



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 035

Date of Decision: 2022-02-28

IN THE MATTER OF AN OPPOSITION

Positec Group Limited

Opponent

And

Hong Kong Sun Rise Trading Limited

Applicant

1,785,936 for POWERWORKS

Application

INTRODUCTION

[1] Hong Kong Sun Rise Trading Limited (the Applicant) has applied for the trademark POWERWORKS (the Mark) based on proposed use in association with various power operated lawn and garden tools. Positec Group Limited (the Opponent) owns a family of WORX trademarks for overlapping or related goods. The Opponent opposes the registration of this Mark primarily on the basis of a likelihood of confusion between the Mark and at least one of the Opponent's WORX trademarks, almost all of which are either registered and/or used in association with similar goods.

[2] For the reasons that follow, this application is refused.

THE RECORD

[3] The application was filed on June 7, 2016, and was advertised on June 28, 2017, in association with the following goods:

Chain saws; electric hedge shears; lawn mowers; power operated blowers; power operated cultivators; power operated tools, namely, lawn and garden edgers; power-operated grass/weed trimmers; power-operated lawn and garden tillers; vacuum cleaners for outdoor use (the Goods)

[4] The Opponent filed its statement of opposition on November 20, 2017. The *Trademarks Act*, RSC 1985, c T-13, was amended on June 17, 2019. All references in this decision are to the Act, as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended [section 70 of the Act].

[5] The Opponent raises grounds of opposition based on registrability under section 12(1)(d), entitlement under sections 16(3)(a) and 16(3)(b), distinctiveness under section 2, and non-compliance with sections 30(e) and (i) of the Act. For the grounds of opposition based on an alleged likelihood of confusion, the Opponent relies on its WORX trademark applications and registrations, many of which have been previously used or made known in Canada.

[6] In support of its opposition, the Opponent filed the affidavits of Philip Fitzpatrick, the sole Director of the Opponent's subsidiary, Positec Canada Inc., and Christina Fradsham (dated December 14, 2017), Legal Assistant with the Opponent's agent.

[7] In support of its application, the Applicant filed the affidavits of Sean Cake, the Vice President of Greenworks Tools Canada Inc. and Helene Deslauriers, Trademark Analyst with CompuMark, a division of Clarivate Analytics.

[8] In reply, the Opponent filed a second affidavit of Christine Fradsham, dated June 11, 2019.

[9] None of the affiants were cross-examined.

[10] Both parties filed written submissions but only the Applicant was represented at a hearing.

ANALYSIS

Section 30(e) and section 30(i) Grounds of Opposition

[11] Under its section 30(e) ground, the Opponent pleads that the application does not conform to the requirements of section 30(e) of the Act in that the Applicant could not have intended to use the Mark in Canada as of the filing date of the application.

[12] Under its section 30(i) ground, the Opponent pleads that the application does not conform to the requirements of section 30(i) of the Act because, at the filing date of the application, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the applied-for Goods.

[13] The evidential burden on the Opponent in respect of a section 30(e) ground is to show that the Applicant did not have a *bona fide* intention to use the Mark in Canada with any or all of the Goods. Under section 30(i), the Opponent's burden is to show evidence that the Applicant acted in bad faith in filing its application [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[14] The Opponent relies on the same facts in support of both grounds. In this regard, the Opponent pleads that the Applicant could not have intended to use the Mark because the Applicant was well aware of both the Opponent's prior sales and pre-existing reputation in the trademarks WORX and/or WORX Logo in conjunction with power tools and power operated gardening tools. This is so, because the Applicant (or the Applicant's corporate affiliate in China) had a previous contractual relationship with the Opponent (and/or the Opponent's corporate affiliate in China). Specifically, the Applicant (or the Applicant's China affiliate), engaged as a contractor, manufacturer or supplier to the Opponent (and/or the Opponent's China affiliate) for the supply of power operated gardening tools. Consequently, the Opponent alleges that the Applicant was aware at all times that its Mark was not distinctive, and that its adoption was likely to cause confusion with the Opponent's WORX trademark and/or WORK Logo.

[15] The Opponent's pleading additionally alleges that the Applicant had adopted a deliberate practice of selling power operated tools and/or power operated gardening tools in conjunction

with a number of different trademarks which are similar phonetically or in the idea conveyed as trademarks used by the Opponent in association with similar goods.

[16] While the evidence of Mr. Fitzpatrick confirms that a company by the name of Changzhou Globe Co. Ltd. served as a supplier for the Opponent in China, and was also affiliated with the Applicant, this evidence by itself is not sufficient to meet the Opponent's burden under section 30(e) or section 30(i). In this regard, the Opponent's evidence does not explain how the relationship between the Applicant and the Opponent's supplier showed that the Applicant did not have a *bona fide* intention to use the Mark in Canada with all of the Goods as of the filing date of the application. Further, mere awareness of prior rights alleged by an opponent, does not preclude an applicant from truthfully making the statement required by section 30(i) of the Act [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197].

[17] Therefore, as the Opponent did not meet its evidential burden under either of these grounds, both of these grounds are rejected.

Section 12(1)(d) Ground of Opposition

[18] The Opponent pleads that the Mark is not registrable in view of the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's WORX Design trademarks, which are the subject of registration Nos. TMA727,239, TMA735,908, TMA780,142, TMA900,383 and TMA940,953, the particulars of which are set out in the attached Schedule A to this decision.

[19] With respect to a section 12(1)(d) ground of opposition, an opponent's initial evidential burden is met if a registration relied upon in the statement of opposition is in good standing as of the date of the decision. The Registrar has discretion to check the register in order to confirm the existence of a registration relied upon by an opponent [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB) (*Quaker Oats*)]. In this case, I have exercised that discretion and I confirm that the Opponent's registrations are all in good standing. I note that the Opponent also filed the registration particulars of these registrations as part of the evidence of Ms. Fradsham. The Opponent has therefore met its initial evidential burden in respect of this ground. Accordingly, I must

determine whether the Applicant has met the legal onus upon it to establish that there is no likelihood of confusion between the parties' trademarks.

[20] In considering the issue of confusion, I will focus on the Opponent's trademark WORX Design, registration No. TMA735,908, shown below, as I consider this trademark to represent the Opponent's best chance of success in view of its associated registered goods (see Schedule A attached to this decision). If the Mark is not confusing with this trademark, it will not be confusing with any of the remaining trademarks relied upon by the Opponent.



Test to Determine Confusion

[21] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them. The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54 (*Mattel*)]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

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

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trademarks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

Inherent distinctiveness and extent to which the trademarks have become known

[23] In his affidavit, Mr. Cake explains how the meanings of the word WORKS and its phonetic equivalent WORX are highly desirable from a marketing perspective in association with tools and yard implements:

“It is my belief that the word WORKS and its variants and phonetic equivalents (such as WORX) are widely used in association with tools as they carry the suggestion that the tools are effective at accomplishing certain tasks and/or function correctly. The word WORK in its very form, is defined in various dictionaries as meaning “(of a machine or system) operate or function, especially properly or effectively”. The Merriam Webster dictionary defines the verb WORK as, inter alia, “to function or operate according to plan or design” and as a noun as “activity in which one exerts strengths or faculties to do or perform something”.

[24] Based on the definitions provided by Mr. Cake, I consider the Opponent’s mark to be inherently weak because it suggests that the Opponent’s lawn and gardening tools and equipment are in good working order. As such, it is only entitled to a narrow ambit of protection.

[25] The Applicant’s Mark is one word comprised of two ordinary dictionary terms – the word “power” and the word “works”. The Mark is therefore not inherently strong either because it suggests that the Applicant’s power operated lawn and garden tools are in good working order.

[26] With respect to the extent to which the trademarks have become known, the evidence of Mr. Fitzpatrick can be summarized as follows:

- The Opponent is known in Canada for the manufacture and sale of power tools, lawn and garden equipment, sold in association with what Mr. Fitzpatrick refers to as “the Opponent’s WORX trademarks” (which includes all of the Opponent’s trademarks as set out in schedule A to this decision) [paras 8-9];

- Since July 2006, the Opponent has sold power operated tools and equipment such as lawn mowers, trimmers, blower/vacuums accessories therefore and power sprayers in association with its WORX trademarks [para 11];
- Since July 2006, sales in Canada of the Opponent's WORX lawn and gardening equipment have exceeded \$67.5 million through 2016, and were projected to exceed \$85.8 million through 2017 [para 15];
- Annual sales of WORX power equipment, such as grass trimmers, pressure sprayers, hedge trimmers, sweepers, work carts, chain saws and power drills sold in Canada have ranged from \$2,330,156 (2007) to \$13,713,977 (2016) [para 15];
- The Opponent's WORX power equipment has always been sold in association with the trademark WORX either prominently marked on the goods themselves and/or prominently marked on the packaging for the goods [para 16; Exhibit B];
- The Opponent has spent over \$188.6 million on television and marketing advertising for its WORX branded lawn and garden equipment in North America since 2007 [paras 23];
- The Opponent's WORX branded lawn and garden equipment is promoted at trade shows in Canada and the United States [para 24; Exhibit H];
- The Opponent's WORX branded lawn and garden equipment have been advertised and/or featured in various Canadian magazines including House and Home, Canadian Living, etc. [para 25; Exhibit I]; and
- From 2006 to 2017, non-television advertising and promotional expenditures in North America for the Opponent's WORX power equipment has exceeded approximately \$14.5 million; it is expected that these expenses for Canada would account for at least 10-15% of the North American total [para 26].

[27] Although a breakdown of sales for each of the Opponent's trademarks was not provided, in view that the Opponent's mark is displayed on most of the goods shown, as well as in the advertisements provided, I am prepared to infer from the significant amount of total sales that the Opponent's WORX Design trademark has become known to a considerable extent in Canada.

[28] The Applicant's Mark, on the other hand, is based on proposed use and the Applicant has not filed any evidence of use or making known of its Mark.

[29] Accordingly, I find that the Opponent's trademarks have become more well-known in Canada than the Mark.

Nature of the parties' goods, services or business and trades

[30] It is the Applicant's statement of goods as defined in its application versus the Opponent's registered goods that governs my determination of these factors [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe Inc v Bohna*, 1994 CanLII 3534, 58 CPR (3d) 381 (FCA)].

[31] Several of the applied for power operated lawn and garden tools are either identical to or related to the Opponent's goods. Further, as the nature of the parties' goods is the same, in the absence of evidence to the contrary, I find that the parties' channels of trade would also overlap.

Degree of resemblance

[32] As stated earlier, the degree of resemblance between the trademarks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side-by-side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, *supra*, at para 20].

[33] In *Masterpiece (supra)*, at para 64, the Supreme Court advises that the preferable approach when comparing trademarks is to begin by determining whether there is an aspect of the trademarks that is particularly striking or unique.

[34] In the present case, the Mark consists of the words POWER and WORKS, neither of which is more striking or unique than the other. The Opponent's trademark consists of the word WORX in a stylized design partially surrounded by a rectangular border. In view of the foregoing, I consider it appropriate in the present case, to focus on the parties' trademarks as a whole, while still bearing in mind the principle that the first word or syllable of a trademark is often the most important, for the purpose of distinguishing [*Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[35] Although the Applicant has adopted the phonetic equivalent of the Opponent's mark as the second component of its mark, the word POWER appears in the dominant first position of the Mark. I therefore find that, overall, the parties' marks have some degree of resemblance in appearance, sound and idea suggested.

Surrounding circumstance: state of the register and state of the marketplace

[36] The Applicant has filed state of the register evidence through the affidavit of Helene Deslauriers and state of the marketplace evidence through the affidavit of Sean Cake.

[37] State of the register evidence favours an applicant when it can be shown that the presence of a common element in trademarks would cause consumers to pay more attention to the other features of the trademarks, and to distinguish between them by those other features [*McDowell v Laverana GmbH Co KG*, 2017 FC 327 at para 42]. Inferences regarding the state of the marketplace may be drawn from such evidence in two situations: a large number of relevant registrations are located; or if there is not a sufficient number of relevant registrations then also evidence of common use in the marketplace of relevant trademarks [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA); *McDowell v Laverana*, *supra*, at paras 41-46; and *Cie Gervais Danone v Astro Dairy Products Ltd*, 1999 CanLII 7656 (FC)]. Relevant trademarks include those that (i) are registered; (ii) are for similar goods and services as the trademarks at issue, and (iii) include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197; *Allergan Inc v Lancôme Parfums Beauté Cie, société en nom collectif* (2007), 64 CPR (4th) 147 (TMOB) at 169].

[38] Ms. Deslauriers conducted a search for the terms WORKS or WORX, limited to active registrations, in Nice classes 7 and 8, with an emphasis on yard and garden maintenance tools and appliances. Ms. Deslauriers located 47 trademark applications and registrations.

[39] I note that eight of the trademarks located belong to the Opponent, and nine others belong to the Applicant. Further, several of the results of Ms. Deslaurier's search, including application Nos. 903,210, 1,793,165, 1,888,033, 1,872,363, 1,872,356, 1,872,367, 1,872,369, and 1,831,683, are for applications which are not based on use.

[40] At the oral hearing, the Applicant's agent argued that many of the applications relied upon were relevant because they have since matured to registration. The Applicant submits that since it has submitted these applications into evidence, it is reasonable for the Registrar to now exercise its discretion to confirm the status of these applications.

[41] I respectfully disagree with the Applicant on this point. The law is clear that, when adjudicating in an opposition proceeding, the Registrar does not exercise discretion to take cognizance of his own records except to verify whether claimed trademark registrations and applications are in good standing [see *Quaker Oats, supra* at 411].

[42] That being said, based upon my review of Ms. Deslaurier's search results, we are still left with at least 20 relevant trademarks. The Applicant's evidence further shows that some of the WORKS or WORX trademarks found in the state of the register search were in fact in use in the Canadian marketplace.

[43] In this regard, the Applicant's affiant Sean Cake provides uncontested evidence of WORKS and WORX trademarks in the marketplace in association with hedge trimmers. Attached as Exhibit A to his affidavit are photographs taken at a Canadian Tire Store located in Keswick, Ontario, on May 2, 2017, where three differently branded lawn and hedge trimmers [WORX (corresponding to the Opponent's application No. 1690631), GREENWORKS (corresponding to the Applicant's registration No. TMA848508) and YARDWORKS, (corresponding to Canadian Tire Corporation, Limited's registration No. TMA997503)] are found side-by-side in an aisle. He further states that, based on his own knowledge of the Canadian marketplace in the area of yard maintenance tools and implements, the YARDWORKS, GREENWORKS and WORX trademarks discussed above have been peacefully co-existing in the Canadian marketplace for at least seven years.

[44] In view of the number of relevant registrations located by Ms. Deslauriers, as well as the evidence of at least one third party WORKS trademark being in use in the marketplace in addition to two of the parties' trademarks, I find that I can infer that Canadian consumers are accustomed to seeing trademarks consisting of or containing WORKS or WORX in the power operated lawn and garden tools area such that they are able to distinguish them to some extent. This factor therefore favours the Applicant.

Surrounding circumstance: family of marks

[45] In its statement of opposition, the Opponent relies on its family of trademarks. I consider it important to point out here that with the exception of the word mark WORX (application

No. 1,913,908) and the Opponent's registration for WORKS Design, registration No. TMA727,239, the Opponent's six remaining WORX Design trademarks are virtually identical trademarks, but for their respective goods and services.

[46] In order to rely on a family of trademarks an opponent must prove use of each trademark of the alleged family [*McDonald's Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB)]. In addition, the presumption of the existence of a family is rebutted where there is evidence that the alleged family's common feature is registered or used by others [*Thomas J Lipton Inc v Fletcher's Fine Foods Ltd* (1992), 44 CPR (3d) 279 (TMOB) at 286-7].

[47] In this case, it is debatable whether the Opponent can even rely on a family of trademarks, as most, if not all of the Opponent's evidence shows use of the same registered WORX Design trademark, albeit with different goods and services. In any event, as mentioned above, there is evidence in this case of use of the phonetic equivalent to the Opponent's trademark, *i.e.*, the term WORKS, by at least one third party, as well as evidence of at least 20 registered trademarks with this feature. Therefore, even if the Opponent's evidence was sufficient to show use of a family of trademarks, I do not find that the use of the Opponent's family of trademarks would increase the likelihood of confusion that consumers would assume that POWERWORKS is simply another trademark of the Opponent [*McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD); *Air Miles International Trading BV v SeaMiles LLC* (2009), 76 CPR (4th) 369 (TMOB) at para 46].

Surrounding circumstance: jurisprudence concerning weak trademarks

[48] The jurisprudence on weak trademarks supports the Applicant's position. As noted by Rand J. in *General Motors Corp v Bellows*, 1949 CanLII 47 (SCC), 10 CPR 101 at pp. 115-6 (SCC), a weak trademark (*i.e.*, a mark of low inherent distinctiveness) is not entitled to a wide ambit of protection:

. . . where a party has reached inside the common trade vocabulary for a word mark and seeks to prevent competitors from doing the same thing, the range of protection to be given him should be more limited than in the case of an invented or unique or non-descriptive word . . . In *Office Cleaning Services*, 63 RPC at p. 43, Lord Simonds used this language: "It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But

that risk must be run unless the first user is allowed unfairly to monopolize the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.” (emphasis added)

[49] Further, as noted in *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR(2d) 154 at 169 (FCTD), “. . . there is ample judicial authority for the proposition that in the case of ‘weak’ marks, small differences may be accepted to distinguish one from the other and a greater degree of discrimination may be fairly expected of the public.”

[50] Finally, a party adopting a weak trademark has been held to accept some risk of confusion [*General Motors v Bellows*, 1949 CanLII 47 (SCC), 10 CPR 101 at 115-116 (SCC)].

Conclusion

[51] Section 6(2) of the Act is not concerned with confusion between the trademarks themselves, but rather confusion as to the source of the goods. Further, as the Supreme Court of Canada explains in *Mattel, supra*, at para 57, the ordinary consumer is owed a certain amount of credit:

... I fully agree with Linden J.A. in *Pink Panther* that in assessing the likelihood of confusion in the marketplace “we owe the average consumer a certain amount of credit” (para. 54). A similar idea was expressed in *Michelin Cie v. Astro Tire Rubber Co. of Canada Ltd.* (1982), 69 CPR (2d) 260 (FCTD), at 263:

. . . one must not proceed on the assumption that the prospective customers or members of the public generally are completely devoid of intelligence or of normal powers of recollection or are totally unaware or uninformed as to what goes on around them.

[52] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, despite the acquired distinctiveness of the Opponent’s WORX Design trademark, the length of time the Opponent’s trademark has been in use and the similarity between the nature of the goods and trade, I find the inherent weakness of the Opponent’s mark, the state of the register and marketplace evidence (which effectively dilutes the scope of protection to which the Opponent’s trademark is entitled in that particular field), as well as the overall differences between the parties’ trademarks, sufficient to shift the balance of probabilities regarding confusion in favour of the Applicant. I

am of the view that the ordinary consumer would not, as a matter of first impression, be likely to think that the power operated lawn and garden tools associated with the Mark would emanate from the same source as those associated with the WORX Design trademark or vice versa. Consequently, I find that there is no reasonable likelihood of confusion between the parties' trademarks.

Section 16(3) and Section 2 Grounds of Opposition

[53] With respect to the ground of opposition based on section 16(3) of the Act, the material date is the applicant's filing date (June 7, 2016). The material date for assessing the non-distinctiveness ground is the date of opposition (November 20, 2017).

[54] The Opponent's section 16(3)(a) ground of opposition relies on the previous use of the Opponent's WORX Design registration Nos. TMA727,239, and TMA780,142, as also shown in the attached Schedule A. The Opponent also relies on use of a WORX Design logo where the word WORX appears in bold in a similar rectangular design as in most of its other WORX Design trademarks, except the space before the letter W and after the letter X is shaded. The material date for this ground is the filing date of the application.

[55] The Opponent's section 2 ground of opposition relies on the Opponent's use of all of the WORX and WORX Design trademarks set out in Schedule A to this decision. The material date for this ground is the date of filing the statement of opposition.

[56] In order to meet its initial burden with respect to its section 16(3)(a) ground of opposition, the Opponent must show that it had used at least one of its relied upon marks prior to the material date. The Opponent must also show that it had not abandoned this trademark as of June 28, 2017, (section 16(5) of the Act). In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent must show that as of November 20, 2017, at least one of its relied upon trademarks was known to some extent at least and its reputation in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd*, 1981 CanLII 2834 (FC), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC)].

[57] The evidence of use of the WORX Design trademark discussed above with respect to the section 12(1)(d) ground of opposition is sufficient to meet the Opponent's burdens under the section 16(3)(a) and section 2 grounds of opposition.

[58] The Applicant's position is clearly less strong under both of these grounds than under the section 12(1)(d) ground. In this regard, I note that the evidence of state of the marketplace postdates the material date under this ground and so is of no avail to the Applicant [see *Servicemaster Co v 385229 Ontario Ltd*, 2014 FC 440 (affirming 2012 TMOB 59)].

[59] The question therefore becomes whether the differences between the marks at issue are sufficient to outweigh the countervailing factors. As stated in *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 at 149 (FCTD), "Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances."

[60] Having considered all of the surrounding circumstances, I arrive at the conclusion that the probabilities of confusion between POWERWORKS and the Opponent's WORX Design as of June 7, 2016, and November 20, 2017, are evenly balanced between a finding of confusion and of no confusion. I reach this conclusion because on the one hand WORX is not the type of mark that is typically accorded a broad scope of protection and the Applicant's Mark has a different beginning than the Opponent's mark. On the other hand though, only the Opponent had acquired a reputation in association with its mark as of June 7, 2016 and November 20, 2017, and the parties would be competitors. Further, the state of the register search undertaken by Ms. Deslauriers was conducted on May 16, 2019, which was subsequent to the material dates for both of these grounds. As the legal burden is on the Applicant to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's trademark, the section 16(3)(a) and section 2 grounds succeed.

Section 16(3)(b) Ground of Opposition

[61] The Opponent alleges that the Applicant is not the person entitled to registration pursuant to section 16(3)(b) of the Act, because the Mark is confusing with the previously filed applications for the Opponent's trademarks set out in Schedule A to the statement of opposition.

[62] To meet its initial evidential burden with respect to its section 16(3)(b) ground of opposition, the Opponent must show that it had applied-for at least one of its trademarks prior to the material date. Any applications filed before June 7, 2016, must also have been pending as of the advertisement of the application on June 28, 2017 [section 16(4) of the Act].

[63] The Opponent only meets its evidential burden under this ground with respect to the following trademarks: WORX Design, application No. 1,690,631, WORX Design, application No. 1,773,883 and WORX, application No. 1,729,742. As the remaining trademarks relied upon under this ground were registered prior to the advertisement date, the Opponent fails to meet its evidential burden [*Governor and Co of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co v Kmart Canada Ltd* (1997), 76 CPR (3d) 526 (TMOB) at 528]. This ground of opposition is therefore rejected with respect to these trademarks.

[64] The trademarks for which the Opponent has met its burden are virtually identical to the trademark relied upon by the Opponent under the section 12(1)(d) ground, except they were applied for in association with additional or different goods or services that are still related to the lawn and garden industry.







[65] The Opponent's position with respect to the other trademarks for which it has met its burden under this ground, however, is basically the same as it was under the section 16(3)(a) and section 2 grounds. Therefore, as of June 7, 2016, the probabilities of confusion between POWERWORKS and the Opponent's WORX Design applications are evenly balanced between a finding of confusion and of no confusion. As the legal burden is on the Applicant to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's trademark, and the Applicant has not done this, the section 16(3)(b) ground of opposition also succeeds.


DISPOSITION

[66] In view of the foregoing, and 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.

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A - THE OPPONENT'S WORX TRADEMARKS

Trademark	Application/ Registration No.	Goods/Services
	TMA727,239	1) Lawn mowers, grass trimmers, hedge trimmers; woodworking machines; saws (machines); electric hammers; mechanically operated hand-held tools, namely, electric screwdrivers.
	TMA735,908	(1) Lawn mowers, grass trimmers, hedge trimmers; woodworking machines; saws (machines); drilling machines; drill bits, saw blades; drills.
	TMA780,142	(1) Tool bags, tool boxes; battery chargers, battery packs.
	TMA900,383	Peeling machines, namely, planers and routers; engraving machines; electric hammers; electric machines and apparatus for polishing, namely, polishers; hand-held tools, other than hand-operated, namely, electric screwdrivers, electric grinders, electric shears, electric sanders, electric wrenches; electric machines and apparatus for cleaning, namely, high pressure cleaners; abrading instruments (hand instruments), namely, diamond cutting disks; hot air guns; high pressure washers; power tool accessories, namely, screwdriver bits, sand sheets; sanding discs, cutting discs; combined vice and workbench.
	TMA940,953	(1) Tool belts, tool handles. *this mark was applied for in association with many other goods and services
	1,690,631	(1) Power tools (2) Hand tools, gardening tools (3) Spray guns for paint; electric welding machines; electric machines and apparatus for cleaning, namely, snow plows, wax-polishing machines, namely, floor polishing machines, automobile polishing machines; vacuum cleaners;

		<p>electric shoe polishers; shredders (machines) for industrial use, namely, disintegrators and mills; emery paper, punches, namely, punching presses for metal work; hand-operated tools; hand-operated guns for the extrusion of adhesives, namely, caulking guns, glue guns, hot adhesive guns; hand operated lifting jacks; electric machines and apparatus for polishing, namely, polishing machines for use in grinding and polishing metal, wood, ceramics and plastics and floor polishing machines; hot air guns, hot glue guns, electric kitchen machines, namely, small electric kitchen appliances; air pumps for vehicles; air pumps for bicycles; rotary pumps; centrifugal pumps; screw pumps; blowers, namely, snow blowers, power blowers for lawn debris; electric generators; snow plows; power tool accessories, namely, router bits, grinding wheels, abrasive wheels, emery paper; carts for garden use, wheelbarrows for garden use</p>
	<p>1,773,883</p>	<p>Goods (1) Duplicating machines, telephones, television, camcorders, digital cameras, electric iron, optical scanners, electric dictionary, measuring apparatus, namely, tape measures, calipers, laser levels, telemeters, range finders, electric relays, facsimile machines, cameras (photography), video cameras, electric door openers, electric door closers, electroplating apparatus for electroplating, picture projectors, smoke detectors, spirit levels, commutators for motors, electric arc plasma cutters, electric door bells, films, namely, sensitized photographic film; unexposed camera film; unexposed photographic film; microphones; radios, remote controllers for radios; remote controllers for video equipment; remote controllers for televisions; semi-conductors; camera,</p>

	<p>optical lenses, tripods for cameras, photographic instruments, namely, motion picture cameras, digital cameras; photographic supplies, namely camera bags, camera lens brushes, camera filters, digital camera memory chips, picture mounts; photographic lenses, photographic cameras and parts therefore, cinematographic cameras and parts therefore, photographic printers, photo enlargers, printing frames; electric lights, refrigerators, air conditioners, clothes dryers, dishwashing machines, washing machines, water heaters, hair dryers, air dryers, electric coffee machines, electric egg boilers, coffee roasters, electric ranges, electric wall ovens, electric convection ovens, toasters, deep fryers, electric egg poachers, toaster ovens, hair driers, baby bottle sterilizers, sterilization units for medical instruments; water sterilizers, electric laundry dryers, microwave ovens; watches, watch bands, horological supplies namely dial, wind-crowns, clock movements and parts thereof, watch cases; wristwatches, rings, clocks and parts thereof, earrings; toys, namely, toy action figures, toy armor, toy bow and arrows, toy boxes, toy chests, toy figures, toy glides, toy guns, toy holsters, toy model kits, hobby kits comprising scrapbooks, bird houses, note books, journals, pens, pencils; hobby kits comprising paints, stencils; hobby kits comprising wood and fiber board, toy craft kits, toy modeling dough, toy pistols, toy putty, toy rockets, toy snow globes, toy stamps, toy vehicles, toy watches, toy weapons, bath toys, crib toys, ride-on toys, non-riding transportation toys, party favours in the nature of small toys, plush toys, stuffed toys, water squirting toys, windup toys; games, namely, video games, board games, computer game cartridges,</p>
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		<p>computer game cassettes, computer game discs, hand held units for playing electronic games; dolls, building blocks</p> <p>(2) Power tools</p> <p>(3) Hand tools; power operated gardening tools</p> <p>(4) Tool belts</p> <p>(5) Tool handles</p> <p>Services</p> <p>(1) Rental of power tools and gardening tools; maintenance and repair of power tools and gardening tools</p>
WORX	1,729,742	<p>(1) Multipurpose wheeled carriers in the nature of garden carts, wheelbarrows, trolleys, carts, hand trucks, and dollies, and accessories for the foregoing sold as a unit, namely, bag holders, cylinder holders, plant mover straps, and rock mover mesh;</p> <p>(2) Accessories for multipurpose wheeled carriers in the nature of garden carts, wheelbarrows, trolleys, carts, hand trucks, and dollies, namely, water bags, garden cart seats, wheelbarrow and garden cart tub organizers, conversion kits for converting a wheelbarrow to a hay wagon or garden cart, attachments for converting a wheelbarrow to a firewood carrier, attachments for converting a wheelbarrow to a wheeled snow plow; wheelbarrow and garden tub organizers in the nature of stick tool holders.</p>

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

HEARING DATE 2021-12-08

APPEARANCES

No one appearing

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