

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 80**

**Date of Decision: 2021-04-29**

**IN THE MATTER OF AN OPPOSITION**

**Winnipeg Pants & Sportswear Mfg. Ltd.**

**Opponent**

**and**

**Bunzl IP Holdings, LLC**

**Applicant**

**1,622,829 for WORKHORSE**

**Application**

INTRODUCTION

[1] Winnipeg Pants & Sportswear Mfg. Ltd. (the Opponent) opposes registration of the trademark WORKHORSE (the Mark), which is the subject of application No. 1,622,829 by Bunzl IP Holdings, LLC (the Applicant).

[2] The Mark is applied for in association with the following goods:

First aid kits; protective safety equipment, namely, hard hats, safety glasses, safety goggles, ear plugs for soundproofing, face protection, namely, face shields not for medical purposes, respirators other than for artificial respiration, face masks not for medical purposes, and protective gloves for industrial use; protective clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons for protection against fire; protective clothing treated with retardants for wear by welders, grinders, and mechanics for protection against flames, sparks and fire; hearing protection headsets, not for medical use, radio-compatible hearing protection headsets, not for medical use; back support belts for workers; protective industrial boots; protective headgear, namely, hard hats and protective helmets; safety traffic cones; knee pads for

workers; dust masks, rubber molded boots; protective sleeves; poly and pvc sleeves; protective aprons; protective aprons made of poly, neoprene coated and pvc; safety boots; mesh safety gloves; disposable bags; tool bags; general purpose rubber and plastic gloves for domestic use; general work clothing, namely, general work gloves, namely, cotton gloves, cotton and leather gloves and leather gloves; latex gloves, rubber gloves, vinyl gloves and polyvinyl chloride gloves, nitrile gloves, poly gloves; socks; rainwear, namely, rain suits, pants, hats, boots, and hip and chest waders for use in connection with fishing and hunting; clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons; outdoor winter clothing, namely, gloves, coveralls, overalls, bib pants, pants, ear muffs; hairnets; all of the goods in the application for work and safety purposes.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's trademark WORKHORSE, previously used and registered in association with similar or related goods.

#### THE RECORD

[4] The application for the Mark was filed on April 17, 2013 on the basis of use in Canada since at least as early as December 31, 2000.

[5] The application was advertised for opposition purposes on April 29, 2015. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[6] On September 29, 2015, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on sections 30(b), 30(i), 12(1)(d), 16(1), and 2 of the Act.

[7] In support of its opposition, the Opponent filed the affidavit of Kareina Turton, affirmed March 8, 2018 in Winnipeg, Manitoba [the Turton Affidavit]. Ms. Turton was not cross-examined.

[8] In support of its application, the Applicant filed the declaration of Dave Huck, declared July 3, 2018. However, per the Registrar's June 18, 2019 ruling – and without objection from

the Applicant – this declaration was deemed to no longer be part of the evidence pursuant to section 56(4) of the *Trademarks Regulations*.

[9] Only the Opponent submitted written representations, but both parties attended an oral hearing.

[10] Before assessing the grounds of opposition, I will first provide an overview of the Opponent’s evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

#### OVERVIEW OF THE OPPONENT’S EVIDENCE

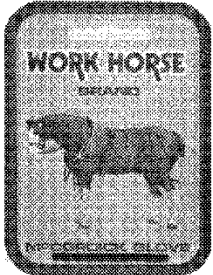

[11] The Opponent is the owner of registration No. TMA267040 for the trademark WORKHORSE [the Opponent’s Trademark], registered in 1982 on the basis of use in Canada since at least as early as October 31, 1980. The Opponent’s Trademark is currently registered in association with “Men’s and boys’ clothing, namely, parkas, jackets”.

#### *The Turton Affidavit*

[12] Ms. Turton is Chief Financial Officer of the Opponent. The Turton Affidavit evidences the following:

- The background of the Opponent as a Canadian apparel company that has manufactured and sold vests, parkas, jackets, bib pants, and coveralls in association with the Opponent’s Trademark or the trademark WORK HORSE since October 1980 [paras 3 to 9].
- The manner of display of the Opponent’s Trademark, in particular on tags and labels affixed to parkas and jackets [paras 10 to 14, Exhibits D and E]. Although the images are of poor quality, I note that the tags display “WORK HORSE” in large letters on a white background below but separate from the image of a train locomotive, while the labels display “WORK HORSE” over two lines on a brown background below but separate from the image of a train locomotive.

- Sales of such WORK HORSE-branded products in Canada since 1998 [paras 15 to 20, Exhibits F to I], including invoices showing sales of WORK HORSE-branded jackets, parkas, bib pants and coveralls [para 17, Exhibit H].
- Promotional material provided to the retailer Peavey Mart in 2015 to promote the Opponent’s WORK HORSE products [para 20, Exhibit I]. I note that WORK HORSE is displayed throughout the material, and without the accompanying image of a train locomotive.
- The Opponent’s relationship with the Applicant’s alleged predecessor(s)-in-title, McCordick Glove & Safety Inc. and McCordick Limited Partnership (collectively McCordick) [paras 21, 26 and 27]. In particular, Ms. Turton alleges that McCordick has been a “long standing” customer of the Opponent and provides evidence of sales of non-WORK HORSE-brand products to McCordick from 2009 through 2017 [para 26, Exhibit N], as well as a June 2018 purchase order that included six units of WORK HORSE bib pants [para 27, Exhibit O].
- Printouts of four registrations currently owned by the Applicant [paras 22 to 25, Exhibits J to M], including the following relevant trademarks [the Applicant’s Registered Trademarks], addressed further below:

	
<p style="text-align: center;">TMA276839 WORK HORSE BRAND &amp; DESIGN</p>	<p style="text-align: center;">TMA899392 WORKHORSE &amp; DESIGN</p>

- Ms. Turton states that, in 2014, the Opponent became aware that the Applicant was selling vests, parkas, jackets, bib pants and coveralls in Canada in association with the WORKHORSE trademark [paras 28 to 30]. Evidence of such includes purchases of the Applicant's pants and parkas from Home Depot stores in Winnipeg, Manitoba in late 2014 and early 2015 [paras 31 to 34, Exhibits P to U]. Tags on such products include the design mark shown below [the By Workhorse Design Mark].



#### EVIDENTIAL BURDEN AND LEGAL ONUS

[13] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (FCTD)]. The presence of an evidential burden on the Opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[14] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on the Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the Applicant.

SECTION 30(B) GROUND OF OPPOSITION – DATE OF FIRST USE

[15] In its statement of opposition, the Opponent pleads that the application does not conform to the requirements of section 30(b) of the Act in that the Applicant had not used the Mark in association with each general class of goods described in the application, as of the alleged date of first use, namely, December 31, 2000.

[16] While the Opponent's initial burden is light under section 30(b) because it has limited access to information regarding use relative to the Applicant, its burden is not eliminated altogether [*John Labatt, supra; Dion Neckwear Ltd v Christian Dior SA et al*, 2002 FCA 29].

[17] In this case, while the Turton Affidavit addresses the Applicant's use of the Mark to some extent [paras 28 to 34], it otherwise makes no attempt to refute the alleged date of first use set out in the application. In this respect, contrary to the Opponent's submission, I do not consider the indication that McCordick's website, *www.mccordick.com*, was only active after 2002 [per Exhibit Q] to be significant, or that it satisfies the Opponent's burden with respect to this ground.

[18] Accordingly, as the Opponent has not met its burden, the ground of opposition based on section 30(b) of the Act is rejected.

SECTION 30(I) GROUND OF OPPOSITION – ENTITLED TO USE STATEMENT

[19] The Opponent pleads that the application does not conform to the requirements of section 30(i) of the Act in that the Applicant cannot have been satisfied that it was entitled to use the Mark in Canada in association with the applied-for goods as at the date of filing of the application because it knew or ought to have known of the Opponent's registration and prior use of the Opponent's Trademark.

[20] Section 30(i) of the Act merely required that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark in Canada in association with the goods or services described in the application. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol Myers Co*, 1974 CarswellNat 476, 15 CPR (2d) 152 (TMOB)].

[21] Although the Turton Affidavit provides that the Applicant's predecessor-in-title, McCordick, was a customer and purchased goods from the Opponent in the past, I do not consider this sufficient to meet the Opponent's burden with respect to this ground. It is well established that knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use its trademark [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197].

[22] Accordingly, as the Opponent has not met its burden, the ground of opposition based on section 30(i) of the Act is rejected.

#### SECTION 12(1)(D) GROUND OF OPPOSITION – CONFUSING WITH A REGISTERED TRADEMARK

[23] The Opponent pleads that the Mark is not registrable in view of section 12(1)(d) of the Act in that it was confusing with the Opponent's Trademark (registration No. TMA267040).

[24] The material date with respect to confusion with a registered trademark is the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd et al*, 1991 CarswellNat 1119, 37 CPR (3d) 413 (FCA)].

[25] I have exercised my discretion and have checked the Register to confirm that the Opponent's registration is extant [per *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Following a July 2019 decision of the Registrar in a section 45 proceeding, as noted above, the registration is now limited to "Men's and boys' clothing, namely, parkas, jackets".

[26] As the Opponent has met its burden in respect of this ground, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's Trademark.

#### *Test to determine confusion*

[27] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services

associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[28] 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 in association with the applied-for goods at a time when they have no more than an imperfect recollection of the Opponent’s Trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[29] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: 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, 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.

[30] The criteria or factors in section 6(5) of the Act 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, 1 SCR 772 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to first consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 66]. In view of its importance, I will first consider the degree of resemblance between the Mark and the Opponent’s Trademark.

#### *Degree of Resemblance*

[31] The parties’ trademarks are identical.

[32] Accordingly, this factor significantly favours the Opponent.



*Inherent Distinctiveness and the Extent Known*

[33] In its written representations, the Opponent submits that the words WORKHORSE and WORK HORSE “carry a connotation of labour and do not bear any relation to clothing” [para 32].

[34] However, the *Merriam-Webster Dictionary* provides the following definitions for “WORK HORSE”:

- a horse used chiefly for labor as distinguished from driving, riding, or racing
- a person who performs most of the work of a group task
- a hardworking person
- something that is markedly useful, durable, or dependable

[35] Given the last definition, I do not consider the parties’ trademarks to be entirely arbitrary with respect to the relevant goods. With respect to clothing goods, WORKHORSE is suggestive of clothing that is durable. In any event, as the parties’ word marks at issue under this ground are the same, the connotation and inherent distinctiveness are also the same.

[36] With respect to the extent to which the parties’ trademarks have become known, even if I were to accept use of the Applicant’s By Workhorse Design Mark as use of the Mark – and notwithstanding the claimed use since 2000 – I otherwise have no evidence of the extent to which the Mark has become known in Canada. In contrast, the Turton Affidavit includes evidence of significant sales of WORK HORSE-branded parkas and jackets to various retailers [paras 15 to 17], as well as some evidence of advertising in association with the Opponent’s Trademark [Exhibit I].

[37] As such, this factor favours the Opponent.

*Length of Time in Use*

[38] Again, notwithstanding the claimed date of first use of 2000, the evidence of use of the Mark is limited and dates back to 2014 at best [Turton Affidavit, paras 30 to 34]. In contrast, I accept that the Opponent’s Trademark has been used in Canada since October 1980 in association with the Opponent’s registered goods, “parkas” and “jackets”.

[39] Accordingly, this factor favours the Opponent.

*Nature of the Goods or Business / Nature of the Trade*

[40] When considering the nature of the goods of the parties in respect of the issue of confusion, it is the statements of goods in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749, 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[41] I first note that, at paragraph 40 of its written representations, the Opponent lists a portion of the Applicant's statement of goods. However, as confirmed at the hearing, this listing does not necessarily identify the applied-for goods which the Opponent considers at issue under this ground. Otherwise, the Opponent submits that the nature of the goods of both parties is "general consumer clothing" and that while the applied-for goods include "workwear, safety and insulated outerwear, at the end of the day, a jacket is a jacket is a jacket" [para 43].

[42] Indeed, while the applied-for goods include the limitation "all of the goods in the application for work and safety purposes", the Opponent's registration has no such limitation.

[43] However, to some extent, the Opponent's submission is an overstatement. In this respect, I note that the application is for a wide variety of goods, none of which are the Opponent's specific registered goods, "jackets" or "parkas". Nevertheless, I consider it fair to consider the applied-for goods to fall within one of four general categories for purposes of this confusion analysis.

[44] The first category, being clothing goods, consists of the fire-retardant-treated clothing, namely, "pants, shirts, bib overalls, coveralls, and aprons" as well as the "outdoor winter clothing" and "rainwear" goods. I consider these clothing goods to be sufficiently related to the Opponent's registered goods, such that this factor favours the Opponent with respect to such goods.

[45] The second category of goods includes the remaining various types of footwear, gloves, and aprons as well as "socks" and "hairnets". While the nature of such goods are further removed from the Opponent's registered goods, they can still be broadly characterized as being,

at minimum, clothing-related goods. Accordingly, this factor favours the Opponent with respect to such goods, albeit not as strongly.

[46] Ultimately, in the absence of evidence relating to the nature of each of the applied-for goods and given the Applicant's onus, I have erred towards considering an applied-for good to fall within this second category.

[47] Nevertheless, a third category of goods can be characterized as wearable specialized safety equipment, such as "protective safety equipment, namely, hard hats" and "hearing protection headsets". Given the specialized and limited nature of such products, I do not consider such goods to overlap significantly with the Opponent's registered goods.

[48] The fourth and final category of goods can be characterized simply as non-wearable goods, such as "First aid kits" and "disposable bags". I do not consider such goods to overlap with the Opponent's registered goods.

[49] With respect to the parties' trades, the Opponent's products appear to be directed, at least in part, to workwear retailers and there is evidence that the parties' goods are sold by the same third-party retailers [Turton Affidavit, para 35]; in any event, there is potential for overlap in the channels of trade.

[50] Overall, these factors favour the Opponent with respect to the applied-for clothing and clothing-related goods, but somewhat favour the Applicant with respect to the applied-for specialized safety equipment and non-wearable goods.

*Additional Surrounding Circumstance - Applicant's Registered Trademarks*

[51] At the hearing, the Applicant submitted that there has been co-existence of various WORKHORSE trademarks in the Canadian marketplace since 1982.

[52] In this respect, as noted above, the Applicant is the owner of the Applicant's Registered Trademarks, WORK HORSE BRAND & DESIGN (TMA276839, registered in 1983) and WORKHORSE & Design (TMA899392, registered in 2015). These registrations include goods

that can be properly considered to include clothing or clothing-related goods, such as gloves, socks and various types of rainwear.

[53] In particular, WORK HORSE BRAND & Design is registered in association with the following goods:

(1) Work gloves, namely cotton gloves, cotton leather gloves, leather gloves, rubber and polyvinyl chloride gloves;

(2) Socks; rainwear, namely hats, capes, coats, pants, boots; safety products, namely safety glasses, ear protection, face protection, namely masks.

[54] For goods (1), a declaration of use was filed in October 1982. For goods (2), a declaration of use was filed in May 1992.

[55] WORKHORSE & DESIGN is registered in association with the following goods, with a claim of use in Canada since 2000:

Work gloves, namely, cotton gloves, cotton leather gloves, leather gloves, latex gloves, rubber gloves, vinyl gloves and polyvinyl chloride gloves; socks; rainwear, namely, hats, capes, coats, pants; safety products, namely, safety glasses, safety goggles, ear protection, namely, earmuffs, radio earmuffs, ear plugs, ear bands; face protection, namely, masks, face shields; fall protection products namely, roofers kits consisting of harnesses, lanyards, rope grabs, self-retracting life-lines, reusable roof anchors with nails, storage pails; barricade tape; respiratory products, namely, respirators, respirator cartridges, dust masks; first aid kits; knee pads, back belts, head protection products, namely, hard hats, bump caps, hair nets; traffic cones; tool bags; spill containment supplies, namely, pads for absorbing oil, polyethylene pails, nitrile gloves, disposable bags; arc flash protection supplies, namely, fire retardant coveralls, gloves and blankets.

[56] At paragraphs 22 and 23 of the Turton Affidavit, Ms. Turton acknowledges the Applicant's Registered Trademarks "for use in association with primarily gloves and safety products; goods that were not overlapping with the WORKHORSE Products". While this statement is problematic for the Opponent, I agree with the Opponent's submission at the hearing that such statements do not amount to an admission that there is no confusion with respect to the applied-for Mark.

[57] To the extent that the Opponent may have been content to have the Opponent's Trademark co-exist with the Applicant's Registered Trademarks, this can potentially be explained by the additional matter in those registrations, in particular the depiction of a horse in

both design marks. The Applicant now seeks registration of the word mark WORKHORSE, without the additional matter, and identical to the Opponent's Trademark. However, it is well established that the Act does not give the owner of a registration an automatic right to obtain any further registrations, no matter how closely they may be related to the original registration [*Groupe Lavo Inc v Proctor & Gamble Inc* (1990), 32 CPR (3d) 533 (TMOB) at para 15; and *Highland Feather Inc v American Textile Co*, 2011 TMOB 16 at para 20].

[58] In any event, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431, 41 CPR (3d) 432 (TMOB); and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178, 44 CPR (3d) 205 (FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc*, 1992 CarswellNat 124, 43 CPR (3d) 349 (FCA)]. In this case, there is no evidence regarding the extent to which the Applicant's Registered Trademarks have been used or become known in Canada. While I accept that the evidence shows co-existence on the trademark *register* since the early 1980s, I do not agree with the Applicant that the evidence shows co-existence in the Canadian *marketplace*.

[59] Accordingly, I do not consider the Applicant's Registered Trademarks to be a significant surrounding circumstance.

#### *Conclusion – Confusion with the Opponent's Trademark*

[60] As mentioned above, the degree of resemblance between the parties' trademarks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion. This is particularly the case where the parties' goods and the parties' channels of trade are the same or potentially overlapping [*Reynolds Consumer Products Inc v PRS Mediterranean Ltd*, 2013 FCA 119, 111 CPR (4th) 155 at paras 26-30].

[61] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to the following applied-for clothing and clothing-related goods:

[...] protective gloves for industrial use; protective clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons for protection against fire; protective clothing treated with retardants for wear by welders, grinders, and mechanics for protection against flames, sparks and fire; [...] protective industrial boots; [...] rubber molded boots; [...] protective aprons; protective aprons made of poly, neoprene coated and pvc; safety boots; mesh safety gloves; [...] general purpose rubber and plastic gloves for domestic use; general work clothing, namely, general work gloves, namely, cotton gloves, cotton and leather gloves and leather gloves; latex gloves, rubber gloves, vinyl gloves and polyvinyl chloride gloves, nitrile gloves, poly gloves; socks; rainwear, namely, rain suits, pants, hats, boots, and hip and chest waders for use in connection with fishing and hunting; clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons; outdoor winter clothing, namely, gloves, coveralls, overalls, bib pants, pants, ear muffs; hairnets; [...]

[62] With respect to the “outdoor winter clothing”, “rainwear”, and two types of applied-for “pants, shirts, bib overalls coveralls, and aprons”, on a balance of probabilities, I find that there is a reasonable likelihood of confusion between the Mark and the Opponent’s Trademark. I reach this conclusion due to the resemblance between the trademarks, the overlap in the general nature of the parties’ goods, the overlap in the parties’ channels of trade, and notwithstanding the specialized nature of the applied-for goods.

[63] With respect to the other goods listed above, at best for the Applicant, I find that the balance of probabilities regarding the likelihood of confusion as to the source of the parties’ goods to be evenly balanced. I reach this conclusion due to the resemblance between the trademarks and the potential overlap in the nature of the parties’ goods and trades, notwithstanding that the Applicant’s Registered Trademarks are in association with some of these goods, such as different types of gloves. Ultimately, absent evidence from the Applicant, I do not consider the limitation “all of the goods in the application for work and safety purposes” sufficient to necessarily distinguish such goods from those of the Opponent. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant with respect to such further goods.

[64] In view of the foregoing, the section 12(1)(d) ground of opposition based on confusion with the Opponent’s Trademark is successful with respect to the aforementioned goods, listed in paragraph 61 above.

[65] This is contrasted with the remaining goods, which can be characterized as specialized safety equipment or non-wearable goods. The differences in the nature of these remaining goods shifts the balance of probabilities in the Applicant's favour such that there is no reasonable likelihood of confusion based on the evidence before me. Accordingly, the ground of opposition is rejected with respect to such remaining goods.

#### SECTION 16 GROUND OF OPPOSITION – NON-ENTITLEMENT

[66] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark in that, contrary to section 16(1) of the Act, at the alleged date of first use (December 31, 2000), it was confusing with the Opponent's Trademark which had been previously used in Canada by the Opponent in association with the goods referred to in registration No. TMA267040.

[67] As a preliminary matter, I note that, as of the filing of the statement of opposition, the Opponent's registration included "vests" in addition to "parkas" and "jackets". However, I do not consider the inclusion of "vests" under this ground to have any impact on the analysis.

[68] As noted above, the uncontroverted evidence set out in the Turton Affidavit is that the Opponent has used the trademarks WORKHORSE or WORK HORSE on men's and boy's clothing, including parkas and jackets, since October 1980 [paras 7 to 9]. In this respect, I accept that the evidenced display of WORK HORSE, alone or below an image of a locomotive, constitutes use of the Opponent's Trademark.

[69] Accordingly, the Opponent meets its initial burden with respect to this ground.

[70] Notwithstanding the earlier material date, I do not find my conclusions above with respect to the confusion analysis to substantially differ under this ground.

[71] Accordingly, the ground of opposition based on section 16 of the Act is successful with respect to the clothing and clothing-related goods identified above, and rejected with respect to the remaining goods.

SECTION 2 GROUND OF OPPOSITION – NON-DISTINCTIVENESS

[72] The Opponent pleads that the Mark is not distinctive and is not capable of being distinctive of the goods of the Applicant in that it is likely to be confused with the Opponent's Trademark, by virtue of the Opponent's prior use and registration of the Opponent's Trademark, and that the trademark is not adapted to distinguish the goods of the Applicant from those of the Opponent.

[73] The material date for this ground of opposition is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[74] Section 2 of the Act, as it then was, defined "distinctive" as follows:

distinctive, in relation to a trademark, means a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them.

[75] A trademark "actually distinguishes" by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is "adapted so to distinguish" is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[76] In *Suzanne's Inc v Auld Phillips Ltd*, 2005 FCA 429, in the context of an expungement proceeding under section 57 of the Act, the Federal Court of Appeal stated that "Obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its distinctiveness, but nothing in principle prevents this result" [at para 7].

[77] Accordingly, first, in order to meet its evidential burden with respect to this ground, the Opponent must show that the Opponent's Trademark had a substantial, significant or sufficient reputation in Canada in association with the relevant goods [see *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 at para 34; see also *Navsun Holdings Ltd v Sadhu Singh Handrad Trust*, 2020 TMOB 64 at para 40].



[78] In this case, even if I were to find that the Opponent has met its initial burden, to the extent that this ground ultimately turns on the issue of confusion, I would come to the same conclusions as above with respect to the section 12(1)(d) and section 16 grounds.

#### DISPOSITION

[79] In view of all of the foregoing and pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the goods set out in strike out below, and reject the opposition with respect to the remaining goods:

~~First aid kits; protective safety equipment, namely, hard hats, safety glasses, safety goggles, ear plugs for soundproofing, face protection, namely, face shields not for medical purposes, respirators other than for artificial respiration, face masks not for medical purposes, and protective gloves for industrial use; protective clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons for protection against fire; protective clothing treated with retardants for wear by welders, grinders, and mechanics for protection against flames, sparks and fire; hearing protection headsets, not for medical use, radio-compatible hearing protection headsets, not for medical use; back support belts for workers; protective industrial boots; protective headgear, namely, hard hats and protective helmets; safety traffic cones; knee pads for workers; dust masks, rubber molded boots; protective sleeves; poly and pvc sleeves; protective aprons; protective aprons made of poly, neoprene coated and pvc; safety boots; mesh safety gloves; disposable bags; tool bags; general purpose rubber and plastic gloves for domestic use; general work clothing, namely, general work gloves, namely, cotton gloves, cotton and leather gloves and leather gloves; latex gloves, rubber gloves, vinyl gloves and polyvinyl chloride gloves, nitrile gloves, poly gloves; socks; rainwear, namely, rain suits, pants, hats, boots, and hip and chest waders for use in connection with fishing and hunting; clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons; outdoor winter clothing, namely, gloves, coveralls, overalls, bib pants, pants, ear muffs; hairnets; all of the goods in the application for work and safety purposes.~~

---

Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

---

**HEARING DATE:** 2020-12-16

**APPEARANCES**

Robert Watchman	For the Opponent
Richard S. Levy	For the Applicant

**AGENTS OF RECORD**

Pitblado LLP	For the Opponent
Richard S. Levy	For the Applicant