



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 045

Date of Decision: 2022-03-15

IN THE MATTER OF AN OPPOSITION

Premier Tech Home & Garden Inc.

Opponent

and

753146 Alberta Ltd.

Applicant

1,843,978 for KILL SHOT

Application

OVERVIEW

[1] Premier Tech Home & Garden Inc. (the Opponent) manufactures and sells consumer lawn and garden products. Among these products are indoor and outdoor pest control products, including insecticides, sold in association with the registered trademarks ONE SHOT (registration No. TMA854,886) and ONE SHOT and design (registration No. TMA851,286).

[2] The Opponent has opposed application No. 1,843,978 (the Application) filed by 753146 Alberta Ltd. (the Applicant) for the trademark KILL SHOT (the Mark). The Application is in association with a variety of goods and services including insecticides and other pest control products.

[3] For the reasons set out below, the Application is refused as the Applicant has not met its burden to demonstrate that there is no likelihood of confusion between the parties' trademarks.

THE RECORD

[4] The Application was filed on June 21, 2017 and is based on proposed use of the Mark in Canada in association with the following goods and services (the Goods and Services):

Goods


(1) Pesticides and insecticides for commercial and domestic use, namely, sprayers, applicators, and dispensers for insect and pest control; (2) Fungicides and herbicides for commercial and domestic use, namely, sprayers, applicators, and dispensers for fungus and weed control for flowering, edible, and combustible plants; (3) Virucides, germicides, and bactericides for commercial and domestic use, namely, sprayers, applicators, and dispensers for virus, germs, and bacteria control, namely, sanitizers for commercial and industrial uses, hand-sanitizing preparations, all purpose disinfectants for sanitary purposes; (4) Pest control agents and formulations, namely, chemical and non-chemical agents and formulations for insect and pest repellent for commercial and domestic use, namely, fly, wasp, and hornet traps, glue boards, fly swatters, ant nests, and sprayers, applicators, and dispensers for essential oil repellent.

Services

(1) Operation of a retail and wholesale sales business for commercial and domestic use products, namely, pesticides, insecticides, fungicides, herbicides, virucides, germicides, and bactericides products; (2) Direct marketing of the goods and services of others in the field of pesticides, insecticides, fungicides, herbicides, virucides, germicides, and bactericides for commercial and domestic use; (3) Online retail and wholesale store services featuring pesticides, insecticides, fungicides, herbicides, virucides, germicides, and bactericides for commercial and domestic use products; (4) Consultation services, namely, providing assistance and recommending pesticides, insecticides, fungicides, herbicides, virucides, germicides, and bactericides for commercial and domestic use products to customers.

[5] The Application was advertised for opposition purposes in the *Trademarks Journal* on February 27, 2019. On April 29, 2019, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[6] The Opponent raises grounds of opposition based on registrability under sections 12(1)(b) and 12(1)(d), entitlement under section 16(3)(a), distinctiveness under section 2, and non-compliance with section 30(e) of the Act. For the grounds of opposition based on an alleged likelihood of confusion, the Opponent relies on the following registered trademarks for which it is the registered owner:

Reg. No.	Trademark	Goods
TMA968,097	BUG SHOT	(1) Liquid preparations of essential oils, in a pressurized container, for use as an odor and pest repellent.
TMA908,157	SURE SHOT	(1) Liquid pesticide preparations in a pressurized container
TMA938,086	PLANTSHOTS	(1) Grass products namely, lawn seeds and grass seeds; Grass repair products namely, combination of lawn seeds and lawn and grass seeds for overseeding (2) Fertilizers, plant nutrients and lawn food; Mulch; Fertilizers mixed with lawn seeds, mulch and pesticides; Fertilizers mixed with lawn seeds, mulch and peat; Growing media namely, soil, planting soil, top soil, potting soil, garden soil, composted plant matters, soil mixes and peat moss
TMA854,886	ONE SHOT	(1) Insect control products namely, insecticides, aerosols, traps, ribbons and baits. (2) Herbicides and weed killer.
TMA851,286		(1) Insect control products namely, insecticides, aerosols, traps, ribbons and baits. (2) Herbicides and weed killer.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] The Opponent filed as its evidence the affidavit of Louis Carrier sworn October 18, 2019 (the Carrier Affidavit). Mr. Carrier is the President of the Opponent. He attests to the Opponent's use in Canada since 2008 of the trademarks ONE SHOT (TMA854,886) and ONE SHOT and design (TMA851,286). His evidence is discussed further below in the analysis of the grounds of opposition. Mr. Carrier was not cross-examined.

[9] The Applicant elected not to file any evidence.

[10] Both parties submitted written representations. No hearing was held.

ONUS

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) ground of opposition

[12] The material date for the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[13] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent's registered trademarks set out in the table above. I have exercised my discretion to check the Register and confirm that each of these registrations remain extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition. As a result, the Applicant bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and any of the Opponent's registered trademarks.

[14] In considering the issue of confusion, I will focus my analysis on the Opponent's registered word mark ONE SHOT (TMA854,886), as in my view that represents the Opponent's best case.

Test for confusion

[15] The test for confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or

not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods 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.

[16] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

[17] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the 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 marks [*Veuve Clicquot, supra*, at para 20].

The inherent distinctiveness of the trademarks and the extent to which they have become known

[18] I consider both parties' trademarks to have a modicum of inherent distinctiveness, but both are on the low end of the spectrum of inherent distinctiveness. In association with pest control products such as insecticides, both the Opponent's trademark ONE SHOT and the Applicant's Mark are suggestive of a product that is effective at disposing of the pest with only a single application.

[19] With respect to the extent to which the parties' trademarks have become known, this consideration clearly favours the Opponent. The Carrier Affidavit describes that the Opponent has used the trademarks ONE SHOT and ONE SHOT and design continuously in Canada in association with insect control products, namely, insecticides, aerosols, traps, ribbons and baits

since February 2008. Mr. Carrier also states that the Opponent has used the trademarks ONE SHOT and ONE SHOT and design in Canada in association with herbicides and weed killers since at least as early as July 2013. The Carrier Affidavit includes numerous examples of the use of these trademarks on the Opponent's products (including products designed to be used against spiders, ants, wasps and hornets) and advertising for such products. I note that I consider the evidence of use of the design mark ONE SHOT and design (TMA851,286) to also constitute use of the word mark ONE SHOT (TMA854,886) [see *Nightingale Interloc v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. The Opponent sells its products at large retail chains such as Walmart, Rona, The Home Depot Canada, Lowes, Canadian Tire and Home Hardware. From 2014 to 2019, the Opponent's sales of its ONE SHOT products exceeded \$4 million annually. Based on the evidence set out in the Carrier Affidavit, I am satisfied that the Opponent's trademark ONE SHOT is known to a reasonable extent in Canada.

[20] In contrast, there is no evidence of record that the Applicant has commenced use of the Mark or that the Mark is known to any extent in Canada.

[21] Taking into account both the inherent distinctiveness of the parties' trademarks and the extent they have become known, this factor favours the Opponent in view of the scope of use and advertising of the Opponent's trademark ONE SHOT in Canada over many years.

[22] As an aside, I note that at paragraph 46 of the Applicant's written representations, the Applicant argued that the Opponent's trademark should be afforded a limited ambit of protection by reason of "the adoption by third parties of a plurality of trademarks, trade name and corporate name [*sic*] involving the word 'SHOT'". However, the Applicant elected not to file any evidence in this proceeding and so there is no evidence of record to support that argument. Further, it is well established that the Registrar will not take judicial notice of the state of the Register in order to assist an applicant with such an argument [see *Molson Breweries v John Labatt Ltd* (1999), 3 CPR (4th) 543 (TMOB) at para 9].

The length of time the trademarks have been in use

[23] The Opponent's trademark ONE SHOT has been continuously used in Canada since 2008. The Application is based on proposed use of the Mark in Canada and the Applicant has not

filed any evidence to indicate that use of the Mark has commenced. This factor favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[24] There is direct overlap between the parties' goods and services and the likely channels of trade. Both parties' goods include insecticides and other pest control products, as well as herbicides. While the Opponent's registration covers only goods and not services, it is apparent that the Services in the Application relate to the sale and marketing of the overlapping goods.

[25] The Applicant has not filed any evidence to suggest that its Goods and Services, or the channels of trade in which they would be offered, are different from those of the Opponent.

[26] This factor also favours the Opponent.

Degree of resemblance

[27] In considering the degree of resemblance, it is preferable to determine whether there is an aspect of each trademark that is "particularly striking or unique" [*Masterpiece, supra*, at paragraph 64]. With both parties' trademarks, in my view, the striking element is the trademark as a whole (*i.e.* "ONE SHOT" or "KILL SHOT"), as it is apparent that each trademark is intended to be read as a unitary term. I do not consider any of the individual words comprising the trademarks to be more striking or unique than the others.

[28] With this in mind, there is a meaningful degree of resemblance between the parties' trademarks. While the first word of each trademark is different, leading to a somewhat different appearance and sound, the terms "ONE SHOT" and "KILL SHOT" in association with the relevant goods convey an essentially identical idea of a product that will eliminate a pest (or weed in the case of a herbicide) with a single application. Moreover, the Applicant's Mark conveys this idea by adopting the same grammatical structure as the Opponent's trademark.

[29] On balance, the degree of resemblance factor favours the Opponent.

Surrounding circumstance – alleged family of trademarks

[30] At paragraphs 55 to 57 of its written representations, the Opponent asserts that its position in this case is strengthened by a family of trademarks which include the word “SHOT”, as listed in paragraph 6 of this decision, above.

[31] However, in order to benefit from the wider scope of protection that may be afforded to a “family” of trademarks, an opponent must prove use of each of the trademarks in the family [see *McDonald’s Corp v Yogi Yogurt* (1982), 66 CPR (2d) 101 (FCTD)]. In this case, the Opponent’s evidence only demonstrates use of the trademark ONE SHOT (TMA854,886) and a design version of that trademark (TMA851,286). The Opponent has not demonstrated use of multiple trademarks each having the structure of a different single-syllable word followed by “SHOT”; in particular, the Opponent has not demonstrated use of any of the trademarks identified in paragraph 6, above, other than ONE SHOT and ONE SHOT and design. For this reason, the Opponent’s argument regarding a family of trademarks does not assist it in this case.

Conclusion regarding the Section 12(1)(d) ground

[32] Having considered all of the surrounding circumstances, I conclude that the Applicant has not satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties’ trademarks. I reach this conclusion considering that each of the statutory factors set out in sections 6(5)(a) through (e) of the Act favours the Opponent, including the resemblance between the parties’ trademarks, the degree of prior use of the Opponent’s trademark in Canada, and the overlap in the parties’ goods and services.

[33] Consequently, the section 12(1)(d) ground of opposition succeeds in respect of the Opponent’s registration TMA854,886 for the trademark ONE SHOT. In addition, in my view, the outcome of the confusion analysis is the same when considering the Opponent’s registration TMA851,286 for the trademark ONE SHOT and design, for essentially identical reasons to those set out above, and so the Opponent’s section 12(1)(d) ground of opposition succeeds based on that registration as well. Since the Opponent succeeds under section 12(1)(d) with respect to these two registrations, I will refrain from considering its other registrations.

Section 16(3)(a) ground of opposition

[34] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark because it is confusing with the Opponent's trademarks that have been previously used in Canada. The material date for this ground of opposition is the filing date of the Application, namely, June 21, 2017.

[35] I will focus my analysis on the Opponent's trademarks ONE SHOT and ONE SHOT and design, as these are the trademarks for which the Opponent has filed evidence of use. The Opponent has met its initial evidential burden for the section 16(3)(a) ground of opposition by way of its evidence demonstrating use of these two trademarks in Canada since 2008, well prior to the material date.

[36] In my view, the earlier material date for the non-entitlement ground of opposition does not alter the confusion analysis set out above for the section 12(1)(d) ground of opposition. Thus, the Applicant has not met its legal burden to demonstrate no likelihood of confusion as of the material date for the non-entitlement ground, and the section 16(3)(a) ground of opposition is also successful.

Remaining grounds of opposition

[37] As I have already found in the Opponent's favour in respect of the grounds of opposition under sections 12(1)(d) and 16(3)(a), I will address the remaining grounds of opposition only briefly.

[38] With respect to the distinctiveness ground of opposition based on section 2 of the Act, I am satisfied that the Opponent has met its initial evidential burden in view of the evidence of use and advertising of its trademarks ONE SHOT and ONE SHOT and design prior to the material date for this ground, namely, April 29, 2019 [see *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 at para 34 for a discussion of an opponent's initial evidential burden under section 2]. As this ground ultimately turns on the issue of confusion between the Mark and the Opponent's trademarks ONE SHOT and ONE SHOT and design, I come to the same conclusion as above for the section 12(1)(d) and

16(3)(a) grounds, notwithstanding the different material date for the section 2 ground. The section 2 ground of opposition therefore succeeds.

[39] With respect to the section 30(e) ground, as the Opponent filed no evidence in support of this ground, I would reject it.

[40] With respect to the section 12(1)(b) ground, I note that the Opponent's written representations do not provide submissions regarding this ground. As indicated in the confusion analysis above, I consider the Mark to have a modicum of inherent distinctiveness; while suggestive of the relevant goods, I would not consider the Mark to be clearly descriptive. Further, in the absence of any evidence or submissions from the Opponent regarding this ground, there is no basis to suggest that the Mark is deceptively misdescriptive. The section 12(1)(b) ground is rejected.

DISPOSITION

[41] 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.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No Hearing Held

AGENTS OF RECORD

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