



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

Citation: 2011 TMOB 42
Date of Decision: 2011-03-08

**IN THE MATTER OF AN OPPOSITION by
Pélican International Inc. to application
No. 1,328,262 for the trade-mark RAMTUFF
in the name of GSC Technologies Corp.**

[1] On December 14, 2006, GSC Technologies Corp. (the Applicant) filed an application to register the trade-mark RAMTUFF (the Mark) based upon use of the Mark in Canada since at least as early as November 1, 2006 in association with the following wares: “boats, pedal boats, canoes, kayaks; molded plastic hulls for boats, pedal boats, canoes and kayaks”.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 26, 2007.

[3] On February 26, 2008, Pélican International Inc. (the Opponent) filed a statement of opposition claiming that the application does not conform to the requirements of s. 30(b) and (i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The statement of opposition also claims that the Mark is not registrable pursuant to s. 12(1)(d) of the Act, that it is non-distinctive of the Applicant pursuant to s. 2 and 38(2)(d) of the Act, and that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1)(a) of the Act, in view of the fact that the Mark is confusing with the following registered trade-marks of the Opponent, which have been used in Canada in association with, *inter alia*, pleasure crafts and the plastic components thereof prior to the date of first use claimed in the Applicant’s application, and continue to be used by the Opponent:

- RAM-X registered under No. TMA244,120 on May 2, 1980 in association with “molded plastic components of boats; plastic materials for toys and sporting goods”. The registration claims use of the mark in Canada since at least as early as August 15, 1978; and
- RAMXCEL registered under No. TMA646,894 on August 30, 2005 in association with “plastic materials for toys and sporting goods”. The registration claims use of the mark in Canada since at least as early as March, 2004.

(the two marks will be hereinafter referred to collectively as the Cited Marks)

[4] The Applicant filed and served a counter statement in which it denies the Opponent’s allegations.

[5] In support of its opposition, the Opponent filed the affidavit of Éloïse Lehmann, a legal clerk in the employ of the law firm representing the Opponent in this proceeding, sworn August 14, 2008, as well as certified copies of registration Nos. TMA244,120 and TMA646,894. In support of its application, the Applicant filed the affidavit of Robert Farber, the President and Director of Marketing Operations of the Applicant, sworn February 16, 2009.

[6] Both parties filed a written argument and attended at an oral hearing.

Onus

[7] 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Summary of the evidence

The Opponent's evidence – the Lehmann affidavit

[8] Ms. Lehmann states in her affidavit that she was instructed to conduct various searches on the website of “Future Beach” at *www.futurebeach.com* and print out the results thereof, as well as attach a copy of two letters, namely a December 4, 2006 cease and desist letter addressed to the Applicant and a December 8, 2006 letter from the law firm representing the Applicant in this proceeding acknowledging receipt. I will revert to the exhibits attached to Ms. Lehmann's affidavit later on in my decision when assessing the s. 30(b) and (i) grounds of opposition. However, it is to be noted at the outset that the Lehmann affidavit shows no evidence, of any kind, of the use of the Cited Marks, nor any evidence, whatsoever, as to the distinctiveness of the Cited Marks or the goodwill or reputation associated with the Cited Marks.

[9] It is also to be noted that the Lehmann affidavit does not support the claim made in the Opponent's statement of opposition that the Opponent is a world leader in the design and manufacturing of pleasure crafts made of plastic materials, that it ranks third in the world among businesses in the manufacture of kayaks, and that it also produces canoes, pedal boats, fishing boats and numerous accessories and parts for the watercraft which it manufactures.

The Applicant's evidence – the Farber affidavit

[10] Mr. Farber states in his affidavit that “[s]ince its creation in 1982, [the Applicant] has been manufacturing a variety of plastic goods. Today, [the Applicant] is a leading manufacturer and designer of a variety of plastic goods including storage and organisation products, folding tables and chairs, closet systems, sporting goods and other household products” [paragraph 2 of his affidavit].

[11] Mr. Farber states that “[the Applicant] began using [the Mark] in association with molded plastic hulls for boats, pedal boats, canoes and kayaks (hereinafter referred to as the “RAMTUFF

Wares”) since at least as early as November 1, 2006” [paragraph 3 of his affidavit]. It is to be noted that while Mr. Farber states that he will refer to the aforementioned wares as the “RAMTUFF Wares”, such wares do not cover the other category of wares described in the Applicant’s application, namely the wares described as “boats, pedal boats, canoes, kayaks”.

[12] Mr. Farber states that in March 2007, he incorporated a separate entity by the name of Future Beach Leisure Products Corporation (Future Beach), through which the Applicant markets its sporting goods, including the RAMTUFF Wares and he attaches as Exhibit RF-1 a copy of the corporate particulars of Future Beach as found on the Québec Corporation Registry. He further states that as President and Director of Manufacturing Operations of the Applicant and as sole shareholder and director of Future Beach, he has control over the activities of both companies. He also confirms that Future Beach’s use of the Mark was and has always been under license by the Applicant, and that the Applicant controls and always controlled the character and quality of the wares sold by Future Beach under license. Exhibit RF-2 to his affidavit shows that the Applicant had granted a non-exclusive license to Future Beach over, *inter alia*, the Applicant’s Mark at least as early as March 2007, and that this license was formalized in writing on September 1, 2008 [paragraphs 4 and 5 of his affidavit].

[13] Mr. Farber states that “[s]ince the Applicant began using the [Mark] in Canada in association with the RAMTUFF Wares, sales for said Wares have exceeded” \$1,700,000 and \$1,900,000 for the years 2007 and 2008 respectively. However, he does not provide a breakdown of annual sales for each of the Applicant’s wares.

[14] Mr. Farber then attaches as Exhibit RF-3 “a sampling of representative invoices, dated as far back as July 31, 2006 relating to the sale of the RAMTUFF Wares by [the Applicant] or [Future Beach]”. Mr. Farber adds that these invoices “relate to sales of pedal boats, canoes and kayaks featuring molded plastic hulls under the [Mark]” [paragraph 6 of his affidavit].

[15] The sampling of invoices filed as Exhibit RF-3 consists of three invoices issued by the Applicant to Canadian retailers dated July 31, 2006, and June 18 and July 3, 2007 respectively. The fact that the 2007 invoices were issued by the Applicant rather than its licensee Future

Beach is not detrimental to the Applicant as there is no provision in the license agreement mentioned above preventing the Applicant from selling the licensed wares to others. That said, there is no reference to the Mark or any of the Applicant's wares in the invoices. The invoices refer only to model numbers. However, it is possible to cross-reference some of these model numbers with the ones indicated in the printouts of Future Beach's website attached to the Lehmann affidavit. I will revert to this point later on in my decision when assessing the s. 30(b) ground of opposition.

[16] Mr. Farber concludes his affidavit by stating that "RAMTUFF Wares are sold across Canada through sports equipment retailers with multiple locations, such as Sport Experts, as well as through specialized water recreational products retailers such as Muskoka Paddle Shack" [paragraph 7 of his affidavit].

Analysis of the grounds of opposition

[17] I will now assess each of the grounds of opposition without necessarily respecting the order in which they were raised in the statement of opposition.

Section 16(1)(a) ground of opposition

[18] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(1)(a) of the Act in that at the date of first use claimed in the Applicant's application, the Mark was confusing with the Cited Marks of the Opponent, which had been previously used in Canada by the Opponent in association with, *inter alia*, pleasure crafts and the plastic components thereof and continue to be so used.

[19] An opponent meets its evidential burden with respect to a s. 16(1)(a) ground if it shows that as of the date of first use claimed in the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [s. 16(5) of the Act]. As per my review above of the Opponent's evidence, the Opponent has failed to meet its burden.

[20] Accordingly, the s. 16(1)(a) ground is dismissed.

Non-distinctiveness ground of opposition

[21] The Opponent has pleaded that the Mark does not distinguish the Applicant's wares from those of others, including the wares of the Opponent in light of the Cited Marks previously used in Canada by the Opponent.

[22] An opponent meets its initial onus with respect to a non-distinctiveness ground if it shows that as of the filing of the opposition its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D)]. As per my review above of the Opponent's evidence, the Opponent has failed to meet its burden.

[23] Accordingly, the non-distinctiveness ground of opposition is dismissed.

Section 30(i) ground of opposition

[24] The Opponent has pleaded that the application does not comply with the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the wares listed therein as:

- (i) the Opponent had informed the Applicant of the Opponent's rights in the Cited Marks before the date of filing of the Applicant's application; and
- (ii) the Mark is likely to depreciate the value of the goodwill associated with the Cited Marks contrary to s. 22 of the Act.

[25] The material date for considering the circumstances respecting the issue of non-compliance with s. 30(i) is the date of filing of the application [see *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 (T.M.O.B.)].

[26] In support of its allegations, the Opponent relies on the copy of the cease and desist letter dated December 4, 2006 attached as Exhibit EL-5 to the Lehmann affidavit as well as the copy of the December 8, 2006 letter from the law firm representing the Applicant acknowledging receipt attached as Exhibit EL-6.

[27] The Applicant submits for its part that the mere fact that the Applicant received a cease and desist letter from the Opponent, in which a claim is made of confusion between the Mark and the Cited Marks, is not sufficient to conclude that the Applicant could not have been satisfied that it was entitled to use the Mark. The Applicant submits that, notwithstanding the cease and desist letter, the Applicant was, at the date of filing of the application, of the opinion that the Mark would not likely cause confusion or any depreciation of the goodwill associated with the Cited Marks.

[28] In support of its allegations, the Applicant relies on the decision of this Board in *Pharmacyclics Inc. v. McKesson Canada Corporation* (unreported, rendered on September 11, 2008). In that decision, the applicant had approached the opponent, prior to the application date, to try to negotiate a co-existence agreement. At page 8 of that decision of mine, I held that such negotiations or discussions were by no means inconsistent with the fact that the applicant might be satisfied that it was entitled to use its mark in Canada. Similarly, and as indicated above, the Applicant submits that the mere receipt of a cease and desist letter by the Applicant in the present case is by no means inconsistent with the fact that the Applicant was satisfied that it was, and is, entitled to use the Mark. I agree.

[29] The Opponent's evidence merely shows that a cease and desist letter was sent to the Applicant, and that the Applicant was thus aware of the Cited Marks. As stated by the Registrar, with a reference to a previous version of s. 30(i), in *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155:

Section 29(i) merely requires "a statement that the applicant is satisfied" and in this case the application does contain such a statement. Taken in the context of s. 29 and in the light of the meaning of the word "statement" there would appear to be substance to the view that

the mere inclusion of that statement in the application satisfies the requirement of para. (i). It may be felt that, if that is the correct view, para. (i) serves no useful purpose. However, even if that is the correct view, para. (i) may act as a deterrent to the would-be applicant whose conscience causes him to have a clear doubt about his right to use.

Unless there is evidence of bad faith on the part of the applicant, there would appear to be no case in which the allegation of confusion could not be more directly and more appropriately raised under either s. 37(2)(b) or (c). Even where there is evidence of bad faith, such evidence would be equally pertinent under those two paragraphs.

[30] In the present case, there is no evidence of bad faith on the part of the Applicant. Furthermore, as the Opponent has failed to adduce any evidence as to the goodwill or reputation associated with the Cited Marks, it is not necessary for me to discuss the second part of the Opponent's pleading based on s. 30(i) and 22 of the Act.

[31] Accordingly, the s. 30(i) ground of opposition is dismissed.

Section 30(b) ground of opposition

[32] The Opponent has pleaded that the application does not comply with the requirements of s. 30(b) of the Act in that the Applicant had never used the Mark within the meaning of s. 4 of the Act, or, alternatively, that the Applicant had not used the Mark before the date of filing of the application.

[33] The material date for considering the circumstances respecting the issue of non-compliance with s. 30(b) is the date of filing of the application [see *Georgia-Pacific Corporation v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)].

[34] To the extent that the relevant facts pertaining to this ground of opposition are more readily available to the Applicant, the evidential burden on the Opponent with respect to such a ground of opposition is lower [see *Tune Masters v. Mr. P.'s Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)]. Also, the Opponent may rely upon the Applicant's evidence provided however that such evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156

(T.M.O.B.)). In this regard, s. 30(b) of the Act requires that there be continuous use of the trademark applied for since the date claimed [see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.)].

[35] This brings me to discuss in further detail the evidence of use of the Mark filed through the Farber affidavit in light of the results of the searches conducted over the Internet in respect of the Mark attached to the Lehmann affidavit.

[36] As per my review above of the Farber affidavit, the Applicant's evidence pertains only to the alleged use of the Mark in association with the RAMTUFF Wares defined by Mr. Farber as "molded plastic hulls for boats, pedal boats, canoes and kayaks" [paragraphs 3, 4, 6 and 7 of the Farber affidavit]. The only reference to any of the remaining wares listed in the Applicant's application is found in paragraph 6 where Mr. Farber states that "[t]he invoices, Exhibit RF-3, relate to sales of pedal boats, canoes and kayaks featuring molded plastic hulls under the [Mark]". There is no reference whatsoever to use of the Mark in association with "boats".

[37] As stressed by the Opponent, the Farber affidavit contains no representations showing the Mark on any of the wares listed in the Applicant's application or their packaging, or showing that the Mark is otherwise associated with the wares in any way. The Farber affidavit does not contain any clear statement of fact that the Mark ever appeared thereon.

[38] The only exhibits filed by the Applicant purporting to evidence use of the Mark as claimed in the application consist of the invoices attached as Exhibit RF-3, which by themselves do not demonstrate use of the Mark within the meaning of s. 4 of the Act. As indicated above, the invoices do not mention the Mark or identify the name of the wares listed in the application. It is to be noted also that two of the three invoices filed are dated after the material date. However, as indicated above, it is possible to cross-reference some of the model numbers referred to in the invoices with the ones indicated in the printouts of Future Beach's website attached to the Lehmann affidavit.

[39] More particularly, the printouts attached as Exhibits EL-1, EL-2 and EL-4 to the

Lehmann affidavit show color pictures with one or two different views (view from the top and/or perspective view) of pedal boats, kayaks, slides, water hammocks and water bicycles on pages where reference is made to various model numbers (such as “WB 202MX”, “CK 100”, etc.) and “RAM TUFF® material...UV resistant” in the text and which display a RAM TUFF & design logo, but not on the products themselves, with the exception of some kayak models. The printouts attached as Exhibit EL-3 show similar information in respect of canoes, except that the reference to “RAM TUFF®” has been replaced by “RAM LINK™2” or “RAM LINK™3”. The pictures shown in Exhibit EL-3 do not display the “RAM LINK” trade-mark on the product themselves.

[40] Cross-referencing the model numbers referred to in the invoices RF-3 with the ones referred to in the printouts EL-1 to EL-4, the invoices would appear to relate only to the sale of pedal boats, kayaks, water hammocks and water bicycles. Water hammocks and water bicycles are not listed in the Applicant’s application. Furthermore, and as indicated above, while the printouts attached as Exhibit EL-1 refer to pedal boats made of “RAM TUFF® material...UV resistant” and display a RAM TUFF & design logo, such logo does not appear on the pedal boats themselves. There is no indication as to how the Mark is affixed on such wares or on their packaging or is in any other manner associated with the wares at the time of the transfer of the property of the wares. This leaves us with the kayak sales.

[41] As indicated above, according to the pictures shown in Exhibit EL-2, the RAM TUFF & design logo appears to be displayed on some, but not all, kayak models. It does not appear on the model number “CK 100” referred to in the invoice RF-3 dated July 31, 2006. There is no indication that the few kayak models displaying the RAM TUFF & design logo (amounting to use of the Mark in accordance with s. 4 of the Act) advertised on Future Beach’s website as of August 13, 2008 (that is the date of Ms. Lehmann’s searches) were offered for sale at the date of first use claimed in the Applicant’s application.

[42] While the Applicant was under no obligation to positively evidence use of the Mark since the date of first use claimed in its application, the Applicant elected to file evidence. As per my review of the Applicant’s evidence, the Farber affidavit is quite laconic. Mr. Farber’s statements

of use of the Mark merely constitute bald assertions of use as opposed to assertions of facts showing use. By comparison, the Lehmann affidavit evidences quite extensive searches conducted on Future Beach's website in respect of both the Mark and the wares covered by the Applicant's application. Cross-referencing the information found in Exhibits EL-1 to EL-4 attached to the Lehmann affidavit with the one provided by Mr. Farber, I find that the Applicant's evidence of use of the Mark raises more questions than it provides evidence of use of the Mark in the normal course of trade pursuant to s. 4 of the Act to the date of filing of the application. Thus, I find the Opponent has satisfied the light evidential burden upon it.

[43] In view of the foregoing, I conclude that the s. 30(b) ground of opposition succeeds on the basis that the Applicant has not met its burden.

Section 12(1)(d) ground of opposition

[44] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with the above-described registered Cited Marks of the Opponent. The material date to assess this issue is 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.)].

[45] The Opponent has provided certified copies of both registrations. As they are extant, the Opponent's evidential burden has been satisfied.

[46] The Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and either one or both of the Cited Marks.

[47] 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.

[48] 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; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[49] There is no debate between the parties that the Mark as well as both of the Cited Marks are coined terms that have equivalent inherent distinctiveness.

[50] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. While the Opponent's registrations claim use of the RAM-X and RAMXCEL trade-marks in Canada since at least as early as August 15, 1978 and March 2004 respectively, the Opponent provided no evidence, whatsoever, of its alleged use of the Cited Marks. In the absence of evidence supporting such dates of first use, a claimed date of first use set forth in a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant or continuing use of the Cited Marks.

[51] As for the Applicant's Mark, while Mr. Farber states in his affidavit that since the Applicant began using the Mark in Canada in association with the RAMTUFF Wares, sales for such Wares have exceeded \$1,700,000 and \$1,900,000 for the years 2007 and 2008 respectively, he does not provide a breakdown of annual sales for each of the Applicant's wares. Furthermore, as per my findings above under the s. 30(b) ground of opposition, there is no indication as to how the Mark is affixed on the wares themselves or on their packaging or is in any other manner associated with the wares at the time of the transfer of the property of the wares (except for some kayak models). Thus, I can hardly ascribe any reputation of note to the Mark.

[52] Turning to the nature of the wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the registrations referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[53] The Opponent's registration Nos. TMA244,120 and TMA646,894 cover "molded plastic components of boats; plastic materials for toys and sporting goods" and "plastic materials for toys and sporting goods", respectively. As stressed by the Opponent, it is readily apparent that the wares described as "molded plastic components of boats" covered by registration No. TMA244,120 overlap directly with the Applicant's wares described as "molded plastic hulls for boats, pedal boats, canoes and kayaks". It is fair to assume, in the absence of evidence to the contrary, that their channels of trade could be identical or overlap.

[54] As for the wares described as "plastic material for [...] sporting goods" covered by both of the Opponent's registrations, I agree with the Opponent that such designation may encompass such sporting goods as boats, pedal boats, canoes and kayaks. As such, I agree with the Opponent that there may be some connection between the wares "plastic material for sporting goods", which includes boats, pedal boats, canoes and kayaks, and the wares listed in the Applicant's application as "boats, pedal boats, canoes, kayaks", the former being the materials out of which the latter are made.

[55] The evidence of record further supports the above findings. As per my review above of the Applicant's evidence, Mr. Farber describes the Applicant as a "manufacturer and designer of a variety of plastic goods including [...] sporting goods" and Future Beach as the entity "through which the Applicant markets its sporting goods, including the RAMTUFF Wares" [paragraphs 2

and 4 of his affidavit]. The printouts attached as Exhibits EL-1, EL-2 and EL-4 to Ms. Lehmann's affidavit further refer to the Mark as the material out of which are made the Applicant's pedal boats, kayaks, slides, water hammocks and water bicycles.

[56] Turning to the degree of resemblance between the parties' trade-marks, both the Opponent's RAM-X and RAMXCEL trade-marks and the Applicant's RAMTUFF Mark have an identical first component, which is inherently distinctive although the word RAM suggests in the context of the wares that such wares are robust, solid or resistant.

[57] It is a well accepted principle that the first portion of a trade-mark is generally the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union Des Éditions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) and *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 (F.C.T.D.)]. As stressed by the Opponent, this is even more so in circumstances where the other components of the trade-marks in question are not as inherently distinctive, as is the case with the trade-mark RAM-X, the second portion of which is the letter "X" evoking size, and the trade-marks RAMXCEL and RAMTUFF, the second portion of which being suggestive of excellence and solidity and strength ("tough"), respectively.

[58] It is also a well accepted principle that the likelihood of confusion is a matter of first impression and imperfect recollection. As reiterated by the Supreme Court in *Veuve Clicquot, supra*:

20 The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the name *Clicquot* on the respondents' storefront or invoice, at a time when he or she has no more than an imperfect recollection of the VEUVE CLICQUOT trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks. As stated by Pigeon J. in *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.* (1968), [1969] S.C.R. 192 (S.C.C.), at p. 202:

It is no doubt true that if one examines both marks carefully, he will readily distinguish them. However, this is not the basis on which one should decide whether there is any likelihood of confusion.

...the marks will not normally be seen side by side and [the Court must] guard against the danger that a person seeing the new mark may think that it is the same as one he has seen

before, or even that it is a new or associated mark of the proprietor of the former mark. (Citing in part *Halsbury's Laws of England*, 3rd ed., vol. 38, para. 989, at p. 590.)

[59] Applying these principles to the present case, I find there is a relatively fair degree of resemblance between the Mark and the Cited Marks owing to their first identical component “RAM”, which dominates the other components thereof. While the second portions of the parties’ marks differ in appearance, sound and ideas, the overall impression created by each of the parties’ marks considered as a whole is that the wares sold in association therewith are robust, solid or resistant.

[60] Before concluding on the likelihood of confusion, I wish to address the Applicant’s submission made in its written argument and at the oral hearing that it is the owner of trade-mark registration No. TMA621,197 for the trade-mark RAMTUFF for use in association with “trash cans, blow moulded plastic tables with folding metal legs, waste baskets, laundry baskets, laundry hampers, moulded tote boxes, moulded recycle bin boxes, plastic storage boxes and plastic drawers”.

[61] More particularly, the Applicant submits that in light of such registration, the trade-mark RAMTUFF is already known by Canadian consumers and associated with the Applicant. The Applicant submits that there is no likelihood of confusion in expanding the wares in association with which the trade-mark RAMTUFF is used. I do not accept this submission.

[62] There is no evidence of record supporting the Applicant’s submission. Furthermore, it is well-established by the jurisprudence that although s. 19 of the Act gives the owner of a registration the exclusive right to the use of that mark with respect to the wares and services covered by the registration, it does not necessarily follow that the registered owner is given an automatic right to obtain any further registrations no matter how closely related they may be to the original registration [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Ménagers Coronet Inc.* (1984), 4 C.P.R. (3d) 108 (T.M.O.B.) at 115].

Conclusion re: likelihood of confusion

[63] As indicated above, the Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. The presence of an onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant [see *John Labatt, supra*].

[64] In view of my analysis above, I find that the Applicant has not met its legal onus to show that it is not reasonably likely that an individual who has an imperfect recollection of the Opponent's RAM-X and RAMXCEL marks as applied to the Opponent's molded plastic components of boats or plastic materials for sporting goods would not as a matter of immediate impression conclude that the Applicant's wares share a common source.

[65] In view of the foregoing, I conclude that the s. 12(1)(d) ground of opposition succeeds.

Disposition

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

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office