copying machines.
- *Telesoft v. Taurus Computer Products Inc.* (1987), 18 C.P.R.(3d) 120 - T-SOFT for use in association with proprietary software and firmware held confusing with TELESOFT & Design for use in association with computer systems, namely computer hardware and software.
- *MicroAge Computer Stores, Inc. v. North American Microtech Inc.* (1988), 19 C.P.R.(3d) 289 - THE SOLUTION P.C. for use in association with computers and computer peripheral hardware held confusing with THE SOLUTION STORE for use in association with retail services in the field of small computer systems and accessories and franchising services.

With respect to the applicant's comments regarding the degree of resemblance, the examiner submits that when considering confusion between trademarks that have identical or similar portions common to both trademarks, the first portion may not always be the most important, since it is the distinguishing feature and idea of each trademark that must be considered. In the Supreme Court of Canada decision of *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011) 92 C.P.R. (4th) 361, Rothstein J. commented as follows at page 379:

While the first word may, for purposes of distinctiveness, be the most important in some cases, I think a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique. Here there is nothing striking or unique about the word "Living" or the words "the Art of Living". "Masterpiece" is the word that distinguishes Alavida and Masterpiece Inc. from other sources of retirement residence services. It is a reasonable conclusion that "Masterpiece" is the dominant word in these trade-marks, and it is obviously identical as between Alavida and Masterpiece Inc. By the same token, in the context of the retirement residence industry,

the idea evoked by the word “Masterpiece”, high quality retirement lifestyle, is the same for both Alavida and Masterpiece Inc.

Finally, the word “Living” is identical as between the Alavida and Masterpiece Inc. trade-marks.” Given these striking similarities, it is, in my respectful view, very difficult not to find a strong resemblance as a whole between the two, Masterpiece Inc.’s trade-marks and Alavida’s trade-mark.

With respect to the applicant’s comments regarding the 717 registered trademarks which include the word “SIGNATURE”, the examiner respectfully submits that there is only one registration, TMA1,093,109 for the related goods according to the searching result in the Canada Trademark Database. The other more than 700 registered trademarks are all for significantly different goods and services, which should not be considered in this situation.

With respect to the applicant’s comment that the word SIGNATURE is not unique or distinctive, the examiner respectfully submits that when considering confusion between trademarks comprised of common portions that may be said to have little inherent distinctiveness, it is not a correct approach to conclude that the lack of inherent distinctiveness eliminates the likelihood of confusion between similar trademarks. In *Reynolds Consumer Products Inc. v. P.R.S. Mediterranean Ltd.* (2013), 111 C.P.R. (4th) 155 (FCA), Webb J.A. commented as follows at para. 23-24 of the decision:

In paragraph 28 of his reasons, the Judge found that neither trade-mark was inherently distinctive. As noted by the Judge, both trade-marks are comprised of a three letter Greek prefix (geo and neo) and a common suffix – web. In my opinion, there is no basis to interfere with these findings. Since the GEOWEB trade-mark is not inherently distinctive, it will be afforded less protection than if it were inherently distinctive. However, less protection does not mean it will not be afforded any protection.

Although GEOWEB is not a strong trade-mark, the question is still whether a consumer, upon encountering the NEOWEB trade-mark in association with cellular confinement systems, would likely be confused about whether these were the GEOWEB wares of Presto.

Having considered the goods as stated, the examiner is unable to conclude that the applicant’s and registrant’s printers are of different nature and would be used in different trades. This would lead the average Canadian consumer of average intelligence to immediately conclude that the goods emanate from the same source.

Therefore, having regard to the foregoing, the objection raised pursuant to paragraph 12(1)(d) of the *Trademarks Act* is hereby maintained.

You are further advised that this application maybe refused under subsection 37(1)(b) of the Act, if your next response does not overcome the aforesaid objection.

The applicant’s written comments with respect to this matter are invited.

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised Protocol application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,

Ling Tao
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