

IN THE MATTER OF AN OPPOSITION
by McPherson's Limited, Regent Sheffield Ltd. &
Wiltshire Canada Inc. to an application to extend
the statement of wares of registration No. 455,666
(application No. 716,716) for the trade-mark SURE
GRIP filed by General Electric Company _____

Registration No. 455,666 for the trade-mark SURE GRIP issued to General Electric Company on March 22, 1996. The registration covers "Handles for use in major appliances, namely refrigerators".

On April 12, 1996, General Electric Company filed an application to extend the statement of wares in its registration to include "Handles for ranges". The application was based on use of the mark since April 1, 1996. The extension application was advertised for opposition purposes on July 31, 1996.

The opponents, McPherson's Limited, Regent Sheffield Ltd. and Wiltshire Canada Inc., filed a statement of opposition on December 15, 1997, a copy of which was forwarded to the applicant on February 2, 1998. The opponents were granted leave to amend their statement of opposition on December 13, 1999.

The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereinafter the *Act*) because the applicant did not use the applied for trade-mark with the applied for wares since the date claimed. The second ground is that the applicant's application does not conform to the requirements of Section 30(i) of the *Act* because the applicant could not have been satisfied that it was entitled to use the applied for trade-mark having regard to McPherson's Limited's previously applied for trade-mark TRUE GRIP, No. 770,141. The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1)(b) of the *Act* because, as of the applicant's alleged date of first use, the applied for trade-mark was confusing with the applied for mark TRUE GRIP, which had been applied for on December 1, 1994, under No. 770,141.

The fourth ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the *Act* because it is confusing with McPherson's Limited's registered trade-mark TRUE GRIP, Registration No. 512,536. The fifth ground is that the applied for trade-mark is not distinctive in that it does not distinguish, nor is adapted to distinguish, the wares of the applicant from those of others including the opponents, in light of, *inter alia*, McPherson's Limited's trade-mark TRUE GRIP.

The applicant filed and served a counter statement. Neither party filed any evidence. Both parties filed a written argument and no oral hearing was conducted.

As for the first ground of opposition, although the legal burden is on the applicant to show its compliance with Section 30(b) of the *Act*, there is an initial evidential burden on the opponents to evidence their supporting allegations of fact. As the opponents did not file any evidence, this first ground of opposition is unsuccessful.

The second ground does not raise a proper ground of opposition in that the opponents did not allege that the applicant was aware that its applied for mark was confusing with McPherson's Limited's trade-mark. Thus, the second ground is also unsuccessful.

With respect to the fourth ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decisions in Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.) and Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Further, in applying the test for confusion set forth in Section 6(2) of the *Act*, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the *Act*.

While the opponents have not filed a copy of McPherson's Limited's trade-mark registration

as evidence in this opposition, the Registrar, having regard to the potential public interest in having such a ground of opposition raised, will exercise his discretion to check the register in order to confirm that the mark is still on the register (see Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltee v. Menu Foods Ltd. (1986), 11 C.P.R. (3d) 410 at 411-412). In this regard, the TRUE GRIP registration relied upon by the opponents is presently on the register and covers “housewares, namely knives, cutlery and barbecue utensils”.

As for Section 6(5)(a) of the *Act*, neither the applicant’s nor McPherson’s Limited’s mark is inherently strong because both marks include the word GRIP which, in relation to the wares, suggests something that is handled. As neither party evidenced any reputation for their marks, the extent to which the trade-marks have become known does not favour either party.

The length of time the marks have been in use does not favour either party as there is no evidence of use for either party’s mark. As for Sections 6(5)(c) and 6(5)(d) of the *Act*, the applicant’s wares “handles for ranges” are different from McPherson’s Limited’s “housewares, namely knives, cutlery and barbecue utensils”. The applicant has submitted that the parties’ wares are sold through entirely different channels of trade. In this regard, the applicant submits that major appliances such as refrigerators and ranges are sold through major appliance dealers’ stores while the knives, cutlery and barbecue utensils of McPherson’s Limited would be sold in kitchen-ware and hardware shops. Although the applicant’s statement of wares is not restricted to major appliance dealers’ stores, I agree with the applicant that “handles for ranges” are not the type of item that would likely be sold in the same type of store as knives, cutlery and barbecue utensils. Thus, in my view, the parties’ channels of trade would not likely overlap.

As for Section 6(5)(e) of the *Act*, there is some resemblance between the marks in that both marks end with the component GRIP and suggest that the user will have a good grip or handhold. The first components of the marks (which are generally the most important for purposes of distinction) are different, however, in both appearance and sound.

As a further surrounding circumstance, the applicant, in its written argument, provides a list

of what it submits are examples of trade-mark registrations which include the word “GRIP” for a variety of wares. However, the applicant has not provided as evidence copies of the registration pages for the registrations identified in the list. Given that there is no evidence as to the ownership of the marks identified in the list, the basis upon which the registrations were obtained, or the identity of the wares covered by the registrations, this list is of little value to the outcome of this proceeding.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the low degree of resemblance in appearance and sound between the marks at issue, and the differences in the nature of the parties’ wares and channels of trade, I consider that the applicant has satisfied the onus on it to show that its mark is not confusing, or likely to be confused, with McPherson’s Limited’s registered mark. Thus, the fourth ground of opposition is also unsuccessful.

As for the third ground of opposition, I have also exercised my discretion to check the Registrar’s records in order to confirm the existence of the McPherson’s Limited’s previously filed application No. 770,141 for the mark TRUE GRIP (see Royal Appliance Mfg. Co. v. Iona Appliances Inc. (1990), 32 C.P.R. (3d) 525). The opponents have met their initial burden in that McPherson’s Limited’s trade-mark application No. 770,141 was filed before the applicant’s application for an extension of the statement of wares. Further, in accordance with s.16(4) of the *Act*, McPherson’s Limited’s application was pending as of the applicant’s advertisement date, the opponent’s application not having proceeded to registration until June 22, 1999.

This ground of opposition also turns on the determination of the issue of the likelihood of confusion between the applicant’s SURE GRIP mark and the opponent’s TRUE GRIP mark, although the material date for assessing the likelihood of confusion in respect of this ground is the applicant’s date of first use (*i.e.* April 1, 1996). In my view, the differences in material dates does not have a significant impact on the determination of the issue of confusion between the applied for trade-mark and McPherson’s Limited’s trade-mark. Thus, my findings above that the trade-marks at issue are not confusing, or likely to be confused, likewise applies to this ground of opposition.

As for the fifth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Further, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (*i.e.* - December 15, 1997): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponents to prove the allegations of fact in support of their ground of non-distinctiveness.

It was incumbent on the opponents to at least evidence some reputation in Canada for McPherson's Limited's mark as of or prior to the material time. Since the opponents failed to file evidence on point, the fifth ground is also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the *Act*, I reject the opponents' opposition.

DATED AT HULL, QUEBEC, THIS 31st DAY OF January, 2001.

C.R. Folz,
Member,
Trade Marks Opposition Board.