



TRADEMARKS

REGISTRATION

Appeal from Registrar of Trademarks decision (2019 TMOB 94) refusing in part applicant's application to register trademark WISER — Trademark WISER used in association with a variety of goods, services including electric apparatus, electric installations, electrical energy management, building management — Respondent opposing applicant's application — Registered owner of number of word, design trademarks incorporating name WEISER — These including, materially for purposes of present appeal, trademark registration TMA129,747 for trademark WEISER for use in association with variety of lock, door hardware goods ('747 registration) — In 2013, respondent filing application to amend '747 registration to add series of new goods — Raising grounds of opposition in its Statement of Opposition including confusion, distinctiveness pursuant to *Trademarks Act*, R.S.C., 1985, c. T-13, s. 12(1)(d), 2 — Registrar noting amendments to '747 Registration — Concluding should consider '747 Registration as amended — Considering elements of test for confusion set out in Act, s. 6(5)— Finding that applicant's WISER trademark confusing with WEISER trademark with respect to household controller goods — Relying on inclusion of electronic, keyless locks, which only appear in amendments, in finding indirect overlap with household controller goods — This leading Registrar to allow opposition, refuse application with respect to household controller goods based on registrability ground of opposition — Registrar reaching same result on distinctiveness ground of opposition — Whether Registrar erring in basing its conclusion that applicant's trademark unregistrable on respondent's extended trademark registration even though respondent did not amend its statement of opposition after application to extend trademark matured to registration — Registrar not erring in considering '747 registration as amended — Principle in *Ferrero SpA v. Cantarella Bros Pty Limited*, 2012 TMOB 45 relating to situation where opponent's trademark application maturing to registration after statement of opposition filed — In such cases, Trademarks Opposition Board (TMOB) holding that opponent cannot rely on such registrations for registrability ground under Act, ss. 38(2)(b), 12(1)(d) unless statement of opposition amended to refer to them, even if application cited in statement of opposition (*Ferrero* rule) — *Ferrero* rule not applying herein — Amendment of '747 registration not resulting in new ground of opposition, as both statutory ground, trademark in question identified in statement of opposition — Changing factors in confusion analysis — Situation not changing because respondent's statement of opposition provided additional detail by including column in its chart listing goods, services in identified registrations — Open to Registrar to verify status of '747 registration at date of hearing — Material date for registrability ground of opposition was date of decision — Registrar's discretion to verify status of registration not limited to "one-way" verification in which registration cannot be broader than at time of statement of opposition — *Ferrero* rule designed to recognize that statement of opposition must set out grounds of opposition with sufficient detail to allow applicant to respond, that opposition limited to grounds identified in statement of opposition — As no new ground of opposition raised, no concern about fairness to applicant, *Ferrero* rule not applying — Registrar entitled to consider issue of confusion based on '747 registration as it stood at date of decision based on statement of opposition as filed — Appeal dismissed.

SCHNEIDER ELECTRIC INDUSTRIES SAS V. SPECTRUM BRANDS, INC. (T-1906-19, 2021 FC 518, McHaffie J., reasons for judgment dated June 1, 2021, 25 pp.)