



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

Citation: 2010 TMOB 150
Date of Decision: 2010-09-17

**IN THE MATTER OF AN OPPOSITION
by Kruger International, Inc. to
application No. 1,256,828 for the trade-
mark BARON in the name of Okamura
Corporation.**

[1] On May 6, 2005, Okamura Corporation (the Applicant) filed an application to register the trade-mark BARON (the Mark) on the basis of proposed use in association with furniture as more specifically defined in the application.

[2] The application was advertised in the *Trade-marks Journal* of November 15, 2006.

[3] Krueger International, Inc. (the Opponent) filed a statement of opposition on March 6, 2007.

[4] The Applicant filed a counter statement on April 16, 2007.

[5] An affidavit of Lisa Zeller, sworn January 11, 2008, together with Exhibits “1” through “27”, was filed by the Opponent as its evidence pursuant to r. 41 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations). Although the Applicant obtained an order for the cross-examination of Lisa Zeller, it elected to not proceed with the cross-examination. On April 7, 2009 the Opponent was granted leave to file an affidavit of Mike Novitski, sworn January 27, 2009, together with Exhibits “1” through “27”, as further evidence pursuant to r. 44(1) of the Regulations.

[6] The Applicant elected to file no evidence in support of its application.

[7] On October 3, 2008, the Applicant filed a revised application that was accepted by the Registrar on October 29, 2008. Thus, the statement of wares of the application of record reads “office chairs”.

[8] On two occasions during the course of the opposition proceeding, the Opponent was granted leave to file an amended statement of opposition. Leave to file an amended statement of opposition was last granted by the Registrar on April 6, 2009 pursuant to r. 40 of the Regulations. Accordingly, the grounds of opposition are those set forth in the amended statement of opposition filed on January 28, 2009.

[9] In preamble to the grounds of opposition, the Opponent alleges ownership of application No. 1,316,324 for the registration of the trade-mark BARRON (the Opponent’s Mark) based on use in Canada since at least as early as June 17, 1997 in association with furniture. That being said, the Opponent’s application does not form the basis of any grounds of opposition. The grounds of opposition set forth in the amended statement of opposition of record can be summarized as follows:

- a) s. 38(2)(c) of the Act - the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act because at the filing date of the application and of the revised application, the Mark was confusing with the Opponent’s Mark previously used and made known in Canada;
- b) s. 38(2)(d) of the Act - the Mark is not distinctive nor is it adapted to distinguish the Applicant’s wares from the wares of the Opponent.

[10] Only the Opponent filed a written argument and was represented at an oral hearing.

[11] On August 26, 2010, which was after the oral hearing, the Opponent filed with the Registrar copies of decisions with respect to its oppositions to applications for the registration of the Mark in the European Union and in the United States. By letter dated August 30, 2010, the Applicant submitted that these decisions should not be taken into consideration. Without commenting on the value of the foreign decisions in this proceeding, I agree with the Applicant.

If the Opponent wished for the decisions to be considered in the subject opposition proceeding, it should have filed them in a timely and proper manner.

Opponent's evidence

[12] Ms. Zeller has been a Product Manager at the Opponent since December 5, 2005. Mr. Novitski has been Director of Intellectual Property at the Opponent since April of 1995. Although I will individually review their respective affidavit, I wish to first summarize the essentially identical evidence introduced by both affidavits.

[13] The Opponent owns over 100 active Canadian trade-mark applications and registrations.

[14] The Opponent, which was founded in 1941, “manufactures a comprehensive and diverse line of office, commercial, institutional and educational furniture for a wide variety of customers in various markets”. The Opponent’s customers include “colleges and universities, schools, hospitals and healthcare facilities, government agencies, and a diverse range of corporate and commercial environments”. Sales orders are received by Kruger International Canada, Inc. (KICI), who in turn distributes the products to the Opponent’s customers or has them shipped to customers through the Opponent itself.

[15] The Opponent’s products have been regularly promoted in Canada through the use of written marketing pieces, public relations releases, trade shows, the Opponent’s website at *www.ki.com*, and through KICI’s sales representatives. The Opponent’s website, which was first posted on February 1, 2001, “has attracted an average of approximately 500,000 visitors annually from 2004-2006, including approximately 15,000 visitors annually from Canada during that same period, or approximately 3.3% of its total visitors worldwide”.

Affidavit of Lisa Zeller, sworn January 11, 2008

[16] Ms. Zeller files a copy of the Opponent’s application No. 1,316,324 [Exhibit “1”]. She states that the Opponent’s Mark has been used in Canada since at least as early as June 17, 1997 in association with “a wide variety of furniture” manufactured by the Opponent. I understand Ms. Zeller’s reference to “BARRON product” or “BARRON products” throughout her affidavit as a reference to the furniture associated with the Opponent’s Mark. Thus, any reference to

“BARRON products” in my decision is a reference to the furniture associated with the Opponent’s Mark.

[17] Ms. Zeller states that the BARRON products come in four styles, including Fixed Leg Tables, Folding Leg Tables, Flip Flop Tables and Plus Tables, in standard and lightweight top varieties, and with a full complement of accessories. The standard line of BARRON products includes over 300 distinct products models. Ms. Zeller files printouts from the Opponent’s website providing, among other things, details of the line of BARRON products and images of the BARRON products [Exhibits “2” through “12”]. She also files a copy of a label representative of the label applied to each of the BARRON products sold in Canada since at least as early as June 17, 1997 [Exhibit “13”]. I note that the label displays the Opponent’s Mark.

[18] According to the yearly breakdown provided in the Zeller affidavit, the Opponent’s approximate Canadian sales figures (understated to preserve confidentiality) of BARRON products totaled \$235,000 from 1997 to 2006. Ms. Zeller files a sampling of invoices with respect to Canadian sales of BARRON products [Exhibit “14”]. Although Ms. Zeller states that these invoices are for the period from 1997 to 2007, according to my review of these invoices, they cover the years 1997, 1998 and 2003 through 2007.

[19] Ms. Zeller files a representative sampling of promotional and advertising material for the BARRON products [Exhibits “16” through “27”].

Affidavit of Mike Novitski, sworn January 27, 2009,

[20] Mr. Novitski states that at least 42 of the Opponent’s Canadian trade-marks applications and registrations are for used in association with chairs, with at least 18 for “chairs used in office environments”. He files a chart summarizing some of the Opponent’s trade-marks for chairs “that are specifically used in office environments” [Exhibit “2”]. I understand Mr. Novitski’s reference to “Seating Products” throughout his affidavit as a reference to the chairs associated with the Opponent’s trade-marks. Thus, any reference to “Seating Products” in my decision is a reference to chairs manufactured by the Opponent.

[21] Mr. Novitski states that the Seating Products encompass “a wide variety of chairs for a wide variety of uses in a wide variety of settings”. He files printouts from the Opponent’s website providing particulars of the Seating Products used in office environments [Exhibits “3” through “17”] as well as a representative sampling of promotional and advertising material [Exhibits “19” through “27”].

[22] According to the yearly breakdown provided in the Novitski affidavit, the Opponent’s approximate Canadian sales figures (understated to preserve confidentiality) of Seating Products totaled \$19,700,000 from 2004 to 2008.

[23] I note that even though the Novitski affidavit evidences that the Seating Products are associated with various trade-marks of the Opponent (for example IMPRESS, STRIVE, KISMET), it does not evidence the use of the Opponent’s Mark in association with Seating Products. I would add that this was not disputed by the Opponent in its submissions. The Opponent submits that the fact that it manufactures and sells Seating Products is a relevant surrounding circumstance.

Onus and Material Dates

[24] 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[25] Although each ground of opposition is based on the allegation that the Mark is confusing with the Opponent’s Mark, the material dates to assess confusion differ and are as follows:

- s. 38(2)(c)/s. 16(3)(a) – the filing date of the application date [see s. 16(3)];
- s. 38(2)(d)/non-distinctiveness – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[26] I am satisfied that the Opponent has discharged its initial evidential burden of showing that the Opponent's Mark was used in association with furniture, in particular tables, prior to May 6, 2005 and had not been abandoned at the date of advertisement of the application [s. 16(5) of the Act]. I am also satisfied that the Opponent has discharged its evidential burden to show that the Opponent's Mark had become known sufficiently as of March 6, 2007 to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.*, 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]. Thus, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that as of each of the material dates there was no reasonable likelihood of confusion between the Mark and the Opponent's Mark.

[27] Based on the evidence of record, it appears to me that the analysis of confusion does not turn on the date at which confusion is assessed. Thus, I shall proceed with the assessment of the likelihood of confusion.

Assessment of the likelihood of confusion

[28] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[29] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 wares, 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. These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)].

[30] I assess the inherent distinctiveness of the trade-marks as about the same, although the inherent distinctiveness of the Mark is arguably less since “baron” is a common word in both the English and French languages.

[31] In view of the Opponent’s evidence, I am satisfied that the Opponent’s Mark has become known to some extent and has been used in Canada since June 17, 1997. By contrast, the Applicant did not furnish any evidence of use of the Mark.

[32] I agree with the Opponent’s submissions that by definition, “furniture” encompasses a wide variety of wares including “office chairs”. In that regard, I refer to *The Canadian Oxford Dictionary* which defines “furniture” as: “the movable equipment of a house, room, etc., e.g. tables, chairs and beds.” As a result, I find that the parties’ wares overlap.

[33] There is no evidence with respect to the Applicant’s channels of trade and there is no restriction in the application. Consequently, for the purposes of determining confusion, I find it reasonable to infer that the parties’ channels of trade could be the same or could overlap.

[34] In addition to being virtually identical in appearance, the Mark and the Opponent’s Mark are identical in sound. These resemblances outweigh differences between the ideas suggested, if any, due to the meaning of the word “baron” forming the Mark which is distinct from “barron”, a coined word, which has no meaning.

[35] Finally, in my view the evidence introduced by the Novitski affidavit with respect to the Seating Products manufactured by the Opponent, though not under the Opponent’s Mark, is an additional circumstance supporting a finding of confusion.

[36] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. I find that there is a reasonable likelihood that the Mark will prompt the consumers to think that the wares associated therewith come from the same source as those associated with the Opponent’s Mark or that they are otherwise associated with the Opponent. Therefore, I find that the Applicant has not discharged its burden of showing, on a balance of probabilities, that the Mark was not confusing with the Opponent’s Mark at the material dates.

[37] Having regard to the foregoing, the ground of opposition based upon s. 16(3)(a) of the Act is successful. Likewise, the ground of opposition based upon non-distinctiveness of the Mark is successful.

Disposition

[38] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office