

**IN THE MATTER OF AN OPPOSITION  
by Paul Alfred Starkins to application No.  
1162419 for the trade-mark KRONK filed  
by Second Round, Inc., a legal entity**

On December 16, 2002, Second Round, Inc., a legal entity (the “Applicant”) filed an application to register the trade-mark KRONK (the “Mark”) based upon use of the Mark in Canada. The statement of wares currently reads: 1. Clothing, namely, t-shirts, sweat shirts, sweat pants, tank tops, jerseys, shorts, jogging suits, jackets, pullovers, sweaters, caps, and polo shirts. 2. Clothing and headwear, namely, t-shirts, sweat shirts, sweat pants, tank tops, jerseys, shorts, jogging suits, jackets, pullovers, sweaters, caps, and polo shirts. The wares marked (1) are based on use in Canada since at least as early as December 1, 1999. The wares marked (2) are based on use and registration in the United States (under No. 2,306,900). The application was advertised for opposition purposes in the Trade-marks Journal of June 2, 2004.

On November 2, 2004, Paul Alfred Starkins (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denied the Opponent’s allegations.

The Opponent’s evidence consists of the affidavit of Mr. Paul Alfred Starkins. The Applicant’s evidence consists of the affidavit of Ms. Sylvia Steward, President of the Applicant. Neither affiant was cross-examined.

Only the Applicant filed a written argument. Neither party requested an oral hearing.

**Grounds of Opposition**

The grounds of opposition may be summarized as follows:

1. The application does not comply with s.30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (“the Act”), in that the Applicant has not used the Mark in Canada since at least as early as December 1, 1999.
2. The application does not comply with s.30(i) in that the Applicant could not have been satisfied that it was entitled to use the trade-mark in association with the wares set out in

the application because it was or should have been aware of the prior trade-mark rights of the Opponent and its predecessor-in-title.

3. The Applicant is not the person entitled to registration, since at the date of filing of the application and the alleged date of first use, the applied for trade-mark was and is confusing with the Opponent's trade-mark KRONK used in connection with clothing items, and in particular knitwear, shirts, t-shirts and trousers, all of which have been previously used in Canada by the Opponent and/or its predecessor-in-title in Canada.
4. The Applicant is not the person entitled to registration since at the date of filing of the application, the Applicant's trade-mark was confusing with the Opponent's trade-mark KRONK and the Opponent's trade-mark application no. 1,157,977, filed November 1, 2002.
5. The Mark is not distinctive in Canada of the Applicant's wares in that the Mark does not distinguish, nor was it adapted to distinguish, the Applicant's wares from those of others, including the wares of the Opponent previously used by the Opponent and/or its predecessor-in-title.

In view that the present application is based both on use in Canada for wares marked (1) and use and registration in the U.S. for wares marked (2), I have interpreted grounds 3 and 4 pleaded by the Opponent as being based on both s. 16(1) and s. 16(2) of the Act.

#### Material Dates

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

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 16(1) - the Applicant's date of first use [see s. 16(1)];
- s.16(2) – the Applicant's filing date [see s.16(2)];
- non-distinctiveness - 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.T.D.)].

### Summary of the Evidence

Mr. Starkins has attested that the Opponent's predecessor-in-title, P&P Clothing, used its KRONK mark in association with clothing items, namely knitwear, shirts, t-shirts, trousers, coats, jackets, tops, track tops, skirts and dresses, since at least as early as March 1996. Attached as Exhibit B to his affidavit is a copy of a U.S. waybill, dated March 29, 1996, showing delivery of a shipment of KRONK clothing wares from "P&P" in London England to an address in British Columbia. I note that the only wares that are legible from the copy of the handwritten invoice are t-shirts and crew necks. Attached as Exhibit C is a copy of an invoice that accompanied this particular shipment. Samples of labels showing the trade-mark as used by the Opponent's predecessor-in-title in association with the clothing wares on or about March 1996 was attached as Exhibit D. Mr. Starkins further explains that the mark was transferred to him by assignment on June 23, 2000, and since then he has continued to use the mark in association with "knitwear, shirts, t-shirts, trousers, coats, jackets, tops, track tops, skirts and dresses" in Canada. He further states that since at least as early as October, 2002, he has used the KRONK trade-mark in association with "articles made from leather or imitation leather, belts, wallets, pocket wallets, purses, keyrings bags, schoolbags, record bags, gym bags, sport bags, athletic bags, toilet bags, backpacks, shoulder bags, handbags, clutch bags, belt bags, hip pouches, satchels, document cases, holdalls, rucksacks, beach bags, tote bags, luggage, cases, carry-on luggage, overnight luggage, bags for travel accessories, shoe bags for travel, luggage carts (non-motorized), parasols, umbrellas, canes, parts and fittings for all the aforesaid goods".

Ms. Steward states that the Applicant and its predecessors-in-title, notably Escot Boxing Enterprises Inc., have used the trade-mark KRONK in Canada since at least as early as 1991 in association with clothing, namely t-shirts, sweat shirts, sweat pants, tank tops, jerseys, shorts, jogging suits, jackets, pullovers, sweaters, caps and polo shirts. Ms. Steward testifies that the Mark has become very well known in the U.S., Canada and through much of the world in respect of providing training services to boxers and promoting boxing and boxing prize fighters and in respect of equipment and clothing marked with the KRONK trade-mark. In this regard, she explains that during the normal course of providing training services to boxers and promoting boxing and boxing prize fighting under the trade-mark KRONK, boxers wear clothing and

equipment prominently marked with the KRONK trade-mark originating from the Applicant or its predecessor-in-title Escot Boxing Enterprises Inc., and the boxers participated in boxing shows, exhibitions, and matches in the U.S., in Canada and in many foreign countries. Photographs showing boxers wearing clothing marked with the KRONK mark are attached as Exhibit A to her affidavit. She further states that at such boxing shows, exhibition and matches including particularly shows in Canada, clothing marked with the KRONK trade-mark originating from the Applicant or its predecessor-in-title was, as a matter of course, offered for sale, and that this is a normal practice in the trade. By way of example, the Applicant's wares were introduced, advertised and promoted at a show in Windsor, Ontario in June 1991, and approximately \$15,000 worth of clothing marked with the KRONK mark were sold at that show.

The Applicant's wares are also sold in Canada and other countries over the Internet and through a website operated by the Applicant. Attached as Exhibit C to her affidavit are samples of invoices showing sales in Canada of the Applicant's wares marked with the KRONK mark from 1999 to 2006.

#### Section 30(b) Ground of Opposition

The initial burden on an opponent is lighter respecting the issue of non-conformance with s. 30(b), because the facts regarding an applicant's first use are particularly within the knowledge of the applicant (*Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.H.O.) at 89). This burden may therefore be met by reference not only to the opponent's evidence but also to the applicant's evidence (*Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 at 230 (F.C.T.D)). However, while an opponent may rely upon an applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is "clearly" inconsistent with the applicant's claims as set forth in its application.

In the present case, I am not satisfied that the Opponent has met its initial burden. In this regard, the Opponent has provided no evidence that the Applicant has not used the Mark in association with the applied for wares. Further, the Applicant's evidence is not clearly inconsistent with its

claim to have used the Mark in Canada since December, 1999. This ground of opposition is therefore unsuccessful.

#### Section 30(i) Ground of Opposition

Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant (see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155; and *Cerverceria Modelo, S.A. de C.V. v. Marcon* (unreported) [2008] T.M.O.B. No. 131). As this is not such a case, I am dismissing this ground of opposition.

#### Sections 16(1)(a) and 16(2)(a) Grounds of Opposition

The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(1)(a) on the basis that the Mark is confusing with the mark KRONK previously used in Canada by the Opponent and/or its predecessor-in-title in association with clothing items, and in particular knitwear, shirts, t-shirts and trousers.

With respect to the s. 16(1)(a) ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark prior to the Applicant's claimed date of first use and non-abandonment of its mark as of the date of advertisement of the Applicant's application (s. 16). Contrary to what the Applicant has submitted, the Applicant's claimed date of first use is the date stated in the application and not the date of first use as may be shown by the Applicant's evidence. The Opponent's burden under s. 16(2)(a) is the same, the only difference being that the Opponent needs to evidence use of its mark prior to the Applicant's filing date of its application and non-abandonment of its mark as of the date of advertisement of the Applicant's application.

With respect to the issue of non-abandonment, the Applicant appears to rely on the fact that the Opponent's application to register the trade-mark KRONK (Application No. 1,157,977) was abandoned November 2, 2007. I agree with the Applicant that this may show the Opponent's intention to abandon its application to register its trade-mark. However, the issue is not whether

the Opponent can show that it has not abandoned an application to register a trade-mark but rather whether the Opponent can show that it had not abandoned its trade-mark at the date of advertisement of the Applicant's mark, i.e. June 2, 2004.

In order for there to be use of a trade-mark within the meaning of s.4 of the Act, that use must be continuous and in the ordinary course of trade (see *Redsand v. Dylex Ltd.* (1997), 74 C.P.R. (3d) 373 (F.C.T.D.)). In my opinion, the evidence furnished does not satisfy this criteria, as the only activity which appears to have occurred before the relevant date was a single transaction, in which t-shirts and crewnecks of the Opponent were sent to an address in Canada. Such a transaction, in my view, is not indicative of a normal commercial transaction in the ordinary course of trade. Therefore, as the Opponent has failed to meet its burden under these grounds, these grounds fail.

#### Sections 16(1)(b) and 16(2)(b) Grounds of Opposition

The Opponent has further pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(1)(b) on the basis that the Mark is confusing with application no. 1,157,977, filed November 1, 2002, for registration of the mark KRONK previously filed by the Opponent. The Opponent did not evidence its application No. 1,157,977. Having regard to the potential public interest in assessing a s. 16(1)(b) ground, however, the Registrar will exercise his discretion to check the Trade-marks Office records to confirm the existence of a pending application being relied upon in support of such a ground (*Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.) at 529). I have exercised that discretion to confirm the existence of Application No. 1,157,977, and note that since it was not filed prior to the Applicant's date of first use with respect to the wares marked (1), the Opponent has not met its burden under this ground of opposition. This ground therefore fails.

As for the wares marked (2), I note that they are exactly the same as the wares marked (1) except for "headwear". Since Application No. 1,157,977 was pending as of the advertisement of the Applicant's application (i.e. June 16, 2003), the Opponent has met its burden under s. 16(2)(b) even though its application was subsequently abandoned on November 2, 2007 (see *ConAgra, Inc. v. McCain Foods Ltd.* (2001), 14 C.P.R. (4<sup>th</sup>) 288 (F.C.T.D.) and s. 16(4)).

In its application no. 1,157,977, the Opponent applied for the following wares:

1. Articles made from leather or imitation leather; belts; wallets, pocket wallets, purses; keyrings; bags, schoolbags, record bags, gym bags, sports bags, athletic bags, toilet bags, backpacks, shoulder bags, handbags, clutch bags, belt bags, hip pouches, satchels, document cases, holdalls, rucksacks, beach bags, tote bags, luggage, cases, carry-on luggage, overnight luggage, bags for travel accessories, shoe bags for travel, luggage carts (non-motorised); parasols, umbrellas, canes; parts and fittings for all the aforesaid goods.
2. Clothing, footwear and headgear, namely hats, caps, bandanas, earmuffs, casual clothing, casual wear, children's clothing, outdoor winter clothing, athletic clothing, athletic footwear, children's footwear, casual footwear, evening footwear.
3. Articles of clothing, namely, knitwear, shirts, T-shirts and trousers.

In applying the test for confusion set forth in s. 6(2) of the Act, consideration is to be given to all of the surrounding circumstances, including those specifically set forth in s. 6(5) of the Act. In the present case, the marks are identical, and the only overlap with respect to the parties' wares is between the Applicant's "headwear" and the Opponent's applied for ware "headgear". The evidence, however, does not refer to any use of the mark KRONK in association with headwear by either the Opponent or his predecessor-in-title. The Opponent has only shown one example of alleged use of the KRONK mark in association with t-shirts and crewneck shirts in 1996. The Applicant, on the other hand, has provided evidence of sales of the Applicant's clothing wares, including caps, sold in association with the Mark in Canada from 1999 to 2003. There is also evidence from the Applicant that approximately \$15,000 worth of the Applicant's wares marked with the KRONK trade-mark were sold in Canada in June, 1991, and there has allegedly been continuous sales in Canada of the Applicant's wares marked with the trade-mark KRONK since that time. The Applicant's Mark has therefore acquired some distinctiveness in Canada through use.

As a surrounding circumstance, I have noted that the Mark appears to have an established reputation in the field of boxing.

I find that a consideration of all the surrounding circumstances leads me to conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the marks. This ground of opposition therefore fails.

#### Distinctiveness Ground of Opposition

The Opponent has pleaded that the Mark is not distinctive and is not capable of distinguishing the Applicant's wares from the wares associated with the Opponent's trade-mark. In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition (November 2, 2004) the Opponent's KRONK mark had become known sufficiently to negate the distinctiveness of the 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.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)). I am not satisfied from the evidence furnished that the Opponent's mark was known sufficiently as of the filing of the opposition to negate the distinctiveness of the Applicant's mark. As the Opponent has not met its burden under this ground of opposition, this ground is not successful.

#### Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8).

DATED AT Gatineau, Quebec, THIS 8th DAY OF January, 2009.

Cindy R. Folz  
Member  
Trade-marks Opposition Board