

Editor's Note: Erratum released on April 28, 2010. Original judgment has been corrected with text of erratum appended.

Citation: 2010 TMOB 029

**IN THE MATTER OF AN OPPOSITION
by Onward Multi-Corp. Inc. to application
No. 1,112,366 for the trade-mark
BROILMASTER filed by Empire Comfort
Systems, Inc.**

[1] On August 10, 2001, Martin Industries, Inc. (Martin Industries) filed an application to register the trade-mark BROILMASTER (the Mark) in association with "gas barbecue grills" based on use in Canada since at least as early as January 1996. The Canadian Intellectual Property Office (CIPO) recorded, on February 20, 2002, an assignment of the application to Empire Comfort Systems, Inc. (the Applicant) dated November 29, 2001.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 18, 2002.

[3] On January 31, 2003, Onward Multi-Corp. Inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- i) the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) as at the alleged date of first use or made known of the Mark or at the date of filing of the application, it was confusing with the Opponent's trade-marks BROIL KING (registration No. TMA257,283) and BROIL QUEEN (registration No. TMA257,282) previously used or made known in Canada by the Opponent and its predecessors in title in association with gas barbecues, or for which applications for registration had been previously filed by the Opponent;
- ii) the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1) of the Act as at the alleged date of first use or made known of the Mark or at the date of filing of the application, it was confusing with the Opponent's

trade-mark BROIL-MATE (registration No. TMA332,350), previously used or made known in Canada by the Opponent and its predecessors in title in association with gas barbecues, replacement parts for barbecues and implements used with barbecues, or for which an application for registration had been previously filed by the Opponent;

- iii) the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(5) of the Act as at the date of advertisement of the application, it was confusing with the Opponent's trade-marks BROIL KING, BROIL QUEEN, and BROIL-MATE previously used or made known in Canada by the Opponent and its predecessors in title in association with the barbecue wares described above, and which were not abandoned;
- iv) the Mark is not distinctive because it does not distinguish and was not adapted to distinguish the Applicant's wares from those of others, due to the use in Canada by the Opponent and its predecessors in title of the trade-marks BROIL KING, BROIL QUEEN and BROIL-MATE;
- v) the application does not conform with the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because the Applicant must have been aware of the Opponent's prior use of the trade-marks BROIL KING, BROIL QUEEN and BROIL-MATE and of the fact that the use of the Mark would likely lead to confusion;
- vi) the Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the Opponent's registered trade-marks BROIL KING (No. TMA257,283), BROIL QUEEN (No. TMA257,282) and BROIL-MATE (No. TMA332,350);
- vii) alternatively, the Opponent states that the trade-marks represent a series of associated marks in relation to barbecues and the Mark is confusing with the series of marks of the Opponent.

[4] The Applicant filed and served a counter statement on September 12, 2003 in which it denied the Opponent's allegations.

[5] The Opponent's evidence pursuant to Rule 41 of the *Trade-marks Regulations* (the Regulations) consists of the affidavit of Theodore A. Witzel sworn on January 12, 2004, with Exhibits A through D (the first Witzel affidavit). Mr. Witzel was cross-examined by the Applicant. The cross-examination transcript and replies to undertakings were filed on February 16, 2005 and March 1, 2005 respectively.

[6] The Applicant's evidence pursuant to Rule 42 of the Regulations includes a certified copy of the file history for US registration No. 2,344,349 for the trade-mark BROIL KING Design owned by the Opponent. The evidence also includes affidavits of John A. Hart sworn on June 29, 2005, with Exhibits A through D (the Hart affidavit), and of Deborah A. Eatherley sworn on June 21, 2005, with Exhibits 1 through 59 (the Eatherley affidavit). The Opponent had obtained an order for the cross-examinations of both affiants, but only proceeded to cross-examine Mr. Hart. The cross-examination transcript was filed on June 2, 2006. I would remark that the cross-examination was conducted on the affidavit filed in the present proceeding and on another affidavit of Mr. Hart filed in a co-pending opposition proceeding between the parties, specifically the opposition to application No. 1,166,534 for the trade-mark BROIL KING Design filed by the Opponent and opposed by the Applicant. While the two affidavits were not filed in the same context, the cross-examination transcript reflects that they were identical.

[7] The Opponent's evidence pursuant to Rule 43 of the Regulations consists of an affidavit of Theodore A. Witzel sworn on September 7, 2006, with Exhibit A (the second Witzel affidavit). Mr. Witzel was cross-examined by the Applicant. The cross-examination transcript, exhibits to the transcript and replies to undertakings were filed on November 6, 2007. The cross-examination of Mr. Witzel was conducted along with his cross-examination on a separate affidavit filed in the co-pending opposition proceeding to application No. 1,166,534 for the trade-mark BROIL KING Design.

[8] Both parties filed written arguments and were represented at an oral hearing.

MATERIAL DATES

[9] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30 – the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- s. 38(2)(b)/s. 12(1)(d) – the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(1) – the date of first use alleged in the application;
- s. 38(2)(d)/non-distinctiveness – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

ONUS

[10] The Applicant bears the legal onus of establishing, on 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 C.P.R. (3d) 293 (F.C.T.D.)].

[11] I shall review the evidence of record before analysing the grounds of opposition. I will refer to parts of the cross-examinations of Messrs. Witzel and Hart insofar as they are relevant to the evidence and the parties' arguments in the present proceeding. Further, my remarks and findings in the present decision are expressed solely on the basis of the evidence filed in the present proceeding and within the context of the case before me.

OPPONENT'S EVIDENCE IN CHIEF

The First Witzel Affidavit and Cross-Examination

[12] I am disregarding parts of the affidavit [paragraphs 6 to 11] where Mr. Witzel opines on the likelihood of confusion between the Opponent's trade-marks and the Mark as this issue is to be decided by the Registrar from the evidence filed in the present

proceeding. Likewise, I am disregarding parts of the cross-examination of Mr. Witzel on his statements on the likelihood of confusion. That being said, I note that Mr. Witzel did refuse to answer questions as to whether he was aware of any actual instances of confusion; he kept insisting that there could be, but refused to say if he knew of any [Q166-Q191].

[13] Mr. Witzel has been President of the Opponent since 1995 [Q8].

[14] The Opponent owns the registrations for the trade-marks BROIL KING (TMA257,283) and BROIL QUEEN (TMA257,282) in association with “gas barbecues”, and BROIL-MATE (TMA332,350) in association with “barbeques, replacement parts for barbeques and implements used with barbeques”. Furthermore, on January 31, 2003, the Opponent filed application No. 1,166,534 for registration of the trade-mark BROIL KING Design in association with “gas barbecues, replacement parts for barbecues and implements used with barbecues” based on use in Canada since at least as early as October 1980 [paragraphs 1 to 4].

[15] Appended as Exhibits “A” through “D” to the Witzel affidavit are printouts of the aforementioned trade-mark registrations and application, which appear to have been obtained from CIPO’s Trade-marks Database. The printouts of the registrations disclose the following information:

- both the trade-marks BROIL KING and BROIL QUEEN were registered on March 27, 1981 in the name of Jacuzzi Inc. further to the filing of a Declaration of Use on October 16, 1980. The Opponent became their owner by assignment of November 16, 1989 from Jacuzzi Inc., which was recorded by CIPO on January 25, 1991;
- the trade-mark BROIL-MATE was registered on September 25, 1987 in the name of B.D. Wait Co. Limited on the basis of use in Canada since August 1985. Anova Inc. was recorded as owner of the registration by CIPO on December 23, 1988 following a merger of October 8, 1987. The Opponent

became the owner of the registration by assignment of January 29, 1990 from Anova Inc., which was recorded by CIPO on March 8, 1996.

[16] Mr. Witzel testifies in cross-examination that the Opponent is in the business of injection-moulding, as well as the manufacture, import and export of barbecues and its components. The Opponent also has two retail stores under the name “T A Appliances” in which barbecues, fireplaces, and household appliances, which Mr. Witzel defines as “white goods”, namely refrigerators, ranges, dishwashers, washers and dryers are sold [Q17, Q22-Q27]. In terms of the normal course of trade, the barbecues are sold to retailers across Canada, such as Home Hardware, Home Depot, Reno Depot, as well as directly to consumers through the Opponent’s stores; others are exported to different countries, including the United States [Q35-Q41]. The Opponent’s barbecues are priced between two hundred to a thousand dollars, with certain models exceeding that price; they could last between five to fifteen years [Q275-Q277].

[17] Mr. Witzel indicates that the Opponent has spent more than ten million dollars in advertising the trade-marks BROIL KING, BROIL-MATE and BROIL KING Design since it acquired the trade-marks [paragraph 5]. The advertisement expenditures include expenditures for the advertisement of the Opponent’s retail stores, such as the advertisement in the July 16, 2004 issue of the newspaper *The Record* appended as Exhibit 1 to the transcript [Q165]. I would remark that two barbecues are among the products that can be seen in the ad.

[18] In terms of sales, Mr. Witzel indicates that the Opponent has sold over two million gas barbecues in Canada under the trade-marks BROIL KING and BROIL-MATE [paragraph 5]. In cross-examination, Mr. Witzel testifies that the figures provided in his affidavit are “a quick estimate” [Q154]. While Mr. Witzel further testifies that more than half of the gas barbecues sold in Canada were associated with the trade-mark BROIL KING [Q155], he does not testify that the remaining barbecues sold were associated with the trade-mark BROIL-MATE. From Mr. Witzel’s cross-examination, it would appear that the Opponent does not detail the average annual sales of gas barbecues

associated with each of the trade-marks BROIL KING, BROIL QUEEN and BROIL-MATE because the Opponent is concerned that these could be of assistance to its competitors [Q158-Q159].

[19] In reference to the trade-marks BROIL KING and BROIL QUEEN, Mr. Witzel testifies in cross-examination that the Opponent purchased the business, including the trade-marks, from Jacuzzi Inc. in 1986 even though the transfer documents indicate 1989 [Q3-Q4]. Copy of an “Agreement dated December 12, 1986” was provided as part of the replies to undertakings. I note that the said agreement is an “Offer to Purchase” executed by the Opponent and Jacuzzi Canada, division of Kidde Canada Limited.

[20] Mr. Witzel states that the trade-mark BROIL KING “has been used continuously in Canada since the date referred to in the Declaration of Use filed on October 16, 1980” and that the trade-mark BROIL KING Design has been used in Canada since the date claimed in application No. 1,166,534 (October 1980) [paragraph 2]. From Mr. Witzel’s cross-examination, it would appear the Opponent takes the position that the agreement of 1986 with Jacuzzi Inc. included the mark BROIL KING Design, which explains the claimed date of first use [Q112-Q120]. As there is no reference to the trade-mark BROIL KING Design of application No. 1,166,534 in the statement of opposition, I agree with the Applicant that it should not be considered to determine the outcome of the present opposition proceeding. That being said, I consider that any reliable evidence of use of the trade-mark BROIL KING in a design format may serve as evidence of use of the word trade-mark BROIL KING of registration No. TMA257,283.

[21] Mr. Witzel states that the trade-mark BROIL QUEEN “had been used continuously in Canada since the date referred to in the Declaration of Use filed on October 16, 1980”, but it has not been in use recently [paragraph 4]. The Opponent has been in a “holding pattern” since the early 1990s; it uses the trade-mark “from time to time” at the requests of customers. The trade-mark BROIL QUEEN was not in use when Mr. Witzel was cross-examined [Q129-Q136].

[22] In reference to the trade-mark BROIL-MATE, Mr. Witzel testifies that the Opponent acquired the trade-mark from the receiver of B.D. Wait around 1990 [Q90-Q94] and that the trade-mark has been used continuously in Canada since August 1985 [paragraph 3]. Copy of a letter dated January 31, 1990 from the receiver was provided as part of the replies to undertakings. The letter refers to an agreement of purchase and sale dated December 29, 1989.

[23] When ask about his knowledge of any competitors of the Opponent selling barbecues or barbecue accessories using the word “broil” as part of the brand name, Mr. Witzel testifies that from mid to late 1980s, while the Opponent was selling barbecues in association with the trade-marks BROIL KING and BROIL QUEEN, he was aware of the company B.D. Wait selling barbecues with the trade-marks BROILMASTER and BROIL-MATE in Canada [Q109-Q110]. Mr. Witzel also indicates that Hunter Enterprises, which was purchased by Martin Industries, was selling barbecues in association with the mark BROILMASTER in the mid 1990s [Q64-Q75]. Mr. Witzel states that B.D. Wait and Hunter Entreprises are not in business anymore. Mr. Witzel attests that the Opponent receives calls from consumers with old BROILMASTER barbecues asking for parts, to a greater extent than parts of other brands of barbecues. He acknowledges that consumers are not asked whether they are calling the Opponent because it is in the business of supplying parts or whether they are calling thinking that the Opponent makes BROILMASTER barbecues [Q194-Q201].

[24] In cross-examination [Q215-Q260], Mr. Witzel refers to the Opponent entering into an agreement with Hudson Standard Corporation, an American company in the business of distributing household appliances under the trade-mark BROILKING. Hudson Standard Corporation is now BroilKing Corporation. As part of the agreement, a link to the Opponent’s website is set up on BroilKing Corporation’s website “www.broilking.com” to redirect customers looking for information about the Opponent’s barbecues on the Internet. However, the Opponent and BroilKing Corporation are not related companies. I have reviewed the documents filed in reply to undertakings regarding the aforementioned agreement, namely a Settlement Agreement

made on March 31, 1997 and a Trade-mark Licensing Agreement dated September 1, 1998 between the Opponent and Hudson Standard Corporation (now BroilKing Corporation). It appears that the agreement relates to the use and registration of the trade-mark BROIL KING by the Opponent for barbecues and related outdoor items and the use and registration of the trade-mark BROILKING by Hudson Standard Corporation (now BroilKing Corporation) for household items in the United States and “all foreign countries and territories”. The second Witzel affidavit provides information on the terms of the agreement, as discussed later on.

APPLICANT’S EVIDENCE

Certified Copy of the File History for US Registration No. 2,344,349

[25] At the oral hearing, I noted to the Applicant’s agent that evidence in opposition proceedings shall be submitted by way of affidavit or statutory declaration, unless it is a document or an extract in the official custody of the Registrar in accordance to s. 54 of the Act. The Applicant’s agent recognized that the certified copy was not filed by way of affidavit or statutory declaration, but went on to indicate that the Applicant would not be relying on the certified copy in the subject opposition proceeding. Thus, I find it unnecessary to decide on the admissibility of the certified copy of the file history for US registration No. 2,344,349 as evidence in the present opposition proceeding.

The Hart Affidavit and Cross-Examination

[26] Here also I am disregarding parts of the cross-examination where Mr. Hart opines on the dissimilarity between the Mark and the Opponent’s trade-marks.

[27] Mr. Hart has been the Chairman of the Applicant since 2004; prior to that, he was the Applicant’s President from 1989 to 2004 and Vice President from 1985 to 1989.

[28] Mr. Hart explains that the Applicant’s headquarters are located in Belleville, Illinois. The Applicant first started manufacturing barbecues in 1999, “with a large, high-end stainless steel grill”. These barbecues retail for around \$6,000 [Q23-Q27]. The

Applicant sells barbecues and accessories to Diversco Supply, Inc. (Diversco), its distributor in Canada, who in turn sells them to different retailers [paragraph 3].

[29] Mr. Hart states that the Applicant acquired the Mark from Martin Industries on November 30, 2001 [paragraph 4]. In cross-examination, Mr. Hart explains that the Applicant purchased “the inventory, the brand name, the tooling and other assets all related to the Broilmaster division of Martin Industries, Inc.” [Q31]. Mr. Hart states that Martin Industries’ business records, including those relating to the sales of BROILMASTER barbecues prior to 2001, are not available to the Applicant [paragraph 5]; both Martin Industries and its predecessor, Lock Stove, are bankrupt [Q40].

[30] Following the acquisition of 2001, the Applicant began selling barbecues bearing the Mark in Canada in 2003 [paragraph 6, Q50]. At paragraph 6 of his affidavit, Mr. Hart states that Canadian retail sale figures for BROILMASTER barbecues for 2003 and 2004 were “significant”, but he goes on to state: “I do not wish to disclose exact sale figures as I am concerned that this information could be of assistance to Empire’s [Applicant’s] competitors.”

[31] The following are appended as exhibits to the Hart affidavit:

- copies of sample invoices relating to the sale of BROILMASTER barbecues in 2003 and 2004 [paragraph 7, Exhibit A]. I note that the Applicant issued the invoices to Diversco. There is no reference to the Mark on the invoices. However, I consider it reasonable to accept the invoices as corroborating the sales of barbecues associated with the Mark in Canada by the Applicant, particularly since the Opponent did not cross-examine Mr. Hart on the invoices;
- sample brochures which contain photographs of barbecues bearing the Mark representative of those sold in Canada in 2003, 2004 and 2005. The brochures are available to customers at retail locations [paragraphs 8-9, Exhibit B]. I note that the Mark is clearly marked on the barbecues shown in the brochures;

- copy of a newspaper ad published in the *Leamington Post* in June 2003 [paragraph 11, Exhibit C];
- excerpts of the Applicant's website "www.broilmaster.com" [paragraph 12, Exhibit D]. I note that the excerpts, which were apparently printed out on May 30, 2005, provide a list of the BROILMASTER dealers (located in the provinces of Prince Edward Island and Ontario) and pictures of different barbecue models.

[32] In Canada, the Applicant advertises the barbecues associated with the Mark through newspaper, distribution of brochures at retail locations, and on its website [paragraphs 10 and 12]. The Applicant has tracked 5,590 hits from Canada on its website since January 2002 [paragraph 13]. In relation to advertising expenditures, Mr. Hart provides that the Applicant spent over US\$11,000 and US\$16,000 on advertising BROILMASTER barbecues for the years 2003 and 2004 respectively in Canada [paragraph 14]. Diversco has also spent nearly US\$27,000 in advertising BROILMASTER grills for the years 2003 and 2004 mainly through newspaper ads, through a co-op advertising program with the Applicant [paragraph 15, Q94]. Mr. Hart goes on to state that the Applicant spends approximately US\$125,000 each year in advertising the BROILMASTER grills in the United States, mainly through newspapers [paragraph 16]. Mr. Hart states at paragraph 17 of his affidavit that he is personally aware that Canadians have been exposed to BROILMASTER advertising through spill-over advertising from the United States to Canada. However, in cross-examination, Mr. Hart recognizes that he does not have any actual knowledge of the basis for the statement at paragraph 17 of his affidavit [Q148-Q151]. Thus, I am not affording any weight to Mr. Hart's statement about spill-over advertising in Canada.

[33] In cross-examination, Mr. Hart indicates that he saw BROILMASTER grills in B.D. Wait's factory and warehouse in 1983 [Q61-Q64]. Mr. Hart also testifies that he became aware of the Opponent's BROIL KING barbecues in 1999, when the Applicant first entered the market [Q116-Q117]. Further, Mr. Hart testifies that he became aware of the BROIL-MATE barbecues in 1983 when he visited B.D. Wait's place of business in Canada [Q118-Q119].

[34] Finally, Mr. Hart testifies that he is aware of another manufacturer of barbecues in North America, WC Bradley, selling barbecues under the brand CHAR-BROIL [Q140].

The Eatherley Affidavit

[35] Ms. Eatherley is a law clerk with the Applicant's trade-mark agent firm. She introduces into evidence information that she obtained from CIPO, from various searches conducted on the Internet, from CIPO's Trade-marks Database, and from the database of the United States Patent and Trademark Office (USPTO).

[36] Ms. Eatherley provides copies of CIPO's file histories for the Opponent's registered trade-marks BROIL QUEEN, BROIL KING and BROIL-MATE [Exhibits 1 to 3]. She also provides photocopies of CIPO's file histories of the trade-mark registrations for WAIT BROIL-MATE, WAIT BROILMASTER and BROILMASTER [Exhibits 4 to 6]. I note that these three registrations, originally owned by B.D. Wait Co. Limited, have either been cancelled pursuant to s. 41(1)(b) of the Act or expunged pursuant to s. 45 of the Act.

[37] Ms. Eatherley also files copies of pages (printed on May 31, 2005) of the website "www.broilking.com" of BroilKing Corporation [Exhibits 7 and 8]. I note that the website provides BroilKing Corporation's Canadian representative contact information for products availability in Canada. The following notice appears on pages of the website: "We are not the Broil King gas grill/barbecue company. To contact them, click here." Ms. Eatherley also submits printouts of the website "www.allbrands.com" that document the results of a search she conducted on June 1, 2005 regarding the online purchase of a BroilKing convection oven from Canada [Exhibits 9 to 15]. I note that Ms. Eatherley was able to obtain the total price of the product including the shipping cost to a Canadian mailing address using a set of postal code. She states at paragraph 11: "It is clear to me that residents of Canada, and 230 other countries, are able to order and obtain BroilKing products from the ALLBRAND.COM web site."

[38] Furthermore, Ms. Eatherley includes printouts of prior versions of both websites “www.allbrands.com” [Exhibits 16 to 19] and “www.broilking.com” [Exhibits 20 to 25] as archived by the Way Back Machine at “www.archive.org”. Regarding “www.allbrands.com”, Ms. Eatherley conducted a search for BroilKing products and found the brand referenced as early as February 2003 under “Kitchen Appliances” [Exhibit 18]. She includes printouts explaining the website’s international order and shipping policies [Exhibit 19]. Regarding “www.broilking.com”, Ms. Eatherley provides a printout of the website in 1997 with the option to request information on international shipping by email [Exhibit 23]. She also provides a copy of the webpage “About BroilKing” as it appeared in 2000, in which the company stated that its products were available in the United States as well as Canada [Exhibit 26].

[39] Appended to her affidavit are printouts of third parties applications/registrations that Ms. Eatherley obtained from CIPO’s Trade-marks Database on June 9, 2005. I remark that these are for one trade-mark that contains the word “broyl” [Exhibit 27], five trade-marks that contain the word “broil” [Exhibits 28 to 32] and ten trade-marks that contain the word “king” [Exhibits 33 to 42].

[40] Ms. Eatherley files the results of her search on the USPTO’s database for trade-marks that contain “broil” and “mast”, as well as “broil” and “king” and printouts of the corresponding six registrations [Exhibits 43 to 49].

[41] In addition, Ms. Eatherley provides printouts of June 2, 2005 of the website “www.broilmaster.com” which include a list of dealers in Canada [Exhibit 50], and a prior version of the website, in particular that of December 1998 archived by the Way Back Machine at “www.archive.org” [Exhibits 51 to 53]. The printouts of the archived website [Exhibit 53] refer to the manufacture and marketing of BROILMASTER barbecues. There is an indication on the archived version that “Broilmaster is one of Martin Industries’ most recognized brand names”. The archived version also indicates that the company’s products were sold in Canada.

[42] Ms. Eatherley provides printouts of June 1, 2005 of Diversco's website at "www.diverscosupply.com" where the Mark can be seen along with many other brands [Exhibit 54]; printouts of June 9, 2005 of the Char-Broil website at "www.charbroil.com" where a list of retailers including those located in Canada is provided along with a link to the official distributor GRILL LOVER's at "www.grilllovers.com" [Exhibits 55 to 57]. Finally, she files printouts of June 13, 2005 of the GRILL LOVER'S website where customers from United States and Canada can order replacement parts for Char-Broil barbecues [Exhibits 58 and 59].

OPPONENT'S EVIDENCE IN REPLY

The Second Witzel Affidavit and Cross-Examination

[43] Mr. Witzel states that he was not aware of the Applicant's use or advertisement of the trade-mark BROILMASTER "until well after" the present proceeding had commenced [paragraph 1]. He files as Exhibit A to his affidavit three website pages printed on February 28, 2006. The first two pages are from the website at "www.broilking.com". The first page shows the following statement: "NOTE: We are not the Broil King gas grill/barbecue company". The second page provides a link to the Opponent's website. The third page is from the Opponent's website at "www.broilkingbbq.com". It shows the trade-mark BROIL KING in a design format at the top of the website page in close proximity to a barbecue. The trade-mark BROIL KING in a design format is also shown on the top of the barbecue.

[44] Mr. Witzel explains the agreement with Hudson Standard Corporation (now BroilKing Corporation) as follows [paragraph 4]:

[...] Hudson Standard can use the mark BROILKING for all household items of Hudson's manufacture other than outdoor barbecues or related outdoor products. The Opponent has the exclusive right to use BROIL KING in Canada or any other country for outdoor barbecues or related outdoor products.

[45] The cross-examination transcript reflects 178 questions with only Q168 through Q178 specifically directed to the second Witzel affidavit. Clearly, the cross-examination

focused on the separate affidavit of Mr. Witzel filed in the co-pending opposition proceeding to application No. 1,166,534 and not part of the record in the present proceeding. I recognize that it is a common practice for parties to conduct cross-examination on affidavits sworn by the same witness in related opposition proceedings. In this instance, however, it is apparent that in addition to the fact that the affidavits were not filed in the same context, they were not identical. Under these circumstances, I am considering the part of the cross-examination specifically and clearly directed to the affidavit of record in the present proceeding. Mr. Witzel confirms that the link redirecting customers to the Opponent's website was part of the agreement made with Hudson Standard Corporation in September 1998; he believes that the link has appeared since "whenever this agreement was made" [Q174].

ANALYSIS OF THE GROUNDS OF OPPOSITION

[46] I dismiss from the outset some of the grounds of opposition.

[47] First, I dismiss the non-entitlement ground of opposition based upon previously filed applications for the trade-marks BROIL KING, BROIL QUEEN and BROIL-MATE for having been improperly pleaded. The applications had already proceeded to registration (Nos. TMA257,283, TMA257,282 and TMA332,350) at the advertisement date of the Mark [see *Governor and Co. of Adventurers of England trading into Hudson's Bay v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.)].

[48] Second, I also dismiss the ground of opposition based upon s. 16(5) of the Act for having been improperly pleaded. Although it relates to the non-entitlement ground of opposition based upon s. 16(1), I do not think that s. 16(5) in itself can form the basis of a ground of opposition pursuant to s. 38(2)(c) of the Act. In any event, if I am wrong in dismissing the ground of opposition based upon s. 16(5), I will be deciding its outcome in determining the ground of opposition based upon s. 16(1) of the Act.

[49] Third, the Opponent's allegations in support of its last and alternate ground of opposition are seemingly related to s. 15 of the Act for associated marks. Since s. 15 is

not the basis of a ground of opposition as defined in s. 38(2) of the Act, I dismiss the ground of opposition for having been improperly pleaded.

[50] I shall now consider the remaining grounds of opposition, although not necessarily in their order of pleading.

Non-compliance with s. 30(i) of the Act

[51] The mere fact that the Applicant may have been aware of the existence of any of the Opponent's trade-marks prior to the filing of the application does not preclude it from truthfully making the statement required by s. 30(i) of the Act. Where an applicant has provided the statement required by s. 30(i), in my opinion the ground of opposition should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As this is not such a case, I dismiss the ground of opposition based upon non-compliance with s. 30(i) of the Act.

Registrability

[52] I have exercised the Registrar's discretion to confirm that the Opponent's alleged registration Nos. TMA257,283, TMA257,282 and TMA332,350 are in good standing as of today's date. Since the Opponent has discharged its initial burden with respect to the ground of opposition based upon s. 12(1)(d) of the Act, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the trade-marks at issue.

[53] 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[54] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 the trade-marks have been in use; c) the nature of the wares, 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 C.P.R. (4th) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[55] Prior to assessing the surrounding circumstances of this case, I wish to address general submissions made by the Applicant in oral argument. The Applicant noted that the Mark was approved for advertisement despite the Opponent's registrations. It further noted that the application for the trade-mark BROIL-MATE of registration No. TMA332,350 did not encounter any objection on the basis of registration No. TMA268,753 for BROILMASTER (now expunged). The Applicant argued that these facts support a finding of no confusion between the Mark and the Opponent's registered trade-marks. I disagree. A decision by the Examination Section of the Trade-marks Office is not binding on this Board and does not have precedential value for this Board since the Examination Section does not have before it evidence that is filed by parties in opposition proceedings.

[56] Furthermore, the Applicant contended that a negative inference should be drawn from the fact that the Opponent's predecessor in title, Jacuzzi Inc., did not oppose the application that resulted in registration No. TMA268,753 for the trade-mark BROILMASTER (now expunged). I disagree. As rightly argued by the Opponent, this would involve speculating as to why Jacuzzi Inc. did not oppose the registration of the trade-mark BROILMASTER, which I consider inappropriate.

[57] I shall now assess the circumstances of this case.

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

[58] I should first note that in its written argument, the Applicant submits that the Opponent's trade-mark BROIL KING is not inherently distinctive as the Eatherley affidavit evidences that the word "king" appears in eight other trade-marks on the register for use in association with barbecues, outdoor cooking apparatus, and barbecues accessories [Exhibits 33 to 37, 39, 40 and 42].

[59] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.), (1991) 36 C.P.R. (3d) 562 (T.M.O.B.)]. It is also established that such inferences can only be drawn where large numbers of relevant registrations are located [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1983), 82 C.P.R. (2d) 267 (T.M.O.B.)].

[60] As the eight registrations referred to by the Applicant include two sets of three registrations belonging to the same owners, I am not satisfied that any inference can be drawn from the state of the register evidence such as to support the Applicant's contention.

[61] The Mark and each of the Opponent's trade-marks are formed with ordinary words of the English language. The prefix "broil" has a descriptive connotation when considering the parties' wares. I remark that the right to the exclusive use of "broil" has been disclaimed apart from the registered trade-marks BROIL KING and BROIL QUEEN. While the suffix component of each trade-mark may not be considered highly distinctive, it is not descriptive of the wares. Thus, both parties' trade-marks possess a certain degree of inherent distinctiveness.

[62] As for the extent to which the Mark has become known, the Applicant submits that it has provided evidence of use of the Mark in the Canadian marketplace over the last thirty years. As a first matter, I note that any use of the Mark by a third party not named as a predecessor in title in the application does not enure to the benefit of the Applicant. Thus, even if there was reliable evidence of use of the Mark by third parties other than Martin Industries, it would not be of assistance to the Applicant's case in considering the extent to which the Mark has become known. In any event, the evidence relied upon by the Applicant, in written and oral arguments, falls short of showing use of the Mark over the last thirty years. In that regard, I note the following:

- the file history for the trade-mark BROILMASTER of expunged registration No. TMA268,753 [Exhibit 6 to the Eatherley affidavit] is not evidence of use of the trade-mark since 1973;
- the Applicant submits that the cross-examinations of Mr. Witzel and Mr. Hart provide evidence that the Mark has been used in Canada through the 1980s and 1990s by various third parties, and ultimately by the Applicant. I do not doubt Mr. Hart's testimony that he came across BROILMASTER grills in B.D. Wait's factory and warehouse in 1983 in Toronto. Still, his testimony is by no means evidence of use of the trade-mark BROILMASTER by B.D. Wait. In fact, neither Mr. Hart's nor Mr. Witzel's testimony directed to the use of a trade-mark by third parties qualify as reliable evidence of use within the meaning of s. 4(1) of the Act;
- the evidence filed by B.D. Wait in the opposition decision *B.D. Wait Co. Ltd. v. Sunbeam Corporation* (1985), 5 C.P.R. (3d) 543 (T.M.O.B.) involving the trade-mark GRILLMASTER and BROILMASTER is not of record in the present proceeding.

[63] The Applicant relies on the December 1998 version of the website "www.broilmaster.com" as evidence of use of the Mark by Martin Industries. Even if I accept Exhibit 53 to the Eatherley affidavit as evidence that the website was in existence in December 1998, I do not accept it as evidence of the truthfulness of the information. There is no reliable evidence of use of the Mark in Canada by Martin Industries nor was

the Applicant able to provide any information regarding sales and advertisement of the wares associated with the Mark in Canada by its predecessor in title. Regarding the use of the Mark by the Applicant, Mr. Hart asserts that the Applicant only began to sell BROILMASTER barbecues in 2003 in Canada. While Mr. Hart provides evidence of use and advertisement of the Mark in Canada starting in 2003, the Applicant has elected not to detail the value or volume of its sales in 2003 and 2004.

[64] Insofar as the Opponent's trade-marks are concerned, the most that I can presume from the mere existence of the registrations is that there has been *de minimis* use of the trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)].

[65] The bulk of the Opponent's evidence pertains to the trade-mark BROIL KING with little mention of the trade-marks BROIL QUEEN and BROIL-MATE. Mr. Witzel asserts that the Opponent has spent more than ten million dollars in advertising the trade-marks since their acquisition. However, he does not submit an annual breakdown of the advertising figures or separate accounts for each trade-mark, nor does he file specimens of advertisement for each trade-mark. In addition, the advertising figures include advertising expenses for the Opponent's retail stores. While Mr. Witzel testifies that the two million barbecues sold by the Opponent were associated with the trade-marks BROIL KING and BROIL-MATE, he does not provide an annual breakdown of the volume of sales. Thus, it is unclear as to when these sales occurred. Furthermore, although Mr. Witzel testifies that half of the barbecues sold were associated with the trade-mark BROIL KING, I am not prepared to infer from the first Witzel affidavit and cross-examination that the remaining half of the barbecues sold were associated with the trade-mark BROIL-MATE.

[66] In view of the evidence furnished, I am satisfied that the Opponent's trade-mark BROIL KING has become known in Canada to a larger extent than the Mark, but the same cannot be said of the trade-mark BROIL-MATE. Further, I am not satisfied that the

Opponent's evidence may lead to the conclusion that the trade-mark BROIL QUEEN has become known in Canada to any extent.

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

[67] The Mark has been applied for registration on the basis of use in Canada since at least as early as January 1996. Yet, there is no evidence of continuous use since that date. The Applicant has however provided supporting evidence of use since 2003.

[68] The mere existence of the Opponent's registrations establishes no more than *de minimis* use. It cannot give rise to an inference of significant or continuous use [see *Entre Computer Centers, Inc., supra*]. Moreover, mere assertions of use of the Opponent's trade-marks BROIL KING, BROIL QUEEN and BROIL-MATE, as found in the first Witzel affidavit, are insufficient to demonstrate use of the trade-marks in Canada within the meaning of s. 4(1) of the Act.

[69] The trade-mark BROIL KING was registered further to the filing of a Declaration of Use on October 16, 1980. In oral argument, the Opponent noted that the last page of CIPO's file history shows a barbecue bearing the trade-mark BROIL KING [Exhibit 2 to the Eatherley affidavit]. In my view, this one page in CIPO's file history is of no assistance to the Opponent's case. Even if I was to infer that this one page relates to the specimens of use filed along with the Declaration of Use, it is not evidence of continuous use of the trade-mark BROIL KING further to the filing of the Declaration of Use.

[70] Insofar as the evidence of use of the trade-mark BROIL KING by the Opponent is concerned, I recognize that the display of the trade-mark in a design format on the top of the barbecue, as shown in the Opponent's website printout of February 28, 2006, may serve as evidence of use of the trade-mark BROIL KING. Further, one of the two barbecues shown in the newspaper advertisement for the Opponent's retail store [Exhibit 1 to the first Witzel cross-examination] appears to bear the trade-mark BROIL KING in a design format similar to what can be seen in the Opponent's website printout. Therefore, I am prepared to infer that the barbecues sold in July 2004 were marked with

the trade-mark BROIL KING in a similar manner to what can be seen in the printout of the Opponent's website. Thus, I accept that the Opponent has provided specimens of use going back to July 2004, which is subsequent to the Applicant's evidence of use of the Mark. However as the Applicant has evidenced use of the Mark since 2003, I do not consider that the length of time the Mark and the trade-mark BROIL KING have been in use significantly favours the Applicant.

[71] The trade-mark BROIL-MATE was registered on the basis of use in Canada since August 1985. However, there is no evidence of continuous use since that date, nor has the Opponent provided any evidence of the manner in which the trade-mark BROIL-MATE has been used in association with the registered wares. Further, the Opponent failed to provide evidence of use of the trade-mark BROIL QUEEN registered further to the filing of a Declaration of Use on October 16, 1980. As in the case of the trade-mark BROIL KING, the last page of CIPO's file history showing a barbecue bearing the trade-mark BROIL QUEEN is of no assistance to the Opponent's case [Exhibit 1 to the Eatherley affidavit]. In fact, Mr. Witzel's testimony is to the effect that the Opponent is not using the trade-mark BROIL QUEEN. When considering the Mark and the Opponent's trade-marks BROIL QUEEN and BROIL-MATE, the length of time the trade-marks have been in use seems to favour the Applicant.

s. 6(5)(c) and (d) - the nature of the wares, services or business and the nature of the trade

[72] In considering the nature of the wares and the nature of the trade, it is the statement of wares in the application and that in the registrations that govern the assessment of the likelihood of confusion under s. 12(1)(d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[73] The Applicant's wares "gas barbecue grills" are either closely related or identical to the wares of registration Nos. TMA257,282, and TMA257,283 described as "gas

barbecues” and to the wares of registration No. TMA332,350 described as “barbeques, replacement parts for barbeques and implements used with barbeques”.

[74] The Applicant contends that the different price ranges of the two parties’ barbecues minimize the likelihood of confusion. In its written argument, the Applicant submits that the ability for a customer to purchase a “customized” barbecue or an “outdoor kitchen” from the Applicant but not from the Opponent, and the availability of the Applicant’s wares in “speciality shops” as opposed to “large box stores such as Home Depot and Home Hardware”, result in variance in the channels of trade that reduces the likelihood of confusion.

[75] While the Opponent’s wares are sold in its retail stores, they are also sold through retailers, as are the Applicant’s wares. Nothing in the evidence suggests that “specialty shops” do not sell barbecue grills of various price ranges, similar to what can be seen in the Opponent’s newspaper ad where barbecues retailing for two hundred to nearly a thousand dollars are sold at the same location. Moreover, the wares appear to be sold to the same kind of consumers, namely individuals looking for some sort of outdoor cooking appliances. Thus, I find it reasonable to consider that the parties’ channels of trade do overlap.

[76] Overall, the nature of the wares and the nature of the trade favour the Opponent.

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

[77] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

[78] Although the first component of a mark is often considered more important for the purpose of distinction, when a word is common, descriptive or suggestive, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)]. Accordingly, in the present case there would be a tendency to discount the importance of the descriptive word “broil” and by corollary to focus more on the other component of the trade-marks at issue. As noted in *United Artists Corp. v. Pink Panther Beauty Corp.* (1988), 80 C.P.R. (3d) 247 at 263 (F.C.A.):

While the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it.

[79] The Opponent submits that the trade-marks at issue are extremely similar in appearance, sound or ideas suggested. The Applicant submits that any resemblance between the trade-marks at issue “is due exclusively to the fact that the marks share the element BROIL”, which is a common English word and is descriptive when considering barbecues. The Applicant argues that due to the suffix MASTER, the Mark is “appreciably different in appearance and sound” from each of the Opponent’s trade-marks. In its written argument, the Applicant refers to various decisions in which trade-marks comprised of a common English word were found not to be confusing. Suffice it to say that the issue of confusion between the Mark and the Opponent’s registered trade-marks is a question of probabilities and surrounding circumstances based on the particular facts of this case. In other words, each case must be decided upon its own merit.

[80] Recognizing the descriptive connotation attaching to the word “broil”, I find that the differences in sound are more important than the similarities when the trade-marks at issue are considered in their entirety. Likewise, I find that the differences in appearance are more important than the similarities when considering the Mark and the Opponent’s trade-marks BROIL KING and BROIL QUEEN in their entirety. However, I find that

there is a fair degree of resemblance in appearance between the Mark and the Opponent's trade-mark BROIL-MATE when considered in their entirety.

[81] Insofar as the ideas suggested by the trade-marks are concerned, the Applicant contends that the suffixes differentiate the ideas suggested by its Mark and each of the Opponent's trade-marks. The Applicant submits that "BROILMASTER imparts that one who purchases the barbecue will master the art of the barbecue, or the barbecue will help the purchaser to master barbecuing, or that the barbecue itself is a master of barbecuing among the most proficient and consummate in design and function" while BROIL KING "suggests that the wares are the 'king', the 'leader' of all barbecues", BROIL QUEEN suggests "a lesser model" and BROIL-MATE suggests that the barbecue is a "friend".

[82] The Opponent submits that the ideas suggested by the Mark and the trade-mark BROIL KING are synonymous and that the ideas suggested by the Mark and the trade-mark BROIL QUEEN are also very similar. In that regard, the Opponent argues that the word "king" can be said to be fairly synonymous to the word "master", as the word "queen", since they imply "a leader or head, one that holds a preeminent position, one having authority over another, a chief among competitors, or one that conquers".

[83] In support of its contention as to the differences between the ideas suggested by the Mark and the trade-mark BROIL KING, the Applicant states in its written argument: "Where there may be many 'masters' of an art or skill, there can be only one 'king'." [paragraph 127]. I do not consider this argument to be of any assistance to the Applicant's case. I agree with the Opponent that the word "king" can be said to be fairly synonymous to the word "master". In the end, I find that there is a high degree of resemblance between the ideas suggested by the Mark and the Opponent's trade-mark BROIL KING.

[84] I am not prepared to find that the word "queen" suggests "a lesser model", as submitted by the Applicant, nor that it can be said to be fairly synonymous to the word "master", as submitted by the Opponent. Yet, both the words "master" and "queen"

suggest individuals of a higher status and so I find that there is some resemblance between the ideas suggested by the Mark and the trade-mark BROIL QUEEN.

[85] Both the words “master” and “mate” suggest individuals of a particular but different status. Thus, I find that there is some difference between the ideas suggested by the Mark and the trade-mark BROIL-MATE.

Additional circumstances

[86] Given the parties’ written and oral arguments, the following additional surrounding circumstances require consideration.

- *No evidence of actual confusion*

[87] The Applicant submits that since both parties’ trade-marks have co-existed in the marketplace for over thirty years without any evidence of actual instances of confusion, “this is a very good indication that the public is not confusing” the Mark with the Opponent’s trade-marks. Given my prior findings with respect to the evidence in the present proceeding, I cannot accept the Applicant’s contention that the trade-marks “have co-existed in the marketplace for over thirty years”.

[88] As previously noted, Mr. Witzel did refuse to answer questions as to whether he was aware of any actual instance of confusion; he kept insisting that there could be, but refused to say if he knew of any. While Mr. Witzel did testify that the Opponent had received calls from consumers asking for parts of BROILMASTER barbecues, he did acknowledge that no questions were asked to find out why consumers were calling the Opponent. Clearly, Mr. Witzel’s testimony cannot serve to establish actual confusion. Nonetheless, it has often been said that an opponent needs not to prove instances of confusion. The burden is on an applicant to demonstrate the absence of likelihood of confusion. In other words, the absence of evidence of confusion does not relieve the Applicant from its burden of proof.

[89] In *Mattel, Inc, supra*, the Supreme Court of Canada recited the remarks made by Décarý J. in *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155 in reference to the implication of “actual confusion”:

While the relevant issue is “likelihood of confusion” and not “actual confusion”, the lack of “actual confusion” is a factor which the courts have found of significance when determining the “likelihood of confusion”. An adverse inference may be drawn when concurrent use on the evidence is extensive, yet no evidence of confusion has been given by the opponent” (My underlining).

[90] In the present case, there is a lack of evidence regarding the continuous use of the Mark in Canada since the date of first use claimed in the application. However, the Applicant did provide evidence of use of the Mark since 2003. As for the Opponent, it did provide evidence showing use of the trade-mark BROIL KING within the meaning of s. 4(1) of the Act since July 2004. Hence, I accept that the Mark and the trade-mark BROIL KING have coexisted on the Canadian marketplace for a few years. Nonetheless, since Mr. Hart did not provide information as to the Applicant’s volume or value of sales, even approximate ones, I am unable to draw a conclusion as to how extensive the use of the Mark was during that period. Thus, I do not consider that the lack of actual instances of confusion between the Mark and the Opponent’s registered trade-mark BROIL KING is a determinative factor.

[91] Finally, the lack of actual instances of confusion cannot be of any significance when considering the trade-mark BROIL QUEEN as there is no evidence directed to the use of the trade-mark. I also consider the lack of actual instances of confusion to be of no significance when considering the trade-mark BROIL-MATE as the evidence does not permit me to draw a meaningful conclusion as to the period or the extent of use of the said trade-mark.

- *Use of “broil” as component of third parties’ trade-marks*

[92] The Applicant submits that the word “broil” is commonly adopted by third parties as components of trade-marks in Canada in association with wares that would fall within

the same class as those of the Opponent, including outdoor cooking equipments and accessories, such that Canadians are used to distinguish one trade-mark from another.

[93] Relying on the Eatherley affidavit, in particular Exhibits 1 to 5 and 28 to 33, the Applicant submits: “Since the 1980s, there have been at least 12 trade-marks owned and 11 registered by different owners incorporating the word BROIL” [paragraph 132 of the written argument]. The Applicant further submits that the Eatherley affidavit, in particular Exhibits 29, 30 and 55 to 56, provides evidence that the owner of the registered trade-mark CHAR-BROIL, namely W.C. Bradley, has a presence in the Canadian market and uses its trade-mark in Canada.

[94] The Applicant is apparently of the view that the fact that the trade-marks BROIL KING, BROIL QUEEN and BROIL-MATE [Exhibits 1 to 3] were owned over the years by entities other than the Opponent is relevant in considering the use of “broil” as a component of third parties’ trade-marks. I disagree. Clearly, if there had been reliable evidence of use of the trade-marks by a predecessor in title of the Opponent, the latter would have benefited from such use. Further, since the registrations for the trade-marks WAIT BROIL-MATE, WAIT BROIL MASTER and BROILMASTER [Exhibits 4 to 6] are either cancelled or expunged, they are irrelevant when considering the state of the register evidence. Likewise, the expunged registration for the trade-mark BROYLAGRIL [Exhibit 27], the abandoned application for the trade-mark THE BROILER FACTORY [Exhibit 28] and the formalized application for the trade-mark ADVANTAGE SERIES BY CHAR-BROIL [Exhibit 29] are irrelevant. I would add that I disagree with the Applicant’s contention that the formalized application for the trade-mark ADVANTAGE SERIES BY CHAR-BROIL filed by W.C. Bradley is evidence of the presence of W.C. Bradley in the Canadian market.

[95] In the end, when considering the state of the register evidence, we are left with three registered trade-marks owned by distinct entities, namely CHAR-BROIL of registration No. TMA253,978 for home and camp grills, COMPU BROIL of registration No. TMA493,508 for microwave ovens, and BROIL BEST & Design of registration

No. TMA265,651 for charcoal briquets [Exhibits 30 to 32]. In my view, three registrations are not sufficient to draw any inference about the state of the marketplace.

[96] Turning now to the evidence introduced with respect to the registered trade-mark CHAR-BROIL of W.C. Bradley, I accept Exhibits 55 to 58 to the Eatherley affidavit as evidence that the website “www.charbroil.com” was in existence on June 9, 2005, but not as evidence of the truthfulness of the information. Further, even though I recognize that Mr. Hart testifies that he is aware of W.C. Bradley selling barbecues under the brand CHAR-BROIL, his testimony does not constitute reliable evidence of use of the trade-mark. In oral argument, the Applicant submitted that given Exhibits 55 to 58 to the Eatherley affidavit and Mr. Hart’s testimony, it is reasonable to infer that the trade-mark CHAR-BROIL is in use in Canada. Even if I was to accept the Applicant’s contention with respect to what can be inferred from the evidence, I would afford little, if any, significance to it. Indeed, I would consider that use of one of the three registered trade-marks disclosed by the state of the register evidence is insufficient to show that trade-marks involving the word “broil” are commonly used on the marketplace in association with cooking appliances, in particular outdoor cooking equipments and accessories.

[97] To summarize, the state of the register and the evidence with respect to the use of the trade-mark CHAR-BROIL in Canada are not sufficient for me to conclude that the average consumer is accustomed to seeing various third parties’ trade-marks incorporating the term “broil” in association with cooking appliances, in particular outdoor cooking equipments and accessories.

- *Use of BROILKING by BroilKing Corporation*

[98] The Applicant submitted both in written and oral arguments that the concurrent use of the Opponent’s trade-mark BROIL KING and of BroilKing Corporation’s trade-mark BROILKING in the Canadian market in association with overlapping wares, lessens the distinctiveness of the Opponent’s trade-mark, “making BROIL KING a weak mark, not entitled to much protection”. In reply, the Opponent submitted in oral argument that the agreement with BroilKing Corporation (formerly Hudson Standard Corporation)

regarding the use of the trade-mark BROILKING for household items, other than outdoor barbecues and related outdoor products, does not affect the distinctiveness of its trade-mark BROIL KING due to its long period of use.

[99] As a preliminary matter, I wish to mention that the ownership, validity and enforceability of registration No. TMA257,283 for the trade-mark BROIL KING are not at issue in this proceeding. Further, the Settlement Agreement of March 31, 1997 and the Trade-mark Licensing Agreement of September 1, 1998 by themselves cannot serve as evidence of use of the trade-mark BROILKING by BroilKing Corporation in Canada.

[100] I should remark that the Applicant submits in its written argument [paragraph 142] that Mr. Witzel testifies that the Opponent and BroilKing Corporation are in the same market. However, according to my review of the relevant part of the first Witzel cross-examination, in particular Q260, the answer provided by Mr. Witzel was in the context of counsel for the Applicant asking whether his client and the Opponent were competitors. That being said, Mr. Witzel did testify that household appliances and barbecues are sold in the Opponent's retail stores. Although there is no evidence showing that any household appliances sold in the Opponent's retail stores are manufactured by BroilKing Corporation, it is reasonable to conclude to an overlap between the Opponent's and BroilKing Corporation's wares and channels of trade. There is also evidence that a link to the Opponent's website is provided on BroilKing Corporation's website.

[101] In addition to my previous observation that website pages appended to the Eatherley affidavit are not evidence of the truthfulness of the information, I wish to make the following remarks on the website printouts relied upon by the Opponent as evidence of use of BroilKing Corporation's trade-mark BROILKING in Canada:

- if I had afforded any weight to Exhibits 7 and 8 as showing the availability of household items manufactured by BroilKing Corporation in Canada through specific Canadian retailers and representatives, at the outmost it would have been evidence as of June 1, 2005 of such availability. That being said, it would still not

have been evidence that any of the household items available on June 1, 2005 through specific Canadian retailers and representatives were associated with the trade-mark BROILKING;

- while there is a reference to “BroilKing Brand Products” on the printouts of the website of 2003 [Exhibit 18], it is unclear as to whether the trade-mark BROILKING appears on any of the household items shown on the website. In any event, mere advertising does not amount to use of a trade-mark in association with wares;
- if I had afforded any weight to the 1997 printout of the website “www.broilking.com”, the mere fact that it provided the option to request information on international shipping would not have been evidence that household items associated with the trade-mark BROILKING were ordered from Canada in 1997. In fact, it would not even have been evidence that household items associated with the trade-mark could be ordered from Canada in 1997.

[102] Despite the deficiencies of the evidence introduced by Ms. Eatherley, I accept Exhibits 10 to 15 as evidence that convection ovens bearing BroilKing Corporation’s trade-mark BROILKING were available to Canadian consumers through online orders on June 1, 2005. Still, this is not evidence of use of BroilKing Corporation’s trade-mark in connection with convection ovens pursuant to s. 4(1) of the Act.

[103] In view of the above, I conclude that the evidence does not support the Applicant’s contention as to concurrent use in the Canadian market of the Opponent’s trade-mark BROIL KING and of BroilKing Corporation’s trade-mark BROILKING.

Conclusion on the likelihood of confusion

[104] Having considered all of the surrounding circumstances, in particular the extent to which the trade-marks have become known, the nature of the wares, the nature of the trade and the high degree of resemblance between the trade-marks in the ideas suggested, I am not satisfied that the Applicant has met its burden to show that there is no reasonable likelihood of confusion between the Mark and the Opponent’s registered trade-mark

BROIL KING. As per my discussion above, I am not satisfied that any significance should be afforded to the use of “broil” as a component of third parties’ trade-marks as an additional circumstance. In any event, if I was to afford any significance to the use of “broil” as a component of third parties’ trade-marks as an additional circumstance, in my view, at the utmost it would evenly balance the probabilities of confusion. As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with the Opponent’s registered trade-mark, I would still decide against the Applicant and find that it has not discharged its burden of showing that the Mark is not confusing with the Opponent’s registered trade-mark BROIL KING.

[105] However, having considered all of the surrounding circumstances, I am satisfied that the Applicant has met its burden to show that there is no reasonable likelihood of confusion between the Mark and the Opponent’s registered trade-marks BROIL QUEEN and BROIL-MATE. Indeed, when considering the trade-mark BROIL QUEEN, I find that the extent to which the Mark has become known and the length of time it has been used combined with the differences between the trade-marks in sound and in appearance tip the balance of probabilities in favour of the Applicant. When considering the trade-mark BROIL-MATE, I find that the extent to which the Mark has become known and the length of time it has been used combined with the differences between the trade-marks in sound and in the ideas suggested tip the balance of probabilities in favour of the Applicant.

[106] In view of the above, I find that the ground of opposition based upon s. 12(1)(d) of the Act is successful to the extent that it is based on registration No. TMA257,283 for the trade-mark BROIL KING. However, I dismiss the ground of opposition based upon s. 12(1)(d) of the Act to the extent that it is based on registration Nos. TMA257,282 for the trade-mark BROIL QUEEN and TMA332,350 for the trade-mark BROIL-MATE.

Non-entitlement pursuant to s. 16(1)(a) of the Act

[107] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and

the Opponent's trade-marks, the Opponent has the initial onus of proving that its trade-marks BROIL KING, BROIL QUEEN and BROIL-MATE were being used at the material date and had not been abandoned at the date of advertisement of the application [s. 16(5) of the Act]. As the application does not provide a precise date during the month of January 1996, I consider the alleged date of first use, thus the material date, to be January 31, 1996.

[108] The mere existence of the Opponent's registrations is insufficient to satisfy the Opponent's initial burden with respect to the non-entitlement ground of opposition [see *Discrete Distribution, L.L.C. v. International Clothiers Inc.* 2006 CarswellNat 4977 (T.M.O.B.)]. Further, mere assertions of use of the Opponent's trade-marks BROIL KING, BROIL QUEEN and BROIL-MATE, as found in the first Witzel affidavit, are insufficient to demonstrate use of the trade-marks in Canada within the meaning of s. 4(1) of the Act [see *Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1979), 45 C.P.R. (2d) 194 (F.C.T.D.); aff'd 53 C.P.R. (2d) 62 (F.C.A.)].

[109] In view of the above, in the absence of supporting evidence of use, I find that the Opponent has not discharged its onus of proving that its trade-marks BROIL QUEEN and BROIL-MATE were being used at the material date. Further, in view of my prior findings, I conclude that the evidence shows use of the trade-mark BROIL KING, within the meaning of s. 4(1) of the Act, since July 2004 at the utmost. Therefore, I find that the Opponent has not discharged its onus of proving that its trade-mark BROIL KING was being used at the material date.

[110] Having regard to the foregoing, I dismiss the ground of opposition based upon non-entitlement pursuant to s. 16(1)(a) of the Act.

Distinctiveness

[111] There is an initial burden on the Opponent to show that one or more of its trade-marks had become known sufficiently as of the material date to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.*, 56 C.P.R. (2d) 44 (F.C.T.D.);

Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd. (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)). The mere existence of the registrations for the Opponent's trade-marks is not sufficient to satisfy the Opponent's evidential burden with respect to this ground of opposition.

[112] In view of the evidence furnished by the Opponent, I find that it has not met its burden to show that its trade-mark BROIL QUEEN or its trade-mark BROIL-MATE had become known sufficiently as of January 31, 2003 to negate the distinctiveness of the Mark.

[113] Furthermore, the deficiencies in the evidence of use and advertisement furnished by the Opponent with respect to the trade-mark BROIL KING coupled with the absence of specimens of use predating July 2004 lead me to find that the Opponent has not met its burden to show that its trade-mark BROIL KING had become known sufficiently as of January 31, 2003 to negate the distinctiveness of the Mark.

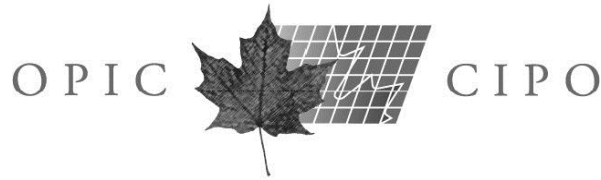
[114] In view of the above, I dismiss the ground of opposition based upon non-distinctiveness.

DISPOSITION

[115] Having regard to the foregoing, and with the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT MONTREAL, QUEBEC, THIS 17th DAY OF MARCH 2010.

Céline Tremblay
Member
Trade-marks Opposition Board



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

**Citation: 2010 TMOB
29**

**Date of Decision:
2010-04-28**

**IN THE MATTER OF AN
OPPOSITION by Onward Multi-
Corp. Inc. to application No.
1,112,366 for the trade-mark
BROILMASTER filed by Empire
Comfort Systems, Inc.**

AMENDED DECISION

[1] Having been notified of a typographical error in paragraph 36 of my decision dated March 17, 2010, specifically that s. 41(1)(b) of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) was incorrectly identified as s. 4(1)(b) of the Act, I hereby amend paragraph 36 of my decision to read:

[117] [36] Ms. Eatherley provides copies of CIPO's file histories for the Opponent's registered trade-marks BROIL QUEEN, BROIL KING and BROIL-MATE [Exhibits 1 to 3]. She also provides photocopies of CIPO's file histories of the trade-mark registrations for WAIT BROIL-MATE, WAIT BROILMASTER and BROILMASTER [Exhibits 4 to 6]. I note that these three registrations, originally owned by B.D. Wait Co. Limited, have either been cancelled pursuant to s. 41(1)(b) of the Act or expunged pursuant to s. 45 of the Act.

[2] Having been notified that the last sentence of paragraph 111 in my decision dated March 17, 2010 was incomplete, I hereby amend paragraph 111 of my decision to read:

[118] [111] There is an initial burden on the Opponent to show that one or more of its trade-marks had become known sufficiently as of the material date to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.*, 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]. The mere existence of the registrations for the Opponent's trade-marks is not sufficient to satisfy the Opponent's evidential burden with respect to this ground of opposition.

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