



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

Citation: 2015 TMOB 89
Date of Decision: 2015-05-26

**IN THE MATTER OF AN OPPOSITION
by 3120490 Canada Inc. to application
No. 1,546,785 for the trade-mark OINK
OINK in the name of Murray Sales Inc.**

[1] 3120490 Canada Inc. (the Opponent) opposes registration of the trade-mark OINK OINK (the Mark) that is the subject of application No. 1,546,785 by Murray Sales Inc. (the Applicant). Filed on October 6, 2011, the application is based on use of the Mark in Canada in association with “kitchen spatulas, whisks, mixing spoons, slotted spoons, tongs, strainers, bag clips, pans, timers” since July 1, 2011.

[2] The Opponent alleges that: (i) the application does not comply with the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to registration of the Mark under section 16(1) of the Act; and (iv) the Mark is not distinctive under section 2 of the Act.

[3] For the reasons that follow, I refuse the application.

The Record

[4] The Opponent filed its statement of opposition on March 4, 2013. The Applicant then filed and served its counter statement on May 7, 2013 denying all of the grounds of opposition.

[5] In support of its opposition, the Opponent filed certified copies of registration Nos. TMA406,686 and TMA379,916, particulars of which are reproduced in Schedule “A” to this decision.

[6] In support of its application, the Applicant filed the statutory declaration of Joe Bonanno, controller of the Applicant. Mr. Bonanno was not cross-examined.

[7] Neither party filed a written argument. Both parties were represented at an oral hearing.

The Parties’ Respective Burden or Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Does the application conform to the requirements of section 30 of the Act?

[9] In its statement of opposition, the Opponent alleges that:

1. the Applicant, or its predecessor in title, did not use the Mark, in Canada, in association with each of the goods described in the application since the alleged date of first use, namely July 1, 2011, or at any relevant time or, alternatively, has abandoned same by way of non-continuous use prior to the filing of the application, contrary to section 30(b) of the Act; and
2. the Applicant could not and cannot still be satisfied that it is entitled to use the Mark in Canada in association with the goods described in the application since, at the date of filing of the application, the Applicant was well aware of the existence of the Opponent’s trade-marks and its continuous use thereof, contrary to section 30(i) of the Act.

[10] The material date for considering the circumstances with respect to the grounds of opposition based upon non-compliance with section 30 is the filing date of the application,

namely October 6, 2011 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

Section 30(b) Ground

[11] With respect to the section 30(b) ground of opposition, an opponent's initial burden can be met by reference not only to its own evidence but also that of the applicant's [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. In the present case, the Opponent did not file any evidence in support of the section 30(b) ground of opposition. Instead, the Opponent submits that since the claimed date of first use is a statutory holiday, it casts doubt on the veracity of the Applicant's claim.

[12] As pointed out by the Opponent during the oral hearing, it has been held in previous Board decisions that the reference to a date of first use of a trade-mark that corresponds to a statutory holiday raises doubt as to the veracity of the claim, especially when there is no evidence of use of the Mark on that date [see *Mexx International BV v Poulin* (2004), 35 CPR (4th) 241 (TMOB), *Nerds On-Site Inc v Iverson* (2006), 57 CPR (4th) 139 (TMOB) and *XS Energy LLC v Petrillo* (2007), 66 CPR (4th) 43 (TMOB)].

[13] In the present case, I am prepared to take judicial notice that the claimed date of first use, namely July 1st, 2011, was a statutory holiday in Canada. Consequently, I am satisfied that the Opponent has discharged its initial burden with respect to the section 30(b) ground of opposition. The Applicant must therefore establish the use of the Mark since July 1, 2011 in association with the applied for goods.

[14] In considering the Applicant's evidence, I disregard any opinions of Mr. Bonanno that go to the questions of fact and law to be determined by the Registrar in this proceeding. This includes Mr. Bonanno's statements to the effect that the subject application conforms to section 30 of the Act and that the Mark "actually distinguishes and is adapted to distinguish the wares of the Applicant from the wares of others".

[15] In terms of use, Mr. Bonanno asserts that "the Applicant's stated date of first use in Canada of the subject trade-mark is true" and that "the subject trade-mark has been used as a

trade-mark from the stated date of first use”. However, no documentary evidence was provided to corroborate Mr. Bonanno’s bald statements. It is well established that mere assertions of use are not sufficient to demonstrate use within the meaning of section 4 of the Act [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. As pointed out by the Opponent, Mr. Bonanno’s statutory declaration does not provide any information regarding the “stated date of first use”, the manner in which the Mark was used on the applied for goods as of July 1, 2011, nor does it provide any evidence of sale of the applied for goods in association with Mark as of July 1, 2011.

[16] The only clear assertion made by Mr. Bonanno in his statutory declaration regarding the sale of the applied for goods pertains to the fact that he has conducted sales of “different kitchen utensils” for the Applicant. Even so, there is no information with respect to the type of kitchen utensils sold, the manner in which the Mark was associated with these kitchen utensils, nor when or where these sales would have occurred.

[17] Attached as “Schedule A” to Mr. Bonanno’s statutory declaration are copies of photos showing various kitchen utensils in their packaging bearing the Mark including kitchen spatulas, mixing spoons, a slotted spoon, tongs, a sink strainer, bag clips, and a frying pan. In this regard, Mr. Bonanno makes the following statements in his statutory declaration:

7. There are reasonable grounds for believing that:
 - (a) The product packaging and copies of pages of the catalogue establish clearly the distinctive features and usage of the wares of the Applicant from the wares of the Opponent.
 - (b) These copies of product packaging and copies of catalogue pages of the Applicant’s wares support the attached trade-mark and prove evidently their differences from the Opponent’s wares.

[18] I note that the exhibits are not notarized. Moreover, there is no information with respect to the time when these kitchen utensils would have been sold in the manner presented in the exhibits.

[19] Setting aside issues with Mr. Bonanno’s statement that “there are reasonable grounds for believing” that the exhibits establish the distinctive features of the Applicant’s products, the statutory declaration simply does not allow me to draw any meaningful conclusion regarding the

Applicant's use of the Mark in association with any of the applied for goods at the claimed date of first use.

[20] When the Applicant's evidence is viewed in its entirety, I am not satisfied that it has discharged its onus to establish use of the Mark in association with any of the applied for goods, within the meaning of section 4(1) of the Act, as of July 1, 2011.

[21] In view of the foregoing, the section 30(b) ground of opposition is successful.

Section 30(i) Ground

[22] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[23] The Opponent did not provide nor refer to any evidence in support of its section 30(i) ground of opposition. Moreover, the mere fact that an applicant might have been aware of an opponent's allegedly confusing trade-marks would not by itself have been sufficient. Consequently, I dismiss the section 30(i) ground of opposition in view of the Opponent's failure to meet its initial burden.

Is the Mark Confusing with the Opponent's Registered Trade-marks?

[24] In its statement of opposition, the Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act, on the ground that it is confusing with the Opponent's registered trade-marks, OINK OINK (TMA406,686) and OINK OINK & Design (TMA379,916), particulars of which are set out in Schedule "A" to this decision.

[25] The material date for considering this issue, which arises from the section 12(1)(d) ground of opposition, is 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)].

[26] Having exercised the Registrar's discretion to check the Register, I confirm that both of the Opponent's alleged registrations are in good standing. The Opponent has therefore met its initial evidential burden in relation to this ground of opposition.

[27] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's registered trade-marks.

[28] For reasons that follow, the section 12(1)(d) ground of opposition is successful.

The test for confusion

[29] 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.

[30] 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. [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 a thorough discussion of the general principles that govern the test for confusion.]

[31] I will focus my analysis on the likelihood of confusion between the Mark and the Opponent's word mark OINK OINK of registration No. TMA406,686 as I consider this to be the Opponent's strongest case.

[32] I will now turn to the assessment of the section 6(5) factors.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[33] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks.

[34] Both parties' marks possess a high degree of inherent distinctiveness as they are neither descriptive nor suggestive of their respective goods and services. In this regard, the *Canadian Oxford Dictionary* defines the term "oink" as "the grunt of a pig or a sound resembling this".

[35] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. The Opponent did not provide any evidence of promotion or use of its trade-mark in Canada. Similarly, as per my earlier discussion of Mr. Bonanno's statutory declaration, I am unable to draw any meaningful conclusion regarding the use or promotion of the Mark with any of the applied for goods by the Applicant given the lack of information regarding the manner and the extent of such use or promotion in Canada.

[36] Accordingly, the section 6(5)(a) factor does not favour either party.

Section 6(5)(b) – the length of time the trade-marks have been in use

[37] The application for the Mark is based upon use in Canada since July 1, 2011. However, as discussed in more detail above, I am unable to draw any meaningful conclusion regarding the use of the Mark with any of the applied for goods by the Applicant thus far. In comparison, the Opponent has provided a certified copy of its registration. However, this only enables the Registrar to assume *de minimus use* [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[38] Accordingly, this factor does not significantly favour either party.

Sections 6(5)(c) and (d) – the nature of the goods, services, trade and business

[39] The sections 6(5)(c) and (d) factors, which involve the nature of the goods, services, trade and business of the parties, favour the Opponent.

[40] When considering sections 6(5)(c) and 6(5)(d) of the Act, it is the statement of goods as defined in the application for the Mark and the statements of goods and services in the Opponent's registration No. TMA406,686 that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [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)].

[41] Furthermore, the statements of goods and services 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. In this regard, evidence of the actual trades of the parties is useful [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)]. In the present case however, I have no evidence of the actual trade engaged in by either the Opponent or the Applicant.

[42] The Mark is applied for use in association with various cooking utensils and kitchen accessories. In comparison, the Opponent's trade-mark OINK OINK is registered for use in association with children's clothing, footwear, toys and fashion accessories, as well as furniture for kids, and the retail sale thereof. It is also registered for use in association with books, greeting cards, stickers, carrying bags including lunch boxes, children's gift items including bedding, picture frames, clothes hangers, as well as light switch plates, and the retail sale thereof.

[43] During the oral hearing, the Applicant submitted that the Opponent's registration does not cover any of the applied for goods, nor does it pertain to kitchen items. Thus, the Applicant takes the position that the nature of the parties' goods and services are different, and presumably the channels of trade as well. In contrast, the Opponent submitted that both parties' goods are

common household goods that could be sold in any general stores, including big-box stores. Thus, both parties' goods are related and there is a potential for overlap in the channels of trade.

[44] While there is little connection between children's apparel, toys, and the applied for goods, the Opponent's statement of goods nevertheless includes lunch boxes which, as in the case of the Applicant's cooking utensils and kitchen accessories, are all household items that are related to food storage and food preparation. Moreover, the Opponent's statement of goods also contains other general household items that could be sold via the same channels of trade as the Applicant's cooking utensils and kitchen accessories. As neither the Opponent's registration nor the subject application contains any restriction on the channels of trade, in the absence of evidence from the parties and given that the parties' goods and services are related, for the purpose of assessing confusion, I conclude that there is also potential for overlap between the parties' channels of trade.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[45] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality.

[46] The parties' trade-marks are identical in appearance, sound and in ideas suggested. As discussed in the section 6(5)(a) analysis, both parties' marks suggest the grunt of a pig or a sound resembling it.

[47] Accordingly, this factor significantly favours the Opponent.

Conclusion in the likelihood of confusion

[48] In *Masterpiece*, the Supreme Court of Canada noted that the degree of resemblance is the statutory factor that is often likely to have the greatest effect on the confusion analysis. In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances including the parties' identical trade-marks, the connection between the parties' respective goods and services, and the potential for overlap in the channels of trade, I am not satisfied that the Applicant has discharged

its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the two parties' trade-marks OINK OINK.

Remaining Grounds of Opposition


[49] Since I have already refused the application under two grounds, I do not consider it necessary to address the remaining grounds of opposition.

Disposition

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

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule “A”

Opponent’s Registered Trade-mark	Reg. No.	Goods and Services
OINK OINK	TMA406,686	<p>Goods:</p> <p>(1) Children's clothing, namely t-shirts, sweatshirts, blouses, shirts, sweaters, pants, skirts, dresses, shorts, snowsuits, underwear, pyjamas, jumpsuits, jumpers, jogging sets, jackets, coats, bathing suits; children's toys, namely educational games, preschool toys, puzzles, plush animals, puppets, balls, tops, dolls, society games, arts and crafts, musical instruments, bicycles, and trains; books; all occasion greeting cards; printed decals for t-shirts; stickers; children's fashion accessories namely pins, bracelets, necklaces, earrings, scarves, mittens, gloves, caps, hats, ear muffs, hair bows, clips and barrettes; children's footwear, namely shoes, boots, sandals, slippers and running shoes; carry bags, namely knapsacks, purses, school bags, wallets, carrying cases and lunch boxes; children's gift items, namely decorative pillows, pot pourri, decorative sheets, musical boxes and figurines, decorative picture frames, decorative clothes hangers, decorative light switch plates; children's wicker furniture namely rocking chairs, baskets, sofas and tables.</p> <p>Services:</p> <p>(1) Operation of retail outlets specializing in the sale of the aforesaid wares.</p>
	TMA379,916	<p>Goods:</p> <p>(1) Children's clothing, namely t-shirts, sweatshirts, blouses, shirts, sweaters, pants, skirts, dresses, shorts, snowsuits, underwear, pyjamas, jumpsuits, jumpers, jogging sets, jackets, coats, bathing suits; children's variety toys and games, namely, plush animals, puppets, balls, tops, dolls, bicycles, and trains; all occasion greeting cards; printed decals for t-shirts; stickers; children's fashion accessories namely pins, bracelets, necklaces, earrings, scarves, mittens, gloves, caps, hats, ear muffs, hair bows, clips and barrettes; children's footwear, namely shoes, boots, sandals, slippers and running shoes; carry bags, namely</p>

Opponent's Registered Trade-mark	Reg. No.	Goods and Services
		<p>knapsacks, purses, school bags, wallets, carrying cases and lunch boxes; children's gift items, namey decorative pillows, roomscents in the form of potpourri, decorative sheets, musical boxes and figurines, decorative picture frames, decorative clothes hangers, decorative light switch plates; children's wicker furniture namely, rocking chairs, chairs, baskets, tables and sofas.</p> <p>Services: (1) Operation of retail outlets specializing in the sale of the aforesaid wares.</p>