



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

Citation: 2010 TMOB 93
Date of Decision: 2010-06-30

**IN THE MATTER OF AN OPPOSITION
by Positec Group Limited to application
Nos. 1177824 and 1177823 for the trade-
marks TOOL WORX and TOOL WORX
and Design in the name of Rui Royal
International Corp.**

[1] On May 14, 2003, Rui Royal International Corp. (the “Applicant”) filed applications to register the trade-marks TOOL WORX, application No. 1177824 and TOOL WORX and Design, application No. 1177823 (shown below) based on use in Canada since as early as May 5, 2003 in association with the following wares:

Hand tools for use with wood and metal, namely: tape measures, gauges, vises, clamps, axes, sockets and socket sets, utility knives, utility knife blades, folding pocket knives, hammers, wrenches, saws, files, pliers, drills, drill bits, screwdrivers, wood chisels, nut drivers, tool boxes, levels, pallets, prybars, wrecking bars, hatchets, glue guns, glue, flashlights, emergency lights, tire gauges, hexkey sets, magnetic pick up tools, chalk lines, floor protectors, namely felt pads, safety eye glasses, safety eye guards, steel squares, filter masks, safety scrapers, door stops, cable ties, siphon pumps, stretch cords, sand paper, carpenters' pencil sharpeners, scissors, electrical tapes, duct tapes, packing tapes, masking tapes, fiberglass tapes, funnels, screws, anchors, hooks, nails, electrical terminals, crimping tools, putty knives, drop cloths, wire brushes and paint brushes, padlocks and combination locks, wires, wire connectors, bolts, hinges, thermometers, door pulls, sewing kits, bicycle repair kits, eyeglass repairs kits, door knobs, clothesline pulleys, clothesline spreaders, twine, push pins, squeegees, mini blind

cleaners, wrenches, paint trays, grommet tool sets, displays signs and cards.



[2] The Applicant disclaims the right to the exclusive use of the word TOOL apart from each trade-mark as a whole. Both trade-marks will hereinafter be referred to as the Marks.

[3] The applications were advertised for opposition purposes in the *Trade-marks Journal* of March 1, 2006. On March 28, 2006, Greapo Power Tools (Suzhou) Co. Ltd. filed a statement of opposition against each application. The Opponent subsequently obtained leave to file amended statements of opposition to reflect Positec Group Limited as the new owner of application Nos. 1171658 and 1150634 and successor-in-title of Greapo Power Tools (Suzhou) Co. Ltd. Positec Group Limited will hereinafter be referred to as the Opponent.

[4] The Applicant filed and served a counter statement in each opposition, and subsequently obtained leave to file an amended counter statement in each opposition.

[5] In support of its oppositions, the Opponent filed two affidavits of Marta Tandori Cheng, an affidavit of Michael Russell and an affidavit of Tom Duncan. In support of its applications, the Applicant filed the affidavits of Caroline Guy, Seymour Samberg and Louise Turgeon. Cross-examinations were conducted of Caroline Guy, Seymour Samberg, and Louise Turgeon, and the cross-examination transcripts, exhibits, undertakings, advisements and refusals all form part of the record in these proceedings. No reply evidence was filed.

[6] Both the Applicant and the Opponent filed a written argument for each opposition. An oral hearing was not held.

[7] The Opponent's grounds of opposition in each case were basically identical and may be summarized as follows:

- the Applicant is not the person entitled to the Marks in view of the provisions of s. 16(1)(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) in that as of the Applicant's dates of first use, the Marks were confusing with the trade-marks WORX, application No. 1150634, and/or WORX and Design, application No. 1171658, which had been previously filed by the Opponent's predecessor-in-title and which were pending as of the date of advertisement of the Marks;
- the applications do not conform to the requirements of s. 30(b) of the Act in that the applications do not contain the dates from which the Applicant has used the Marks in Canada in association with each of the general classes of wares described in the application, and the Applicant has not used the Marks with the wares since the alleged date of first use of May 5, 2003, if at all; and
- the Marks are not distinctive within the meaning of s. 2 of the Act in that the Marks do not actually distinguish the wares in association with which they have allegedly been used, nor are adapted to distinguish them, namely from the hand and power tools of the Opponent which have been sold and made known in Canada by the Opponent or its predecessor-in-title in association with the marks WORX and or WORX and Design.

Summary of the Opponent's Evidence

[8] Ms. Cheng identifies herself as a trade-mark agent working for the Opponent's trade-mark agent firm. Attached to her first affidavit are copies of the Opponent's application Nos. 1,171,658 and 1,150,634, for the trade-marks WORX and WORX and Design, both standing in the name of the Opponent. Application No. 1,171,658 for the mark WORX (shown below) was filed March 26, 2003, for the following wares: Lawn mowers, grass trimmers, hedge trimmers; woodworking machines; saws (machines); drilling machines; drill bits, saw blades; drills.



Application No. 1,150,634, for the mark WORX and Design (shown below), was filed August 28, 2002, for the following wares: Lawn mowers, grass trimmers, hedge trimmers; woodworking machines; saws (machines); electric hammers; mechanically operated hand-held tools, namely, electric screwdrivers.



[9] In her second affidavit, Ms. Cheng discusses the results of various Internet searches. Her evidence shows that in some locations on the Applicant's website, ToolWorx is referred to as one word as opposed to as two words. Further, an alleged printout of the Applicant's website extracted on October 27, 2006, suggests that the ToolWorx brand was not officially launched by the Applicant until January of 2004. Finally, additional printouts from the Applicant's website list some of the applied for wares as "new products", and some of the other applied for wares are not mentioned at all.

[10] Mr. Russell identifies himself as the Canadian Sales Manager for Positec USA, the North American distributor for power tools manufactured by the Opponent. In his experience, it is routine in the industry to sell hand tools and power tools side-by-side in the tool areas of Canadian hardware stores such as Canadian Tire, Rona Home Improvement and the Home Depot. He further explains that he attends the same North American Hand and Power Tool Trade-Shows as the Applicant. Finally, from at least May 2004 until May 2006 he was unaware of any hand tools or other goods sold in Canada by the Applicant under either of the Marks.

[11] Mr. Duncan identifies himself as the President of Positec U.S.A. Inc., the exclusive North American distributor for garden tools, hand tools and power tools manufactured and sold by the Opponent, as well as its affiliate, Greapo Power Tools (Suzhou) Co. Ltd. He explains that both the Opponent and its predecessor-in-title have licensed Positec U.S.A. Inc. to use the WORX trade-mark in Canada, and maintain care and control over the nature and quality of the goods sold thereby in association with the WORX trade-marks. Positec U.S.A. Inc. began selling hedge clippers, lawn trimmers and lawn mowers marked with the WORX trade-mark under

license as of March 5, 2003. As of October 1, 2006, the Opponent began selling power tools marked with its WORX trade-mark in Canada. Attached as Exhibit C to his affidavit is a copy of a page in the 2006 Canadian Tire catalogue which illustrates the WORX garden tools sold and distributed by Positec U.S.A. Inc. in Canada. As Exhibit F, Mr. Duncan has attached printouts from web pages of *www.costco.ca* advertising WORX branded power tools in Canada and showing how the mark appears with the wares. Mr. Duncan states that as of December 2006, the Opponent's sales of power tools have exceeded \$2.2 million. The Opponent has also spent over \$100,000 in advertising and promoting its WORX tools in Canada since December 2006, and examples of such advertising are also attached to his affidavit. While Mr. Duncan lists the publications in which advertisements or articles featuring the Opponent's WORX branded tools have appeared, he does not provide the circulation figures for these publications in Canada.

Summary of the Applicant's Evidence

[12] Ms. Guy identifies herself as an employee of CRAC Centre de Recherches et d'Analyses sur les Corporations. She provides the results of a search conducted on a SAEGIS database for the word WORX or WORKS in connection with tools and other wares. Printouts of the CIPO database for similar marks are also provided.

[13] Ms. Turgeon is account manager for the Applicant. Attached as Exhibit 1 to her affidavit are copies of printouts of merchandise samples displaying the Marks which she states have been distributed to hardware stores including RONA, Sodisco-Howden, Canac Marquis and BMR. She explains that in her experience, it is common in the industry to distribute samples, sketches and presentations with merchandise to the clients. Attached as Exhibit 2 to her affidavit are samples of invoices, four of which bear the date of May 3, 2003, and refer to "samples" with a selling price of \$0 U.S. dollars. Ms. Turgeon confirms that the wares were distributed "à titre d'échantillon avec leur emballage portant la marque". At paragraphs 8 and 9 of her affidavit, she states that she is unaware of any instances of confusion between the Marks and any other trade-mark.

[14] She explains on cross-examination that the Applicant gives samples to customers who may have already approved the purchase of the product, or they have not yet made a commitment and the Applicant is soliciting to get the business (see Turgeon cross-ex., Qs. 99 –

106). She was also able to link the TOOL WORX tools to the invoices because of the SKU number. In this regard, she explains that the TOOL WORX items start with the numbers 3-0.

[15] Mr. Samberg is President of the Applicant. Mr. Samberg states in his affidavit that the Applicant has used the Marks in Canada since at least as early as May 3, 2003, without interruption. He explains at paragraph 7 that his company sells wares bearing the Marks to hardware stores, such as RONA, Sodeco Howden, Canac Marquis and BMR. The annual sales of the wares bearing the Marks have ranged between \$50,000 and \$220,000 between 2003 and 2007. Attached to his affidavit as Exhibit 1 are samples of invoices dated between May 3, 2003 and 2007, reflecting both the distribution of samples (as previously explained by Ms. Turgeon) and the sale and delivery by his company of wares bearing the Marks. As Exhibits 2-4 of his affidavit are samples of labels showing the Marks as used in Canada, photos of wares bearing the Marks, and catalogues showing only the tools and hardware available for sale under the Marks. He also lists the trade shows his company has attended between 2004 and 2007 where the company has promoted its products. Printouts from his company's website, where tool products are also sold under the Marks, are attached as Exhibit 5 to his affidavit. Exhibit 5 also shows a copy from a page of the Applicant's website dated September 25, 2007, which shows that there was a news update posted in May 2003 which stated that the ToolWorx brand was officially launched. Finally, Mr. Samberg states that he is not aware of any case of confusion between the Marks and the Opponent's marks.

[16] On cross-examination, Mr. Samberg was unable to explain the discrepancy between the Opponent's evidence that in 2006 the Applicant's website stated that the ToolWorx brand was listed as being launched in January 2004 and the Applicant's evidence that in 2007 the Applicant's website stated that the ToolWorx brand was being launched in May, 2003. Mr. Samberg also stated the following on his cross-examination at Qs. 340 – 341:

Q. 340 – Do you have any sales on or before May 5, 2003?

A. 340 – Of what, Tool Worx?

Q. 341 – Tool Worx products.

A. 341 – No, I wouldn't think so.

Preliminary Issue

[17] The Opponent has objected to the admissibility of the exhibits attached to both the Turgeon and Samberg affidavits for not being notarized. In considering the admissibility of such evidence, I had regard to the following comments from former Chairman Partington in *Beiersdorf AG v. Future International Diversified Inc.* (2002), 23 C.P.R. (4th) 555 (T.M.O.B.):

The opponent raised a number of objections to the applicant's evidence in its written argument and during the oral hearing. First, the opponent alleged that the exhibits accompanying the Monahoyios affidavit are inadmissible as they have not been identified and endorsed by the Commissioner for Oaths who commissioned the affidavit. Although a court would likely rule such exhibits inadmissible [see, for example, *Andres Wines Ltd. v. E. & J. Gallo* (Fed. C.A.), at pp. 135 -136], the Registrar does not strictly adhere to the rules of practice of the Federal Court relating to the admissibility of exhibits. Thus, the Registrar will consider unnotarized exhibits admissible where no objection is raised by the other party or where an objection is raised at such a late stage of the opposition that the party which submitted the evidence has little or no opportunity to correct the deficiency.

[18] In the present case, both affidavits were properly sworn before a commissioner of oaths but the exhibits attached to them were not. In this regard, the exhibits were simply referred to as Exhibit 1 or Pièce 1. The Opponent raised the admissibility of the exhibits in its written argument in April, 2009. In my view, the Applicant has had more than sufficient time since receiving the written arguments to correct the deficiencies in its evidence. I therefore find the exhibits to the Turgeon affidavit and Samberg affidavit inadmissible in each opposition.

Section 30(b) Ground of Opposition

[19] The Opponent pleads as its second ground of opposition in each case that the applications do not conform to the requirements of s. 30(b) in that the Applicant's trade-marks have not been used in Canada in association with the wares listed in the applications since the dates of first use alleged in the applications. To the extent that the relevant facts with respect to this ground of opposition are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to this ground of opposition is lower, and can be met by reference to the Applicant's own evidence [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R.

(3d) 84 (T.M.O.B.); *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)). Once the Opponent's burden has been met, the Applicant must show continuous use of the Marks in the normal course of trade since the date claimed: see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.) at 262.

[20] In the present case, the Opponent cannot point to inconsistencies in the exhibits attached to the Turgeon and Samberg affidavits to meet its burden under this ground as those exhibits are not of record. However, in view of the other evidence filed by the Opponent combined with the evidence received on cross-examination, I am satisfied that the Opponent has cast doubt on the veracity of the Applicant's claimed dates of first use. In this regard, Mr. Samberg on cross-examination stated that there were no sales of ToolWorx products on May 5, 2003, which is the Applicant's claimed date of first use for both of its marks. Further, on cross-examination, Mr. Samberg was unable to explain the discrepancy between the Opponent's evidence and the Applicant's evidence regarding the launch dates of the ToolWorx products as they appeared on the Applicant's website. I therefore find that the Opponent has met its burden under this ground of opposition in both oppositions.

[21] It was therefore incumbent on the Applicant to evidence its claimed dates of first use which it has failed to do, primarily because the Samberg and Turgeon exhibits are not admissible as evidence. Had these exhibits been admissible, the outcome of this ground may have been different. In this regard, both Mr. Samberg and Ms. Turgeon attach as exhibits to their affidavits samples of invoices dated from May 3, 2003 to 2007 initially reflecting the distribution of samples of products and later, purchased goods. Also attached are examples showing how the Marks are used on the products or on the packaging.

[22] The issue would have then been whether or not the shipment of sample products by the Applicant to its Canadian customers constituted use of the Marks in the normal course of trade. In considering this issue, I have had regard to the following comments of former Board Member Martin in the decision *Canadian Olympic Assn. v. Pioneer Kabushiki Kaisha* (1992), 42 C.P.R. (3d) 470 [*Pioneer Kabushiki*]:

Where samples are shipped from a company to its Canadian distributor in advance of regular shipments of the goods for marketing, informational and promotional purposes and this is the regular practice of the parties and where the Canadian distributor then takes delivery of regular shipments of the goods and makes normal commercial sales of the goods, I consider that the transfer of the possession of the sample goods to the Canadian distributor constitutes use of the trade-mark in the normal course of trade. In other words, the facts in this case support the conclusion that the transfer of the sample goods was part of a dealing in the goods for the purpose of acquiring goodwill and profits from the trade-marked goods. Whether or not the sample goods themselves were eventually sold is irrelevant. In this regard, reference may be made to the decisions in *Lin Trading Co. v. CBM Kabushiki Kaisha* (1988), 21 C.P.R. (3d) 417, [1989] 1 F.C. 620, 20 C.I.P.R. 1 (C.A.); affirming 14 C.P.R. (3d) 32, [1987] 2 F.C. 352, 10 C.I.P.R. 260 (T.D.); affirming 5 C.P.R. (3d) 27 (T.M. Opp. Bd.) at p. 32, and *Argenti Inc. v. Exode Importations Inc.* (1984), 8 C.P.R. (3d) 174 (F.C.T.D.) at p. 185.

[23] In the present case, Ms. Turgeon states the following in her affidavit : “il est courant dans l’industrie de la quincaillerie de distribuer des échantillons, des dessins et des présentations avec des marchandises aux clients afin de les faire connaître l’apparence des ensembles et susciter des achats de leur part”, and confirms this on cross-examination. Therefore, similar to the situation in *Pioneer Kabushiki, supra*, the samples in the present case are used for marketing, informational and promotional purposes with a view to obtaining orders from customers. The transfer of the samples was part of a dealing in the goods for the purpose of acquiring goodwill and profits from the goods. Clearly, from the sales figures provided by Mr. Samberg, the transfer of the samples resulted in many sales of the Applicant’s TOOLWORX and TOOLWORX and Design products. I further note that the Applicant was not required to show use of its Marks with each of the applied for wares as of the date claimed.

[24] Based on the evidence as a whole, and despite the discrepancies in the evidence, I would have considered that the Applicant did establish on a balance of probabilities that its Marks had been used in Canada since at least as early as May 5, 2003, as claimed.

Section 16(1)(b) Ground of Opposition

[25] The Opponent’s first ground of opposition, as previously noted, was based on s. 16(1)(b) of the Act. The material date for assessing the s. 16(1)(b) ground is typically the claimed date of first use [s. 16(1)(b)]. However, where an opponent has successfully challenged an applicant’s

claimed date of first use under a s. 30(b) ground of opposition, the material date for assessing a s. 16(1) ground of opposition becomes the Applicant's filing date [see *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 6 C.P.R. (2d) 278 (T.M.O.B.); *Everything for a Dollar Store (Canada) Inc. v. Dollar Plus Bargain Centre Ltd.* (1998), 86 C.P.R. (3d) 269 (T.M.O.B.)]. Accordingly, the material date for determining the likelihood of confusion with respect to the Marks in each case is May 14, 2003.

[26] An opponent relying upon a trade-mark application in challenging an applicant's entitlement to registration under s. 16(1)(b) of the Act, need only establish that the trade-mark application being relied upon had been previously filed in Canada and that the application was pending at the date of advertisement of the applicant's application [see s. 16(4) of the Act]. In the present case, the Opponent has discharged the initial burden upon it as its trade-mark applications were filed August 28, 2002, and March 26, 2003, and were both pending as of the Applicant's advertisement dates for each mark.

test for confusion

[27] 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.

[28] 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 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.)].

[29] Even though the Applicant's marks have a unique spelling, when sounded they are phonetically equivalent to the words "tool works" which suggests that the wares are in good working order. As such, the Marks are weak marks, possessing little inherent distinctiveness [see *Toys "R" Us (Canada) Ltd. v. Manjel Inc.* (1992), 46 C.P.R. (3d) 135 (T.M.O.B.), aff'd 24 C.P.R. (4th) 470 (F.C.T.D.)]. The Opponent's marks are also not inherently strong since they too are very suggestive of the character of the applied for wares.

[30] With respect to the extent to which the trade-marks have become known, neither party has shown use or making known of their marks prior to the Applicant's filing date. This factor therefore does not favour either party.

[31] Similarly, under s. 6(5)(b), since no party has shown use of their marks prior to the Applicant's filing date, this factor does not favour either party.

[32] With respect to the nature of the parties' wares, the applied for wares include a variety of hand tools for use with wood and metal while the Opponent's applied for wares include garden, wood working and power tools. There is some overlap between the wares as the Opponent's wares also include hand tools and mechanically operated hand-held tools.

[33] As for the parties' channels of trade, the Applicant's evidence shows that the Applicant's goods are sold through Canadian home improvement stores such as Rona Hardware and are directed to the average consumer for home use. The Opponent's evidence shows that its tools are directed to individual handymen and consumers, and are sold through similar stores such as Canadian Tire and home improvement stores. The Russell affidavit further establishes that, in Canada, hand tools and power tools are sold side-by-side in the tool areas of hardware stores such as Home Hardware, Home Depot and Rona home improvement stores. The parties' channels of trade would therefore be similar if not identical.

[34] With respect to the degree of resemblance between the marks, the first component of a mark is often considered more important for the purpose of distinction. However, when that component 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.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37

C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)].

[35] In the present case, both of the Opponent's marks are the word WORX, one which appears in bold capital letters in a rectangular box design and the other in a bold shadow effect on top of an oval design. The Applicant has adopted the entirety of the Opponent's marks as the dominant component of both of its Marks. The only difference is that the Marks have added the word TOOL in front of the word WORX, and a house design in the TOOL WORX and Design mark. The word TOOL is not particularly strong, however, because it is descriptive of the applied for wares. The trade-marks are therefore quite similar in appearance and sound. The ideas suggested by the marks are also similar, as the Opponent's marks suggest something that is in good working order while the Marks specifically suggest tools that are in good working order.

[36] As a further surrounding circumstance, there is the evidence introduced by the Applicant concerning the state of the trade-mark register. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*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.)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[37] Ms. Guy located many Canadian trade-mark registrations for marks that incorporate "WORKS" as a suffix in connection with "tools and other hardware products likely to be sold in hardware stores". The searches undertaken by Ms. Guy, however, were conducted in September, 2007, more than 4 years subsequent to the material date for considering this ground of opposition. In any event, of the approximately 18 relevant registrations that cover wares that overlap with those of the Applicant and Opponent, I note that about 10 of the marks were registered prior to the Applicant's filing date. In my view, the existence of 10 registrations without evidence of use of the registered marks is insufficient to allow me to make any meaningful conclusions about the common adoption and use in the market-place of trade-marks incorporating the word "WORKS" for wares of the type of issue in the present case. In this

regard, see the opposition decision in *Espirit de Corp. v. S.C. Johnson & Son Inc.* (1984), 3 C.P.R. (3d) 451.

[38] As a final surrounding circumstance, the Applicant has also contended that there has been no evidence of actual confusion as between the Opponent's marks and the Marks. In view that the Opponent had not even begun using its marks in Canada as of the filing date of the applications, I do not consider such argument particularly persuasive.

[39] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities between the marks, wares and trades of the parties, I find that the probability of a reasonable likelihood of confusion between the marks in issue is evenly balanced with the probability of no reasonable likelihood of confusion. Accordingly, the issue must be decided against the Applicant as the legal onus is on the Applicant to establish that, on a balance of probabilities, there is no reasonable likelihood of confusion. Accordingly, the s. 16(3)(b) ground of opposition succeeds.

Section 38(2)(d) Ground of Opposition

[40] As its final ground of opposition, the Opponent pleaded that the Marks are not distinctive of the Applicant in that they do not actually distinguish the wares in association with which they have allegedly been used by the Applicant from the wares of others, namely from the hand and power tools of the Opponent which have been sold in Canada and made known in Canada in association with the marks WORX and/or WORX Design. The material date with respect to this ground is the date of filing of the oppositions, i.e. March 22, 2006 [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)]. In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the oppositions its trade-marks had become known sufficiently to negate the distinctiveness of the Marks [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

[41] From the evidence furnished, I am not satisfied that the Opponent has shown that either of its marks had become known sufficiently as of the filing date of the statements of opposition to negate the distinctiveness of the Marks. This ground is therefore unsuccessful.

Disposition

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

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office