

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 November 29, 2022.

REMARKS

The Examiner has maintained the objection 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.

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confusingly similar to the herein mark to prevent registration and thus the objections under Section 12(1)(d) should be withdrawn.

Firstly, the Examiner will note that the application is filed in respect of the following goods, as amended:

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

The Examiner is reminded that the confusion 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factors (discussed below in detail) there is no likelihood of confusion and the objection under 12(1)(d) should be withdrawn.

Nature of Goods and channels of the trade (see Trademarks Examination Manual Section 3.2.1.3/4):

When considering the nature of the goods and nature of trade, there is no likelihood of confusion. When making a decision concerning the issue of confusion, examiners must consider the nature of the goods or services associated with the trademarks. 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 further define the goods, the applicants goods are now listed as:

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

The electronic printers of the herein application are sold through entirely different channels of trade, to entirely different consumers – they are sold to sophisticated laboratory operators, not direct consumers and are not designed for conventional printing, rather they are specifically for printing onto laboratory slides and tissue cassettes. These goods are often referred to using the industry term “slide and cassette printers” and the applicant has included this into the revised definition. Such printers are utilized in laboratory settings to print on slides and cassettes for microscopes (see www.primera.com/support/slideprinter). Such

slides are commonly glass and cassettes are made from high density polymers for storage of specimens for examination. Printers of the herein application are designed specifically for this purpose, used in a very specific setting, namely a laboratory, explicitly to print on laboratory slides and tissue cassettes. Such goods are entirely different in specific application, channel of trade and nature of consumer than a typical printer such as of the cited registration.

The Examiner states, the printers of the cited registration could include the specialized printers of the applicant, and therefore, be sold in direct proximity to one another in the marketplace and that 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. The applicant strongly disagrees.

The Examiner must appreciate the convention definition of a printer is to be applied to the cited registration's "printers" unless expressly defined otherwise. The applicant's goods are not within the conventional definition of a printer.

The conventional industry definition of printer is: a machine for printing text or pictures onto paper, especially one linked to a computer.

The Examiner cannot unilaterally chose to reject industry definitions and terms that clearly distinguish the applicant's goods from typical printers. There is no basis to do so.

It is inconceivable that the conventional industry accepted definition of printer entails the applicant's goods. Clearly a "printer" without further specification entails only "a machine for printing text or pictures onto paper..." whereas a slide and cassette printer entails an entirely different printer. Without express further definition, it does not encompass/entail an entirely different specialized printing device design particularly to print on a laboratory slide or tissue cassette. The printers of the cited registration as defined are meant for paper or paper products and cannot be considered to cover the type of printer listed in the herein application, specifically for printing on laboratory slides and tissue cassettes. This vast difference in nature of goods and channel of trade distinguishes the herein mark from the cited registration such that there is no likelihood of confusion when considering the factors of nature of goods and channel of trade. For this reason alone, the objection should be withdrawn.

Degree of resemblance between the marks

When considering degree of resemblance, the likelihood of confusion is further diminished. 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 matter the cited mark has as its first and primary aspect LG, a dominant highly distinctive and ubiquitous brand in the retail consumer space. As LG is the first portion in the cited mark, and a highly distinctive portion, it is the most important for purposes of establishing confusion. LG is one of the worlds most recognized brands. The fact that the cited mark has dominant distinctive brand as its first word alone should eliminate any likelihood of confusion when considering visual similarity and the impression created. For this reason alone, the objection under 12(1)(d) should be withdrawn.

As will be discussed below, the term SIGNATURE is not a purely arbitrary word, rather it is a dictionary word that has been used by many many parties across various goods and services as a registered mark. Provided that there is not direct overlap in the appearance, goods and services and the channels of trade of the various users of SIGNATURE, many registrations have and should continue to co-exist on the register and in the marketplace without confusion.

The applicant notes that 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 reinforces 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 (see above).

When considering the above, we request favourable reconsideration and approval of this application for advertisement.

The Examiner is reminded that where examiners are in doubt as to whether the applicant's trademark is likely to cause confusion with another trademark, they shall cause the application to be advertised in the manner prescribed. If the other trademark is registered, pursuant to subsection 37(3) of the Trademarks Act, the owner of the registered trademark shall be notified, by registered letter, of the advertisement of the application.

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*

Elliott J. Gold, RIDOUT & MAYBEE LLP
Trademark Agents for the Applicant

April 18, 2023
Toronto, Ontario, Canada
(For personal contact, please call Elliott J. Gold at telephone no. 416-868-1482)