



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

Citation: 2010 TMOB 033
Date of Decision: 2010-03-24

**IN THE MATTER OF AN OPPOSITION
by Joseph M. Anderson to application
No. 1,279,373 for the trade-mark smokin
joe in the name of Smokin Joe Inc.**

[1] On November 14, 2005, Nu-Life Inc. (the Original Applicant) filed an application to register the trade-mark smokin joe (the Mark) based upon proposed use of the Mark in Canada in association with the following wares:

Raw tobacco, cigars, cigarillos, cigarettes, cut tobacco, rappee, manufactured tobacco of all kinds, matches, tobacco pipes, pipe holders, ashtrays, match boxes, cigar cases and humidors.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 3, 2006.

[3] On June 29, 2006, Joseph M. Anderson (the Opponent) filed a statement of opposition. The Original Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[4] Pursuant to r. 41 of the *Trade-marks Regulations*, SOR/96-195, the Opponent filed an affidavit of Joseph M. Anderson. On November 15, 2007, the Original Applicant cross-examined Mr. Anderson on his affidavit and on December 12, 2007 it filed a copy of the transcript of cross-examination. The Original Applicant advised the Registrar that the Opponent had not provided answers to questions taken under advisement in a timely fashion.

[5] By letter of December 18, 2007, the Registrar advised the parties of the deadline for filing evidence pursuant to r. 42. On January 8, 2008, the Original Applicant advised that it would not be filing any evidence under r. 42 and requested that the proceeding move on to the written argument stage. By letter dated January 14, 2008, the Opponent wrote the Registrar and expressed the view that the Original Applicant had not given it sufficient time to provide answers to the approximately thirty questions taken under advisement. The Opponent then requested an extension of time for the purpose of the Opponent filing such answers. Given that it is the examining party's responsibility to file answers to undertakings, the approach taken in this proceeding was somewhat irregular. Nevertheless, the Registrar did grant the examined party an extension of time to file the answers; however, the Registrar advised that the answers would be considered as filed under r. 44(1).

[6] On January 24, 2008, the Registrar recorded Smokin Joe Inc. (the Applicant) as the owner of the present application pursuant to the filing of an assignment.

[7] On March 25, 2008, the Opponent filed answers to the questions taken under advisement during the cross-examination of Mr. Anderson.

[8] On May 5, 2008, the Applicant wrote the Registrar advising that it wished to withdraw the earlier election to not file evidence under r. 42. The Applicant explained that it would not have made such an election if it had at that time been in receipt of the answers to the questions taken under advisement. The Opponent objected to the Applicant's request.

[9] The Registrar responded to the Applicant's May 5, 2008 letter in a letter dated July 15, 2008. In this letter, the Registrar explained that there was no means to withdraw an election to not file evidence but that he would consider the Applicant's request as amounting to a request for leave to file additional evidence. However, as the Applicant had not met all the requirements relevant to a request for leave under r. 44, the Registrar did not grant the Applicant leave to file additional evidence. By separate letter of the same date (July 15, 2008), the Registrar called for the filing of written arguments pursuant to r. 46(1).

[10] Only the Opponent filed a written argument. However, the Applicant requested that an oral hearing be held. The Opponent attended for the hearing, but the Applicant failed to appear.

Grounds of Opposition

[11] The Opponent has pleaded two grounds of opposition under s. 38(2) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act):

- 1) pursuant to s. 38(2)(c)/16(3) the Opponent pleads that at the date of filing of the application, the Mark was confusing with the Opponent's trade-mark SMOKIN JOES, which was previously used in Canada in association with tobacco products, including cigars and cigarettes; and
- 2) pursuant to s. 38(2)(d) the Opponent pleads that the Mark is not distinctive in that it is not adapted to distinguish and does not actually distinguish the wares in association with which it is proposed to be used from the wares of the Opponent, having regard to the use by the Opponent of its trade-mark SMOKIN JOES.

[12] The basis of both grounds of opposition is an allegation that confusion is likely between the parties' marks. Although the material date for assessing the likelihood of confusion differs with respect to each ground (November 14, 2005 regarding the first ground and June 29, 2006 regarding the second ground), in the circumstances of this case, nothing turns on the date at which the issue of confusion is determined.

Onus

[13] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[14] The Opponent has met its initial onus with respect to the first ground of opposition because the evidence shows that the Opponent's mark was used in Canada prior to November 14, 2005 and had not been abandoned as of May 3, 2006 [see s. 16(3) and (5) of the Act]. In addition, the Opponent has met its initial onus with respect to the second ground because the evidence shows that the Opponent's mark was, as of June 29, 2006, known to some extent, with

a reputation in Canada that was substantial, significant or sufficient [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

Likelihood of Confusion

[15] 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.

[16] In applying the test for confusion, I 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 each has 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, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)]

[17] Both marks are inherently distinctive.

[18] There is no evidence that the Applicant's Mark has become known to any extent whereas Mr. Anderson's evidence shows that the Opponent's mark has been displayed on tobacco products (namely tobacco cigarettes and little cigars) sold in Canada since as early as 2000.

[19] While there is evidence that the Opponent's mark has been used, there is no evidence that the Applicant's Mark has been used.

[20] The parties' wares are of the same nature and overlap. It is therefore fair to assume that their channels of trade would also overlap.

[21] There is an extremely high degree of resemblance between the two marks given that they only differ by one letter.

[22] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to either ground of opposition, namely, the Applicant has not satisfied me that on a balance of probabilities confusion between the two marks is not likely. Both grounds therefore succeed.

Disposition

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

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office