



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

**Citation: 2012 TMOB 6**  
**Date of Decision: 2012-01-09**

**IN THE MATTER OF AN OPPOSITION  
by Ruko of Canada Limited to  
application No. 1,335,693 for the trade-  
mark BENCHMARK SHARK in the  
name of Home Hardware Stores Limited**

[1] On February 15, 1997, Home Hardware Stores Limited (the Applicant), filed an application for the trade-mark BENCHMARK SHARK (the Mark) based upon proposed use of the Mark in Canada. The statement of wares currently reads: wire stripper and utility knife.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 28, 2007.

[3] On December 28, 2007, Ruko of Canada Limited (the Opponent) filed a statement of opposition against the application. The grounds of opposition, as amended September 4, 2008, are the following: the Mark is not registrable pursuant to s. 12(1)(d), the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a), and the Mark is not distinctive. Each of these grounds is based on confusion with the Opponent's use and registration of its SHARK trade-mark (registration No. TMA220,199), registered in association with: diving knives, hunting knives and utility knives.

[4] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[5] The Opponent's evidence consists of the affidavit of Renate Koppe, Vice President of the Opponent. The Applicant's evidence consists of the affidavit of Jessica Ryan, Articling Student with the Applicant's agent. Only Ms. Koppe was cross-examined, and her cross-examination transcript, exhibits and replies to undertakings form part of the record.

[6] Both the Applicant and the Opponent filed a written argument. An oral hearing was conducted at which both parties were represented.

### Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[8] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(b)/s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(3) - the filing date of the application [see s. 16(3)];
- s. 38(2)(d)/s. 2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

### Grounds of Opposition

#### *Section 38(2)(b)/Section 12(1)(d) – Non-registrability*

[9] The s. 12(1)(d) ground of opposition turns on the issue of the likelihood of confusion between the Mark and the Opponent's SHARK mark, registration No. TMA220,199.

[10] I note that the Opponent's initial burden with respect to the s.12(1)(d) ground has been satisfied because registration No. TMA220,199 is in good standing.

*test for confusion*

[11] 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. 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 or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

[12] The Supreme Court of Canada has discussed the appropriate process for assessing all of the surrounding circumstances in determining whether two trade-marks are confusing in its decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401. It is with these general principles in mind that I shall now assess all of the surrounding circumstances.

*s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known*

[13] The Opponent's mark is not inherently strong because the word "shark" is an ordinary dictionary word that has a suggestive connotation when used in association with knives and related goods. While the Applicant's Mark also includes the component "shark", I agree with the Applicant that the Mark is slightly more inherently distinctive than the Opponent's mark because of the additional component BENCHMARK which has no meaning in association with the applied for wares.

[14] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The evidence of the Opponent's affiant, Ms. Koppe, provides the following information about the use of the Opponent's mark with its registered wares:

- the Opponent commenced use of the trade-mark SHARK in association with a line of floating, flexible knives, comprising both filleting knives and hunting knives in 1976; photographs of the original packaging of the knives and of the knives themselves were attached as Exhibits B and C to Ms. Koppe's affidavit;
- the Opponent's knives have been sold in sporting goods stores and hardware stores across Canada and national retail chain locations including Canadian Tire, Rona, Zellers and also to Home Hardware distribution centers for distribution to individual Home Hardware stores;
- total sales of the Opponent's registered wares in Canada from 1977-1988 were \$250,000;
- the Opponent's registered wares almost sold out completely in 1998 because of a dispute with the Opponent's manufacturer and as a result, only a limited quantity of the Opponent's registered wares were available to be sold from 1998-2008 (i.e. 9 dozen) (Koppe cross-examination, qs. 43-45);
- two invoices, each for 4 SHARK knives, dated April 23, 2008, and April 25, 2008, in the name of Ruko Outdoor Products Inc., were introduced as Exhibit E to Ms. Koppe's affidavit; on cross-examination, the witness revealed that the sales came as a result of calling two of its former customers and advising that it had some inventory left if they were interested in taking them (Koppe cross-examination, qs. 52-54); and
- the Opponent's SHARK line of products was advertised in the Opponent's 1993-94 catalogue which was distributed by the Opponent to 800 regular customers; in the 95-96 and 98 catalogue, the Opponent's mark was referenced by product code only.

[15] The Applicant submits that the Opponent has not shown any use of its registered mark SHARK because the evidence shows the mark always appearing with the Opponent's house mark RUKO. The use of a trade-mark in combination with additional words or features

constitutes use of the registered mark if the public as a matter of first impression, would perceive the trade-mark per se as being used. This is a question of fact which is dependent on whether the trade-mark stands out from the additional material and whether the trade-mark remains recognizable [*Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.); *Promafil Canada Ltee. v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.)].

[16] When used on the wares or on the packaging, the evidence shows that the Opponent's mark always appears with the word RUKO, either side by side in the same font, or in a distinctive design where the S of the word SHARK encompasses the word RUKO. The fact that the SHARK trade-mark is not used alone on the knives or on their packaging was confirmed by Ms. Koppe on cross-examination (see Koppe cross-examination, qs. 26-31; Koppe affidavit, Exhibits B, C & D).

[17] The Opponent's mark does appear alone, however, in the body of the two invoices, each for four SHARK brand knives, dated April 23, 2008, and April 25, 2008, in the name of Ruko Outdoor Products Inc., attached to the Koppe affidavit as Exhibit E. I am not sure that this evidence is sufficient on its own to show use of the mark *per se* as there is no information that these invoices accompanied the wares at the time of sale. Further, there is no explanation why the name appearing on the invoices is different from the name of the Opponent. Finally, Ms. Koppe admitted on cross-examination that the two sales came as a result of calling two former clients and asking them if they were interested in taking some left over inventory (see Koppe cross-examination, qs. 52-54). While Ms. Koppe stated that there was no incentive to call the former customers, and the Opponent was "just hoping to get rid of the inventory", I agree with the Applicant that it is possible that these sales may not have been in the normal course of trade.

[18] In any event, as the Opponent submitted, the Opponent was not required to show use of its mark as registered to support its s. 12(1)(d) ground. I would note, however, that in view of the evidence furnished, I cannot conclude that the Opponent's mark, as registered, has become known to any extent in Canada. As the Applicant's Mark is based on proposed use and the Applicant has not shown any use of its Mark since its filing date, this factor does not favour either party.

*s. 6(5)(b) - the length of time each trade-mark has been in use*

[19] The length of time that each mark has been in use does not favour either party.

*s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade*

[20] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares and services that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[21] The parties' wares are similar in that they both comprise knives. They are not identical, however, as the Applicant's wire stripper and utility knife would be considered a "multi-tool" which is different from the Opponent's diving, hunting and filleting knives. It is also relevant that the Opponent, at the time of swearing the Koppe affidavit, was developing a new series of pocket knives bearing the SHARK trade-mark and was planning to expand its SHARK line to include some of the Opponent's sharpeners and utility knives.

[22] As for the channels of trade, the Opponent has filed evidence to establish that it has sold its SHARK brand products in the Applicant's own stores, in addition to department stores and sporting goods stores. The parties' channels of trade would therefore likely overlap.

*s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[23] While the first portion of a mark is often considered to be the most important for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)], the mark must also be considered as a whole [see *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 at 369 (F.C.T.D.)]. In the present case, the marks BENCHMARK SHARK and SHARK resemble each other visually and orally to the extent that the Applicant's Mark includes the Opponent's mark in its entirety. While the component BENCHMARK acts, to some extent, to distinguish the Applicant's Mark from the Opponent's mark, I agree with the Opponent that it is a static word that is not as suggestive to the

consumer as the dominant component SHARK. In my view, the word SHARK suggests that both parties' wares have shark like features (i.e. are sharp like a shark's teeth).

*further surrounding circumstances*

[24] As a further surrounding circumstance, the Applicant relies on the state of the marketplace evidence introduced by Ms. Ryan. Ms. Ryan conducted an investigation of trademarks incorporating the term "shark" used in association with knife and scissor products available for purchase in Canada. Ms. Ryan located the following examples:

- SAMURAI SHARK sharpener purchased at a Canadian Tire store by Ms. Ryan in Ottawa on November 18, 2009;
- THE SHARK tape and bandage cutter available at [www.bigkahuna.ca](http://www.bigkahuna.ca) which was ordered by Ms. Ryan from her office in Ottawa and later received as ordered;
- NEBO SHARK knife available from [www.highlandwoodworking.com](http://www.highlandwoodworking.com) which was ordered by Ms. Ryan from her office in Ottawa and later received as ordered;
- SHARK FIN professional grooming shears available from [www.sharkfinshears.com/grooming](http://www.sharkfinshears.com/grooming) which the company's representative confirmed is available for shipment to Canada; and
- SHARK knife previously available from [www.klassenbronze.com](http://www.klassenbronze.com), a company that sells its products through distributors including in Canada, but later discontinued.

[25] Of the five products located by Ms. Ryan, I agree with the Opponent that the SHARK knife product and the SHARK FIN grooming shears are not relevant because the first product had already been discontinued at the time of Ms. Ryan's search and the evidence that the second product is available for shipment to Canada is hearsay.

[26] Of the three remaining cutting instruments, all of which were purchased by Ms. Ryan, one was purchased in person and two of them were ordered off the Internet. While the online purchases are evidence of the fact that it is possible for Canadians to buy these wares off the Internet, I do not consider this evidence regarding third party marks to be very strong evidence of marketplace use in Canada. This leaves us with the evidence of the SAMURAI SHARK sharpener purchased at a Canadian Tire store in Ottawa. By itself, this evidence is insufficient to show that Canadians are used to distinguishing between SHARK cutting instruments. I therefore

conclude that the Applicant's state of the marketplace evidence is insufficient to be a significant surrounding circumstance.

*conclusion re likelihood of confusion*

[27] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees BENCHMARK SHARK on the Applicant's wire stripper and utility knife at a time when he or she has no more than an imperfect recollection of the Opponent's SHARK trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[28] In view of my findings above, and in particular the similarity between the parties' wares, the overlap between the parties' channels of trade and the high degree of resemblance between the marks in appearance, sound, and idea suggested, it seems to me that such a consumer would, as a matter of first impression, be likely to believe that the wares associated with the SHARK mark and the BENCHMARK SHARK mark were manufactured, sold or performed by the same person.

[29] The s. 12(1)(d) ground of opposition therefore succeeds.

*Section 38(2)(c)/16(3)(a) - Non-entitlement*

[30] The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(3)(a) on the basis that the Mark is confusing with the Opponent's mark SHARK which had been previously used in Canada in association with knives.

[31] With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark prior to the Applicant's filing date and non-abandonment of its mark as of the date of advertisement of the Applicant's application [s. 16].

[32] From the evidence furnished, I am not satisfied that the Opponent has shown use of its mark *per se* prior to the Applicant's filing date and non-abandonment of its mark as of the date of advertisement of the Applicant's application. This ground of opposition is therefore not successful.



*Section 38(2)(d)/(2) – Non-Distinctiveness*

[33] Regarding the ground of opposition based on lack of distinctiveness pursuant to s. 2 of the Act, the Opponent needs to have shown that as of the date of filing of the opposition its trade-mark had become known sufficiently to negate the distinctiveness of the applied-for mark [*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.); *Bojangles International, LLC v Bojangles Café Ltd* (2006), 48 C.P.R. (4<sup>th</sup>) 427]. It is not necessary for the Opponent to show that its mark had become well known, it is sufficient to establish that its mark has become known sufficiently to negate the distinctiveness of the applicant's mark. As stated by Noel J in the *Bojangles* case at p. 444: "A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient."

[34] In view that the Opponent has not provided sufficient evidence of use of its mark *per se* in Canada prior to the filing date of the statement of opposition, I am of the view that the Opponent has not established that its trade-mark is sufficiently known so as to negate the distinctiveness of the Mark. This ground of opposition is therefore unsuccessful.

Disposition

[35] In view of the above, and 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.

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