

**IN THE MATTER OF AN OPPOSITION  
by RA Brands, L.L.C. to application No.  
1,054,193 for the trade-mark  
REMINGTON HOMES COUNTRY  
STORE filed by Calsper Developments  
Inc.**

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On April 6, 2000, Calsper Developments Inc. (the “Applicant”) filed an application to register the trade-mark REMINGTON HOMES COUNTRY STORE (the “Mark”). The application is currently based upon proposed use of the Mark in Canada in association with the operation of a real estate sales office. The Applicant has disclaimed the right to the exclusive use of the word HOMES apart from the Mark.

The application was advertised for opposition purposes in the Trade-marks Journal of March 13, 2002. On August 13, 2002, RA Brands, L.L.C. (the “Opponent”) filed a statement of opposition against the application, which reads in part:

1. ... The grounds of opposition are as follows:

a) ...The trade-mark which is the subject matter of application 1,054,193 is not registrable in view of Section 12(1)(d) of the *Trade-marks Act*, [R.S.C. 1985, c. T-13] (the “Act”), and the Applicant is not entitled to registration of its mark contrary to Section 16(3)(a), (b) and (c) in view of the prior and confusing applications and registrations of the Opponent, as set out below:

Regn. TMDA20942	REMINGTON
Regn. 425,798	REMINGTON
Regn. 468,948	REMINGTON
Appln. 1,001,687	REMINGTON
Regn. 489,314	REMINGTON Design
Regn. TMDA16221	REMINGTON UMC & Red Ball Design

b) In view of the facts set out in 1(a) above, Applicant’s mark is not distinctive of it, nor is it capable of becoming distinctive of it.

c) In summary, and for the foregoing reasons, the trade-mark opposed is:

- i) not registrable;
- ii) the Applicant is not entitled to registration; and
- iii) not distinctive and is not capable of being distinctive of the services proposed by the Applicant.

The Opponent's two design marks are shown below:



*Remington*



The Applicant filed and served a counter statement in which it denied the grounds of opposition.

As rule 41 evidence, the Opponent filed certified copies of the five registrations and one application relied upon in its statement of opposition, as well as an affidavit of Katherine Busse. The Applicant obtained an order for the cross-examination of Ms. Busse but did not proceed with a cross-examination.

The Applicant filed the affidavit of Matthew Bratty as rule 42 evidence. The Opponent obtained an order for the cross-examination of Mr. Bratty and a transcript of the cross-examination forms part of the record.

Neither party filed a written argument, but an oral hearing was held at which both parties were represented.

#### Material Dates

The material dates with respect to the grounds of opposition are as follows: 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*, 37 C.P.R. (3d) 413 (F.C.A.); s. 16(3) - the filing date of the application; distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4<sup>th</sup>) 317 (F.C.T.D.) at 324].

### Onus

Although the Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act, there is an initial 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4<sup>th</sup>) 155 (F.C.A.).]

### Section 12(1)(d) Grounds of Opposition

The Opponent has met its initial burden with respect to its s. 12(1)(d) grounds of opposition because the registrations on which it relies are extant. The likelihood of confusion among the marks will therefore be assessed, beginning with the likelihood of confusion between the Mark REMINGTON HOMES COUNTRY STORE and the Opponent's REMINGTON mark.

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. 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: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. All factors to be considered under s. 6(5) do not necessarily have equal weight. The weight to be given to each depends on the circumstances. [See *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1966), 66 C.P.R. (3d) 308 (F.C.T.D.).]

*inherent distinctiveness of the trade-marks*

As the Applicant's mark simply adds descriptive words to REMINGTON, both parties' marks share a similar degree of inherent distinctiveness.

*the extent to which each trade-mark has become known*

There is no evidence that the Opponent's REMINGTON mark has become known in Canada.

There is some evidence that the Applicant's Mark has become known in Canada [see for example Exhibit "C", Bratty affidavit], but it is difficult to assess to what extent.

*the length of time each trade-mark has been in use*

The dates of first use set out in the Opponent's registrations are as follow: TMDA20942 - 1857; 425,798 - February 1992; 468,948 - November 01, 1996; 489,314 - January 22, 1998; and TMDA16221 - March 01, 1911. Based on the dates of first use set out in the Opponent's registrations, the length of time that each trade-mark has been in use favours the Opponent. [See *Cartier Men's Shops Ltd. v. Cartier Inc.* (1981), 58 C.P.R. (2d) 68 (F.C.T.D.) at 71.]

*the nature of the wares, services or business; the nature of the trade*

When considering the wares, services and trades of the parties under s. 12(1)(d), it is the statements of wares or services in the parties' trade-mark application or registrations that govern. [See *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.).]

The statement of wares in each of the Opponent's registrations reads as follows:

- TMDA20942 - Rifles, shot guns, pistols, cartridges, cartridge shells, shot gun cartridges, paper shot shells, powders, wads, percussion caps, primers, bullets, bullets and shot;
- 425,798 - Tents, backpacks, camping stools, sleeping bags, and hunter's all-purpose carry bags;

- 468,948 – bed throws;
- 489,314 - Traps for throwing targets; optical scopes or sights; and archery products, namely bows, arrows, arrow rests, quivers and cases and accessories for the foregoing wares; and
- TMDA16221 - Fire-arms and ammunition.

There is thus no connection at all between the Applicant’s services, namely the operation of a real estate sales office, and any of the Opponent’s registered wares and there is no reason to conclude that there is any connection between the parties’ trades.

*the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

There is a high level of resemblance between the parties’ marks as a result of them sharing the word REMINGTON as the first component of each of their marks. Nevertheless, there are significant differences among them visually and aurally as a result of the inclusion of the words HOMES COUNTRY STORE in the Applicant’s Mark. This component of the Mark also results in the Mark as a whole suggesting a different idea from that associated with the Opponent’s marks.

*conclusion re likelihood of confusion*

I am satisfied that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the marks REMINGTON and REMINGTON HOMES COUNTRY STORE. In reaching this conclusion, I am aware that in *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188 the Court stated, “it is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction” I also acknowledge that s. 6(2) specifically indicates that confusion may be likely whether or not the wares or services are of the same general class. However, as stated by Mr. Justice Binnie in *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22 at paragraph 73, “Be that as it may, the view is correct that ‘all of the surrounding circumstances’ must be taken into consideration but that, in some cases, some circumstances (such as the differences in wares) will carry more weight than others.” In the present case, I find that the differences in the wares weigh more heavily than the

degree of resemblance among the marks.

For reasons similar to those set out above, an analysis of the likelihood of confusion between REMINGTON HOMES COUNTRY STORE and each of the Opponent's REMINGTON Design marks also results in a conclusion that, on a balance of probabilities, there is not a reasonable likelihood of confusion. Of course, the additional words and design incorporated into the mark covered by the Opponent's registration No. TMDA16221 makes the Opponent's case with respect to such mark even weaker.

For the foregoing reasons, all of the s. 12(1)(d) grounds of opposition are rejected.

#### Section 16 Grounds of Opposition

In order to meet its evidential burden with respect to a s. 16(3)(a) ground of opposition, an opponent must provide evidence of use of its trade-mark prior to the filing of the applicant's application. When an opponent only files a certified copy of its registration, the Registrar will assume only *de minimus* use of the opponent's trade-mark. [See *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.).] Therefore the mere filing of certified copies of the Opponent's registrations does not support the Opponent's evidential burden with respect to its s. 16(3)(a) grounds of opposition.

The Opponent's application No. 1,001,687 was filed before the Applicant's application and was still pending as of the date of advertisement of the Applicant's application. Accordingly, the Opponent has met its evidential burden with respect to its s. 16(3)(b) ground of opposition. However, for reasons similar to those discussed with respect to the s. 12(1)(d) grounds of opposition, the s. 16(3)(b) ground is also rejected. It is noted that application No. 1,001, 687 was filed based upon proposed use of the mark REMINGTON in association with "games, namely computer games, card games, and video games; board games, and playing cards" and there is no evidence that the Opponent's mark ever acquired any reputation in Canada in association with games. Moreover, games are completely unrelated to the Applicant's services.

The s. 16(3)(c) ground of opposition is also rejected, as the Opponent's pleadings do not refer to any trade-name in support of such a ground.

#### Distinctiveness Ground of Opposition

This ground of opposition has been so pleaded as to rely on the likelihood of confusion between the parties' marks resulting in the Applicant's Mark not being distinctive.

In the recent decision in *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* 2006 FC 657, Mr. Justice Noël stated at paragraph 34, "A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient." Because the Opponent has not filed any evidence concerning its use or promotion of its marks, I am unable to conclude that any of its marks has acquired a reputation in Canada that is "substantial, significant or sufficient". The Opponent has therefore not satisfied its initial burden with respect to its distinctiveness ground of opposition and that ground accordingly fails. The mere filing of certified copies of the Opponent's registrations does not satisfy the Opponent's evidential burden with respect to its allegations of non-distinctiveness. [See *Entre Computer Centers, Inc. v. Global Upholstery Co., supra.*]

At the oral hearing, the Opponent's agent argued that the Applicant's Mark is not distinctive for reasons other than a likelihood of confusion with the Opponent's marks. However, I will not address those arguments because the Opponent did not plead any basis for non-distinctiveness other than a likelihood of confusion. [See *Imperial Developments Ltd. v. Imperial Oil Ltd.* (1984), 79 C.P.R. (2d) 12 (F.C.T.D.) at 21.]

#### Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 23rd DAY OF AUGUST 2006.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board