



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 179
Date of Decision: 2016-11-16

IN THE MATTER OF AN OPPOSITION

**Les Promotions Atlantique Inc. / Atlantic
Promotions Inc.**

Opponent

and

**Warimex Waren-Import Export Handels
GmbH**

Applicant

1,634,992 for ROCKSTAR

Application

[1] Les Promotions Atlantique Inc. / Atlantic Promotions Inc. (the Opponent) opposes registration of the trade-mark ROCKSTAR (the Mark) that is the subject of application No. 1,634,992.

[2] The application is based upon proposed use of the Mark in Canada in association with the following goods:

Cookware, frying pans, woks, cooking pots, cooking pot sets, pot lids.

[3] The opposition was brought by the Opponent under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and raises grounds of opposition based upon sections 2 (non-distinctiveness); 12(1)(d) (non-registrability); 16(3)(a) (non-entitlement); and 30 (non-conformity) of the Act. The central issue is whether there is a likelihood of confusion between the Mark and the Opponent's trade-mark THE ROCK previously used and registered in Canada in association with the following goods:

Cookware namely pots, pans, fry pans, saucepans, broilers, roasters, dutch ovens, skillets and bakeware namely cake, pie and bread moulds.

[4] For the reasons that follow, the opposition is successful.

The Record

[5] The application was filed on July 12, 2013 and originally claimed a priority filing date of June 25, 2013 based on Australian application No. 1564642. The application was advertised for opposition purposes in the *Trade-marks Journal* on September 24, 2014.

[6] The Opponent opposed the application by a statement of opposition filed with the Registrar on November 21, 2014. The Applicant filed and served a counter statement on January 6, 2015 denying each of the grounds of opposition set out in the statement of opposition.

[7] In support of its opposition, the Opponent filed a certified copy of registration No. TMA862,635 for its trade-mark THE ROCK. It also filed an affidavit of its Director General, Gilles Gosselin, sworn May 4, 2015 (the Gosselin affidavit), and an affidavit of Guylaine Bergeron, a paralegal with the firm representing the Opponent, sworn April 30, 2015 (the Bergeron affidavit).

[8] In support of its application, the Applicant filed an affidavit of Kenneth Ma, a lawyer with the firm representing the Applicant, sworn August 26, 2015 (the Ma affidavit). The Applicant also amended voluntarily its application so as to delete the priority claim based on the above-mentioned Australian application, which amendment was accepted by the Registrar on August 6, 2015.

[9] The statement of opposition was subsequently amended by the Opponent, with leave of the Registrar granted on September 11, 2015. The counter statement was also amended by the Applicant, with leave of the Registrar granted on October 6, 2015.

[10] Neither party filed a written argument. The Opponent alone requested and made submissions at an oral hearing.

[11] At the outset of the hearing, the Opponent conceded that all of the grounds of opposition based upon non-compliance of the application with section 30 of the Act ought to be dismissed for the Opponent has not met its evidential burden in respect thereof. Accordingly, I will not discuss these grounds further.

[12] The Opponent also pointed out that the Bergeron affidavit, which purports to file a certified copy of Community trade-mark registration No. 011896131 issued by the Office for Harmonization in the Internal Market, was no longer of any assistance to its case in view of the amendments made to the Applicant's application and the Opponent's statement of opposition. Accordingly, I will not discuss this part of the Opponent's evidence further.

Analysis

The parties' respective burden or onus

[13] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

The non-registrability ground of opposition

[14] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's registered trade-mark THE ROCK referred to above.

[15] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[16] As the Opponent's evidential burden has been satisfied, the Applicant must therefore establish on a balance of probabilities that there is not a reasonable likelihood of confusion between the Mark and this registered trade-mark of the Opponent.

The test for confusion

[17] Section 6(2) of the Act provides that:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[18] Thus, this section does not concern the confusion of the trade-marks themselves, but confusion of goods or services from one source as being from another source.

[19] The test for confusion is one of first impression and imperfect recollection. As stated by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD) at 369:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[20] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time the trade-marks have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 2006 SCC 22, 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 2006 SCC 23, 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc*

(2011), 2011 SCC 27, 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

The inherent distinctiveness of the trade-marks and the extent to which they have become known

Inherent distinctiveness

[21] The trade-marks at issue both possess some measure of inherent distinctiveness. However, neither of them is particularly strong in view of the somewhat laudatory connotation of the dictionary word “rock” in the context of the parties’ goods, which suggests the idea of cookware as solid as a stone (or rock).

[22] Furthermore, given the dictionary meaning of the word “rockstar” (or rock star), the Mark somewhat suggests that the Applicant’s applied-for goods are renowned or revered in their category [see, *inter alia*, the dictionary definition of the word “rockstar” from the *Dictionary.com* website attached under Exhibit A to the Ma affidavit]. For authority that I can take judicial notice of dictionary definitions, see *Tradall SA v Devil’s Martini Inc* (2011), 2011 TMOB 65, 92 CPR (4th) 408 (TMOB).

[23] The Ma affidavit also purports to evidence that the phrase “The Rock” corresponds to the nickname of the Canadian province of Newfoundland [see the dictionary definition of the word “rock” from the *Canadian Oxford Dictionary* attached under Exhibit B, and the printout from the Wikipedia website for an entry entitled “Newfoundland (island)” attached under Exhibit C]. However, I agree with the Opponent that the primary meaning of the trade-mark THE ROCK to the ordinary consumer of the Opponent’s cookware is not that of a geographic name or location. Rather, the meaning that predominates is that of cookware as solid as a rock [see *Atlantic Promotions Inc v Canada (Registrar of Trade Marks)* 2 CPR (3d) 183 (FCTD); and *Mc Imports Inc v AFOD Ltd*, 2016 FCA 60 for a discussion of the general principles that apply to trade-marks that may consist of geographic names and have other meanings].

[24] In this regard, I note that Exhibit 8 to the Gosselin affidavit, which consists of excerpts from two Canadian magazines including articles referring to the Opponent’s cookware under the

trade-mark THE ROCK, supports this conclusion. The first article entitled “*C’est du solide!*” ([FREE TRANSLATION] “It’s solid!”) indicates that the Opponent’s cookware was named “The Rock” because “...son revêtement intérieur rappelle la texture de la roche. Il en possède aussi la solidité et la résistance...” ([FREE TRANSLATION] “...its lining recalls the texture of the rock. It also has its strength and resistance...”). The second article indicates that the Opponent’s cookware “...porte bien son nom. Dotée d’une base très épaisse, ... [cette batterie de cuisine] est 40% plus résistante aux abrasions et aux égratignures [...] de plus, elle possède la texture d’une roche” ([FREE TRANSLATION] ... “this cookware is aptly named. With a very thick base, it is 40% more resistant to abrasion and scratches. [...] moreover, it has the texture of a rock.)

Acquired distinctiveness

[25] The strength of a trade-mark may be increased by making it known through promotion or use.

[26] The application for the Mark is based upon proposed use and there is no evidence that the Mark has been used in Canada pursuant to section 4 of the Act or that it has become known in Canada to any extent.

[27] By contrast, the Gosselin affidavit evidences that the Opponent’s trade-mark THE ROCK has been used in Canada by the Opponent and become known to a significant extent, as per my review below of the salient points of this affidavit.

[28] I shall note that I am not affording weight to any of the statements made by the affiant that constitute personal opinion on the likelihood of confusion between the parties’ marks. The likelihood of confusion is a question of fact and law to be determined by the Registrar based on the evidence of record in the present proceeding.

The Gosselin affidavit

[29] Mr. Gosselin states that the Opponent was founded in 1965 and is the Canadian leader in the development and commercialization of kitchen utensils and accessories.

[30] Mr. Gosselin states that today, the Opponent distributes in Canada more than 1000 kitchen products sold under various trade-marks, including the trade-mark THE ROCK. The Opponent also distributes these products through its wholly owned subsidiary Atlantic International Import Inc. (Atlantic Import), and Mr. Gosselin attests that the Opponent has control over the character and quality of the products sold by Atlantic Import under the trade-mark THE ROCK.

[31] Mr. Gosselin attests that the Opponent has used the trade-mark THE ROCK in Canada since at least as early as June 21, 2013 in association with various kitchen utensils including pots, pans, fry pans, sauce pans, and broilers, and notably in association with other trade-marks of the Opponent, namely its trade-marks STARFRIT and HERITAGE.

[32] Mr. Gosselin refers collectively to the products covered by the Opponent's registration for the trade-mark THE ROCK as the "Products" and I will do the same while summarizing his evidence.

[33] Mr. Gosselin states that the Opponent's Products under the trade-mark THE ROCK are sold in Canada through retailers such as Canadian Tire, Walmart, Costco, Sears, Jean Coutu, Rossy, Safeway, and Bed Bath & Beyond.

[34] Mr. Gosselin provides the sales figures for Canadian sales of the Products under the trade-mark THE ROCK from June 2013 up until March 2015, the total of which amounts to in excess of 26 million dollars, as per the following breakdown: \$518 517 (between June 2013 and August 2013); \$11 389 274 (between September 2013 and August 2014); and \$14 741 833 (between September 2014 and March 2015).

[35] Mr. Gosselin states that the Opponent advertises and promotes the Products under the trade-mark THE ROCK through various means including advertising media, coupons and coop advertising.

[36] Mr. Gosselin provides the figures for advertising and promotional expenditures from 2013 up until March 2015, the total of which amounts to close to 4 million dollars, as per the following breakdown: \$42 196 (between June 2013 and August 2013); \$2 074 402 (between September 2013 and August 2014); and \$1 792 241 (between September 2014 and March 2015).

[37] Mr. Gosselin states that the Opponent also advertises the Products under the trade-mark THE ROCK on its website *www.starfrit.com*, which is accessible to Canadians, since at least June 2013.

[38] Mr. Gosselin states that the Opponent has also advertised the Products under the trade-mark THE ROCK through advertising campaigns on French and English television channels in Canada. He attests that for the period between November 3 and December 21, 2014, 30 second broadcasts were viewed over 116 million times. Between November 4 and December 21, 2013, 30 second broadcasts were viewed over 96 million times. He further states that more than 21,000 Canadian internet users watched to date adverts for the Products under the trade-mark THE ROCK, on *YouTube*.

[39] In support of his assertions of use and advertising of the trade-mark THE ROCK in Canada, Mr. Gosselin attaches the following exhibits to his affidavit:

- Exhibit GG-2, which he describes as a sampling of representative invoices showing sales of the Opponent's Products under the trade-mark THE ROCK. Mr. Gosselin attests that the invoices are issued by Atlantic Import two days after delivery of the Products;
- Exhibit GG-3, which he describes as a sampling of product packaging displaying the trade-mark THE ROCK. Mr. Gosselin attests that these samples are representative of the way in which the trade-mark THE ROCK has been used by the Opponent since at least as early as June 21, 2013;
- Exhibit GG-4, which he describes as various excerpts from the Opponent's website at *www.starfrit.com* relating to the advertising of the Products under the trade-mark THE ROCK;
- Exhibit GG-5, which he describes as excerpts from the websites of various clients of the Opponent, such as Walmart, Costco, Canadian Tire, and Bed Bath & Beyond, which do advertise and sell the Opponent's Products under the trade-mark THE ROCK;

- Exhibit GG-6, which he describes as a representative sampling of coupons distributed by the Opponent in the fall 2013, and for which the Opponent has incurred costs in excess of \$240 000.;
- Exhibit GG-7, which he describes as a representative sampling of flyers from retail stores that sell the Products under the trade-mark THE ROCK. Mr. Gosselin attests that by way of example, Canadian Tire and Walmart each distributes approximately 10 million copies of flyers each week. He further attests that the Products under the trade-mark THE ROCK have been advertised by the Opponent in such flyers more than 130 times since 2013; and
- Exhibit GG-8, which he describes as two excerpts from Canadian magazines including articles referring to the Products under the trade-mark THE ROCK. Mr. Gosselin attests that the first article was published in the November 2013 issue of the magazine “*Les idées de ma maison*”, which is printed in approximately 68 000 copies in Canada. The second article was published in the fall 2013 issue of the magazine “*Le Guide Cuisine*”, which is printed in approximately 50 000 copies in Canada.

[40] Upon review of these exhibits, I am of the view that the manners of use and advertising of the trade-mark THE ROCK with cookware diminish somewhat the measure of reputation that the Opponent can claim in it. While the Gosselin affidavit establishes extensive use of the trade-mark THE ROCK in association with the Opponent’s cookware in Canada since June 2013, it often appears in association with other trade-marks (namely STARFRIT and HERITAGE) that are also shown in a prominent fashion on the packaging of the Opponent’s cookware. Consequently, the reputation which would accrue to the Opponent’s trade-mark THE ROCK on its own is somewhat diminished with respect to its goods [see *Euro-Pharm International Canada Inc v Eurofarma Laboratórios Ltda* 2015 TMOB 91].

[41] Even so, I agree with the Opponent that it can reasonably be concluded that the trade-mark THE ROCK has become known to a fairly significant extent in Canada in relation to the Opponent’s cookware.

Conclusion on the section 6(5)(a) factor

[42] In view of the foregoing, I find that this factor, which is a combination of inherent distinctiveness and acquired distinctiveness, favours the Opponent.

The length of time the trade-marks have been used

[43] In view of my comments above, this factor also favours the Opponent.

The nature of the goods, services or business, and the nature of the trade

[44] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods in the registration relied upon by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 1996 CanLII 3963 (FCA), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[45] The Applicant's applied-for goods are either identical or closely related to those covered by the Opponent's registration. In the absence of evidence to the contrary, there is no reason to conclude that the parties' goods would not travel through the same channels of trade and be directed to the same types of clientele.

[46] These factors thus favour the Opponent.

The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[47] As noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, “the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion”.

[48] Moreover, as previously mentioned, it is well-established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, “[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it” [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 1998, CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA), at para 34]. Even though the first word or portion of a trade-mark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique [see *Masterpiece, supra*, at para 64].

[49] Applying those principles to the present case, I find there is a fair degree of resemblance between the parties’ marks owing to the shared component “ROCK”. Nevertheless, I find they are more different than alike, in terms of appearance and sound, as well as in the ideas suggested by them owing to the component “STAR”, which I find is equally dominant with the component “ROCK” in the Applicant’s Mark.

Additional surrounding circumstances

State of the register

[50] In addition to the definitions mentioned above under my review of the section 6(5)(a) factor, the Ma affidavit purports to introduce into evidence the particulars of the following trade-mark applications or registration found on the Canadian register of trade-marks:

- Allowed application No. 1,646,882 for the trade-mark StoneDine in the name of the Applicant in association with “cookware, frying pans, woks, [...]” [see Exhibit D];
- Allowed application No. 1,618,169 for the trade-mark ROCKCROCK in the name of Columbia Insurance Company in association with “cookware” [see Exhibit E]; and
- Registration No. TMA881,644 (resulting from application No. 1,618,170) for the trade-mark ROCKCROK also in the name of Columbia Insurance Company in association with “cookware” [see Exhibit F].

[51] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[52] In the present case, only one registered mark and two allowed applications would be relevant, which is far from being a sufficient number for inferences about the state of the marketplace to be made.

Conclusion regarding the likelihood of confusion

[53] As indicated above, the Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

[54] Having considered all of the relevant circumstances, I find that at best for the Applicant, the balance of probabilities weighs equally for both parties.

[55] Indeed, considering that the Opponent has used its trade-mark THE ROCK very extensively over the last few years, that the Applicant cannot claim any reputation for its Mark, that the parties’ goods and channels of trade are either identical or overlapping, and that there is a

fair degree of resemblance between the marks at issue (even though they are more different than alike), I find that the Applicant has failed to establish, on a balance of probabilities, that an individual having an imperfect recollection of the Opponent's trade-mark THE ROCK as associated with the Opponent's products, would not, as a matter of first impression and imperfect recollection conclude that the Applicant's applied-for goods come from the same source or are otherwise related to or associated with the Opponent's products.

[56] Accordingly, the section 12(1)(d) ground of opposition succeeds.

The non-distinctiveness ground of opposition

[57] The Opponent has pleaded that the Mark does not distinguish the applied-for goods of the Applicant from the goods of the Opponent, nor is it adapted so as to distinguish them in view of the Opponent's prior use in Canada of its trade-mark THE ROCK in association with cookware.

[58] An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing date of the opposition (in this case November 21, 2014) its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As per my review above of the Gosselin affidavit, the Opponent has met its evidential burden.

[59] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition.

[60] The non-distinctiveness ground of opposition therefore succeeds.

The non-entitlement ground of opposition

[61] As I have already refused the application under two grounds, I will not address this remaining ground of opposition.

Disposition

[62] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2016-10-12

APPEARANCES

Laurent Carrière

FOR THE OPPONENT

No appearance

FOR THE APPLICANT

AGENTS OF RECORD

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