



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

Citation: 2014 TMOB 92
Date of Decision: 2014-04-30

**IN THE MATTER OF AN OPPOSITION
by Brasstech, Inc. to application
No. 1,441,085 for the trade-mark
GINGER'S DESIGN in the name of Elte
Carpets Limited**

[1] Ginger's International Bath Centre Ltd. applied to register the trade-mark GINGER'S DESIGN (the Mark) on June 10, 2009, based upon use of the Mark in Canada since at least as early as May 2004, in association with the following wares and services:

Wares:

Bathroom supplies, sanitary wares and accessories, namely, bathtubs, sinks, toilets, bidets, towel bars, faucet sets, mirrors, cloth towels, shower curtains, soap dishes, waste baskets, hand dryers, decorative bottles, body care soap, glass containers and bathmats

Services:

Furniture and fixture repair services

[2] As a result of an amalgamation which took place subsequent to the filing of the application, the application for the Mark now stands in the name Elte Carpets Limited (the Applicant).

[3] Brasstech, Inc. (the Opponent) is the owner of the trade-mark GINGER, which it claims to have used in Canada, either by itself or through a predecessor, in association with “bath lighting, namely sconce lights; bathroom accessories namely towel bars, towel rings, robe hooks, shelves, tissue holders, and plumbing products, namely faucets, lavatory faucet sets, tub faucet sets, shower heads, shower jets, body sprays and shower valves”, since prior to the Applicant’s claimed date of first use.

[4] The Opponent has opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based upon sections 30(b), 30(i), 16(1)(a) and 2 of the Act.

[5] In support of its opposition, the Opponent filed the affidavit of Jonathan F. Wood, sworn October 24, 2011 (the Wood affidavit), the affidavit of Theodore Sorokopas, sworn October 24, 2011 (the Sorokopas affidavit) and the affidavit of Michael Bull, sworn November 23, 2012 (the Bull affidavit). Mr. Wood and Mr. Bull were both cross-examined on their affidavits and the transcripts of the cross-examinations have been made of record.

[6] In support of its application, the Applicant filed the affidavit of Allison Trimble, sworn March 20, 2012 (the Trimble affidavit). Ms. Trimble was cross-examined on her affidavit and the transcript of the cross-examination has been made of record.

[7] Both of the parties filed written arguments and attended a hearing.

Onus

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

Preliminary Matter

[9] At the hearing, the Opponent withdrew the ground of opposition based upon section 30(i) of the Act. In view of this, only the sections 30(b), 16(1)(a) and 2 grounds remain to be decided. I will address each of these grounds in turn below.

Non-conformity – Section 30(b)

[10] The Opponent alleges that the Applicant has not used the Mark in Canada since the claimed date of first use, namely, May 2004. Section 30(b) of the Act requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the date of filing of the application [*Benson & Hedges (Canada) Ltd v Labatt Brewing Co* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[11] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(b) of the Act because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986) 10 CPR (3d) 84 (TMOB) at 89].

[12] In this case, the Opponent has filed the Sorokopas affidavit in support of its section 30(b) ground of opposition. Mr. Sorokopas is a private investigator [see para 1].

[13] In a nutshell, Mr. Sorokopas' affidavit provides details regarding visits which he made on September 29, 2011 to the stores "Elte" and "Ginger's Bath & Boutique" (Ginger's), both of which are located in Toronto, Ontario. Elte is located at the same address which has been provided for the Applicant in the application for the Mark [see para 3]. It sells furniture, antiques, lighting, lighting fixtures, carpets and broadloom [see para 4]. Ginger's is located at a different address, but is also owned by the Applicant [see paras 5 and 16]. The purpose of Mr. Sorokopas' visit to the Applicant's stores was clearly to gather information regarding the Applicant's use of the Mark or its lack of use thereof.

[14] At the outset, I wish to note that I am cognizant of the fact that Mr. Sorokopas' evidence clearly postdates the material date for the Opponent's section 30(b) ground of opposition and that some of his evidence arguably also has hearsay flaws. That being said, I am also mindful of the

fact that it is difficult for a third party to produce evidence to show that there was no use of another party's mark at any date, let alone at a date several years ago. This is precisely why the evidential burden in cases like this is lighter. I am therefore prepared to consider Mr. Sorokopas' evidence. A similar approach to evidence of this nature has been taken by this Board in the past [see *Seven-Up Canada Co v Caribbean Ice Cream Company Ltd*, 2007 CanLII 80903 (TMOB)]. I would add that the Applicant had an opportunity to challenge Mr. Sorokopas' evidence through cross-examination, but it did not do so. Moreover, the Applicant did not put forward any substantive submissions regarding Mr. Sorokopas' evidence in its written argument or at the hearing.

[15] While visiting Elte, Mr. Sorokopas spoke with a sales associate and obtained a copy of Elte and Ginger's joint catalogue [see paras 5 and 7 and Exhibit "A"]. The catalogue clearly displays the Mark and features many products, including many of those which are covered in the application for the Mark. Notably, the Mark is not visible on any of the wares which are in the catalogue.

[16] During his visit to Ginger's, Mr. Sorokopas also observed signage outside the store which featured the Mark and noted that a large portion of the store appeared to be dedicated to bathroom products. Attached as Exhibits "B" and "C" to Mr. Sorokopas' affidavit are photographs showing the outside store signage and the interior of the store.

[17] In paragraph 14 of his affidavit, Mr. Sorokopas indicates that during his visit to Ginger's, he walked through the entire store and made notes on the various items which were on display. In particular, he observed which trade-marks were featured on the various products which were on display in the store. Although the store carried many of the wares which are covered by the application for the Mark, Mr. Sorokopas determined that the Mark was only visible on two lines of bath towels, hand towels and wash cloths which were sold in the store [see para 15]. Attached as Exhibit "D" to Mr. Sorokopas' affidavit are photographs of one of the wash cloths, including the label and tag featuring the Mark.

[18] Mr. Sorokopas purchased the wash cloth shown in Exhibit "D" and attached a copy of the associated sales invoice to his affidavit as Exhibit "E". The Mark is shown on the top left corner of the invoice above the Applicant's address. Attached as Exhibit "F" to Mr. Sorokopas'

affidavit is a photograph of the store bag which was given to him with his purchase. The Mark is prominently displayed thereon [see para 15].

[19] During his visit, Mr. Sorokopas also learned from a sales associate that Ginger's has a parts and service department that operates under the name "Ginger's Appliances Service". In addition, he learned from a sales associate that Ginger's does not sell furniture and that Elte's provides a "scratch and dent" service for the furniture that is sold by Elte and for the equipment that is sold by Ginger's [see para 8].

[20] The Opponent's evidence suggests that aside from "cloth towels", the Mark is not used in association with wares, *per se*. Rather, it appears as though it may be used in connection with retail services relating to the sale of the types of wares which are covered in the application. Moreover, the Opponent's evidence suggests that while the Mark may be used in connection with a parts and service business relating to appliances which are sold by the Applicant, it does not appear to be in use in association with "furniture and fixture repair services" *per se*, as claimed in the application. Although the "scratch and dent" services which are offered by the Applicant may be considered to be "furniture and fixture repair services", they appear to be offered in the Elte store, rather than the Ginger's store and there is no evidence to suggest that they are advertised or performed in association with the Mark.

[21] In my view, while the Opponent's evidence may not definitively establish non-use of the Mark, it certainly casts doubt on whether the Mark has been used since the claimed date of first use or at all, in association with anything other than "cloth towels". I therefore find that the evidence is sufficient for the Opponent to meet its light evidential burden in respect of its section 30(b) ground of opposition in relation to all of the wares in the application, with the exception of "cloth towels" and in relation to all of the services in the application.

[22] I must therefore go on to consider whether the evidence filed by the Applicant can positively establish continuous use of the Mark from the claimed date of first use up to the filing date of the application for anything other than "cloth towels" or for the services.

The Trimble Affidavit and Transcript of Cross-examination

Ms. Trimble's Employment History with the Applicant

[23] At the date of swearing her affidavit, Ms. Trimble had been the Director of Buying Plumbing and Hardware of Ginger's International Bath Centre Ltd., (Ginger's), the Applicant's predecessor-in-title, since 2010 [para 1]. Prior to that position, she held the positions of General Manager from 2001 to 2010 and Senior Buyer from 1991 to 2010. She started with the company in 1985 [para 2].

Ms. Trimble's Development of Ginger's Private-Label Products

[24] In 2002, Ms. Trimble developed a private-label (where a retailer contracts with a manufacturer or supplier to make products under the retailer's own brand) for Ginger's under the brand Ginger's. The private-label line encompasses several product categories, including bath hardware, basins, kitchen sinks, kitchen faucets, bath faucets and bathtubs. Within each of these product categories, there are different style lines. Ms. Trimble states that the private-label line of products marketed under the Ginger's brand (the Ginger's products) was launched in April of 2004 [paras 3 and 9].

[25] In paragraph 9 of her affidavit, Ms. Trimble sets out a chart detailing the different styles for each category of Ginger's products under the private-label line.

Promotion and Advertising of the Ginger's Products

[26] Attached as Exhibit "B" to Ms. Trimble's affidavit are product information sheets for various Ginger's products, which Ms. Trimble states have been distributed to interior designers, architects, builders, design/build firms and developers in Canada. Ms. Trimble indicates that the information sheets are also available in-store to customers alongside the products sold [para 10]. Each of the information sheets features a picture of the product, its style name and product details. The Mark appears on the bottom right hand corner of the information sheets, above the company name Ginger's International Bath Centre and the contact information for the company.

[27] Attached as Exhibit “D” to Ms. Trimble’s affidavit are copies of photographs of in-store displays of the Ginger’s products. Ms. Trimble states that the Ginger’s products have been offered for sale in the Ginger’s retail store in the manner shown in these photographs since April of 2004. Notably, the Mark is not present on any of the displays.

[28] In paragraph 19 of her affidavit, Ms. Trimble states that every year, Ginger’s utilizes many forms of advertising to promote its retail services and the Ginger’s products bearing the Mark. Attached as Exhibit “G” to her affidavit is a chart setting out representative examples of advertisements and promotions which Ms. Trimble states have been used by Ginger’s in Canada over the years since at least as early as 2004, along with information on the publications in which the advertisements appeared. The dates of publication range from February 2009 to April/May 2012.

[29] Attached as Exhibit “H” are copies of the advertisements and promotions shown in the chart in Exhibit “G”. The Opponent has pointed out that some of the materials in Exhibit “H” appear to simply promote the Applicant’s retail store business, which is located in Toronto. In addition, some of the other materials in Exhibit “H” include advertisements for third party branded goods as well as the private-label Ginger’s products. On cross-examination, Ms. Trimble confirmed that a customer would not be able to identify which products are the private-label Ginger’s products and which are third party branded products [see Trimble transcript, question 231].

[30] In paragraph 18 of her affidavit, Ms. Trimble states that every year since 2003, Ginger’s has spent a minimum of \$260,000 on the promotion and advertising of its retail store business and its Ginger’s products bearing the Mark. Ms. Trimble has not provided any breakdown with respect to what portion of the advertising specifically relates to the Applicant’s private-label Ginger’s products and what portion relates to the Applicant’s business in general and the third party branded products which it also sells.

Sales of the Ginger’s Products

[31] In addition to being offered for sale at Ginger’s retail store, the Ginger’s products bearing the Mark have also been available for sale since 2007 at a retail store in Ottawa [para 13].

[32] The Ginger's products are also offered for sale online [para 14]. Attached as Exhibit "E" to Ms. Trimble's affidavit are representative pages from Ginger's website offering for sale the Ginger's products. Notably, there is no reference to the Mark on these pages. Rather, part of the Applicant's company name (ELTE) appears in conjunction with the words "Ginger's Bath" underneath, in a different font style than that which appears in the Mark.

[33] Ms. Trimble states that although the Ginger's products bearing the Mark were first offered for sale in April of 2004, Ginger's purged certain information from its computer system, including sales information from prior to 2005. Accordingly, Ms. Trimble has provided sales information for sales of Ginger's products only for the years of 2005 to 2011. Annual sales for these years ranged from \$380,000 in 2005 to \$2.5 million in 2011 [see para 15]. Attached as Exhibit "F" are representative samples of invoices showing sales of Ginger's products bearing the Mark to customers in Canada from 2005 to 2012.

[34] In paragraph 16 of her affidavit, Ms. Trimble indicates that although she cannot provide sales information for April and May of 2004, she is confident that sales were made prior to May 31, 2004 because the Ginger's products were designed and positioned at a price point which Ginger's felt confident would garner immediate sales. I am not prepared to accept Ms. Trimble's statement in this regard. While it's true that an affiant's experience and his or her office may put him or her in a position to have personal knowledge of the facts without necessarily having been a direct witness to the event, I am not convinced that this is the case here [see *Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD) at pages 59-60; *Scott Paper Ltd v Georgia-Pacific Consumer Products LP* (2010), 83 CPR (4th) 273 (FC) at para 35; *Philip Morris Inc v Imperial Tobacco Ltd*, (1987), 13 CPR (3d) 289 (FCTD)].

[35] Contrary to the statements made in Mr. Bull's affidavit, which I will discuss in more detail under the non-entitlement ground, Ms. Trimble has not based her statement on any business records or knowledge of a sales relationship which existed between the Applicant and a particular customer. Although Ms. Trimble may have had personal knowledge of the Applicant's business, the fact that the products may have been priced to sell, does not mean that any actually sold during the months of April and May of 2004, as Ms. Trimble has presumed.

[36] That being said, at the start of her cross-examination, after affirming, Ms. Trimble indicated that she wished to correct paragraphs 15 and 16 in her affidavit.

[37] With respect to paragraph 15, Ms. Trimble indicated that she wished to update it to state: “In 2005, Ginger’s purged certain information from its computer system, including sales information prior to 2005. Sales information specifically refers to product sales information prior to 2005”.

[38] With respect to paragraph 16, Ms. Trimble indicated that she wished to update it to state: “Although I cannot provide sales information for April and May of 2004, I can in fact provide customer invoices which specifically show a sale of a Soho single-hole faucet which is part of the Ginger’s private label product line which I talk about in my affidavit and are dated prior to May 2004”.

[39] Copies of the invoices referred to by Ms. Trimble were put on record and marked as Exhibit “A” to the cross-examination transcript. During her cross-examination, Ms. Trimble clarified that the documents marked as Exhibit “A” were, in fact, screen shots of invoices, rather than actual invoices.

[40] Not surprisingly, the Opponent objected to the introduction of Exhibit “A” during the cross-examination. The Opponent took the position that Ms Trimble did not clarify anything in her affidavit and that it was “too late” for the Applicant to be introducing such documents [see Trimble transcript, page 4, line 19 to page 6, line 3]. I am of the view that Ms. Trimble was entitled to correct her affidavit. It may have been procedurally preferable for the Applicant to introduce the contents of Exhibit “A” by way of filing a request for leave to file additional evidence. However, I am prepared to consider this evidence, as Ms. Trimble was under oath at the time that she was cross-examined and documents were relevant to the correction which was made to her affidavit. Moreover, since the documents were produced by Ms. Trimble and introduced during cross-examination, counsel for the Opponent was able to question Ms. Trimble regarding the documents and in fact, did so.

[41] I note, however, that at best, the screen shots of these invoices show sales of “faucet sets” as of the May 2004 claimed date of first use.

Use of the Mark in Association with the Ginger's Products

[42] In paragraph 11, Ms. Trimble confirms that the Ginger's products are always and have always been packaged in boxes/packaging bearing the Mark, in which they are sold to customers in Canada. Attached as Exhibit "C" are photographs of various Ginger's products in packaging, which Ms. Trimble states is representative of how the products have been sold to customers in Canada since Ginger's first sale [para 11]. The photographs in Exhibit "C" show the Mark present on the packaging itself or on stickers affixed thereto.

[43] During cross-examination, Ms. Trimble acknowledged that the photographs were taken in the Applicant's warehouse and that customers are not permitted into the warehouse [Trimble transcript, Q's 273-275]. The Opponent submits that this evidence is somehow ambiguous or deficient because the photographs were taken in the Applicant's warehouse, it is unclear when they were taken and the Applicant did not file actual packaging. Given Ms. Trimble's statement that the packages shown in the photographs are representative of how the Ginger's products are always and have always been sold to customers in Canada, I do not find that there is any merit to the Opponent's submissions in this regard.

[44] During cross-examination, Ms. Trimble confirmed that the Applicant directs the vendor regarding the packaging design and content for the Applicant's private-label program. [Trimble transcript, Q's 80-83].

[45] Ms. Trimble also confirmed on cross-examination that when products are originally received from the vendor, she double checks the packaging to ensure that the packaging has been made according to the Applicant's specifications [Trimble transcript, Q's 180-183]. Ms. Trimble was asked whether she subsequently checks every order that comes in. She replied that she does not [Trimble transcript, Q 185]. Ms. Trimble was then asked whether it is possible that subsequent orders of the private-label program products may not have been labeled with the Ginger's trade-mark. In response, she stated that she believed that this was something that she or someone else would have noticed, since it is common knowledge that the private-label products must be packaged with the Ginger's name on them. [Trimble transcript, Q's 186-188].

[46] Prior to this line of questioning, Ms. Trimble was presented with a delivery ticket, which was produced by the Opponent and subsequently identified by Ms. Trimble as originating from Ginger's. It had not previously been included in Ms. Trimble's affidavit or in any of the other evidence of record. The delivery ticket is marked as Exhibit "1". Ms. Trimble confirmed that the products identified in the delivery ticket are sold under Ginger's private-label program. Although, they were not identified as such in the delivery ticket [Trimble transcript, page 24, Q 112 to page 28, Q 122].

[47] Ms. Trimble was then presented with a box containing a product which she identified as being the same as one of the products which was referred to in the delivery ticket. The box was marked as Exhibit "2". Ms. Trimble acknowledged that the Mark was not present on the box and indicated that a mistake must have been made by the manufacturer [Trimble transcript, page 29, Q 126].

[48] The Applicant objected to the introduction of the delivery ticket, the box and its contents, as well as to the Opponent's questions regarding these items. The Applicant submitted that there was no way to ascertain the source of the product, when it was purchased or whether it had been altered in some manner.

[49] The Opponent then went on to introduce a second box and mark it as Exhibit "3". The Opponent attempted to have Ms. Trimble answer a series of questions regarding the second box, but counsel for the Applicant objected to the questions and refused to have Ms. Trimble answer them. Additional boxes were subsequently entered as Exhibits "4" to "6", which resulted in similar objections and refusals [Trimble transcript, pages 33, line 12 to page 36, line 17].

[50] The Opponent takes the position that since Ms. Trimble was able to identify the delivery ticket comprising Exhibit "1" and the product in the box comprising Exhibit "2", these exhibits were properly introduced and should be considered as evidence. The Opponent also takes the position that I should draw an adverse inference from Ms. Trimble's refusal to answer the questions which were later put to her regarding the subsequently introduced exhibits. The Opponent submits that Ms. Trimble could have confirmed on rebuttal whether the product boxes had been tampered with, as she would have had knowledge of what the boxes should have looked like, as a result of her position with the Applicant. I reject the Opponent's submissions.

[51] The mere fact that Ms. Trimble knew what the packaging for the Applicant's Ginger's products should look like does not mean that she was in a position to confirm that the boxes introduced by the Opponent during her cross-examination originated from the Applicant and were received in the packaging which was presented to her. After all, Ms. Trimble was not the one who purchased the products and received them.

[52] In view of the foregoing, I am not prepared to consider this evidence or draw any adverse inferences from Ms. Trimble's refusals regarding the boxes which were subsequently introduced during her cross-examination. If the Opponent wished to rely upon such evidence it should have filed it by way of affidavit and the Applicant should have had an opportunity to cross-examine the affiant regarding the source of the products and how they were purchased and received.

[53] I wish to add that even if I am wrong in not considering this evidence or drawing an adverse inference against the Applicant for Ms. Trimble's refusals, it would not change my ultimate conclusion in this case. The fact that some of the Ginger's products may have been shipped without the Mark appearing on the packaging after the material date, does not mean that other products weren't shipped within the material date in packaging which did feature the Mark, as is clearly stated to be the case by Ms. Trimble in her affidavit.

Conclusion Regarding Section 30(b) Ground of Opposition

[54] Ms. Trimble confirmed that other than on the boxes, there is no other way that the Mark would be associated with the Ginger's private-label products. [Trimble transcript, pages 29-30, Q131 and pages 43-44, Q's 165 to 175]. In other words, the Mark does not appear on the products or on product inserts and the products are not identified with the Mark in invoices or on delivery tickets.

[55] Ms. Trimble has acknowledged that customers would not know from looking at the Applicant's invoices or delivery tickets which products are sold under the Mark and which are sold under third party trade-marks [Trimble transcript, Q's 33 and 238-245].

[56] In addition, Ms. Trimble has acknowledged that a customer looking at the Applicant's website would have no way of knowing which products are sold under the Applicant's private-

label program in association with the Mark and which are third party branded products [Trimble transcript, Q 210].

[57] The Mark does appear to be present on storefront signage and shopping bags. However, while this may constitute use of the Mark in association with retail services or trade-name use, it does not, in my view, constitute use of the Mark in association with wares within the meaning of section 4 of the Act, particularly since the Applicant also sells third party wares in the same venues using the same shopping bags.

[58] We are therefore left with packaging, as the Applicant's only means of showing use of the Mark. While Exhibit "C" to Ms. Trimble's affidavit does show use of the Mark on packaging and while I am prepared to accept the statements which Ms. Trimble has made regarding use of the Mark in paragraph 11, the fact remains that Ms. Trimble has only been able to show actual sales of a single product (the Soho faucet) dating back to the May 2004 claimed date of first use. All of the remaining invoices and the sales figures which have been provided date back only as far as 2005. Although Ms. Trimble has explained the reason for this in her affidavit, it does not change the fact that her evidence is only sufficient to positively establish use of the Mark for "faucet sets", as far back as the claimed date of first use.

[59] With respect to the services, I note that the Applicant has not provided any evidence of use of either furniture or fixture repair services. Moreover, during her cross-examination, Ms. Trimble confirmed that the Applicant does not sell furniture or offer any furniture repair services [Trimble transcript, Q's. 261-262].

[60] In view of the foregoing, the section 30(b) ground of opposition is successful in relation to all of the wares, with the exception of "cloth towels" and "faucet sets" and in relation to all of the services.

Non-entitlement – Section 16(1)(a)

[61] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the Opponent's trade-mark GINGER, which had been "continuously,

extensively and previously used and advertised in Canada by the Opponent and/or its predecessors”.

[62] Although the Opponent did not specifically identify the wares in association with which it allegedly previously used its trade-mark in its section 16(1)(a) ground of opposition, it did identify them elsewhere in its statement of opposition as being “bath lighting, namely sconce lights; bathroom accessories, namely, towel bars, towel rings, robe hooks, shelves, tissue holders, and plumbing products, namely, faucets, lavatory faucet sets, tub faucet sets, shower heads, shower jets, body sprays and shower valves”.

[63] The material date for a ground of opposition based upon section 16(1)(a) of the Act would typically be the claimed date of first use [section 16(1)]. However, where an opponent has successfully challenged an applicant’s claimed date of first use under a section 30(b) ground of opposition, the material date for assessing a section 16(1) ground of opposition becomes the applicant’s filing date [see *American Cyanamid Co v Record Chemical Co Inc* (1972), 6 CPR (2d) 278 (TMOB); *Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB)].

[64] Accordingly, the material date for determining the likelihood of confusion with respect to “cloth towels” and “faucet sets” is May 2004 (the claimed date of first use of the Mark), whereas the material date with respect to the remaining wares and the services is June 10, 2009 (the filing date of the application).

[65] Prior to assessing whether or not there is any likelihood of confusion between the parties’ trade-marks, it is first necessary to determine whether the Opponent has met its initial burden to show use of its trade-mark prior to the aforementioned material dates and non-abandonment as of the date of advertisement of the Mark, namely, February 9, 2011 [section 16(5)]. The Wood and Bull affidavits and transcripts of cross-examination provide information regarding the Opponent and its use of its trade-mark in Canada. I will summarize some of the more pertinent information in those affidavits below.

The Wood Affidavit

[66] At the time of swearing his affidavit, Mr. Wood was the Vice President of Sales and Marketing for the Opponent and had been since 2003 [see para 1]. In paragraphs 6 to 8, Mr. Wood provides some information regarding the history of the GINGER trade-mark. It was first used as both a trade-mark and company name by a father and son team in 1983 [see para 6]. That company was subsequently acquired by a corporation called Masco Corporation in 2000, which later merged it into the Opponent in 2004. The Opponent has continued to sell bath lighting, bathroom accessories, faucets and shower heads under the GINGER brand since the merger [see paras 7 and 8].

[67] In paragraph 5 of his affidavit, Mr. Wood states that the Opponent uses the trade-mark GINGER in Canada and the United States in association with the wares “bath lighting, namely sconce lights; bathroom accessories, namely, towel bars, towel rings, robe hooks, shelves, tissue holders, and plumbing products, namely, faucets, lavatory faucet sets, tub faucet sets, shower heads, shower jets, body sprays and shower valves” (collectively the GINGER products).

[68] In paragraph 19 of his affidavit, Mr. Wood states that the GINGER products have been sold in Canada since as early as 1995 through Direct Buy [see para 19]. In support of this statement, Mr. Wood attaches a screen shot from the Opponent’s computer records showing that Direct Buy was opened as an account for GINGER products on January 1, 1995 [see Exhibit “A”]. The Applicant submits that this evidence is not sufficient to establish that the Opponent’s predecessor actually sold any of its products in association with its trade-mark in Canada to Direct Buy. I agree. At best, the screen shot suggests that an account was opened.

[69] In paragraphs 20 to 21 of his affidavit, Mr. Wood identifies a number of retail purchasers to which the Opponent has sold its GINGER products since 1995. Notably, Mr. Wood does not indicate whether any of them are located within Canada. In paragraph 21 of his affidavit, Mr. Wood identifies a number of Canadian hotel purchasing groups to which the Opponent has sold its GINGER products. However, he does not specify when the Opponent sold its wares to these groups.

[70] Mr. Wood goes on to provide some further information regarding the Opponent's normal course of trade. He states that the GINGER products are sold directly to authorized Canadian dealers (or hotel purchasing groups), who then sell the products to end-use customers in Canada. The dealers order the products and the products are shipped to the dealer or to the end user as described in the purchase order [see para 22].

[71] Mr. Wood indicates that the GINGER products are shipped in packages that include the GINGER trade-mark, product information and descriptions [see para 23]. Attached as Exhibit "B" are photographs which were taken in 2009 of boxes for some of the GINGER products. Mr. Wood indicates that the boxes are similar to those which were in use prior to and in the years since 2009.

[72] In paragraph 31 of his affidavit, Mr. Wood provides details pertaining to the number of units of GINGER products which were sold in Canada during the years of 2006-2009. The numbers range from between 5,765 and 10,521. Attached as Exhibit "BB", are copies of representative invoices that were sent to Canadian purchasers. The invoices all relate to sales to one company, namely, Cantu Bathrooms & Hardware Ltd. (Cantu) and date back as far as May of 2002.

[73] The Applicant submits that the invoices do not assist the Opponent in evidencing that it sold products bearing its trade-mark into Canada, as the majority of the invoices suggest that the products were, in fact, shipped to a U.S. address, rather than to Canada and any invoices for products which were shipped to Canada covered products other than those which the Opponent has referred to in its pleadings. The Opponent submits that the Bull affidavit remedies this.

The Bull Affidavit

[74] Mr. Bull is one of the owners of Cantu [see para 1]. Cantu displays and sells decorative plumbing and hardware in Canada [see para 4]. Mr. Bull is an active shareholder in the business and has been the active owner in the business since it was purchased in 1986. As the active owner of Cantu, Mr. Bull has responsibility for and knowledge of all aspects of its business, including its current and historical sales of GINGER products. Mr. Bull states that Cantu maintains accurate print and computer records of its business activities [see paras 1 to 3].

[75] Cantu has displayed and sold GINGER bathroom lighting, bathroom accessories and plumbing products from its showrooms since at least as early as 2001 [see para 9]. When Cantu sells GINGER products to a customer, the products are contained in boxes bearing the GINGER trade-mark. The boxes are the same as those in which the products are delivered to Cantu. Mr. Woods states that this has been the case for as long as he can remember [see paras 10 and 17]. Attached as Exhibit “A” to Mr. Bull’s affidavit are photographs of a toilet paper roller and a plumbing valve in packaging which Mr. Bull states are currently in stock at Cantu [see para 11]. The GINGER trade-mark is prominently displayed thereon.

[76] The Applicant takes issue with Mr. Bull’s failure to specify the number of years during which the GINGER products have been shipped in this manner. However, I note that Mr. Wood’s affidavit does shed some light on this to the extent that Mr. Wood also provides photographs of sample packaging bearing the GINGER trade-mark which he states was used prior to and in the years since 2009.

[77] In paragraph 12, Mr. Bull states that Cantu’s records show that Cantu has been selling GINGER products since at least as early as 2001. He indicates that he knows this because Cantu’s computer records show that Cantu has been paying Ginger USA since at least as early as 2001 and he believes that these payments could only be for the purchase of GINGER products to sell in Cantu’s showrooms. Attached as Exhibit “B” to Mr. Bull’s affidavit is a print screen from Cantu showing a record of payments made to Ginger USA in 2001.

[78] At the hearing, I queried the identity of Ginger USA and counsel for the Opponent simply commented that affiants are not always as precise as they could be with language. I understood this to mean that Mr. Bull’s reference to Ginger USA was simply a loose reference to the Opponent’s predecessor. I note that Mr. Wood was not overly precise in providing details with respect to the Opponent’s predecessors either [see Wood affidavit, page 1, para 6 to page 2, para 8]. The Applicant has not taken issue with this aspect of the Opponent’s evidence. Moreover, in his affidavit, Mr. Bull states that he dealt with Mr. Wood for many years and that he was Cantu’s contact at Ginger and now at Brasstech, Inc., the Opponent. Mr. Bull also confirmed that Cantu was also a direct customer of the Opponent at the time of the merger and that he was aware of the merger between the two companies when it took place [see para 13].

[79] The Applicant has taken issue with other aspects of Mr. Bull's evidence. In particular, the Applicant submits that the statement made in paragraph 12 of Mr. Bull's affidavit suggests that he does not have any personal knowledge of sales of the Ginger products to Cantu dating back to 2001. The Applicant further submits that Mr. Bull's assumption that the sales in the print screen must relate to sales of GINGER products, may not be accurate given that the Opponent appears to offer brands other than just the GINGER brand [see Bull cross-examination, page 9, lines 4-10; Wood affidavit, para 2 and Wood cross-examination, page 14, lines 18-23].

[80] With respect to the first issue which has been raised by the Applicant, I note that the Federal Court has held that an affiant's experience and his or her office may put him or her in a position to have personal knowledge of the facts without necessarily having been a direct witness to the event [see *Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD) at pages 59-60; *Scott Paper Ltd v Georgia-Pacific Consumer Products LP* (2010), 83 CPR (4th) 273 (FC) at para 35; *Philip Morris Inc v Imperial Tobacco Ltd*, (1987), 13 CPR (3d) 289 (FCTD)]. Overall, I find that Mr. Bull had personal knowledge of the Opponent's business. In my view, it seems he was in a position from his position and experience with the Opponent to know of what he deposed. I am therefore prepared to accept his statement that the payments could not have related to anything other than purchases of the GINGER products and I reject the Applicant's submission that his evidence should be disregarded.

[81] With respect to the second issue which has been raised by the Applicant, I note that the entries in the print screen date back to 2001. Thus, this sales information presumably relates to sales which the Opponent's predecessor would have made to Cantu, rather than sales made by the Opponent itself. Since there is no evidence to establish that the Opponent's predecessor sold any brands other than the GINGER brand of wares, I find it reasonable to accept Mr. Bull's statement that these sales would have related to sales of the GINGER brand wares.

[82] In paragraphs 15 and 16 of his affidavit, Mr. Bull goes on to provide details pertaining to how Cantu imports the GINGER products into Canada. Mr. Bull states that the GINGER products are delivered to an authorized agent of Cantu at a U.S. receiving address. The

authorized agent then assumes responsibility for clearing customs and shipping the products to Cantu's showrooms in Canada.

[83] The Applicant submits that the Bull affidavit does not fill in the gaps which were present in the Wood affidavit. In particular, the Applicant submits that although the Bull affidavit was purportedly filed to demonstrate that the Opponent had shipped certain products to Cantu in Canada, it makes no reference to any actual transactions or to any of the transactions which were referred to in the Wood affidavit and supported by the invoices attached as Exhibit "BB".

[84] In other words, the Applicant submits that the Bull affidavit does not provide the "missing link" to show that products which were referenced in the invoices attached as Exhibit "BB" to the Wood affidavit were actually shipped to Canada. While this may be the case, I am of the view that evidence must be considered in its totality and in light of the evidence which has been filed in the present case, I do not find it necessary for the Bull affidavit to provide a "link" which is specific to the particular invoices which are referred to in the Wood affidavit.

[85] The Applicant submits that invoices showing products being shipped to a location in the United States, accompanied by an assertion that the products were later brought into and sold in Canada, is not sufficient to show "use" in accordance with the Act. The Opponent relies upon the decision of *Redsand Inc v Thrifty Riding & Sports Shop Ltd* for this proposition [see *Redsand Inc v Thrifty Riding & Sports Shop Ltd* 1997 CarswellNat 996 (FCTD)].

[86] I consider the decision in *Redsand* to be distinguishable from the present case. In *Redsand*, the evidence of the Opponent's alleged use of its trade-mark in Canada consisted of one invoice referring to a purchase which was shipped to an address in the United States and statements to the effect that wares were sold in Canada for a brief period. In the present case, we have many invoices which cover a several year period. In addition, the Opponent has provided unit sales figures for a number of years, sample packaging and sworn statements regarding years of sales from both the Opponent and its Canadian purchaser (Cantu). An explanation has also been provided with respect to how the Canadian purchaser orders the wares and arranges for shipment of the wares to Canada.

[87] While both the Wood and the Bull affidavits could certainly have benefited from more precision, I am satisfied that the information which is contained in the combination of these two affidavits is sufficient to enable the Opponent to meet its evidential burden, at least in relation to the wares and services for which the material date is June 10, 2009. I also find that the evidence is sufficient for the Opponent to meet its initial burden in relation to “cloth towels” and “faucet sets”, in respect of which the material date is May of 2004.

[88] I will now go on to consider whether the Applicant has satisfied its legal onus to show that the Mark was not reasonably likely to cause confusion with the Opponent’s trade-mark.

[89] 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.

[90] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time 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 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

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

[91] The Opponent’s trade-mark GINGER and the Mark, GINGER’S DESIGN, very closely resemble one another and I find that they possess about the same degree of inherent distinctiveness.

[92] Approximate sales of the Applicant's Ginger's products in Canada have ranged from \$380,000 in 2005 to \$1.3 million in 2009 [Trimble affidavit, para 15]. Mr. Wood has not provided any sales figures. However, he has provided details pertaining to the number of units of the Opponent's GINGER products which were sold in Canada during the years of 2006-2009. The numbers range from between 5,765 and 10,521 [Wood affidavit, para 31].

[93] The Opponent has also filed some evidence relating to its promotional and advertising activities. However, the period of time and/or extent to which most of these activities took place in or reached the Canadian marketplace is somewhat unclear.

[94] For example, in paragraph 30, Mr. Wood indicates that the Opponent sends price books to all of its dealers each year, including those in Canada and he attaches copies of the cover pages of such books as Exhibit "AA" to his affidavit. However, he does not indicate how many price books have been sent to Canadian dealers, nor does he specify the number of Canadian dealers to which the books have been sent.

[95] Similarly, in paragraph 29 of his affidavit, Mr. Wood states that the GINGER products are advertised using catalogues, brochures and sales sheets that are distributed across North America and in other countries. Samples of such catalogues, brochures and sales sheets are attached as Exhibits "H" to "Z" to Mr. Wood's affidavit. However, Mr. Wood does not specifically indicate whether any of these materials were distributed in Canada.

[96] In paragraphs 26 to 28 of his affidavit, Mr. Wood makes reference to advertisements featuring the GINGER trade-mark which have appeared in various publications, but no circulation figures for the publications have been provided and Mr. Wood has not indicated whether the publications are circulated in Canada. During his cross-examination, Mr. Wood was only able to confirm circulation in Canada of a single publication [see Wood cross-examination, page 26, line 25, page 27, lines 1 to 20, page 39, lines 6 to 25 and page 40, lines 1 to 4].

[97] There are similar "vagueness" issues with respect to the evidence which has been put forward in the Wood affidavit regarding sales of the Opponent's wares.

[98] By way of example, although Mr. Wood provides a list of retail purchasers of the GINGER products in paragraph 20 of his affidavit, he does not specify that these purchasers are

Canadian and the remainder of the evidence (the Bull affidavit) only establishes that one of the retailers, namely, Cantu, is Canadian.

[99] Similarly, in paragraph 21 of his affidavit, Mr. Wood provides a list of Canadian hotel purchasing groups to which the GINGER products have been sold, but Mr. Wood does not indicate when the GINGER products were sold to these groups.

[100] In addition, Mr. Wood provides unit sales figures in paragraph 31 of his affidavit for sales of the GINGER products in Canada from 2006 to 2009, but he does not indicate how many customers purchased the wares. Thus, it could have been a single purchaser, such as Cantu, or many.

[101] While I am able to conclude that the Opponent's trade-mark has become known in Canada to some extent as a result of its use, due to the aforementioned shortcomings in the Opponent's evidence I am unable to draw any meaningful conclusions regarding how well known its trade-mark has become.

[102] It is also difficult for me to assess the extent to which the Mark has become known, given that the Applicant's evidence suggests that the bulk of the materials relied upon by the Applicant to promote its products (i.e. product information sheets, catalogues, in-store displays, website, etc.) appear to advertise the Applicant's retail store services in general or are presented in such a manner that does not enable customers to associate the Mark with the wares. That being said, as a result of the sales figures which have been provided for the Ginger's products specifically, I am prepared to infer that the Mark has become also become known to some extent.

Section 6(5) (b) –length of time in use

[103] The application for the Mark is a "use" based application and the Applicant has filed evidence of use dating back to 2004, for at least some of its wares. As previously discussed, the Opponent has also filed evidence relating to the use of its trade-mark in Canada which somewhat predates the Applicant's date of first use.

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

[104] Insofar as the nature of the parties' wares, services or business and the nature of the trade are concerned, it is clear that there is some overlap, as both parties' are in the business of selling bathroom accessories and related items. In terms of services, the application for the Mark broadly covers "furniture and fixture repair services". To the extent that such services may be considered to encompass bathroom furniture and fixture repair services, there is also a connection between the services in the application for the Mark and the Opponent's wares.

Section 6(5)(e) – degree of resemblance between the trade-marks

[105] With respect to the degree of resemblance between the trade-marks, it is clear that the parties' trade-marks very closely resemble one another.

Conclusion Regarding Likelihood of Confusion

[106] In view of the overlap in the wares and services and in view of the high degree of resemblance between the parties' trade-marks, I conclude that the Applicant has not discharged the legal onus resting upon it to show that confusion between the Mark and the Opponent's GINGER trade-mark was not likely.

[107] The section 16(1)(a) ground of opposition is therefore successful in relation to the wares and services for which the material date is June 10, 2009, as well as for "cloth towels" and "faucet sets", in respect of which the material date is May of 2004.

Non-distinctiveness – Section 2 of the Act

[108] The Opponent has pleaded that the Mark is not adapted to distinguish, nor capable of distinguishing the wares and services of the Applicant from the wares of the Opponent.

[109] The material date to assess this ground of opposition is the filing date of the statement of opposition, namely, April 8, 2011 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[110] For the reasons previously mentioned under the section 16(1)(a) ground of opposition in relation to the section 6(5)(a) factor, I am not satisfied that the Opponent has met its evidentiary burden to establish that its trade-mark had become known sufficiently in Canada as of April 8, 2011, to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[111] Accordingly, the non-distinctiveness ground of opposition is dismissed.

Disposition

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

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