



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 296**

**Date of Decision: 2021-12-31**

**IN THE MATTER OF AN OPPOSITION**

**Onward Multi-Corp Inc.**

**Opponent**

**and**

**Empire Comfort Systems, Inc.**

**Applicant**

**1,515,140 for BROILMASTER**

**Application**

[1] Onward Multi-Corp Inc. (the Opponent) opposes application no. 1,515,140 to register the trademark BROILMASTER (the Mark) filed by Empire Comfort Systems, Inc. (the Applicant).

[2] The opposition is based primarily on an allegation that the Mark, used in association with “gas grills and replacement parts therefor” (the Goods), is confusing with the Opponent’s trademarks BROIL KING, BROIL KING & Design, BROIL KING IMPERIAL, and BROIL-MATE (Opponent’s Trademarks), registered and used in association with the same goods. The BROIL KING & Design trademark consists of the phrase “Broil King” in a simple, bold font with a chevron replacing the dot on each letter “i”, as depicted below (BROIL KING Design):

**Broîl Kîng**

[3] For the reasons that follow, I refuse the application.

## THE RECORD

[4] The application to register the Mark (the Application) was filed by the Applicant on February 14, 2011 based on use of the Mark in Canada in association with the Goods since at least as early as 2001. An amendment was made on February 10, 2020 to add that the Mark was used not only by the Applicant but also by its predecessor in title, Martin Industries, Inc. (Martin Industries).

[5] The Application was advertised in the *Trademarks Journal* on June 22, 2016, and opposed on September 15, 2016, when the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The statement of opposition was subsequently amended on July 23, 2020 to reflect a change in the status of one of the Opponent's trademark registrations. The grounds of opposition are based on the following sections of the Act: 30(i) (compliance with formal requirements); 12(1)(d) (registrability of the trademark); 16 (entitlement to registration); and 2 (distinctiveness of the trademark).

[6] Numerous amendments to the Act came into force on June 17, 2019. Pursuant to the transitional provisions in section 70 of the Act for applications advertised before June 17, 2019, the grounds of opposition in this case will be assessed based on the Act as it read immediately before amendment, an exception being that the definition of confusion in sections 6(2) to 6(4) of the Act as it currently reads will be applied.

[7] The Applicant filed a counter statement containing a blanket denial of all "valid and clear" allegations in the statement of opposition. The counter statement also pleads that (i) the allegations in the sections 16 and 30 grounds regarding the Opponent's Trademarks being "previously used, made known, applied for and registered" are vague and provide insufficient particulars to enable the Applicant to respond and (ii) the Opponent "does not have clean hands", having attempted unsuccessfully to register the Mark for itself.

[8] Both parties submitted evidence in support of their respective positions, filed written arguments, and were represented at an oral hearing.

[9] This case was heard together with a related opposition, concerning the Applicant's application no. 1,515,141 to register the trademark OPTIONS BY BROILMASTER; however,

separate evidence is of record in each proceeding. Each of the two cases must be considered independently and a separate decision will issue for the related proceeding.

PRELIMINARY MATTERS ARISING FROM THE HISTORY BETWEEN THE PARTIES

[10] This case is not the first legal dispute between the parties involving the trademarks BROIL KING, BROIL-MATE, and BROILMASTER. In arguing the present case, the parties raised two prior oppositions involving these trademarks:

- The Opponent successfully opposed the Applicant’s prior application no. 1,112,366, filed August 10, 2001, to register the Mark for use in association with “gas barbecue grills” (the Prior Application), prevailing on a ground alleging confusion with the trademark BROIL KING, while allegations of confusion with BROIL-MATE failed: *Onward Multi-Corp Inc v Empire Comfort Systems, Inc*, 2010 TMOB 29 (the *2010 Opposition*).
- The Applicant successfully opposed the Opponent’s application no. 1,481,784 to register the trademark BROILMASTER for itself in association with “gas barbecues, gas grills, and replacement parts therefor”, prevailing on grounds alleging confusion with the Mark and what amounts to bad faith: *Empire Comfort Systems, Inc v Onward Multi-Corp Inc*, 2015 TMOB 80 (the *Applicant’s 2015 Opposition*).

[11] Before considering the merits of the present case, I will address the preliminary matters arising from the history between the parties.

**Principle of comity**

[12] The Opponent submits that the Registrar is obliged to adhere to the principle of judicial comity, whereby previous decisions by the same tribunal should be followed unless they are considered to be clearly wrong, in which case explicit reasons for the departure must be given. Alternatively, the Opponent submits that, even if the Registrar is not legally bound by its previous decisions, a previous decision involving the very marks at issue in this case is a surrounding circumstance that must be considered in assessing the likelihood of confusion between the marks.

[13] The Opponent submits that the degree of resemblance between the parties' trademarks is a key factor where the principle of comity comes into play. In particular, the Registrar should follow its decision from the *2010 Opposition* to the effect that (i) the word KING is "fairly synonymous" with the word MASTER, resulting in a "high degree of resemblance" between the trademarks BROIL KING and BROILMASTER in ideas suggested, and (ii) there is also a "fair degree of resemblance" between the trademarks BROIL-MATE and BROILMASTER. The Opponent submits that, in reaching these conclusions, the Registrar did not equivocate or see it as a difficult case and the facts have not changed.

[14] Conversely, the Applicant submits that important distinctions between the *2010 Opposition* and the present case weigh in its favour, particularly the new evidence of (i) a difference in connotation between the word MASTER and the words KING and MATE and (ii) third-party use of trademarks featuring the word BROIL in the same channels of trade, resulting in consumers being used to distinguishing between such trademarks.

[15] The doctrine of judicial comity seeks to prevent the same legal issue from being decided differently by members of the same court or tribunal, thereby promoting certainty in the law [*Apotex v Allergan Inc*, 2012 FCA 308]. However, it only applies to determinations of law and not to factual findings, where each case has a different factual matrix or evidentiary basis [*Allergan, supra*; *Bauer Hockey Ltd v Sport Masko Inc*, 2021 FCA 166; *Eclectic Edge Inc v Gildan Apparel (Canada) (LP)*, 2015 FC 133]. The Registrar's previous findings of fact or mixed fact and law are potentially persuasive and deserve respectful attention; nevertheless, each case must be assessed on its own evidentiary record and arguments [*Amgen Inc v Pfizer Canada ULC*, 2020 FC 522].

[16] In the present case, although there are factual similarities with the *2010 Opposition* and some common underlying legal issues, there are also important differences between the two proceedings, including differences in the material dates for the various grounds of opposition and in the evidence presented. The jurisprudence has also developed since the *2010 Opposition*: that case was decided before the Supreme Court of Canada provided its guidance on the resemblance factor in *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27.

[17] Consequently, comity cannot lead me to simply adopt the conclusions made in the *2010 Opposition*. However, I will pay respectful attention to the Registrar's previous findings in assessing the case before me. While recognizing the differences in the facts and issues in the *2010 Opposition*, and that each case must be decided on its own merits, I will refer to the *2010 Opposition* where I consider it appropriate to do so.

### **Allegation of wearing down**

[18] The Opponent also draws attention to two trademark applications filed by the Applicant after the *2010 Opposition*: no. 1,641,445 for the Mark in association with "charcoal fired barbecue grills" and no. 1,515, 141 for OPTIONS BY BROILMASTER in association with "gas grills and replacement parts therefor". The Opponent submits that an applicant should not have the option of thus continuously "refiling" an application that has been refused, to retry the matter before the same arbiter, as an alternative to bringing an appeal. The Opponent submits that, with such repeated proceedings over several decades, the Applicant "plans to drain the Opponent's resources, exhaust the Opponent's resolve to maintain its challenges to the Applicant's BROILMASTER applications, and/or extract valuable sales and marketing information from the Opponent", while also consuming the Registrar's finite resources [written argument para 39].

[19] The particulars of applications no. 1,641,445 and no. 1,514,141 are not in evidence, even though the Opponent's opposition to the latter was heard together with the present case. In any event, while I appreciate that parties should be able to rely on the final decision in a matter and be protected from the expense and uncertainty of continued attack, the questions to be decided in the various cases referenced by the Opponent will not necessarily be the same. Trademarks that are confusing at a given point in time will not necessarily be confusing at a different point in time, owing to intervening changes in the law and/or factual matrix, including changes in the trademark itself or in the associated goods and services. Nothing prevents an applicant from seeking to register the same trademark or a variation when a change in the surrounding circumstances might tip the balance in its favour.

[20] Accordingly, I must assess the Application on its merits, at the material dates in the present case and based on the evidence of record.

### **Allegation of unclean hands**

[21] Finally, I note the Applicant’s pleading that the Opponent “does not have clean hands”, given its attempt to register the trademark BROILMASTER for itself, which was successfully opposed in the *Applicant’s 2015 Opposition*. However, the Applicant has not established how the clean hands doctrine—which generally concerns a plaintiff’s conduct in relation to the subject matter of an equitable remedy—would apply to the present case. The Applicant has drawn no connection between the Opponent’s application and the specific questions to be decided in the case before me. Accordingly, the Applicant’s pleading with respect to “clean hands” is not a relevant circumstance in the present case.

### EVIDENTIAL BURDEN AND LEGAL ONUS

[22] With respect to the present proceeding, as in any trademark opposition case, the legal onus is on the Applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, 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 that ground of opposition exist. If this initial burden is met, then the Applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

### THE OPPONENT’S EVIDENCE

[23] In support of its opposition, the Opponent filed the affidavit of its secretary, Terence R. Witzel, which is dated July 25, 2017. Mr. Witzel is responsible for all administrative support to the Opponent’s legal, operations, procurement and transport, logistic, and information technology functions. In his affidavit, he describes how the Opponent’s Trademarks have been used and promoted in Canada. In so doing, he notes that a licence to use the trademarks has been granted to the Opponent’s wholly owned subsidiary Onward Manufacturing Company Limited (Onward Manufacturing). Attached as exhibits to his affidavit are extracts from the Opponent’s corporate profile and trademark registrations, some product images and one of packaging, copies

of product catalogue and price list covers and brochures, and documentation of online advertising at *broilkingbbq.com* and *broilmatebbq.com* as well as on the websites third-party retailers. I note that Mr. Witzel refers to the Opponent's products interchangeably as "barbecues" and "grills", explaining that he considers these terms to refer to identical products [para 7]. This interpretation is consistent with the documentary evidence and I will do the same.

[24] Mr. Witzel was cross-examined on his affidavit and the transcript is of record.

[25] The Applicant argues that the Opponent may not rely on certain aspects of this evidence. I will address the admissibility of particular portions of Mr. Witzel's affidavit and the Applicant's objections before proceeding with a review of the Applicant's evidence.

### **Admissibility of exhibits prepared by the Opponent's agent**

[26] The Applicant submits that the webpages attached as Exhibits B and D-F to Mr. Witzel's affidavit are inadmissible hearsay, because it was the Opponent's trademark agent firm and not Mr. Witzel himself who drafted the affidavit and prepared the exhibits. Indeed, Mr. Witzel acknowledged during cross-examination that he did not know who at that firm located the webpages or when they were printed [Qs 50, 56-59, 62]. He refused to answer how they were sent to him and admitted he did not verify whether each and every one existed online, but he did confirm having the entire affidavit before him when it was commissioned and having "certainly gone online with regards to this particular booklet" [Qs 13-15, 61]. He also confirmed that he had recently read the affidavit and did not wish to make any changes [Qs 5-6].

[27] At the hearing, the Applicant argued that the existence of materials downloaded from the Internet can only be established by an individual who has personally verified that existence online and that an adverse inference should be drawn from the failure to provide a witness with such personal knowledge. Conversely, the Opponent submitted that counsel's involvement in arranging the facts provided by the Opponent and the related exhibits into affidavit form does not render the evidence inadmissible. In the Opponent's submission, the exhibits must be considered together with Mr. Witzel's sworn statements and the question of who physically printed the pages has no bearing on the truthfulness of his assertion that all of the information in his affidavit is from his personal knowledge or his verification of the Opponent's records [Witzel, para 2].

[28] I agree with the Opponent. There is no requirement that the text of an affidavit be written by the affiant personally; rather, an affiant must attest to the veracity of the affidavit's contents. In the present case, Mr. Witzel confirms at the beginning of his affidavit that he is making oath and that all of the information he provides is within his personal knowledge or has been verified by him in the Opponent's records, and he confirmed during cross-examination that he had no changes to make.

[29] I also note that the exhibits in question consist of (i) printouts of registration particulars from the Canadian Trademarks Database for trademarks owned or opposed by the Opponent and (ii) advertising displaying the Opponent's Trademarks on the Opponent's websites and those of its retailers. I accept that, by virtue of his position and responsibilities, Mr. Witzel would be knowledgeable about the Opponent's trademarks and its marketing and distribution channels and would thus be in a position to recognize the exhibited documents and attest to whether they are accurate representations of the Opponent's practices. Indeed, the Applicant has not challenged the accuracy or authenticity of the printouts.

[30] In the circumstances, I am prepared to give the exhibits in question some weight.

### **The implications of Mr. Witzel's references to Onward Manufacturing**

[31] The Applicant also submits that the Opponent may not rely on the use and promotion of its trademarks from January 1, 2001 to the present, as that use was by its wholly owned subsidiary Onward Manufacturing and does not enure to the Opponent's benefit.

[32] In response, the Opponent submits that, regardless of Onward Manufacturing's activities, the Opponent itself has continued to sell goods in association with the Opponent's Trademarks, including through agents or distributors. In the alternative, the Opponent submits that any use of its trademarks by Onward Manufacturing would be deemed under the Act to be use by the Opponent, because public notice has been given that the use is under licence from the Opponent.

[33] Use or advertising of a trademark by a company under licence from the trademark owner will only enure to the owner's benefit if it meets the requirements of section 50(1) of the Act, which deems a licensee's use or advertising to be by the trademark owner if the owner "has, under the licence, direct or indirect control of the character or quality of the goods or services".



[34] However, nothing prevents a company from being both the trademark owner's licensee and its distributor. A distributor does not actually use the owner's trademark but merely acts as an intermediary along the chain of transactions between the owner and the ultimate consumer. It is well established that a trademark owner's ordinary course of trade will often involve distributors, wholesalers and/or retailers, and that distribution and sale of the owner's goods through such entities can constitute trademark use by the owner, so long as the owner is the first link in the chain of distribution [*Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD); *Osler, Hoskin & Harcourt v Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD)].

[35] In his affidavit, Mr. Witzel states that "Onward Manufacturing was licensed by the Opponent on or about January 1, 2001 to manufacture and sell barbecues/gas grills and related products on behalf of the Opponent" [para 4, my emphasis]. Since Mr. Witzel has framed the relationship between the Opponent and Onward Manufacturing as a licensing arrangement, I will discuss the provisions of section 50 of the Act before addressing the Opponent's own use.

#### Licensed use under section 50 of the Act

[36] When a trademark is used by a licensee, there are three main methods by which the trademark owner can demonstrate the control required to benefit from section 50(1): first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of a licence agreement that explicitly provides for the requisite control [*Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102]. In addition, where public notice is given of the owner's identity and of the fact that the use is under licence, section 50(2) of the Act creates a rebuttable presumption that the use is licensed by the owner, with the requisite control.

[37] In the present case, the evidence does not contain an attestation that the Opponent controls the character or quality of the goods provided in association with any of its trademarks. Mr. Witzel specifies that the licence includes royalties and the right to use the Opponent's Trademarks, but he is silent as to who controls the character or quality of the goods. Nor did the Opponent furnish a copy of a licence agreement providing for the requisite control. Although the Opponent took under advisement a cross-examination request for at least the portions of the

licence that deal with control over the character and quality of the goods [Q29], the Opponent ultimately did not answer this request.

[38] I am also not satisfied that the evidence otherwise demonstrates the requisite control. In this respect, the jurisprudence is clear that corporate structure or share ownership on its own does not support an inference that the parent company controls the character or quality of the goods sold by the subsidiary [*Live! Holdings, LLC v Oyen Wiggs Green & Mutala LLP*, 2020 FCA 120]. There is at least one document in evidence suggesting that Onward Manufacturing shares the Opponent's address [compare 2014 Dealer Price List referencing Onward Manufacturing at Exhibit D with Opponent's Corporation Profile Report at Exhibit A]. However, in the absence of any other indicia, the mere fact that both companies share the same office premises would not demonstrate the parent company's control over the character or quality of the goods sold by the subsidiary [see *e.g. Schwartz Levitsky Feldman v Sun Life Assurance Company of Canada*, 2010 TMOB 37; *2076631 Ontario Limited v 2169-5762 Quebec Inc.*, 2011 TMOB 92].

[39] Finally, I am not satisfied that public notice has been given that Onward Manufacturing's use of the Opponent's Trademarks is licenced by the Opponent, which would have allowed the Opponent to benefit from the presumption created by section 50(2) of the Act.

[40] In this respect, Mr. Witzel states that "[t]he name of the manufacturer (i.e. the Opponent or Onward Manufacturing) is used on the packaging for the barbecues/grills" [para 7]. However, he furnished only one image of packaging which, at the most, displays a mark on the side of the package that is difficult to make out given the poor quality of the image but that appears consistent with the "ONWARD" logo appearing in other materials [Exhibit C]. Certain catalogue or price-list covers or brochures display an abbreviation such as "OMC" or "ONWARD"; however, such a notation is ambiguous on documents dated 2001 or later, where it could refer to either the Opponent (Onward Multi-Corp. Inc.) or Onward Manufacturing Company Limited [Exhibit C]. At best, a Home Depot advertisement appears to name the Opponent: the attribution statement on the exhibited copy is cut off, but the visible portion is consistent with the phrase "Broil-Mate is a registered trademark of [illegible] Onward Multi-Corp. Inc." [Exhibit D]. However, because this document is undated, it is not possible to determine whether it was

distributed before or after the assignment to Onward Manufacturing. In any event, none of these materials is shown to indicate that the trademark use is under licence.

[41] At the hearing, the Opponent submitted that the documents filed with the Registrar in the current opposition proceeding are public documents giving notice of the ownership and licencing of the Opponent's Trademarks. However, I am not aware of any authority for this manner of providing notice to the public. In my view, it is doubtful that it would be effective, as it would require purchasers to access and review opposition files to determine whether any licences governing the trademark for the product to be purchased are in effect.

[42] In the circumstances, I cannot find that Onward Manufacturing's use of the Opponent's Trademarks enures to the Opponent's benefit under section 50 of the Act.

#### Use by the Opponent itself

[43] At the hearing, the Opponent's primary position was that the Opponent also sells goods *itself*, both through its own retail stores and through distributors, sales agents, or other retailers, including big box stores. In this respect, I note Mr. Witzel's statement that, "[p]rior to Onward Manufacturing manufacturing and selling on behalf of the Opponent, the Opponent manufactured and sold the barbecues and related wares" [para 4, my emphasis]. However, the Opponent stresses that Mr. Witzel never suggests the Opponent *stopped* selling; on the contrary, Mr. Witzel describes the Opponent not only as "a leading manufacturer" but also as "a distributor" of the goods, who has sold them both "directly" and "indirectly" [paras 6, 8-11].

[44] The Opponent submits that its interpretation aligns with the evidence in the *2010 Opposition*; however, if additional evidence was furnished in that case, it is not of record in the case before me. In particular, nowhere in Mr. Witzel's affidavit does he mention the Opponent having its own retail stores, whether physical or online.

[45] In the present case, upon review of the furnished examples of trademark use "directly in relation to the Opponent's wares and services on ... catalogues, brochures ...", I find that only two of the documents dated after January 1, 2001 identify a potential source for the goods in an unambiguous manner: the 2014 and 2015 dealer price lists for BROIL-MATE identify "ONWARD MANUFACTURING COMPANY LTD." as the company accepting orders [para 7,

Exhibit C]. At the hearing, attention was drawn to the Opponent's address being displayed in the header of the 2014 price list; however, nothing prevents a parent and its subsidiary from having the same address. In addition, the only attribution statement displayed on the furnished printouts from "websites of the Opponent" reads "© Onward Manufacturing Company Ltd. 2016" [paras 12-13, Exhibits D-E] and Mr. Witzel confirmed during cross-examination that this website (*broilkingbbq.com*) is actually owned by "[o]ne of our related companies" [Qs 36-37]. Thus Mr. Witzel's references to "websites of the Opponent" and to trademark use "directly in relation to the Opponent's wares" include materials that appear to originate from Onward Manufacturing.

[46] In addition, Mr. Witzel's references to use of the Opponent's Trademarks "indirectly" encompass use by Onward Manufacturing. In this respect, I note that he specifies the Opponent's sales under the trademark BROIL KING in Canada as from 2006 were made "directly or indirectly through Onward Manufacturing" [para 8, my emphasis].

[47] If Onward Manufacturing were merely a *distributor* of goods originating from and branded by the Opponent, then its role in the distribution chain would not undermine the Opponent's trademark use. However, Mr. Witzel states that Onward Manufacturing is licensed not only to sell but also to *manufacture* the grills and related products and that advertising is prepared "by or on behalf of the Opponent and/or Onward Manufacturing or by dealers of the Opponent and/or Onward Manufacturing" [paras 4, 12, my emphasis]. The fact that Onward Manufacturing may have advertising prepared on *its* behalf and dealers acting on *its* behalf in respect of goods *it* has manufactured suggests that Onward Manufacturing may be the source of at least certain goods. Branded goods made by Onward Manufacturing pursuant to its rights under a licence—rather than merely in fulfilment of a supply contract—would originate from Onward Manufacturing and thus their sale would not enure to the Opponent's benefit where the requirements of section 50 of the Act are not met.

[48] Unfortunately, Mr. Witzel does not clearly distinguish between the Opponent's actions and those of Onward Manufacturing when he describes trademark use as being "by or on behalf of" the Opponent [para 5]. When asked under cross-examination what he means by the expression "by or on behalf of", he specified that he means use by the Opponent "and/or any of

our affiliated companies”, including ones whose names he did not remember [Qs 42-45]. When asked to name those in the Canadian market, he elaborated as follows [Q46]:

A. *We’re an old company and over the years we have had numerous changes to our corporate structure. We are over a hundred year old company and so some of those companies still exist and would be using the marks and I just don’t have perfect knowledge of each of our different entities, as that’s not something I have to deal with on a day to day basis.*

[49] Given Mr. Witzel’s position as Secretary of the Opponent, responsible for all administrative support to the Opponent’s legal, operations, and procurement functions, his lack of “perfect knowledge” regarding which companies are using the Opponent’s Trademarks “on behalf of the Opponent” suggests that at least some such companies may not be acting as the Opponent’s agents, suppliers, or distributors. If the expression “on behalf of” were meant to indicate only such relationships, then it should have been a simple matter for Mr. Witzel to provide that clarification when specifically asked under cross-examination.

[50] Mr. Witzel does make some statements regarding the Opponent specifically, but they do not establish its use of the Opponent’s Trademarks:

- Mr. Witzel states that millions of gas barbecues have been manufactured “by the Opponent” for export [para 8]; however, he does not specify how trademarks are displayed on such goods and thus it is not possible to determine whether the requirements of section 4(3) of the Act for use of a trademark by export have been met.
- Mr. Witzel states that “the Opponent” has used the trademark BROIL KING IMPERIAL since 1999 and that sales of this model “are reasonably estimated to be approximately 5% of the BROIL KING sales in Canada” [paras 5, 8]. However, at best, his affidavit shows BROIL KING and IMPERIAL displayed as separate trademarks; for example, BROIL KING on a grill lid and IMPERIAL on its control panel or BROIL KING on a package label at some distance above the fine print “IMPERIAL XL 296 LBS. 135 KG.” [Exhibit C]. There is one occurrence of “BROIL KING® IMPERIAL™ XL” in the text of an advertisement [Exhibit C]; however, there is no indication that such advertisements accompanied the goods at the time of sale or otherwise met the requirements of section 4(1) of the Act for use of a trademark in association with goods. I would also note

that the above-referenced images and materials are undated and, as such, would not assist in showing use of the trademark BROIL KING IMERIAL after January 1, 2001.

- Mr. Witzel states that “the Opponent” has spent money advertising and marketing the BROIL KING brand in Canada, including via “websites of the Opponent” and distribution by its sales representatives [paras 8-9,12 with Q49]. However, advertising on its own does not meet the criteria for trademark use set out in section 4 of the Act. Moreover, as noted above, at least certain advertising displays the name of Onward Manufacturing and it is therefore unclear whether any goodwill or reputation generated by such materials would be acquired by the Opponent or Onward Manufacturing.

[51] The law is clear that ambiguities in an affidavit should be resolved against the party adducing the evidence [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. In the present case, owing to the ambiguities in Mr. Witzel’s affidavit, I am unable to determine the extent of the Opponent’s own use of its trademarks—which may have been no more than nominal—or the extent to which these trademarks have acquired a reputation in the hands of the Opponent.

#### Conclusion with respect to relevance of use by Onward Manufacturing

[52] In view of the foregoing, I find the evidence insufficient to demonstrate either (i) that licensed use or advertising of the Opponent’s Trademarks by Onward Manufacturing enures to the Opponent’s benefit or (ii) that after the licence was granted, the Opponent continued its own use or advertising of the trademarks. While Mr. Witzel does not state the Opponent stopped using the trademarks, he does not provide evidence of use that can be clearly attributed to the Opponent either. As a result, I am unable to find that the Opponent benefits from the evidence of use and promotion of its trademarks after January 1, 2001.

[53] I would add that my conclusion is based strictly on the evidence before me and is not a finding with respect to the validity or enforceability of the Opponent’s registered trademarks.

[54] I also agree with the Opponent that use of its trademark being divided among affiliated entities is not a fact that would assist in establishing the distinctiveness of the Mark. However, the level of distinctiveness acquired by *both* parties’ trademarks will need to be weighed in any

confusion analysis. Also, an applicant is not required to respond to a ground of opposition alleging the negation of its trademark's distinctiveness by an opponent's trademark *unless* the opponent first meets its evidential burden to support the facts pleaded in that regard.

### **Opinion evidence**

[55] Finally, I note that I have disregarded Mr. Witzel's stated opinion that the Opponent's Trademarks are well known and have a significant reputation, as he has not established himself as an expert in market research or trademark law and is not independent of the parties.

### THE APPLICANT'S EVIDENCE

[56] In support of its application, the Applicant filed a certified copy of the Opponent's registration no. TMA332,350 for the trademark BROIL-MATE, showing that it was expunged on May 10, 2018 for failure to renew, and the following five affidavits.

- The affidavit of its VP Delivery Support Services, Kenneth J. Belding, which is dated July 31, 2018. Mr. Belding, who previously held the position of VP Sales and before that VP Technical Services, describes how the Mark has been used and promoted in Canada by Martin Industries from 1999 to 2001 and by the Applicant since 2003. As exhibits to his affidavit, he attaches representative photographs of grills and of packaging for parts, copies of product brochures and manual covers, sample invoices, and documentation of online advertising, including webpages from the Internet Archive Wayback Machine at *web.archive.org*, which archives the appearances of webpages over the years;  
  
Mr. Belding was cross-examined on his affidavit; the transcript as well as answers to undertakings and questions taken under advisement are of record.
- The affidavit of its Business Analyst and former Marketing Manager, Jeffrey F. Cleveland, which is dated August 3, 2018. Mr. Cleveland describes and provides printouts of certain customer inquiries and communications the Applicant received from individuals in Canada stating they had purchased or been gifted one or more BROILMASTER grills in the 1970s, 80s, and/or 90s and, in some cases, subsequently purchased replacement and/or upgrade parts.

- The affidavit of Jonathan W. Marchand, which is dated July 24, 2018. Mr. Marchand identifies himself as an associate with the firm connected to the Applicant's agent and provides the following: (i) photocopies he made of pages from the Registrar's file on April 25, 2017 concerning Martin Industries' assignment of the Prior Application; and (ii) registration pages for the Applicant's trademarks that he printed from the United States Patent and Trademark Office's online database on April 27, 2017.
- An affidavit of D. Jill Roberts dated August 1, 2018 (Roberts No. 1). Ms. Roberts identifies herself as a graduate of the law clerk program at Cambrian College in Sudbury, Ontario, and in this first affidavit she provides the following:
  - pages she printed from the Canadian Trademarks Database in July 2018 to show the state of the register with respect to BROIL-formative trademarks;
  - printouts and screen captures of webpages she accessed in April and May 2017 and July 2018 from the Applicant's website; the websites of other manufacturers, distributor and retailers; and the Internet Archive Wayback Machine;
  - photographs and brochures from retailers she visited in April 2017; and
  - (iv) as Exhibit 35, a photocopy of her affidavit from the *Applicant's 2015 Opposition* (Roberts No. 1A), in which she provides photographs and a brochure from a retailer she visited in July 2013.

I note that I consider Ms. Roberts to be adopting the contents of her affidavit from the *Applicant's 2015 Opposition* by reference and thus swearing to their truth.

- A second affidavit of D. Jill Roberts, dated August 2, 2018 (Roberts No. 2), wherein Ms. Roberts provides various definitions from her searches of the 1998 *Canadian Oxford Dictionary (Canadian Oxford)*, the *Google.ca* search engine, and the Canadian Trademarks Database, conducted on May 4, 2017. The Google search results include printouts from the websites at *wikipedia.org* and *canadianfoodandwineinstitute.ca* and from the website of the Opponent at *broilkingbbq.com*.

[57] The Opponent has objected to several aspects of the Applicant's evidence, which I will address before considering the grounds of opposition.



### **Admissibility of records from Martin Industries**

[58] At the oral hearing, the Opponent objected that the sales figures and sample brochures from Martin Industries furnished by Mr. Belding are inadmissible hearsay. Mr. Belding was also challenged during cross-examination with contradictory evidence he had provided in the related proceeding against *OPTIONS BY BROILMASTER*, namely that he was unaware of any evidence of sales by Martin Industries and did not have access to their business records. It was also put to him that the Applicant's former president, John Hart, had sworn in the *2010 Opposition* that the Applicant received no sales records from Martin Industries.

[59] Mr. Belding responded by explaining that, after giving evidence in the related opposition, he found the sales numbers with some brochures and marketing information in his old office, in a binder that would have been received from Martin Industries but was forgotten over the years [Qs 18-37]. He specified that he did not remember how he got hold of the binder and that Mr. Hart may not have known about the binder, because at the time it was considered to be "really of no consequence" and the numbers "indicate no sales of any consequence" [Qs 30-37].

[60] At the hearing, the Applicant took the position that the contents of the binder are corporate documents and thus exempt from the rule against hearsay. The Applicant also notes in its written argument that Mr. Belding was not taken up on his offer to provide the pages from the binder that document the sales figures [para 53, citing Q33].

[61] It appears Mr. Belding did not make the records in this binder, or even obtain the binder, in the usual and ordinary course of the Applicant's business. Rather, he was given it in the context of a brand acquisition, as something "of no consequence", under circumstances that he cannot recall [Qs 13-17, 30-37]. Moreover, the binder does not appear to have since been maintained as a corporate record but rather has "sat in a drawer for years, and years and years", as Mr. Belding had "just forgotten it was there" [Q31]. In the circumstances, I am not satisfied that the contents of the binder qualify as a business record exempt from the rule against hearsay.

[62] Hearsay evidence that is *prima facie* inadmissible may still be admitted if it satisfies the criteria of necessity and reliability [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. If information from Martin Industries is not otherwise

available, then resort to the binder would be necessary. However, I am not satisfied the resulting sales figures may be considered reliable. Mr. Belding appears to have no personal knowledge of Martin Industries' sales or record keeping practices. On cross-examination, he could not recall the exact year or circumstances in which he received the binder or provide any information on how the sales figures were derived [Qs 27-37]. At best, when asked whether the binder contained "summaries of sales figures or invoices" or anything "of consequence" to attach as a supporting exhibit, Mr. Belding was able to answer "I don't know about invoices. I believe it was summaries." and "Well, there could be something. I don't know. I could get a piece of paper that's out of the biner that shows these sales" [Qs 27-28, 33]. In the circumstances, I am not prepared to give the purported sales figures any weight.

[63] I reach a different conclusion for the sample brochures. As evidence of the manner in which Martin Industries was branding and promoting merchandise, the brochures speak for themselves and there is no reason to doubt their authenticity. Indeed, parts of the Applicant's own brochures have a similar look and feel and show similarly branded goods [compare Exhibits B and F]. Moreover, I am prepared to accept that Mr. Belding, as the Applicant's VP Sales when the Mark was acquired, would have become familiar with the merchandise at least to the extent necessary to sell accessories and replacement parts and continue the product line. However, in the absence of any information on the timing and extent of the brochures' distribution, they are of limited probative value and I am not prepared to give them much weight.

#### **Admissibility of e-mails from customers**

[64] The Opponent also submits that Mr. Cleveland's affidavit constitutes inadmissible hearsay. Mr. Cleveland attaches to his affidavit e-mails he received from 2009 to 2016 in his capacity as the Applicant's Marketing Manager, from five individuals in Canada who own BROILMASTER grills from the 1970s, 80s, and 90s. The e-mails include inquiries about replacement parts and grills, as well as stories and photographs of grills submitted to the Applicant's "Broilmaster Hall of Fame", which was created in 2011 and was still online in 2018 [Cleveland paras 3-9, Exhibits A-C]. Some of the grills depicted in the photographs display the Mark.

[65] The Applicant submits that this evidence is necessary given the difficulty of obtaining sworn testimony from customers or other direct evidence from that far back in time. It further submits that such spontaneously sent, unsolicited messages may be considered reliable.

[66] However, even if it is unrealistic to expect consumers to provide an affidavit and submit to cross-examination to help the Applicant register a trademark, I am not satisfied the customers' statements in this case are sufficiently reliable to be admitted for the truth of their contents. Although the e-mails appear to have been received and retained by the Applicant in the ordinary course of its business, the statements themselves are not records made by the Applicant. Furthermore, these customers' statements refer to products acquired decades ago and the Opponent is precluded from testing the customers' recollection through cross-examination.

[67] In any event, such early sales of BROILMASTER grills would be of little assistance to the Applicant's case. The Application claims use of the Mark only by the Applicant and Martin Industries, whereas Mr. Belding indicates the Mark was owned in the 1970s and 80s by different predecessors. Indeed, one of the photographed grills is marked WAIT BROILMASTER with a label from B.D. Wait Co. Limited/Limitée, yet the Applicant provides no information on its relationship to that company. Unlicensed use of the Mark by entities other than those named in the Application does not enure to the Applicant's benefit.

[68] At best, this correspondence indicates that, at the time it was sent, at least the authors were familiar with the Mark and associated it with the Applicant's grills. The fact that they praised BROILMASTER grills and asked the Applicant about replacement parts and upgrades speaks to how the brand was known at the time and to the reputation it had acquired, regardless of the truth of the e-mails' contents. To that extent, Mr. Cleveland's evidence is admissible. However, such individual statements are not necessarily representative of the general public's perceptions or associations, and so Mr. Cleveland's evidence may not be probative in that regard [see *CIBC World Markets Inc v Stenner Financial Services Ltd*, 2010 FC 397; and *Joseph E Seagram & Sons Ltd v Canada (Registrar of Trade Marks)* (1990), 33 CPR (3d) 454 (FCTD)].

### **Admissibility of the state-of-the-marketplace evidence**

[69] Finally, the Opponent submits that the Applicant's evidence of trademark use by third parties is inadmissible hearsay and that the inconvenience of obtaining direct evidence in this regard does not obviate the need to show use in accordance with the Act.

[70] The results of Internet searches are generally considered hearsay and cannot be relied upon for the truth of their contents. However, they are admissible to show how the located webpages appeared at the time and the Wayback Machine archive has been accepted as a reliable source for evidencing past appearance [see *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FC) at para 21; rev'd on other grounds 2008 FCA 100; and *ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056, aff'd 2005 FCA 96; see also *Cogan v EMusic.com Inc*, 2011 TMOB 34 at para 18]. Accordingly, as examples of how third-party advertising has appeared, the results of Ms. Roberts' Internet searches are admissible. That said, the fact that certain websites offering goods for sale were accessible from Canada does not in itself establish the extent to which Canadians other than Ms. Roberts may have visited the sites or that any of the goods were actually sold in Canada at any relevant time.

[71] I note that the Applicant also relies on certain webpages as evidence of the Opponent's pricing. To the extent that this evidence is hearsay, it appears necessary and reliable, as the Opponent would not be expected to assist the Applicant to make its case and had the opportunity to refute the evidence. I am therefore also prepared to give such evidence some weight.

### **GROUND OF OPPOSITION BASED ON CONFUSION BETWEEN THE TRADEMARKS**

[72] The primary grounds of opposition in this case turn on allegations of confusion between the Mark and the Opponent's Trademarks. By way of background, I will begin with a brief overview of each party's business and trademark portfolio.

#### **The Opponent's business and trademarks**

[73] The Opponent is an Ontario-based manufacturer and distributor of gas barbecues and replacement parts, implements, and accessories for barbecues, which are sold in Canada and also exported to the United States and elsewhere [Witzel, paras 3, 6, 8]. The Opponent's Trademarks

are displayed on the barbecues themselves and on their packaging, as well as on various promotional materials [para 7, Exhibits C-E]. Mr. Witzel states that the promotional and marketing methods consist mainly of advertisements in journals and magazines and on television; posters, brochures, and newsletters distributed by the Opponent's sales representatives and mailed upon request or to mailing lists; signage on billboards and truck trailers; trade show materials; publications on the Opponent's websites and those of online retailers and dealers; and other, unspecified "items" and "activities" [paras 12-13, Q49, Q67].

[74] The Opponent's Trademarks include BROIL KING and BROIL KING Design, which were purchased from Jacuzzi Inc. in the 1980s; BROIL KING IMPERIAL, which refers to the top model in the BROIL KING line; and BROIL-MATE, which was purchased from BD Waite Co. Limited in 1990 [paras 5, 8]. With respect to BROIL KING Design, I note that the chevrons replacing the dot on each "i" appear more like candle flames in some of the earlier marketing materials; however, I consider this to be an acceptable minor variation of the trademark [per the principles set out in *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[75] In addition, I consider use of the BROIL KING Design to also constitute use of BROIL KING, since the word mark remains recognizable and stands out from the design features [for the principles regarding added elements and stylization, see *Canada (Registrar of Trade Marks) v Cie International pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[76] I would also note that on some grills and promotional materials the BROIL KING Design is followed by the word "SOVEREIGN" printed at an angle, in a different size and font style. Since I find that BROIL KING and SOVEREIGN stand out as separate trademarks, I consider such display to also constitute use of both BROIL KING and BROIL KING Design [for the principles regarding use of multiple trademarks together, see *Stikeman, Elliot v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)].

### **The Applicant's business and the Mark**

[77] The Applicant manufactures and sells grills and grill accessories in Canada and the United States under the trademark BROILMASTER, which it acquired from Martin Industries in

November 2001 [Belding paras 3-4, 7-8; see also Marchand Exhibit A]. The Mark is displayed on the grills themselves and on product packaging and manuals, as well as on the Applicant’s website and annual brochures provided to customers through distributors [Belding paras 5, 9-13, 25-26, 30]. The grills have been manufactured since the 1960s (by earlier predecessors) and are customizable in that consumers can choose all the parts, materials, and finishes [Belding paras 3-4]. For example, a customer might choose a grill head, a cart or post, and up to three shelves, and could add more features, such as a side burner or rotisserie, or upgraded finishes [Belding para 21 & Exhibit F]. The Applicant continues to manufacture and supply parts for the older grill models to Canadian customers [Belding para 6; Cleveland Exhibits A-B].

[78] I note from the Applicant’s evidence that the Mark is often displayed in a rectangular frame together with a descriptive phrase—“PREMIUM GRILLS” or “PREMIUM GAS GRILLS” in the case of grills and “ESSENTIALS” in the case of accessories. In these cases the Mark appears in bold lettering above the description and is followed by the ® registration symbol. I consider such displays to constitute display of the Mark as registered, since the Mark remains recognizable as such and stands out from the descriptive element [per the principles set out in *CII Honeywell Bull, supra; Nightingale Interloc, supra*].

**Registrability of the mark under section 12(1)(d)**

[79] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the following registered trademarks of the Opponent:

Trademark	Reg. No.	Registered Goods
<b>BROIL KING</b>	TMA257,283	Gas barbecues.
<b>BROIL KING &amp; Design</b> <b>Broil King</b>	TMA787,133	Gas barbecues.
<b>BROIL KING IMPERIAL</b>	TMA832,426	Barbecues, grills and replacement parts therefor.
<b>BROIL-MATE</b>	TMA332,350	Barbeques, replacement parts for barbeques and implements used with barbeques.

[80] The Opponent further pleads that “three or more” of its trademarks represent a series of associated trademarks and that the Mark is confusing with the entire series. However, pleading

several potentially confusing trademarks under a registrability ground presents several distinct bases for opposition, each of which must be considered separately, with confusion being assessed on a mark-by-mark basis [*Benjamin Moore & Co Limited v Home Hardware Stores Limited*, 2017 FCA 53; see also *Masterpiece, supra*]. That said, the allegation of a series will be considered as one of the surrounding circumstances in the test for confusion.

[81] The material date for this ground is the date of the Registrar's decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. An opponent's initial burden is met if the registration it relies upon is in good standing and the Registrar has discretion to check the Register in this respect [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised that discretion, I confirm that the BROIL-MATE registration was expunged for failure to renew on May 10, 2018, but that the registrations for BROIL KING, BROIL KING Design, and BROIL KING IMPERIAL (BROIL KING Trademarks) remain extant.

[82] The Opponent having met its initial burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with any of the BROIL KING Trademarks.

#### The test for confusion

[83] 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 in the same class of the Nice Classification system for trademark registration [section 6(2) of the Act].

[84] The test for confusion is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees an applicant's trademark at a time when he or she has no more than an imperfect recollection of the opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23 at para 20].

[85] Regard must be had to all the surrounding circumstances, including those set out in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services, or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and the weight given to each will vary in a context-specific analysis [*Veuve Clicquot, supra*; *Masterpiece, supra*; *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22].

[86] In my opinion, comparing the Mark and BROIL KING (TMA257,283) will effectively decide the registrability ground of opposition. If confusion is not likely between the Mark and BROIL KING, then it will not be likely between the Mark and BROIL KING Design or BROIL KING IMPERIAL. I will therefore focus my discussion on the BROIL KING registration.

#### Resemblance between the trademarks

[87] The degree of resemblance between the trademarks at issue is generally the most important factor in assessing the likelihood of confusion [*Masterpiece, supra*]. Each trademark must be considered as a whole; it is not the proper approach to set them side by side and carefully examine them to find similarities and differences [*Veuve Clicquot, supra*; *Masterpiece, supra*]. However, considering a trademark as a whole does not mean that a dominant component that would affect an average consumer's overall impression of the trademark should be ignored [*Masterpiece, supra*]. The preferable approach is to begin by determining whether there is an aspect of each trademark that is "particularly striking or unique" [*Masterpiece, supra* at para 64].

[88] In the present case, the Opponent takes the position that BROIL is the "dominant and distinctive" portion of the Mark [written argument at para 31]. Conversely, the Applicant submits that there is nothing striking or unique about the common English word BROIL. In the Applicant's submission, the word BROIL means to "cook (meat etc.) by direct exposure to heat" [*Canadian Oxford* in Roberts No. 2, Exhibit 1]; it is thus descriptive of grills, such that consumers will rather focus on the other portions of the parties' respective trademarks.

[89] The first portion of a trademark is often considered to be the most important for the purpose of distinction [*Conde Nast Publications Inc v Union des Éditions Modernes* (1979), 46



CPR (2d) 183 (FCTD)]. However, when the first portion is a descriptive or suggestive word, its importance diminishes [*Merial LLC v Novartis Animal Health Canada Inc* (2001), 11 CPR (4th) 191 (FCTD)]. In the present case, both trademarks begin with the word BROIL and they are similar to that extent. However, I agree with the Applicant that the word BROIL describes a function of grills and therefore consumers would tend to accord it less importance.

[90] In the circumstances, I consider the most striking aspect of the Opponent’s trademark BROIL KING to be the idea conveyed by the trademark as a whole, namely that of being the “king” of broiling. I consider the most striking aspect of the Mark to be the idea conveyed by the trademark BROILMASTER as a whole, namely that of being a “master” of broiling.

[91] I find the trademarks to be only somewhat similar in appearance and sound, because the words constituting the second half of each trademark—KING and MASTER—are visually and aurally different. There is also a difference in that BROIL KING is a two-word construction whereas BROILMASTER is a single compound word; however, I find that difference to be relatively subtle. As for ideas suggested, each of the parties submits a different interpretation.

[92] The Opponent submits that BROIL KING and BROILMASTER are synonymous and suggest “a leader or head, one that holds a preeminent position, one having authority over another, a chief among competitors, or one that conquers” [written argument, para 29].

[93] Conversely, the Applicant submits that BROIL KING suggests the idea of royalty and grills having royal stature, whereas consumers would understand BROILMASTER to refer to someone who has achieved great skill at grilling or cooking and will lead grill owners to achieve a high level of such skill. In this respect, the Applicant draws attention to the following definition of the word “king” from the online encyclopedia *Wikipedia* and the following definitions of the word “master” from *Canadian Oxford* [Roberts No. 2, Exhibits 1, 6, emphasis in original]:

King:

**King** is the title given to a male monarch in a variety of contexts.

Master:

**5a** a person skilled in a particular trade and able to teach others (often *attrib.:* *master carpenter*).

**5b** a person highly accomplished in a particular skill, activity, etc.” (*Italian violin masters; a master of manipulation*).

**6a** (in full **master’s degree**) a graduate degree....

[94] Further, the Applicant argues that common English words in which a term is followed by the word “master”—such as brewmaster, choirmaster, concertmaster, drillmaster, grandmaster, and toastmaster—are understood to refer to someone highly skilled in a particular field and able to teach and lead others in that skill [citing definitions from *Canadian Oxford* and *google.ca* and information from websites located in a Google search—see Roberts No. 2, Exhibits 1-5].

[95] I also note the Applicant’s submission that the trademark BROIL KING is particularly suggestive of royalty in view of the Opponent (i) also owning the trademark BROIL KING IMPERIAL; (ii) having owned a registration for BROIL QUEEN in association with “gas barbecues” [Roberts No. 2, Exhibit 9]; and (iii) advertising on its website the sub-brands IMPERIAL, REGAL, BARON, SOVEREIGN, SIGNET, MONARCH, and GEM, which are suggestive of royalty [Roberts No. 2, Exhibits 7 (advertising) and 8 (definitions of the words in the sub-brands)]. However, under a section 12(1)(d) ground of opposition, it is the effect of the Opponent’s registered trademark itself that must be considered, and not the effect of other indicia that may appear with it or in proximity, such as sub-brands or brands on other products in the same product line. Such contextual factors do not limit the scope of the opponent’s registration. Furthermore, as noted above, each trademark pleaded under a registrability ground of opposition must be considered separately. Consequently, the Opponent’s BROIL KING IMPERIAL trademark does not imbue BROIL KING with any additional royalty connotation.

[96] I agree with the Applicant that the terms BROIL KING and BROILMASTER are not perfect synonyms, given the difference in character between a “king” and a “master”. However, I am unable to accept the Applicant’s position that the ideas suggested by the two trademarks are different because the word KING necessarily denotes royalty whereas the word MASTER has no connection to that concept. The Applicant’s evidence does not lead to the conclusion that the word KING has only this single meaning or that the meanings put forward by the Opponent—particularly those evoking leadership or preeminence—would not occur to the average consumer as a matter of immediate impression in the context of the trademark as a whole.

[97] When, at the hearing, the Applicant was asked to comment on the Opponent’s proposed meanings for the word KING, the Applicant responded that the only definition in evidence was the one from *Wikipedia* attached to Ms. Roberts’ affidavit. However, in assessing what consumers would understand from a combination of ordinary words such as “BROIL KING”, the Registrar must not only consider the evidence but also apply common sense [see *Candrug Health Solutions Inc v Thorkelson*, 2008 FCA 100; and *Neptune SA v Attorney General of Canada*, 2003 FCT 715]. In the present case, I find it cannot fairly be said that the word KING has only the one known meaning submitted by the Applicant.

[98] Indeed, the Registrar is not entitled to take judicial notice that a word has only a single meaning without evidence to that effect [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327; *Caterpillar Inc v Puma SE*, 2021 FC 974]. In the present case, the Applicant chose not to provide a dictionary entry from the *Canadian Oxford* for the word KING—despite having done so for the words BROIL and MASTER, various compound words ending in MASTER, and the Opponent’s royalty-related sub-brands. It is true that the *Wikipedia* entry provides one definition; however, *Wikipedia* is an encyclopedia and not a dictionary. Encyclopedias provide information on a list of subjects; dictionaries provide the various meanings of words. Given the nature and function of an encyclopedia entry, I cannot find, based solely on the *Wikipedia* entry for the royal title of “King”, that the word KING has no other ordinary meanings.

[99] In this respect, the Registrar may take judicial notice of the dictionary definitions of words found in trademarks [*Caterpillar, supra*; *Tradall SA v Devil’s Martini Inc*, 2011 TMOB 645]. The *Concise Canadian Oxford Dictionary* (Toronto: Oxford University Press, 2005) confirms that the word KING has multiple meanings, including the following:

King:

- 1 (as a title usu. **King**) a male sovereign, esp. the hereditary ruler of an independent state.
- 2 a person or thing pre-eminent in a specified field or class (*railway king*).
- 3 a large (or the largest) kind of plant, animal, etc. (*king penguin*).

[100] In my view, to the extent that a “king” may be understood to be a person of the highest rank and a leader (of a realm or in a specified industry), the notion is not entirely unlike that of a “master”—such as a choirmaster, concertmaster, or drillmaster—being in a pre-eminent position

and leading others. I would also note the following definitions from the *Canadian Oxford* entry for the word MASTER attached to Ms. Roberts' second affidavit, which relate to being a leader or head or in a controlling position [Exhibit 1]:

Master:

**1a** a person having control of persons or things.

**1c** a male head of a household (*master of the house*).

**3a** the head of a college, school, etc.

**3b** the head or presiding officer of a society, institution, Masonic lodge, etc.

**4a** a person who has or gets the upper hand (*we shall see which of us is master*).

[101] On balance, I find that the ideas conveyed by the parties' trademarks are similar, despite the difference in precise metaphor employed. In my view, when each trademark is considered in association with the relevant goods, neither the image of a male monarch nor the image of a skilled expert is more striking than the underlying idea of being the leading grill for broiling. While BROIL KING may suggest the idea of a grill with royal stature and BROILMASTER the idea of an expert grill imparting skill, I consider it more likely that the average consumer encountering either trademark displayed in association with a grill would, as a matter of immediate impression, understand the trademark to denote a leading grill, at the top of its class.

[102] In sum, considering the question as a matter of first impression and imperfect recollection, I find there to be a fairly high degree of resemblance between the trademarks because of their conceptual similarity, and despite the visual and aural differences in the latter portion of the trademarks. Accordingly, this factor favours the Opponent.

Inherent and acquired distinctiveness

[103] Both parties' trademarks have a similarly low degree of inherent distinctiveness: the first portion describes the function of the goods and the trademark as a whole has a somewhat laudatory connotation, evoking the concept of a leading grill for broiling. However, the presentation of this concept as a metaphor provides at least some inherent distinctiveness.

[104] In addition, both parties filed evidence of their trademark's use and promotion to show the extent to which it has become known.

*Opponent's evidence of use and promotion*

[105] Mr. Witzel asserts continuous use of the BROIL KING trademark in association with gas barbecues in Canada since at least as early as October 1980 “by or on behalf of the Opponent or its predecessor in title” [para 5]. He provides two average annual sales figures: one for the period 1989–2005 and one for the period 2006–2017 [paras 8-9]. He also provides an average annual marketing expense figure for each of these date ranges [paras 8-9]. The figures are substantial.

[106] However, as discussed above, for the period after January 1, 2001, Mr. Witzel does not clearly distinguish between the Opponent's use and that of its licensee Onward Manufacturing; nor does he show that Onward Manufacturing's use enures to the Opponent's benefit. It is therefore impossible to determine what proportion of any goodwill or reputation generated for the trademark after January 1, 2001 would be acquired by the Opponent as opposed to Onward Manufacturing. As a result, I am unable to determine to what extent, if any, the trademark BROIL KING has become known as a trademark *of the Opponent* after January 1, 2001.

[107] As for earlier use and promotion, rather than providing annual sales figures for each of the years from 1989 to 2000, Mr. Witzel provides only a single average for the period 1989–2005. The extent to which sales in each of the years from 1989 to 2000 may have been above or below this 17-year average is unknown. It may be that annual sales prior to 2001 were limited and that Onward Manufacturing's sales after January 1, 2001 raised the average. The same can be said of the marketing expenses.

[108] Mr. Witzel also attaches examples of advertising and promotion to his affidavit. While many of them are more recent or undated, I note the following that either predate or appear to predate the licence to Onward Manufacturing [Exhibit C]:

- copies of a BROIL KING dealer price list cover from 1990, of BROIL KING annual product catalogue covers from 1991, 1992 and 1997, and of what appear to be brochures for BROIL KING SOVEREIGN from 1998 and 1999—the three earliest covers depict grills bearing the trademarks BROIL KING and SOVEREIGN on the lid (as may the 1997 cover, where the branding cannot be made out clearly from the poor quality copy);

- an undated advertisement depicting a gas grill with the model number BK4024, featuring the trademark BROIL KING on the lid, below the smaller trademark JACUZZI; and
- an undated sheet depicting grill models BK 3020 and BK 4020 under the page heading “Broil King”, printed with a maple leaf between the two words—BROIL KING is displayed on one of the grill lids and, based on the similarity of the model numbers to Jacuzzi’s BK4024, I am prepared to accept the grills as additional early models.

[109] However, Mr. Witzel provides no information on the extent to which such materials have been distributed or accessed by Canadians. Nor does he provide particulars with respect to the location or timing of any of the other forms of advertising and promotion, or even differentiate between advertising directed to consumers and that directed to dealers. The website at *broilkingbbq.com* appears to be directed to consumers, but there is no indication that it was accessible before the BROIL KING trademark was licensed to Onward Manufacturing.

[110] Consequently, I am also unable to determine to what extent BROIL KING became known in the hands of the Opponent *before* it was licensed to Onward Manufacturing. Moreover, there is no indication of whether it would remain known as a trademark of the Opponent today.

*Applicant’s evidence of use and promotion*

[111] The Applicant asserts use of the Mark in Canada since at least the 1970s. However, as noted above, any use of the Mark by a third party not named as a predecessor in title in the application does not enure to the Applicant’s benefit. Furthermore, the sales figures from Martin Industries constitute inadmissible hearsay and there is no information on when and to what extent Martin Industries’ brochures were distributed. That said, I am prepared to accept the statements made in the e-mails furnished by Mr. Cleveland as evidence that at least five Canadians associate the Mark with the Applicant’s grills as a product line dating from the 1970s, 80s and 90s, bearing in mind that these consumers are not necessarily representative.

[112] With respect to the Applicant itself, Mr. Belding states that it has been selling grills and grill accessories in association with the Mark in Canada continuously since at least as early as 2003, with annual sales “in the thousands of dollars”, totalling “in excess of \$300,000 USD” from 2003 to the end of 2010 and “in excess of \$250,000 USD” from the beginning of 2011 to

mid-2018 [paras 10, 19, 23-24]. He explains that the grills and grill accessories are sold through Canadian distributors who in turn sell to boutique retailers (he names three distributors and six boutique stores), and through on-line retailers such as *amazon.ca* and *grillspot.ca*, who also sell replacement parts [paras 15-18]. He notes that the Applicant continues to manufacture and supply parts for grill models from the 1970s and 80s and has received requests from Canada for such replacement parts [para 6]. In support, he attaches the following materials to his affidavit:

- Sample invoices for grills, parts, and accessories sold to distributors in Canada each year from 2003 to 2018 [para 19, Exhibit E]. The invoiced products were shipped to Quebec, Ontario, Manitoba, Alberta, and British Columbia. A variety of products are listed, such as “grill head”, “cart”, “patio post”, “side shelf”, “burner kit”, “igniter kit”, “porcelain grid”, and “replacement briquets”, among others.
- Photographs showing the Mark displayed on grills, including on and inside the lid and on the control panel; Mr. Belding attests that these photographs are representative of how the Mark has been displayed since the 1960s [para 5, Exhibit A].
- Photographs showing the Mark on the package boxes of grill shelf kits, shrouds, and screens—Mr. Belding states these photographs are representative of the Mark’s display on various product packaging in Canada since 2003 [para 11, Exhibit C].
- Sample covers of product manuals packaged with the goods sold to consumers, for grills and accessories such as side burners, smoker shutters, regulators, griddles, collector boxes, ignitors, and shelves, representative of how the Mark has been displayed on such manuals since 2002 [paras 12-13, Exhibit D].
- A sampling of the Applicant’s annual BROILMASTER brochures—from 2007, 2016, and 2018—representative of how the Mark has been displayed on the Applicant’s brochures since 2003; Mr. Belding states that such brochures are given to Canadian distributors for distribution to customers and retailers [para 25, Exhibit F].
- Webpages archived from *broilmaster.com* displaying the Mark—and, as of 2001, an image of a grill or at least the lid—for every year from 1999 to 2018 [para 30, Exhibit H].
- Google Analytics statistics for the *broilmaster.com* website, indicating that it attracted over 5000 visits from Canada *in total* in the period 2002–2005 and in the range of

approximately 2000 to 5000 visits from Canada *each year* in the periods 2010–2011 and 2013–2017, with 70%–80% of the visits from 2010 to 2017 being new visits [Belding at paras 27-29, Exhibit G, Q67].

[113] In addition, Ms. Roberts provides information she was able to obtain about distributors, dealers, and retailers of the Applicant’s BROILMASTER grills in Canada. Attached as exhibits to her first affidavit are the following [Roberts No. 1]:

- Webpages archived from *broilmaster.com* every year from 2001 to 2010, advertising grills and accessories in 2001, and replacement parts under the heading “Grilling Accessories” as of 2002 [Exhibit 2]. As of 2003, a “Dealer” page lists dealers in Canada: a single Ontario dealer is listed in 2003 and as of 2004 the page lists at least four Ontario dealers and one in Prince Edward Island.
- Extracts from the website of Canadian distributor Diversco, indicating that it carries BROILMASTER barbecues, including webpages archived in 2003 and 2004 and pages accessed directly in 2017 and 2018 [paras 4-5, Exhibits 3-5]. The pages accessed in 2017 and 2018 include extracts from an online product catalogue, which lists three different models of complete barbecues.
- Extracts from the website of Canadian distributor Comfort Heating and Air Conditioning, indicating that it installs gas lines for BROILMASTER barbecues, including a webpage archived in 2015 and pages accessed directly in 2017 [paras 6-7, Exhibits 6-7].
- A webpage from *grillspot.ca* offering “affordable replacement parts for your BroilMaster barbecue grill”, including burner assemblies, cooking grates, a radiation shield, and a heat indicator [para 8, Exhibit 8].
- A webpage from *amazon.ca* offering grill parts “by Broil Master”, namely a burner, natural gas regulator kit, grill head, and “Flare Buster” [para 9, Exhibit 9].
- Photographs of BROILMASTER grills on sale at the Romantic Fireplaces & BBQ boutique retail store on July 10, 2013 and a brochure promoting BROILMASTER grills obtained from the store on the same day [Roberts No. 1A].



[114] The Opponent submits that the Applicant's evidence of sales and advertising does not assist its case for a number of reasons:

- Mr. Belding does not distinguish between sales of grills, accessories, and replacement parts, such that it is conceivable all or most of the sales were of accessories.
- None of the exhibited invoices covers sufficient components to complete a grill. If the Applicant's business model were to sell complete grills, then distributors would be expected to order all the parts for one rather than a random collection of parts that could presumably be interchanged with those of other manufacturers.
- The Mark is not displayed on the invoices and there is no evidence that the retailer's floor models photographed by Ms. Roberts were actually sold as complete grills.
- Even assuming sales of complete grills, dividing the sales totals by the average price of the Applicant's grills would suggest sales of only ten or twelve grills per year.
- Sales do not appear to have been continuous: Martin Industries sold the Mark in 2001, yet the Applicant's sales figures and sample invoices begin in 2003.
- The sales figures in evidence in the related opposition proceeding against OPTIONS BY BROILMASTER are the same, which would suggest the figures may be conflated or otherwise call their legitimacy into question.
- The accessories sold may not have been replacement parts. In this respect, I note that the accessories featured in Martin Industries' brochures also include items such as wood chips, cooking tools, steak knives, and touch-up paint [Belding Exhibit B].
- The Applicant has not adduced evidence of any advertising expenditures.

[115] I would first note that I do not consider Mr. Belding's evidence to be inconsistent with the sale of complete grills. For example, invoice no. 157496 [p. 77] contains an entry on line 10 for ten "D3BL GRILL W/GC3CART 2CTN" (part no. D3GC). This item appears on its face to comprise the two basic elements of a complete grill, a grill head and a cart—specifically the "D3BL-LP BLACK DELUXE GRIL" grill head (part no. D3BL) and the "GARDEN CART W/COVER/SHELF" (part no. GC3). Those two parts are listed separately on lines 10 and 11 of invoice no. 175776 [p. 78]. I also note invoice no. 18209 [p. 80], which charges a single price for

three items: the D3BL grill head, the GC3 cart, and a front shelf. Furthermore, I have no reason to doubt Mr. Belding's sworn statement that the invoices are for "sales of grills and grill accessories ... in association with the BROILMASTER trademark" and I am prepared to infer that the Mark would be displayed at least on the lid of complete grills and on parts' packaging as depicted in the photographs at Exhibits A and C to his affidavit.

[116] Moreover, as mentioned above, it is well established that a trademark owner's ordinary course of trade will often involve distributors, wholesalers and/or retailers, and that use of a trademark at any point along the chain of distribution enures to the benefit of the owner, provided that the marked goods originate from the owner [see *Manhattan Industries, supra*; and *Osler, Hoskin & Harcourt, supra*]. Considering the volume of parts represented in the sample invoices and Mr. Belding's explanation that the Applicant sells grills whose configuration is customizable, I find it reasonable to infer that at least some of the Applicant's substantial sales to distributors resulted in the retail sale of complete grills.

[117] With respect to the number of grills sold, I disagree that it may be estimated by dividing Mr. Belding's sales totals by his indication of the approximate retail price of a grill. The invoices he provides reflect wholesale prices in U.S. dollars: for example, invoices nos. 157496 and 175776 charge US\$354.97 for the aforesaid grill head and cart (whether in combination or separately) and invoice no. 18209 charges US\$293 for the combination of a grill head, cart, and shelf. These prices, albeit from 2003–2004, are not in the same ballpark as the CA\$3200 approximation Mr. Belding provides for a grill head, cart, and shelf at retail. That said, I would consider even sales in the hundreds of grills per year across Canada to be fairly limited.

[118] With respect to the Opponent's remaining comments, I do not consider them to undermine the Applicant's sales figures. The evidence shows that the *broilmaster.com* website was accessible in 2002 and whether the Applicant began its own sales then or in 2003 will make little difference to the distinctiveness acquired as of today's date. Furthermore, even if the sales figures for OPTIONS BY BROILMASTER were of record in the present case, I would see no inconsistency in stating that sales under both marks exceeded a certain number. Indeed, the Applicant's product packages and manuals [Exhibits C-D] show OPTIONS BY BROILMASTER displayed only as a secondary trademark, close to the Mark. Finally, the pages

from Martin Industries' brochures featuring accessories provide an indication of the components specifically marketed as "replacement parts": these include "replacement grids, burners, shelves and other components", as well as "Original equipment replacement burners", "Replacement cooking grids", and "Replacement ignition kit" [para 9, Exhibit B]. In addition, given the modular nature of the Applicant's grills, I am prepared to accept that many of the invoiced products—such as griddles, side burners, or warming racks—could be either an original accessory or a replacement part.

[119] As for advertising, the Applicant has furnished descriptions and examples thereof. That said, the number of hits to its website appears modest and no traffic figures are given for the distributors' or dealers' websites. There is also no description of the extent to which the print advertising has been distributed in Canada. In the circumstances, I am only prepared to find that the Applicant's advertising has been distributed or accessed to a limited extent.

#### *Conclusion on inherent and acquired distinctiveness*

[120] In view of the evidence furnished, I cannot find that BROIL KING is known today as a trademark of the Opponent, and I can only find that the Mark has become known in Canada to a limited extent. In the end, the overall consideration of the trademarks' inherent distinctiveness and the extent to which they have become known favours the Applicant, but only slightly.

#### Length of use

[121] The Opponent submits that the evidence establishes continuous use of BROIL KING in Canada since at least as early as October 1980. However, the Opponent appears to be relying on the date claimed in its registration, whereas the Federal Court has cautioned against giving even *de minimis* weight to such dates and, moreover, a registration in itself is not evidence that the registered trademark has been used continuously since the claimed date [see *Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951; and *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[122] I am prepared to accept, from the fact that Mr. Witzel has chosen to provide an average annual sales figure for the period 1989–2005, that the Opponent had sales in 1989. Furthermore, since the BROIL KING trademark is consistently displayed on the lid of the barbecues depicted

on the price list and catalogue covers attached to Mr. Witzel's affidavit—including those from the early 1990s and those that appear to be from Jacuzzi—I find it reasonable to infer that BROIL KING was displayed on the barbecues sold in 1989 in the same general manner. On this basis, I would be prepared to accept use of the BROIL KING trademark since 1989.

[123] However, given that the evidence of use by the Opponent and by Onward Manufacturing after January 1, 2001 is conflated, and it has not been established that use by Onward Manufacturing enures to the Opponent's benefit, I am not satisfied that there is support for the Opponent's claim that it has used the BROIL KING trademark *continuously* from the 1980s.

[124] The Applicant claims use of the Mark since 2001; however, it has furnished admissible evidence of use in Canada only since 2003, and the volume of those sales appears to be limited.

[125] In the circumstances, I find that this factor favours the Applicant, but only slightly.

#### Nature of the goods, businesses, and trades

[126] When considering the nature of the parties' goods, businesses, and trades under this ground, it is the statement of goods in the applicant's application and the statement of goods in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The 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; evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[127] From a plain reading of the statements of goods in the Application and in the Opponent's registration, it appears that the nature of the parties' goods is largely the same, since both parties' trademarks are for use in association with barbecues or grills, and the Applicant's replacement parts for grills would be a related good.

[128] The Opponent submits that the parties' channels of trade are also equivalent, with both parties sharing the same consumer base. At the hearing, the Opponent argued the Mark could be seen as a natural extension of the Opponent's brand, to be used at a different price point.

[129] Conversely, the Applicant submits that the parties' goods differ in practice because they are sold in different types of stores, to different types of consumers, at significantly different price points. The Applicant submits that its grills are higher-end and customizable, ranging in retail price from CA\$1600 to over CA\$4200 [Belding paras 3, 21-22; see also Roberts No. 1 Exhibit 9], whereas the Opponent's grills come with all the parts pre-selected by the manufacturer and are significantly less expensive, for example, the BARON model retailing for CA\$529 at Rona [Roberts No. 1, Exhibit 24]. Further, the Applicant submits that its grills and grill accessories are sold through distributors and boutique retail stores—such as heating and air conditioning, and hearth and patio stores—to best offer customization, servicing, repair, and parts replacement [Belding paras 15-17], whereas the Opponent's grills are sold through big box stores and large retail establishments [see Witzel, Exhibit D]. In sum, the Applicant submits its grills are for consumers who are willing to invest time and money to acquire a unique, premium, customized product, whereas the Opponent's grills are aimed at the average consumer who wants a functional grill, conveniently purchased from a big box store, for a deal.

[130] At the hearing, the Applicant added that it would be commercially unwise for it to change its business model when its reputation is based on customizable goods. In this respect, the Applicant cites *YM Inc v Jacques Vert Group Ltd*, 2014 FC 1242, for the proposition that assessing a company's future sales operations should not include speculation about possible new ventures. In that case, while acknowledging that there was no guarantee the applicant's PLANET clothing would always only be sold in the applicant's boutiques while the opponent would always only sell inexpensive clothing in its URBAN PLANET stores, the Federal Court found that there was no evidence to suggest the existing channels of trade would ever change.

[131] First, I am not prepared to infer that the single sign advertising a BARON model of BROIL KING grill is typical of the Opponent's price point. Indeed, the webpages from Home Hardware attached to Mr. Witsel's affidavit show two REGAL models of BROIL KING grill, retailing for CA\$1,649.99 and CA\$2,249.99, respectively [Exhibit D]. Both the Applicant and

the Opponent already offer their grills in a range of models at various price levels and, in the absence of evidence to the contrary, I would consider an expansion of such a product range in either direction to be a fairly natural extension. Moreover, there is no evidence to suggest that neither boutique stores nor big box stores sell barbecues at a range of price points.

[132] Second, both parties target consumers of outdoor cooking appliances and neither the Application nor the Opponent's registration restricts the channels of trade in the manner described by the Applicant. Nor does the evidence support such a distinction. The Opponent's retailers listed at *broilkingbbq.com* include not only large home improvement and department stores but also what appear to be specialty stores for barbecues, heating, hearth, and patio, including Barbecues Galore, BBQ Prestige, Patio Palace Fireplace & Barbecue Shoppe, Wicker World Home + Patio, and BBQing.com powered by Capital Appliance & BBQ [Witzel, Exhibit D]. With respect to the last two stores, I note that Capital Appliance & BBQ is also one of the Canadian dealers listed on the Applicant's website from 2006 to 2010 and that what appears to be a similar wicker store, Wickerland Patio & Home, is one of the Applicant's Canadian retailers identified by Mr. Belding [Roberts No. 1, Exhibit 2; Belding, para 17]. I also note from Ms. Roberts's first affidavit that in 2017 *amazon.ca* was offering parts such as cooking grids for the grills of both the Applicant and the Opponent [Exhibits 9, 34].

[133] The Applicant also submits that consumers will take more care when purchasing an apparatus such as a grill, which further militates against a likelihood of confusion. I accept that consumers shopping for expensive or important goods are likely to be somewhat more alert and attentive to the trademarks encountered. However, the test for confusion remains one of both first impression and imperfect recollection, even when the goods are expensive or important and likely to be researched by consumers [*Masterpiece, supra*].

[134] In view of the foregoing, and in the absence of any contrary information with respect to the parties' distributors and retailers, there appears to be considerable overlap and potential for overlap in the parties' goods and in their channels of trade. Therefore, the nature of the goods, business, and trade favour the Opponent.

### Surrounding circumstances

[135] The parties have raised a number of additional surrounding circumstances to consider.

#### *Scope of protection afforded to trademarks containing descriptive terms*

[136] The Applicant submits that any similarity between the parties' trademarks is due to the word BROIL, which is descriptive of the parties' goods and as such cannot be monopolized. The Applicant also argues that the registration for BROIL KING disclaims the right to the exclusive use of the word BROIL apart from the trademark as a whole.

[137] I would first note that the disclaimed portion of a trademark still forms an integral part of the trademark as a whole [see *Cafe Supreme F & P Ltée v Registrar of Trade Marks*, 4 CPR (3d) 529 (FCTD); and *American Cyanamid Co v Record Chemical Co* (1972), 7 CPR (2d) 1 (FCTD)]. That said, it is well established that trademarks comprised of descriptive or suggestive words are only entitled to a narrow ambit of protection. A greater degree of discrimination may fairly be expected from the public where a trademark consists wholly or in part of words describing the articles to be sold, such that even relatively small differences may suffice to avert confusion [*General Motors Corp v Bellows*, [1949] SCR 678, citing *Office Cleaning Services Ltd v Westminster Window & General Cleaners, Ltd* (1946), 63 RPC 39 at 41 (HL)].

[138] In the present case, I agree with the Applicant that the word BROIL is descriptive of the Opponent's goods. Moreover, I find that the evidence of use and promotion of BROIL KING is not so extensive as to significantly increase its distinctiveness. I therefore find that the BROIL KING trademark is not entitled to a particularly wide ambit of protection, and that relatively small differences may suffice to avert confusion. Accordingly, this circumstance favours the Applicant.



#### *The state of the register and marketplace*

[139] The Applicant also furnished evidence on the state of the register and the state of the marketplace in an effort to establish that trademarks featuring the word BROIL are common in the relevant market. The common occurrence of a certain element tends to cause purchasers to pay more attention to the other features of the trademarks and to distinguish between them by

those other features [see *Polo Ralph Lauren Corp v United States Polo Assn* (2000), 9 CPR (4th) 51 (FCA); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. Where a large number of relevant trademarks is identified on the register, the Registrar can infer that the element they all have in common is used in the marketplace; however, where the number of trademarks identified is not large, evidence of such use needs to be furnished [see *Maximum Nutrition, supra*; *McDowell v Laverana GmbH & Co. KG*, 2017 FC 327; and *Canada Bread Company, Limited v Dr. Smood APS*, 2019 FC 306].

[140] The Applicant submits that, “[w]hen third party marks are shown to be in actual use, fewer marks are required to make inferences that a word is commonly adopted and used in the marketplace ...” [written argument at para 108]. If the Applicant is suggesting that limited evidence of use automatically leads to an inference of more widespread use, I disagree. When evidence of use is required, it must be sufficient to support a conclusion that purchasers commonly encounter trademarks containing the shared element.

[141] Ms. Roberts’s search of the Canadian Trademarks Register revealed nine registered trademarks containing the word BROIL, standing in the names of seven different owners, for use in association with broiling and cooking appliances [Roberts No. 1, para 29, Exhibit 29]:

Mark	Reg. No.	Owner	Relevant Goods
BROILCHEF & Design * 	TMA877026	Grilltown Enterprises Inc.	gas barbecue grills; barbecue grill covers; sale of replacement parts for barbecues
CHAR-BROIL	TMA523978	W.C. Bradley Co.	home and camp grills
CHAR BROIL & Design ** 	TMA935850		charcoal, gas, electric bbq grills, parts & accessories for bbq grills
G-BROIL	TMA808792	Applica Consumer Products, Inc.	electric grills and electric griddles for domestic use
PERFECT BROIL	TMA773626		electric toaster ovens for domestic use
MAXBROIL	TMA846256	BSH Home Appliances	domestic cooking ovens; structural parts
TRUE-BROIL	TMA758542	Whirlpool Properties, Inc.	integral component of domestic cooking ovens, namely, a broiler
COMPU BROIL	TMA493508	Sharp Kabushiki Kaisha	microwave ovens
EVENBROIL ADVANCED BROILING SYSTEM	TMA725471	LG Electronics Inc.	oven ranges; electric ranges; microwave ovens; gas ranges; gas stoves; electric toasters

\* BROILCHEF & Design consists of the word “Broilchef” in a simple, narrow, slightly three-dimensional font, with shaded lettering and a flame design replacing the dot on the letter “i”.



\*\* CHAR-BROIL & Design consists of the word “Char-Broil” in a simple, thick, outlined font, with a flame design above the letters “ro” in “Broil”.

[142] I find this number of trademarks too small for inferences to be drawn about the state of the marketplace [for a similar conclusion, see *McDowell, supra*, re ten registrations / seven owners]. Furthermore, the claims of use contained in the registrations themselves are not evidence that the trademarks have been used continuously since the claimed date or become known to any significant extent [see *Entre, supra*].

[143] It is therefore necessary to consider the Applicant’s evidence of the state of the marketplace. In this respect, Mr. Witzel admitted on cross-examination that he has been aware of CHAR-BROIL barbeques being sold in Canada for over 25 years and knows BROIL CHEF barbeques as a “recent entrant” in Canada [Qs 26-28]. More importantly, Ms. Roberts provides some evidence of advertising in respect of these trademarks, as well as the trademark PERFECT BROIL, and an unregistered BROILKING trademark unrelated to the Opponent. The printouts she made from various retailers’ websites and the Wayback Machine and the photographs and brochures she obtained from Ottawa retail stores show the following:

BROILCHEF:

- BROILCHEF grills advertised at *grilltown.com* in 2012, on Home Depot’s *.ca* website in 2014, on the *.ca* websites of Grilltown, Home Depot, Walmart, and Best Buy in 2017, and at *grilltown.ca* in 2018 [Exhibits 10-11, 14, 18, 20, 28].

CHAR-BROIL:

- CHAR-BROIL grills advertised at *charbroil.ca* (2014–2018) and on the *.ca* websites of Home Depot (2010–2017), Lowes (2011), Walmart (2011–2017), Rona (2017), and Grilltown (2017, with a 2018 search revealing only what appear to be compatible generic parts and accessories) [Exhibits 10, 13, 15-16, 19-20, 23, 25-27].
- CHAR-BROIL grills advertised in Lowes’ 2017 and 2018 store brochures [Exhibit 22].
- CHAR-BROIL grills displayed for sale in-store in 2017 at Home Depot, Lowes, Walmart, and Rona [Exhibits 12, 17, 21, 24].

PERFECT BROIL:

- Black & Decker PERFECT BROIL toaster oven advertised at *amazon.ca* in 2017 with the notation “Currently unavailable[.] We don’t know when or if this item will be back in stock” [Exhibit 30].
- Two hits for a similar Black & Decker toaster oven but not mentioning the specific brand, produced along with other variously branded goods in a search for “perfect broil” on

Walmart’s website in 2017—in the absence of the toaster’s brand or information on the accuracy of the search function, this result is not relevant [Exhibit 15].

BROILKING (Hudson Standard):

- BROILKING countertop electric cooking appliances, such as convection ovens, griddles, portable ranges, and warming trays, advertised at *broilking.com* by a company called “Broil King” in 2000, 2011, 2015, and 2017, but with no indication that the website targets Canadian consumers or accepts orders from Canada [Exhibits 32-33]. I note that, at least from 2011, the site includes a disclaimer that Broil King is “NOT the gas grill/barbecue company”, while webpages from 1996 and 1999 show that the company has also operated under the name “Hudson Standard Corporation”. I will refer to this company as “Hudson Standard” for convenience.
- Hits for griddles, countertop burners, and grill accessories variously branded as BROILKING, BROIL KING and BROIL-KING, produced in a search for “broilking” on *amazon.ca* in 2017 [Exhibit 34]. Having compared the product images with the evidence before me depicting products under Hudson Standard’s and the Opponent’s respective trademarks, I find that the hits include both kitchen appliances branded by Hudson Standard and accessories for the Opponent’s brand of grills.

[144] Ms. Roberts’ evidence does not establish that any of the depicted goods have actually been sold in Canada or otherwise transferred in the normal course of trade or exported; as such, it does not demonstrate trademark use within the meaning of the Act [section 4]. Moreover, in the absence of information on the number of Canadians having accessed these websites or visited the stores, this advertising does not establish that the trademarks in question have been brought to the attention of Canadian consumers to any meaningful extent.

[145] At best, in light of Mr. Witzel’s familiarity with the BROILCHEF and CHAR-BROIL brands, and given that goods under these brands appear to have been offered for sale by multiple major retailers over the course of several years, I would be prepared to infer that there has been at least some use of these two BROIL-formative trademarks in Canada. However, it is important to remember that the resemblance between the parties’ trademarks in the present case goes beyond the shared word “BROIL” to include (i) a suffix connoting a high-ranking individual or leader and (ii) the resulting laudatory quality imparted to the trademark as a whole. Of the trademarks located by Ms. Roberts, only BROILCHEF refers to an individual who is arguably a leader in or holds the highest rank in broiling—to the extent that the word “CHEF” refers to a chief cook. CHAR-BROIL seems instead to denote a specific type of broiling—grilling over charcoal—without any particularly laudatory connotation. Although some of the other

trademarks on the register may have a laudatory connotation—such as PERFECT BROIL or MAXBROIL—they appear to denote, if anything, a type of broiling (“perfect”, “maximum”, “even” etc.) rather than evoking the idea of a person (like a “king” or a “master”).

[146] Thus, I find that, even if I were to accept the presence of both BROILCHEF and CHAR-BROIL in the Canadian marketplace, the evidence would still fall short of demonstrating that Canadian consumers of cooking appliances are accustomed to differentiating between trademarks that evoke the idea of the topmost individual in broiling. Accordingly, the state of the register and marketplace is not a significant surrounding circumstance in the present case.

*The Applicant’s get-up*

[147] In his affidavit, Mr. Belding underscores that the Applicant’s grills have “a bowtie burner not found in the grills of other companies” and “a rib pattern on the lid that sets the look of a BROILMASTER grill apart from other brands”, with the Mark being displayed on this lid [Belding paras 4-5]. However, when assessing the likelihood of confusion, it is the effect of the mark applied for *itself* that must be considered, not the effect of other indicia that may appear with it in actual use [*Reno-Dépôt Inc v Homer TLC Inc*, 2010 TMOB 11; *Groupe Fruits & Passion Inc*, 2007 CarswellNat 2319 (TMOB)]. Such contextual factors do not form part of the trademark the Applicant seeks to register and nothing would prevent the Applicant from altering the style of its burner or lid. Accordingly, this circumstance does not assist the Applicant.

*The Opponent’s family of trademarks*

[148] As noted above, the Opponent pleads that “three or more” of its trademarks represent a series of associated trademarks and that the Mark is confusing with this series.

[149] When multiple trademarks having common characteristics are registered and used by the same owner, this series is known as a “family”. Owning a family of trademarks increases the likelihood of consumers assuming that a new trademark having the same characteristic is simply another member of the family [*Everex Systems Inc v Everdata Computer Inc* (1992), 44 CPR (3d) 175 (FCTD)]. A party seeking to rely on a family of trademarks must establish that it is using more than one or two trademarks within the alleged family and such use must be sufficient to establish that consumers would recognize a family of marks [*Arterra Wines Canada, Inc v*

*Diageo North America Inc*, 2020 FC 508; *McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD)].

[150] In the present case, I am of the view that the BROIL KING Design trademark is simply a design version of the word mark. Its minor stylization does not add any elements to the alleged family; rather, use of BROIL KING Design supports use of the word mark [for a similar conclusion, see *Arterra Wines, supra*]. Further, as discussed above, I am not satisfied that the Opponent has established use of BROIL KING IMPERIAL, rather than use of IMPERIAL as a separate trademark. The alleged family would therefore consists of only BROIL KING and BROIL-MATE. However, as noted above, two trademarks is insufficient to constitute a family. Accordingly, the concept of a family of trademarks does not apply to the present case.

*Absence of actual confusion*

[151] The Applicant submits that the lack of evidence of actual confusion in the marketplace for over 20 years is confirmation that confusion is unlikely.

[152] An opponent is under no obligation to submit evidence of instances of actual confusion; the burden is on an applicant to demonstrate the absence of a likelihood of confusion. However, although it is not a determining factor, if the evidence shows extensive concurrent use of both trademarks in the same area over many years, then an adverse inference *may* be drawn from a lack of evidence of actual confusion, but only in cases where such evidence would readily be available if the allegation of a likelihood of confusion were justified [see *Mattel, supra*].

[153] In the present case, both parties adduced only limited evidence of use and there is no clear indication of the extent to which their trademarks have coexisted in the same markets. It is therefore not possible to draw any meaningful conclusion from the absence of actual confusion.

[154] The Applicant cites *Advance Magazine Publishers Inc v Victoria Vogue, Inc* (2001), 12 CPR (4th) 398 (TMOB), for the proposition that over twenty years of concurrent use render a lack of evidence of actual confusion relevant, even when an applicant's sales "have not been particularly significant" [*Advance Magazine* at para 16]. However, that case is distinguishable in that the opponent's trademark VOGUE was well known in Canada and the applicant's sales were considerably larger than in the present case.

[155] In the circumstances of the present case, this circumstance does not assist the Applicant.

*No suit for infringement*

[156] Finally, the Applicant invokes the doctrines of laches and acquiescence and submits that the Opponent's failure to sue for infringement suggests it is not truly concerned about a likelihood of confusion. The Opponent responds that the Applicant's limited sales in Canada, which are only of replacement parts, do not warrant the cost of an infringement action.

[157] I am not prepared to speculate regarding the Opponent's motives in respect of a potential infringement question and it would be inappropriate to require the Opponent to explain its litigation strategy in this regard.

[158] Furthermore, even if the equitable doctrines of laches and acquiescence were to apply to opposition proceedings, the Opponent did not delay in opposing the Application: its statement of opposition was filed within the standard benchmark extension of time available from the statutory deadline. Moreover, there is no evidence that the Opponent's conduct encouraged the Applicant to believe a further attempt to register the Mark would not be opposed. Since registration would provide the Applicant with greater rights in the Mark than would be acquired through use alone, the Opponent's inaction with respect to the use made of the Mark so far does not mean tacit agreement to the Mark's registration or a belief that confusion would be unlikely.

[159] Consequently, I do not consider the lack of an infringement action to be a relevant surrounding circumstance.

Conclusion with respect to confusion

[160] As noted above, the onus is not on the Opponent to show that confusion is likely but rather on the Applicant to satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion.

[161] Having considered all the surrounding circumstances, I find that, at best for the Applicant, the probabilities are evenly balanced between a finding of confusion with the trademark BROIL KING and a finding of no confusion. I reach this conclusion owing primarily

to the fairly high degree of resemblance between the parties' trademarks, particularly when considered as a matter of first impression and imperfect recollection, and the considerable overlap in the nature of the goods and trades. I do not find the likelihood of confusion to be significantly decreased by the BROIL KING trademark's low degree of inherent distinctiveness or the absence of evidence of use benefitting the Opponent after January 1, 2001. In this respect, I have also borne in mind that use of the Mark over the years appears to have been fairly limited and the extent to which Canadians have been exposed to its promotion has not been established.

[162] In view of all the foregoing, I find that the Applicant has not met its legal onus to show, on a balance of probabilities, that there is no reasonable likelihood of confusion. The ground of opposition based on registrability of the Mark under section 12(1)(d) of the Act is therefore successful.

#### **Entitlement to registration over previously used trademarks under section 16(1)(a)**

[163] Under this ground, the Opponent essentially pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16 of the Act because, at all material times, the Mark was confusing with any or all of the Opponent's Trademarks, which had been previously used, made known, applied for, and registered in Canada by the Opponent and/or its predecessors in title, as further described in the statement of opposition, and which the Opponent had not abandoned as of the date of advertisement of the Application.

[164] Although the Applicant pleads in its counter statement that the reference to the Opponent's Trademark's having been "previously used, made known, applied for, and registered" is vague and does not provide sufficient particulars to enable the Applicant to respond, I find that this reference is sufficiently defined by the Opponent's specification that the use, making known, application for, and registration is as described in the statement of opposition. Paragraph 3 of the statement of opposition sets out the statement of goods and claimed date of first use for each of the Opponent's registrations. Accordingly, it is clear that this pleading amounts to a ground of opposition under section 16(1)(a) of the Act, based on prior use of each of the Opponent's Trademarks in association with the goods and since the date of first use claimed in the corresponding registration.

[165] Making known is not described in the statement of opposition and as such is not a basis for this ground. Furthermore, paragraph 3 of the statement of opposition sets out the registration dates for each of the Opponent's Trademarks, showing that none were pending when the Application was advertised. There is thus no basis for a ground of opposition under section 16(1)(b) of the Act based on prior application [section 16(4)].

[166] To meet its initial burden, the Opponent must demonstrate that the trademark on which it relies was used prior to the Mark's first use, in accordance with section 16(1)(a) of the Act, and had not been abandoned when the Application was advertised, as stipulated in section 16(5). Abandonment requires both an absence of use and an intention to abandon use [*Labatt Brewing Co v Formosa Spring Brewery Ltd* (1992), 42 CPR (3d) 481 (FCTD); *Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)]. The use on which the Opponent relies must be its own use or that of a predecessor in title, per section 17(1) of the Act.

#### BROIL KING Trademarks

[167] Section 16 of the Act does not impose any requirements concerning the length or extent of use of an opponent's trademark; so long as it functions as a trademark, a single instance of use within the meaning of section 4 of the Act may suffice for an opponent to meet its burden [*JC Penney Co v Gaberdine Clothing Co*, 2001 FCT 1333].

[168] As discussed under the registrability ground, I am prepared to accept that the Opponent sold barbecues displaying the BROIL KING trademark in 1989. I am also prepared to accept, from the fact that the Opponent has been incurring marketing expenses for the BROIL KING trademark, and at least licensing its use, from 2001 to the date of Mr. Witzel's affidavit, that the Opponent did not intend to abandon this trademark when the Application was advertised. I am therefore satisfied that the Opponent has met its initial burden with respect to BROIL KING. Again, I am of the opinion that neither of the other two BROIL KING Trademarks presents a stronger case and I will accordingly focus my analysis on the BROIL KING word mark.

[169] The Opponent having met its initial burden, the onus is on the Applicant to satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion.

[170] I find that the Applicant's case is no stronger at the date of its first use of the Mark, whether that is taken to be in 2001, according to the date claimed in the Application, or 2003, based on the earliest invoices. The Mark would have been promoted for a lesser time in the early 2000s and there is no indication that it would have otherwise been better known at that time than today. Moreover, to the extent that BROIL KING had become known as the Opponent's trademark by January 1, 2001, the period during which Onward Manufacturing may have become known as a source of BROIL KING goods would have been shorter.

[171] I am also mindful of the Applicant's submission that the trademark BROIL KING is particularly suggestive of royalty in view of the Opponent also owning the trademarks BROIL KING IMPERIAL and BROIL QUEEN and using various sub-brands suggestive of royalty. Since the non-entitlement ground of opposition is based on the Opponent's actual use of the BROIL KING trademark, the manner and context in which this trademark is used would be relevant. However, although Mr. Witzel claims use of BROIL KING IMPERIAL since at least as early as 1999, he provides only an estimate of sales starting from 2006 and no other evidence of use of this trademark at the material date. At best, some of the dealer price list and catalogue covers predating the material date display BROIL KING together with the sub-brand SOVEREIGN. However, the definitions of the word SOVEREIGN in the *Canadian Oxford* indicate that the term also has similar connotations to KING; in this respect, I note the following:

Sovereign:

**1** the recognized supreme ruler of a people or country under monarchical government ....

**2** a person or body of people that has supremacy or authority over another or others.

**1a** (of a thing, quality, power etc.) supreme, greatest.

**2a** (of a person) having superior or supreme rank or power; esp. holding the position of a ruler or monarch.

**4** excellent; effective (*a sovereign remedy*).

[172] Consequently, in my view, although displaying the trademark BROIL KING together with the word SOVEREIGN would emphasize the idea of royal stature, it would not detract from the idea behind the metaphor, being that of a leading grill for broiling, greatest in its class.



[173] Accordingly, for reasons similar to those expressed in relation to the section 12(1)(d) ground of opposition based on registrability, the section 16(1)(a) ground of opposition based on non-entitlement to registration over the Opponent's trademark BROIL KING is successful.

### BROIL-MATE

[174] I reach a different conclusion for the Opponent's trademark BROIL-MATE.

[175] In this case, Mr. Witzel asserts continuous use of the trademark in association with gas barbecues in Canada since at least as early as August 1985 "by or on behalf of the Opponent and its predecessor in title", which would be B.D. Wait Co. Limited (B.D. Wait), from whom the Opponent purchased BROIL-MATE "on or about January 29, 1990" [para 5]. I note from the trademark's registration particulars that B.D. Wait had amalgamated into Anova Inc. on October 8, 1987 [Exhibit B]; however, since an amalgamation does not imply an assignment, I do not consider it to be of any consequence.

[176] In support of his assertion of use, Mr. Witzel provides two average annual sales figures: one for the period 1990–2005 and one for the period 2006–2017 [paras 10-11]. He also provides one average annual marketing expense figure: for 1990–2005. Instead of a marketing expense figure for 2006–2017, he states that "[d]uring the last several years" Home Depot has been the primary retailer in Canada, that "more than 4% of the dollar value of sales have been spent in each year on advertising and marketing of the BROIL-MATE brand across Canada", and that this brand is "advertised in newspapers and on the web" [para 10]. He does not specify whether such spending and advertising is by Home Depot or the Opponent.

[177] With respect to the examples of advertising and promotional materials attached to his affidavit, there is one example that I am prepared to infer predates the licence to Onward Manufacturing: it appears to be the cover and two inside pages of a brochure with the tag line "Just you *Wait*" [at Exhibit C, emphasis in original]. The advertisement is undated; however, "*Wait*" is emphasized with a different font and displayed at an angle, and the text of the brochure mentions grill features "with famous Wait design engineering". These references seem to indicate that the brochure originates from B.D. Wait, and thus pre-dates that company's amalgamation into Anova Inc. on October 8, 1987.

[178] However, owing to the quality of the photocopy, it is not possible to make out how the BROIL-MATE trademark is displayed on the barbecues depicted in this brochure. Moreover, Mr. Witzel does not specify whether the images of barbecues in the remaining advertising and marketing materials are representative of how BROIL-MATE was displayed on goods prior to the material date or whether any such materials were delivered together with the goods at the time of sale, to provide the notice of association required by section 4 of the Act. I would also note that Mr. Witzel does not provide any examples of packaging displaying this trademark.

[179] Accordingly, even if I were to accept from Mr. Witzel's sales figures that the Opponent had sales in 1990, the Opponent has not demonstrated how, at the material date, the BROIL-MATE trademark was displayed on the goods or on their packaging, or otherwise associated with the goods at the time of sale in the normal course of trade, in compliance with the requirements for use of a trademark set out in section 4 of the Act. Moreover, even if I had found the Opponent's initial burden to be met, I would have found that the Applicant meets the legal onus on it to demonstrate that there is no reasonable likelihood of confusion. In this respect, I note the following.

*Resemblance between the trademarks*

[180] The Opponent submits that BROIL-MATE and BROILMASTER are "exceeding similar" in sound and "substantially similar" in appearance, considering that the differences between MASTER and MATE are "only minor" and BROILMASTER differs from BROIL-MATE by only two letters added towards the end of the Mark [written argument at para 32]. With respect to the difference in ideas suggested, the Opponent cites *Menley & James Laboratories, Inc v Laboratoire Cogan-Produits Lydia Dainow SA* (1993), 51 CPR (3d) 558 (TMOB), where an application for ROSE MIST in association with cosmetic preparations was refused because the Registrar was left in a state of doubt as to whether it was confusing with the opponent's trademark ROSE MILK & Design, also registered in association with cosmetic preparations. The Registrar found that the trademarks resembled each other because their first words, albeit descriptive, were identical and their second words were aurally similar.

[181] Conversely, the Applicant submits that confusion is unlikely because BROIL-MATE suggests the idea of a "grilling buddy", which is different from the idea suggested by

BROILMASTER. In this respect, the Applicant submits there are numerous common words coupling “MATE” with another term—such as classmate, playmate, roommate, soulmate, and teammate—which are understood to have the meaning of being a “friend or companion” [citing *Canadian Oxford* definitions at Roberts No. 2, Exhibit 10]. At the hearing, the Applicant also took issue with the Opponent’s approach of parsing the trademarks to find letters in common.

[182] With respect to the Applicant’s last point, the fact remains that the trademarks have a similar pattern of letters overall, leading to a substantial degree of visual similarity between them, the hyphen in BROIL-MATE notwithstanding. However, in my view, the trademarks as a whole are different when sounded, owing to the aural difference between MATE and MASTER. In this respect, the present case is distinguishable from the decision in *Menley & James*.

[183] I also find the ideas suggested by each trademark to be different. Again, I consider the most striking aspect of the Mark to be the idea it conveys, namely that of being a “master” of broiling, in the sense of being the leading grill for broiling well. Similarly, I consider the most striking aspect of the trademark BROIL-MATE to be the idea it conveys, which in this case is that of being a “mate” for broiling. In this respect, I accept the Applicant’s interpretation of the word MATE as meaning a “friend” or “companion”. In my view, as a matter of immediate impression on the average consumer of grills, the metaphor BROIL-MATE evokes the idea of a user-friendly appliance to depend on for broiling.

[184] In sum, I find there to be a fair degree of resemblance between the trademarks in terms of appearance, but significant aural and conceptual differences. Overall, given the differences in the most striking aspect of each trademark, I find that this factor favours the Applicant.

*Inherent and acquired distinctiveness and length of use*

[185] Both parties’ trademarks have a similarly low degree of inherent distinctiveness. The first portion of each trademark describes the function of the goods and each of the trademarks considered in its totality has at least a slight laudatory connotation. Nevertheless, each mark being a metaphor gives it at minimum some degree of inherent distinctiveness.

[186] As for the extent to which the parties’ respective trademarks have become known in Canada, the Opponent submits that the totality of the evidence with respect to BROIL-MATE

weighs in its favour to a greater degree in the present case than in the *2010 Opposition*. In 2010, the Registrar was unwilling to find, in the absence of a breakdown of sales and advertising for BROIL-MATE, that this trademark had become known to a larger extent than BROILMASTER. The Opponent submits that it has provided such a breakdown in the present case as well as furnishing evidence of use, advertisement and sales.

[187] However, I would again note that, for the period after January 1, 2001, Mr. Witzel does not clearly distinguish between the Opponent's use and that of Onward Manufacturing; nor does he establish that Onward Manufacturing's use of the Opponent's Trademarks enures to the Opponent's benefit. As a result, I am unable to determine to what extent, if any, BROIL-MATE became known as a trademark of the Opponent after January 1, 2001. Furthermore, Mr. Witzel provides no information on the extent to which advertising and marketing materials bearing the BROIL-MATE trademark have been distributed in or accessed from Canada. In the absence of such information, and given Mr. Witzel's lack of precision in providing annual sales and marketing figures, it is impossible to determine to what extent BROIL-MATE became known in the hands of the Opponent before it was licensed to Onward Manufacturing.

[188] In the absence of information on the extent to which Canadians were exposed to the BROIL-MATE trademark, I am unable to find that BROIL-MATE had become known to more than a limited extent by the material date, whether it be in 2001 or 2003. Accordingly, although the combination of inherent and acquired distinctiveness favours the Opponent in this case, it does so only slightly.

[189] Similarly, although the length of time the trademarks have been in use favours the Opponent, it does so only slightly.

*Nature of the goods, businesses, and trades*

[190] Under this ground of opposition, it is the statement of goods as defined in the Application versus the goods for which the Opponent has shown actual use that governs the analysis. However, the goods sold under the BROIL-MATE trademark are similar to the goods sold in association with BROIL KING and the business and trade with respect to each of these trademarks are similar as well. The evidence indicates that BROIL-MATE barbecues are sold at

lower prices—for example, Mr. Witzel attaches to his affidavit dealer price lists from 2014–2015 listing effective retail prices from \$219 to \$529 [Exhibit C] and printouts from the website at *homedepot.ca* advertising such grills for \$118 to \$597 [Exhibit D]. Ms. Roberts attaches printouts to her affidavit archived from the same website in 2014, 2015 and 2017, advertising such grills for \$99 to \$449 [Roberts No. 1, Exhibits 20, 31]. However, for the reasons set out above under the registrability ground, I find that there is nevertheless considerable overlap in the nature of the goods, business and trades. Accordingly, this factor favours the Opponent.

*Surrounding circumstances*

[191] For reasons similar to those discussed above under the registrability ground of opposition, I consider the only significant surrounding circumstance to be the jurisprudence surrounding trademarks containing descriptive terms, which again favours the Applicant, albeit to a lesser extent (since I consider the trademark BROIL-MATE as a whole to have somewhat less of a laudatory connotation than BROIL KING).

*Conclusion with respect to confusion*

[192] For an applicant to meet its legal burden, the Registrar must be reasonably satisfied that, on a balance of probabilities, the registration sought is unlikely to create confusion; the Registrar need not be satisfied beyond doubt that confusion is unlikely [*Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29]. In the present case, I find that, on a balance of probabilities, the Mark is not likely to create confusion with the Opponent’s trademark BROIL-MATE. The differences between the trademarks are sufficient to avoid a likelihood of confusion, even as a matter of first impression and imperfect recollection, despite the overlap in the nature of the goods and trade. I reach this conclusion bearing in mind that the trademark BROIL-MATE has a relatively low degree of inherent distinctiveness and has not been shown to have acquired significant distinctiveness in the hands of the Opponent.

[193] For these reasons, the section 16(1)(a) ground of opposition based on non-entitlement to registration over the Opponent’s trademark BROIL-MATE is rejected.

## **Distinctiveness of the Mark under section 2**

[194] The Opponent also pleads that the Mark is not distinctive within the meaning of section 2 of the Act, because it does not distinguish and is not adapted to distinguish the Goods from the goods “of others, namely the Opponent’s” goods. Paragraph 1 of the statement of opposition specifies that references to “Opponent” throughout the statement of opposition constitute references to the “Opponent and/or any predecessors in title”.

[195] I note that the Opponent’s pleading does not refer broadly to distinguishing the Goods from the goods “of others”. Instead, the Opponent has restricted its pleading to distinguishing the Goods from the goods of the “Opponent and/or any predecessors in title”. Accordingly, in order to meet its initial burden, the Opponent must prove that the trademark use or reputation on which it relies enures to its own benefit or to that of a predecessor in title.

[196] Furthermore, the trademark on which an opponent relies must be sufficiently known in Canada to negate the distinctiveness of the applicant’s mark [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657]. In this respect, an opponent must show that, at the material date, its trademark was known in Canada to some extent, having a “substantial, significant or sufficient” reputation, or else that it was well known in a specific area of Canada—in either case, there must be clear evidence of the extent to which the trademark was known [*Bojangles, supra*; *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10]. The material date for this assessment is the date the statement of opposition was filed, which in the present case is September 15, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[197] As discussed above, the Opponent’s evidence does not show what proportion, if any, of the use made of its trademarks after January 1, 2001 was either its own use or use enuring to its benefit. The Opponent’s lack of precision in providing annual sales and marketing figures also makes it impossible to determine the extent to which any of its trademarks had become known before that date, and there is no indication as to whether any of them would remain known *as a trademark of the Opponent* up to the material date. I would also note that, although the Opponent submits its advertising expenditures are significant, some of the examples of advertising Mr. Witzel provides appear on their face to be directed to dealers rather than consumers, and he

does not specify what proportion of the advertising is directed to the general public. Indeed, Mr. Witzel provides no information on the extent to which any of the advertising and marketing materials referenced in his affidavit have been distributed in or accessed from Canada. One is left to speculate on this point, which the Federal Court has indicated should be resisted [*1648074 Ontario Inc v Akbar Brothers (Pvt) Ltd*, 2019 FC 1305 at para 53].

[198] As the Opponent has not met its initial burden, I reject the ground of opposition based on non-distinctiveness.

### **Satisfaction of entitlement to use the Mark in compliance with section 30(i)**

[199] The Opponent pleads that the Application does not comply with the requirements of section 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use or register the Mark in Canada in association with the Goods, as the Mark is confusing with the Opponent's Trademarks previously used, made known, applied for and registered in Canada. The Opponent further pleads that the Applicant was aware of the Opponent's Trademarks and knew the Mark was not registrable over them, from previous opposition proceedings wherein the Opponent successfully opposed an application for the Mark.

[200] Again, although the Applicant pleads in its counter statement that the reference to the Opponent's Trademarks having been "previously used, made known, applied for, and registered" is vague and does not provide sufficient particulars for a response, I find that this reference is sufficiently defined by the Opponent's specification that the use, making known, application for, and registration is as described in the statement of opposition. When the statement of opposition is read as a whole, it is clear that this pleading alleges confusion based on prior use of each of the Opponent's Trademarks in association with the goods, and since the date of first use, claimed in the corresponding registration set out at paragraph 3 of the statement of opposition.

[201] Section 30(i) of the Act merely requires that an applicant include a statement in its application that it is satisfied it is entitled to use the trademark in Canada in association with the goods or services described in the application. However, awareness of an allegedly confusing trademark does not in itself preclude an applicant from being satisfied of its own entitlement to use the mark it is applying to register. Even an applicant who is found not to be entitled to

registration may be entitled to use the mark without registration. Similarly, an applicant whose previous application for the same mark was successfully opposed may prevail in an opposition proceeding against its subsequent application, owing to changes in factual circumstances, the evidence presented, and the material dates.

[202] Accordingly, where, as here, the required statement is included in the application, an opponent may only rely on section 30(i) in specific cases, such as where bad faith or fraud is alleged [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. In the present case, I do not consider the Opponent's allegation that the Applicant plans to drain the Opponent's resources, exhaust its resolve, and/or extract valuable sales and marketing information to amount to evidence of bad faith. At best, the Opponent questions the Applicant's motives in repeatedly applying to register the same trademark, but section 30(i) concerns entitlement to use rather than entitlement to register.

[203] Consequently, the section 30(i) ground of opposition is dismissed, as the Opponent has failed to meet its evidential burden.

#### DISPOSITION

[204] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application pursuant to section 38(12) of the Act.

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Oksana Osadchuk  
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** 2020-10-27

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