

**IN THE MATTER OF AN OPPOSITION
by Electrolux Home Products, Inc. and
Husqvarna Outdoor Products Inc. to
application no. 1168028 for the trade-mark
WEEDERATOR filed by 2941538 Canada Inc.**

On February 18, 2003, the applicant 2941538 Canada Inc. filed an application to register the trade-mark WEEDERATOR, based on proposed use in Canada, for the following wares:

lawn and garden tool namely: weed remover.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 17, 2003, and was opposed by Electrolux Home Products, Inc. on February 10, 2004. The Registrar forwarded the statement of opposition, which relied on two trade-mark registrations for the mark WEED EATER, to the applicant on February 19, 2004, pursuant to Section 38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement. During the course of this proceeding, the original opponent Electrolux assigned its WEED EATER trade-marks to Husqvarna Outdoor Products Inc. Electrolux then requested leave to amend the statement of opposition to add Husqvarna as a joint opponent. The request for leave was supported by certified copies of trade-mark registrations for WEED EATER showing Husqvarna as the current owner of the marks. The applicant did not object to Electrolux' request for leave which the Board granted in a ruling dated January 30, 2007. Only the opponent filed evidence and only the opponent was represented at an oral hearing. Neither party submitted a written argument.

STATEMENT OF OPPOSITION

The grounds of opposition, as amended, allege that:

- (a) the applied for mark WEEDERATOR is not registrable, pursuant to Section 12(1)(d) of the *Trade-marks Act*, because it is confusing with Husqvarna's trade-marks WEED EATER, registration nos. 213324 and 304355 covering, among other things, various power tools for lawn care including weed and grass cutting and mowing,
- (b) the applicant is not entitled to register the applied for mark WEEDERATOR, pursuant to Section 16(3)(a), because as of the date of filing the application the mark WEEDERATOR was confusing with the mark WEED EATER previously used or made known by Electrolux and by the opponents' predecessors in title in association with the wares specified in registration nos. 213324 and 304355,
- (c) the application does not conform to Section 30 because the applicant could not have been satisfied that it is entitled to use the applied for mark in view of the prior adoption, use and registration by the opponents of the above mentioned WEED EATER trade-marks,
- (d) the applied for mark WEEDERATOR is not adapted to distinguish the applicant's wares from the wares of the opponents for the reasons set out in paragraphs (a), (b) and (c) above.

OPPONENTS' EVIDENCE

The opponents' evidence consists of the affidavit of George Hawranko, an executive with Electrolux. His evidence may be summarized as follows. Electrolux and its predecessors in title have used the trade-mark WEED EATER in Canada since 1973. The mark has been affixed to products and packaging for products sold in Canada. Such products include trimmers, edgers, tractors, mowers and blowers. Exhibit B attached to Mr. Hawranko's affidavit illustrates the various tools Mr. Hawranko refers to in his testimony. According to Mr. Hawranko, WEED EATER is "the most recognized brand in outdoor equipment on the market today." Sales in Canada of products sold under the mark WEED EATER averaged about \$3.56 million annually

in the years 1998 and 1999, thereafter rising to about \$17.67 million annually for the years 2000 - 2003 inclusive.

WEED EATER products are sold through box stores such as Canadian Tire, Wal-Mart and Rona; through hardware retailers such as Home Hardware; and through co-ops such as Tru Serv and Federated Co-op. According to Mr. Hawranko, WEED EATER products are sold to “all areas of the Canadian lawn and garden market . . .” Advertising and promotion of WEED EATER products have exceeded \$2 million annually for the five year period 2000 to 2005. Copies showing examples of print advertising are attached as Exhibit C to Mr. Hawranko’s affidavit.

MAIN ISSUE

The determinative issue in this proceeding is whether the applied for mark WEEDERATOR is confusing with the opponent Husqvarna’s mark WEED EATER. The material dates to assess the issue of confusion are (i) the date of my decision with respect to the ground of opposition alleging non-registrability, (ii) the date of filing the application, that is, February 8, 2003, with respect to the grounds of opposition alleging non-entitlement and non-compliance with Section 30; and (iii) the date of opposition, that is, February 10, 2004, with respect to the ground of opposition alleging non-distinctiveness: for a review of case law concerning 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.). In the instant case, nothing turns on whether the issue of confusion is assessed at a particular material date.

LEGAL ONUS

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Trade-marks Act*, between the applied for mark WEEDERATOR and the opponent Husqvarna's mark WEED EATER. The presence of an 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: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Trade-marks Act*: 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 opponent Husqvarna's mark WEED EATER possesses a fairly low degree of inherent distinctiveness as the mark is suggestive of the function of the opponents' wares, that is, to keep a lawn free of weeds. The applied for mark WEEDERATOR also possesses a low degree of inherent distinctiveness as the mark suggests that the applicant's products function as a "weed

terminator” to keep a lawn free of weeds. I conclude from the evidence that the mark WEED EATER had acquired a substantial reputation at all material times, while the applied for mark cannot claim any acquired reputation at any material time. The parties’ wares are very similar and I would expect that they would be sold side by side through the same retail outlets. The length of time that the parties’ marks have been in use favours the opponents as the mark WEED EATER was used in Canada for about 30 years prior to the filing of the present application. In my view, the parties’ marks in their entirety resemble each other to a fair extent visually and in sounding. The marks in issue also suggest the same idea of “eliminating weeds” or “getting rid of weeds.” Further, the marks in issue are prefixed by the component WEED, and it is the first portion or first syllable of a mark that is the more important for the purposes of distinction: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 C.P.R.(2d) 183 at 188 (F.C.T.D.).

DISPOSITION

Considering all of the above, I find that the applicant has not met the onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks in issue.

The subject application is therefore refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 25th DAY OF FEBRUARY, 2008.

Myer Herzig,
Member, Trade-marks Opposition Board