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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 114

Date of Decision: 2022-06-08

IN THE MATTER OF AN OPPOSITION

Positec Group Limited	**Opponent**
and	
Hong Kong Sun Rise Trading Limited	**Applicant**
1,764,307 for GREENWORKS and Design	**Application**

INTRODUCTION

[1] Positec Group Limited (the Opponent) opposes registration of the trademark GREENWORKS and Design (the Mark), shown below, the subject of application No. 1,764,307 (the Application), that was filed by Hong Kong Sun Rise Trading Limited (the Applicant).

[2] The Application was filed on January 21, 2016, on the basis of use in Canada since at least as early as April 2012 in association with the following goods (the Goods):

> (1) Chain saws; electric hedge shears; lawn mowers; power blowers for lawn debris; power operated cultivators; power operated tools, namely, lawn and garden edgers; power-operated grass/weed trimmers; power-operated lawn/garden tillers; vacuum cleaners for outdoor use, all of the aforementioned goods being battery-operated and electric.

[3] The Application was advertised in the *Trademarks Journal* of October 25, 2017.

[4] The Opponent alleges that (i) the Application does not conform to the requirements of section 30(b) of the *Trademarks Act*, RSC 1985, c T-13 (the Act); (ii) the Application does not conform to the requirements of section 30(i) of the Act; (iii) the Mark is not registrable pursuant to section 12(1)(d) of the Act; (iv) the Applicant is not entitled to registration of the Mark pursuant to section 16(1)(a) of the Act; and (v) the Mark is not distinctive pursuant to section 2 of the Act. The last three grounds of opposition revolve around the likelihood of confusion between the Mark and the Opponent's trademarks, particulars of which are set out in Schedules B (section 12(1)(d) and section 2 grounds), C (section 16(1)(a) ground), and D (section 2 ground).

[5] As a preliminary matter, I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[6] For the reasons that follow, I reject the opposition.

THE RECORD

[7] The Opponent filed its statement of opposition on March 21, 2018. The Applicant filed and served its counter statement on May 28, 2018 denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Philip Fitzpatrick, sworn June 18, 2019 together with Exhibits A to N, and the affidavit of Christina Fradsham (Fradsham affidavit #1), sworn May 22, 2019, together with Exhibits A to PP.

[9] Mr. Fitzpatrick is the Sole Director of Positec Canada, Inc., a subsidiary of the Opponent. In his affidavit, he introduces evidence of use of the Opponent's relied upon trademarks in Canada. Ms. Fradsham is a Legal Assistant with the agent for the Opponent. In the Fradsham affidavit #1, she provides the results of a Canadian Trademark Database (CTMD) search she conducted for the Opponent's various relied upon trademarks, as well as the trademarks of both the Opponent and the Applicant listed in Schedule A to this decision. The Fradsham affidavit #1 further includes the results of a United States Patent and Trademark Office Electronic Search System (TESS) database, and of a United States Trademark Status & Document Retrieval (TSDR) database search for registration No. 4136239 (the Applicant's POWERWORKS trademark).

[10] In support of its Application, the Applicant filed the affidavit of Hélène Deslauriers, sworn October 11, 2019, and the affidavit of Sean Cake, sworn October 11, 2019 (Cake affidavit #1).

[11] Ms. Deslauriers is a Trademark Analyst contracted with the agent for the Applicant. She introduces state of the register evidence in her affidavit.

[12] Mr. Cake is the President of Greenworks Tools Canada, Inc., a division fully owned and controlled by the Applicant, which is a sales, marketing, and after sales service provider of the Applicant's manufactured outdoor power equipment and power tools for Canada. In this affidavit (affidavit #1), he introduces state of the marketplace evidence.

[13] The Opponent, in reply, filed a second affidavit of Ms. Fradsham, (Fradsham affidavit #2), sworn October 29, 2019, together with Exhibits A to D. The Fradsham affidavit #2

includes the same USPTO database search results as those which were included in the Fradsham affidavit #1.

[14] The Applicant requested and was granted leave to file the supplemental affidavit of Mr. Cake, sworn June 24, 2020 (Cake affidavit #2). The Cake affidavit #2 introduces concurrent use evidence and further state of the register evidence.

[15] None of the affiants were cross-examined on their affidavits.

[16] Both parties filed written representations, however, only the Applicant made representations at a hearing.

ANALYSIS

Section 30(b) Ground

[17] The Opponent pleads that the Application for the Mark does not comply with the requirements of section 30(b) of the Act in that the Application does not contain an accurate date from which the Applicant has used the Mark in Canada in association with the Goods. In particular, the Applicant has not used the Mark with the Goods since at least as early as April 2012, as alleged, or for that matter, the Applicant has not used the Mark in Canada with the Goods at all.

[18] Section 30(b) of the Act requires that there be continuous use of the applied-for trademark in the normal course of trade from the date claimed to the filing date of the application [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[19] While the legal burden is upon an applicant to show that its application complies with section 30 of the Act, there is an initial evidential burden on an opponent to establish the facts relied upon by it in support of its section 30 ground [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 at 329 (TMOB); and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)]. With respect to section 30(b) of the Act in particular, an opponent's initial burden has been characterized as light due to an opponent's limited access to information regarding use relative to the applicant. While an opponent can meet

its initial burden by reference to its own evidence, its burden can, in some cases, be met with reference to the applicant's evidence, in which case the opponent need only show that the applicant's evidence puts into issue the claims set forth in the applicant's application, on a balance of probabilities [*Corporativo de Marcas GJB, SA De CV v Bacardi & Company Ltd*, 2014 FC 323, and; *Molson Canada v Anheuser-Busch Inc* 2003, 29 CPR (4th) 315] .

[20] If an opponent succeeds in discharging its initial evidential burden, the applicant must then, in response, substantiate its claim of use during the material time. However, while an opponent is entitled to rely on the applicant's evidence, if any, to meet its evidential burden, the applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by an opponent meeting its evidential burden [see *Kingsley v Ironclad Games Corporation*, 2016 TMOB 19 at para 63].

[21] The Opponent has not made any submissions with respect to this ground of opposition in particular. Rather, it has simply submitted "it is believed that the Opponent has met its evidentiary burden with respect to its various grounds of opposition." Furthermore, with respect to its evidence, it has not filed any evidence that cast doubt on the veracity of the Applicant's claimed date of first use of the Mark in association with the Goods in Canada.

[22] Accordingly, the Opponent has failed to meet its burden under this ground of opposition; thus, this ground of opposition is dismissed.

Section 30(i) Ground

[23] The Opponent pleads that the Application does not conform to the requirements of section 30(i) of the Act, since the Applicant could not have been satisfied that it was entitled to use the Mark in Canada with the Goods. This being so, the Opponent pleads, since at least as of the filing date of the Application, and as of and prior to the alleged date of first use of the Mark in association with the Goods, the Applicant was aware of the prior use and registration of the Opponent's WORX and/or WORX Logo trademarks in Canada in conjunction with power tools and power operated gardening tools.

[24] In addition, the Opponent pleads that the Applicant could not have been satisfied that it was entitled to use or to a monopoly in the Mark with the Goods, since prior to the filing date of

the Application, and as of and prior to the alleged date of first use of the Mark in association with the Goods, the Applicant, or a corporate affiliate of the Applicant o/a Changzhou Globe Co., Ltd (f.k.a. Changzhou Globe Tools Co., Ltd.), in the same China Province as the Opponent, engaged as a contractor, manufacturer and/or supplier to the Opponent and/or a China affiliate of the Opponent for the supply of power operated gardening tools. The Opponent pleads that by reason of the previous contractual and/or commercial relationship between the Applicant and/or the Applicant's aforementioned China Affiliate and the Opponent and/or the affiliate corporation of the Opponent, 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 globally, as well as in Canada. As a result, the Opponent pleads that the Applicant was well aware at all times that the Mark was not distinctive, and that its adoption was likely to cause confusion with the trademark WORX and/or the WORK Logo owned by the Opponent. Further, the Opponent alleges that the Applicant has 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 to, or in the idea conveyed as trademarks used by the Opponent with similar goods [per those listed in Schedule A to this decision].

[25] In response, the Applicant simply submits that the Opponent has not met the evidential burden under this ground of opposition.

[26] With respect to the Opponent's position, it would appear from the statement of opposition and its written representations, that the Opponent is alleging that the Applicant has acted in bad faith. In this regard, the Opponent submits with respect to its burden under this ground of opposition, that "an opponent may face at least some burden to introduce some evidence suggesting the applicant may have acted in bad faith." [citing *Sapodilla Co v Bristol Myers Co* (1974), 15 CPR (2d) 152 (RTM); *Evonik Industries AG v Glaxo Group Ltd*, 2019 TMOB 49]. The Opponent submits that it has filed more than sufficient evidence to meet this burden. As such, the Opponent submits that the burden shifts to the Applicant to provide evidence showing that it could make the statement it was entitled to use the Mark in Canada [per *Levis v Golubev*, 2019 TMOB 100]. The Opponent submits that the Applicant has not provided any evidence to

meet its burden of showing that it could make the statement that it was entitled to use the Mark in Canada in compliance with section 30(i) of the Act.

[27] The facts and evidence in the case, with respect to the section 30(i) ground, are nearly identical to those in *Positec Group Limited and Hong Kong Sun Rise Trading Limited*, 2022 TMOB 35, regarding the trademark POWERWORKS [the POWERWORKS decision]. I agree with the conclusions reached in that decision regarding the section 30(i) ground as follows (at para 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(i).

[28] Further to this, there is no evidence that the Applicant contravened any such previous contractual and/or commercial relationship between the Applicant and/or the Applicant's aforementioned China Affiliate and the Opponent and/or the affiliate corporation of the Opponent.

[29] Lastly, I will add, that as was also held in the POWERWORKS decision, 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 *Woot Restaurants Inc*, 2012 TMOB 197].

[30] Therefore, as the Opponent has not met its evidential burden under this ground, the ground is rejected.

Confusion Grounds

Section 12(1)(d)

[31] The Opponent pleads that the Mark is not registrable in view of the provisions of section 12(1)(d) of the Act in that the Mark is confusing within the meaning of section 6(5) of the Act with the trademarks which have been previously registered by the Opponent as set forth in Schedule B attached thereto, both individually, and collectively as a trademark family.

[32] 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)].

[33] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the discretion to check the register in order to confirm the existence of any registrations relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised the Registrar's discretion, I confirm that the Opponent's registrations relied upon are in good standing as of the date of this decision.

[34] Since the Opponent has satisfied its initial evidential burden for this ground of opposition, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's alleged trademarks.

[35] For the reasons that follow, this ground of opposition is rejected.

[36] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[37] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time each has 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, including in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th)

321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

[38] In *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

> …the degree of resemblance, although the last factor listed in s.6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis … if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar… As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start…

[39] Under the circumstances of the present case, I consider it appropriate to analyze the degree of resemblance between the parties' marks first. Furthermore, I will focus on the Opponent's trademark WORX Design, registration No. TMA735,908 (the WORX Design Mark), 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.

Section 6(5)(e) – the degree of resemblance

[40] 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*].

[41] 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.

[42] In the present case, the Mark consists of the words "green" and "works" displayed in lower case, as one word, together within a darker hexagonal crest or background. The element

"green" appears in darker shading than the element "works". For ease of reference, I have reproduced the Mark below. Neither of the elements "green" or "works" appears more striking or unique than the other.

[43] The Opponent's trademark, on the other hand, consists of the word WORX, in upper case, in a stylized design partially surrounded by a rectangular border. Once again, for ease of reference, the Opponent's trademark is reproduced below.

[44] As previously indicated, I will focus on the parties' trademarks as a whole; however, I will still bear 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)]. In the present case, I find this principle to be even more instructive and relevant, given that I have found that neither portion of the Mark, "green" or "works" is particularly striking or unique.

[45] The Applicant has adopted the phonetic equivalent of the Opponent's trademark as the second component of its mark; however, the word "green" appears as the first, or (otherwise considered to be the) dominant portion of the Mark [see *Conde Nast, supra*]. The degree of resemblance in appearance, sound, and idea suggested between the parties' trademarks is limited, owing to the "works" and "WORX" elements of the parties' trademarks. The idea suggested by this element of the parties' trademarks being that the parties' respective goods are in good working order [as was held in the POWERWORKS decision], or are used for yard and garden "work". However, the word "green" appearing as the dominant first portion, which as submitted by the Applicant, could be interpreted as a suggestion regarding grass or foliage which are green, or the type of technology employed in the Applicant's Goods (environmentally friendly). Thus, the overall ideas suggested by the parties' marks differ.

[46] Furthermore, I find the parties' trademarks overall are quite different visually. The Opponent's trademark appears in upper case, partially surrounded by a rectangular border which is dominated by the word WORX. The Applicant's Mark, on the other hand, is in lower case, and includes a hexagonal shaded background, that although is not the dominant portion of the Mark, creates a visual impact that is much different from the Opponent's mark, with its, by contrast, relatively insignificant border.

[47] The Applicant further relies on the decision *Positec Group Limited v Orange Works Kitchen & Home Corp,* 2017 TMOB 141 – a decision which considered the trademark ORANGE WORKS under a confusion analysis with the Opponent's WORX trademarks, including, TMA735,908 (WORX Design). Although two cases are never alike, by way of analogy, I agree with the Applicant that the following reasoning at paragraph 51 of that decision is relevant to the case at hand:

> Given that the word WORX in the Opponent's trade-marks is similar to the word WORKS in the Mark, there can be said to be some similarity between the parties' marks in appearance, sound and suggested idea. However, in light of the fact that the word ORANGE appears in the dominant first position of the Mark and the Opponent's trade-marks also feature a design component and corrupted spelling in the word WORX, the marks may also be said to differ from one another in all three aspects. With respect to the Opponent's submission that the word ORANGE simply acts as a modifier for WORKS and does nothing to distinguish the Mark, I note that ORANGE can be both a noun (a fruit) and an adjective (a colour). Both of these meanings result in a strong visual impression and associated idea which differs from that which is created by the Opponent's trade-marks. Overall, I consider the parties' marks to be slightly more different than they are alike.

[48] Having regard to the aforementioned, I find the parties' marks to be more different than alike. I will now assess the remaining relevant surrounding circumstances to determine whether any of these other factors shift the balance of probabilities in favour of the Opponent [see *Masterpiece, supra* at para 49].

Section 6(5)(a) – the inherent distinctiveness of the trademarks and the extent to which they have become known

[49] The Applicant's Mark, as one word, is coined word that is comprised of two ordinary dictionary terms – the word "green" and the word "works". Once again, the "works" portion of

the Mark is not inherently strong given that it suggests that the Applicant's Goods are in good working order or used for yard and garden "work". The Opponent submits that prefix "green" in the Applicant's Mark is a word which is commonly used to suggest that the goods are environmentally friendly. I accept this could be true as, see for example, one definition of the word "green" from the *Merriam-Webster* online dictionary is as follows:

> : tending to preserve environmental quality (as by being recyclable, biodegradable, or nonpolluting)

Although, as previously indicated, the word "green" could also be suggestive, particularly in the context of yard and garden tools, of simply the colour green, as regarding grass or foliage.

[50] The design element of the Applicant's Mark, although not the dominant portion of the Mark, and being comprised of a simple hexagonal shaded background or crest, nonetheless has some measure of visual impact. The design, visually in combination with the other elements of the Mark, in my view give rise to a limited degree of inherent distinctiveness.

[51] With respect to the WORX Design Mark, the Opponent submits that WORX is a coined word, and therefore should have a high degree of inherent distinctiveness. While WORX is a coined word, from a visual standpoint, contrary to the Opponent's submission that the inherent distinctiveness of its trademark is "lessened only slightly by its connotation with the dictionary word "works" in relation to its goods", the fact remains that, when sounded, the Opponent's trademark is *identical* when sounded to the word "works". Furthermore, as previously stated, the idea suggested by this element, is that the goods associated with this trademark are in good working order, or are used for yard or garden work. I will add that, contrary to the Applicant's Mark, the design component does not have much visual impact, and therefore, does not significantly increase the distinctiveness of the Opponent's highly suggestive trademark.

[52] In any event, the strength of a trademark may be increased by means of it becoming known in Canada through promotion or use.

[53] The Applicant has not filed any evidence that specifically addresses the extent of use and promotion of its Mark. In this regard, the Cake affidavit #1 introduces evidence that hedge trimmers bearing the Mark were available for sale, in close proximity to WORX and

YARDWORKS branded hedge trimmers at a Canadian Tire Store in Ontario. The Cake affidavit #2 (supplementary affidavit) introduces evidence of leaf blowers bearing WORX and YARDWORKS trademarks at a Canadian Tire location. I will discuss more regarding the Cake affidavits under the state of the marketplace and concurrent use surrounding circumstances factors forthcoming.

[54] The Opponent's evidence on the other hand, shows extensive use and promotion of its WORX Design Mark in Canada. In this regard, I will provide a summary of the Opponent's evidence regarding the use of its trademarks, including the WORX Design Mark, provided through the affidavit of Philip Fitzpatrick.

Opponent's Evidence – Fitzpatrick Affidavit

[55] Mr. Fitzpatrick, the Sole Director of Positec Canada, Inc. explains that Positec Canada is a subsidiary of the Opponent. He states that the Opponent is a holding company that through its licensed subsidiaries, specializes in the production and sale of power tools as well as lawn and garden equipment. He refers to the Opponent and its subsidiaries collectively as Positec.

[56] Mr. Fitzpatrick states that Positec is known in Canada and throughout the world for the manufacture and sale of power tools, lawn and garden equipment, and other types of goods, including but not limited to electric and/or battery operated chainsaws, hedge trimmers and clippers, lawn mowers, leaf blowers, lawn and garden edgers, and grass and weed trimmers, as well as accessories therefor and power sprayers, which are all sold in association with the trademark WORX and the WORX Logo (as in registration TMA735,908).

[57] Mr. Fitzpatrick states that since at least July 2006, the Opponent has sold and distributed, in Canada, WORX-branded hand and power tools, as well as WORX-branded power lawn and garden tools. He states that the goods sold by the Opponent in association with WORX trademarks in Canada have included without restriction, not only power operated tools and equipment, such as drills, saws, drivers and the like, but also lawn and garden equipment such as electric and/or battery operated chainsaws, hedge trimmers and clippers, lawn mowers, leaf blowers, lawn and garden edgers, grass and weed trimmers, as well as accessories therefor as well as power sprayers (collectively the "WORX Lawn and Garden Equipment").

[58] Mr. Fitzpatrick states that since about 2006, the WORX Lawn and Garden Equipment has been sold continuously in Canada to the general public, hobbyists, and to trade contractors through Canadian retailers such as The Home Depot, Canadian Tire, Home Hardware, TSC Stores, Rona and Lowe's Home Improvement stores.

[59] Mr. Fitzpatrick states that sales in Canada by the Opponent of all WORX-branded tools, including WORX Lawn and Garden Equipment is estimated to have exceeded $92 million by the end of 2019. He further states that it is believed that the WORX Lawn and Garden Equipment would account for approximately 65% of all WORX-branded products sold in Canada by the Opponent.

[60] With respect to notice of association of the WORX trademark(s) with the WORX Lawn and Garden Equipment, Mr. Fitzpatrick states that with all such goods sold in Canada, the trademark WORX is either prominently marked on the goods themselves and/or prominently marked on the packaging for the goods. In support, he provides "representative" photographs and/or sample packaging of WORX Lawn and Garden Equipment and other types of WORX-branded power tools and accessories sold in Canada [Exhibit B]. The WORX trademark is clearly displayed on the various lawn and garden equipment and other power tools shown in the photographs.

[61] With respect to advertising and promotion of WORX Lawn and Garden Equipment, Mr. Fitzpatrick states that these goods have been featured and advertised in numerous Canadian distributed magazines, newspaper advertisements, and store catalogues. Further to this, he states that these goods have been advertised on various third party retailer websites and in Canadian television infomercials for direct sale to end customers. In support, he provides the following:

- sample advertisements from retailers such as Canadian Tire, Home Hardware, Rona, etc. [Exhibit C];

- printouts from online retailers Amazon and *www.worx.com/en-CA*/, which he states feature advertisements for WORX Lawn and Garden Equipment, as well as other WORX-branded tools sold by the Opponent to Canadian consumers via these sites [Exhibit D];

- printscreen shots from *http://www.ispot.tv/brands/IIR/worx* which lists information on the television commercials featuring WORX Lawn and Garden Equipment [Exhibit E], and printscreen shots from *http://www.asseenontv-canada.com* which features the "WORX GT Cordless String Trimmer" [Exhibit F]. He explains that the *ispot* website tracks television commercials by brand across various platforms including network television, and that the *As Seen on TV* website showcases popular products that have been featured in informercials that have aired in Canada [Exhibit F];

- photographs of the Opponent or its licensee booths taken from various trade shows such as the Rona Annual Fall Show in Montreal, the BMR Fall Show in Quebec City, the Federated Coop Fall Buy Mark in Saskatoon, and the Canadian Tire Dealer Convention in Toronto [Exhibit G];

- a sampling of historical print ads which appeared in various Canadian magazines or magazines with Canadian circulation including Holmes Magazines, Cabin Life, Canadian Living Magazine, HOSS Magazine and House and Home [Exhibit H];

[62] Mr. Fitzpatrick estimates that the Opponent and its licensees have spent over $20 million as of May 2019 in television and radio advertising for WORX Lawn and Garden Equipment or other WORX-branded products in North America from 2007 to 2019. In addition, he estimates that from 2006 to 2018, non-television advertising and promotional expenditures in North America for the WORX Lawn and Garden Equipment and other WORX-branded power tools and accessories exceeded $16 million CDN as of 2018. He provides a chart with a breakdown of annual non-television advertising and promotional expenditures in North American in association with the WORX Lawn and Garden Equipment and other WORX-branded products for the period 2006 to 2018 (page 16). Lastly, he states that it is expected that Canadian advertising and promotional expenditures for WORX Lawn and Garden Equipment would account for at least 10% of the North American totals.

[63] Having regard to the aforementioned, I do not consider the inherent distinctiveness of the either parties' mark to be high; although, I do consider the Applicant's Mark to be slightly more inherently distinctive than the Opponent's mark given the inclusion of the element "green" and the incorporated design element. With respect to acquired distinctiveness, however, the

Applicant has not filed any evidence to demonstrate the extent of use and promotion of its Mark. On the other hand, the Opponent has shown extensive use and promotion of its mark to the extent that it has acquired some level of distinctiveness. Thus, I find the acquired distinctiveness of the Opponent's mark shifts this factor overall, significantly in the Opponent's favour.

Section 6(5)(b) – the length of time of use

[64] Having regard to my findings in the section 6(5)(a) factor concerning the extent to which the parties' marks have become known, I find the Opponent's evidence once again supports that the Opponent's trademark has been used over a lengthier period of time. That is, although the Applicant has claimed use since April 2012, the Applicant has not filed any evidence concerning use of its Mark since that date, nor the extent of use of its Mark at all.

[65] This factor thus also favours the Opponent.

Section 6(5)(c) and (d) – the nature of the goods and channels of trade

[66] 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 Aktein* 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*, 58 CPR (3d) 381 (FCA)].

[67] Similar to that which was noted in the POWERWORKS decision, several of the applied-for power operated lawn and garden tools are either identical to or related to the Opponent's Goods.

[68] Further, evidence from the Cake affidavits (#1 and #2), as will be discussed in more detail below, suggests that the parties' channels of trade do, in fact, overlap (both being sold in Canadian Tire Stores for example).

[69] Having regard to the aforementioned, I find these factors favour the Opponent.

Additional Surrounding Circumstances – State of the Register and State of the Marketplace

[70] 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]. However, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); and *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD), 36 CPR (3d) 562 (TMOB); and *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[71] Relevant trademarks include those that (i) are for similar goods and services as the trademarks at issue, and (ii) 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]. If there is not a sufficient number of relevant registrations then also evidence of common use in the marketplace of relevant trademarks will be considered [*Kellogg Salada, supra*; *McDowell* v *Laverana, supra,* at paras 41-46; and *Cie Gervais Danone* v *Astro Dairy Products Ltd*, 1999 CanLII 7656 (FC)].

[72] As previously indicated, the Applicant has provided evidence of state of the register under the Deslauriers affidavit.

[73] In this regard, Ms. Deslauriers, a Trademark Analyst employed by CompuMark, conducted a Canadian Full Dilution Search at the request of the agent for the Applicant, for the terms "WORKS" OR "WORX", limited to active registrations in classes 7 and 8 and with an emphasis on yard and garden maintenance tools and appliances.

[74] Ms. Deslauriers attests that on October 11, 2019, she consulted the Canadian Trademarks Register via CompuMark's database to retrieve all occurrences with the terms "WORKS" or "WORX" limited to active registrations pursuant to the above request. She attaches as Exhibit HD-1 to her affidavit, the results of that Canadian Trademark Register search.

[75] The results of Ms. Deslauriers' above-noted search include 49 trademarks. Of the 49 trademarks, I note the following as of the date of Ms. Deslauriers' search:

- Nine identified trademarks belong to the Opponent, with seven being registered and two with a status of formalized;
- 15 trademarks are owned by Canadian Tire Corporation, Limited, nine of which are registered, four with a status of registration pending, and two of which have been searched;
- Nine trademarks are owned by the Applicant, three of which are registered, three of which are searched, two of which are opposed, and one of which has been searched but is in default;
- Three trademarks are owned by Walmart Apollo, LLC, two of which are registered, and one of which is formalized;
- Two trademarks are owned by RUI ROYAL INTERNATIONAL CORP., both of which are registered; and
- The 11 remaining trademarks belong to separate entities – seven of which are registered, one which is advertised, one which is searched, and two of which are allowed (with one in default).

[76] I have included a listing of the trademarks from the above-noted trademarks that I deem relevant under Schedule E to this decision; that is, those marks owned by a third party, which are registered, include "works" or phonetic equivalents such as "worx", and are for use in association with the same, similar, or overlapping goods. The schedule identifies a non-exhaustive sampling of overlapping goods associated with each relevant trademark.

[77] At the hearing, as also occurred at the hearing with respect to the POWERWORKS decision, the Applicant's agent argued that many of the applications relied upon and introduced into evidence were now relevant because they have since matured to registration. Thus, the Applicant submits it is reasonable for the Registrar to now exercise its discretion to confirm the status of these applications.

[78] However, as was held in the POWERWORKS decision, 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]. That is, in general, the Registrar will not take judicial notice of the state of the Register (other than in respect of marks

specifically referred to by an opponent in a statement of opposition) [see *Molson Breweries v John Labatt Ltd (Labatt Brewing Co Ltd)* (1999), 3 CPR (4th) 543 (TMOB) at 552].

[79] Nonetheless, from the Deslauriers affidavit, it appears that as at the date of her search, there were 49 active trademarks (30 of which were registered), which included the word WORKS or phonetic equivalents for the same, similar or overlapping goods, owned by 12 different entities (10 being third party). There are 20 such relevant registrations for third party marks (see Schedule E to this decision).

[80] In addition to the aforementioned, as previously indicated, Mr. Cake has introduced state of the marketplace evidence (Cake affidavits #1 and #2).

[81] In particular, the Cake affidavit #1 includes two photographs taken by Mr. Cake on Tuesday, May 2, 2017 at a Canadian Tire store located in Keswick, Ontario, where three differently branded lawn and hedge trimmers which all contain the words WORK, WORKS, or WORX can be found side by side in an aisle [Exhibit A]. He notes that the three products include (i) a WORX branded lawn trimmer, which is issued or manufactured by the Opponent and corresponds to their allowed trademark application No. 1,690,631; (ii) a trimmer that is branded GREENWORKS, which is issued or manufactured by the Applicant and corresponds to Canadian trademark registration No. TMA848,508, and; (iii) a hedge trimmer branded YARDWORKS with a stylized Y logo, which is issued by Canadian Tire Corporation, Limited, and corresponds to their Canadian trademark registration No. TMA997,503.

[82] In the Cake affidavit #2, Mr. Cake provides more recent photographs of two leaf blowers taken at a Canadian Tire store, one branded under the Opponent's WORX trademark, and the other under Canadian Tire's house brand, YARDWORKS.

[83] In view of the number of relevant registrations located by Ms. Deslauriers, I would be prepared to infer on that evidence alone, that Canadian consumers are accustomed to seeing trademarks consisting of or containing WORKS or WORX in association with the same, similar, or overlapping goods, such that they are able to distinguish between the marks. This conclusion is further supported by the evidence of at least one third party WORKS trademark being in use in

the marketplace in addition to two of the parties' trademarks. This factor therefore strongly favours the Applicant.

Additional Surrounding Circumstance – Concurrent Use of Parties' Marks

[84] In the Cake affidavit #1, Mr. Cake 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 have been peacefully coexisting in the Canadian marketplace for at least 8 years.

[85] It is well established in jurisprudence that an opponent is not required to show actual instances of confusion. The onus is on the applicant to demonstrate the absence of likelihood of confusion. The fact that there is no evidence of confusion does not relieve an applicant of its burden of proof. Nevertheless, an adverse inference may be drawn from the lack of evidence of actual instances of confusion when there is evidence of extensive concurrent use of the marks [see *Mattel Inc, supra*, at para 55].

[86] In order to given extended coexistence meaningful weight as a factor in the confusion analysis, there should be evidence of sufficient volume of actual concurrent use of the marks. In this case, the Applicant has not provided any evidence with respect to the use of the Mark since the date of first use claimed in the application, or for that matter, at any time whatsoever. Thus, I am unable to draw any conclusions regarding concurrent use.

Additional Surrounding Circumstance – Family of Marks

[87] In its statement of opposition, the Opponent relies on an alleged "trademark family" under this ground of opposition (see Schedule B).

[88] 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]. In addition,

a relevant consideration when a family of marks is pleaded is whether the feature common to the Opponent's marks is found in trademarks owned by others [*Techniquip, supra*].

[89] In the present case, with the exception of the trademark WORX & Design (TMA727,239), the remaining four WORX Design trademarks relied upon by the Opponent under this ground are virtually identical trademarks, but for their respective goods and services [see Schedule B]. Furthermore, as was held in the POWERWORKS decision, 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. I would add that even "two … marks do not a family make" [*U L Canada Inc v Wells' Dairy, Inc*, 1999 CanLII 19471 (TMOB)].

[90] 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 number of trademarks incorporating WORX or phonetic equivalents as a common feature, I do not find that the use of such trademarks by the Opponent would increase the likelihood of confusion that consumers would assume that the Applicant's Mark 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].

Conclusion

[91] 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 overall differences between the parties' trademarks in appearance, when sounded and ideas suggested, are sufficient to shift the balance of probabilities regarding confusion in favour of the Applicant.

[92] It is recognized that it is possible for the degree of distinctiveness attributed to a weak trade-mark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian*, (1984), CPR (3d) 238 at 240]. However, while the Opponent has clearly evidenced use of its trademark TMA735,908, I do not find the evidence of use to be as extensive as required to increase the narrow scope of protection afforded to the Opponent's trademark. The Opponent has not evidenced a family of trademarks, and the differences between the parties' marks in appearance, when sounded, and in ideas suggested overall are sufficient – such that, the evidence does not support that the Opponent's trademark is so well known as to extend its monopoly over all uses of phonetic equivalents of the word "worx" embedded within a trademark. The state of the register and marketplace evidence is further supportive in this respect. Accordingly, the jurisprudence on weak trademarks is a factor which weighs in the Applicant's favour in this case [see *General Motors Corp* v *Bellows* (1949), 10 CPR 101 at pp. 115-6 (SCC); and in *GSW Ltd* v *Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 at 169 (FCTD)].

[93] Thus, 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.

[94] Accordingly, the ground of opposition under section 12(1)(d) of the Act is dismissed.

Section 16(1)(a)

[95] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark in view of the provisions of section 16(1)(a) of the Act, in that as of the alleged date of first use of the Mark, in Canada, the Mark was confusing within the meaning of section 6(5) of the Act with the Opponent's WORX trademarks, both individually, and as a family, and which have been previously used and made known by the Opponent, in association with the goods and services (per Schedule C).

[96] With respect to a section 16(1)(a) ground, the Opponent has an initial burden of establishing that its trademark(s) alleged in support of this ground of opposition was used or

made known prior to the Applicant's claimed date of first use, namely, April 2012, and were not abandoned at the date of advertisement of the application for the Mark (October 25, 2017) [section 16(5) of the Act].

[97] I am satisfied that the Fitzpatrick affidavit establishes, as per the summary under the section 12(1)(d) ground of opposition, that the Opponent has met its burden to show prior use and non-abandonment of its WORX Design Mark in association with power operated lawn and garden tools.

[98] The Applicant's evidence of state of the marketplace under the Cake affidavits #1 and #2 postdates the material date under this ground and therefore will not be considered [see *Servicemaster Co v 385229 Ontario Ltd*, 2014 FC 440 (affirming 2012 TMOB 59)].

[99] Nevertheless, despite Ms. Deslauriers' dilution search being conducted on May 21, 2019, the particulars of the trademarks identified during her search include registration dates. A review of her search results in that regard, reveals that as of the material date under this ground of opposition, namely, April 2012, there were 15 relevant registrations, owned by 10 different entities.

[100] Overall however, despite the differences in material date under this ground, my conclusions under the section 12(1)(d) are still largely applicable. That is, 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 Mark, 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 overall differences between the parties' trademarks in appearance, when sounded and ideas suggested, are sufficient to shift the balance of probabilities regarding confusion in favour of the Applicant.

[101] It is recognized that it is possible for the degree of distinctiveness attributed to a weak trade-mark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian*, (1984), CPR (3d) 238 at 240]. However, while the Opponent has clearly evidenced use of its trademark WORX Design, despite the state of the register evidence not being as strong as in the section 12(1)(d) ground due to the difference in material date, I do not find the evidence of use to be as

extensive as required to increase the narrow scope of protection afforded to the Opponent's trademark. The Opponent has not evidenced a family of trademarks, and the differences between the parties' marks in appearance, when sounded, and in ideas suggested overall are substantial – such that, the evidence does not support that the Opponent's trademark is so well known as to extend its monopoly over all uses of phonetic equivalents of the word "worx" embedded with a trademark. Accordingly, the jurisprudence on weak trademarks is a factor which weighs in the Applicant's favour in this case.

[102] Thus, I am of the view that the ordinary consumer, as a matter of first impression, would not have been likely to think, as of the relevant date, that the goods associated with the Mark emanated from the same source as those associated with the WORX Design Mark or vice versa. Consequently, I find that there was no reasonable likelihood of confusion between the parties' trademarks at the relevant date under the non-entitlement ground of opposition.

[103] Accordingly, the ground of opposition under section 16(1)(a) is dismissed.

Section 2 Ground of Opposition

[104] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods from those of others throughout Canada, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[105] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent must show that as of March 21, 2018, one or more of the Opponent's Marks (per Schedule D) 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), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd,* 2006 FC 657, 48 CPR (4th) 427].

[106] I am satisfied that the Fitzpatrick affidavit establishes, as per the summary under the section 12(1)(d) ground of opposition, that the Opponent has met its burden to show, as of March 21, 2018, that its WORX Design Mark was known sufficiently in Canada [per *Bojangles, supra*] in association with power operated lawn and garden tools.

[107] I note that the Applicant's evidence of state of the marketplace and concurrent use under the Cake affidavit #1, includes photographs which were taken on May 2, 2017 – that is, prior to the material date under this ground. Thus, unlike the non-entitlement ground of opposition, this evidence will be considered with respect to distinctiveness.

[108] Furthermore, the later material date under this ground in contrast to the non-entitlement ground, captures even more relevant registered trademarks under Ms. Deslauriers' state of the register evidence. A review of her search results in this regard, reveals that as of the material date under this ground of opposition, namely, March 21, 2018, in addition to the registered trademarks of the Applicant and the Opponent, there were 17 relevant registrations, owned by 10 different entities. 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 with the same, similar, or overlapping goods, such that they are able to distinguish between the marks.

[109] Once again, 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 overall differences between the parties' trademarks in appearance, when sounded, and ideas suggested, sufficient to shift the balance of probabilities regarding confusion in favour of the Applicant.

[110] Furthermore, as previously indicated, while the Opponent has clearly evidenced use of its WORX Design Mark, I do not find the evidence of use to be as extensive as required to increase the narrow scope of protection afforded to the Opponent's trademark. The Opponent has not evidenced a family of trademarks, and the differences between the parties' marks in appearance, when sounded, and in ideas suggested overall are sufficient – such that, the evidence does not support that the Opponent's trademark is so well known as to extend its monopoly over all uses of phonetic equivalents of the word "worx" embedded within a trademark. The state of the

register and marketplace evidence if further supportive in this respect. Accordingly, the jurisprudence on weak trademarks is a factor which weighs in the Applicant's favour in this case.

[111] Thus, I am of the view that the ordinary consumer, as a matter of first impression, would not have been likely to think, as of the relevant date, that the Goods associated with the Mark would emanate from the same source as those associated with the WORX Design Mark or vice versa. Consequently, I find that there was no reasonable likelihood of confusion between the parties' trademarks at the relevant date under the non-distinctiveness ground of opposition.

[112] Consequently, the ground of opposition based on section 2 of the Act is also dismissed.

DISPOSITION

[113] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition, pursuant to section 38(12) of the Act.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-12-07

APPEARANCES

No one appearing	For the Opponent
Richard Whissell	For the Applicant

AGENTS OF RECORD

Riches, McKenzie & Herbert LLP	For the Opponent
Perley-Robertson, Hill & McDougall LLP	For the Applicant

SCHEDULE A

OPPONENT'S MARKS	**APPLICANT'S MARKS**
WORX	
	POWERWORKS
	HYDROWORKS
	SNOWORKS
	TOOLWORKS
INTELLICUT	SMART CUT
GT	G-MAX
	MAX
OUR MISSION ZERO EMISSION	SMELL THE GRASS NOT THE GAS

SCHEDULE B

Opponent's trademarks pleaded under section 12(1)(d) of the Act:

Trademark	Registration No.	Goods
	TMA727,239	Lawn mowers, grass trimmers, hedge trimmers, woodworking machines; saws (machines); electric hammers; mechanically operated hand-held tools, namely, electric screwdrivers.
	TMA735,908	Lawn mowers, grass trimmers, hedge trimmers, woodworking machines; saws (machines); drilling machines; drill bits, saw blades; drills.
	TMA780,142	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	Tool belts, tool handles.

SCHEDULE C

Opponent's trademarks pleaded under section 16(1)(a) of the Act:

Trademark



All in association with the following goods and services: *Goods* Power tools; garden tools; lawn mowers, grass trimmers, hedge trimmers; woodworking machines; saws (machines); electric hammers; mechanically operated hand-held tools, namely, electric screwdrivers; lawn mowers, grass trimmers, hedge trimmers; woodworking machines; saws (machines); drilling machines; drill bits, saw blades; drills; tool bags, tool boxes; battery chargers, battery packs; 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; peeling machines, namely, planers and routers; engraving machines; cutting machines, namely, cutters, marble cutters; electric breakers, electric tackers, staple guns, electric hammers; electric machines and apparatus for polishing, namely, polishers and abrasive wheels; hand-held tools, other than hand-operated, namely, electric screwdrivers, electric grinders, electric shears, electric sanders, electric wrenches; spray guns for paint; electric welding machines; electric machines and apparatus for cleaning, namely, snow plows, high pressure cleaners, wax-polishing machines, vacuum cleaners; electric shoe polishers; shredders (machines) for industrial use, namely, disintegrators and mills; abrading instruments (hand instruments), namely, sharpening wheels, diamond cutting disks, emery paper, punches; hand tools, hand-operated; hand-operated guns for the extrusion of adhesives; hand operated lifing jacks; lawn clippers (hand instruments); pruning knives; jointers; hot air guns, hot glue guns, nailing guns; electric kitchen machines; drill presses; pumps; high pressure washers; generators; snow plows; power tool accessories, namely, router bits, screwdriver bits, grinding wheels, abrasive

wheels, sanding sheets sanding discs, cutting discs, emery paper; combined vice and workbench; tool belts, tool handles; hand tools.

Services

Rental of tools; maintenance and repair of tools.

SCHEDULE D

Opponent's trademarks pleaded under section 2 of the Act:

Trademark	Application No.	Goods	Services
	1,150,634	Lawn mowers, grass trimmers, hedge trimmers; woodworking machines; saws (machines); electric hammers, mechanically operated hand-held tools, namely, electric screwdrivers	
	1,171,658	Lawn mowers, grass trimmers, hedge trimmers; woodworking machines; saws (machines); drilling machines; drill bits, saw blades; drills.	
	1,232,192	Tool bags, tool boxes; battery chargers, battery packs.	
	1,426,461	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.	
	1,495,553	Tool belts, tool handles;	
	1,690,631	Power tools; Hand tools, gardening tools; 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; 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	
WORX	1,773,883	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	rental of power tools and gardening tools; maintenance and repair of power tools and gardening tools

		film; unexposed photographic film; microphones; radios, remote controllers for radios; remote controllers for video equipment; remote controllers for televisions; semi-conductors; camera, 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, computer game cassettes, computer game discs, hand held units for playing electronic games;	

		dolls, building blocks; power tools; hand tools; power operated gardening tools; tool belts; tool handles	
WORX	1,729,742	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; 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.	
	1,769,976	duplicating machines, telephones, television, camcorders, digital	rental of tools; maintenance and repair of tools

Abandoned on June 6, 2017		cameras, electric iron, optical scanners, electric dictionary, measuring apparatus, namely, tape measures, calipers, laser levels, telemeters, range finders, optical lenses, relays, facsimile machines, cameras (photography), video cameras, electric door openers, electric door closers, electroplating apparatus for electroplating, projectors, smoke detectors, spirit levels, commutators, 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, 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, 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, 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, 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, computer game cassettes, computer game discs, hand held units for playing electronic games; dolls, building blocks; power tools; hand tools; power operated gardening tools	

SCHEDULE E

The results of Ms. Deslauriers' state of the register search. The status of the trademark listed, is the status of that trademark as of the date of Ms. Deslauriers' search (namely, October 11, 2019).

Trademarks owned by Canadian Tire Corporation:

	Trademark	**Application/ Registration No.**	**Status**	**Examples of Relevant Goods**
1.	YARD WORKS	889,851, TMA544,673	Registered (registration date: May 8, 2001)	Garden tools, lawn mowers, trimmers.
2.	YARDWORKS	873,955, TMA544,763	Registered (registration date: May 9, 2001)	Garden tools, lawn mowers, trimmers.
3.	YARD WORKS	889,852, TMA544,672	Registered (registration date: May 8, 2001)	Garden tools, lawn mowers, trimmers.
4.	YARDWORKS	1,708,973, TMA997,509	Registered (registration date: May 25, 2018)	Pruners, garden tools, lawn mowers, trimmers, power blowers and vacuums for leaves and lawn debris.
5.	YARDWORKS	1,708,974, TMA997,503	Registered (registration date: May 25, 2018)	Pruners, garden tools, lawn mowers, trimmers, power blowers and vacuums for leaves and lawn debris.
6.	YARDWORKS	1,293,065, TMA765,290	Registered (registered April 29, 2010)	Pruners, garden tools, lawn

				mowers, trimmers.
7.	YARDWORKS CANADA	873,954, TMA544,762	Registered (registered May 9, 2001)	Pruners, garden tools, lawn mowers, trimmers.
8.		1,708,975, TMA997,502	Registered (registration date: May 25, 2018)	Lawn mowers, trimmers, power blowers and vacuums for leaves and lawn debris.
9.	YARD WORKS	889,850 TMA544,674	Registered (registration date: May 8, 2001)	Pruners, lawn mowers, trimmers, blowers.

Trademarks owned by Walmart Apollo, LLC:

	Trademark	**Application/ Registration No.**	**Status**	**Examples of Relevant Goods**
1.	HANDIWORKS	1,064,865, TMA563,623	Registered (registration date: June 18, 2002)	Hand tools.
2.	HANDIWORKS	1,137,019, TMA590,789	Registered (registration date: September 25, 2003)	Power drills.

Trademarks owned by RUI ROYAL INTERNATIONAL CORP.:

	Trademark	**Application/ Registration No.**	**Status**	**Examples of Relevant Goods**
1.	TOOLWORKS	1,230,974, TMA645,707	Registered (registration date: August 15, 2005)	Saws, drills.
2.		1,406,945, TMA791,825	Registered (registration date: March 1, 2011)	Saws.

The remaining trademarks which belong to separate entities:

	Trademark	**Application/ Registration No.**	**Status**	**Examples of Relevant Goods**	**Owner**
1.	GARDENWORKS	718,965, TMA426,985	Registered (registration date: May 6, 1994)	Garden tools and implements, hedge trimmers, lawnmowers.	Canada Gardenworks Ltd.
2.	DIRTWORKS	1,682,989 TMA908,694	Registered (registration date: July 16, 2015)	Landscaping tools, namely, cultivators, box scrapers, and rakes.	Polaris Industries Inc.
3.	THE GOLFWORKS	669,871, TMA425,177	Registered (registration date: March 18, 1994)	Hand tools.	Golf Galaxy Golfworks, Inc. (an Ohio corporation)
4.	REELWORKS	1,335,138, TMA760,994	Registered (registration date: March 5, 2010)	Hose reel.	Intradin (Shanghai) Machinery Co., Ltd.
5.	SOFTWORKS	1,061,534, TMA562,352	Registered (registration date: May 22, 2002)	Hand-operated garden tools, namely, trowels, cultivators, scratchers, weeders, and weeding forks.	Helen of Troy Limited
6.	POLARWORX	1,400,108, TMA756,845	Registered (registration date: January 12, 2010)	General shovels for multi-purpose shovelling.	Gardena Canada Ltd.
7.	QPR SHOPWORX	1,476,526, TMA803,744	Registered (registration date: August 5, 2011)	Shovels and rakes.	QUIKRETE CANADA HOLDINGS, LIMI TED