



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

Citation: 2012 TMOB 162
Date of Decision: 2012-08-21

**IN THE MATTER OF AN
OPPOSITION by Metallica, a
California general partnership to
application No. 1,407,794 for the
trade-mark METALLICA in the
name of 523544 B.C. INC.**

[1] On August 19, 2008, 523544 B.C. INC. (the Applicant) filed an application to register the trade-mark METALLICA (the Mark). The application was filed on the basis of the Applicant's use in Canada since at least as early as 1996 in association with the following:

Custom metal fabrication; Welding; Machining (the Services).

The application was advertised for opposition purposes in the *Trade-marks Journal* of June 17, 2009.

[2] On July 9, 2009, Metallica, a California general partnership (the Opponent) filed a statement of opposition pleading the grounds summarized below. As the Opponent did not include the specific subsections of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) allegedly contravened, I have included these.

- (a) contrary to section 30(a) of the Act, the application does not contain a statement in ordinary commercial terms of the specific services with which the Mark has been used;
- (b) contrary to section 30(b) of the Act, the application does not contain a date from which the Applicant has so used the Mark in association with the Services;
- (c) contrary to section 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Mark as it was aware of the Opponent's use of the METALLICA trade-mark in Canada;
- (d) contrary to section 12(1)(d) of the Act, the Mark is not registrable because it is confusing with registration Nos. TMA576,901; TMA463,382; TMA665,287; and TMA535,099;
- (e) contrary to section 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of first use in the application, the Mark was confusing with the use of the Opponent's trade-marks MANDATORY METALLICA and METALLICA; and
- (f) contrary to section 2 of the Act, the Mark is not distinctive of the Applicant.

[3] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[4] In support of its opposition, the Opponent filed a certified copy of each of registration Nos. TMA576,901; TMA463,382; TMA665,287; and TMA535,099 and an affidavit of Anthony DiCioccio. In support of its application, the Applicant filed an affidavit of William Lawson. Both parties filed a written argument. Following the exchange of the written arguments, the Opponent pointed out that the Applicant's written argument improperly included new evidence. The portions of the Applicant's written argument that attempt to introduce or refer to new evidence have been disregarded.

[5] The Opponent attended a hearing held on April 18, 2012.

Onus and Material Dates

[6] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[7] The material dates with respect to the grounds of opposition are as follows:

- sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- section 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(1) of the Act - the date of first use claimed in the application; and
- sections 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Section 30 Grounds of Opposition

[8] The section 30(a) ground alleges that the application does not contain a statement of services in ordinary commercial terms. As no evidence or argument was filed in support of this ground, the Opponent has not met its burden and it is dismissed [*McDonald's Corp v MA Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 (TMOB) 104].

[9] The section 30(i) ground alleges that the Applicant could not have been properly satisfied that it was entitled to use the Mark because the Applicant must have been aware of the Opponent's trade-mark. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where

there is evidence of bad faith [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is dismissed.

[10] Turning now to the section 30(b) ground of opposition, the application for the Mark claims a first use date of 1996 which is interpreted as December 31, 1996. Section 30(b) of the Act requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the date of filing of the application [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[11] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P.'s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. This burden may be met by reference not only to the opponent's evidence but also to an applicant's [*Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. While an opponent may rely upon an applicant's evidence to meet its evidential burden in relation to this ground, an opponent must show that the applicant's evidence is "clearly" inconsistent with the claims in the application [*Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), aff'd 11 CPR (4th) 489 (FCTD)].

[12] The evidence of William Lawson, the sole owner, director and officer of the Applicant, provides the following:

- The Applicant was incorporated on July 12, 1996 and owns and operates Metallica Mfg, a sheet metal shop that provides the Services (para 5).
- In his affidavit, Mr. Lawson states the following:

Para 5 Metallica Mfg is a sheet metal shop that provides custom metal fabrication, welding and machining services to the public using the mark "Metallica" ... in association with those services ...

Para 6 Metallica Mfg has provided the Services in association with the Mark beginning at least as early as 1996 and has done so every year since that time.

- The Services are offered to a variety of industries including “medical, food processing, food service, construction/industrial” (Exhibit F).
- The Applicant’s business records are kept for only five years and there are no documents available which show sales relating to the Services or Mark in 1996 or for the next several years (para 8).
- The affidavit includes:
 - a work order from 2001 (Exhibit B) and several purchase requisitions in 2003 (Exhibit C) all of which list “Metallica Mfg” as the trade-name of the company performing the quoted work and appear to be prepared by the Applicant’s customers;
 - work orders prepared by the Applicant in 2010 (Exhibit D) which show the following; and

METALLICA MFG.

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- print-outs from the web-site *www.metallicamanufacturing.ca* dated June 25, 2010 (Exhibit F) which Mr. Lawson states has been operation since in or about 2002 (para 17).

[13] The Opponent submits the following in an effort to meet its burden under section 30(b) of the Act. First, that the Applicant has used the trade-name METALLICA MFG rather than the Mark. Second, that there is no evidence of use of the Mark in association with the Services.

[14] The Opponent first submits that Exhibits B and C are “clearly inconsistent” with the Applicant’s claimed use of the Mark between 1996 and the filing date (August 19, 2008) since they do not show use of the Mark but rather the trade-name. Since these work orders appear to be prepared by the Applicant’s customers it is expected that they would not show use of the Mark. I disagree with the Opponent’s submissions that these Exhibits should be taken as representative of or examples of the Applicant’s use of the Mark between 1996 and August 19, 2008 since they are the only documentary evidence attached to the affidavit from that period of time. I note that nowhere in the affidavit does Mr. Lawson state that the exhibits show how the Mark was typically used or that the Exhibits provide an example of how the Mark was used. Rather, reading the affidavit as a whole, I infer that Mr. Lawson was providing documentary evidence in support of the fact that the Applicant was offering services during this time.

[15] The Opponent also argues that Exhibit D does not show use of the Mark but rather METALLICA MFG. First, as these work orders (prepared by the Applicant) post date the relevant date for this ground of opposition they are not relevant [*Molson Canada 2005 v XL Energy Marketing Sp z o. o.* (2012), 100 CPR (4th) 225 (TMOB) at para 16]. Second, I find that such use is trade-mark use in addition to trade-name use since METALLICA MFG. appears in a much larger stylized font above the address [*Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (T.M.O.B.); *Bereskin & Parr v Red Carpet Food Systems Inc* (2007), 64 CPR (4th) 234 (TMOB) at para 17]. In this way, it would be perceived by consumers as indicating the source of the custom metal fabrication services referenced in the work orders. Third, the use of METALLICA MFG. would qualify as use of the Mark since MFG. is descriptive of the specific manufacturing services (custom metal fabrication; welding; machining) provided [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *Little Eagle Cor v Ailments Dainty Foods Inc* (1994), 53 CPR (3d) 573 at 576 (TMOB)].

[16] It was open to the Opponent to cross-examine Mr. Lawson on his affidavit in order to clarify any ambiguities that exist in his evidence with respect to how the Mark was used. The Opponent chose to not to request cross-examination and it cannot satisfy

its evidential burden by pointing to these ambiguities which do not render Mr. Lawson's evidence clearly inconsistent with the date of first use claimed in the application. Accordingly, this ground of opposition is dismissed.

Section 12(1)(d) Ground of Opposition

[17] I have exercised my discretion and checked the register to confirm that registration Nos. TMA576,901; TMA463,382; TMA665,287; and TMA535,099 are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground of opposition. I consider that the Opponent's best chance of success is with its registration No. TMA665,287 for METALLICA. The particulars for this registration are set out below.

Registration No.	Trade-mark	Wares and Services
TMA665,287	METALLICA	<p>Ornamental novelty buttons, ornamental novelty patches for clothing; Car bumper stickers, metal key chains; Pendants, tags, metal key rings; Cans containing various merchandise namely, key chains, videos, musical recordings, clothing, stickers and novelty items; Ashtrays; Dog tags; Rugs, door mats; Cigarette lighters; Non-metal key chains; Metal license plates, license plate frames, furniture, namely, bar stools, license plate frames made of plastic, floor mats for vehicles, SUV mats, car cleaning substances and tools, namely, air fresheners; Statuettes; Flashlights; Body adornments, all made wholly or partially of common metals or their alloys; Flashlights; Lunch boxes; Wall hangings made of paper; wallpaper; Ornamental novelty patches for clothing; ornamental novelty buttons and ornamental novelty pins; Rugs and doors mats; Air fresheners.</p> <p>Live performances; Entertainment services; namely, live musical performances.</p>

[18] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated 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 likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[19] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis. I will therefore commence with this issue.

Degree of Resemblance Between the Marks

[20] The Mark and the Opponent's METALLICA registration are identical in sound and appearance. Even though the parties' marks are identical in appearance, I find that they suggest different ideas when considered in association with the wares and services of each party. The Opponent's METALLICA trade-mark suggests heavy metal, the type of music played by the Opponent (Exhibit C to the affidavit of Anthony DiCioccio). In contrast, the Mark suggests that the Services involve or use metal.

Inherent distinctiveness and extent known

[21] The parties' marks have a similar degree of inherent distinctiveness. The extent of use favours the Opponent as its METALLICA mark would be regarded as a famous

mark with respect to goods and services related to music. The evidence of Anthony DiCioccio, personal manager of the Opponent, provides the following:

- Metallica formed in 1981 and is one of North America's most famous musical groups (para 4). It has released over 11 albums, 24 music videos and 45 singles (para 5).
- Since 1981 performance revenues in association with Canadian Metallica performances have exceed \$45 Million. This ranges from no revenues in 1999-2002 and 2005-2008 (when there were no performances in Canada) to over \$12 Million in 2004 (para 28).
- Sales of Metallica's music and performances have exceeded 5 million units in Canada in various formats including videocassettes, DVD video, audio cassettes, laser discs, compact discs, digital downloads, ringtones and internet video (para 37).
- References to Metallica and its music and concerts have appeared in numerous Canadian newspapers including: The Toronto Sun, The New Brunswick Telegraph-Journal, The Montreal Gazette, The Toronto Star, the Edmonton Journal, The Ottawa Citizen and The Globe and Mail (Exhibit K). No circulation figures have been provided. I am, however, prepared to take judicial notice of the fact that The Globe and Mail has wide circulation in Canada and each of the other papers has some circulation in their named areas [*Milliken & Co v Keystone Industries (1979) Ltd* (1986), 12 CPR (3d) 166 (TMOB) at 168-169].
- Metallica has sold merchandise made from metal in association with the METALLICA trade-mark including the following (para 19):

Metal license plates; metal key chains; metal key rings; metal switch plates; jewellery made from metal, namely, necklaces, rings, earrings; metal lunch boxes; furniture, namely, metal bar stools ("Metallica Merchandise").

- That since 1981, Metallica's Canadian sales revenues in association with Metallica Merchandise exceed \$14 Million and for the years between 2006-2009 ranged from between \$490,000 to \$3.6 Million approximately (para 27).

In contrast, the Applicant has not provided any information which would allow me to quantify the extent of its use.

Length of time in use

[22] This factor favours the Opponent as registration No. TMA665,287 has been in use since 1985 in contrast to the Mark which has been in use since 1996.

Nature of the wares, services and trade

[23] When considering the nature of the wares, services and trade, I must compare the Applicant's statement of services with the statement of wares and services in the Opponent's registration [*Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB) at 98-99]. However, these 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), 68 CPR (3d) 168 (FCA)].

[24] The Opponent's METALLICA trade-mark is used in association with the famous musical group Metallica. It is used not only in association with musical performances by this group but also with a wide range of merchandise including the Metallica Merchandise. There is, however, no suggestion in the evidence that the Opponent offers manufacturing services or that its registered wares can be customized in any way. The Opponent's wares and services appear directed to those that enjoy its music.

[25] In contrast, the Mark is used in association with custom metal fabrication; welding; machining. The Applicant has made products for industries as diverse as health care, food processing, food services, and construction including surgical carts, stretchers, smoke house racks, washroom enclosures, deep fry stations, and window flashings. Its

Services are those of a manufacturer designing and making custom or customizable goods for sophisticated consumers.

[26] The Opponent argues that the Services overlap with the Opponent's registered wares and services since a customer would be likely to contact the Applicant to order a set of custom-made METALLICA branded bar stools as the Applicant is a metal fabricator offering a wide variety of custom metal fabrication services (Opponent's Written Argument, paras 7.39-7.44). To me this seems like a very tenuous connection and I find that there are significant differences between the parties' wares, services, businesses, channels of trade and prospective consumers. This is the case even though the Opponent's mark may be regarded as a famous one with respect to goods and services related to a musical group [*Mattel, Inc v 3894207 Canada Inc, supra* at paras 82-83].

Conclusion

[27] Section 6(2) is not concerned with confusion between the marks themselves, but rather confusion as to the source of the goods or services. In this case, an assessment of confusion asks whether there would be confusion of the Services, provided in association with the Mark, as emanating from or sponsored by or approved by the Opponent. In view of the differences between the nature of the parties' respective wares and services and the differing ideas suggested the use of the METALLICA mark by each party, I do not find on a balance of probabilities that there is a likelihood of confusion. Accordingly, this ground of opposition is dismissed.

Remaining Grounds of Opposition

[28] The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's METALLICA and MANDATORY METALLICA trade-marks. While the Opponent has met its initial burden, the Applicant has also met its burden because there is no likelihood of confusion for the reasons set out in the discussion of the section 12(1)(d) ground.

Disposition

[29] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board