



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

Citation: 2017 TMOB 83

Date of Decision: 2017-07-12

IN THE MATTER OF AN OPPOSITION

**The Kingsford Products Company,
LLC**

Opponent

and

Tokai of Canada Ltd.

Applicant



1,655,739 for KING

Application

INTRODUCTION

[1] On December 5, 2013, the Applicant filed an application to register the trade-mark KING (the Mark). The application is based upon proposed use of the Mark in Canada, in association with “butane”.

[2] The Opponent is the owner of the registered trade-marks KINGSFORD (TMA344,604), KINGSFORD CHARCOAL BRIQUETS & DESIGN (TMA335,006), KINGSFORD (TMA195,651), KINGSFORD & DESIGN (TMA196,359) and KINGSFORD (TMA386,771). The particulars for each of the Opponent’s registered trade-marks are set out in the table below.

Trade-mark	Registration Number	Goods
KINGSFORD	TMA344,604	barbecue sauce
	TMA335,006	charcoal briquets
KINGSFORD	TMA195,651	charcoal, charcoal lighters, refractory material for lining barbecues, wood chips for smoking and flavoring foods
	TMA196,359	charcoal, charcoal lighters, refractory material for lining barbecues, wood chips for smoking and flavoring foods
KINGSFORD	TMA386,771	barbecue grills

[3] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* dated October 8, 2014. On March 9, 2015, the Opponent opposed it under section 38 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), by way of filing a statement of opposition. The grounds of opposition are based upon sections 30(i), 12(1)(d), 16(3)(a), 16(3)(c) and 2 (distinctiveness) of the Act. Each of the grounds is in part based upon an allegation that there is a likelihood of confusion between the Opponent's registered trade-marks and the Mark.

[4] The Applicant filed a counter statement on May 20, 2015.

[5] Only the Opponent elected to file evidence. Its evidence consists of the affidavit of Christine Miroslavich, sworn September 21, 2015. Ms. Miroslavich was not cross-examined.

[6] Neither party filed written arguments.

[7] Both parties attended a hearing on July 6, 2017.

[8] For reasons to follow, the opposition is successful.

ONUS

[9] 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

MATERIAL DATES

[10] The material dates that apply to the grounds of opposition are:

- sections 38(2)(a)/30(i) - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(3)(a)/16(3)(c) – the filing date of the application [section 16(3) of the Act]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

EVIDENCE

[11] The evidence in this case consists solely of the Miroslavich affidavit. Ms. Miroslavich is a law clerk employed by the agent for the Opponent. She conducted a search of the Canadian trade-marks database on September 21, 2015 to obtain the particulars for the registrations relied

upon by the Opponent in the statement of opposition. The particulars are attached as Exhibit “A” to Ms. Miroslavich’s affidavit.

[12] I note that in addition to providing the particulars for the registrations relied upon in the statement of opposition, Ms. Miroslavich included the particulars for an application (no. 1,666,106) and two other registrations (TMA810,844 and TMA767,620) owned by the Opponent. I do not consider the particulars for these additional registrations and the additional application to be of any assistance to the Opponent. It has not relied upon them in its pleadings, nor has it filed any evidence (i.e. evidence of use and/or reputation) to suggest that they should be taken into account as a relevant surrounding circumstance in this case.

[13] I further note that at the start of the hearing, the Applicant pointed out that the spelling of the Opponent’s name in the statement of opposition (The Kingsford Product Company LLC) differs slightly from that which appears in the Opponent’s registrations, attached as Exhibit “A” to Ms. Miroslavich’s affidavit (The Kingsford Products Company, LLC). The Opponent confirmed that there is a typographical error in the statement of opposition and that the correct spelling for the Opponent’s name is as it appears in its registrations. The Opponent therefore requested that the decision be issued in the correct name. In view of the Opponent’s submissions, and since the Applicant confirmed at the hearing that it has no issue with the Opponent’s request, this decision is being issued in the correct name of the Opponent (The Kingsford Products Company, LLC).

ANALYSIS OF GROUNDS OF OPPOSITION

Sections 30(i), 16(3)(a), 16(3)(c) and 2

[14] The Opponent has failed to meet its evidential burden in respect of the grounds of opposition based upon sections 30(i), 16(3)(a), 16(3)(c) and 2 of the Act.

[15] With respect to section 30(i), the application contains a statement that the Applicant is satisfied that it is entitled to use the Mark, as required by section 30(i) of the Act. It has been held that where an applicant has provided the required statement, a ground of opposition based upon this section should only succeed in exceptional cases [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no evidence that this is an exceptional case.

The Opponent has therefore not met its evidential burden in respect of the section 30(i) ground of opposition.

[16] With respect to sections 16(3)(a) and 16(3)(c), the Opponent was required to file sufficient evidence to show that one or more of its trade-marks/trade-name was used in Canada (within the meaning of section 4 of the Act) prior to the filing date of the application for the Mark and had not been abandoned at the date of advertisement. No such evidence has been filed. Accordingly, the Opponent has not met its evidential burden in relation to the sections 16(3)(a) and 16(3)(c) grounds of opposition.

[17] With respect to section 2 (distinctiveness), the Opponent was required to show that as of March 9, 2015, one or more of its trade-marks/trade-name had substantial, significant or sufficient reputation in Canada to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 1981 CanLII 2834 (FC), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC)]. The Opponent has failed to file any evidence to establish reputation. The Opponent has therefore not met its evidential burden in relation to the section 2 ground of opposition.

[18] In view of the foregoing, the grounds of opposition based upon sections 30(i), 16(3)(a), 16(3)(c) and 2 of the Act are all rejected.

Section 12(1)(d)

[19] An opponent's initial evidential burden is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon in the statement of opposition is in good standing as of the date of the decision. The Registrar has discretion to check the register in order to confirm the existence of a registration relied upon by an opponent [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised the Registrar's discretion and confirm that the Opponent's registration Nos. TMA344,604, TMA335,006, TMA195,651, TMA196,359 and TMA386,771 are all extant. The Opponent has therefore met its initial evidential burden in respect of this ground. Accordingly, I must go on to determine whether the Applicant has met the legal onus upon it to establish that there is no likelihood of confusion between the parties' trade-marks.

Test for Confusion

[20] 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 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.

[21] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 each has 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. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)]. Finally, the test under section 6(2) of the Act does not concern confusion of the marks themselves, but confusion of the goods or services from one source as being from another source.

[22] I consider the Opponent's case to be strongest when comparing the Mark with its KINGSFORD trade-mark which is the subject of registration Nos. TMA344,604, TMA195,651 and TMA386,771, as its other trade-marks contain a design element and therefore resemble the Mark to a lesser extent. I will therefore focus my confusion analysis on that particular trade-mark.

Consideration of Section 6(5) Factors

Inherent Distinctiveness and the Extent to which the Trade-marks have Become Known

[23] At the hearing, both parties acknowledged that the word KING is an ordinary dictionary term, which may be used in reference to royalty, dominance or pre-eminence. The Opponent pointed out that FORD is also an ordinary dictionary term, used to refer to a shallow place where a river or stream may be crossed. These definitions are consistent with those provided in the Canadian Oxford Dictionary 2nd edition [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65

(CanLII) at para 29, which provides that the Registrar can take judicial notice of dictionary definitions]. At the hearing, the Applicant pointed out that FORD may also have some significance as a surname.

[24] Although the word KING is an ordinary dictionary term, there is no evidence that it has any significance in relation to the Applicant's goods. Likewise, there is no evidence to suggest that KINGSFORD, in whole or in part, has any meaning or significance in relation to the Opponent's goods. Accordingly, despite the fact that they are both composed of ordinary dictionary terms, I still find the parties' marks to be somewhat inherently distinctive.

[25] Insofar as acquired distinctiveness is concerned, I note that the Mark is a proposed use mark and there is no evidence that it has acquired any distinctiveness. Likewise, although its trade-marks have been registered for quite some time, there is no evidence that the Opponent has acquired any reputation in them.

[26] I therefore find that the first factor in section 6(5), which involves an assessment of both the inherent and acquired distinctiveness of the parties' marks, does not favour either party.

Length of Time the Marks have been in Use

[27] I do not find that this factor significantly favours either party in this case. Neither party has filed any evidence of use, and when an opponent files only copies (certified or otherwise) of its registration(s), the Registrar will assume only *de minimus* use of its trade-mark(s) [*Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

The Nature of the Parties' Goods, Services or Business and Trades

[28] It is the Applicant's statement of goods as defined in its application versus the Opponent's registered goods that governs my determination of these factors [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[29] The Opponent's registrations cover a range of barbecue related goods, including barbecue sauce (TMA344,604), charcoal, charcoal lighters, refractory material for lining barbecues, wood chips for smoking and flavoring foods (TMA195,651) and barbecue grills (TMA386,771). The application for the Mark is for "butane", which is essentially a type of fuel. The application for the Mark contains no restrictions or limitations with respect to the application or industry of use for the Applicant's "butane". Without any such restrictions or limitations, I am unable to conclude that there would not be a relationship between the parties' goods or any overlap in their respective channels of trade. The Applicant's "butane" may well also relate to barbecues and be sold to the same consumers.

Degree of Resemblance

[30] In *Masterpiece* [supra] the Supreme Court of Canada considered the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5) 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...

[31] In *Masterpiece*, the Court also advised that the preferable approach to considering resemblance "is to first consider whether there is an aspect of the trade-mark that is particularly striking and unique" (para 64). However, the Court acknowledged that in some cases, the first word or syllable of a trade-mark will still be the more important, for the purpose of distinctiveness [*Masterpiece*, supra at paras 64-66; and *Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)]. In my view, this is true in the case at hand.

[32] The Mark simply consists of the word KING, which is an ordinary dictionary term. Likewise, the Opponent's trade-mark KINGSFORD is also formed of a combination of ordinary dictionary terms. As previously discussed, there is no evidence that either party's mark has any significance or meaning in relation to the parties' goods. There is also no evidentiary basis for me to conclude that the FORD part of the Opponent's trade-mark is any more inherently distinctive than the first part of its mark, namely KINGS. Thus, I do not agree with the

Applicant's contention that FORD would detract from KINGS in the Opponent's trade-mark so as to reduce its distinctiveness to a significant extent.

[33] Given that the whole of the Mark is incorporated into the Opponent's trade-mark and it appears in the dominant first position of both parties' marks, there are some visual and phonetic similarities between the parties' trade-marks. To the extent that KING in the Mark and in the Opponent's trade-mark may be perceived in a similar manner, the marks may also be said to bear some similarity to one another in terms of connotation. In view of the foregoing, I find there to be a fair degree of resemblance between the parties' marks.

Conclusion Regarding Likelihood of Confusion

[34] Section 6(2) of the Act does not concern confusion of the marks themselves, but confusion of goods and services from one source as being from another source. The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark in association with the goods and/or services at a time when he or she has no more than an imperfect recollection of the Opponent's trade-mark and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23 (CanLII) at para 20].

[35] In the present case, I am not satisfied that the Applicant has met its legal onus of demonstrating that there is no reasonable likelihood of confusion between the parties' marks, on a balance of probabilities. There is no evidence before me to suggest that either party's mark possesses a higher degree of inherent or acquired distinctiveness than the other and no evidence of use has been filed by either party. While the parties' goods are not identical, they could well be related and/or sold through the same channels of trade. This is because there are no restrictions or limitations in the statement of goods in the application for the Mark and no evidence has been filed to establish that the Applicant's "butane" does not have barbecue related applications. In view of this, and since there is a fair degree of resemblance between the marks in question, I am unable to conclude that the Applicant has met its burden in this case. It is not up to the Opponent to establish that there is a likelihood of confusion. Rather, it is up to the Applicant to establish that there is not (on a balance of probabilities). It has not succeeded in doing so.

[36] The ground of opposition based upon section 12(1)(d) of the Act is therefore successful.

DISPOSITION

[37] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2017-07-06

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