

Federal Court



Cour fédérale

Date: 20210723

Docket: T-17-19

Citation: 2021 FC 782

Ottawa, Ontario, July 23, 2021

PRESENT: The Honourable Justice Fuhrer

BETWEEN:

TOKAI OF CANADA LTD

Applicant

and

**THE KINGSFORD PRODUCTS
COMPANY, LLC**

Respondent

JUDGMENT AND REASONS

I. Overview

[1] Tokai of Canada Ltd sought to register the trademark KING for barbeque and fireplace lighters, and for cigarette lighters. The Kingsford Products Company, LLC successfully opposed Tokai's trademark applications based on several registered trademarks involving KINGSFORD for goods relating to barbecuing and/or charcoal, including charcoal lighters. Tokai now appeals the Registrar's decisions refusing its trademark applications because of a likelihood of confusion.

[2] Two issues arise in this appeal:

- A. *What is the applicable standard of review, taking into account the new evidence filed on appeal?*
- B. *Did the Registrar err in concluding that, pursuant to paragraph 12(1)(d) of the Trademarks Act, RSC 1985, c T-13 [TMA], that the trademark KING is not registrable because Tokai failed to establish no reasonable likelihood of confusion between KING, as applied for, and KINGSFORD, as registered?*

[3] See “Annex A” below for the relevant *TMA* provisions.

[4] Tokai conceded at the hearing before me that if the Court does not consider its new evidence to be “material,” then the Registrar of Trademarks did not make any palpable and overriding errors. For the more detailed reasons that follow, I find that both parties’ new evidence submitted to the Court is either inadmissible or immaterial. Notwithstanding Tokai’s concession, I further find, on a review of the applicable decisions described below, that the Registrar did not make any palpable and overriding errors. I therefore dismiss Tokai’s appeals.

II. Background

A. *The Applications, the Oppositions and Other Related Proceedings*



[5] Tokai filed application No. 1,539,953 [953 Application] on August 9, 2011 to register the trademark KING for utility lighters based on use of the trademark in Canada since at least as early as December 30, 2010. Tokai amended the 953 Application on February 7, 2013 to redefine “utility lighters” as “barbeque and fireplace lighters.” The Registrar approved the 953 Application on February 14, 2013 and it was advertised on April 24, 2013 in the *Trademarks Journal* for opposition purposes.

[6] Kingsford opposed the 953 Application on August 9, 2011 and pleaded grounds of opposition based on the *TMA* sections 12(1)(d), 16(1)(a), 16(1)(c), 2, as well as 30(i) and 30(b). Kingsford filed the Affidavit of Elenita Anastacio, sworn March 18, 2014; Ms. Anastacio was not cross-examined on her affidavit. Tokai filed the Affidavit of John Tucker, sworn June 11, 2015, a director of Tokai [Tucker Affidavit]; Mr. Tucker was cross-examined on his affidavit on January 18, 2016 and the transcript was filed with the Trademarks Opposition Board [TMOB]. On behalf of the Registrar of Trademarks, the TMOB found in favour of Kingsford, but only in respect of the registrability ground based on the *TMA* s 12(1)(d); all other grounds were dismissed or rejected: *The Kingsford Products Company, LLC v Tokai of Canada Ltd*, 2018 TMOB 126 [953 TMOB Decision].

[7] Tokai filed application No. 1,684,990 [990 Application] on July 7, 2014 to register the trademark KING for cigarette lighters based on intention to use the trademark in Canada. The Registrar approved the 990 Application on January 8, 2015 and it was advertised on March 4, 2015 in the *Trademarks Journal* for opposition purposes.

[8] Kingsford opposed the 990 Application on February 3, 2016 and pleaded grounds of opposition based on the *TMA*, sections 12(1)(d), 16(3)(a), 16(3)(c), 2, and 30(i). In this case, only Kingsford filed any evidence, the Affidavit of Elenita Anastacio, sworn September 14, 2016; Ms. Anastacio was not cross-examined on her affidavit. Similarly, the TMOB found in favour of Kingsford, but only in respect of the registrability ground based on the *TMA* s 12(1)(d); all other grounds were dismissed or rejected: *The Kingsford Products Company, LLC v Tokai of Canada Ltd*, 2018 TMOB 127 [990 TMOB Decision].

[9] The following chart summarizes the registered trademarks on which Kingsford relied in its successful oppositions to Tokai's trademark applications:

Trademark and Registration Number	Goods	Basis of Registration in Canada
KINGSFORD TMA195,651	(1) Charcoal and charcoal lighters	Used in Canada since at least June 1, 1953
 KINGSFORD & Design TMA196,359	(1) Charcoal, charcoal lighters	Used in Canada since at least June 1, 1953
KINGSFORD TMA344,604	(1) Barbecue sauce.	Used in UNITED STATES OF AMERICA. Registered in or for UNITED STATES OF AMERICA on January 06, 1987 under No. 1,424,150
 KINGSFORD CHARCOAL BRIQUETS & Design TMA335,006	(1) Charcoal briquets.	Used in UNITED STATES OF AMERICA. Registered in or for UNITED STATES OF AMERICA on March 19, 1985 under No. 1,325,270
KINGSFORD TMA386,771	(1) Barbecue grills	Used in UNITED STATES OF AMERICA. Registered in or for UNITED STATES OF AMERICA on April 11, 1989 under No. 1,534,164

[10] Although Tokai filed separate Notices of Application under the *TMA* s 56(1) to appeal each TMOB decision, the Court consolidated the matters by Order dated November 25, 2019. Tokai seeks to have the TMOB decisions set aside and its trademark applications allowed.

[11] The parties to this consolidated appeal were also involved in an earlier opposition proceeding involving the trademark KING, which was the subject of application number 1,655,739 filed by Tokai for use in association with “butane”: *The Kingsford Products Company, LLC v Tokai of Canada Ltd.*, 2017 TMOB 83 [739 TMOB Decision]. In that case, the TMOB refused the application pursuant to the *TMA* s 12(1)(d), finding that the applied for trademark KING was likely to be confused with Kingsford’s registered KINGSFORD trademarks. On appeal, the Court upheld the 739 TMOB Decision in *Tokai of Canada Ltd v The Kingsford Products Company, LLC*, 2018 FC 951 [Tokai FC 2018].

B. *The Parties’ New Evidence on Appeal*

[12] Both parties filed new evidence in this appeal, further to the *TMA* s 56(5).

(1) Tokai’s New Evidence

[13] Tokai filed:

- (a) The Affidavit of Jon L. Purther, sworn February 4, 2019 [Purther Affidavit], including three exhibits:
 - Exhibit “A” – Certificate Concerning Code of Conduct for Expert Witness;
 - Exhibit “B” – Curriculum vitae;
 - Exhibit “C” – Detailed report of survey results; and

(b) Third party registrations for trademarks containing KING.

[14] Kingsford cross-examined Mr. Purther on his affidavit on September 10, 2019. The transcript of the cross-examination forms part of the Applicant's record in this matter.

(a) *The Purther Affidavit*

[15] Mr. Purther is the President and Chief Operating Officer of CorbinPartners Inc [CorbinPartners], a marketing science company that conducts market research and has experience providing forensic research support for trademark litigation. Tokai retained CorbinPartners to plan, design and implement a survey of Canadian adults who had purchased or planned to purchase, a butane lighter.

[16] The survey was conducted online between May 29, 2018 and January 5, 2019, and was comprised of seven hundred and seven (707) online interviews with participants. The survey's findings and methodology are contained in a report prepared by CorbinPartners dated January 17, 2019 [Butane Lighter Study] which is attached as Exhibit "C" to the Purther Affidavit. The Butane Lighter Study concluded that the survey showed "no statistical evidence of misapprehension as to the source of the 'KING' butane lighter, directly attributed to its brand name."

(b) *Third Party Trademark Registrations*

[17] Tokai also filed certified copies of ten (10) third party trademark registrations and one (1) allowed trademark application [Third Party Marks]. The chart below contains a summary of the

Third Party Marks, with only references to lighters or related goods listed in the “Goods” column.

Trademark and Registration Number	Goods	Basis of Registration in Canada
KINGS TMA170,636	Various consumer goods, including (6) cigarette lighters	Used since at least as early as May 1984 on goods (6)
THE WHEAT KINGS TMA587,190	Various consumer goods, including disposable lighters	Used since at least as early as September 1947 on goods and services
GOLDKING TMA658,880	Various goods relating to smoking, including tobacco products, and smokers’ articles, including lighters	Used in GERMANY. Priority filing date September 02, 2004
OIL KINGS TMA780,652	Various consumer goods, including (2) lighters	Declaration of use filed October 2010
EDMONTON OIL KINGS TMA780,653	Various consumer goods, including (2) lighters	Declaration of use filed October 2010
KING OF BEERS TMA745,897	Lighters for smokers.	Declaration of use filed July 2009
VAPEKING TMA928,535	Various goods relating to electronic cigarettes products and articles of clothing	Used since at least as early as May 2014 on goods and services
 SUPER KINGS TMA997,832	Various goods relating to smoking, including tobacco products, and smokers’ articles, including lighters and matches.	Declaration of use filed May 2018
LOS ANGELES KINGS TMA170,637	Various consumer goods, including (6) cigarette lighters	Used since at least as early as May 1984 on goods (6)
KING OF BLUE TMA745,897	Various consumer goods, including lighters	Declaration of use filed October 2012

THE KING OF CANNABIS Application No 1,818,905	(3) Smoker articles, including lighters	Used since at least as early as 2014
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(2) Kingsford's New Evidence

[18] Kingsford filed the Affidavit of Maria Golverk, legal assistant, sworn May 3, 2019

[Golverk Affidavit], including six exhibits:

Exhibit "A" – Particulars for Tokai's 953 Application, 990 Application, and 739 Application obtained from the Canadian Intellectual Property's Office online trademarks database;


Exhibit "B" –The *953 TMOB Decision* and the *990 TMOB Decision*;





Exhibit "C" –The Judgment and Reasons of Justice Manson in *Tokai FC 2018*;

Exhibit "D" –The Tucker Affidavit;

Exhibit "E" –The transcript of the January 18, 2016 cross-examination of Mr. Tucker;

Exhibit "F" –Certified copies of seven KINGSFORD registrations, obtained from the Canadian Intellectual Property Office; although the Golverk Affidavit states that Kingsford owns eight Canadian trademark registrations, the details of which are summarized in the chart below, a certified copy of registration number TMA386,771 is missing from this exhibit.

Trademark and Registration Number	Goods	Basis of Registration in Canada
KINGSFORD TMA195,651	(1) Charcoal and charcoal lighters	Use in Canada since at least as early as June 1, 1953
 TMA196,359	(1) Charcoal, charcoal lighters	Used in Canada since at least June 1, 1953

 <p>TMA335,006</p>	(1) Charcoal briquets.	Used in UNITED STATES OF AMERICA. Registered in or for UNITED STATES OF AMERICA on March 19, 1985 under No. 1,325,270.
<p>KINGSFORD TMA344,604</p>	(1) Barbecue sauce.	Used in UNITED STATES OF AMERICA. Registered in or for UNITED STATES OF AMERICA on January 06, 1987 under No. 1,424,150.
<p>KINGSFORD TMA386,771</p>	(1) Barbecue grills	Used in UNITED STATES OF AMERICA. Registered in or for UNITED STATES OF AMERICA on April 11, 1989 under No. 1,534,164
 <p>TMA767,620</p>	(1) Charcoal briquets	Declaration of Use filed May 5, 2010
 <p>TMA810,844</p>	(1) Charcoal barbeque grills; charcoal smokers; charcoal chimneys (chimney starters) fabric grill covers; patio fireplaces.	Declaration of Use filed October 19, 2011
 <p>TMA991,526 (1,666,106)</p>	(1) Aluminum foil. (2) Containers formed of aluminum foil for household use	Used in UNITED STATES OF AMERICA on goods (2). Registered in or for UNITED STATES OF AMERICA on September 01, 2015 under No. 4,804,820 on goods (2). Declaration of Use filed February 15, 2018 on goods.

III. Analysis

C. *Applicable Standard of Review*

(1) General Principles

[19] An appellate standard of review applies where, as in the case before me, there is a statutory right of appeal: *Canada (Minister of Citizenship and Immigration) v Vavilov*, 2019 SCC 65 [Vavilov] paras 36-37, citing *Housen v Nikolaisen*, 2002 SCC 33, [2002] 2 SCR 235 [Housen]. *Vavilov* does not displace the previous jurisprudence regarding new evidence filed with the Federal Court on appeal from a decision of the Registrar, but rather necessitates an adjustment: *The Clorox Company of Canada, Ltd. v Chloretec SEC*, 2020 FCA 76 [Clorox] at paras 19-23. The starting point is a consideration of whether any new evidence would have affected the TMOB's decision materially: *Clorox*, above at para 19.

[20] To be considered "material," the new evidence must be sufficiently substantial and significant, and of probative value: *Clorox*, above at para 21, citing respectively *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707 at para 27 and *Tradition Fine Foods Ltd. v. Groupe Tradition'l Inc.*, 2006 FC 858 at para 58. "[E]vidence that merely supplements or repeats existing evidence will not surpass this threshold": *Scott Paper Limited v Georgia-Pacific Consumer Products LP*, 2010 FC 478 [Scott Paper] at paras 48-49. The test is not whether the new evidence would have changed the Registrar's mind, but rather whether it would have a material effect on the decision: *Scott Paper*, above, at para 49. In that regard, quality, not quantity, is key: *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707 at para 27.

[21] Further to the *TMA* s 56(5), a finding of materiality permits the Court to “exercise any discretion vested in the Registrar.” Justice de Montigny noted that this entails an appeal *de novo* calling for the application of the correctness standard: *Clorox*, above at para 21, referring to *Canada (Minister of Citizenship and Immigration) v. Vavilov*, 2019 SCC 65 [*Vavilov*] (and the situations where the presumptive reasonableness standard of review will be rebutted, as summarized at *Vavilov* para 17). In other words, the Court need not defer to the decision maker’s reasoning process; undertaking its own analysis, the Court may decide whether it agrees with the decision maker’s determinations or whether it will substitute its own views: *Dunsmuir v New Brunswick*, 2008 SCC 9 at para 50, [2008] 1 SCR 190.

[22] If the new evidence is not material (or if no new evidence is filed), then this is the point at which *Vavilov* requires an adjustment to the applicable standard: *Clorox*, above at para 22. Instead of the previous standard of reasonableness, the appellate standard of review applies, with reference to *Housen*. This means questions of fact or mixed fact and law (except extricable questions of law) will be assessed for “palpable and overriding error.” Palpable means an obvious error, while an overriding error is one that affects the decision-maker’s conclusion; it is a highly deferential standard of review: *Mahjoub v Canada (Citizenship and Immigration)*, 2017 FCA 157 at paras 61-64. Questions of law (including extricable questions of law), on the other hand, will be assessed for correctness according no deference to the conclusions of the underlying decision maker: *Clorox*, above at para 23; *Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 at para 42.

[23] In sum, I must assess the nature, significance, probative value, and reliability of the parties' new evidence, in the context of the record, and determine whether it adds "something of significance" and hence, whether it would have affected the TMOB's decision materially: *Seara Alimentos Ltda v Amira Enterprises Inc*, 2019 FCA 63 [*Seara*] at paras 23-26. In other words, would the evidence have enhanced or otherwise clarified the record in a way that might have influenced the Registrar's conclusions on a finding of fact or exercise of discretion, had it been available at the time of the Decision? Further, even when new evidence is admitted on appeal, this does not necessarily displace the TMOB's findings in respect of every issue but rather only those issues for which the evidence is provided and admitted: *Seara*, above at para 22.

(2) Materiality of Parties' New Evidence

(a) *Tokai's New Evidence*

[24] For the more detailed reasons below, I find that deficiencies in the survey impact its reliability and validity and, thus, the Purther Affidavit is inadmissible. I further find the Third Party Marks are not sufficiently significant and probative that they would have affected the TMOB's decisions materially.

(i) Purther Affidavit

[25] Survey evidence, as a species of expert evidence, must meet the following conjunctive criteria for the Court to find it admissible: (a) relevance; (b) necessity in assisting the trier of fact (in the sense that the evidence is outside the experience and knowledge of a judge); (c) the absence of any exclusionary rule; and (d) a properly qualified expert: *Masterpiece Inc v Alavida*

Lifestyles Inc, 2011 SCC 27 [*Masterpiece*] at para 75, citing *R v Mohan*, 1994 CanLII 80 (SCC), [1994] 2 SCR 9. Further, to be considered relevant, the survey must be both reliable (in that if it were repeated it would produce the same results) and valid (in that the right questions were put to the right pool of survey participants in the right way and in the right circumstances to produce the evidence sought): *Masterpiece*, above at para 94, citing *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 [*Mattel*] at para 45.

[26] I do not disagree with Tokai that the survey results could have affected the Registrar's consideration, in a material way, of the applicable surrounding circumstances in the confusion analysis under the *TMA* s 6(5). The TMOB Member found, in respect of the 990 Application for example, that the probability of confusion between KING and KINGSFORD was evenly balanced. This meant that because Tokai did not satisfy the onus on it of establishing no likelihood of confusion, on a balance of probabilities, that the TMOB Member had no choice but to find against Tokai: *990 TMOB Decision*, at para 52. An admissible survey could have been a material factor influencing which way the balance should tip, were such a survey before the TMOB for consideration.

[27] In my view, however, there are both reliability and validity issues with the survey conducted by CorbinPartners that negatively affect its admissibility. I add that Mr. Purther's qualifications, the reputation of CorbinPartners, and the impartial and independent conduct of the survey, are not in issue. Nor is there any applicable exclusionary rule.

[28] I find that the online survey conducted in this case highlights the challenges in attempting to simulate a consumer's imperfect recollection at the time when they encounter the products and trademark in issue in the marketplace.

[29] While the Tucker Affidavit explains generally that Tokai manufactures and sells at wholesale to retailers in Canada, it further explains in more detail that Tokai "distributes its products to Wal-Mart Canada Corp., which operates the WALMART chain of department stores in all Canadian provinces." Although the Tucker Affidavit could have been clearer in this regard, I infer from this statement that the Tokai's KING Lighters (utility lighters, namely barbecue and fireplace lighters), are distributed wholesale to Wal-Mart Canada and then sold at the retail level at WALMART stores in Canada. There is no mention that the KING Lighters are sold online. The transcript of Mr. Tucker's re-examination, on the heels of his cross-examination, discloses that KING Lighters are sold only in WALMART stores in Canada.

[30] When asked in cross-examination if he knew what the test for confusion is, Mr. Purther answered generally that he is "well versed in the standards for research purposes that are used to assess confusion." He further explained that "one definition would be that of an individual with an imperfect recollection of the senior mark would see two separate parties as being one and the same[; e]ither affiliated, one sourced by the other and so on."

[31] Although Mr. Purther's explanation of the test is not incorrect, it is incomplete. It is missing the crucial element of "a casual consumer somewhat in a hurry" who sees the name on a

storefront or an invoice: *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 [Veuve] at para 20. In other words, it is missing context.

[32] Paraphrasing *Veuve*, the more complete confusion test is a matter of first impression in the mind of the casual consumer somewhat in a hurry who sees the junior user's name or mark on a storefront, a shelf in the store or an invoice, at a time when they have no more than an imperfect recollection of the senior user's name or mark. Such consumer does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[33] In addition, while the Supreme Court has clarified that subsequent research and care may "unconfuse" a consumer, what is relevant for the *TMA* analysis is the confusion that may have occurred when the consumer first encountered the trademark: *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 [*Masterpiece*] at para 87.

[34] Justice Rothstein (as he then was) noted that surveys have the potential to provide empirical evidence demonstrating consumer reactions in the marketplace, something that generally would not be known to a trial judge and, thus, would not run afoul of the second *Mohan* requirement of necessity: *Masterpiece*, above at para 93.

[35] Justice Rothstein agreed, however, with Justice Binnie's observation in *Mattel* that "often the difficulty with survey evidence is whether it meets the first of the *Mohan* requirements[,] relevance": *Masterpiece*, above at para 94. As further noted by Justice Rothstein, "[s]imulating

an ‘imperfect recollection’ through a series of lead-up questions to consumers will rarely be seen as reliable and valid”: *Masterpiece*, above at para 96. I find this is borne out in the case before me.

[36] In my view, the survey is deficient in four respects: the way in which the term “butane lighters” is used; the discounting or removal of surveys completed too quickly; taking into account surveys completed over a significantly longer period than the 10-minute length indicated for the survey; and notable contextual and other gaps in the effort to simulate the imperfect recollection of a casual consumer in a hurry in an online survey.

“Butane Lighters”

[37] The survey questionnaire itself refers only to “butane lighter(s).” When questioned on cross-examination about whether he did any checking to determine if the term would be understood by participants, Mr. Purther answered that they were comfortable that the phrase was acceptable in describing a lighter, based only on “some initial assessment in on-line investigation to see the usage of ‘butane lighter,’” and because the focal point of the survey was the name King. Participants, however, were not shown a picture of a butane lighter at the outset of the survey.

[38] I find that a lack of common understanding among survey participants as to the meaning of butane lighters (as including both cigarette and utility lighters), could have skewed responses to questions in a way that had a direct impact on CorbinPartners’ analysis of the results. For example, Q2 of the survey questionnaire begins with the question “What do you know, if

anything, about a butane lighter with that brand name [i.e. KING]?” There is space for the participant to type an answer or they could choose the answer “I am not aware of a butane lighter with that brand name.” Someone thinking of butane lighters as cigarette lighters only might have chosen the latter answer, while someone thinking of butane lighters as both cigarette and utility or only utility lighters, and aware of KING utility lighters, might have answered differently.

[39] It was not until the end of the survey when a few final questions were posed to participants to categorize their responses, that participants were alerted to the different types of butane lighters at issue with the following question: “Have you purchased any of the following types of butane lighter products in the last 12 months?” This question was followed by “a. Utility lighter” and “b. Cigarette lighter,” with depictions of these types of lighters, and “c. Other – Please specify.” By that point, however, the questions about the brand KING in the context of a “butane lighter” had been asked already. I note that the detailed report of the survey results, attached as Exhibit “C” to the Further Affidavit, describes that “[p]articipants could not move forward to a subsequent question unless the current question was answered, and **could not return to a previous question once proceeding forward in the survey.**” [Emphasis added.]

[40] In addition, I note Exhibit “A” to the Tucker Affidavit is comprised of representative photographs of Tokai’s KING Lighters (and their packaging) as they have been sold in Canada. The words “Utility Lighter” are fairly prominent underneath the even more prominent word “King” at the top of the package (with a stylized letter “i” depicting a flame where the dot above the “i” normally would appear). While the packaging cautions “DANGER – Extremely Flammable. Contains Flammable Gas Under Pressure,” there does not appear to be any reference

to “butane.” In my view, the casual consumer in a hurry, when confronted with Tokai’s products in the marketplace would see “King” and “Utility Lighter” but likely not much else, even were there a reference to “butane” somewhere on the packaging.

[41] Because the 990 Application covering the goods “cigarette lighters” was based on proposed use, and Tokai did not file any evidence demonstrating the use of KING in association with cigarette lighters in Canada, it is not known how such goods would be presented in the marketplace, if use of the trademark in Canada has commenced.

“Surveys Completed Too Quickly”

[42] When asked in cross-examination if there is a time limit on how long participants can take to answer any particular question, Mr. Purther responded that there is no time limit. He further clarified that they “look out for those that are excessive in their time frame over a couple of days” and they might pull such surveys but that did not happen in this case. He also indicated that, on the other end, “if something is being completed too quickly, someone is straight lining answers [he gave the example of answering C all the way through multiple choice questions], that they would look out to remove that interview as well.”

[43] Although Mr. Purther indicated that they are looking for first impression and do not have an issue with someone giving a first impression (“that’s actually the expectation that’s being made”), they “would look out for someone who is too quickly completing the entire survey.” He further offered that,

“...the research company has a method that they go through where they can see the average time that it’s being done. And if it’s below that certain time, or

significantly below that certain time, that they might remove that interview before we even see it. And keep in mind the research company has no idea what the purpose of the survey is. They are just conducting it based under certain rules.”

[44] Based on this explanation, in my view the research partner did not understand the applicable test for confusion and, therefore, may have removed surveys that in its view, or “under certain rules,” were completed too quickly even though they well may have represented first impressions of a casual consumer somewhat in a hurry.

“Surveys Taking Too Long to Complete”

[45] Next, Mr. Purther was asked on cross-examination the following questions about surveys that took a long time to complete:

6 74 Q. And so how would you be getting a
7 first impression if people are taking hours or days?
8 A. If someone were taking days to
9 complete it, their initial answer to the first
10 question would be a first impression. But you're --
11 if it's -- yes, if it's over days, we have a concern
12 that the survey is not the focus of that individual,
13 and we might remove that for them being disengaged.
14 75 Q. Okay, but hours, any minutes
15 wouldn't be a problem?
16 A. No.

[46] I find that these questions and answers represent the very issue identified by Justice Rothstein in *Masterpiece* (at para 87) of a survey participant who might have been confused on first impression but who could “unconfuse” themselves by taking extra care in answering the questions and/or conducting research. By permitting participants to take hours, instead of 10 or even 20 or 30 minutes, to complete what seems to be a fairly short, straight forward survey, in

my view strays well outside the stated expectation of someone giving a first impression. There is no evidence of how long any of the 707 survey participants took to complete the survey, thus preventing the Court from considering this issue in any more meaningful way.

“Contextual and Other Gaps”

[47] I find that there were at least two contextual gaps in the survey. First, in my view, the manner in which the survey participant was shown the brand name KING online is not reflective of the manner in which the trademark would be encountered in the marketplace in the applicable circumstances (i.e. on packaging or the goods themselves, potentially along side other similar products, such as on a store shelf). For example, the survey questionnaire begins as follows:

Q1. The remainder of this survey pertains to butane lighters. You are about to be shown the brand name of a butane lighter you might buy, and then asked some questions. Please click ‘*CONTINUE*’ to view the name.

[PROGRAMMER: ONCE ‘*CONTINUE*’ HAS BEEN SELECTED, DISPLAY ‘*KING*’ NAME’ FOR UP TO 8 SECONDS AND THEN REMOVE. ALLOW THE RESPONDENT TO CLICK “*CONTINUE*” TO MOVE TO NEXT PAGE BEFORE THAT TIME IF THEY SO CHOOSE. THEN POP-UP THE FOLLOWING QUESTION...]

Were you able to see the brand name?

[48] Based on the above, it appears that the survey participant’s first encounter with the trademark KING would have occurred in isolation from anything else. I find this falls within the validity consideration of whether the right questions have been asked “in the right way in the right circumstances to provide the information sought, i.e. not merely showing a design logo without any context and then subsequently immediately removing it from their site and asking

questions, ...” [emphasis in original]: *Imperial Tobacco Canada Limited v Philip Morris Brands SARL*, 2018 FC 503 at para 59.

[49] In circumstances where a product would normally be purchased in a store, rather than online, it seems more difficult in my view, although not impossible, to simulate the imperfect recollection of a casual consumer in a hurry at the time when they encounter the relevant trademark in the marketplace.

[50] Second, the Purther Affidavit states that, “[t]he percentage of participants who identified a product type offered by Kingsford as being put out by the company who puts out the KING butane lighter is statistically greater for those stating they had previously purchased a butane lighter named KING than those who hadn’t...; [b]y that I mean, someone who stated they had previously purchased a KING lighter was more likely to identify those lighters with Kingsford, as compared to someone who had not previously purchased a KING lighter.”

[51] The survey was conducted and the results were analyzed in terms of participants who previously had purchased a KING lighter or those who had not made such a purchase. The survey failed to account for those participants who, although they may not have purchased a KING lighter previously, nonetheless were aware of KING lighters having encountered them in the marketplace or even in some other context. In other words, there appears to have been an assumption, unjustified in my view, that participants who had not previously purchased a KING lighter were not familiar with them.

[52] Kingsford advocates another gap regarding the restriction of the survey to butane lighters, lighter fluid, barbecue lighters, charcoal and charcoal briquettes. In other words, the survey and subsequent analysis did not consider the full scope of the goods covered in the 953 application and the 990 application and in the KINGSFORD registrations, all of which, in Kingsford's view are relevant to the confusion analysis. On cross-examination, Mr. Purther indicated that the survey was restricted to narrower than what Kingsford sells or has in their registrations based on the investigation that they did; those were the core goods CorbinPartners found. Apart from Mr. Purther's testimony, however, there is little evidence of the investigation conducted by CorbinPartners in this regard. Further, in my view the goods, barbecue grills for example, listed in registration number TMA386,771 for KINGSFORD, could have been relevant as well, although this may not have impacted the survey results perceptibly.

[53] I conclude that all the above deficiencies in the survey evidence cumulatively render it unreliable and invalid, and hence, inadmissible in the circumstances.

(ii) Third Party Marks

[54] Although Tokai's new evidence of the Third Party Marks is reliable, based on the certified copies submitted and on the operation of the *TMA* s 54, I find for the reasons below that such evidence is not sufficiently significant or of probative value that it would have influenced the TMOB or had a material effect on the TMOB Member's reasoning in each case.

[55] In this appeal, Tokai argues that KING and KINGSFORD are inherently weak trademarks, contrary to the 953 *TMOB Decision* (paras 35-38), the 990 *TMOB Decision* (paras

31-34), and the Court's decision in *Tokai FC 2018* (paras 31-32). In support of this position, Tokai relies on the eleven (11) Third Party Marks and argues that their coexistence means no single entity can claim strong rights in or to the element KING. This in turn signifies, according to Tokai, that the KINGSFORD trademarks are weak and, thus, comparatively small differences will serve to distinguish them. Further, because Kingsford has not filed evidence that it has used its trademarks, Tokai argues that prior use and advertising of the KINGSFORD trademarks (which has not been evidenced) has not sufficiently enhanced their distinctiveness so as to entitle them to a broad scope of protection.

[56] The Third Party Marks constitute state of the register evidence in these proceedings. State of the register evidence generally may be relevant to the extent that it enables the trier to draw inferences regarding the state of the marketplace: *McDowell v Laverana GmbH & Co KG*, 2017 FC 327 [*McDowell*] at para 42. The trier may be inclined to draw inferences about state of the marketplace, however, only where there is evidence of a large number of relevant registrations. In theory, an element that is common in the marketplace may have little distinctiveness, thus causing consumers to pay greater attention to small differences (i.e. other features) between and among trademarks containing or comprised of that element: *McDowell*, above at para 42; *Alticor Inc v Nutravite Pharmaceuticals Inc*, 2004 FC 235 [*Alticor*] at para 59, citing *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA) [*Kellogg*].

[57] In *Alticor*, the state of the register evidence demonstrated in excess of 100 relevant registrations of trademarks with the prefix NUTR, while in *Kellogg*, there were in excess of 50 relevant trademark registrations and more than 40 trade names involving NUTRI. In *McDowell*,

however, the state of the register evidence involved just seven owners of 10 registered trademarks that included HONEY as a dominant component. Confronted with this evidence, the Court held that it was insufficient to find HONEY common to the trade (and hence, non-distinctive), absent evidence of common use in the marketplace by third parties: *McDowell*, above at para 44.

[58] In considering Tokai's state of the register evidence, I note that there are nine owners of 11 registered and applied for trademarks containing KING or KINGS for goods involving lighters. I find this state of the register evidence in line with the evidence considered by the Court in *McDowell*. In other words, the number of trademarks is insufficient to draw any inferences about the state of the marketplace, especially in the absence of any demonstrated marketplace use: *McDowell*, above at para 46, citing *Hawke & Company Outfitters LLC v Retail Royalty Co*, 2012 FC 1539 at para 40.

(b) *Kingsford's New Evidence*

[59] I find that only the certified copies of the seven (of eight) KINGSFORD registrations, attached as Exhibit "F" to the Golverk Affidavit, constitute new evidence in this appeal but that such evidence is not material.

[60] Before the TMOB, Kingsford provided evidence of the particulars of its eight KINGSFORD registrations via the Affidavits of Elenita Anastacio [Anastacio Affidavits]. Attached as an exhibit to each of the Anastacio Affidavits were printouts of the full registration particulars from the *CD NameSearch* Canadian Trademarks Database. The TMOB exercised the

Registrar's discretion to confirm that the KINGSFORD registrations are in good standing: 953 *TMOB Decision*, at para 29; and 990 *TMOB Decision*, at para 25.

[61] Notwithstanding the evidentiary advantage afforded certified copies of documents in the Registrar's official custody (i.e. that they are evidence of the facts set out in the documents), I am not persuaded that in the circumstances they would have had any significant or probative value in the sense that they would have affected the TMOB's decisions materially. In my view, the TMOB's conclusions regarding the factor of the extent and length of use, in the likelihood of confusion analysis, turned not so much on the lack of certified copies. Rather, the TMOB's findings regarding this factor were based primarily on Kingsford's lack of evidence of actual use in Canada and, in the case of the 953 *TMOB Decision*, on the fact that several of the registrations for its KINGSFORD trademarks are based solely on use and registration in the United States of America.

[62] Further, the TMOB noted expressly that, "even if the Opponent had provided certified copies of its registrations, and I had given at least *de minimis* weight to the date of use claimed... this would not affect my finding on this factor": 990 *TMOB Decision*, above at para 41. While the TMOB's reasoning on this point is less explicit in the 953 *TMOB Decision*, considering the decisions holistically, I find that the same reasoning may be inferred. In my view, it is apparent that the TMOB Member turned their mind to such evidence, and found that it would have no effect on their conclusions.

D. *No Palpable and Overriding Errors*

[63] Because I find the parties' new evidence on appeal either inadmissible or immaterial, and because in my view there are no extricable questions of law in issue, the applicable standard of review in this matter is palpable and overriding error. This is "an even more deferential standard of review than the standard of reasonableness": *Clorox*, above at para 38.

[64] Tokai's concession does not absolve the Court from reviewing the decisions for any palpable and overriding errors. For the reasons below, I am not persuaded that the TMOB erred.

[65] The main issue for the Court's consideration in this regard is whether the TMOB, on behalf of the Registrar, made any palpable and overriding errors in finding a likelihood of confusion in each case, and not whether the Court would have come to a different conclusion based on the record before the TMOB.

[66] Paragraph 12(1)(d) of the *TMA* provides that a trademark is registrable if it is not confusing with a registered trademark. The material date for assessing confusion under this provision is the date of the decision of the trier of fact. Because I find the parties' new evidence is either inadmissible or immaterial, the applicable relevant date is the date of the TMOB's decisions, namely, October 31, 2018. Such date falls well before June 17, 2019 when significant amendments to the *TMA* came into force. In my view, the amendments to *TMA* s 12 have little, if any, impact on the *TMA* s 12(1)(d) analysis.

[67] Further, subsection 6(2) of the *TMA* provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[68] Having regard to the Supreme Court decisions *Veuve* and *Masterpiece*, as well as the Federal Court of Appeal decision in *Reynolds Presto Products Inc v PRS Mediterranean Ltd*, 2013 FCA 119 [*Reynolds*] at para 20, I find an apt articulation of the test to be applied in assessing the likelihood of confusion in this case to be as follows. As a matter of first impression, would the casual consumer, somewhat in a hurry, who sees a good bearing Tokai's trademark KING, when that consumer first encounters the trademark KING in the marketplace, and where the consumer has no more than an imperfect recollection of any one of Kingsford's trademarks and does not pause to give the matter any detailed consideration or scrutiny, be likely to be confused as to the source of the goods? In other words, would the casual consumer believe the goods associated with KING and KINGSFORD respectively were authorized, licensed, manufactured or sold by the same person, that is, by Kingsford?

[69] Subsection 6(5) of the *TMA* describes the following specific factors to be considered in the confusion analysis, in the context of "all the surrounding circumstances":

- (a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;
- (b) the length of time the trademarks or trade names have been in use;
- (c) the nature of the goods, services or business;
- (d) the nature of the trade; and

- (e) the degree of resemblance between the trademarks or trade names in appearance or sound or in the ideas suggested by them.

[70] These factors are not exhaustive, and may be weighed differently, in a context-specific assessment; the onus is on Tokai in this case to demonstrate no likelihood of confusion on a balance of probabilities: *Mattel*, above at para 54. The degree of resemblance, however, “is the statutory factor that is often likely to have the greatest effect on the confusion analysis”: *Masterpiece*, above at para 49. This factor involves a consideration of the totality of the trademarks, but the “first impression, imperfect recollection” test means that the trademarks must not be assessed side by side.

[71] Although the first element of the trademark often is the most important, for the purposes of distinctiveness (*Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD), at 188 *per* Cattnach J), a preferable approach when assessing the degree of resemblance is to consider whether there is an aspect of the trademark that is striking or unique: *Masterpiece*, above at para 64. The degree of resemblance factor recognizes that trademarks with some differences still may result in likely confusion: *Masterpiece*, above at para 62.

[72] The lack of significant difference between the goods also is an important consideration that must be weighed and balanced with the other factors including, most importantly, the resemblance between the marks: *Reynolds*, above at paras 17 and 29. That said, there is “a greater likelihood of confusion if two trade-marks that resemble each other are used in association with the same products (or substantially the same products)”: *Reynolds*, above at para 30.

[73] With these principles in mind, I next consider each of the TMOB's decisions.

(1) *953 TMOB Decision*

[74] Only the ground of opposition based on the *TMA* s 12(1)(d) is in issue in the appeal of the *953 TMOB Decision*, Kingsford having been unsuccessful regarding the grounds based on the *TMA* sections 16(1)(a), 16(1)(c), 2, 30(b) and 30(i).

[75] The TMOB considered that Kingsford's strongest case was its word mark KINGSFORD (registration numbers TMA195,651; TMA344,604; TMA386,771), which was the primary focus of the TMOB's confusion analysis. If there were no finding of a likelihood of confusion between these marks, it is unlikely confusion would be found between KING and the other two registered design marks, the dominant element of which, in any event, is KINGSFORD. In my view, this kind of focusing is in line with the approach adopted in *Masterpiece*, above at para 61.

[76] The TMOB then distilled the test for confusion to one of first impression and imperfect recollection with reference to subsections 6(2) and 6(5), as well as to *Masterpiece* and *Mattel* regarding the possibility of attributing unequal weight to the factors enumerated in the latter subsection. I discern no palpable and overriding error in the TMOB's focus on Kingsford's word mark and the formulation of the applicable test for assessing confusion.

[77] I turn next to the enumerated *TMA* s 6(5) factors considered by the TMOB.

(a) *Inherent Distinctiveness*

[78] I am not convinced that the TMOB committed a palpable and overriding error in the analysis of inherent distinctiveness. The TMOB found that both KING and KINGSFORD have a

“fair degree of inherent distinctiveness” given that there is no clear link between the goods associated with each trademark and the trademark itself. Contrary to this finding and as noted above, Tokai argues that the marks are inherently weak, and hence, comparatively small differences will serve to distinguish them. This argument is premised, however, on the Third Party Marks that I have found insufficiently significant and of no probative value.

[79] Further, “[m]arks are inherently distinctive when nothing about them refers the consumers to a multitude of sources[; w]here a mark may refer to many things or... is only descriptive of the wares... less protection will be afforded.” *United Artists Pictures Inc v Pink Panther Beauty Corp*, [1998] 3 FC 534 (FCA) at para 23. Neither KING nor KINGSFORD is descriptive of the applicable goods, and the TMOB Member agreed with Kingsford that there was no evidence in the record to suggest otherwise. I therefore find no palpable and overriding error in the TMOB’s conclusion that this factor favours neither party.

(b) *Extent Known and Length of Time in Use*

[80] The TMOB combined the analysis of the extent to which the trademarks have become known (the *TMA* s 6(5)(a)), or acquired distinctiveness, with the assessment of the length of time the marks have been in use (the *TMA* s 6(5)(b)), and concluded this blended factor slightly favours Tokai. I discern no palpable and overriding error in the conclusion nor in the analysis.

[81] The TMOB found that the trademark KING had become known to some extent in Canada, albeit not significantly, because of evidence of its use since 2010 based on the Tucker Affidavit. The TMOB noted that, conversely, Kingsford filed no evidence of use of the

KINGSFORD trademarks nor certified copies of the applicable registrations. The TMOB thus attributed no weight to the allegation of use in Canada since at least June 1, 1953 in registration number TMA195,651, further noting that registration numbers TMA344,604 and TMA386,771 are based solely on use and registration in the United States. The TMOB concluded that the presumption of *de minimis* use flowing from evidence of registration, had it been filed, would not have affected the conclusion that this factor slightly favours Tokai.

[82] Kingsford argues that it is entitled to the presumption of *de minimis* use of the KINGSFORD trademarks in Canada in association with the various goods covered by the registrations dating back to June 1, 1953. I note that only registration numbers TMA195,651 and TMA196,359 are based on use in Canada as of such date and currently cover charcoal and charcoal lighters.

[83] In support of its argument, Kingsford relies on the TMOB decision in *Monster, Inc v Mattel, Inc*, 2014 TMOB 197 [*Monster*]. This decision indeed holds that a presumption of *de minimis* use may be drawn “based on the date of first use mentioned in the certificates of registration”: *Monster*, above at para 34. The TMOB also noted in the latter case, however, that the presumption “cannot give rise to an inference of significant use”: *Monster*, above at para 34. Further, as I noted above, it is apparent that the TMOB Member in the case before me considered whether the outcome would be different, were they to assume *de minimis* use, and held that they still would find this factor slightly favours the Applicant. In the circumstances, I thus am not convinced that the TMOB committed a palpable and overriding error in its determination regarding this factor.

(c) - and - (d) *Nature of the Goods, Trade and Business*

[84] The TMOB combined its analyses of these factors in its decision and found that they favour Kingsford. Again, I discern no palpable and overriding errors in this conclusion, nor in the analyses.

[85] The TMOB Member found a close relationship between the “nature of the parties’ goods,” having regard to the goods listed in the 953 Application (barbeque and fireplace lighters) and the KINGSFORD registrations on which they focused, namely registration numbers TMA195,651 (charcoal and charcoal lighters), TMA344,604 (barbecue sauce), and TMA386,771 (barbecue grills). They noted that a copy of the KING Lighter’s product packaging, comprising Exhibit “A” to the Tucker Affidavit, depicts a utility lighter being used to light charcoal on a barbecue and indicates that the lighter is ideal for lighting “barbecues/charcoal or gas grills” and “fireplaces.”

[86] In my view, the TMOB did not err in the assessment of the nature of goods. Further, I note that Tokai acknowledged in its appeal that there is some connection between the nature of the parties’ goods.

[87] The *TMA* s 6(2) encompasses the possibility of likely confusion even if the products are not of the same general class: see also *Mattel*, above at para 65. I agree with the TMOB that Tokai’s goods - barbecue and fireplace lighters - are closely related to Kingsford’s products, being charcoal, charcoal lighters, grills, charcoal briquettes, and various other products ancillary

or related to barbecuing or grilling. Although the parties' respective goods are not identical, the likelihood of confusion may be heightened where the goods in issue are of such a nature that they often are used together: *Empresa Cubana Del Tabaco v Tequila Cuervo SA Dec V*, 2013 FC 1010 at paras 40-43, aff'd 2015 FCA 15. Tokai's goods, as illustrated in the copy of the KING Lighter packaging, are intended for use in barbecuing or grilling.

[88] Regarding the nature of the trade, the TMOB concluded that the parties' goods could travel through the same channels of trade. The TMOB noted that neither the 953 Application nor the KINGSFORD registrations contain any restrictions in terms of the channels of trade. Further, the absence of evidence regarding the channels of trade through which Kingsford's goods would travel, coupled with the close relationship between the nature of the parties' goods, led the TMOB to conclude that there is a significant likelihood that the channels of trade overlap, despite Tokai's evidence that the KING Lighters are sold exclusively to Wal-Mart. Tokai argues that Kingsford's lack of evidence should not be permitted to bolster a conclusion that the parties' goods could travel through the same channels of trade. I disagree, primarily because there are no restrictions as to the channels of trade in the 953 Application nor in Kingsford's registrations.

[89] In my view, the TMOB's reasoning is consistent with other TMOB decisions, and therefore does not constitute a palpable and overriding error: see for example, *Les Promotions Atlantique Inc. v Warimex Waren-Import Export Handels GmbH*, 2016 TMOB 179 at para 45; *SA Damm v Hijos De Rivera, SA* 2015 TMOB 230 at para 41; *3M Company v Integrity Supply Incorporated*, 2015 TMOB 136 at para 35. Further, Tokai ultimately bears the onus in the confusion analysis, and I find it failed to demonstrate that there was no likelihood that its goods

would travel through the same channels of trade as those of Kingsford. Given the similarities in the nature of the parties' respective products, no restrictions as to channels of trade in the 953 Application and the KINGSFORD registrations, and no evidence from Kingsford regarding the applicable channels of trade, I am not convinced the TMOB was wrong to conclude that these factors strongly support a likelihood of confusion.

(e) *Degree of Resemblance*

[90] The TMOB found a fair degree of resemblance between the parties' trademarks, noting that: the whole of the trademark KING is incorporated into KINGSFORD; KING appears in the dominant first position of the parties' trademarks; and there are some visual, phonetic and connotative similarities. The Registrar cites the *739 TMOB Decision*, in which the TMOB found a fair degree of resemblance between KING and KINGSFORD for similar reasons. In my view, the TMOB did not err in its conclusion nor its reasoning regarding this factor.

[91] As the Supreme Court observed in *Masterpiece*, the resemblance analysis "can be approached by considering only those characteristics that define the relevant trade-marks or trade-name. It is only these elements that will allow consumers to distinguish": *Masterpiece* at para 61. Resemblance refers to "the quality of being either like or similar", and does not require that the marks be identical: *Masterpiece* at para 62. In my view, here the word or element KING, in addition to being the sole or first element of the parties' trademarks, is the "particularly striking or unique" part of the marks: *Masterpiece*, at para 64.

[92] I find that the TMOB appropriately considered the visual, phonetic and connotative similarities, with the dominant position of the word KING in the KINGSFORD trademarks. As noted above, I cannot agree with Tokai that these marks are inherently weak, so much so that the addition of SFORD to KINGSFORD is sufficient to distinguish the marks. In my view, when considered in their totality, there is a marked resemblance between the parties' trademarks in appearance (visual similarities), sound (phonetic similarities) and in the ideas (connotation) suggested. I thus cannot find that the TMOB erred in its determination of this factor.

(d) *Additional Surrounding Circumstances*

[93] The Applicant invoked two additional surrounding circumstances in support of its appeal, namely: i) the existence of the Third Party Marks; and ii) survey evidence in the form of the Further Affidavit showing, on a balance of probabilities, that there is no likelihood of confusion. Because I have found the evidence of Third Party Marks immaterial, for the purposes of establishing that the parties' trademarks are weak as argued by Tokai, and the survey evidence inadmissible, I will not give any further consideration to these asserted surrounding circumstances.

[94] For completeness, I note that neither party has advanced arguments about whether the Registrar erred in concluding the lack of actual confusion, despite an apparent lengthy period of co-existence, is not a significant factor in this case. I find Justice Manson's reasoning on this point (*Tokai FC 2018*, above at para 22), as cited by the TMOB in its decision, equally applicable to the circumstances in the matter before me. In particular, Mr. Tucker testified in his cross-examination that there was no specific mechanism for bringing customer complaints of

confusion to his attention. There also was no evidence that he otherwise would have been aware of such complaints by reason of his corporate position. Further, absent evidence of extensive concurrent use, the adverse inference that otherwise might be drawn where the opponent provides no evidence of actual confusion, cannot be drawn in the matter before me: *Christian Dior, SA v Dion Neckwear Ltd*, 2002 FCA 29 at para 19.

(g) *Overall Assessment Regarding the Likelihood of Confusion*

[95] In my view, the TMOB's cumulative assessment of the above factors, in the context of the applicable surrounding circumstances, supports the conclusion that Tokai has failed to discharge its burden, for the 953 Application, to show no likelihood of confusion, on a balance of probabilities. I find particularly compelling the strong findings with respect to the "close relationship" between the parties' goods, and the "fair degree of resemblance" between the parties' respective trademarks. Having regard to the guidance in *Reynolds*, above, this combination of factors results in a "greater likelihood" of confusion. In sum, I find no palpable and overriding errors in respect of the *953 TMOB Decision*.

(2) *990 TMOB Decision*

[96] Similarly, only the ground of opposition based on the *TMA* s 12(1)(d) is in issue in the appeal of the *990 TMOB Decision*, Kingsford having been unsuccessful regarding the grounds based on the *TMA* sections 16(3)(a), 16(3)(c), 2, and 30(i).

[97] Overall, I am not convinced that the TMOB committed any palpable and overriding errors in its determinations on the *TMA* 6(5) factors. In applying the test for confusion to the 990 Application, I note that the relevant circumstances differ regarding the factors of the extent to which the trademarks are known and length of use, as well as the nature of the goods, trade and business, as discussed below.

(a) *Inherent Distinctiveness*

[98] The TMOB again found a fair degree of resemblance between the parties' trademarks, with the same rationale as in the case of the *953 TMOB Decision*, and concluded that this factor favours neither party. Given that the marks themselves are the same, KING and KINGSFORD, I find no error in this approach. The only substantial difference is the TMOB's reference, in the *990 TMOB Decision*, to the findings of some inherent distinctiveness in the *739 TMOB Decision* and the *Tokai FC 2018* decision.

(b) *Extent Known and Length of Time in Use*

[99] The TMOB's analysis focused on Kingsford's lack of evidence of actual use, and lack of certified copies of its KINGSFORD registrations on which it sought to rely via printouts of the registrations from the Canadian trademarks database attached to the Anastacio Affidavit as an exhibit. The TMOB Member, referring to *Tokai FC 2018* at para 35, assigned no weight to the June 1, 1953 use date claimed in registration number TMA195,651 for KINGSFORD.

[100] Further, the TMOB noted that even if Kingsford had filed certified copies, and *de minimis* weight were given to the 1953 date, it would not change the Member's finding regarding this factor. Because the 990 Application is based on proposed use, and because Tokai filed no evidence that the trademark KING had been used in Canada with cigarette lighters, the TMOB concluded that this factor favours neither party.

[101] Although I might have found differently – that is, that the factor slightly favoured Kingsford – had certified copies been filed so that *de minimis* weight could be given to the 1953 use date, the fact remains that no certified copies were filed. Nonetheless, the TMOB Member turned their mind to such evidence, and found that even if Kingsford had provided certified copies, it would have had no effect on their conclusions. I thus am not convinced the TMOB committed a palpable and overriding error in the circumstances.

(c) - and - (d) *Nature of the Goods, Trade and Business*

[102] The TMOB held that the goods in the 990 Application, cigarette lighters may be considered to have some “basic connection” with Kingsford's charcoal lighters, both goods comprising a type of lighter. Although the relationship in this case may not be as close as in the case of the utility lighters at issue in the *953 TMOB Decision*, nonetheless as noted above, the *TMA* s 6(2) encompasses the possibility of likely confusion even if the relevant products are not of the same general class. Thus, in my view, the application of the palpable and overriding error standard does not warrant intervention with the TMOB's findings on this issue.

[103] In addition, because of the lack of restriction as to the channels of trade applicable to the goods in the 990 Application and in the KINGSFORD registrations, and absent any evidence from either party regarding the channels of trade, the TMOB was unable to conclude that there would be no potential for overlap in their respective channels of trade. No new evidence was submitted on appeal directed to this issue. In the circumstances, I am not persuaded that the TMOB made any palpable and overriding error in its determination of this issue.

(e) *Degree of Resemblance*

[104] The TMOB arrived at the same conclusion on this factor in this case, as in the *953 TMOB Decision*. The TMOB found a fair degree of resemblance between the parties' trademarks, noting that: the whole of the trademark KING is incorporated into KINGSFORD; KING appears in the dominant first position of the parties' trademarks; and there are some visual, phonetic and connotative similarities. For the above reasons, I similarly cannot find that the TMOB erred in its determination of this factor in the circumstances.

(f) *Overall Assessment Regarding the Likelihood of Confusion*

[105] In my view, the TMOB's cumulative assessment of the above factors, in the context of the applicable surrounding circumstances, supports the conclusion that the probability of confusion between KING and KINGSFORD is evenly balanced between a finding of confusion and no confusion. This means that because the onus was on Tokai to establish no likelihood of confusion, on a balance of probabilities, that the issue must be decided against Tokai. Given that the connection between the goods is not as strong in this case, but nonetheless there is still some

connection, given the lack of evidence regarding the applicable channels of trade, noting that they are not restricted in the 990 Application and the KINGSFORD registrations, and given the fair degree of resemblance, I am unable to discern any palpable and overriding errors in the TMOB's overall assessment of likely confusion.

IV. CONCLUSION

[106] On the first matter at issue, because I find the parties' new evidence on appeal either inadmissible or immaterial, and because in my view there are no extricable questions of law in issue, the applicable standard of review in this matter is palpable and overriding error, *per* the appellate standard set out in *Housen*.

[107] Neither Tokai nor Kingsford convinced me that the TMOB committed any palpable and overriding errors in respect of any of its assessments of the *TMA* s 6(5) factors in either the 953 *TMOB Decision* or the 990 *TMOB Decision*. Accordingly, I am of the view that none of those findings should be disturbed, and thus, Tokai's appeals must fail.

[108] Having regard to the parties' submissions on costs at the hearing of this matter, I exercise my discretion to award Kingsford lump sum costs in the amount of \$5,000, inclusive of disbursements, legal fees and taxes.

JUDGMENT in T-17-19

THIS COURT'S JUDGMENT is that:

1. The Applicant's appeals under subsection 56(1) of the *Trademarks Act* of the Registrar's decisions in this matter, having citations 2018 TMOB 126 and 2018 TMOB 127, are dismissed.
2. The Applicant shall pay costs to the Respondent in the amount of \$5,000, inclusive of disbursements, legal fees and taxes.

"Janet M. Fuhrer"

Judge

Annex “A”: Relevant Provisions***Trademarks Act, RSC 1985, c T-13 - Version from 2018-12-30 to 2019-06-16***

<p>Definitions</p> <p>distinctive, in relation to a trade-mark, means a trade-mark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them; (distinctive)</p>	<p>Définitions</p> <p>distinctive Relativement à une marque de commerce, celle qui distingue véritablement les produits ou services en liaison avec lesquels elle est employée par son propriétaire, des produits ou services d’autres propriétaires, ou qui est adaptée à les distinguer ainsi. (distinctive)</p>
<p>When mark or name confusing</p> <p>6 (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.</p> <p>Idem</p> <p>(2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.</p> <p>...</p>	<p>Quand une marque ou un nom crée de la confusion</p> <p>6 (1) Pour l’application de la présente loi, une marque de commerce ou un nom commercial crée de la confusion avec une autre marque de commerce ou un autre nom commercial si l’emploi de la marque de commerce ou du nom commercial en premier lieu mentionnés cause de la confusion avec la marque de commerce ou le nom commercial en dernier lieu mentionnés, de la manière et dans les circonstances décrites au présent article.</p> <p>Idem</p> <p>(2) L’emploi d’une marque de commerce crée de la confusion avec une autre marque de commerce lorsque l’emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les produits liés à ces marques de commerce sont fabriqués, vendus, donnés à bail ou loués, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces produits ou ces services soient ou non de la même catégorie générale.</p> <p>...</p>
<p>What to be considered</p> <p>(5) In determining whether trade-marks or trade-names are confusing, the court or the</p>	<p>Éléments d’appréciation</p> <p>(5) En décidant si des marques de commerce ou des noms commerciaux créent de la</p>

<p>Registrar, as the case may be, shall have regard to all the surrounding circumstances including</p> <ul style="list-style-type: none"> (a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known; (b) the length of time the trademarks or trade names have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them. 	<p>confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :</p> <ul style="list-style-type: none"> a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus; b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage; c) le genre de produits, services ou entreprises; d) la nature du commerce; e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux, notamment dans la présentation ou le son, ou dans les idées qu'ils suggèrent.
<p>When trademark registrable</p> <p>12 (1) Subject to section 13, a trade-mark is registrable if it is not</p> <p>...</p> <ul style="list-style-type: none"> (d) confusing with a registered trademark; <p>...</p>	<p>Marque de commerce enregistrable</p> <p>12 (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :</p> <p>...</p> <ul style="list-style-type: none"> d) elle crée de la confusion avec une marque de commerce déposée; <p>...</p>
<p>Registration of marks used or made known in Canada</p> <p>16 (1) Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with goods or services is entitled, subject to section 38, to secure its registration in respect of those goods or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with</p>	<p>Enregistrement des marques employées ou révélées au Canada</p> <p>16 (1) Tout requérant qui a produit une demande selon l'article 30 en vue de l'enregistrement d'une marque de commerce qui est enregistrable et que le requérant ou son prédécesseur en titre a employée ou fait connaître au Canada en liaison avec des produits ou services, a droit, sous réserve de l'article 38, d'en obtenir l'enregistrement à l'égard de ces produits ou services, à moins que, à la date où le requérant ou son prédécesseur en titre l'a en premier lieu ainsi</p>

<p>(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;</p> <p>(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or</p> <p>(c) a trade-name that had been previously used in Canada by any other person.</p>	<p>employée ou révélée, elle n'ait créé de la confusion :</p> <p>a) soit avec une marque de commerce antérieurement employée ou révélée au Canada par une autre personne;</p> <p>b) soit avec une marque de commerce à l'égard de laquelle une demande d'enregistrement avait été antérieurement produite au Canada par une autre personne;</p> <p>c) soit avec un nom commercial qui avait été antérieurement employé au Canada par une autre personne.</p>
<p>Proposed marks</p> <p>(3) Any applicant who has filed an application in accordance with section 30 for registration of a proposed trade-mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the goods or services specified in the application, unless at the date of filing of the application it was confusing with</p> <p>(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;</p> <p>(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or</p> <p>(c) a trade-name that had been previously used in Canada by any other person.</p>	<p>Marques projetées</p> <p>(3) Tout requérant qui a produit une demande selon l'article 30 en vue de l'enregistrement d'une marque de commerce projetée et enregistrable, a droit, sous réserve des articles 38 et 40, d'en obtenir l'enregistrement à l'égard des produits ou services spécifiés dans la demande, à moins que, à la date de production de la demande, elle n'ait créé de la confusion :</p> <p>a) soit avec une marque de commerce antérieurement employée ou révélée au Canada par une autre personne;</p> <p>b) soit avec une marque de commerce à l'égard de laquelle une demande d'enregistrement a été antérieurement produite au Canada par une autre personne;</p> <p>c) soit avec un nom commercial antérieurement employé au Canada par une autre personne.</p>
<p>Contents of application</p> <p>30 An applicant for the registration of a trade-mark shall file with the Registrar an application containing</p> <p>...</p>	<p>Contenu d'une demande</p> <p>30 Quiconque sollicite l'enregistrement d'une marque de commerce produit au bureau du registraire une demande renfermant :</p> <p>...</p>

<p>(b) in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of goods or services described in the application;</p> <p>...</p> <p>(i) a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the goods or services described in the application.</p>	<p>b) dans le cas d'une marque de commerce qui a été employée au Canada, la date à compter de laquelle le requérant ou ses prédécesseurs en titre désignés, le cas échéant, ont ainsi employé la marque de commerce en liaison avec chacune des catégories générales de produits ou services décrites dans la demande;</p> <p>...</p> <p>i) une déclaration portant que le requérant est convaincu qu'il a droit d'employer la marque de commerce au Canada en liaison avec les produits ou services décrits dans la demande.</p>
<p>When applications to be refused</p> <p>37 (1) The Registrar shall refuse an application for the registration of a trade-mark if he is satisfied that</p> <p>(a) the application does not conform to the requirements of section 30,</p> <p>(b) the trade-mark is not registrable, or</p> <p>(c) the applicant is not the person entitled to registration of the trade-mark because it is confusing with another trade-mark for the registration of which an application is pending,</p> <p>and where the Registrar is not so satisfied, he shall cause the application to be advertised in the manner prescribed.</p>	<p>Demandes rejetées</p> <p>37 (1) Le registraire rejette une demande d'enregistrement d'une marque de commerce s'il est convaincu que, selon le cas :</p> <p>a) la demande ne satisfait pas aux exigences de l'article 30;</p> <p>b) la marque de commerce n'est pas enregistrable;</p> <p>c) le requérant n'est pas la personne qui a droit à l'enregistrement de la marque de commerce parce que cette marque crée de la confusion avec une autre marque de commerce en vue de l'enregistrement de laquelle une demande est pendante.</p> <p>Lorsque le registraire n'est pas ainsi convaincu, il fait annoncer la demande de la manière prescrite.</p>
<p>Statement of opposition</p> <p>38 (1) Within two months after the advertisement of an application for the registration of a trade-mark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar.</p> <p>Grounds</p>	<p>Déclaration d'opposition</p> <p>38 (1) Toute personne peut, dans le délai de deux mois à compter de l'annonce de la demande, et sur paiement du droit prescrit, produire au bureau du registraire une déclaration d'opposition.</p> <p>Motifs</p>

<p>(2) A statement of opposition may be based on any of the following grounds:</p> <ul style="list-style-type: none"> (a) that the application does not conform to the requirements of section 30; (b) that the trade-mark is not registrable; (c) that the applicant is not the person entitled to registration of the trade-mark; or (d) that the trade-mark is not distinctive. <p>...</p> <p>Decision</p> <p>(8) After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application or reject the opposition and notify the parties of the decision and the reasons for the decision.</p>	<p>(2) Cette opposition peut être fondée sur l'un des motifs suivants :</p> <ul style="list-style-type: none"> a) la demande ne satisfait pas aux exigences de l'article 30; b) la marque de commerce n'est pas enregistrable; c) le requérant n'est pas la personne ayant droit à l'enregistrement; d) la marque de commerce n'est pas distinctive. <p>...</p> <p>Décision</p> <p>(8) Après avoir examiné la preuve et les observations des parties, le registraire repousse la demande ou rejette l'opposition et notifie aux parties sa décision ainsi que ses motifs.</p>
<p>Appeal</p> <p>56 (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.</p> <p>...</p> <p>Additional evidence</p> <p>(5) On an appeal under subsection (1), evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.</p>	<p>Appel</p> <p>56 (1) Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l'avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit avant, soit après l'expiration des deux mois.</p> <p>...</p> <p>Preuve additionnelle</p> <p>(5) Lors de l'appel, il peut être apporté une preuve en plus de celle qui a été fournie devant le registraire, et le tribunal peut exercer toute discrétion dont le registraire est investi.</p>

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-17-19

STYLE OF CAUSE: TOKAI OF CANADA LTD v THE KINGSFORD
PRODUCTS COMPANY, LLC

PLACE OF HEARING: TORONTO, ONTARIO (VIA VIDEOCONFERENCE)

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JUDGMENT AND REASONS: FUHRER J.

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APPEARANCES:

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