

# Small Differences are Sufficient to Distinguish Weak Trademarks

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A recent [decision](#) of the Federal Court illustrates that for trademarks made up of highly suggestive and non-distinctive components small differences between the trademarks, such as different suffixes, can distinguish the marks and avoid confusion.

## The Facts

Assurancia, Inc. is an insurance broker and financial services firm. In 2012 it applied for the trademark ASSURANCIA for use in association with insurance brokerage, financial services and consulting services relating to insurance based on use since January 2008.

Assurant, Inc. is the owner of 13 registered trademarks consisting of the element “ASSURANT”. Assurant, Inc. opposed the above application on the basis that the applied for mark was confusing with its registered trademarks; the applicant was not the person entitled to the registration; and the mark was not distinctive.

## The Decision of the Trade Marks Opposition Board

The Hearing officer noted that a confusion analysis had to be conducted by considering all relevant circumstances, including those listed at subsection 6(5) of the Act, that is:

- a) the inherent distinctiveness of the trademarks at issue and the extent to which they have become known;
- b) the period during which these trademarks have been in use;
- c) the nature of the goods, services or business at issue;
- d) the nature of the trade; and
- e) the degree of resemblance between the trademarks at issue in appearance, or sound or in the ideas suggested by them.

The hearing officer reviewed the evidence presented dealing with the statutory factors and concluded confusion was unlikely. The key factors were that the ASSURANCIA mark had inherent distinctiveness greater than ASSURANT marks, although still low and that the marks involved were different phonetically. Although the marks resemble each other visually and in the ideas they suggest, this resemblance was due to the common component ‘ASSURAN’, which

was highly suggestive of the parties' services. Although this component forms the first part of the marks, this was lessened by the respective marks being highly suggestive. In such cases, a slight difference will be enough to distinguish them and reduce the probability of confusion. When a party uses a non-distinctive evocative name independently of any acquired distinctiveness it must accept some confusion without penalty.

The hearing officer also said this conclusion was supported by the fact there was a lack of evidence of confusion, despite the coexistence of the marks in Quebec for over 8 years.

### **The Appeal**

Assurant, Inc. appealed from the decision to the Federal Court. To support its appeal it filed additional evidence to show the extent to which it had used its registered trademarks and in particular at the date of first use alleged by Assurancia, Inc.

The judge took a cautious approach and accepted the new evidence was material and re-examined the grounds of opposition on an extended record as opposed to a simple appeal.

Assurant, Inc. devoted most of its submissions to the entitlement ground since this ground was decided as of the date Assurancia, Inc's first use. Assurant, Inc. showed it was using its registered trademarks at this date which undercut the hearing officer's comments about the lengthy period of coexistence without confusion.

The primary argument was that a hearing officer erred in not concluding that the respective marks were confusing. The judge disagreed and said that the key to the Board's findings was that the resemblance between the trademarks, both in appearance and in the ideas they suggested, was due to the highly suggestive and non-distinctively evocative common component 'ASSURAN'. This resulted in slight differences between the trademarks, such as different suffixes, giving the trademarks as a whole a different sound, which was enough to distinguish them and reduce the risk of confusion. Also key to the Board's findings was the longstanding principle that when a party uses words or terms commonly used in their trade, some confusion is to be expected, but that the average consumer in such context will distinguish between the non-common features of the respective trademarks.

There was undeniably some resemblance between ASSURANCIA and ASSURANT but this came from the shared feature – "ASSURAN" – which is suggestive of insurance, the industry in which both parties offer their services. As a result the non-common features of the competing trademarks – the suffixes "T" and "CIA" – were critical to the confusion analysis.

While other arguments were presented they too were not accepted and the appeal was dismissed.

### **Comment**

The case illustrates a conflict that frequently occurs. When a product or service is launched the individuals responsible may decide that it will be easier for marketing purposes to choose a mark that is suggestive and conveys to consumers the benefits associated with the product or service.

Unfortunately as time passes it may be difficult to stop competitors from using similar marks in association with competing products or services.

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*These comments are of a general nature and not intended to provide legal advice as individual situations will differ and should be discussed with a lawyer.*