



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

Citation: 2015 TMOB 80
Date of Decision: 2015-04-28

**IN THE MATTER OF AN OPPOSITION
by Empire Comfort Systems, Inc. to
application No. 1,481,784 for the trade-
mark BROILMASTER in the name of
Onward Multi-Corp. Inc.**

[1] Onward Multi-Corp. Inc. (the Applicant) has filed an application to register the trade-mark BROILMASTER (the Mark), based upon proposed use in Canada, in association with “gas barbecues, gas grills, and replacement parts therefor”.

[2] Empire Comfort Systems, Inc. (the Opponent) is the owner of the trade-marks OPTIONS BY BROILMASTER and BROILMASTER, which it claims to have used in Canada since at least as early as 2000 and 2001 respectively, in association with “gas grills and replacement parts therefor”.

[3] The parties are not strangers to one another. They have previously been involved in two other opposition proceedings against one another.

[4] In the first case, the Opponent herein applied to register its trade-mark BROILMASTER (under application No. 1,112,366) and that application was successfully opposed by the Applicant herein (the prior BROILMASTER opposition) [*Onward Multi-Corp Inc v Empire Comfort Systems, Inc* (2010), 2010 TMOB 29 (CanLII)]. In that proceeding, a likelihood of confusion was found between the applied for trade-mark BROILMASTER (applied for by the Opponent herein) and the trade-mark BROIL KING (a trade-mark of the Applicant herein).

[5] In the second case, the Applicant herein applied to register the trade-mark BROIL KING (under application No. 1,166,534) and that application was opposed by the Opponent herein under sections 30(i), 30(b), 12(1)(b) and 2 of the Act. (the prior BROIL KING opposition) [*Empire Comfort Systems, Inc. v Onward Multi-Corp. Inc.* (2010), 2010 TMOB 30 (CanLII)]. The opposition was successful under the section 30(b) ground for some goods, but unsuccessful for others and for the remaining grounds.

[6] I will not go into any further detail about these proceedings. Suffice it to say, having successfully opposed the Opponent's previously filed application for BROILMASTER and having had its BROIL KING application unsuccessfully opposed (in part) by the Opponent, the Applicant has now applied to register BROILMASTER itself and the Opponent has opposed its application, primarily based upon its prior use of BROILMASTER.

[7] For reasons which will be discussed in more detail below, the opposition is successful.

File History

[8] The application for the Mark was filed on May 19, 2010 and advertised for opposition purposes in the *Trade-marks Journal* on November 3, 2010.

[9] On March 24, 2011, the Opponent opposed the application for the Mark under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based upon sections 30(i), 16(3)(a) and 2 (distinctiveness) of the Act.

[10] The Applicant filed a counterstatement on July 26, 2011 denying each of the grounds set out in the statement of opposition.

[11] In support of its opposition, the Opponent filed the affidavits of Donald Rigney, sworn November 22, 2011 (the first Rigney affidavit) and the affidavit of Jill Roberts, sworn November 25, 2011 (the first Roberts affidavit). Mr. Rigney was cross-examined and the transcript of his cross-examination has been made of record. Ms. Roberts was not cross-examined.

[12] As its evidence, the Applicant filed the affidavit of Terrence R. Witzel, sworn June 27, 2012 (the Witzel affidavit). Mr. Witzel was cross-examined on his affidavit and the transcript of his cross-examination has been made of record.

[13] As evidence in reply, the Opponent filed the affidavit of Donald Rigney, sworn July 12, 2013 (the second Rigney affidavit), the affidavit of Corey Boone, sworn July 12, 2013 (the Boone affidavit), the affidavit of Bart Gilchrist, sworn July 15, 2013 (the Gilchrist affidavit), the affidavit of Jill Roberts, sworn July 12, 2013 (the second Roberts affidavit) and the affidavit of Jill Roberts, sworn July 15, 2013 (the third Roberts affidavit). Only Mr. Rigney was cross-examined.

[14] Both parties filed a written argument.

[15] A hearing was held on February 12, 2015 and both parties attended.

Onus

[16] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Preliminary Matters

Reply Evidence

[17] The Applicant objects to the Opponent's evidence in reply, namely, the second Rigney affidavit, the Boone affidavit, the Gilchrist affidavit, the second Roberts affidavit and the third Roberts affidavit, on the basis that it does not constitute proper reply evidence.

[18] Pursuant to section 43 of the *Trade-marks Regulations* SOR/96-195 (the Regulations), reply evidence must be "strictly confined to matters in reply". I further note that if an opponent is uncertain about whether its evidence constitutes proper reply, it is able to request leave to file

additional evidence under section 44 of the Regulations. However, no such request was made by the Opponent in this case.

[19] Justice Pelletier in *Halford v Seed Hawk Inc* (2003), 24 CPR (4th) 220 (FCTD) at paras 14-15 provided the following guidelines with respect to reply evidence:

- (i) Evidence which is simply confirmatory of evidence already before the court is not to be allowed.
- (ii) Evidence which is directed to a matter raised for the first time in cross examination and which ought to have been part of the plaintiff's case in chief is not to be allowed. Any other new matter relevant to a matter in issue, and not simply for the purpose of contradicting a defence witness, may be allowed.
- (iii) Evidence which is simply a rebuttal of evidence led as part of the defence case and which could have been led in chief is not to be admitted.

[20] In addition, the Opponent has directed my attention to a decision of this Board in which Member Folz stated that the test for whether or not evidence is proper reply evidence is not simply whether the evidence could have been included in the Opponent's evidence in chief, but whether the evidence is in reply to the Applicant's evidence and is responsive to unanticipated matters [*Kerr Controls Ltd v Mike Witherall Mechanical Ltd* (2013), 116 CPR (4th) 357 (TMOB)].

[21] In this case, the Opponent purports to have filed its reply evidence in order to address paragraph 19 of the Witzel affidavit, wherein Mr. Witzel states that he directed twenty-four of the Applicant's sales persons to search the Canadian market for any evidence of BROILMASTER products and that they were unable to find any information concerning the sale of such products in Canada. In paragraph 19 of his affidavit, Mr. Witzel also stated that from his experience, BROILMASTER has been absent from the Canadian marketplace for well over fifteen years and that he has not seen any BROILMASTER product at any trade shows or consumer shows in Canada or elsewhere in this century.

[22] For reasons which I will discuss in more detail below, I am of the view that the bulk of the Opponent's reply evidence is not proper reply.

The Second Rigney Affidavit

[23] The second Rigney affidavit provides copies of brochures for its BROILMASTER products which Mr. Rigney states have been distributed over the years to Canadians at retail locations in Canada. Excerpts from brochures ranging in date from 2002 to 2012 are provided as Exhibits “A” to “H” of his affidavit. They are similar in nature to the brochure which was attached as Exhibit “A” to the first Rigney affidavit and as Exhibit “D” to the first Roberts affidavit and I see no reason why they could not also have been provided as part of the Opponent’s evidence in chief under section 41 of the Regulations. They are confirmatory in nature and given that the Opponent’s grounds of opposition all hinge on its prior use of its trade-mark, I do not consider this evidence to be responsive to anything which may be said to be unanticipated in the Applicant’s evidence.

[24] The remainder of the second Rigney affidavit provides details pertaining to the Opponent’s attendance and promotional activities at various trade-shows which took place in the United States. This evidence appears to have been filed as rebuttal to evidence led as part of the Applicant’s case. In particular, it appears to have been filed to rebut the statement in Mr. Witzel’s affidavit that he has never seen the Opponent at trade-shows and perhaps also to deal with refusals which were made by Mr. Witzel during cross-examination. While it could have been led as evidence in chief, I do not find Mr. Witzel’s evidence in this regard to be something that could reasonably have been anticipated by the Opponent. In view of this, it arguably relates to new matter and is proper reply. However, given that it relates to trade-shows which took place in the United States and there is no information regarding how many Canadians attended, I do not consider it to be of assistance to the Opponent.

The Boone and Gilchrist Affidavits

[25] The Boone and Gilchrist affidavits come from the Opponent’s distributors in Canada, namely, Diversco Supply Inc and National Energy Equipment, Inc. and they speak to sales of the Opponent’s BROILMASTER products to their dealer network in Canada which in turn sells to the public. In my view, this evidence could also have been filed in conjunction with Mr. Rigney’s first affidavit and Ms. Roberts’ first affidavit as part of the Opponent’s evidence under section 41 of the Regulations. Both of those affiants made reference to the Opponent’s

distributors in their affidavits and nothing precluded the Opponent from filing this confirmatory evidence directly from its distributors to augment the information which was contained in those affidavits and more fully exhaust its evidence in the first instance in support of its grounds of opposition.

The Second Roberts Affidavit

[26] The second Roberts affidavit provides details pertaining to Ms. Roberts' attendance at a retail store in Ottawa where she viewed BOILMASTER barbecue models on display, made inquiries about the Opponent's barbecues and obtained a brochure. This evidence clearly relates to the use of the Opponent's trade-mark in Canada and again, could have been filed as part of the Opponent's evidence under section 41 of the Regulations. Instead, the Opponent elected to file it as rebuttal to the Applicant's evidence. As an aside, I note that Ms. Roberts' evidence post-dates the material dates for all three grounds of opposition which have been pleaded in this case.

The Third Roberts Affidavit

[27] The third Roberts affidavit purportedly addresses issues arising out of the cross-examination of Mr. Witzel and primarily appears to have been filed to show that the parties are members of the same trade organization and that their products (i.e. the Applicant's BROIL KING products and the Opponent's BROILMASTER products) are sold or advertised on-line in close proximity to one another. Presumably, it is also intended to rebut the statement in paragraph 19 of Mr. Witzel's affidavit about how his sales representatives were unable to find any information concerning the sale of the Opponent's products in Canada.

[28] I find that this evidence also constitutes improper reply. Evidence pertaining to common membership in trade organizations and overlap in the parties' channels of trade or the Opponent's sales of its products in Canada directly relates to the issues of confusion and the Opponent's prior use of its trade-mark. Such evidence may also have supported the Opponent's non-distinctiveness ground of opposition, as its pleading makes specific reference to the advertisement of the Opponent's products over the internet. In my view, this evidence does not relate to anything new or unanticipated and could have been filed as the Opponent's evidence under section 41 of the Regulations. In fact, similar evidence was presented in the first Roberts

affidavit, but it post-dated the material date for two of the grounds of opposition [see First Roberts affidavit, para 13, Exhibit “M”]. Alternatively, the Opponent could have sought leave to file it as additional evidence under section 41 of the Regulations.

[29] The purpose of reply evidence under section 43 of the Regulations is not to fill a void, buff up or more fully complete the Opponent’s evidence in chief under section 41 of the Regulations. With the exception of the second part of the second Rigney affidavit (i.e. the information that pertains to trade-shows), I agree with the Applicant that the remainder of the Opponent’s reply evidence is not proper reply. I have therefore not had regard to it.

[30] If my finding that this evidence is not admissible is incorrect, I note that even if I had considered it to be admissible, it would not have affected the final outcome of this decision.

Applicant’s other BROIL formative Trade-marks/ Outcome of prior Opposition Proceedings

[31] Most of Mr. Witzel’s affidavit consists of details relating to other BROIL formative trade-marks which the Applicant has applied for, registered and/or used. For example, BROIL KING (registration No. TMA257,283), BROIL-MATE (registration No. TMA332,350) and BROIL KING IMPERIAL (application No. 1,515,198) [Witzel affidavit, paras 3-18].

[32] I wish to note that ownership of these other trade-marks does not automatically grant the Applicant the right to obtain registration of the Mark no matter how closely the trade-marks may be related [see *American Cyanamid Co v Stanley Pharmaceuticals Ltd* (1996), 74 CPR (3d) 571 (TMOB); *Ralston Purina Canada Inc v HJ Heinz Co of Canada* (2000), 6 CPR (4th) 394 (TMOB)].

[33] Furthermore, the fact that the Applicant may have successfully opposed a prior application by the Opponent for the trade-mark BROILMASTER, does not necessarily mean that the Applicant is now entitled to register that same trade-mark.

Analysis of Grounds of Opposition

Non-entitlement - Section 16(3)(a)

[34] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act in view of the Opponent's prior use and making known of its trade-mark BROILMASTER in Canada, since at least as early as 2001, in association with "gas grills and replacement parts therefor".

[35] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark, the Opponent has an initial onus to prove that its trade-mark was in use or had been made known in Canada prior to the May 19, 2010 filing date of the application for the Mark and had not been abandoned as of the November 3, 2010 date of advertisement for the Mark [section 16(5) of the Act].

[36] In the present case, the parties agree that there is a likelihood of confusion between their trade-marks. However, they disagree about whether the Opponent has met its initial burden in respect of this ground of opposition. If the Opponent has not met its initial burden, whether there is a likelihood of confusion or not becomes moot, as the burden will not shift to the Applicant to establish that there is no likelihood of confusion.

[37] Bearing this in mind, I will now turn to the evidence which has been filed by the Opponent in this proceeding.

The first Rigney Affidavit and the first Rigney Transcript of Cross-examination

[38] Mr. Rigney is the Executive Vice President and Chief Operating Officer of the Opponent [first Rigney affidavit, para 1]. Mr. Rigney's affidavit provides the following information and materials:

- the Opponent has been selling BROILMASTER brand barbeques and barbeque accessories in Canada on a continuous basis since at least as early as 2003 to the present [first Rigney affidavit, para 3];

- BROILMASTER brand barbeques and accessories sold in Canada are marked with the trade-mark BROILMASTER and the BROILMASTER trade-mark has always appeared on or in association with all BROILMASTER brand products which have been sold in Canada since at least as early as 2003 [first Rigney affidavit, para 8 first Rigney transcript, Q's 69-85];
- attached as Exhibit "A" is a sampling of invoices which Mr. Rigney states evidences sales of BROILMASTER brand barbeques and accessories each year from 2003-2011 [Rigney affidavit, para 4];
- the Opponent's sales of its BROILMASTER brand barbeques and accessories to Canadian consumers have been in the thousands of dollars on an annual basis and from 2003 up until the time that Mr. Rigney swore his affidavit, total sales were in excess of \$450,000 [first Rigney affidavit, paras 4 and 6];
- attached as Exhibit "B" is a brochure that is used to advertise the BROILMASTER brand barbeques and accessories to Canadians. According to Mr. Rigney, such brochures are available to customers at retail locations in Canada and have been available since at least as early as 2003 [first Rigney affidavit, para 7]. The brochure contains photographs of some of the Opponent's products. The trade-mark BROILMASTER can be seen on various parts of barbecues and accessories or their packaging. Although BROILMASTER appears within a rectangular border and features the descriptive words "premium gas grills" in smaller font below it, I am satisfied that the manner in which it appears with this additional matter still constitutes use of the Opponent's BROILMASTER trade-mark [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); and *Ivy Lea Shirt Co v Muskoka fine Watercraft and Supply Co*, (1999) 2 CPR (4th) 562 (TMOB); Aff'd 11 CPR (4th) 489 (F.C.T.D.)]. Although Mr. Rigney stated during cross-examination that BROILMASTER also sometimes appears on its own (i.e. without the additional descriptive matter) on the Opponent's products, no examples of this were shown in the exhibits attached to his affidavit [first Rigney transcript, Q's 63-83].

- prior to September 2010, BROILMASTER barbecues were sold in parts in a “build your own” manner for assembly by the customer. In September of 2010 (for the 2011 season), the Opponent introduced pre-assembled barbecues [first Rigney transcript, Q’s 103-107 and 129-137]. No invoices for any pre-assembled barbecues have been provided and had they been, they likely would have post-dated the material date for considering this ground of opposition;
- the Opponent sells its BROILMASTER brand barbecues and accessories through Canadian distributors such as Diversco Supply Inc. and National Energy Equipment Inc. and has done so since at least as early as 2003. They in turn sell to retailers for sale to the Canadian public [first Rigney affidavit, para 9]. Mr. Rigney identifies four of the Opponent’s Canadian retailers in paragraphs 10 and 11 of his affidavit. They are located in Ontario and British Columbia; and
- in paragraph 12, Mr. Rigney states that the Opponent operates a website which is accessible to Canadians. According to Mr. Rigney, the Opponent’s website had 3,733 hits from Canadians between November 14, 2009 and November 13, 2010 and 2, 479 hits from Canadians between November 14, 2010 and November 13, 2011.

[39] The Applicant notes that the Opponent’s BROILMASTER trade-mark is not specifically referenced in all of the invoices which are attached as Exhibit “A” to Mr. Rigney’s affidavit and it submits that it is incorrect to infer that the products described in those invoices are products which are associated with the Mark. In support of its submissions, the Applicant relies on the decision in *Facton Ltd v Kelendji (c.o.b. Diplome Watch of Canada)*, [2012] TMOB 142. However, the present case is distinguishable from that case, as Mr. Rigney has clearly stated in his affidavit that the products listed and described in the invoices are in fact BROILMASTER brand products [first Rigney affidavit, para 5].

[40] The Applicant also takes issue with the fact that the product descriptions referenced in the Opponent’s invoices appear to reference different stand-alone products (for example, burners, side shelves, carts, rotisseries etc). The Applicant submits that there is no evidence that the

Applicant has ever sold barbecues or accessories in association with the BROILMASTER trade-mark.

[41] I note that Mr. Rigney clearly states in his affidavit that the Opponent has sold barbecues and accessories in Canada since at least as early as 2003 and that they are marked with the trade-mark, as is shown in the photographs in the brochure attached as Exhibit “B” to his affidavit. Mr. Rigney confirmed on cross-examination that prior to 2010, BROILMASTER barbecues were sold in a “build your own” manner for assembly by the customer [first Rigney affidavit, paras 3 and 8; first Rigney transcript, Q’s 103-107 and 129-137].

[42] During cross examination, Mr. Rigney made the following statement:

103.

Q. So you were getting to the point of telling us that you essentially, as I understand what you’re saying, selling a number of parts to a customer and then they assemble them. Is that what you’re saying?

A. It’s a build your own. You pick your grill head. You pick your cart. You pick your side shelves. You pick your side burner, and you build it, similar to the way you used to buy a Mustang...

[43] Given the manner in which the Opponent’s products have been sold, it is not surprising that its invoices do not reference “barbecues” or “gas grills”, *per se* and I do not find the issue of whether the Opponent sold assembled versus pre-assembled units in association with its trade-mark to be a relevant consideration. Moreover, I note that in addition to “gas grills”, the statement of opposition also refers to “replacement parts”. Thus, it is reasonable to assume that not all of the invoices which have been provided by the Opponent would include all of the component parts which are required in order to form a complete “barbecue” or “gas grill”. Some may well cover only various random parts.

[44] With respect to the Applicant’s point that there is no evidence that the Opponent has sold any “accessories” bearing the BROILMASTER trade-mark, I note that Exhibit “B” shows, for

example, use of the trade-mark in association with rotisseries and grill covers and both of these items are referenced in invoices which are attached as Exhibit “A” to Mr. Rigney’s affidavit.

The First Roberts Affidavit

[45] The first Roberts affidavit provides some additional information regarding the Opponent’s website and Canadian dealers for the Opponent’s BROILMASTER products.

[46] Ms. Roberts is a law clerk graduate and Assistant Bailiff [first Roberts affidavit, para 1]. On November 24, 2011, she accessed the ‘Support/Dealer Locator’ page on the Opponent’s website and noted that it referenced six Canadian dealers [first Roberts affidavit, paras 1-4]. A copy of this page forms part of Exhibit “C” to her affidavit. Notably, Exhibit “C” post-dates the material date for this ground of opposition. However, Ms. Roberts also used the Wayback Machine to print out representative screen captures from various parts of the Opponent’s website for the years of 1999 – 2008 [first Roberts affidavit, paras 7-11, Exhibits “F”-“K”].

[47] Exhibits “I” and “J” consist of screen captures from the “accessories” link on 2001 and 2003 archived versions of the Opponent’s website. They show images of what appear to be some of the Opponent’s barbecue parts and accessories. The trade-mark BROILMASTER can be seen on some of the parts/accessories or on their packaging. Exhibit “K” consists of a screen capture from a 2008 archived version of the Canadian Dealer page of the Opponent’s website. It lists 5 dealer locations (4 in Ontario and 1 in Prince Edward Island) for the Opponent’s products. Exhibit “L” shows a screen capture from the Canadian Dealer page of the Opponent’s website as of October 26, 2010 (a few months after the material date). It lists the same 5 dealers as Exhibit “K”.

[48] Exhibit “M” consists of screen captures from the websites of two of the Opponent’s Canadian dealers. The screen captures were also obtained using the Wayback Machine and they are also dated October 26, 2010 (after the material date). One of them shows both the Opponent’s and the Applicant’s products.

[49] Exhibit “O” consists of screen captures from the website of Diversco Supply Inc., a company which Mr. Rigney identified in the first Rigney affidavit as being a distributor of the

Opponent's products in Canada [first Rigney affidavit, para 9]. The screen captures, which range from 2003 to 2008 all display the Opponent's BROILMASTER trade-mark

[50] At least some of this evidence does pre-date the material date and can therefore be considered. However, as the Applicant has correctly pointed out print-outs from the websites cannot be relied upon as truth of their contents [*Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FCTD), rev'd on other grounds (2008), 64 CPR (4th) 431(FCA)].

[51] In view of this, at most, I consider this evidence to be useful to establish that as of the dates of the archived screen captures, the Opponent featured those particular BROILMASTER products or listed those particular dealers on its website and those dealers/distributors made reference to the Opponent's products on their websites.

Conclusion

[52] Overall, I find the Opponent's evidence sufficient to establish that its trade-mark was in use in Canada prior to the May 19, 2010 filing date of the application for the Mark and had not been abandoned as of the November 3, 2010 date of advertisement for the Mark. I therefore find that the Opponent had met its initial evidential burden in respect of this ground of opposition.

[53] In view of this finding, I must go on to consider whether the Applicant has met the burden upon it to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and its trade-mark.

[54] Since the parties in this case have conceded that there is a likelihood of confusion between their respective trade-marks, I do not consider it necessary to address this issue in detail. Suffice it to say, I agree.

[55] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[56] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 goods, 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 CPR (4th) 321 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

[57] In the present case, the parties' trade-marks are identical and they are used or intended to be used in association with similar, if not identical goods. In view of the similarities in the nature of the goods, it is reasonable to assume that the parties' channels of trade would also overlap. Since the parties' trade-marks are identical, they possess the same degree of inherent distinctiveness. However, only the Opponent has filed any evidence of use of its trade-mark or any evidence to suggest that its trade-mark has become known to any extent.

[58] In view of the foregoing, I find that the Applicant has failed to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's trade-mark.

[59] Accordingly, this ground of opposition is successful.

Non-distinctiveness - Section 2

[60] The Opponent has pleaded that the Mark is not distinctive and is not adapted to distinguish the Applicant's goods from those of others including those of the Opponent. As part of its pleading, the Opponent asserts that the Mark is the Opponent's trade-mark BROILMASTER and in view of this, any consumer seeing it would associate it with the Opponent and not the Applicant. The Opponent also asserts in its pleading that its BROILMASTER brand products are advertised over the internet on many websites and that any consumer looking for BROILMASTER brand products on the Internet will be directed to the Opponent's products. In view of this, the Opponent submits that the Mark cannot be distinctive of the Applicant.

[61] The material date for assessing this ground of opposition is the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[62] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods from those of others throughout Canada there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [*Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[63] In the present case, the Opponent is under an obligation to show that, as of the filing date of the statement of opposition, namely, March 24, 2011, its trade-mark BROILMASTER had become known sufficiently in Canada to negate the distinctiveness of the Mark. The reputation of the Opponent's trade-mark should be substantial, significant or sufficient [*Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[64] Although I found the Opponent's evidence sufficient to meet its evidential burden in respect of the non-entitlement ground of opposition, I do not find it sufficient to meet the evidential burden upon it under this ground.

[65] As the Applicant has pointed out, according to the first Roberts affidavit, effective as of November 24, 2011 (a few months after the material date), the Opponent's website indicated that its products were available for purchase at only six dealer locations in only two provinces (Ontario and British Columbia) [first Roberts affidavit, para 4, Exhibit "C"]. Prior to the material date and in particular, as of February 12, 2008, the Opponent's website indicated that its products were available at only 5 dealer locations in Canada in only two provinces (Ontario and Prince Edward Island) [First Roberts affidavit, Exhibit "K"]. Mr. Rigney references only 4 dealers in his affidavit [First Rigney affidavit, paras 10-11].

[66] According to Mr. Rigney, from 2003 up until the time that he swore his affidavit, the Opponent's sales of its BROILMASTER brand barbeques and accessories to Canadian

consumers were “in excess of \$450,000” [first Rigney affidavit, paras 4 and 6]. Given that these sales span across a period of approximately nine years, this is not a particularly large number.

[67] Since there is no indication as to what the average per unit cost is for the Opponent’s products and Mr. Rigney has not indicated how many units were sold during each year, it is impossible to ascertain whether the Opponent sold a few or many units during any given year or how many unit sales it had in total. Mr. Rigney provides only a vague statement that sales have been “in the thousands of dollars on an annual basis” [first Rigney affidavit, para 4].

[68] The Opponent has also not provided any advertising figures. While the Roberts affidavit establishes that some of the Opponent’s dealers displayed its products on their websites, there is no indication how many Canadians visited those sites and there is no information regarding the extent to which those dealers may have advertised the Opponent’s products to Canadian consumers. The Opponent’s own website had a fairly modest number of hits from Canadians (3,733 hits between November 14, 2009 and November 13, 2010 and 2, 479 hits between November 14, 2010 and November 13, 2011) and at least some of those hits were likely after the material date.

[69] Although Mr. Rigney states in the first Rigney affidavit that brochures advertising the Opponent’s products in association with the trade-mark BROILMASTER are available to customers at retail locations in Canada, he does not indicate how many are typically distributed to customers or whether the distribution is limited to the retailers identified in paragraphs 10 and 11 of his affidavit.

[70] Based upon the limited evidence before me, I am unable to conclude that the Opponent has met the burden upon it to establish that its trade-mark’s reputation was substantial, significant or sufficient as of the material date.

[71] Accordingly, this ground of opposition is dismissed.

Non-compliance - Section 30(i)

[72] The Opponent has pleaded that the application for the Mark does not comply with section 30 of the Act because at the date of filing of the application, the Applicant could not have been satisfied that it was entitled to use or register the Mark. The Opponent makes the following assertions in its statement of opposition:

- i) the Opponent is the owner of application nos. 1,515,140 for BROILMASTER (based upon use since at least as early as 2001) and 1,515,141 for OPTIONS BY BROILMASTER (based upon use since at least as early as 2000), both of which cover “gas grills and replacement parts therefor”;
- ii) at the time that the Applicant filed the application for the Mark, it was aware of the Opponent’s prior use of BROILMASTER in Canada and in the United States, due in part, to the fact that the parties had previously been involved in opposition proceedings in Canada, during the course of which the Opponent filed evidence of use of its BROILMASTER trade-mark;
- iii) at the time that the Applicant filed the application for the Mark, it did not intend to use the Mark as such use would be an infringement of the Opponent’s rights in its BROILMASTER trade-mark;
- iv) the application for the Mark was fraudulently filed.

[73] Although the statement of opposition broadly references section 30 of the Act, at the hearing and in its written argument, the Opponent specifically identified section 30(i) of the Act as forming the basis of its pleading.

[74] Section 30(i) of the Act requires that an applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 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 CPR (2d) 152 (TMOB) at 155].

[75] In *Canadian Trade-marks Act – Annotated Robic Leger*, rev. ed. (Scarborough, Ont.: Carswell) (looseleaf), H.G. Richard discusses section 30(i) (formerly section 29(i)) as follows at 30-47,30-48:

The final consideration before proceeding to the actual search of the indexes and examination of the mark itself, is whether or not the applicant is satisfied "that he is entitled to use the mark in Canada in association with the wares or services described in the application". This can be looked at as a type of contract between the applicant and the public, establishing that all information and supporting evidence, including revisions or additions of same, have been submitted **in good faith**, and that the application as it stands, is approved by the applicant. Assuming that everything is in order, the applicant or his agent affixes his signature. The examiner can then proceed with the examination of the mark and the search of the indexes. (emphasis added)

[76] As stated by Board Member Folz in *Cerverceria Modelo, SA de CV v Marcon*, the statement provided by s. 30(i) essentially purports to be evidence of the applicant's good faith in submitting its application [*Cerverceria Modelo, SA de CV v Marcon* (2008), 70 CPR (4th) 355 (TMOB)]. In my view, the evidence in this case is sufficient to give rise to a finding that the Applicant did not file its application for the Mark in good faith.

[77] As previously discussed, there is some evidence of promotion and use in Canada by the Opponent of its BROILMASTER trade-mark which predates the filing date of the application for the Mark. The Opponent submits that there is also evidence to establish that the Applicant knew about the Opponent's prior use of its BROILMASTER trade-mark in Canada. In this regard, the Opponent has directed my attention to the fact that the Applicant filed its application for the Mark less than two months after a decision was rendered in respect of the prior BROILMASTER opposition and exactly two months after a decision was rendered in respect of the prior BROIL KING opposition. The Opponent asserts that in both cases, evidence of use of its BROILMASTER trade-mark was filed by the Opponent and relied upon by the Board in its finding of facts.

[78] Mere knowledge of the existence of an opponent's trade-mark does not in and of itself support an allegation that the applicant could not have been satisfied of its entitlement to use a mark [*Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)]. Such knowledge is not necessarily inconsistent with an applicant's statement that it was entitled

to use the trade-mark on the basis *inter alia*, that its trade-mark was not confusing with the Opponent's trade-mark.

[79] However, in the present case, the Applicant conceded that there is a likelihood of confusion between the parties' trade-marks in its written argument and at the hearing. In addition, the Opponent has also directed my attention to the following statement which was made by the agent for the Applicant and adopted by Mr. Witzel during his cross-examination:

362. Q. And I would ask you, sir, why would you take a competitor's exact mark and apply for it in Canada? Why would you take Empire's mark, BROILMASTER, and apply for that exact same mark for the same wares and apply for it in Canada? Why would you do that, sir...

MR. SCHNURR: It's simply a legal issue

MR. BULBULIA: It's a factual issue in terms of decision-making process he said he's involved in brand development...

374. Q. Are you trying to take the BROILMASTER trade-mark for itself in Canada, for yourself?

MR. SCHNURR: Your client's mark is confusing with our client's marks and we do not want your client to be using that mark in Canada

MR. BULBULIA (to Mr. Witzel): Do you accept his answer?

MR. WITZEL: Yes

[Witzel transcript, Q's 362-374]

[80] The Opponent submits that this statement constitutes an admission on the part of the Applicant that it filed the application for the Mark in an attempt to undermine the Opponent and prevent it from using its BROILMASTER trade-mark in Canada. I agree and in my view, this statement gives rise to an inference that the Applicant did not file its application for the Mark in good faith.

[81] In view of the Applicant's prior knowledge of the Opponent's trade-mark and in view of its admission that there is a likelihood of confusion between its trade-mark and the Opponent's, I find that the evidence which was elicited from Mr. Witzel on cross-examination is sufficient for the Opponent to meet its initial evidential burden in respect of this ground of opposition.

[82] The onus therefore shifts to the Applicant to establish, on a balance of probabilities, that it was satisfied of its entitlement at the time that it filed its application for the Mark and that its intentions were *bona fide* when it did so. The Applicant has not filed any evidence to enable it to meet this burden.

[83] In view of the foregoing, this ground of opposition is successful.

Disposition

[84] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office