



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

Citation: 2016 TMOB 147
Date of Decision: 2016-08-26
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Caplan Industries Inc.

Opponent

and

9158-1298 Québec Inc.

Applicant

1,622,711 for TASK WORKWEAR

Application

[1] Caplan Industries Inc. (the Opponent) opposes registration of the TASK WORKWEAR trade-mark (the Mark) covered by application No. 1,622,711 in the name of 9158-1298 Québec Inc. (the Applicant).

[2] This application, filed on April 16, 2013 and amended on May 20, 2015, is based on the projected use of the Mark in association with the following goods:

Clothing, namely sportswear, casual wear, leisure wear, jeans, blouses, sweaters, coats, pants, cargo pants, shirts, jackets; hats; shoes; accessories for men, women and children, namely belts, excluding belts for industrial use and in construction.

[3] The determining question in the case at bar is whether the Mark is confusing with the TASK and TASK & Design trade-marks registered in the Opponent's name and alleged to have been previously used or made known in Canada.

[4] In general, the TASK trade-mark is registered in association with hand tools, accessories and parts for hand tools, accessories for power tools, and safety goggles. The statement of goods

of the registration is reproduced in its entirety in Appendix A of my decision. The TASK & Design trade-mark, illustrated below, is registered in association with "hand tools".



[5] The Opponent filed evidence, while the Applicant chose not to file any evidence.

[6] Each of the parties filed a written argument and was represented at the hearing. However, I must point out that the Applicant's written argument only consists of two laconic paragraphs. In other words, this written argument does not contain any substantial representation.

[7] For the following reasons, I consider it appropriate to refuse the registration application.

The grounds of opposition

[8] The statement of opposition filed on August 19, 2014 raised six grounds of opposition under subsection 38(2) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). Three of these grounds of opposition are no longer at issue in the case at bar.

[9] Indeed, the grounds of opposition alleging that the registration application did not satisfy the requirements of subsections 30(e) and 30(i) of the Act were expunged by interlocutory decision of the Registrar dated November 12, 2014. Moreover, the Opponent indicated in its written argument that it was withdrawing the ground of opposition alleging that the registration application did not satisfy the requirements of subsection 30(a) of the Act [see paragr. 123 of the written argument].

[10] Therefore, only three grounds of opposition remain to be resolved, all based on the likelihood of confusion between the Mark and the Opponent's TASK and TASK & Design trade-marks. To summarize, these grounds of opposition allege that: (1) the Mark is not registrable according to paragraph 12(1)(d) of the Act; (2) the Applicant is not the person entitled to registration of the Mark according to paragraph 16(3)(a) of the Act; and (3) the Mark is not distinctive according to section 2 of the Act.

[11] The statements of the grounds of opposition are reproduced in their entirety in Schedule B of my decision.

Relevant dates

[12] The relevant dates for considering the circumstances in regard to the grounds of opposition are the following:

- Paragraphs 38(2)(b)/12(1)(d) of the Act - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Paragraphs 38(2)(c)/16(3)(a) of the Act - the filing date of the application; and
- paragraph 38(2)(d) and section 2 of the Act - the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

The burden incumbent on the Parties

[13] The legal onus is on the Applicant to show that the application for registration does not contravene the provisions of the Act. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

However, the Opponent must discharge the initial burden of proving the facts on which it bases its allegations. The fact that an initial evidential burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient evidence exists to allow a reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

Opponent's Evidence

[14] Before analyzing the grounds of opposition, I will review the Opponent's evidence, which consists of affidavits of Christopher Waldner and Dulce Campos.

[15] Neither Mr. Waldner nor Ms. Campos were cross-examined by the Applicant.

Affidavit of Christopher Waldner dated March 19, 2015 and its Exhibits 1 to 72

[16] Mr. Waldner is Director of Product Management and Marketing for the Opponent [paragr. 1].

[17] Mr. Waldner filed a certificate of compliance to prove that the Opponent is in good standing with the British Columbia Corporate Registry [paragr. 2, Exhibit 2].

[18] Mr. Waldner explained the process that led to the adoption of the Opponent's TASK trade-mark in April 1981, followed by the adoption of the TASK & Design trade-mark in 1983. Mr. Waldner presented the steps taken for the registration of these trade-marks. He filed certified copies of the registrations Nos. TMA278,164 for the TASK mark and TMA358,452 for the TASK & Design mark [paragr. 3 to 6, Exhibits 3 and 4].

[19] Mr. Waldner continued his affidavit by presenting the evidence by collective reference to the TASK and TASK & Design trade-marks [paragr. 7]. Consequently, my subsequent use of the term "TASK Marks" reflects the collective reference to the TASK and TASK & Design trade-marks in Mr. Waldner's affidavit.

[20] Mr. Waldner explained that the average prices of the goods associated with the TASK Marks range approximately between \$0.39 and \$395 [paragr. 8]. Even though it is a little long, I reproduce below paragraph 9 of the affidavit concerning the value of the sales of the goods to facilitate reference to this evidence during the analysis of the grounds of opposition:

9. The gross sales of Caplan have steadily increased since the inception of the Task trade-marks which identifies (sic) Caplan's goods set out in the registrations as introduced in paragraphs 4 through 7 to this my affidavit as Exhibits 3 and 4. By 1992 the gross sales of Caplan reached approximately \$4,000,000.00, by the end of 1998 sales were over \$10,000,000.00, in 2004 they reached over \$17,000,000.00 and steadily increased each year since with revenues well over \$17,000,000.00 in 2014. In accordance with normal and acceptable accounting procedures detailed invoices have been purged prior to 2003, however in the following paragraphs wherein specimens of use are introduced, copies of actual invoices have been provided confirming sales of the products bearing the TASK trade-marks from the years 2003 through 2014.

[21] The copies of invoices to which Mr. Waldner refers in paragraph 9 of his affidavit accompany the specimens provided to prove the use of the TASK Marks [paragr. 10 to 70, Exhibits 5 to 65]. In general, I note that the specimens consist of photographs of tools, accessories, safety goggles, and a tool belt. They show one of the TASK Marks on the packaging of the goods and/or on the goods themselves. I have listed the goods represented by the specimens in Appendix C of my decision.

[22] Mr. Waldner explained that the Opponent's basic clientele is composed of approximately 3,000 retailers, distributed across Canada, who sell hardware products [paragr. 72].

[23] Mr. Waldner provided the annual breakdown of the amounts spent by the Opponent from 1993 (\$41,208) to 2014 (\$591,846) for the promotion of its goods [paragr. 73]. I note that according to this annual breakdown, the Opponent's promotion expenses total \$6,217,006. Mr. Waldner specified that almost all the amounts spent by the Opponent concern print advertising associated with the TASK Marks [paragr. 74].

[24] Mr. Waldner explained that almost all promotion is done "*on a co-op basis with customers and directly through various media in Caplan's trade*" [paragr. 75].

[25] Mr. Waldner filed specimens of co-op advertising, accompanied by invoices, and of direct advertising [paragr. 76 to 79, Exhibits 66 to 69]. According to Mr. Waldner's representations, these specimens consist of:

- copies of Irly Distributors Ltd. circulars, each distributed in 260,000 copies (approx) in the British Columbia Lower Mainland. I note these circulars seem to date back to the year 2001;
- copy of a Totem Building Supplies circular, distributed in 611,822 copies (approx) in the Province of Alberta. I note this circular seems to date back to the year 1998;
- copy of a Lumberworld circular, in British Colombia. I note this circular is for the period from October 22 to 29, 2013; and
- copy of an advertisement in *Home Improvement Retailing*, apparently published in the February 2015 issue.

[26] Mr. Waldner explained that since the early 1980s, the Opponent has participated in trade shows held across Canada, where the TASK Marks are high profile. Mr. Waldner listed the trade shows in which the Opponent participated as of the date of its affidavit, and their locations [paragr. 80]. It appears from this list that 16 of the 22 trade shows are held in Canada.

[27] Mr. Waldner indicated that the TASK Marks appear on the Opponent's website, launched in 2004. He filed pages from the Opponent's current website [paragr. 81, Exhibit 70].

[28] The last two exhibits of Mr. Waldner's affidavit consist of price lists dating from January 1, 1988 and January 1, 1989 for the goods associated with the TASK Marks [paragr. 82 and 83, Exhibits 71 and 72].

Affidavit of Dulce Campos dated March 20, 2015 and its Exhibits A to S

[29] Ms. Campos is a researcher and trade-mark assistant employed by the firm acting as the Opponent's trade-mark agent. Ms. Campos submitted in evidence the results of online searches she conducted according to the instructions of Trisha A. Doré, a trade-mark agent.

[30] Before pursuing my review of the affidavit, I must discuss the Applicant's position, according to which I should not take Ms. Campos' affidavit into account because the evidence pertains to contested questions (citing *Cross-Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada*, 2006 FCA 133, 53 CPR (4th) 286; *Campbell Soup Co v Fancy Pokket Corp*, 2006 CanLII 80370, 56 CPR (4th) 359 (TMOB); and *Tritap Food Broker v Billy Bob's Jerky Inc*, 2012 TMOB 40, 100 CPR (4th) 244).

[31] I agree with the Applicant that, as an employee of the Opponent's trade-mark agents, Ms. Campos cannot be considered an independent witness with a totally objective deposition. Moreover, I acknowledge that in the *Campbell Soup Company* decision, supra, the Registrar refused to admit into evidence an affidavit of an employee of the opponent's agents seeking to prove an overlap between the parties' goods. The Registrar did likewise in the *Tritap Food Broker* decision, supra. However, it is possible that in these cases, the affidavits contained assertions that can be likened to opinions, which led the Registrar reasonably to refuse to admit

the evidence. It is a well-known principle of law that each case must be decided according to its specific circumstances.

[32] In the present case, a reasonable reading of her affidavit leads me to conclude that Ms. Campos is not expressing opinions, or making assertions that can be likened to opinions, that must be excluded from the evidence in application of the *Cross-Canada* decision, supra.

[33] I therefore will consider the evidence Ms. Campos presented, obviously accounting for its probative force. Consequently, I return to the review of the affidavit.

[34] Ms. Campos filed the definition of the term "*workwear*" found on the website *Dictionary.com*; this definition reads: "*clothes, such as overalls, as worn for work in a factory, shop, etc; working clothes*" [paragr. 4, Exhibit A].

[35] Ms. Campos files pages from websites of different retailers she visited "*for any work wear apparel*" [paragr. 5 to 21, Exhibits B to R]. The websites visited by Ms. Campos, as identified by her, are listed in Appendix D of my decision. I note that in addition to filing pages of the Mark's Work Warehouse website, Ms. Campos filed a circular of this retailer for the period from March 18 to 30, 2015 [Exhibit B].

[36] Finally, following the withdrawal of the ground of opposition based on subsection 30(a) of the Act, the excerpt from the *Manuel des produits et services* filed by Ms. Campos for the term "*accessories*" (accessories) is no longer relevant [paragr. 22, Exhibit S].

Analysis of the grounds of opposition

[37] The grounds of opposition raise the following questions:

1. Is the Mark registrable on today's date?
2. Was the Applicant the person entitled to registration of the Mark on April 16, 2013?
3. Was the Mark distinctive of the Applicant's goods as of August 19, 2014?

[38] I will examine these questions in turn.

1. Is the Mark registrable on today's date?

[39] This question arises from the ground of opposition alleging that the Mark is not registrable according to paragraph 12(1)(d) of the Act due to the Opponent's registrations Nos. TMA 278,164 and TMA358,452 for the TASK and TASK & Design trade-marks.

[40] I have exercised the Registrar's discretionary power to confirm that each of registrations alleged by the Opponent is in good standing. I recognize that the first footnote of each registration indicates that the Opponent was registered as holder on February 4, 1994 following a "transfer" from Caplan Industries Limited dated July 15, 1993. I note that this information is in line with the certificate of compliance from the British Columbia Corporate Registry, which indicates that the Opponent is the result of an "amalgamation" [Exhibit 2 of the Waldner affidavit].

[41] Since the Opponent has discharged its burden of proof regarding this ground of opposition, it is appropriate to determine whether the Applicant has discharged its legal onus to prove, according to the balance of probabilities, that there is no confusion between the Mark and the TASK (TMA278,164) and TASK & Design (TMA358,452) trade-marks.

[42] The test for confusion is that of first impression and imperfect recollection. According to subsection 6(2) of the Act, 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.

[43] In deciding whether these trade-marks cause confusion, the registrar must take into account all circumstances in the case, specifically those listed in subsection 6(5) of the Act, i.e. 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 or trade-names have been in use; c) the nature of the goods, services or business; d) the nature of the trade; 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 different weight will be given to each of these factors in a context-specific assessment. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve*

Clicquot Ponsardin v Boutiques Cliquot Ltée et al (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for an advanced examination of the general principles governing the test for confusion.]

[44] It emerges from the Opponent's representations that it considers that the use of its TASK & Design composite mark (TMA358,452) constitutes a use of its TASK word mark (TMA278,164). Thus, during the hearing, the Opponent focused its representations on the likelihood of confusion between the Mark and its TASK word mark.

[45] Since the word "TASK" is the dominant element of the TASK & Design composite mark, it is my opinion that any evidence of use of this mark, according to subsection 4(1) of the Act, may also be valid as evidence of use of the TASK word mark. Therefore, I will also focus my analysis of the likelihood of confusion by comparing the Mark with the TASK word mark. If it turns out that confusion is unlikely between the Mark and the TASK word mark (the TASK Mark), it would be no more likely with the TASK & Design composite mark

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

[46] This factor, stated in paragraph 6(5)(a) of the Act, is a combination of the inherent distinctiveness of the trade-marks and the distinctiveness acquired by them due to their use or promotion in Canada.

[47] Concerning the inherent distinctiveness of the marks, I note that "TASK" is a common word in the English language, the primary meaning of which is "*a piece of work to be done or undertaken*" [see online version of *Canadian Oxford Dictionary* (2nd ed.)]. During the hearing, the Applicant argued that the TASK Mark is suggestive of the function of the goods associated with it, because tools are used to perform "*a task*" and that consequently the TASK Mark does not have high inherent distinctiveness. I find that the Applicant's argument is reasonable. This having been said, it is my opinion that it is also reasonable to conclude that "TASK", when considered in the Mark as a whole, suggests that the goods associated with it are worn to perform a task, even more so in view of the term "WORKWEAR".

[48] All in all, I find that the marks of both parties have similar inherent distinctiveness.

[49] As I have already mentioned, a trade-mark can acquire distinctiveness due to its use or promotion in Canada. Yet there is no evidence in the case at bar to conclude that the Mark has acquired distinctiveness.

[50] During the hearing, the Applicant argued that the evidence concerning the use and promotion of the TASK Marks in Canada is not as important as the Opponent claims.

[51] I immediately note that, according to my understanding of its oral representations, the Applicant does not contest the Opponent's position that Mr. Waldner's affidavit as a whole is sufficient to prove that the TASK Mark has been used in Canada for over thirty years in association with tools and accessories. However, the Applicant challenges the evidence concerning the extent of this use.

[52] The Applicant submits, first and foremost, that Mr. Waldner's affidavit shows that the goods associated with the TASK Marks are not the only goods marketed by the Opponent. In this regard, the Applicant submits that Mr. Waldner clearly declares that the promotional expenses concern *all the Opponent's goods* [paragr. 73 of the Waldner affidavit]. The Applicant also submits that the mention found in the heading of the sales invoices issued effective from the year 2008, which I reproduce hereinafter, makes it possible to infer that the Opponent operates divisions selling other goods than those associated with the TASK Marks [Exhibits 5 to 65 of the Waldner affidavit].

Task Tools

A DIVISION OF CAPLAN INDUSTRIES INC

[53] The Applicant thereby submits that it is impossible to conclude that the sales figures presented in paragraph 9 of Mr. Waldner's affidavit only concern the goods associated with the TASK Marks [see paragr. 20 of my decision].

[54] In this regard, the Applicant argues that the sales figures are presented as those of the Opponent ("*gross sales of Caplan*") rather than as goods associated with the TASK Marks. In other words, according to the Applicant, Mr. Waldner did not clearly indicate that the sales

figures are only for the goods associated with the TASK Marks. Consequently, the Applicant urges me not to account for the sales figures in application of the well-known legal principle that any ambiguity in an affidavit should be resolved against the party who files the evidence [see *Conde Nast Publications Inc v Union Des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[55] During the hearing, the Opponent did not contest that the goods associated with the TASK Marks are not the only goods it markets in Canada. However, the Opponent vigorously contested the Applicant's argument concerning the ambiguity of the evidence of the sales figures. In this regard, the Opponent argues that a reasonable reading of paragraph 9 of Mr. Waldner's affidavit makes it possible to conclude that the sales figures concern the goods associated with the TASK Marks. I agree. Indeed, even though the formulation of paragraph 9 of the affidavit is somewhat murky, the Applicant's argument concerning the ambiguity of the evidence seems to disregard the reference to the TASK Marks at the very beginning of the paragraph.

[56] During the hearing, the Applicant also referred to the invoices to challenge the values of the sales in Canada of the goods associated with the TASK Marks. In particular, the Applicant noted that, according to the invoices filed by Mr. Waldner, sales of safety goggles would only total \$131.89 (Exhibit 64 of the Waldner affidavit). Yet the Opponent rightly submitted that a reasonable reading of Mr. Waldner's affidavit makes it possible to conclude that the invoices supplied by Mr. Waldner do not represent *all* the sales invoices of the goods concerned, including safety goggles.

[57] Consequently, despite its oral representations, the Applicant did not convince me that the Opponent did not prove significant sales of the goods associated with the TASK Marks in Canada.

[58] I do not intend to discuss at length the Applicant's oral representations regarding the evidence concerning the promotion of the TASK Marks. I acknowledge that there are deficiencies in this evidence. For example, there is no information concerning the number of participants in the trade shows held in Canada, in which the Opponent participated over the years, and the number of Canadians who have visited the Opponent's website since 2004. Nonetheless, a reasonable reading of Mr. Waldner's entire affidavit leads me to conclude that the

goods associated with the TASK Marks have been promoted continuously and significantly in Canada.

[59] Indeed, not only does Mr. Waldner supply specimens of co-op advertising and direct advertising over the years, but I remind the parties that according to his testimony, almost all of the Opponent's promotional expenses, which amounted to over \$6 million for the years from 1993 to 2014, were allocated to the print advertising associated with the TASK Marks [paragr. 73 and 74 of the Waldner affidavit].

[60] All in all, I find that the evidence presented by Mr. Waldner as a whole allows me to conclude that the TASK Mark has become widely known in Canada, or at least has become known to a non-negligible extent, whereas there is no evidence of use or promotion of the Mark in Canada.

[61] In view of the foregoing, I conclude that the overall assessment of the factor set out in paragraph 6(5)(a) of the Act favours the Opponent.

The period during which the trade-marks have been in use

[62] The Applicant acknowledges that this factor, set out in paragraph 6(5)(b) of the Act, favours the Opponent.

The type of goods and the nature of the trade

[63] In the context of the ground of opposition based on paragraph 12(1)(d) of the Act, I must assess these factors, set out in paragraphs 6(5)(c) and (d) of the Act, by comparing the statement of goods of the application under opposition with the statement of goods of registration No. TMA278,164 [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)]. These statements must be examined in the perspective of determining the probable nature of the trade envisioned by the parties, and not all of the trades, the wording could encompass, as recalled by the Federal court in *Bridgestone Corporation v Campagnolo SRL*, 2014 FC 37, 117 CPR (4th) 1.

[64] I remind the parties that the Applicant is seeking registration of the Mark in association with the following goods:

Clothing, namely sportswear, casual wear, leisure wear, jeans, blouses, sweaters, coats, pants, cargo pants, shirts, jackets; hats; shoes; accessories for men, women and children, namely belts, excluding belts for industrial use and in construction.

[65] I also remind the parties that I have reproduced in its entirety in Appendix A of my decision, the statement of goods of registration No. TMA278,164 and that, in general, these goods are hand tools, accessories and parts for hand tools, accessories for power tools, and safety goggles.

[66] For the purposes of examination of the type of goods and the nature of the trade, I will discuss the representations of each party in turn. I will conclude with my discussion of these representations and my assessment of the factors involved.

Opponent's representations

[67] During the hearing, the Opponent reiterated the representations found in its written argument to convince me that the type of goods and the nature of the trade are factors that favour it. The following is a summary of the Opponent's written and oral representations:

- In the absence of evidence from the Applicant, we must speculate on the type of goods and the nature of the trade associated with the Mark. However, it is reasonable to infer from "WORKWEAR" that the clothing and shoes associated with the Mark are "*workwear*". The Applicant's goods thereby are intended for the same consumers as those of the Opponent.
- There is an overlap between the nature of the trade of the parties in that the goods potentially could be used together by the same consumers (citing *Kamsut Inc v Jaymei Enterprises Inc*, 2010 TMOB 196).
- It is common for workwear and the Opponent's goods to be sold in the same distribution niches. In the absence of evidence from the Applicant regarding its distribution niches, there is no reason to presume that a significant difference exists

between the parties' distribution niches (citing *Manufacturier de Bas de Nylon Doris Ltée v Eclectic Edge, Inc*, 2013 TMOB 213).

- The Opponent's goods are offered in retail stores that also offer workwear. Ms. Campos' affidavit shows that the large-surface stores Rona, Lowes, Canadian Tire, Army & Navy, and Walmart sell workwear [Exhibits D, I, K, O and P of the Campos affidavit]. A number of invoices found among Exhibits 5 to 65 of Mr. Waldner's affidavit show that these retailers are all customers of the Opponent.
- Safety goggles and tool belts are similar to clothing in that they are articles that are worn. On the Rona website one can find safety goggles among the clothing, particular hats, jackets, sweaters, shoes, shirts, jeans, belts, stockings, and clothing corresponding to leisure wear (Exhibit D of the Campos affidavit).
- The exclusion "belts for industrial or construction use" is nothing other than a barely veiled attempt to convince the Registrar that the "belts" associated with the Mark would not be found in renovation stores or hardware stores. However, no evidence was presented by the Applicant to support this conclusion.
- The exclusion "for industrial or construction use" is limited to belts. It does not apply to any of the other goods. In particular, this exclusion does not apply to "hats", "pants", "jackets", "shoes", "jeans", "coats", "shirts", "cargo pants" or "leisure wear" identified as goods in the application and all sold in the same distribution niches as the Opponent's goods, as proved by its evidence. The limitation of the exclusion to belts reinforces the thesis that all the other goods described in the registration application are "for industrial or construction use") citing the *Expressio Unius Est Exclusio Alterius* principle of legal interpretation. In French, "L'expression d'une chose signifie l'exclusion de l'autre". In English, [TRANSLATION] "The expression of one thing means the exclusion of the other").

[68] In addition to the foregoing, during the hearing, the Opponent argued that the case at bar is one in which the concept of natural extension of its goods supports the conclusion that consumers would be likely to conclude wrongly that the Opponent is the source of the goods associated with the Mark (citing *Les Marques Metro / Metro Brands senc v Julia Wine Inc*,

2014 TMOB 230, 126 CPR (4th) 89; and *Lutron Electronics Co v Litron Distributors Ltd*, 2013 TMOB 129, 14 CPR (4th) 194). I note that since the hearing was held, the Registrar's decision in *Les Marques Metro*, supra, has been upheld by the Federal Court [see *Julia Wine Inc v Les Marques Metro / Metro Brands senc*, 2016 FC 738].

Applicant's representations

[69] It is no surprise that the Applicant contests the Opponent's claims. The following summarizes my understanding of the Applicant's oral representations:

- In view of the statement of goods of the application, it is inaccurate to conclude that the mention "WORKWEAR" means that the goods associated with the Mark are work clothing and work shoes. Moreover, the statement of goods of the application refers to "sportswear", "casual wear", "leisure wear". Even if the Opponent's argument were appropriate, there are different types of work. It is thereby impossible to infer that "hats", "pants", "jackets", "shoes", "jeans", "coats", "shirts", "cargo pants" or "leisure wear" associated with the Mark can be intended for industrial or construction workers.
- It is inappropriate to apply the legal principle *Expressio Unius Est Exclusio Alterius* to interpret the statement of goods of the registration application.
- The statement of goods of the application and the statement of goods of registration No. TMA278,164 speak for themselves: the goods involved are fundamentally different.
- None of the specimens submitted in evidence by Mr. Waldner proves the use or promotion of the Mark in association with clothing. Not only are tool belts not identified in registration No. TMA278,164, but it is not because these belts are worn that they must be considered as clothing. Also, just because safety goggles are worn does not mean they must be considered clothing. Moreover, the Opponent's evidence shows that safety goggles are advertised with tools.

- The facts in the case at bar are distinguished from those found in the decisions cited by the Opponent to substantiate its position that consumers could be likely to conclude wrongly that the Opponent is the source of the goods associated with the Mark in application of the concept of natural extension of its goods.
- If Ms. Campos' affidavit is admitted into evidence, it cannot be granted any probative force, because the evidence constitutes hearsay. Ms. Campos did not visit the retailers in question to verify whether the Opponent's goods and workwear are sold side by side.
- If it were to be decided that the Opponent's evidence establishes that its goods are offered in retail stores that also offer clothing corresponding to the clothing associated with the Mark, the parties' goods are so different that if they were found in different in-store locations, this mitigates the likelihood of confusion (citing *Clorox Co v Sears Canada Inc*, (1992) 41 CPR (3d) 483 (FCTD), upheld by (1993) 49 CPR (3d) 217 (FCA); and *Edelweiss Food Products Inc v World's Finest Chocolate Canada Ltd*, 2000 CanLII 28672, 5 CPR (4th) 256 (TMOB)).

[70] In view of its representations concerning Ms. Campos' affidavit, during the hearing I invited the Applicant's comments regarding the possibility that I may recognize automatically that a wide range of goods is offered for sale in certain hardware chains, such as Rona. The Applicant indicated that it accepts this possibility. However, it reiterated that it is reasonable to conclude that the goods associated with the TASK Mark would not be sold side by side with workwear, and even less so with clothing and shoes and are not workwear.

Discussion of the representations and assessment of the factors set out under paragraphs 6(5)(c) and (d) of the Act

[71] I immediately note that the decisions cited by the parties are relevant to the extent they involved opposition proceedings and raise the principles that govern the test for confusion. However, as I have already mentioned, it is a well-known principle of law that each case must be decided according to its specific circumstances.

[72] I agree with the Applicant that the goods identified in its application differ from those identified in registration No. TMA278,164. However, subsection 6(2) of the Act clearly indicates that there may be a likelihood of confusion, regardless of whether the goods are of the same general class.

[73] Moreover, the assessment of the type of goods must take into account the evidence and the proceedings, not the unsubstantiated representations of the parties. The Applicant has chosen not to file evidence to establish that the goods are not work clothing and work shoes, and that the term "WORKWEAR" in the Mark was not chosen because of the type of clothing and shoes.

[74] Thus, in the absence of evidence by the Applicant and the absence of restriction in the statement of goods of the registration application, I agree with the Opponent that the possibility cannot be excluded that the clothing and shoes associated with the Mark are work clothing and work shoes, or intended for workers. I would add that I arrive at this conclusion while disregarding the Opponent's argument based on the applicability of the principle *Expressio Unius Est Exclusio Alterius* in matters of legal interpretation. As for the exclusion of "belts for industrial or construction use", I do not believe that it is appropriate to attach as much significance to this as the Applicant argues. Belts are clothing accessories that may be worn by workers.

[75] I will add in this regard that I find unconvincing the Applicant's argument that it is impossible to infer that clothing associated with the Mark can be intended for industrial or construction workers, due to the fact that [TRANSLATION] "different types of work" exist. The mere fact that different types of work exist in no way allows a specific type of clientele to be excluded. It is also appropriate to note on this point that the statement of goods of registration No. TMA278,164 of the TASK Mark also in no way mentions a specific type of clientele. Moreover, having considered the photographs attached to Mr. Waldner's affidavit, I conclude that an ordinary Canadian consumer may use the goods associated with the TASK Mark. In other words, neither the statement of goods of the registration or the Opponent's evidence makes it possible to conclude that only industrial and construction workers are likely to procure the hand tools, accessories and parts for hand tools, accessories for power tools, and safety goggles associated with the TASK Mark.

[76] In view of all of the foregoing, the Applicant has not convinced me that the fact that the goods associated with the parties' marks are intrinsically different is sufficient to conclude that the Applicant is favoured significantly by the assessment of the factor set out in paragraph 6(5)(c) of the Act.

[77] Concerning the nature of the trade, I note in the first place that Ms. Campos does not state that the retailers mentioned in her affidavit sell the Opponent's goods side by side with workwear, contrary to what the Applicant suggested during the hearing. Instead, the Opponent relies on Ms. Campos' affidavit to argue that safety goggles and workwear are offered side by side by retailers who are customers of the Opponent.

[78] I agree in part with the Applicant's position concerning the probative force of the retailers' web pages supplied by Ms. Campos. Indeed, I find that the information and statements contained in these pages regarding the goods shown constitute hearsay. Thus, the retailers' web pages cannot be accepted as evidence for the veracity of their content [see *Candrug Health Solutions Inc v Thorkelson*, 2007 FC 411, 60 CPR (4th) 35 (FC); overturned on other grounds, 2008 FCA 100, 64 CPR (4th) 431]. On the other hand, I do not see any reason for not accepting that these pages show workwear offered by the retailers in question and that they existed when Ms. Campos visited the websites [Exhibits B to R of the Campos affidavit]. However, I note that Ms. Campos does not specify in her affidavit the date of her visit to any of the websites. Moreover, I did not find the presence of dates on the printouts of the web pages.

[79] Ultimately, the fact that I refused to exclude Ms. Campos' affidavit from the Opponent's evidence has no impact for the Applicant.

[80] Indeed, I am ready to recognize automatically that a wide range of products is offered for sale in a major hardware chain, such as Rona. I am also ready to recognize automatically that a wide range of products is offered for sale in large-surface stores, such as Canadian Tire. However, as the Opponent argues, some of the invoices found among Exhibits 5 to 65 of Mr. Waldner's affidavit prove that Rona and Canadian Tire are customers of the Opponent.

[81] Finally, when determining the likelihood of confusion, it is unnecessary to prove that the parties' goods are sold at the same points of sale; the mere fact that the parties have the

possibility of doing so is sufficient [see *Cartier Men's Shops Ltd v. Cartier Inc* (1981), 58 CPR (2d) 68 (FCTD)]. In the case at bar, the statement of goods of the registration application and the statement of goods of the registration do not restrict the parties' distribution niches. I would add that subsection 6(2) of the Act does not require the products to be sold side by side to conclude there is a likelihood of confusion.

[82] All in all, in the absence of contrary evidence, I find that it cannot be excluded that the goods identified in the application under opposition can be offered by retailers who offer the goods identified in registration No. TMA278,164. Thus, I conclude there is the possibility of an overlap between the parties' distribution niches and that the Opponent is favoured by the assessment of the factor set out in subsection 6(5)(d) of the Act.

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

[83] In the *Masterpiece* decision, *supra*, the Supreme Court of Canada ruled that the degree of resemblance between the marks, even though this is the last factor listed in subsection 6(5) of the Act, is the statutory factor that is often likely to have the greatest effect on the test for confusion.

[84] It is clearly established that in the assessment of confusion, it is not appropriate to dissect trade-marks into their component parts. Trade-marks instead must be examined as a whole. The first part of a trade-mark is generally considered as the most important when assessing the likelihood of confusion [see *Conde Nast Publications Inc*, *supra*, p. 188]. In paragraph 64 of the *Masterpiece* decision, the Court writes that to measure the degree of resemblance, a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.

[85] Incidentally, the word "WORKWEAR" in the Mark is not particularly striking or unique, because the Mark is associated with clothing. Since the TASK Mark is entirely present as the first part of the Mark, a high degree of resemblance thereby exists between the trade-marks in their presentation and sound. I also conclude there is a degree of resemblance in the ideas suggested by the marks, in that each suggests the idea of a task, namely a specified piece of work that must be performed.

[86] Therefore, I conclude that the assessment of the factor set out in paragraph 6(5)(e) of the Act favours the Opponent.

Conclusion on the likelihood of confusion

[87] I remind the parties that the test for confusion consists in asking whether an individual with an imperfect recollection of the Opponent's TASK mark could conclude, on the basis of a first impression, that the goods associated with the Mark come from the same source or are otherwise related to or associated with the Opponent's goods.

[88] Further to my analysis of the factors set out in subsection 6(5) of the Act, I conclude that the Applicant has not discharged its ultimate onus of establishing, according to the balance of probabilities, that there is no risk of confusion between the Mark and the Opponent's TASK mark.

[89] Indeed, in view of the presence of the term "WORKWEAR" in the Mark, I find it is more than likely that a consumer seeing the Mark associated with clothing and shoes will conclude, on the basis of the first impression, that it concerns work clothing and work shoes. I thereby find that the possibility cannot be excluded that a consumer with an imperfect recollection of the TASK Mark may believe that the goods associated with the Mark comes from the same source as or are otherwise related to the Opponent's goods. I arrive at this conclusion, particularly by taking into account my conclusion regarding the possibility of an overlap between the parties' commercial niches and the fact that the degree of resemblance between the marks, the distinctiveness acquired by the TASK Mark and its use in Canada for over thirty years are all factors that favour the Opponent.

[90] Ultimately, in view of the circumstances of the case at bar, I conclude that the differences between the type of goods is not a sufficient factor to tip the balance of probabilities in favour of the Applicant. At best for the Applicant, I find that the balance of probabilities is also split between the conclusion that a likelihood of confusion exists between the Mark and the TASK Mark and the conclusion that no likelihood of confusion exists. Since the ultimate onus that no reasonable likelihood of confusion exists between the Mark and the TASK Mark rests with the Applicant, I resolve the question in favour of the Opponent.

[91] In view of my conclusion, I find it is unnecessary for me to rule on the likelihood of confusion between the Mark and the Opponent's TASK & Design trade-mark (TMA358,452).

[92] Due to the foregoing, the ground of opposition based on paragraph 12(1)(d) of the Act is granted, to the extent it is based on registration No. TMA278,164 for the TASK trade-mark.

2. Was the Applicant the person entitled to registration of the Mark on April 16, 2013?

[93] This question arises from the ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark, according to paragraph 16(3)a) of the Act, due to the confusion with the TASK and TASK & Design trade-marks that the Opponent alleges to have used or made known previously in Canada.

[94] It must be noted that the Applicant, during the hearing, argued that the Opponent pleaded its ground of opposition by restricting it to an allegation of having used its marks or made them known in association with the goods covered by registrations No. TMA278,164 and No. TMA358,452. Thus, the Applicant submits that the Opponent did not allege that it used its marks or made them known in association with tool belts. On the basis of a fair interpretation of the ground of opposition argued, I agree with the Applicant.

[95] As for the ground of opposition based on paragraph 12(1)d) of the Act, I will focus my analysis on the ground of opposition by considering the Opponent's TASK Mark.

[96] As proved by Appendix C of my decision, Mr. Waldner filed specimens of use of the TASK Mark, accompanied by sales invoices for the years 2003 to 2014, for practically all the goods identified in registration No. TMA278,164. I find that Mr. Waldner's affidavit on the whole is fully sufficient to conclude that the Opponent has discharged its ultimate onus of proving its use of the TASK Mark in Canada previous to April 16, 2013, in association with hand tools, accessories and parts for hand tools, accessories and parts for power tools, and safety goggles, and the non-abandonment of the TASK Mark as of the date of announcement of the application, namely March 19, 2014 [see subsection 16(5) of the Act].

[97] Since the difference in the relevant date has essentially no impact on my previous assessment of the factors set out in subsection 6(5) of the Act, I conclude that the Applicant has

not discharged its ultimate onus of establishing, according to the balance of probabilities, that there was no risk of confusion between the Mark and the TASK Mark as of April 16, 2013.

[98] Therefore, the ground of opposition based on paragraph 16(3)(a) of the Act is granted, to the extent it is based on the likelihood of confusion with the TASK Mark previously used in Canada by the Opponent in association with the hand tools, accessories and parts for hand tools, accessories for power tools, and safety goggles identified in registration No. TMA278,164.

Was the Mark distinctive of the Applicant's goods as of August 19, 2014?

[99] This question arises from the ground of opposition alleging that the Mark is not distinctive, according to section 2 of the Act, because it does not distinguish and is not capable of distinguishing the Applicant's goods from the goods associated with the Opponent's TASK and TASK & Design trade-marks.

[100] Considering Mr. Waldner's affidavit as a whole, I conclude that the Opponent has discharged its ultimate onus of proving that its TASK Mark, as of August 19, 2014, had acquired a sufficient reputation in Canada to deny the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v. Bojangles Café Ltd* (2006), 2006 FC 657, 48 CPR (4th) 427].

[101] Once again, the difference of relevant date has essentially no impact on my assessment of the factors set out in subsection 6(5) of the Act on the ground of opposition based on paragraph 12(1)(d) of the Act and based on registration No. TMA278,164 for the TASK Mark.

[102] Consequently, I conclude that the Applicant has not discharged its ultimate onus of establishing that the Mark, as of August 19, 2014, was distinctive of the goods identified in the registration application, and I grant the ground of opposition based on section 2 of the Act.

Decision

[103] In exercising the authority delegated to me pursuant to subsection 63(3) of the Act, I refuse registration application No. 1,622,711 in application of subsection 38(8) of the Act.

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

Certified true translation
Arnold Bennett

APPENDIX A

Statement of Goods of Registration No. TMAC278,164

- (1) Ratchets, socket sets, wood boring bits, sandpaper, and abrasive cutting wheels.*
- (2) Hand tools, namely hand saws, carpenters pencils, levels, squares, scratch brushes, sanding blocks, punches, chisels, snips, wire brushes, pliers, utility knives, bow saws, drywall saws, nail sets, squares, layout tools, sanding sponges, wrenches, screw extractors, files, rasps, hex keys, chalk lines, hack saws, key hole saws, hammers, tape measures, screw drivers and nut drivers.*
- (3) Accessories and parts for hand tools, namely saw blades and metal drilling bits.*
- (4) Accessories for power tools, namely sanding belts, grinding wheels, sanding discs, drill bits, hole saws, counter sinks, saw blades, sanding wheels, router bits, drill chucks, drill keys, jigsaw blades, depressed center wheels, reciprocating saw blades, dowel drills, tapered plug cutters, ball bearings, chuck keys, wood screw pilots, bit holders, nut setters, wire wheels and dado heads.*
- (5) Drywall tape, chalk and safety goggles.*

APPENDIX B

Analysis of the Grounds of Opposition

- (d) **Sections 38(2)(b) and 12(1)(d):** Pursuant to Section 38(2)(b) of the Act, the trade-mark as applied for is not registrable in view of Sections 38(2)(b) and 12(1)(d) of the Trade-marks Act because it is confusing with the registered trade-marks namely, registration numbers TMA278,164 and TMA358,452 granted in respect of the trademarks TASK and TASK & Design respectively, which are owned and used in Canada since 1983 by the Opponent in association with work tools and accessories, as more particularly set out in a copy of these registrations attached to this Statement of Opposition as “Schedule A”.
- (e) **Sections 38(2)(c), 16(3)(a) and 16(5):** The Applicant is not the person entitled to registration of the proposed trade-mark in view of Sections 38(2)(c), 16(3)(a) and 16(5) of the Trade-marks Act because, at the date of filing of the application, the proposed trade-mark was confusing with the trade-marks TASK and TASK & Design, which the Opponent previously had used or made known in Canada since 1983 in association with the wares set out in registration numbers TMA278,164 and TMA358,452 detailed in subparagraph (d) and Schedule A and which were not abandoned at the date of advertisement of the Applicant’s application.
- (f) **Sections 38(2)(d) and 2:** Pursuant to Section 38(2)(d) of the Act, the Trade-mark is not distinctive in view of Section 2 of the Act because, at all material dates including the date of filing of this Statement of Opposition, the trade-mark applied for is not distinctive, having regard to the provisions of Sections 38(2)(d) and 2 of the Trade-marks Act, because it is not capable of distinguishing the Applicant’s wares from those of others, particularly the wares sold by the Opponent under the trade-marks set out in subparagraph (d) to this statement of opposition namely TASK and TASK & Design, nor is it adapted to so distinguish them.

APPENDIX C

List of Goods Represented by the Specimens of Use of the Opponent's TASK Marks

- *Ratchets*
- *Socket set*
- *Wood boring bit*
- *Sand paper*
- *Saw*
- *Carpenter pencil*
- *Level*
- *Square*
- *Scratch brush*
- *Sanding block*
- *Punch*
- *Chisel*
- *Set of snips*
- *Wire brush*
- *Set of pliers*
- *Utility knife*
- *Bow saw*
- *Drywall saw*
- *Nail set*
- *Layout tool*
- *Sanding sponge*
- *Wrench*
- *Screw extractor*
- *File*
- *Rasp*
- *Hex key*
- *Chalk line*
- *Hack saw*
- *Keyhole saw*
- *Hammer*
- *Tape measure*
- *Screwdriver*
- *Nut driver*
- *Saw blade*
- *Metal drilling bits*
- *Sanding belts*
- *Grinding wheels*
- *Sanding discs*
- *Drill bits*
- *Hole saw*
- *Counter sinks*
- *Saw blade*
- *Sanding wheels*
- *Mesh sanding screens*
- *Router bit*
- *Drill chuck*
- *Drill key*
- *Jigsaw blades*
- *Depressed centre wheels*
- *Reciprocating saw blades*
- *Dowell drill*
- *Tapered plug cutter*
- *Chuck key*
- *Wood screw pilot*
- *Bit nut holders*
- *Wire wheel*
- *Dado heads*
- *Drywall tape*
- *Powdered chalk*
- *Safety goggles*
- *Tool belt*

APPENDIX D

Websites Visited by Dulce Campos

- Mark's Work Warehouse at *www.marks.com*
- Imagewear at *www.imagewear.ca*
- Rona at *www.rona.ca*
- Big K Clothing at *www.bigkclothing.ca*
- Dickies Canada at *www.dickies.ca*
- Helly Hansen at *www.hhworkwear.com*
- The Home Depot at *www.homedepot.ca*
- Lowe's Canada at *www.lowes.ca*
- Summit Tools at *www.summittools.com*
- Canadian Tire at *www.canadiantire.ca*
- Work Authority at *www.workauthority.ca*
- Industry Workwear at *www.industryworkwear.ca*
- Army and Navy (The address is not reflected in the affidavit because paragraph 17 is truncated.)
- Sears Canada at *www.sears.ca*
- Walmar (sic) at *www.walmart.ca*
- KMS Tool and Equipment at *www.kmstools.com*
- IHL Canada at *www.ihlcanada.com*

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

HEARING DATE: 2016-06-01

APPEARANCES

Trisha A. Doré

FOR THE OPPONENT

Thomas Gagnon-van Leeuwen

FOR THE APPLICANT

AGENT(S) OF RECORD

ACCUPRO TRADEMARK SERVICES LLP

FOR THE OPPONENT

ROBIC

FOR THE APPLICANT