

**IN THE MATTER OF AN OPPOSITION  
by D.A.M. Neue Deutsche Angelgerate  
Manufaktur Int. GmbH to application no.  
1177439 for the trade-mark QUICKFIRE  
filed by Shimano Inc.**

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On May 8, 2003, Shimano Inc. filed an application to register the trade-mark QUICKFIRE based on use in Canada since at least as early as August 5, 1982, in association with the wares

fishing tackle, namely reels for fishing and a number of other wares related to fishing. The application was subsequently amended to delete the other related wares.

The Examination Section of the Trade-marks Office objected to the subject application on the basis that the applied for mark QUICKFIRE was confusing with trade-mark registration no. 162991 for QUICK covering the wares “fishing reels.” The applicant responded by arguing, among other things, that the applied for mark was visually and phonetically different from the cited mark, and that other marks comprised of the component QUICK, for use in association with fishing equipment, were already registered. The Examination Section accepted the applicant’s submissions and the applied for mark was advertised for opposition purposes in the *Trade-marks Journal* issue dated June 16, 2004.

The subject application was opposed by D.A.M. Neue Deutsche Angelgerate Manufaktur

Int. GmbH, the owner of the above mentioned mark QUICK, on March 4, 2005. A copy of the statement of opposition was forwarded by the Registrar of Trade-marks to the applicant on March 29, 2005, as required by Section 38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement.

The opponent's evidence consists solely of a certified copy of its above mentioned trade-mark registration no. 162991. The applicant's evidence consists of the affidavit of Tom Brooke, Vice President, Operations for Shimano Canada Ltd., a wholly owned subsidiary of the applicant. Only the applicant submitted a written argument and only the applicant attended at an oral hearing.

#### STATEMENT OF OPPOSITION

Various grounds of opposition are pleaded, namely that (i) the application does not comply with Section 30(b) of the *Trade-marks Act* because the mark was not used since the alleged date of first use, (ii) the applied for mark is not registrable, pursuant to Section 12(1)(d) of the *Act*, because it is confusing with the opponent's trade-mark registration for QUICK, (iii) the applicant is not entitled to register the applied for mark QUICKFIRE, pursuant to Section 16(1) of the *Act*, because it is confusing with the opponent's mark QUICK previously used in Canada, and (iv) the applied for mark QUICKFIRE is not adapted to distinguish the applicant's wares from the wares of the opponent sold under its QUICK mark, pursuant to Section 2.

## LEGAL ONUS AND EVIDENTIAL BURDEN

The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. In the instant case, the only ground of opposition supported by the evidence (that is, the certified copy of registration no. 162991) is the ground alleging non-registrability.

## APPLICANT'S EVIDENCE

Mr. Brooke's evidence, as it relates to this jurisdiction, may be summarized as follows. The applicant Shimano began making bicycle parts in Japan in 1921. Since then the applicant has grown from a sole proprietorship to a multi-national publicly traded company. The Fishing Tackle Division of the company was launched in 1970. Shimano exhibited its line of fishing tackle in a trade-show in the United States in 1978 at which time its sales began to increase substantially. In 1982 the applicant invented a novel baitcasting reel which it named QUICKFIRE, which reel was introduced to the public in 1983. Shimano Canada was established

in 1983 as the Canadian distributor for Shimano products including the QUICKFIRE reel. Similar distributorships were established in various other countries. Mr. Brooke describes the QUICKFIRE reel in paragraph 16 of his affidavit:

16. One of the best examples of Shimano's fishing product innovation and precision engineering is the QUICKFIRE technology.' The design of the QUICKFIRE product makes it possible to use one hand to cast the bait, speeding up the casting process, and permitting the fisherman to reach down, pick up the line and make a cast, all in one fast and easy one-handed motion. It also simplifies night fishing by removing the need to look at the reel to make a cast, and makes cold weather fishing more enjoyable because it keeps one hand warm and dry for longer periods of time.

The mark QUICKFIRE is prominently displayed on various models of the applicant's fishing reels as well as on packaging for various models of fishing rods sold together with a QUICKFIRE reel.

In 1995 sales of QUICKFIRE reels in Canada amounted to \$.5 million, rising gradually to \$1.5 million in 1999 and 2000, and thereafter gradually declining to \$.6 million in 2004. The applicant's fishing tackle products are sold through 739 dealers and retailers across Canada. The applicant advertises its fishing tackle including the QUICKFIRE reel in product catalogues, consumer and trade magazines, point of sale posters, at its website and at consumer sporting goods shows across Canada.

Mr. Brooke's observations regarding the opponent D.A.M. Neue Deutsche Angelgerate

Manufaktur Int. GmbH appear at paragraphs 38 and 39 of his affidavit:

38. I am aware of D.A.M. Neue Deutsche Angelgerate Manufaktur Int. GmbH (the Opponent) and the QUICK D.A.M. spinning reels. To my knowledge, during the twentythree years I have worked for Shimano Canada Ltd., the QUICK D.A.M. spinning reels have only been available in Canada in very limited distribution, unlike Shimano Inc.'s QUICKFIRE spinning reel. To my knowledge there are no formal distribution channels in Canada that currently make the QUICK D.A.M. products available to the public or to retailers.
39. Although I have seen many of Shimano Inc.'s competitors at the numerous industry trade shows I have attended in Canada and the United States, I do not recall ever seeing a direct corporate presence for the Opponent or its QUICK D.A.M. products at any of these shows. It has been my impression that the Opponent is not a major player in the Canadian market for fishing tackle, unlike the Applicant in the present Opposition.

#### MAIN ISSUE & TEST FOR CONFUSION

As discussed earlier, the sole issue for decision is whether the applied for mark QUICKFIRE used in association with fishing reels is confusing with the opponent's mark QUICK registered for the same wares. The material date to assess the issue of confusion, with respect to the ground of opposition based on Section 12(1)(d), is the date of decision: for a review of material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.).

The test for confusion is one of first impression and imperfect recollection. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to

all the surrounding circumstances, including those enumerated in Section 6(5) of the *Act*, namely: the inherent distinctiveness of the marks 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; the degree of resemblance in appearance or the sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors 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* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

#### *Consideration of Section 6(5) Factors*

The applied for mark QUICKFIRE possesses a fair degree of inherent distinctiveness since it is a coined word. However, the distinctiveness of the mark is lessened to the extent that the mark is suggestive of a desirable feature of a fishing reel, namely that it permits rapid deployment. The opponent's mark QUICK possesses less inherent distinctiveness than the applied for mark, and is also suggestive of the same desirable quality for the opponent's wares. The evidence of record shows that the applied for mark QUICKFIRE had acquired some reputation in Canada through sales and advertising under the mark since at least 1995. There is no evidence to show that the opponent's mark QUICK has acquired any reputation in Canada. The length of time that the marks in issue have been in use favours the applicant. In this regard, Mr. Brooke's evidence is to the effect that the applicant has been using its mark QUICKFIRE in Canada since 1983 while the opponent has not evidenced any continuing use of its mark. I have noted from the opponent's registration for its mark, which is in evidence, that the mark QUICK

was registered in 1968 on the basis of use of the mark since 1952. However, such evidence purporting to establish use of a mark, without anything more, is insufficient to establish anything other than use of the mark for a short duration in 1952.

The nature of the parties' wares is the same, however, it appears from Mr. Brooke's evidence that the opponent's wares are sold through limited channels of distribution different from the applicant's channels of distribution. The resemblance between the marks QUICK and QUICKFIRE in appearance and in sounding owes to the component QUICK common to each mark. In this regard, it is the first portion of a mark that is the more important for the purposes of distinction. However, in a case such as this where the first portion is fairly non-distinctive, the importance of the first portion is diminished. The marks suggest ideas that are more dissimilar than alike. In this regard, the opponent's mark suggests the idea of "rapid" while the opponent's mark suggests "rapid fire."

#### DISPOSITION

Considering the foregoing, and keeping in mind that (i) small differences may suffice to distinguish between marks of low inherent distinctiveness (see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R.(2d) 154 (F.C.T.D.)), and (ii) the opponent's participation in this proceeding has been minimal, I find that the applicant has shown, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark QUICKFIRE

and opponent's mark QUICK at the material date which is the date of decision. Accordingly, the opposition is rejected.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 29<sup>th</sup> DAY OF, OCTOBER, 2008.

Myer Herzig,  
Member,  
Trade-marks Opposition Board