



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

**Citation: 2010 TMOB 213**  
**Date of Decision: 2010-12-02**

**IN THE MATTER OF AN OPPOSITION by  
Home Hardware Stores Limited to  
application No. 1,340,808 for the trade-mark  
HOMEOWNER in the name of Ames True  
Temper Properties, Inc.**

[1] On March 26, 2007, Ames True Temper Properties, Inc. (the Applicant) filed an application to register the trade-mark HOMEOWNER (the Mark) based on proposed use of the Mark in Canada in association with: manually operated hand tools, namely, shovels, rakes, hoes, spades, cultivators, weeding forks, fertilizers scoops, scrapers, garden spoons, lawn edgers, post hole diggers, hand hooks, sod cutter, sod remover and replacement handles for long-handled tools (the Wares).

[2] The Applicant claims a priority date pursuant to s. 34 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), on the ground that an application for registration of the same or substantially the same trade-mark was filed in the United States of America on September 27, 2006 under serial No. 77008313.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 24, 2007.

[4] On March 25, 2008, Home Hardware Stores Limited (the Opponent) filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[5] The Opponent's evidence consists of the affidavit of James Haggerty, a trade-mark searcher employed by the trade-mark agents for the Opponent. Mr. Haggerty was instructed by the solicitor for the Opponent to print out full particulars of 72 trade-marks from the Canadian Trade-mark Register. I note that the Opponent is the owner of these marks all of which include the word HOME as an element thereof.

[6] The Applicant elected not to file any evidence.

[7] Both parties filed written arguments and were represented at a hearing.

### Statement of Opposition

[8] The grounds of opposition are reproduced hereafter:

*s. 38(2)(a) and s. 30*

- The Application does not conform to the requirements of Section 30 of the Act and more specifically to the requirements of Section 30(e) of the Act as the Applicant does not and did not, at any material time, intend to use the trade-mark in Canada in association with the wares set out in the Application.
- The Application does not conform to the requirements of Section 30 of the Act and more specifically to the requirements of Section 30(i) of the Act as the Opponent has extensively used its family of HOME trade-marks in Canada in association with a variety of goods and services including manually operated hand tools since well prior to the filing date of the Application, namely March 26, 2007. The Applicant must have been aware of the use by the Opponent of its family of HOME trade-marks in Canada and could not have been satisfied that it was entitled to use the Trade-mark in Canada in association with the wares set out in the Application since it is confusing with the Opponent's family of HOME trade-marks.

*s. 38(2)(b) and s. 12(1)(d)*

- The Trade-mark is not registrable as it is confusing with the Opponent's registered trade-marks particulars of which are provided on the attached Schedule "A"

*s. 38(2)(c) and s. 16(2)(a) / 16(3)(a)*

- The Applicant is not the person entitled to registration of the Trade-mark since, at the date of filing of the Application (i.e. March 26, 2007), the Trade-mark was

confusing with the Opponent's family of HOME trade-marks referred to above which had been previously used in Canada in association with a variety of goods and services including manually operated hand tools. The Opponent had not abandoned its family of HOME trade-marks as of the date of advertisement of the Application.

s. 38(2)(c) and s. 16(2)(b) / 16(3)(b)

- The Applicant is not the person entitled to registration of the Trade-mark since, at the date of filing of the Application (i.e. March 26, 2007), the Trade-mark was confusing with the Opponent's applications referred to on the attached Schedule "A" which had been previously filed in Canada. The Opponent's applications were pending as of the date of advertisement of the Application.

s. 38(2)(c) and s. 16(2)(c) / 16(3)(c)

- The Applicant is not the person entitled to registration of the Trade-mark since, at the date of filing of the Application (i.e. March 26, 2007), the Trade-mark was confusing with the Opponent's trade name which had been previously used in Canada for many years. The Opponent had not abandoned its trade name as of the date of advertisement of the Application.

s. 38(2)(d) and s. 2

- The Trade-mark is not distinctive. Section 2 of the Act provides that distinctive in relation to a trade-mark means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares and services of others or is adapted so to distinguish them. The Trade-mark is not and cannot be distinctive of the Applicant, nor is it adapted to distinguish the Applicant's wares from the wares and services of others and particularly from the wares and services of the Opponent.

#### Onus and material dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

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

- s. 38(2)(a) / s. 30(e) and s. 30(i) - the date of filing of the application [in this case the priority date of filing, i.e. September 27, 2006];
- s. 38(2)(b) / s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c) / s. 16(2) - the date of filing of the application [in this case the priority date of filing, i.e. September 27, 2006];
- s. 38(2)(c) / s. 16(3) - the date of filing of the application [see s. 16(3), in this case the priority date of filing, i.e. September 27, 2006];
- s. 38(2)(d) / s. 2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

### Preliminary issues

[11] At the start of the hearing the Opponent requested that the Registrar exercise her discretion to verify the register and take note of the Opponent's trade-mark HOME OWNERS HELPING HOMEOWNERS under registration No. TMA758,040 covering *inter alia*, the operation of retail hardware stores. The Applicant, taken by surprise by this late request, vigorously objected thereto indicating that this registration was never identified in the statement of opposition and it is far too late to raise an additional ground at the hearing stage.

[12] The Registrar could exercise her discretion to verify the register to confirm the status of trade-marks, but generally chooses to do so only where reference is made in the statement of opposition to a registration that forms the basis of an allegation pursuant to s. 12(1)(d) of the Act [*Quaker Oats Co. of Canada/Cie Quaker Oats du Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B)].

[13] As the Opponent failed to include said registration in its statement of opposition, I respectfully decline the Opponent's request.

[14] In turning to the Opponent's initial evidentiary burden, the Opponent has not led any evidence with respect to the grounds of opposition based on s. 30(e), s. 30(i), s. 16(3)(a), s. 16(3)(c) and s. 2 of the Act, as a result the Opponent's initial evidentiary

burden respecting these grounds has not been met. These grounds are therefore dismissed.

[15] Additionally, as the application does not include a basis for registration pursuant to s. 16(2) of the Act [use and registration abroad], the grounds pursuant to s. 16(2)(a), s. 16(2)(b) and s. 16(2)(c) of the Act are improperly pleaded and are hereby dismissed.

[16] Accordingly, my analysis will deal with the remaining grounds of opposition based on s. 12(1)(d) and s. 16(3)(b) of the Act.

Ground of opposition based on s. 12(1)(d)

[17] The Opponent alleges that the Mark is not registrable as it is confusing with its registered trade-marks identified in Schedule “A” to my decision.

[18] I have considered it appropriate in this case to exercise the Registrar's discretion to check the register and having done so, I confirm that the Opponent's marks pleaded under this ground are in good standing as of today's date [see *Quaker Oats Co. of Canada/Cie Quaker Oats du Canada v. Menu Foods Ltd.*(1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. Since the Opponent has discharged its initial burden with respect to this ground of opposition, the Applicant must establish on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's marks.

[19] I consider the Opponent's case to be strongest with respect to registration TMA381,072 for the trade-mark HOME & Deign (reproduced below)



covering a variety of wares, *inter alia*, lawn and garden care products and tools therefore namely (...) rakes, rake handles, hoes, hoe handles, shovels, shovel handles, forks, fork handles, spades, spade handles, axes, axe handles, sledges, sledge handles, picks, pick handles, weeders, pruners, grass sheers, and a number of services, *inter alia*, the operation of building supply centres and services in connection with the operation of

hardware merchants of providing facilities for quantity and economic purchase of merchandise.

[20] I will focus my discussion on that one mark of the Opponent unless otherwise indicated. Thus, the success or failure of this ground will turn on the issue of confusion with this registration.

[21] 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.

[22] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trade-marks have 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. This list is not exhaustive and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)].

*(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[23] The Mark possesses little inherent distinctiveness as it suggests that the hand tools are intended for use by home owners.

[24] Likewise, the Opponent's mark is also suggestive that the wares and services are for home use; however it possesses a greater degree of inherent distinctiveness owing to the design element.

[25] The distinctiveness of the marks may increase by the extent to which they have become known.

[26] The Applicant's application is based on proposed use and as no evidence of use has been filed since the filing of the application, I conclude that the Mark has not become known in Canada.

[27] The Opponent submits in its written argument that its HOME marks have become well-known throughout their extensive use in Canada over the last forty years. However it is recalled that the Opponent has not filed any evidence of use.

[28] Given the alleged extensive use in Canada of the Opponent's marks for over forty years, I suspect that it would have been relatively easy for the Opponent to provide evidence of use, such as volume of sales, invoices, labels, packaging, the number of hardware stores and their locations across Canada, advertising expenditures to name a few.

[29] The only evidence filed is the particulars of 72 trade-marks owned by the Opponent, 69 of which are registered. I bear in mind that this is a significant number of registrations and in this respect I am prepared to infer that the Opponent has a certain presence in the marketplace; nonetheless without any actual evidence of use I cannot make any conclusive determination as to the extent to which the Opponent's mark has become known.

[30] Under these circumstances, the mere existence of registrations can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of the Opponent's mark [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)].

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

[31] The Applicant's application is based on proposed use, whereas the Opponent's registration is based on use since August 31, 1987.

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

[32] The Applicant's application covers manually operated hand tools which directly overlap with the Opponent's wares namely, rakes, rake handles, hoes, hoe handles, shovels, shovel handles, forks, fork handles, spades, spade handles, axes, axe handles, sledges, sledge handles, picks, pick handles, weeders, pruners, grass sheers.

[33] Although there is no evidence regarding the parties' channels of trade, it is fair to presume that both parties' wares would likely be sold through similar avenues. The Applicant's Wares may also be sold through the Opponent's building supply centres. Accordingly I am of the view that the parties' trade channels could likely overlap.

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

[34] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.*, 47 C.P.R. (2) 145, conf. (1982), 60 C.P.R. (2d) 70 (F.C.A.)].

[35] It is also a well-accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [*Conde Nast Publications Inc. v. Union des éditions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

[36] In these circumstances not only is the word HOME the first portion of the marks at issue, it can be said that the Applicant has appropriated the entirety of the word portion of the Opponent's mark. In this respect the marks are similar in appearance and when sounded. The ideas suggested are slightly different, the Mark referring to the owner of a home whereas the Opponent's mark simply refers to a home.

[37] Overall, there is a fair degree of resemblance between the Mark and the Opponent's mark in appearance, sound and ideas suggested by them.



*Surrounding circumstance*

*Family of marks*

[38] As a surrounding circumstance the Opponent alleges that it holds a family of HOME trade-marks, and as such it should be afforded a wide ambit of protection, citing in support of its contention the following passage in *McDonald's Corp. v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.):

[79] (...) when trade marks which have common characteristics are registered in the name of one owner as in the case of the marks EGG MCMUFFIN, MACSUNDAE, MCCHEESE and MCFEAST, that circumstance gives rise to the presumption that such marks form a series of marks used by the one owner and the registration of such marks is tantamount to a single registration combined of those several marks.

[39] I however note that Justice Cattnach, later in that same decision goes on to state the following:

[93] While the presumption of the existence of a series of trade marks can arise at the time of an application for the registration of a trade mark with the consequence indicated the same presumption does not arise in opposition proceedings. Before any similar inference as would arise from the presumption can arise in the opposition proceedings based upon the use of other marks any such use must be established by evidence.

[94] The question therefore is whether the appellants have discharged the onus cast upon them of establishing the existence of a series of marks owned by the corporate appellant with which the application by the corporate respondent for the registration of the trade mark MCYOGURT may conflict. That is to be discharged by the establishment of the use of the trade marks sufficient to constitute a family. [emphasis added]

[40] The Opponent in *McDonald's Corp.*, *supra* had successfully discharged its onus by filing extensive evidence of use of its marks, namely, high volume of sales and widespread advertising, both exceeding millions of dollars, thus establishing its family of marks.

[41] The Opponent in the present proceeding did not file any evidence of use or advertising, and has therefore not discharged the onus cast upon it. A family can only be

found to exist where evidence is put forward of use of each of the family members which is not done here [see *McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382].

*State of the Register*

[42] At the hearing the Applicant submitted an argument based on the state of the register with respect to the element "HOME", arguing that the word "HOME" appears frequently on the register and should not be afforded a wide ambit of protection given its widespread use. No evidence supporting this claim was filed. In opposition proceedings, the Registrar does not exercise her discretion to have regard to anything appearing on the register that is not properly proved by evidence, except to verify whether properly pleaded trade-mark registrations and applications are extant, as I have done in this case. Without evidence, I am unable to make a determination on these submissions which have been disregarded [see *John Labatt Ltd. / John Labatt Ltée. v. W.C.W. Western Canada Water Enterprises Inc.* (1991), 39 C.P.R. (3d) 442].

*conclusion re likelihood of confusion*

[43] In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. The basic issue to be decided is whether a consumer who has a general and not precise recollection of the Opponent's mark, will, upon seeing the Applicant's Mark, be likely to think that the parties' wares originate from a common source. Although the common word "home" is not one that can be given a broad scope of protection given its ordinary meaning and that it is somewhat suggestive of the wares, nonetheless, in view of my conclusions above, I find that the Applicant has not satisfied the burden on it to show that there is no reasonable likelihood of confusion between its Mark and the Opponent's mark. I reach this conclusion particularly since the Applicant has appropriated the word portion of the Opponent's mark which also happens to be the first word in both marks. In this respect the first word is the most important for purposes of distinction. Moreover there is a clear overlap between the parties' wares and a potential overlap in their channels of trade.

[44] I have also considered that if there is doubt whether the registration of a trademark would cause confusion with a prior mark, the doubt must be resolved against the newcomer [*Conde Nast Publications Inc. v. Union des éditions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

[45] I therefore conclude that the Applicant has not discharged its legal onus of showing on a balance of probabilities that the Mark would not be confusing with the Opponent's mark.

[46] The ground of opposition based on s. 12(1)(d) of the Act is therefore successful.

Ground of opposition based on s. 16(3)(b)

[47] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark since at the date of filing the application the Mark was confusing with its applications referred to on the attached Schedule "A" which had been previously filed in Canada and which were pending at the date of advertisement of the Applicant's application.

[48] Insofar as the Opponent's ground of opposition is based upon the previous filing of these applications, the Opponent must show that the applications were filed prior to the filing date of the Applicant's application and must satisfy s. 16(4) of the Act which requires its applications to have been pending at the date of advertisement of the Applicant's application, *i.e.*, October 24, 2007.

[49] Once again I have considered it appropriate in this case to exercise the Registrar's discretion to check the register and I confirm that ten applications (identified below) were filed prior to the filing date of the Applicant's application and were pending at the date of advertisement of the Applicant's application [ see *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525].

- HOME HANDYMAN REPAIRS AND INSTALLATIONS & Design (No. 1,285,863) covering, *inter alia*, repair and installation services;

- HOME AT HOME & Design (No. 1,294,071) covering, *inter alia*, printed publications;
- HOME EXPRESSIONS & Design (No. 1,221,154) covering, *inter alia*, home décor products such as furniture, window coverings and bathroom accessories;
- HOME EXPRESSIONS EXPRESS YOUR PASSION FOR STYLE & Design (No. 1,221,155) covering, *inter alia*, home décor products such as furniture, window coverings and bathroom accessories;
- HOMEWORKS & Design (No. 1,310,723) covering, *inter alia*, software products designed to allow users to place products and colours on a digital image of a home;
- BEAVER HOMES & COTTAGES & Design (No. 1,290,627) covering, *inter alia*, books on home and cottage design, and the operation of an Internet website providing information in the field of home and cottage design and construction;
- BEAVER HOMES & COTTAGES A CANADIAN HOME BUILDING TRADITION & Design (No. 1,290,632) covering, *inter alia*, books on home and cottage design, and the operation of an Internet website providing information in the field of home and cottage design and construction;
- HOME FURNITURE (No. 1,280,647) covering, *inter alia*, household furniture and the operation of retail furniture stores;
- HOME GARDENER EARTH MOVER & Design (No. 1,300,513) covering shovels;
- homextra.ca (No. 1,144,931) covering, *inter alia*, promotional publications and extranet web site services to the applicant's dealers.

[50] "Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the overall surrounding circumstances." [*Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) affirmed (1982), 60 C.P.R. (2d) 70 (F.C.A.)].

[51] Bearing these principles in mind, although the above noted marks include the word HOME, I am of the view that confusion would be unlikely since when considered in their entirety these marks convey different ideas and do not resemble the Mark in any

significant way. Also, in most instances there is no overlap between the Applicant's Wares and the Opponent's wares and services.

[52] Accordingly, the s. 16(3)(b) ground of opposition is unsuccessful and is hereby dismissed.

Disposition

[53] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

---

Lynne Pelletier  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**SCHEDULE A**

	Trade-Mark	App/Reg No.
1		TMA381,072
2		TMA638,451
3		TMA510,668
4		TMA487,398














5		TMA425,959
6		TMA348,817
7		TMA384,063
8		1,285,863
9		TMA567,667
10		TMA500,988
11		1,294,071
12		TMA558,258
13		1,221,154
14		1,221,155
15		TMA647,819
16		1,310,723
17		TMA591,162
18		TMA647,170

19		TMA581,466
20		TMA575,145
21		TMA590,053
22		TMA661,115
23		TMA487,397
24		TMA363,967
25		1,330,458
26	<b>HOMEHARDWARE.COM</b>	1,121,928
27		TMA335,948
28	<b>HOME OF THE HANDY MAN</b>	TMA286,011
29	<b>HELP IS CLOSE TO HOME</b>	TMA481,663
30	 Help is close to home.	TMA481,665
31	<b>HOME AUTO CLUB</b>	TMA349,805

32		TMA310,728
33		TMA417,026
34	<b>HEMECARD</b>	TMA326,237
35	<b>A CANADIAN HOME BUILDING TRADITION</b>	1,290,628
36	<b>ALL ROADS LEAD TO HOME</b>	TMA582,442
37		1,290,627
38		1,290,632
39	 <b>GUTTER BLASTER</b>	TMA589,642
40	<b>HOME FURNITURE</b>	1,280,647
41	 <b>EARTH MOVER</b>	1,300,513
42	 <b>Lawn-food</b>	TMA613,408
43		TMA141,988



44	 <b>DRAIN HOOK</b>	TMA625,416
45	<b>HOME CRETE</b>	TMA184,655
46	<b>HOME HARDWARE.CA</b>	1,107,710
47	<b>HOMELAND FURNITURE</b>	TMA248,030
48		TMA251,551
49	<b>homextra.ca</b>	1,144,931
50	<small>THE HOME OF GREAT</small> <b>INTERIORS</b>	1,205,824
51	<b>HOME ASSEMBLY</b>	TMA331,057
52		TMA335,307
53	<b>HOME BUILDER</b>	TMA309,152
54	<b>HOME BUILDING CENTRE</b>	TMA420,924
55	<b>HOME FOR CHRISTMAS</b>	TMA515,512
56		TMA424,586
57	<b>HOME HARDWARE</b>	TMA276,387
58		TMA294,304
59	<b>HOME PAINTER</b>	TMA331,212
60		TMA301,874
61	<b>HOME SECURITY</b>	TMA327,549

62		TMA295,550
63		TMA300,488
64		TMA317,390
65		TMA296,652
66		TMA306,965
67		TMA306,966
68		TMA286,453
69		TMA297,566
70		TMA387,162
71		TMA384,360
72		TMA295,655
73		TMA329,231
74		TMA272,564