

**IN THE MATTER OF AN OPPOSITION by
Simpson Strong-Tie Company, Inc. to application
No. 1,172,462 for the trade-mark QUIK BIT filed
by Canadian Tire Corporation, Limited**

On March 26, 2003, Canadian Tire Corporation, Limited (the “Applicant”) filed an application to register the trade-mark QUIK BIT (the “Mark”) based upon proposed use of the Mark in Canada in association with the following wares:

hand tools, namely axes, axe handles, leather axe sheaths, mitre boxes, screwdrivers, ratchet screw drivers, five in one screw drivers, screwdriver set, ratcheting tool sets, levels, aluminum levels, torpedo level, sliding T level, tape measures, vice clamp, planes, block plane, chisels, wrenches, wrench holders, wire cutters, cable ripper, staple gun, staple hammer, staples, combination square, telescoping magnetic pick-up tool, magnetic pick-up tool, tube cutter, pliers, three piece mini pliers set, snap ring pliers set, locking pliers, spring clamps, wood carving sets, six piece punch and chisel set, sawhorse brackets, tote drawer, workshop apron, electrician pouch, inspection mirror, aprons, chisel sets, sockets, vice, pouch, wood chisel, hex key sets, T handle hex key sets, ratchet wrenches and ratchet wrench sets, socket sets, snips, bolt cutters, tap and die sets, utility knives, window scrapers, wire brushes.

The Applicant has disclaimed the right to the exclusive use of the word BIT apart from the Mark in respect of the wares screwdrivers, ratchet screw drivers, five in one screw drivers and screwdriver set.

The application was advertised for opposition purposes in the Trade-marks Journal of March 24, 2004. On June 2, 2004, Quik Drive USA Inc. filed a statement of opposition. On December 7, 2004, an amended statement of opposition was filed in which the opponent was amended to Simpson Strong-Tie Company, Inc. (the “Opponent”). By Office Letter of February 1, 2005, the Opponent was granted leave to so amend the statement of opposition.

The Applicant filed and served a counter statement on July 22, 2004. By Office Letter of July 4, 2005, the Applicant was granted leave to amend the counter statement.

In support of its opposition, the Opponent filed the affidavit of G. Lyle Habermehl. The Applicant obtained an order to cross-examine him on his affidavit and the transcript of the cross-

examination, as well as answers to certain questions have been filed.

In support of its application, the Applicant initially filed the affidavits of Anthony Henry Whitehouse and Christine Walo. It subsequently obtained leave to file additional evidence, namely the affidavits of Shane Fortier and Patti Terry.

The Opponent obtained an order for the cross-examination of Mr. Whitehouse but did not proceed with a cross-examination.

Each party filed a written argument and each party participated in an oral hearing.

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Summary of Opponent’s Evidence

I will summarize below what I consider to be the key portions of the evidence.

Habermehl Affidavit

Mr. Habermehl is the President of both Quik Drive USA Inc. (“Quik Drive”) and Quik Drive Canada Inc. (“Quik Drive Canada”). Quik Drive is the original owner of the marks relied upon by the Opponent in these proceedings (QUIK DRIVE, QUIKSTRIP, QD, QD2000 and QUIKDRIVER), the marks having been assigned to the Opponent on October 14, 2004. Quik Drive Canada was the Canadian distributor for Quik Drive.

Mr. Habermehl attests that from the 1980s until October 14, 2004, Quik Drive was a manufacturer of automatic screw driving systems and carried on the business of selling power

screwdrivers, plastic strips carrying screws to be used with power screwdrivers and bits for power screwdrivers. (During cross-examination, Mr. Habermehl agreed that, general speaking, collated specialty fasteners and auto feed driving systems were Quik Drive's only business: Questions 89-90.) From at least 1988 and continuously to October 14, 2004, Quik Drive "extensively, and continuously, sold and provided" the following wares in Canada in association with the QUIK DRIVE trade-mark to its Canadian distributor, namely Quik Drive Canada: replaceable metal screwdriver bits for power screwdrivers; strips of screws for power screwdrivers; power screwdrivers. Mr. Habermehl has provided packaging, brochures and photographs to show how QUIK DRIVE was associated with such wares. (Exhibits "F", "G", "H" and "I")

Quik Drive Canada sold the QUIK DRIVE products to distributors and building supply dealers in Canada, who in turn sold them to end users. Most QUIK DRIVE products have been sold to contractors and professional builders but they have also been sold at the retail level.

Brochures showing the QUIK DRIVE mark have been distributed in Canada continuously from at least 1994 to October 14, 2004. In excess of at least 60,000 such flyers/brochures have been distributed in Canada from 1998. QUIK DRIVE products have also been promoted in Canada at trade shows.

Because the parties are competitors, Mr. Habermehl has been reluctant to disclose the exact details regarding Quik Drive Canada's sales; instead, he states that there were sales of QUIK DRIVE products in Canada in at least the tens of millions of Canadian dollars prior to each of the following dates: March 26, 2003, June 2, 2004 and October 14, 2004.

The bulk of Mr. Habermehl's evidence is directed to the QUIK DRIVE mark. He does not make any reference to a QUIKDRIVER mark, but he does provide the following evidence concerning the remaining marks relied upon by the Opponent:

- Re QD and QD 2000: QUIK DRIVE screwdriving tools are part of the QD series of tools, and in particular, the QD 2000 series of automatic screwdriving tools (see Exhibit "G", a

brochure from 2000 regarding the QD2000 series of power screwdrivers, which also refers to QUIK DRIVE bit packs);

- Re QUIKSTRIP: the trade-mark QUIKSTRIP has appeared on boxes of QUIK DRIVE screw strips sold in Canada from at least 1998 (see Exhibit “I”, packaging used in Canada).

Mr. Habermehl has been retained by the Opponent to assist it and he therefore states that he is personally aware of the Opponent’s activities in Canada with respect to the QUIK DRIVE products and that the Opponent has continued to offer for sale and sold the QUIK DRIVE, QUIKSTRIP, QD and QD 2000 products in Canada continuously since October 15, 2004. (Mr. Habermehl’s affidavit was sworn on February 15, 2005.)

During cross-examination, Mr. Habermehl confirmed that the QUIK DRIVE product packaging changed after the mark was assigned on October 15, 2004 (Question 176). He thought, but could not say for certain, that two names, Quik Drive and Simpson Strong-Tie, appear on the newer packaging. He was asked to provide an example of the Opponent’s QUIK DRIVE packaging (Question 182). This question was taken under advisement. The Opponent’s agent subsequently advised, “We continue the objection and refusal to Question 182 and will not be providing samples of additional packaging at this time.” However, the Opponent did not provide any reasons in support of its objection. Given that a valid basis for the objection and refusal is not evident, I agree with the Applicant that a negative inference should be drawn based on the Opponent’s refusal. (The Opponent did produce side panels etc. of the pre-October 15, 2004 packaging to show that Quik Drive U.S.A., Inc.’s name did appear on that packaging, pursuant to Question 102.)

I will also address the part of the cross-examination that related to paragraph 22 of Mr. Habermehl’s affidavit. Paragraph 22 reads:

Most QUIK DRIVE products have been sold in Canada to contractors and professional builders. However, QUIK DRIVE products, including power screw drivers, screw tips and bits, have been sold in Canada at the retail level. I understand that Simpson currently has plans to and intends to offer for sale and sell at retail the various QUIK DRIVE products as described above.

On cross-examination, there was the following exchange:

111. Q. When you say in the last paragraph, paragraph 22, you say you understand that Simpson currently has plans to and intends to offer for sale. Is that something that someone has told you?
A. Yes.
112. Q. Who would that be?
A. Various.
113. Q. Employees of Simpson Strong-Tie?
A. Yes.
114. Q. Current employees of Simpson Strong-Tie?
A. Yes.

It thus appears that the statement was inadmissible hearsay and I am therefore disregarding it.

Summary of Applicant's Evidence

I will summarize below what I consider to be the key portions of the evidence.

Whitehouse Affidavit

Mr. Whitehouse is the Applicant's Line of Business Director – Tools. He attests that QUIK BIT screwdrivers, five in one screw drivers and screwdriver sets have been sold since at least as early as April 2003 and that as of December 31, 2005 sales exceeded 3.6 million dollars. QUIK BIT wares are sold to the public both through Canadian Tire Associate Stores and through the Applicant's website.

Mr. Whitehouse states that thousands of advertising dollars have been spent each year to promote the QUIK BIT mark across Canada. However, given that his affidavit was signed in January 2006, that merely amounts to a statement that at least two thousand dollars were spent in each of the years 2003, 2004 and 2005.

The QUIK BIT mark was promoted in the Applicant's 2004 catalogue (Exhibit "C"). Mr. Whitehouse attests that the Applicant's catalogues are distributed to customers in every province of Canada and that 11.3 million copies of its 2005 catalogue were distributed (he does not provide the number distributed in 2004, nor does he provide an example of the 2005 catalogue).

The QUIK BIT wares were also advertised in flyers, newspaper inserts and at point of sale. Examples of flyers from 2003 and 2004 have been provided as Exhibit “D”. Mr. Whitehouse states that the number of flyers and newspaper inserts distributed on a given occasion is similar to the number of catalogues distributed for that year (but we have not been provided with the number of catalogues distributed in the years 2003 and 2004).

The Mark was also promoted orally in a television commercial at the end of 2003 (Exhibit “E”).

Mr. Whitehouse notes that the Applicant’s Mark sometimes appears incorrectly in advertisements as QUIK-BIT. However, I am not particularly concerned by this since the use of QUIK-BIT would be held to qualify as use of QUIK BIT pursuant to current jurisprudence [see e.g. *Promafil Canada Ltée v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59, *Alibi Roadhouse Inc. v. Grandma Lee’s International Holdings Ltd.*, 76 C.P.R. (3d) 326, and *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535].

As noted by Mr. Whitehouse, QUIK BIT, not QUIK-BIT, appears on the product packaging.

Walo Affidavit

Ms. Walo is a trade-mark clerk with the firm that represents the Applicant. In late 2005 or early 2006, she conducted various searches aimed at locating marks containing the word QUICK, QUIK or KWIK for use in association with tools and related wares/services. Her results include the following:

1. approximately 30 websites that offered to sell such wares to Canadians;
2. 35 such marks on the Canadian trade-marks database.

I consider the most relevant third party marks located by Ms. Walo to include the following:

1. QUICKTOOL for manufacturing of specialized cutting tools
2. QUIKUT for hand tools, namely knives, blades, saws...
3. KWIK-PRO for drywall screws

4. QUICKMILL for milling machines and drilling machines
5. QUICK LOAD for welding torches
6. QUICKSAND for sander
7. QUICK-CHANGE for Blade-left MAG-SA kit
8. QUICK CLAMP for jig saw
9. QUIK-LOK cord for drill
10. QUICK RELEASE for cutters
11. QUICK-GRIP for clamps
12. QUICK-PACK for adapter plates
13. KWIK STEPPER for bits
14. KWIK STRIPPER for wire stripper
15. KWIK CYCLE for crimp tool
16. QUICKBLADE for utility knife
17. KWIK-TITE for ratchet wrenches

Fortier Affidavit

Mr. Fortier, a private investigator, located the following wares being offered for sale in Canada in November/December 2006:

- DEWALT RAPID LOAD Quick Change Accessory System
- BLACK & DECKER jigsaws featuring QUICK CLAMP for blade changes
- BLACK & DECKER drill drivers with a QUICK CONNECT feature
- QUICK-GRIP clamps and vices
- QUICK-JAW clamps
- QUICK RELEASE tubing cutter
- QUICKSQUARE squares
- QUICK TOOL custom-made cutters
- KWIK-PRO products available at Home Depot
- KWIK START drill bit sets

Terry Affidavit

Ms. Terry, a private investigator, provides a copy of a catalogue that she obtained in Canada on November 26, 2006 that advertises QUICK-CHANGE tap adapters.

Section 30(e) ground of opposition

The Opponent has pleaded:

The Applicant's application does not comply with the requirements of s. 30(e) of the Act in that the application does not contain an accurate and true statement that the Applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the Applicant's trade-mark QUIK BIT in Canada in association with the wares recited in the application in that the Applicant (either by itself or through a licensee, or by itself and through a licensee) did not intend to use the Applicant's trade-mark QUIK BIT in Canada, particularly in view of the Applicant's stated intention in the Applicant's related Application Serial No. 1,172,463 filed on the same date, namely March 26, 2003, based also upon proposed use in Canada to register the mark QUIK BIT in association with the same statement of wares as set out in the present application.

In its amended counter statement, the Applicant denied the Opponent's allegations and also pleaded:

Further or in the alternative, the Applicant states that Simpson Strong-Tie Company, Inc. has no standing to assert the ground of opposition alleged in paragraph 1(a) of the amended statement of opposition since such a ground is not capable of being assigned, was not assigned from Quick Drive USA Inc. to Simpson Strong-Tie Company, Inc. and it is prohibited at common law since it constitutes maintenance and champerty.

In its written argument, the Applicant relied upon *Sleeman Maritimes Ltd. v. Moosehead Breweries Ltd.* (2001), 13 C.P.R. (4th) 562 (T.M.O.B.) in support of this alternative pleading.

Leaving aside the question of whether or not the Opponent has standing to assert this ground of opposition, the ground cannot succeed because there is no evidence that meets the Opponent's initial burden. Instead, we have Mr. Whitehouse's uncontested evidence that the Applicant intended to use the Mark and has in fact commenced use of the Mark in association with some of the applied-for wares.

The s. 30(e) ground is accordingly dismissed.

Section 12(1)(d) grounds of opposition

The Opponent has pleaded that the Mark is not registrable within the meaning of s. 12(1)(d) of the Act because it is confusing with the following registered trade-marks, both individually and collectively as a family:

1. QUIK DRIVE registered under No. TMA455,959 for replaceable metal screwdriver bits for power screwdrivers; belts carrying collated fasteners for feeding to fastener installation power tools; metal screw collated in a plastic holding strip for feeding to power screwdriver; collated metal screws; metal screws; fastener installation power tools; power screw drivers and parts and attachments therefor
2. QUIKSTRIP registered under No. TMA513,984 for metal screws; metal screws collated in a plastic holding strap for feeding to power screwdrivers
3. QD registered under No. TMA539,044 for power tools for fastener installation, namely, power screwdrivers and parts therefore; screwdriver attachments for power operated fastener installation tools; accessories for power fastener installation tools, namely, fastener magazines, screwdriver mandrels, replaceable metal screwdriver bits, and belts carrying collated fasteners; metal screws, collated metal screws, metal screws collated in a plastic holding strip for feeding to power screwdrivers
4. QD2000 registered under No. TMA481,523 for screwdriver attachments for power operated fastener installation tools; screwdriver attachments for driving fasteners collated in a holding strip
5. QUIKDRIVER registered under No. TMA612,070 for auto-feed screw driving tools; screwdriver attachments for power operated fastener installation tools; power tool accessories, namely, screwdriver attachments for driving fasteners collated in a holding strip; screwdriver attachments for power operated tools for the installation of threaded fasteners.

The material date for assessing the likelihood of confusion under s. 12(1)(d) is today's date [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.)]. As each of the Opponent's registrations

remains on the register, the Opponent has satisfied its initial onus under this ground.

test for confusion

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 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 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 C.P.R. (4th) 321 (S.C.C.).]

preliminary issue: family of trade-marks

The Opponent has claimed that it has a family of trade-marks but this is not born out by the evidence.

In order to rely on a family of trade-marks an opponent must prove use of each mark of the alleged family. [*McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 (T.M.O.B.); *MacDonald's Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)] In addition, the presumption of the existence of a family is rebutted where there is evidence that the alleged family's common feature is registered or used by others. [*Thomas J. Lipton Inc. v. Fletcher's Fine Foods Ltd.* (1992), 44 C.P.R. (3d) 279 (T.M.O.B.) at 286-7; *Canadian Olympic Association v. Techniquip Limited* (1999), 3 C.P.R. (4th) 219 (F.C.A.)]

The five registered marks of the Opponent do not successfully form a family. First of all, the marks QD and QD2000 differ substantially from the remaining three marks, QUIK DRIVE, QUIKSTRIP and QUIKDRIVER. Second, there is no evidence of use of QUIKDRIVER, only of QUIKSTRIP and QUICK DRIVE, and a family typically consists of more than two marks. I also note that the Opponent's marks co-exist with another QUIK-prefixed mark on the register, namely QUIKUT for hand tools (registration No. TMA159,719).

Thus the benefit bestowed by the family of marks doctrine is not available to the Opponent.

assessment of s. 6(5) factors

As the Opponent's position is strongest with respect to its QUIK DRIVE mark, I will assess the s. 6(5) factors having regard to that mark.

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

Both marks are inherently weak because both QUIK BIT and QUIK DRIVE are suggestive marks. QUIK indicates that the associated tools perform their tasks quickly. BIT is a reference to a part of some tools. DRIVE is a reference to the function of a screwdriver.

The Opponent has submitted that the unique spelling of QUIK in its mark increases its distinctiveness. I am not convinced of this both because "quik" is a phonetic equivalent of "quick" and the Opponent is not the only party who has chosen to misspell "quick" as "quik" in a trade-mark (see Ms. Walo's evidence re QUIKUT and QUIK-LOK).

As of today's date, both QUIK DRIVE and QUIK BIT have become known to some extent.

The Applicant submits that QUIK DRIVE is not presently distinctive of the Opponent because there is no evidence that the Opponent has educated the public concerning its acquisition of QUIK DRIVE and no evidence that the Opponent's name has been associated with QUIK DRIVE in the market. In this regard, the Applicant relies upon *Heintzman v. 751056 Ontario Ltd.* (1990), 34 C.P.R. (3d) 1 (F.C.T.D.) and *Wilkinson Sword (Canada) Ltd. v. Juda* (1966), 51

C.P.R. 55 (Ex. Ct.). Each of those cases concerned the expungement of a trade-mark registration on the basis that the mark was not distinctive of the current owner of the registration. In each case, the mark had been known for a long time to indicate a particular source/quality of wares. Following the assignment of the mark, the source/quality changed, without the public being informed of such change. In those circumstances, the court held that the registrations were invalid because the marks were not distinctive of the new owner. The present case is not very similar to those cited. In particular, I will note that the validity of the Opponent's registrations is not at issue in an opposition.

However if, based on the Opponent's failure to produce the Opponent's own packaging, I am entitled to draw the negative inference that the Opponent has not continued to sell QUIK DRIVE wares, then the Applicant's Mark might be more known than the Opponent's mark as of today's date. Alternatively, if the negative inference to be drawn is that subsequent to the assignment, the packaging referred to a party other than the assignee, then this would support a conclusion that the distinctiveness acquired by QUIK DRIVE through use/promotion by the assignor prior to October 14, 2004 has subsequently diminished because the associated goodwill has since October 14, 2004 enured to a party other than the assignee. Either inference has a negative impact on the extent to which the Opponent's mark has become known as of today's date.

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

The Applicant's evidence reveals that use of QUIK BIT began at least as early as April 2003 whereas the Opponent's evidence shows that QUIK DRIVE was in use in Canada by the Opponent's predecessor-in-title, Quik Drive USA Inc., from at least 1988 to October 14, 2004.

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

The parties' wares are all hand tools (or components/accessories thereof) and both parties' wares include screwdrivers, of various types. The Applicant has conceded that there may be an overlap in the channels of trade (paragraph 89, Applicant's written argument).

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

The marks resemble one another primarily because the first word of each mark is identical. Although the first component of a mark is often considered more important for the purpose of distinction, when a word is a common, descriptive or suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)].

The differences between the words BIT and DRIVE result in the marks differing somewhat in appearance, sound and idea suggested.

other surrounding circumstances

i) The Opponent's use of another QUIK-prefixed mark, QUIKSTRIP, may be considered to be a further surrounding circumstance but given the sparse evidence of such use, I do not consider it to be significant.

ii) There is no evidence showing that the Opponent's QUIK DRIVE mark has been used in Canada subsequent to 2004.

iii) The Applicant has introduced evidence of various third party marks. The Opponent's position is that only marks starting with QUIK (not any phonetic equivalent thereof) are relevant. I agree with the Opponent that the evidence regarding third party QUIK marks is insufficient to be meaningful. However, I do not agree that QUICK or KWIK marks are completely irrelevant. Based on the evidence provided by the Applicant, I am prepared to conclude that the average Canadian purchaser/user of tools and related products would be used to seeing marks that begin with a phonetic equivalent of the word "quick" from a variety of sources, at least as of 2006.

iv) More than 3.6 million dollars worth of sales of QUIK BIT tools occurred between 2003 and

December 31, 2005, without there being any evidence of confusion with QUIK DRIVE in the marketplace, despite the fact that Mr. Habermehl alleged that during the ten years preceding October 14, 2004, QUIK DRIVE products have been about 90% of the total Canadian market for power screwdriving tools, screw strips and bits.

conclusion regarding likelihood of confusion

Having considered all of the surrounding circumstances, I find that there is not a reasonable likelihood of confusion between QUIK DRIVE and QUIK BIT as of today's date. My conclusion has been supported by the fact that "quick" in various forms is today a fairly common component of trade-marks in the parties' general field.

As the Opponent's position is no stronger with respect to its other marks, all of the s. 12(1)(d) grounds of opposition are dismissed.

Before proceeding, I will reproduce a comment that was relied upon by the Applicant and made by former Chairman Metcalfe in *Societe des Produits Nestle S.A. v. Delmark Co. Inc.* (1979), 52 C.P.R. (2d) 114 at 118:

...the word "quick" **in any form** being an expression that is and must remain common to the trade, that is to say, open to the trade to use and cannot be permitted to become the subject of an extensive monopoly by any one trader.
[emphasis added]

Although this comment seems at first blush to strongly support the Applicant's position, its application to the case at hand must be tempered by the differing facts that were before Chairman Metcalfe. In particular, the cited decision concerned an opposition by the owner of the trade-mark QUIK for instant flavoured powder for addition to milk against an application for the trade-mark DELMARK QUICK for dried-food mixes having as their principal components pasta, cereals or vegetables, to be used in making main-meal preparations. Chairman Metcalfe held that both parties' wares were in the broad class of alimentary products but that their specific wares were unrelated. He also noted that the Opponent's QUIK mark, although well known, had been limited to one single product and concluded that it was only entitled to an extremely narrow ambit of protection due to its lack of inherent distinctiveness. It is of course also to be noted that

the component DELMARK has greater inherent distinctiveness than the present Applicant's BIT component, and that DELMARK, unlike BIT, appears as the first and dominant portion of the applied-for mark.

Section 16(3)(a) grounds of opposition

The Opponent has pleaded that the Applicant is not the person entitled to registration because QUIK BIT was confusing as of March 26, 2003 with each of the five trade-marks listed under the s. 12(1)(d) grounds, individually and as a family, such marks having allegedly been previously used and made known in Canada by the Opponent and its predecessor-in-title, Quik Drive USA Inc., in association with the wares covered by their respective registrations.

As set out earlier, I have already found that the Opponent cannot claim the benefit of a family of trade-marks.

Once again, I will focus my discussion on the Opponent's QUIK DRIVE mark.

The evidential burden on the Opponent under the entitlement grounds of opposition is two-fold:

1. the Opponent must demonstrate prior use or making known of its mark;
2. the Opponent must establish non-abandonment of its mark as of the date of advertisement of the Applicant's application (s. 16(5)).

The Opponent has met the first arm of its initial evidential burden with respect to its QUIK DRIVE mark, as there is evidence that this mark was in use prior to March 26, 2003. The Applicant submitted in its written argument that the Opponent has not met its onus regarding non-abandonment, but the Applicant incorrectly referred to the relevant date as November 10, 2004. As of the correct date of March 24, 2004, I find that the evidence is clear that the Opponent's predecessor-in-title (which then owned QUIK DRIVE) had not abandoned QUIK DRIVE. The Opponent has therefore also met its initial burden under s. 16(5).

The material date for determining the likelihood of confusion under s. 16(3)(a) is the filing date

of the Applicant's application, namely March 26, 2003. This substantively earlier material date results in the following differences with respect to a consideration of the likelihood of confusion under this ground as opposed to under s. 12(1)(d):

1. there was no use of the Applicant's proposed use Mark as of March 26, 2003;
2. there is no evidence that any third parties were using QUICK/QUIK/KWIK- prefixed marks in the marketplace as of March 26, 2003;
3. only the following third party marks were on the Register as of March 26, 2003 – QUICKTOOL, QUIKUT, KWIK-PRO, QUICKMILL [four registrations is insufficient to draw any inferences about the state of the marketplace: *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]
4. use of the Opponent's QUIK DRIVE mark by its predecessor-in-title had been continuous in Canada for 14 years as of March 26, 2003, with no evidence suggesting a break in its use.

In view of the foregoing differences, the Applicant has a more difficult case to meet than it did under s. 12(1)(d) and I am not satisfied that it has met its burden to show that confusion was unlikely as of March 26, 2003 with respect to the following overlapping wares: screwdrivers, ratchet screw drivers, five in one screw drivers, screwdriver set. Accordingly, the s. 16(3)(a) ground of opposition succeeds with respect to those wares based on the Opponent's predecessor's prior use of QUIK DRIVE. However, the s. 16(3)(a) ground does not succeed with respect to the remaining wares because QUIK DRIVE should only be granted a narrow ambit of protection.

Distinctiveness ground of opposition

The Opponent has pleaded that the QUIK BIT mark is not distinctive of the Applicant's wares because it does not, and is not adapted to, distinguish the wares of the Applicant from the wares of others, including the wares of the Opponent and its predecessor-in-title Quik Drive USA Inc. The material date with respect to this ground is the date of filing of the opposition, June 2, 2004.

[*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)] Once again, I will focus my analysis having regard to the Opponent's mark QUIK DRIVE.

The Opponent meets its initial burden under this ground if it shows that its trade-mark had become known sufficiently as of June 2, 2004 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.)]. The Opponent's evidence satisfies this initial burden.

Although the Applicant had commenced use of its Mark prior to June 2, 2004, I am not satisfied that it has met its evidential burden under this ground. My conclusion is based in part on the fact that there is no evidence that it was common in the parties' general field to adopt marks that begin with a form of the word QUICK as of June 2, 2004. The distinctiveness ground of opposition therefore succeeds, but only with respect to the overlapping wares, namely, screwdrivers, ratchet screw drivers, five in one screw drivers, and screwdriver set.

Section 16(3)(b) ground of opposition

This ground of opposition is not stronger than the s. 16(3)(a) grounds and therefore I see no need to address it.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act but only with respect to screwdrivers, ratchet screw drivers, five in one screw drivers, and screwdriver set. The opposition is rejected with respect to the remaining wares, namely: hand tools, namely axes, axe handles, leather axe sheaths, mitre boxes, ratcheting tool sets, levels, aluminum levels, torpedo level, sliding T level, tape measures, vice clamp, planes, block plane, chisels, wrenches, wrench holders, wire cutters, cable ripper, staple gun, staple hammer, staples, combination square, telescoping magnetic pick-up tool, magnetic pick-up tool, tube cutter, pliers, three piece mini pliers set, snap ring pliers set, locking pliers, spring clamps, wood carving sets, six piece punch and chisel set, sawhorse brackets, tote

drawer, workshop apron, electrician pouch, inspection mirror, aprons, chisel sets, sockets, vice, pouch, wood chisel, hex key sets, T handle hex key sets, ratchet wrenches and ratchet wrench sets, socket sets, snips, bolt cutters, tap and die sets, utility knives, window scrapers, wire brushes. Authority for a split decision is set out in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.).

DATED AT TORONTO, ONTARIO, THIS 6th DAY OF FEBRUARY 2009.

Jill W. Bradbury
Member
Trade-marks Opposition Board