



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 135**

**Date of Decision: 2020-11-30**

**IN THE MATTER OF AN OPPOSITION**

**GT Hiring Solutions (2005) Inc.**

**Opponent**

**and**

**Building and Construction Trades  
Department of the American  
Federation of Labor/Congress of  
Industrial Organizations**

**Applicant**

**1,643,785 for HIGH SCHOOLS TO  
HARDHATS**

**Application**

INTRODUCTION

[1] GT Hiring Solutions (2005) Inc. (the Opponent) opposes registration of the trademark HIGH SCHOOLS TO HARDHATS, applied for under application No. 1,643,785 by Building and Construction Trades Department of the American Federation of Labor/Congress of Industrial Organizations (the Applicant or BCTD).

[2] The application was filed based on proposed use in Canada in association with the following services, as amended:

- (1) Employment services aimed at high school students who are family members of veterans and reservists of the Canadian Armed Forces, namely recruitment,

placement, training and networking, for jobs and apprenticeship programs in the construction industry.

(the Services)

[3] A key issue in this proceeding is the likelihood of confusion with the Opponent's registered trademark HARDHATS in association with the services "training and placement in jobs of unemployed individuals including those on income assistance or employment/unemployment insurance".

[4] For the reasons set out below, the opposition is rejected.

#### THE RECORD

[5] The Applicant filed the application for the Mark on September 16, 2013. The application was advertised for opposition purposes in the *Trademarks Journal* of October 5, 2016.

[6] On March 6, 2017, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded by the Opponent include sections 12(1)(d), 16(3)(a), 2, and 30 of the Act. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[7] The Applicant filed a counter statement on August 22, 2017 denying the grounds of opposition.

[8] Both parties filed evidence and written representations. Only the Applicant was represented at a hearing.

[9] Before assessing the allegations advanced in the statement of opposition, I will briefly review the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

## OVERVIEW OF THE EVIDENCE

### **Opponent's evidence**

[10] The Opponent filed a certified copy of registration No. TMA625,476 for the trademark HARDHATS. The Opponent also filed the affidavits of Frank Bourree (sworn December 18, 2017) and Dulce Campos (sworn December 22, 2017).

[11] Mr. Bourree is an officer and director of the Opponent. He provides the particulars of the Opponent's registration, makes a confirmatory statement regarding the Opponent's use and non-abandonment of its trademark, and attaches what he describes as an example of the "current brochure for the HARDHATS program offered". Ms. Campos, a trademark researcher and assistant employed by the agent for the Opponent, provides copies of various documents including: a Certificate in Good Standing from the BC Corporate Registrar for the Opponent; domain name particulars for *www.hardhats.ca*; printouts of the current website *www.hardhats.ca* as well as archived pages of this website from the Internet Wayback Machine's Internet Archive; and a printout of the current website *www.gthiringsolutions.ca*.

### **Applicant's evidence**

[12] The Applicant's evidence consists of the affidavit of Joseph Maloney (sworn April 9, 2018), a Director, Officer and member of the Executive of the Applicant since approximately 1993 (para 1). The Maloney affidavit mainly provides information on a related employment program of the Applicant for veterans leaving the Canadian military, provided under the trademarks HELMETS TO HARDHATS, a French version thereof, and a bilingual logo design mark. Mr. Maloney also discusses some of the Applicant's initiatives geared towards high school students and young adults to educate them on the job opportunities available in the building and construction trades, most recently the Services offered under applied-for trademark HIGH SCHOOLS TO HARDHATS.

[13] Mr. Maloney attests to, *inter alia*, the following:

- The Applicant represents fourteen Building and Construction Unions and roughly 500,000 workers in Canada. It coordinates the activities of the various building and

construction trades and plays a significant role in ensuring these industries continue to grow and thrive (para 4).

- In 2006, among his activities with the Applicant, Mr. Maloney was instrumental in establishing a national program, operated in association with the trademark HELMETS TO HARDHATS, that provides employment opportunities to veterans leaving the military for civilian jobs in the building and construction trades (paras 5, 6).
- The Applicant owns a registration for the trademark HELMETS TO HARDHATS (TMA688,696) which issued in May 2007 in association with “employment services limited to veterans leaving the Canadian military for jobs in the construction industry” (paras 10, 11; Exhibit 2). The Applicant also owns a registration for the French language version of the mark, DU REGIMENT AUX BATIMENTS, and the English/French bilingual logo version, HELMETS TO HARDHATS, DU REGIMENT AUX BATIMENTS & DESIGN, which issued in June and August, 2013, respectively (paras 12, 13; Exhibit 3) (collectively identified as the HELMETS TO HARDHATS Marks).
- To assist the Applicant in operating the HELMETS TO HARDHATS program, the Applicant established 8024499 Canada Association, a not for profit corporation (the 802 Company), on November 25, 2011. Mr. Maloney was named a first Director of the 802 Company, a position which he continues to hold (paras 16, 17; Exhibit 5).
- Mr. Maloney states that the 802 Company has at all times been licensed by the Applicant to use the HELMETS TO HARDHATS Marks, as well as the subject Mark in association with the services listed in the registrations and the subject application (para 18).
- Exhibit 6 is copy of a document entitled “HELMETS TO HARDHATS Canada Business Plan”, which provides a guideline regarding the goals, objectives, operations and marketing plan for the HELMETS TO HARDHATS program. Mr. Maloney states that this document has appeared online on the website (which website is not identified, though I note that the website address *www.buildingtrades.ca* appears on the document’s cover page) since at least June 2008, and has been shared with groups including the federal and

various provincial governments, and industry participants (para 19). The document displays the HELMETS TO HARDHATS trademark. I note that the document also refers to “Helmets to Hardhats Canada (H2H)” as the not for profit organization operating the HELMETS TO HARDHATS program.

- Exhibit 7 consists of copies of pages, printed February 17, 2015, from the Helmets to Hardhats English language website at *www.helmetstohardhats.ca*. The website is bilingual and a link to the French language version is available online. The pages display various of the HELMETS TO HARDHATS Marks and provide information on the HELMETS TO HARDHATS program and services, including its operation, participant testimonials, training and occupations information, and questions and answers regarding the scope, operation and benefits of the program (paras 21, 22). I note that the webpages identify “Helmets to Hardhats Canada” and/or H2H as the not for profit entity operating the program.
- Interested vets are required to register in the HELMETS TO HARDHATS program via the web-based system (which appears on the *www.helmetstohardhats.ca* website) (para 7, Exhibit 7). Since the HELMETS TO HARDHATS program began operating, over 6000 vets have registered, so as to learn more about the program, explore potential new employment options, or to actively seek new career opportunities (para 24).
- The Applicant has also been involved in a number of initiatives for jobs and apprenticeship programs in the construction industry aimed at high school students and young adults (para 27). In conjunction with these programs, the Applicant adopted the Mark in September 2013, by filing an application for same on a proposed use basis with the Canadian Trademarks Office (para 35).
- Since at least December 2017, the Mark has appeared on the Helmets to Hardhats website at *www.helmetstohardhats.ca* (para 36). Exhibit 15 contains printouts of pages, dated December 28, 2017, from this website displaying the Mark in association with the advertising of the Services.

## ONUS AND MATERIAL DATES

[14] 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

- Sections 38(2)(a)/30 – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(b)/12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trademarks* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(3)(a) – the date of filing of the application; and
- Sections 38(2)(d)/2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 , 34 CPR (4th) 317 at 324 (FC)].

## ANALYSIS OF THE GROUNDS OF OPPOSITION

### **Section 30(a) ground**

[16] While a ground of opposition under section 30(a) of the Act was pleaded in the statement of opposition, the Opponent subsequently withdrew this ground in its written argument.

### **Section 30(i) ground**

[17] The Opponent has pleaded that contrary to section 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Services. In particular, the Opponent has pleaded that the Applicant was aware of the Opponent's

earlier use and registration of the Opponent's registered trademark, with which the Mark was and is confusing.

[18] Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The application for the Mark contains the requisite statement and there is no evidence that this is an exceptional case. Accordingly, this ground of opposition is summarily rejected.

### **Section 30(e) ground**

[19] The Opponent has pleaded that the application does not conform to the requirements of section 30(e) of the Act because at the material date, the Applicant, by itself, or through a licensee, or by itself and through a licensee, did not intend to use the Mark in Canada.

[20] As I understand it, the Opponent's primary argument is that the Maloney affidavit establishes that the Applicant's HELMETS TO HARDHATS program and marks are managed, operated and used by the entity 'Helmets to Hardhats Canada' and not by the Applicant. The Opponent submits that the Applicant's evidence does not show that the named licensee 802 Company or Helmets to Hardhats Canada or H2H has been using the Applicant's trademarks in Canada under license in compliance with section 50 of the Act. The Opponent takes the position that the Applicant's evidence clearly indicates that it intends to use the Mark in Canada in the same manner in which it has used its other trademarks, with the result that the Opponent has raised sufficient doubt concerning the veracity of the Applicant's claimed intention to use the Mark.

### **The Opponent fails to meet its evidential burden**

[21] Since the facts concerning the Applicant's intentions are primarily within the knowledge of the Applicant, the burden of proof on the Opponent with respect to this ground is lighter [*Molson Canada v Anheuser-Busch Inc* (2003), 2003 FC 1287, 29 CPR (4th) 315 (FCTD); *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB)]. The Opponent may rely on its own evidence and the Applicant's evidence [*Labatt Brewing Company Limited v*

*Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD)]. However, the Opponent may only rely on the Applicant's evidence if it is clearly inconsistent or puts into issue the claims set forth in the Applicant's application. On this issue, all of the pertinent evidence of record is to be assessed according to the usual criteria, that is, taking into consideration its provenance (including its quality and reliability), the absence of evidence that might reasonably be expected to exist, whether the evidence has been tested on cross-examination and if so, how it fared. Multiple diverse considerations inform the assessment of evidence [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323 at para 37].

[22] In this case, the Opponent relies on the Applicant's evidence to meet its onus. The Opponent alleges that the Maloney affidavit is deficient in several respects, most notably in that it does not show any use of the Applicant's marks by the Applicant or the 802 Company but rather by the entity "Helmets to Hardhats Canada", and that the affiant provides no information on this entity, such that any use of the Applicant's trademarks cannot be considered to enure to the benefit of the Applicant.

[23] I agree with the Opponent that there are shortcomings in the Maloney affidavit, particularly as it relates to the identification and role of the entity "Helmets to Hardhats Canada". At the hearing, counsel for the Applicant explained that the Applicant's licensor, 802 Company, uses "Helmets to Hardhats Canada" as a trade name, which provides some clarity. However, as this evidence is not of record, I am not prepared to confirm this finding. In any event, even with the shortcomings in the Applicant's evidence, I do not consider there to be anything in the Maloney affidavit that is clearly inconsistent with or puts into issue the Applicant's statement of its intent to use the Mark at the material date of September 16, 2013 (the filing date of the application). Accordingly, the Opponent has failed to meet its evidential burden for the section 30(e) ground of opposition. This ground of opposition is therefore rejected.

### **Section 12(1)(d) ground of opposition**

[24] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act in view of the Opponent's registration No. TMA625,476 for the trademark HARDHATS in association with the services "training and placement in jobs of unemployed individuals including those on income assistance or employment/unemployment insurance". I have exercised



my discretion and checked the Register to confirm that this registration is extant [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

#### Test to determine confusion

[25] The Opponent having met its initial burden of proof, I must now determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's registered trademark HARDHATS.

[26] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods or services are of the same general class or appear in the same Nice Class. In making such an assessment, I must consider all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[27] In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 SCR 824 at paragraph 20, the Supreme Court of Canada set out how the test is to be applied:

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 [mark] at a time when he or she has no more than an imperfect recollection of the [prior] 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.

[28] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011

SCC 27 at paragraph 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[29] Importantly, section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's Services, provided under the Mark, would believe that those Services were being provided by the Opponent, or that the Applicant was authorized or licensed by the Opponent who offers services under the trademark HARDHATS.

#### Inherent distinctiveness

[30] In considering the inherent distinctiveness of the respective parties' trademarks, I have exercised my discretion to refer to dictionary definitions [*Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 at para 29 which provides that the Registrar can take judicial notice of dictionary definitions].

[31] The Opponent's trademark HARDHATS is a combination of two ordinary words, and the *Canadian Oxford Dictionary* (2ed) defines "hard hat" as follows:

hard hat

*noun*

1. protective headgear worn on construction sites, logging sites, etc.
2. *informal* a construction worker.
3. *informal* a conservative member of the working class.

[32] Further, the Opponent's evidence indicates that the job training and placement services are in the field of construction. The client brochure attached as Exhibit 1 to the Bourree affidavit prominently includes the phrase "Trade Up. Take the training and find work in construction" and "Trade Up. Find qualified workers for your construction projects". The brochure also includes pictures of workers wearing hard hats. Accordingly, I consider the Opponent's trademark to be suggestive of the field or type of job training and placement services offered by the Opponent.

[33] Similar to the Opponent's trademark, I find the word "hardhats" in the Applicant's Mark also suggests the field of the Applicant's employment programs. Indeed, the Applicant's Services (as listed) go further in that they expressly identify that they pertain to the construction

industry. I also find the words “HIGH SCHOOLS” to be suggestive of the Applicant’s Services in that they are aimed at high school students, with the result that these words do not significantly increase the overall inherent distinctiveness of the Mark.

[34] Accordingly, this factor favours neither party.

#### Extent known and length of time in use

[35] The extent known and length of time in use does not significantly favour either party. As discussed below, while the Opponent’s registration claims use of the HARDHATS trademark since June 2002, the Opponent’s evidence falls short of establishing that the Opponent’s trademark has been used or promoted in association with the Opponent’s services to any meaningful extent. With respect to the Applicant’s Mark, as discussed below, I am reluctant to consider the evidence showing use of the Mark (in December 2017) in my analysis.

#### *Opponent’s evidence*

##### Bourree affidavit

[36] Mr. Bourree is an originating officer and director of the Opponent. He was also an officer and director of the Opponent’s predecessor in title, GT Hiring Solutions Inc. (para 1).

Mr. Bourree’s evidence relating to the Opponent’s and/or its predecessor in title’s use of HARDHATS is reproduced below:

3. I confirm that since 2003 programs have been offered under the HARDHATS program namely “training and placement in jobs of unemployed individuals including those on income assistance or employment/unemployment insurance”. On average annually approximately 850 applications were received, resulting in approximately 550 accepted individuals through the program and 335 successfully graduated and placed individuals. I confirm that the use of the HARD HATS [*sic*] mark has not been abandoned.

4. Attached to this my affidavit as Exhibit 1 are examples of the current brochure for the HARD HATS [*sic*] program offered.

[37] Exhibit 1 appears to be a mock-up of a brochure (labelled 4” x 9” Brochure: Client) that displays the Opponent’s trademark and provides information regarding a job training program. The brochure, which is undated, prominently includes the phrases “Trade Up. Take the training

and find work in construction”, and “Trade Up. Find qualified workers for your construction projects”. The brochure also includes pictures of construction workers wearing hard hats.

[38] I consider Mr. Bourree’s statement to be merely confirmatory in nature. It does not itself constitute evidence of use of the Opponent’s mark as it is unaccompanied by evidence of how the trademark actually appears, if at all, in the performance of the Opponent’s services. The brochure (Exhibit 1) shows use of the Opponent’s trademark in association with the advertising of the Opponent’s services, pursuant to section 4(2) of the Act. However, it is described as “current”, and there is no indication that it would have been used at any time prior to the swearing of the affidavit in December 2017. Further, no information is provided as to the extent to which the brochure may have been distributed in Canada (for instance the number of brochures and method of distribution). The Applicant, in its written argument and at the hearing, also pointed out that the brochure itself does not refer to the Opponent as the source of the services. Rather, the brochure references “Grant Thornton, the Canadian Home Builders Association of British Columbia, and the Province of British Columbia”. The Applicant also noted that the brochure indicates that HARDHATS is managed by “Grant Thornton Job Placements, Inc.” with no mention of the Opponent as the owner of the HARDHATS trademark, or having any association with the HARDHATS program.

#### First Campos affidavit

[39] Ms. Campos is employed by the agent for the Opponent as a trademark researcher and assistant (para 1). On the instruction of Trisha A. Doré, senior registered trademark agent of the agent for the Opponent, Ms. Campos visited a number of websites including:

- The website *webnames.ca*. Ms. Campos then entered <*www.hardhats.ca*> into the WHOIS feature of the page. The Opponent is identified as the registrant for the domain name *www.hardhats.ca* (para 5, Exhibit 2).
- The current website for *www.hardhats.ca* (para 6). Exhibit 3 is a printout of the website. I note that the Opponent’s trademark appears as a header at the top of the webpage.

- Online searches of the Internet Archive Wayback Machine for the web address *http:hardhats.ca* (para 7). Exhibits 4A through M consist of approximately 47 printouts of the *hardhats.ca* main page as archived at various dates from June 21, 2003 to January 10, 2016. The printouts are identical and display the Opponent's trademark on the page header.

[40] In my view, little weight may be given to this affidavit since Ms. Campos is employed by the agent for the Opponent and the evidence relates to a contentious issue in the proceeding, namely the Opponent's use of its trademark [*Cross Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada* (2006), 2006 FCA 133, 53 CPR (4th) 286 (FCA)]. As noted by the Applicant in its written argument, any evidence regarding the use of the trademark could have been attested to by Mr. Bourree. In any event, I note that Ms. Campos' evidence fails to establish that any consumers in Canada visited this web page at any time.

Certified copy of the Opponent's registration No. TMA625,476

[41] While a certified copy of the Opponent's registration has been filed, this does not support the conclusion that the Opponent's mark has become known to any significant extent, or that it has been continuously used.

*Applicant's evidence of use – Maloney affidavit*

[42] The application for the Mark is based on proposed use. The Maloney affidavit establishes that the Mark has appeared on the *www.helmetstohardhats.ca* website advertising the Services since December 2017 (para 36, Exhibit 15). However, I am reluctant to consider this in the analysis given that there is some ambiguity in the Maloney affidavit as to whether the use enures to the benefit of the Applicant (although based on the information provided by counsel at the hearing, it may be that it does). In any event, I note that this evidence is not particularly helpful since there is no evidence indicating the number of consumers that may have accessed the webpage. If I am wrong in not considering this evidence of use in my analysis, I note that it would not affect my overall finding on this factor.

The nature of the goods and services and trade and business

[43] When considering sections 6(5)(c) and 6(5)(d) of the Act, it is the statement of goods and services in the application and the statement of goods and services in an opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. 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. In this regard, evidence of the actual trades of the parties is useful [*McDonald's Corp v Coffee Hut Stores Ltd*, 1996 CanLII 3963 (FCA), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB)].

[44] The services listed in the Opponent's registration are "training and placement in jobs of unemployed individuals including those on income assistance or employment/unemployment insurance".

[45] The Services listed in the Applicant's application are "employment services aimed at high school students who are family members of veterans and reservists of the Canadian Armed Forces, namely recruitment, placement, training and networking, for jobs and apprenticeship programs in the construction industry".

[46] Notwithstanding that the Applicant's Services are narrower in scope, I find that there is significant overlap in the parties' services given that both are in the nature of employment services providing job training and placement. While it might be unlikely that the consumers of the Applicant's services (high school students) would be individuals on income assistance or employment/unemployment insurance, the Opponent's services are not limited to this type of consumer.

[47] Accordingly, this factor favours the Opponent.

### Degree of resemblance

[48] The Opponent's mark consists solely of the word HARDHATS. While the Applicant's Mark contains the word HARDHATS (and thus the entirety of the Opponent's trademark), I do not consider this element of the Mark to stand out. Rather, I consider the trademark HIGH SCHOOLS TO HARDHATS as a unitary phrase.

[49] With this in mind, to the extent that the parties' marks both contain the element HARDHATS, there is some resemblance between them. However, there are also visual and phonetic differences between the marks as the Applicant's Mark is longer, structured more as a phrase, and begins with a different word. The Applicant's Mark also holds a different connotation in that it is suggestive of the transition made by students from high school to construction work. Based on the foregoing, I find that the parties' marks are more different than alike.

[50] Accordingly, this factor favours the Applicant.

### Surrounding circumstance - Co-existence on the Register and in the marketplace of the HELMETS TO HARDHATS trademarks

[51] In its written and oral representations, the Applicant identifies as a relevant surrounding circumstance its use and ownership of the HELMETS TO HARDHATS Marks. The Applicant notes that the HELMETS TO HARDHATS registration (No. TMA668,696) has co-existed on the Register with the Opponent's registered mark for over a decade, and its other two registrations (DU REGIMENT AUX BATIMENTS (No. TMA853,877) and the HELMETS TO HARDHATS bilingual logo design (No. TMA858,653)) have co-existed with the Opponent's registration for over five years, and that the Opponent never took any steps to oppose or otherwise challenge the use or registration by the Applicant of any of these marks. The Applicant submits that the Opponent has not presented any evidence of actual confusion, and that consequently, it must be presumed that the Opponent's mark is not confusing with any of the Applicant's marks, including the applied-for Mark. The Applicant further submits that it would be contradictory and nonsensical to conclude that the subject Mark is confusing with the registered mark HARDHATS, while conceding that the registered mark HELMETS TO HARDHATS is not confusing with that mark.

[52] It is well established that an applicant's ownership of one or more trademarks does not confer an automatic right to obtain a further registration [*Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc* (1984), 4 CPR (3d) 108 at 115 (TMOB)]. Further, while the Maloney affidavit provides evidence of use of the Applicant's trademarks, in particular HELMETS TO HARDHATS, I am reluctant to find that this use enures to the Applicant based on shortcomings in the Maloney affidavit (discussed above).

[53] Based on the foregoing, I do not consider these factors to assist the Applicant. I would add that if I am wrong in this regard, that this does not affect my overall conclusion on the likelihood of confusion.

### Conclusion

[54] Having considered all the surrounding circumstances, in particular the degree of resemblance, as a matter of first impression and imperfect recollection, I find that the Applicant has met the onus on it to show that the balance of probabilities weighs in its favour on the issue of confusion. Accordingly, the section 12(1)(d) ground of opposition is rejected.

### **Section 16(3)(a) ground of opposition**

[55] The section 16(3)(a) ground of opposition also turns on the issue of confusion between the Mark and the Opponent's HARDHATS trademark. While I have some doubt as to whether the Opponent meets its initial burden, to the extent that it might do so, my conclusions respecting the 12(1)(d) ground also apply to this ground of opposition. Thus, I find that the Applicant has met, at the material date of September 16, 2013 (the filing date of the application), the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark. Accordingly, the section 16(3)(a) ground of opposition is rejected.

### **Section 2 ground of opposition**

[56] The ground of opposition based on section 2 of the Act is rejected on the basis that the Opponent has failed to meet its evidential burden. As discussed above, the Opponent's evidence is insufficient to establish that its trademark had become known sufficiently in Canada as of the



material date of March 6, 2017 (the date of filing the statement of opposition), so as to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd (1981)*, 1981 CanLII 2834 (FC), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd (2006)*, 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC)].

DISPOSITION

[57] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Jennifer Galeano  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** 2020-07-24

**APPEARANCES**

No one appearing

FOR THE OPPONENT

Sheldon S. Lazarovitz

FOR THE APPLICANT

**AGENTS OF RECORD**

ACCUPRO TRADEMARK SERVICES LLP

FOR THE OPPONENT

SHELDON S. LAZAROVITZ

FOR THE APPLICANT