

Federal Court



Cour fédérale

**Date: 20221017**

**Docket: T-681-21**

**Citation: 2022 FC 1410**

**Toronto, Ontario, October 17, 2022**

**PRESENT: The Honourable Madam Justice Furlanetto**

**BETWEEN:**

**VIVO MOBILE COMMUNICATION  
CO., LTD.**

**Applicant**

**and**

**GARMIN SWITZERLAND GMBH**

**Respondent**

**JUDGMENT AND REASONS**

[1] This is an appeal under section 56 of the *Trademarks Act*, RSC 1985, c T-13 [TMA] of a decision of the Trademarks Opposition Board [TMOB] through the designate Registrar, refusing Trademark Application No. 1,674,127 [Application] for the VIVO stylized mark, depicted below [Mark]:

The VIVO stylized mark, consisting of the word "vivo" in a bold, lowercase, sans-serif font. The letter 'i' has a small dot above it, and the 'o' is a simple circle.

[2] On this appeal, the Applicant filed new evidence that it argued would have materially affected the TMOB's analysis of the parties' goods and channels of trade and the impact of the small family of Respondent trademarks recognized by the TMOB. It also argued that the TMOB erred in its confusion analysis.

[3] However, as set out further below, it is my view that the Applicant's new evidence is not material and probative such that it would have impacted the TMOB's analysis of these factors to justify reconsideration of any issues on a *de novo* basis. Further, the Applicant has not demonstrated any palpable and overriding errors with the TMOB's confusion analysis. As such, the Decision shall be upheld and the appeal dismissed.

#### I. Background

[4] On April 24, 2014, the Applicant's predecessor in title filed the Application for the Mark based on proposed use in association with "telephone apparatus, specifically telephones, portable telephones, mobile telephones, cellular telephones, and smartphones" [Goods]. The Application was assigned to the Applicant, Vivo Mobile Communication Co, Ltd [Vivo], on June 18, 2019.

[5] The Respondent, Garmin Switzerland GMBH [Garmin], opposed the registration of the Mark under section 38 of the TMA. As the statement of opposition was filed on May 13, 2016, the provisions of the TMA as they read before that date applied to the opposition. The opposition was based on the following grounds:

- (a) the Application did not conform with section 30 of the TMA;
- (b) the Mark was not registrable under section 12(1)(d) of the TMA because there was a reasonable likelihood of confusion with the Respondent's VIVOFIT and

VIVOSMART trademarks [Respondent Marks], registered in association with the following wares: “monitoring devices for medical and non-medical purposes, namely, electronic monitor that monitors, records and displays physical activity levels, physical inactivity periods, steps walked or ran, distances covered in exercise, exercise levels achieved compared with exercise levels goals, calories burned, exercise goal levels based on past exercise, quality of rest and sleep patterns” [Respondent Goods];

- (c) the Applicant was not the person entitled to registration of the Mark under section 16 of the TMA; and,
- (d) the Mark was not distinctive under section 2 of the TMA.

[6] The Respondent filed two affidavits, including an affidavit from the Associate General Counsel – IP of Garmin International, Inc, the owner of the Respondent Marks [Ayres Affidavit]. The Ayres Affidavit included evidence of the use of the Respondent Marks, as well as other trademarks (VIVOACTIVE, VIVOKI, VIVOHUB and VIVOMOVE), owned by the Respondent [collectively, the Respondent Family Marks] in association with wearable fitness bands, “smart watches”, and wearable activity trackers, which act as monitoring devices for medical and non-medical purposes such as monitoring, recording, and displaying physical activity and inactivity levels, amongst other things.

[7] The Applicant did not file any evidence on the Opposition.

[8] The Application was refused in a decision of the TMOB dated February 25, 2021 [Decision]. Applying the confusion test under section 6(5) of the TMA, the TMOB concluded that the Mark was not registrable pursuant to section 12(1)(d) of the TMA because the Applicant had failed to establish, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Respondent Marks as of the date of the Decision.

[9] The TMOB found that both the Mark and Respondent Marks possessed a high degree of inherent distinctiveness because the word “VIVO” did not have any connotation to the Goods or Respondent Goods, although it found the inherent distinctiveness of the Respondent Marks to be diminished somewhat because of the suffix components FIT and SMART that described features of the Respondent’s monitors. The remaining factors under section 6(5), however, were found to favour the Respondent. The TMOB found that: the Respondent Marks were known to a greater extent and had been used longer than the Mark, which was based on proposed use; there was a strong connection between the parties’ goods and a potential for overlap between the channels of trade; and there was a high degree of resemblance between the Mark and Respondent Marks in appearance and sound, which was not affected by the suffix components of the Respondent Marks or the stylization of the Mark. The TMOB also found that the Respondent Family Marks increased the likelihood of confusion, *albeit* with only a small impact.

[10] The TMOB further concluded that the Mark was not distinctive of the Applicant because it failed to demonstrate there was no reasonable likelihood of confusion with the Respondent Marks as of the date the statement of opposition was filed. The TMOB did not address the remaining grounds of opposition.

[11] The Applicant appealed the Decision on April 26, 2021 and filed a certified copy of the file history for the Application and two new affidavits: the Affidavit of Luo Xuehong [Xuehong Affidavit], Intellectual Property Manager of the Applicant company; and the Affidavit of Kerry Biggs [Biggs Affidavit], a paralegal with the Applicant’s law firm.

[12] The Xuehong Affidavit sets out background on the Applicant and its business, including evidence relating to the use and the reputation of the VIVO mark in Asia and Europe in association with smartphones. It also spoke to asserted co-existence of the VIVO mark and Garmin's VIVO-containing trademarks in Asia and Europe, how Vivo makes smartphones available to the public in Africa, Asia and Europe, and its current intention for distribution of its phones in Canada.

[13] The Biggs Affidavit identified three "VIVO" trademark registrations from a search of the Canadian Trademarks database for marks registered or pending in association with computer goods. All of the registrations were registered to a third party and were opposed before registration by the Respondent. The affidavit attached a letter filed with the Trademarks Office, which showed an amendment to the statements of wares for the marks to remove "sports wristwatches, smart watches, and wearable digital technology which track fitness, sports activities and/or location, and their related computer software".

[14] There was no cross-examination on the affidavits and the Respondent did not file any further evidence.

## II. Issues

[15] The following issues are raised by this appeal:

- (a) What is the standard of review in view of the new evidence filed?

- (b) Did the TMOB err in its confusion analysis by: (i) not placing more emphasis on the higher degree of inherent distinctiveness of the Mark; (ii) finding that there was a connection between the goods and overlap with the channels of trade; (iii) finding a high degree of resemblance; and (iv) finding that the Respondent Family Marks increased the likelihood of confusion?

### III. Analysis

#### A. *What is the Standard of Review in view of the new evidence filed?*

[16] The standard of review for appeals under section 56 of the TMA is the appellate standard of review: *Canada (Minister of Citizenship and Immigration) v Vavilov*, 2019 SCC 65 at paras 36-52; *Clorox Company of Canada, Ltd v Chloretec SEC*, 2020 FCA 76 [*Clorox*] at paras 22-23. For questions of mixed fact and law, this is palpable and overriding error; for pure questions of law, the standard is correctness: *Housen v Nikolaisen*, 2002 SCC 33.

[17] Palpable means an obvious error, while an overriding error is one that affects the decision-maker's conclusion: *Clorox* at para 38. Palpable and overriding error is a highly deferential standard of review, while the correctness standard applies no deference to the underlying decision-maker: *Clorox* at para 23; *Tokai of Canada Ltd v Kingsford Products Company, LLC*, 2021 FC 782 [*Tokai*] at para 22.

[18] Where an Applicant leads new evidence in an appeal of a decision of the TMOB, the Court must first consider the materiality of the evidence and determine whether the evidence is sufficiently substantial, significant and probative that it would have a material impact on the

TMOB's decision: *Clorox* at para 21; *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707 [*Vivat*] at para 27; *Beverly Hills Jewellers MFG Ltd v Corona Jewellery Company Ltd*, 2021 FC 674 [*Corona*] at paras 36-39; *Tokai* at para 20.

[19] If evidence is material, the Court must review that portion of the decision to which the evidence applies on a correctness standard and make its own determination on the basis of the whole of the evidence. The Court is not limited to finding a reviewable error in the TMOB's decision and the appeal is in the nature of a hearing "*de novo*" with the benefit of the additional evidence: *Clorox* at para 21; *Tokai* at para 23; *Seara Alimentos Ltda v Amira Enterprises Inc*, 2019 FCA 63 [*Seara*] at para 22.

[20] As set out in *Seara* at paragraphs 23 and 25, an assessment of whether the new evidence would have a material impact on the TMOB's decision does not require a determination of whether the new evidence would ultimately change the result or outcome; the assessment is a preliminary test. The correct question is whether, in the context of the confusion analysis, the evidence could lead to a different conclusion in respect of one or more of the factors set out in subsection 6(5) of the TMA and the balancing underpinning the conclusion as to whether confusion was likely.

[21] Evidence may be "material" where it enhances the overall cogency of the record in a way that may have influenced the TMOB's conclusions on a finding of fact or exercise of discretion (*Seara* at para 24; *Tokai* at para 23) or fills gaps or remedies a deficiency identified by the TMOB (*Corona* at para 38-39). Evidence is not "material" if it relates to facts after the relevant

date, merely supplements or confirms the findings of the TMOB, or is repetitive of evidence that was already before the decision-maker: *Corona* at paras 38-39; *Seara* at para 24; *Hawke & Company Outfitters LLC v Retail Royalty Company*, 2012 FC 1539 [*Hawke*] at para 31.

[22] Materiality is a matter of quality, not quantity: *Hawke* at para 31; *Vivat* at para 27; *Tokai* at para 20; *Assurant, Inc v Assurancia, Inc*, 2018 FC 121 at para 23.

(1) The Xuehong Affidavit

[23] The Applicant argues that the evidence provided in the Xuehong Affidavit is material to the TMOB's finding that there is a connection between the parties' goods and an overlap between the parties' channels of trade. In particular, it argues that the evidence addresses the inferences made by the TMOB as to consumer behaviour and the channels of trade that will be used in connection with the Goods.

[24] At paragraph 20 of the Decision, the Registrar stated the following with respect to the nature of the parties' goods and the channels of trade:

While the Opponent's goods are not telephones and cannot be used as telephones, some of them are intended to be integrated with a user's smart phone. As such, there is a strong connection between the goods described as mobile telephones, cellular telephones and smart phones and the Opponent's registered goods. Furthermore, I find that the consumers of these goods overlap since consumers of the Applicant's goods must also be owners of a mobile, cellular or smart phone to obtain full functionality out of the Opponent's VIVOSMART monitors. Finally, with respect to the nature of the trade, I find there to be an overlap as "the Opponent's evidence is that its "products dealers and distributors include major retail chains specializing in the sale of personal electronics such as Best Buy and the Source [...]" (para 43) which, I infer, would also sell the Applicant's products (even if not in the same section of the stores).



[25] The Applicant points to evidence in the Xuehong Affidavit setting out the business practices of Vivo in other jurisdictions and its current intentions for Canada. It says this evidence establishes that when Vivo enters the Canadian marketplace it will sell through the same specialized channels of trade as it does in other jurisdictions, including its official website that does not sell third party products and through bricks and mortar retail stores, selling only VIVO smartphones. It argues that these are different channels from the major retail channels used by the Respondent. The Applicant asserts that the Xuehong Affidavit explains the consumer behaviour associated with the products at issue and that consumers conduct research and take care before making purchases. The Applicant further relies on the statement in the Xuehong Affidavit relating to the coexistence of the parties' marks on foreign trademark registers and in foreign markets without confusion.

[26] The Respondent argues that the Applicant mischaracterizes the evidence in the Xuehong Affidavit, which it says does not state that the Applicant's products will be sold through "specialized channels of trade" and Canadian stores that will sell *only* VIVO smartphones, or that it only offers products through the Applicant's website in other countries. It contends that even if the Applicant's characterization is accepted, claims about a present intention to market the Goods a certain way cannot be material absent actual restrictions in the statement of goods or evidence of a historical pattern of sales in Canada. It also asserts that the evidence regarding consumer behaviour is unsubstantiated and the evidence pertaining to coexistence of the marks on foreign registers and in foreign markets is irrelevant to the question of trademark confusion in Canada.

[27] The Xuehong Affidavit states that: “[w]hen Vivo enters the Canadian marketplace, it intends to distribute its phones through a dedicated VIVO website and authorized VIVO stores.” I agree with the Respondent, this does not explicitly limit the Applicant’s marketing plan by saying that the Applicant’s website is the only and exclusive online channel, or that the Applicant’s VIVO smartphones will only be sold through its branded stand-alone stores. It expresses a current non-limiting intention to sell the Applicant’s smartphones in Canada through a dedicated VIVO website and through authorized VIVO stores that sell Vivo’s products, without limiting those stores to selling only those products.

[28] As noted by the Respondent, the focus of the confusion analysis must be on the terms of the application because those terms set out what an applicant is authorized to do with its mark: *Mattel Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 53; *Seara* at para 41. When considering the nature of the goods and the channels of trade, it is the statements of goods in the proposed application and in the registrations relied upon by the Opponent that must be assessed, having regard to the channels of trade that would normally be associated with such goods: *Henkel Kommanditgesellschaft auf Aktien v Super Drafton Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) [*Henkel*]; *Mr Submarine Ltd v Amandista Investments* (1987), CPR (3d) 3 (FCA).

[29] While actual use in Canada may be relevant to determine the probable type of business or trade arising from a party’s statement of goods and services (*McDonald's Corporation v Coffee Hut Stores Ltd*, (1996), 68 CPR (3d) 168 at para 6 (FCA)), a stated intention as to how the goods will be sold has been found to be insufficient to restrict the channels of trade (*General Mills, Inc v Somapharm Inc*, 1997 CanLII 15786 (CA TMOB) [*General Mills*] at para 16; *Henkel* at para 8,

aff'g *Henkel Kommanditgesellschaft auf Aktien v Super Drafton Import Export Inc* (1984), 2 CPR (3d) 361 (FCTD) [*Henkel*] at para 26; *Eminence SA v Registrar of Trade Marks*, (1977), 39 JCPR (2d) 40 at para 14 (FCTD)). This is because there is no restriction on the applicant from selling its goods through the channels of trade provided by the application in future. Without a restriction in the statement of wares as to the associated channels of trade, or absent a long historical pattern of sales through particular channels of trade, it is difficult to infer from a party's stated intention that sales through the same or overlapping channels of trade will not occur: *General Mills* at para 16.

[30] In this case, there are no restrictions to the channels of trade arising from the Application. Further, there is no evidence of an existing pattern of sales in Canada as there has not yet been any use of the Mark in Canada, or any related mark of the Applicant. The only examples of use provided by the Applicant relate to use of the Mark elsewhere.

[31] The present intention proposed by Ms. Xuehong is just that; a present non-limiting intention without legal restriction as to how the Applicant's VIVO smartphones may be sold in future. The Applicant's evidence, while directed to the Registrar's comments, is not, in my view, probative. The evidence does not lead to a finding that the major retailers that sell the Respondent's products will not, or could not, sell the Applicant's Goods. The evidence would not have materially affected the Registrar's finding that there is a potential for the channels of trade to be overlapping.

[32] The Applicant also asserts that the Xuehong Affidavit is informative of consumer behaviour, relating to the products at issue. At paragraphs 13 and 17 of her affidavit,

Ms. Xuehong states the following:

13. Smartphone consumers carefully research competing technologies before purchasing a smartphone. For example, consumers closely compare and consider aesthetic features and the functionality of a phone along with price before purchase.

[...]

17. Garmin specializes in the development of wearables for athletic or exercise purposes, specifically fitness trackers and smart watches. Like VIVO smartphones, these products are also valuable goods for which consumers will conduct research and take great care before deciding to purchase.

[33] These are the only two paragraphs in the Xuehong Affidavit that address this issue.

[34] I agree with the Respondent, it is unclear how Ms. Xuehong, an intellectual property manager, is able to opine on this consumer behaviour, as no factual foundation is provided for these statements. The statements on their own are too vague and unsupported to be of probative or material value.

[35] The further evidence of coexistence on foreign trademark registers is not relevant as the TMOB's decision must be based on Canadian standards and the circumstances of the Canadian market: *Vivat* at para 65.

[36] Moreover, the limited evidence provided does not set out the full particulars of the parties' foreign rights, nor does it demonstrate actual marketplace coexistence in any of the jurisdictions noted as there is no evidence of contemporaneous sales of both parties' goods in the

markets in question. There is only the bare assertion that there is co-existence without confusion. The nature of the evidence on its face is not substantial and material.

[37] I am not persuaded that the Xuehong Affidavit evidence would have had a material effect on any of the factors in the TMOB's analysis.

(2) The Biggs Affidavit

[38] The Applicant asserts that the evidence provided in the Biggs Affidavit of three other "VIVO" third party trademarks would have materially affected the TMOB's conclusion that the Respondent Family Marks support a finding of confusion. It further asserts that these marks are responsive to the TMOB's finding that "there was no evidence that the Respondent's family of trademarks' common feature "vivo" is registered or used by others".

[39] The Respondent argues that the evidence in the Biggs Affidavit would not have materially affected the Decision. It contends that these third party trademarks are not relevant as they expressly exclude many of the Respondent Goods, there is an insufficient number of registered trademarks to draw any inferences regarding the state of the marketplace, and there is no evidence of use in the marketplace. The Respondent asserts that even if the evidence were to be considered, all of the trademarks in question were registered after the opposition proceedings were commenced. This postdates the material date for the distinctiveness analysis and cannot impact the TMOB's conclusion on that ground of opposition. Again, I agree with the Respondent.

[40] Although state of the register evidence may be relevant where it allows the Court to draw inferences regarding the state of the marketplace (*Tokai* at para 56; *McDowell v Laverana GmbH & Co KG*, 2017 FC 327 [*McDowell*] at para 42), it will be of limited assistance absent evidence of use of those other marks (*Hawke* at para 40) or where there is not a large enough number of relevant registrations to draw an inference that the element is common in the marketplace (*McDowell* at para 42).

[41] In this case, the Applicant has identified three other VIVO trademarks on the register, for use in association with computer-related goods. While the existence of these registered marks responds to the TMOB's statement regarding the registration by others of marks using the word "VIVO", the registrations add little else to the TMOB's analysis, particularly as each of the registrations were amended to remove from the statement of goods and services the following goods and services that are relevant to the Respondent Goods:

*Goods: all of the foregoing goods excluding any and all use in association with sports wristwatches, smart watches and wearable digital technology which track fitness, sports activities and/or location, and their related computer software*

*Services: all of the foregoing services excluding any and all use in association with sports wristwatches, smart watches and wearable digital technology which track fitness, sports activities and/or location, and their related computer software*

[42] The remaining goods do not include personal electronic devices. Thus, the addition of these third party marks, even if accepted, do not take away from the finding that the Respondent has a small family of marks in this area.

[43] Further, there is an insufficient number of registrations to establish a commonality in the use of the word “VIVO” in the Canadian marketplace and there is no evidence to establish any use of the marks in question.

[44] In my view, the evidence presented in the Biggs Affidavit is not material or probative and would not have affected the analysis of the already small impact of the Respondent Family Marks as a surrounding circumstance.

B. *Did the TMOB err in its confusion analysis?*

[45] As set out by the TMOB

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that use of a trademark causes 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 are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

[46] There is no allegation that the TMOB made an error of law. Palpable and overriding error is the standard of review. As set out earlier, palpable and overriding error is a highly deferential form of review. The Applicant must demonstrate an error that is both obvious and critical to the very outcome of the proceeding: *Clorox* at para 38; *Tokai* at para 22.

[47] The Applicant asserts that the TMOB erred by: (i) not placing more emphasis on the higher degree of inherent distinctiveness of the Mark; (ii) finding that there was a connection between the goods and overlap with the channels of trade; (iii) finding a high degree of resemblance; and (iv) finding that the Respondent Family Marks increased the likelihood of confusion. I will deal with each of these arguments in turn.

(1) Inherent Distinctiveness

[48] As noted earlier, the TMOB found that both the Mark and the Respondent Marks possess a high degree of inherent distinctiveness because they use “VIVO” which does not have any connotation to the parties’ goods. However, it found that the inherent distinctiveness of the Respondent Marks was less because of the suffix components “FIT” and “SMART”, which described features of the Respondent’s monitors.

[49] While the Applicant argues the TMOB should have placed more emphasis on the finding that the inherent distinctiveness factor favoured the Applicant, in my view, I see no error in the manner in which the TMOB approached this factor or its analysis.

[50] The TMOB acknowledged that the factor favoured the Applicant. However, in its balancing of all of the surrounding circumstances in its confusion analysis it implicitly found that the Respondent Marks were much stronger in view of the evidence submitted in the Ayres Affidavit as to the extent to which the Respondent Marks had become known and the length of time they were in use as compared to the Applicant’s proposed use of the Mark.

[51] The TMOB reiterated in its concluding paragraph that it considered all of the “surrounding circumstances” and highlighted those factors that it considered to be particularly



relevant to its determination; namely, the extent of use of the Respondent Marks, the potential for overlap in the parties' channels of trade and the nature of the parties' goods and the strong similarities of the parties' marks in appearance and sound. There is no basis to suggest that the inherent distinctiveness of the Mark, which is one of the surrounding circumstances, was not weighed and considered as part of this analysis.

[52] While the Mark had greater inherent distinctiveness than the Respondent Marks, the Respondent Marks had acquired distinctiveness through use in the marketplace: *Pink Panther Beauty Corp v United Artists Corp*, 1998 CanLII 9052 (FCA), [1998] 3 FC 534 at para 23; *Reynolds Presto Products Inc v P.R.S. Mediterranean Ltd*, 2013 FCA 119 at para 22. The extent to which the Respondent Marks had been used and become known made those marks stronger overall.

[53] I do not consider there to be any palpable and overriding error in the treatment of the paragraph 6(5)(a) factor or in the TMOB's analysis.

(2) The Nature of the Goods and Channels of Trade

[54] The Applicant argues the TMOB erred in concluding there was a strong connection between the parties' goods. It says that the TMOB misunderstood the evidence when it concluded that consumers must own a mobile, cellular, or smart phone to get full functionality of the Respondent Goods.

[55] There is no requirement that the parties' goods be the same or even of the same general class for there to be confusion. As set out in *Mattel* at paragraph 65:

I believe Linden J.A. misspoke to the extent he suggested that, for confusion to occur, there must be "some resemblance or linkage to the wares in question", i.e. to the wares for which the registration of the trade-mark is sought. Resemblance is clearly not a requirement under s. 6. On the contrary, the point of the legislative addition of the words "whether or not the wares or services are of the same general class" conveyed Parliament's intent that not only need there be no "resemblance" to the specific wares or services, but the wares or services marketed by the opponent under *its* mark and the wares or services marketed by the applicant under *its* applied-for mark need not even be of the same *general* class.

[56] Although there is a greater likelihood of finding confusion for identical products, the likelihood of confusion may also be heightened where the goods in issue are often used together: *Tokai* at para 87.

[57] As noted by the Registrar, the Respondent's evidence indicates that its VIVOSMART device is designed to be paired with a consumer's smartphone and gently vibrate and display texts, calls, emails and calendar alerts from compatible Bluetooth® enabled devices (Ayres Affidavit, Exhibit 16, product information), while its VIVOFIT devices can be connected to a consumer's smartphone or computer through the Garmin Connect Mobile App (Ayres Affidavit, Exhibit 17, product information). The Ayres Affidavit speaks to the use of the mobile apps being compatible with, and installed on a user's smart phone. This creates a direct overlap between the Respondent Goods and the Goods, which cover telephone apparatus that includes mobile telephones, cellular telephones and smartphones.

[58] The TMOB considered the Applicant's argument that the Respondent Goods were not the same as the Goods, did not compete with the Goods in the marketplace and could not be used as substitutes, and acknowledged that the Respondent Goods were not telephones and could not be used as telephones. However, it found that some of them were intended to be integrated with a user's smart phone and as such that there was a strong connection between the parties' goods. In my view, there is sufficient evidence from the Ayres Affidavit showing that the parties' goods would be used together, including the evidence referred to by the TMOB (Ayres Affidavit, Exhibits 16 and 17), to support this finding.

[59] The Applicant argues that the Xuehong Affidavit establishes that the nature of the parties' goods are such that consumers would research their purchases and would be less likely to have any confusion as to source. While consideration of the nature of the wares should take into account that there may be increased attentiveness for expensive goods (*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 [*Masterpiece*] at paras 67, 70-72; *Reynolds Presto Products Inc v PRS Mediterranean Ltd*, 2013 FCA 119 at para 19), as discussed earlier, the Applicant has not established with material evidence the consumer behaviour associated with the goods in issue. Nor would I infer by the nature of these goods that they are of such a quality and cost to have an impact on the likelihood of confusion. I do not consider the TMOB to have erred in not considering this aspect as part of its s 6(5)(c) analysis.

[60] The Applicant asserts that the Xuehong Affidavit shows that the Applicant does not intend to sell its goods through similar retail channels as the Respondent. However, as noted earlier, I do not accept that this evidence establishes that there would not be potential for

overlapping channels of trade in future. Rather, as the TMOB found, the Applicant's products are of a type that may be sold through the same retail channels as the Respondent. Further, as there is a connection between the goods, there is a potential for consumers of the products to be overlapping.

[61] I find no palpable or overriding error in the TMOB's analysis or finding that these factors favour a likelihood of confusion.

(3) Degree of Resemblance

[62] The Applicant contends that the TMOB erred by overlooking the design element of the Mark and concluding that the different sound and connotations conveyed by the suffix portions of the Respondent Marks did not meaningfully diminish their resemblance to the Mark.

[63] The Respondent argues the TMOB properly compared the dominant elements of the Mark and the Respondent Marks, in this case, the common element "VIVO". It asserts that the TMOB did not overlook the stylization of the Mark or the phonetic or connotative differences from the use of the component suffixes, but determined that the differences did not override the resemblance between the Mark and the Respondent Marks.

[64] In my view, the TMOB's analysis of this factor is consistent with the approach set out in *Masterpiece*, wherein the Court explained that the resemblance analysis "can be approached by considering only those characteristics that define the relevant trade-marks... It is only these elements that will allow consumers to distinguish" (para 61). As noted in *Masterpiece*,

“[r]esemblance is defined as the quality of being either like or similar” and the degree of resemblance analysis under s 6(5)(e) recognizes that “marks with some differences may still result in likely confusion” (para 62).

[65] I find the TMOB appropriately identified “VIVO” as the dominant, most striking and unique element of the Respondent Marks given its coined nature as compared to the descriptive nature of the suffixes “FIT” and “SMART” in relationship to the consumer goods. Similarly, it was appropriate to find that this dominant element, which encompassed the whole of the Mark, rendered the Respondent Marks and Mark to bear a high degree of resemblance visually and phonetically. The TMOB acknowledged that there was less resemblance with respect to the ideas suggested by the marks, but found that the marks nonetheless maintained a high degree of resemblance because of their visual and phonetic similarity. I find no palpable and overriding error in this analysis.

[66] The TMOB explicitly considered the stylization of the Mark and concluded that this did not materially affect the degree of resemblance. Again, I find no error in this finding. As the Respondent Marks are word marks, they may be used in any font or stylization: *Masterpiece* at paras 55 and 58. In this case, the Ayres Affidavit provided examples of use of the Respondent Marks in a lower case format (Ayres Affidavit, Exhibits 5, 6, 11, 12, 16).

[67] The Applicant’s further argument that the Mark has a “modern or futuristic aspect”

[68] was not specifically raised before the TMOB and accordingly, it cannot be faulted for not addressing this specifically. However, I do not find this argument as it relates to appearance to differ from the considerations associated with stylization, which were addressed by the TMOB.

[69] In my view, the Applicant has not identified a palpable and overriding error.

(4) Respondent Family Marks

[70] As to the Applicant's arguments on the TMOB's analysis on the Respondent Family Marks, in my view these are dependent on the Biggs Affidavit. As I have found that the Biggs Affidavit is not material and probative, I am of the view that the Applicant's arguments cannot succeed.

[71] The TMOB found that the relatively small family of marks only had a small impact on the confusion analysis. In my view, this surrounding circumstance did not factor heavily in the confusion analysis and I see no palpable and overriding error in the TMOB's identification and analysis of the Respondent Family Marks.

IV. Conclusion

[72] The Applicant's new evidence is not material and probative such as to mandate reconsideration of any issues on a *de novo* basis.

[73] The Applicant has failed to demonstrate any palpable and overriding errors with the TMOB's confusion analysis and the Decision should be upheld.

V. Costs

[74] Both parties asked for their costs of the appeal. The Applicant asserted that costs should be awarded at the middle of column III of Tariff B. The Respondent asserted that the parties should be entitled to file further submissions on costs, while acknowledging that in the normal course costs would be awarded on the scale put forward by the Applicant.

[75] As I see no reason to deviate from the norm in these circumstances, costs shall be awarded accordingly.

**JUDGMENT IN T-681-21**

**THIS COURT'S JUDGMENT is that:**

1. The appeal is dismissed.
2. Costs are awarded to the Respondent at the middle of column III of the  
Tariff, along with reasonable disbursements.

"Angela Furlanetto"

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Judge



**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-681-21

**STYLE OF CAUSE:** VIVO MOBILE COMMUNICATION CO., LTD. v  
GARMIN SWITZERLAND GMBH

**PLACE OF HEARING:** HEARD BY VIDEOCONFERENCE

**DATE OF HEARING:** MARCH 24, 2022

**JUDGMENT AND REASONS:** FURLANETTO J.

**DATED:** OCTOBER 17, 2022

**APPEARANCES:**

Timothy C. Bourne Meika C. Ellis	FOR THE APPLICANT
James Green Matthew Cook	FOR THE RESPONDENT

**SOLICITORS OF RECORD:**

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