



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 251

Date of Decision: 2022-12-09

IN THE MATTER OF AN OPPOSITION

Opponent: Holland Imports Inc.

Applicant: Hangzhou Great Star Industrial Co., Ltd.

Application: 1,850,090 for ROC RUNNER Design

INTRODUCTION

[1] Hangzhou Great Star Industrial Co., Ltd. (the Applicant) has applied to register the trademark ROC RUNNER Design (the Mark), shown below, in association with the following goods: (1) Hand held cutting tools; hand-operated saws; jig-saws; hand tools; hand-operated sharpening tools and instruments; shears; miter cutters being hand tools (the Goods).

**ROC
RUNNER**

[2] Holland Imports Inc. (the Opponent) opposes registration of the Mark. The opposition is based primarily on allegations that the Mark is confusing with the

Opponent's ROK trademark, registered in association with, among other things, power and hand tools.

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

THE RECORD

[4] The application was filed on July 31, 2017, based on proposed use in Canada and advertised for opposition purposes in the *Trademarks Journal* on December 18, 2019.

[5] On February 18, 2020, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T 13 (the Act). All references are to the Act as amended June 17, 2019, unless otherwise noted.

[6] The grounds of opposition, as set out in the Opponent's statement of opposition, may be summarized as follows:

- The Mark is confusing with the Opponent's ROK trademark;
- The Applicant is not the person entitled to registration of the Mark in view that it was confusing with the Opponent's ROK trademark which was previously used or made known in Canada;
- The Applicant is not the person entitled to registration of the Mark in view that it was confusing with the Opponent's previously filed trademark application No. 1,478,105 for the trademark ROK;
- The Mark is not distinctive; and
- The Applicant was not using or did not propose to use the Mark in Canada.

[7] On July 3, 2020, the Applicant served and filed a counter statement.

[8] In support of its opposition, the Opponent filed the affidavit of Shahid Punjani.

[9] The Applicant did not file any evidence. The Opponent's affiant was not cross-examined.

[10] Only the Applicant submitted written representations; a hearing was requested at which only the Opponent was represented.

EVIDENTIAL BURDEN AND LEGAL ONUS

[11] The Applicant bears the legal onus of showing that its application complies with the provisions of the Act. However, for each ground of opposition, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist. If this initial burden is met, then the Applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd*, (1990), 30 CPR (3d) 293 (FCTD)].

GROUND SUMMARILY DISMISSED

[12] The Opponent pleads that the Applicant was not the person entitled to the registration of the Mark at the filing date of the application because, contrary to section 16(1)(b) of the Act, the Mark was confusing with the Opponent's previously filed trademark application No. 1,478,105 for the trademark ROK.

[13] Section 16(1)(b) requires the Opponent to have filed its trademark application in Canada prior to the Applicant's filing date (*i.e.*, December 18, 2019) or date of first use, whichever is earlier. Pursuant to section 16(2) of the Act, the right of an applicant to secure registration of a registrable trademark is not affected by the previous filing of an application for registration of a confusing trademark by another person unless the application for registration of the confusing trademark was pending on the day on which the applicant's application was advertised, *i.e.*, December 18, 2019.

[14] In this case, the Opponent filed its trademark application on April 22, 2010, which was prior to the Applicant's filing date. However, as the Opponent's trademark issued

to registration on March 15, 2011, it was not pending as of the date of advertisement of the Applicant's application as is required by section 16(2). This ground is therefore dismissed for the Opponent's failure to meet its evidential burden.

SECTION 12(1)(D) GROUND OF OPPOSITION – REGISTRABILITY

[15] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent's ROK registration No. TMA792,829, which is registered in association with the following goods: (1) Power tools, hand tools, hand and power tools for use in woodworking, hand and power tools for use in metalworking, dollies, mechanic's tools, pneumatic tools for woodworking, pneumatic tools for metalworking, and parts and fittings for aforesaid wares. (2) Spray paint guns. (3) Safety glasses; grinding wheel bowls. (4) Storage boxes. (5) Air tanks; saw blades.

[16] The material date for considering this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks*, 1991 CanLII 11769 (FCA)].

[17] I have exercised my discretion to check the Register and confirm that the Opponent's registration No. TMA792,829 is in good standing [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I therefore find that the Opponent has met its burden with respect to this ground of opposition.

[18] I now have to determine, on a balance of probabilities, if there is a reasonable likelihood of confusion with between this trademark and the Mark.

Meaning of Confusion between Trademarks

[19] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

[20] The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured 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.

[21] Thus, section 6(2) does not concern mistaking one trademark for the other, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's Goods, sold under the Mark, would believe that those goods were produced or authorized or licensed by the Opponent who sells its goods under the ROK trademark.

Test for Confusion

[22] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two trademarks are confusing, are "all the surrounding circumstances including" those specifically mentioned in sections 6(5)(a) to 6(5)(e) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the trademarks or in the ideas suggested by them.

[23] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 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.

Inherent distinctiveness and extent known

[24] The inherent distinctiveness of a trademark refers to its uniqueness when considered with its associated goods and/or services.

[25] In this case, the Applicant submits that the dictionary meaning for the word ROC is a mythical bird of Eastern legend, imagined as being of enormous size and strength

(*Oxford English Dictionary*). While I have no reason to question that definition, there is no evidence that the average consumer of the Applicant's Goods would be aware of this dictionary meaning. Regardless, I agree with the Applicant that the Mark, being ROC RUNNER in stylized form, is not suggestive of a character or quality of the applied-for Goods and therefore possesses a certain degree of inherent distinctiveness.

[26] With respect to the Opponent's trademark, the Applicant submits that it is a weak mark deserving of a narrow range of protection. In this regard, the Applicant submits that I should take judicial notice of the numerous prior trademarks on the Register consisting of the word ROCK with goods similar to those of the Opponent.

[27] The Opponent's trademark is a coined word. While it is phonetically like the word "rock" when sounded, I do not find that this word has any meaning in association with the Opponent's goods. Further, it has been previously held that the Registrar will not take judicial notice of the state of the Register (other than in respect of trademarks 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]. I therefore find that the Opponent's trademark is also inherently distinctive.

[28] The acquired distinctiveness of a trademark refers to the extent to which it has become known in Canada. The evidence of Mr. Punjani, Director of the Opponent, may be summarized as follows:

- The Opponent was established in Burnaby, B.C. in October 1973; it is a multi-channel wholesaler and retailer offering a wide array of high quality products for the home and job site, including professional quality tools and hardware;
- The Opponent has been offering ROK branded goods to Canadian customers since at least as early as October 2009;
- The ROK branded goods extend to multiple product lines, with 16 product lines of tools and accessories in Canada;

- The 16 product lines contain 91 unique product categories and a list of the over 2700 ROK branded goods available in Canada;
- ROK branded goods are offered to consumers through the Opponent's website *www.hollandimports.com*, the ROK website *www.roktools.ca*, the Summit Tools website *summittools.com*, the Summit Tools retail locations and over 800 stores that carry ROK branded goods;
- ROK branded goods are sold in many stores in Canada including, but not limited to, Home Hardware, Rona/Lowe's, Peavey Mart, Canac, London Drugs, Castle Building Centres, Nurseryland, Kent Building Centres, Groupe BMR, Timber Mart and Ace Hardware;
- Between 2013 and November 4, 2020, the Opponent has sold in excess of 12 million units of ROK branded goods to third parties and at retail stores, representing sales in excess of \$109 million CAD;
- Between 2018 and 2019, the Opponent spent in excess of \$400,000 per year on total advertising expenditures; and
- The ROK brand and ROK branded goods have been promoted in Canada or to Canadian customers using a variety of means including via: the Opponent's website, the ROK website, the Summit Tools' website, the purchasing process (including in store posters, banners, and merchandisers highlighting the ROK brand, videos playing in store highlighting ROK branded goods and ROK branded packaging and product labels), print advertisements in trade magazines, tradeshows, store visits by sales representatives, promotional emails, print flyers, brochures and sell sheets, the Opponent's printed catalogs, the Opponent's social media accounts and Summit Tools' social media accounts.

[29] The Applicant submits that the Opponent's units of goods and sales figures from 2013 to 2020 are vague in that they are not delineated or separated by the Opponent's

specific goods or groups of goods. The Applicant also notes that the advertising figures for 2018 and 2019 are vague and do not specify which goods the advertising relates to.

[30] I agree with the Applicant that it would have been preferable if the Opponent had provided quantitative evidence of sales or advertising of goods sold under its ROK brand. However, in the absence of cross-examination, I have no reason to draw negative inferences from any alleged shortcomings to Mr. Punjani's evidence. On a fair reading of his evidence, I find that the Opponent's trademark has acquired a considerable reputation in Canada.

[31] As there is no evidence regarding use of the Mark, I cannot conclude that it has become known to any extent in Canada.

[32] In these circumstances, given that the Opponent's trademark has become known to a greater extent in Canada than the Mark, I find that overall this factor favours the Opponent.

Length of time in use

[33] The Applicant submits that while the Opponent claims that its goods were offered to Canadian consumers since at least as early as October 2009, the evidence does not separately identify when, where or which of the Opponent's goods were first offered to Canadian consumers.

[34] I agree that the evidence does not support use of the Opponent's trademark with its goods since at least as early as October, 2009. However, at a minimum, I accept that the evidence as a whole shows that the Opponent has been using its trademark in association with the relevant goods since at least as early as 2013. As the Applicant has not shown any use of its Mark, this factor favours the Opponent.

Nature of Goods and Channels of Trade

[35] Regarding the nature of the parties' goods, the Mark has been applied for in association with hand held cutting tools; hand-operated saws; jig-saws; hand tools; hand-operated sharpening tools and instruments; shears; and miter cutters being hand

tools. While the Opponent's affiant asserts that its trademark is used in association with over 2700 unique products, it is the statement of goods as defined in the registration relied upon by the Opponent that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[36] The Applicant submits that much of the evidence shows alleged use of the Opponent's trademark for goods that do not overlap and are not similar to the Applicant's Goods or are for unrelated goods. I disagree. In this regard, the Opponent's evidence shows its trademark being displayed on tile cutters, utility knives, hand saws and jig saws, all products that fall under the broad category of hand tools. I therefore find that the applied for Goods either directly overlap with or are related to the Opponent's goods, and this factor favours the Opponent in the confusion analysis.

[37] Insofar as the nature of the parties' trade is concerned, I first note that the application does not contain any restrictions with respects to the channels of trade for the distribution of the Applicant's Goods. Further, there is no evidence regarding the channels of trade through which the Applicant offers its goods for sale. I therefore find that, in view of how closely related the parties' goods are, the nature of the trade is also likely to be substantially the same [*Opus Building Corp v Opus Corp* (1995), 60 CPR (3d) FC at 104]. In other words, it is reasonable to infer that the Applicant's Goods would be carried in the same types of stores as the Opponent's goods.

[38] This factor therefore favours the Opponent.

Degree of resemblance

[39] As previously noted, the Supreme Court of Canada indicates in *Masterpiece*, *supra*, that the most important factor under section 6(5) of the Act will often be the degree of resemblance between the trademarks.

[40] In this case, the Applicant submits that the Mark differs from the Opponent's trademark because the applied-for Mark is a composite mark composing two words in a

unique stylization and design. The Applicant also relied on several opposition decisions where the Registrar found no confusion between trademarks having an identical sounding first word or prefix.

[41] The Opponent, on the other hand, submits that there is a considerable degree of resemblance between the trademarks because the most dominant feature of the Mark is the word ROC, which is almost identical in appearance and sound to the Opponent's ROK trademark.

[42] I agree with the Applicant that confusion will be unlikely in situations where trademarks share common features but also feature dominant differences such that the differences are a signal to the public that the products associated with each trademark have different sources. In this case, however, I do not find there to be dominant differences between the trademarks. As noted by the Opponent, the most striking aspect of the Mark, and also its first component, is the word ROC which is almost identical to the Opponent's mark ROK. Further, the component RUNNER appears in smaller font and below the word ROC thereby decreasing its significance when the Mark is considered as a whole. I therefore find there to be a considerable degree of resemblance between the trademarks in appearance and sound.

[43] The Applicant also submits that the ideas suggested by the trademarks are not similar. In this regard, the Applicant submits that ROC and ROK connote different ideas. This submission, however, is based on the dictionary meaning of the word ROC provided above. As previously noted, the average consumer may not be aware that the word ROC is defined as a mythical bird, and is therefore different in idea suggested than the Opponent's ROK mark. In my view, however, neither party's trademark suggests any obvious idea, other than that suggested by the aforementioned phonetic similarities to the word "rock". But even if I am wrong in this regard, I find that overall the degree of resemblance between the trademarks is sufficient to favour the Opponent.

Conclusion regarding confusion

[44] Ultimately, the test to be applied is whether a casual Canadian consumer, having an imperfect recollection of the Opponent's trademark ROK in association with hand

and power tools, when they see the Mark, ROC RUNNER Design, in association with the Goods, would think the products come from the same source.

[45] Having considered all of the surrounding circumstances contemplated by section 6(5) of the Act, and given that each of the relevant factors favours the Opponent as discussed above, I conclude that the Applicant has not met its legal burden of establishing on a balance of probabilities that confusion is not likely between the Mark and the Opponent's trademark. The section 12(1)(d) ground of opposition is therefore successful.

SECTION 2 GROUND OF OPPOSITION – DISTINCTIVENESS

[46] The material date for the section 2 ground of opposition is the date of filing the statement of opposition, namely, February 18, 2020.

[47] In order to meet its initial evidential burden under this ground of opposition, an opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada in association with relevant goods and/or services so as to negate the distinctiveness of the applied for trademark [see *Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[48] In my view, the Opponent's evidence of its use of the ROK trademark in Canada, set out above, is sufficient for the Opponent to meet its evidential burden for the section 2 ground of opposition.

[49] I find that this ground of opposition is successful based on the same analysis of confusion as set out above with respect to the section 12(1)(d) ground of opposition. Specifically, I find that the Applicant has not met its legal burden to demonstrate that there is no likelihood of confusion between the Mark and the Opponent's trademark, and thus has not met its legal burden to demonstrate that the Mark is distinctive of the Applicant pursuant to section 2 of the Act as of the material date.

[50] Consequently, the section 2 ground of opposition is also successful.

REMAINING GROUND OF OPPOSITION

[51] As I have already refused the application under two grounds, I will not address the remaining grounds of opposition.

DISPOSITION

[52] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

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

Appearances and Agents of Record

HEARING DATE: 2022-12-01

APPEARANCES

For the Opponent: Reagan Seidler

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Smart& Biggar

For the Applicant: Chooi Law Professional Group