

Federal Court



Cour fédérale

Date: 20220603

Docket: T-1026-21

Citation: 2022 FC 813

Ottawa, Ontario, June 3, 2022

PRESENT: Mr. Justice McHaffie

BETWEEN:

BUNZL IP HOLDINGS, LLC

Applicant

and

WINNIPEG PANTS & SPORTSWEAR MFG. LTD.

Respondent

JUDGMENT AND REASONS

I. Overview

[1] Bunzl IP Holdings, LLC appeals the decision of the Trademarks Opposition Board, as delegate of the Registrar of Trademarks, refusing in part its application to register the trademark WORKHORSE, Application No 1,622,829. Bunzl applied to register the WORKHORSE mark in association with a variety of work and safety-related goods. Winnipeg Pants & Sportswear Mfg Ltd [WPS] opposed Bunzl's application on the basis of its own WORKHORSE trademark, TMA267040, used and registered in association with *Men's and boys' clothing, namely, parkas,*

jackets. The Registrar granted WPS's opposition in part, refusing Bunzl's application as it related to what the Registrar termed "clothing" or "clothing-related" goods including fire-retardant coveralls, aprons, socks, and work gloves, but allowing the application for "wearable specialized safety equipment" goods such as hardhats and "non-wearable" goods such as first aid kits: *Winnipeg Pants & Sportswear Mfg Ltd v Bunzl IP Holdings, LLC*, 2021 TMOB 80.

[2] Bunzl appeals the Registrar's decision pursuant to section 56 of the *Trademarks Act*, RSC 1985, c T-13, asking that its entire trademark application be allowed. In support of its appeal, Bunzl has filed new evidence regarding its use of the WORKHORSE trademark.

[3] For the reasons that follow, I allow the appeal in part, direct the Registrar to allow Bunzl's application as it relates to various *work glove* goods and *socks*, and dismiss the appeal as it relates to the other goods at issue. I conclude that Bunzl's new evidence is material to some of the Registrar's conclusions, and that I should apply the correctness standard of review in respect of those issues, while applying the palpable and overriding error standard to issues unaffected by the new evidence. Considering the new evidence as well as the evidence that was before the Registrar, I conclude there is no likelihood of confusion on the relevant material dates with respect to the *work glove* goods and *socks*, but that there is a likelihood of confusion in respect of the other goods at issue.

II. Issues

[4] Bunzl's appeal raises the following issues:

- A. Does the further evidence filed by Bunzl affect the standard of review of the Registrar's decision?
- B. Applying the appropriate standard of review, should the Court interfere with the Registrar's decision?

[5] The parties' submissions, and particularly those of WPS, focus on the first issue. However, both issues must be addressed for the disposition of this appeal.

III. Analysis

A. *Standard of Review*

(1) Applicable principles

[6] On a section 56 appeal from a decision of the Registrar, parties may adduce additional evidence and this Court may exercise any discretion vested in the Registrar: *Trademarks Act*, s 56(5). As set out recently by the Federal Court of Appeal, the nature of the evidence filed on an appeal, if any, affects the applicable standard of review: *Clorox Company of Canada, Ltd v Chloretec SEC*, 2020 FCA 76 at paras 18–30.

[7] The Court must first determine whether any new evidence on the appeal would have materially affected the Registrar's decision: *Clorox* at para 19, citing *Monster Cable Products, Inc v Monster Daddy, LLC*, 2013 FCA 137 at para 4. To meet this standard, the evidence must be material in the sense of being "sufficiently substantial and significant" and of "probative value": *Clorox* at para 21, citing *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707 at para 27 and *Tradition Fine Foods Ltd v Group Tradition'l Inc*, 2006 FC 858 at para 58. It cannot simply repeat prior evidence or supplement or confirm the Registrar's findings: *Seara Alimentos Ltda v Amira Enterprises Inc*, 2019 FCA 63 at para 24; *Caterpillar Inc v Puma SE*, 2021 FC 974 at para 33. The assessment includes consideration of the "nature, significance, probative value, and reliability of the parties' new evidence, in the context of the record": *Caterpillar* at para 36, citing *Seara* at paras 23–26. However, it is simply a preliminary assessment to determine if the Court will have to reassess the evidence, and not an up-front determination of whether it will ultimately change the result or outcome: *Seara* at para 23; *Smart Cloud Inc v International Business Machines Corporation*, 2021 FC 236 at para 48.

[8] If there is no evidence that meets this standard, the Court will review the Registrar's decision using the usual appellate standards, namely "palpable and overriding error" for questions of fact and questions of mixed fact and law, and "correctness" for questions of law, including those extricable from questions of mixed fact and law: *Clorox* at para 23; *Housen v Nikolaisen*, 2002 SCC 33 at paras 8–37. If there is new material evidence, the Court will apply the correctness standard to the Registrar's decision, conducting an appeal *de novo*: *Clorox* at paras 18, 21. However, even where there is new material evidence, this does not necessarily

displace the Registrar's findings on every issue, but only those issues to which the new evidence speaks: *Seara* at para 22; *Caterpillar* at para 36; *Smart Cloud* at paras 48, 62.

[9] To assess the materiality of the new evidence filed in this proceeding, it is necessary to review the trademark application at issue, the Registrar's decision, and the evidence that Bunzl puts forward on this appeal.

(2) The trademark application and opposition

[10] In April 2013, Bunzl applied to register the trademark WORKHORSE as a word mark, for use in association with certain goods. After amendments made during prosecution, the goods identified in the application are the following:

First aid kits; protective safety equipment, namely, hard hats, safety glasses, safety goggles, ear plugs for soundproofing, face protection, namely, face shields not for medical purposes, respirators other than for artificial respiration, face masks not for medical purposes, and protective gloves for industrial use; protective clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons for protection against fire; protective clothing treated with retardants for wear by welders, grinders, and mechanics for protection against flames, sparks and fire; hearing protection headsets, not for medical use, radio-compatible hearing protection headsets, not for medical use; back support belts for workers; protective industrial boots; protective headgear, namely, hard hats and protective helmets; safety traffic cones; knee pads for workers; dust masks, rubber molded boots; protective sleeves; poly and pvc sleeves; protective aprons; protective aprons made of poly, neoprene coated and pvc; safety boots; mesh safety gloves; disposable bags; tool bags; general purpose rubber and plastic gloves for domestic use; general work clothing, namely, general work gloves, namely, cotton gloves, cotton and leather gloves and leather gloves; latex gloves, rubber gloves, vinyl gloves and polyvinyl chloride gloves, nitrile gloves, poly gloves; socks; rainwear, namely, rain suits, pants, hats, boots, and hip and chest waders for use in connection

with fishing and hunting; clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons; outdoor winter clothing, namely, gloves, coveralls, overalls, bib pants, pants, ear muffs; hairnets; all of the goods in the application for work and safety purposes.

[11] Bunzl's application, which was filed prior to amendments to the *Trademarks Act* that came into force in 2019, claimed that the trademark had been used in Canada "since at least as early as December 31, 2000."

[12] WPS opposed Bunzl's application on five grounds. Two of these, pertaining to conformity with section 30 of the *Trademarks Act*, were rejected by the Registrar and are not in issue on this appeal. The remaining three each relate to allegations that Bunzl's WORKHORSE trademark was confusing with WPS's registered trademark for WORKHORSE, TMA267040. WPS's WORKHORSE trademark is registered for use in association with *Men's and boys' clothing, namely, parkas, jackets*. At the time the opposition was filed, the registration also included *vests*, but this good was expunged following a 2019 decision of the Registrar under section 45 of the *Trademarks Act*.

[13] The three grounds of opposition that remain at issue are (1) under paragraphs 38(2)(b) and 12(1)(d) of the *Trademarks Act*, Bunzl's mark is not registrable since it is was confusing, at the date of the Registrar's decision, with WPS's registered trademark; (2) under paragraph 38(2)(c) and subsection 16(1) of the *Trademarks Act*, Bunzl is not the person entitled to registration since, at the date of first use of the trademark, it was confusing with WPS's registered trademark which had been previously used in Canada in association with the goods in the registration; and (3) under paragraph 38(2)(d) and section 2 of the *Trademarks Act*, the

trademark was not distinctive and was not capable of being distinctive of Bunzl's goods, since it was likely to be confused with WPS's trademark.

[14] I pause to note that subsection 70(1) of the *Trademarks Act* provides that Bunzl's application, which was advertised before the 2019 amendments, is to be dealt with and disposed of in accordance with the former legislation, subject to amendments to section 6 and other sections that are not at issue. In particular, subsection 38(2) of the *Trademarks Act*, setting out available grounds of opposition, should be applied as it stood before the amendments:

Trademarks Act, s 70(1)(a).

[15] In support of its opposition, WPS filed an affidavit from its Chief Financial Officer, Kareina Turton. Bunzl responded with a statutory declaration from its Vice-President, Safety, Dave Huck. However, Mr. Huck's declaration was later removed from the record after Bunzl failed to make Mr. Huck available for cross-examination. The Registrar's decision was therefore made based on Ms. Turton's affidavit and without any supporting evidence from Bunzl. Ms. Turton's affidavit referred to Bunzl's other registered trademarks, which include two WORKHORSE-related marks, namely WORK HORSE BRAND & Design, TMA276839, and WORKHORSE & Design, TMA899392. It also contained some information regarding Bunzl's website, WPS's awareness of sales of certain WORKHORSE-branded Bunzl products in 2014, and samples of purchases of Bunzl products in 2015. However, it otherwise contained little information regarding Bunzl's use of the WORKHORSE trademark.

(3) The Registrar's decision

[16] The Registrar treated the goods listed in Bunzl's application as belonging in four general categories, listed in order of their proximity to the *jackets* and *parkas* in WPS's registration:

(1) "clothing" goods, covering fire-retardant-treated clothing (*pants, shirts, bib overalls, coveralls, and aprons*), *rainwear* and *outdoor winter clothing*; (2) "clothing-related" goods, covering various types of *boots, work gloves, and protective aprons*, as well as *socks* and *hairnets*; (3) "wearable specialized safety equipment," such as *hard hats* and *hearing protection headsets*; and (4) "non-wearable" goods, such as *first aid kits* and *disposable bags*. The Registrar concluded on the evidence before them that there was a reasonable likelihood of confusion with respect to the first two categories, but not the final two.

[17] In reaching this conclusion, the Registrar applied the test for confusion under subsection 6(2) of the *Trademarks Act* as interpreted in the jurisprudence, and took into consideration the relevant surrounding circumstances, including those listed in subsection 6(5) of the *Trademarks Act*: *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54.

[18] The Registrar's consideration of the degree of resemblance of the marks under paragraph 6(5)(e) of the *Trademarks Act* was understandably brief, noting that the two WORKHORSE trademarks are identical. No evidence was needed for this assessment. However, in considering the other subsection 6(5) factors, the Registrar made repeated reference to the lack

of evidence from Bunzl. In particular, the Registrar made the following observations during the course of their reasons regarding the confusion factors:

- in assessing the extent to which the trademarks had become known [paragraph 6(5)(a)]: “[...] even if I were to accept use of the Applicant’s By Workhorse Design Mark as use of the Mark – and notwithstanding the claimed use since 2000 – I otherwise have no evidence of the extent to which the Mark has become known in Canada”;
- in assessing the length of time in use [paragraph 6(5)(b)]: “[a]gain, notwithstanding the claimed date of first use of 2000, the evidence of use of the Mark is limited and dates back to 2014 at best”;
- in assessing the nature of the goods or business [paragraph 6(5)(c)]: “in the absence of evidence relating to the nature of each of the applied-for goods and given the Applicant’s onus, I have erred towards considering an applied-for good to fall within this second category”;
- in assessing the state of the register and marketplace as surrounding circumstances [subsection 6(5)]: “there is no evidence regarding the extent to which the Applicant’s Registered Trademarks have been used or become known in Canada”;
- in addressing the overall likelihood of confusion in respect of certain clothing-related goods: “[u]ltimately, absent evidence from the Applicant, I do not consider the limitation ‘all of the goods in the application for work and safety purposes’ sufficient to necessarily distinguish such goods from those of the Opponent” [emphasis added throughout].

[19] These assessments formed part of the Registrar's conclusions that the factors in paragraphs 6(5)(a) and (b) favoured WPS, that the factors in paragraphs 6(5)(c) and (d) favoured WPS in respect of the "clothing" and "clothing-related" goods, and that Bunzl's registered trademarks were not a significant surrounding circumstance. I agree with Bunzl that on the Registrar's own analysis, the absence of evidence from Bunzl on these issues was a material part of their confusion analysis.

(4) Bunzl's new evidence on appeal

[20] In support of its appeal to this Court, Bunzl filed a solemn declaration from Dave Huck pursuant to subsection 56(5) of the *Trademarks Act* and Rule 306 of the *Federal Courts Rules*, SOR-98/106, which I will refer to as his affidavit. Mr. Huck is the son of John Huck, the founder of McCordick Glove, a division of Martin & Stewart Inc. Through a number of corporate evolutions, that business ultimately became Bunzl. Mr. Huck started working at his father's business in his mid-teens and has worked full-time with Bunzl or its predecessors since he was 18 years old in 1984.

[21] Mr. Huck's affidavit speaks to the corporate history of Bunzl; its use of the trademark WORKHORSE or WORK HORSE in association with work gloves, said to have started in 1979 and continued through the present; its later use of WORKHORSE in association with socks, rainwear, and other safety products; the designs used by Bunzl in association with the WORKHORSE mark, which have included drawings of a work horse as seen in its WORK HORSE BRAND & Design and WORKHORSE & Design trademark registrations; its marketing and labelling materials, including its website; its customers and channels of trade; its

sales of WORKHORSE marked goods, including sales estimates where sales records were unavailable; and its trademark applications and registrations. Mr. Huck also gives his evidence that he is not aware of any instances of actual confusion between Bunzl's products and those of WPS throughout his time with Bunzl.

(5) Bunzl's new evidence is material

[22] WPS did not cross-examine Mr. Huck on his affidavit. However, it challenges Mr. Huck's evidence as irrelevant and unreliable, and argues the evidence does not meet the standard for materiality set out in *Clorox*, *Seara* and *Caterpillar*. For the following reasons, I disagree.

(a) *Significance and probative value of the new evidence*

[23] Mr. Huck's affidavit speaks directly to matters relevant to the confusion analysis on which the Registrar noted the lack of evidence from Bunzl. This included the length and extent of use of the WORKHORSE mark by Bunzl and information about its products. This is new and relevant information that does not simply repeat prior evidence. To the contrary, it provides evidence in a number of areas where there was previously none.

[24] WPS argues Mr. Huck's evidence is not relevant or probative because it focuses on design elements not included in the word mark applied for; it refers to Bunzl's other trademark registrations; and it refers to WPS's use of another trademark, TOUGH DUCK. I disagree. While some aspects of Mr. Huck's affidavit have less direct relevance, this does not render the evidence

as a whole irrelevant or immaterial. In my view, it was appropriate for Mr. Huck's evidence regarding Bunzl's historical use of the trademark to identify the manner in which the mark was used over time, including design elements, even though the mark applied for is a word mark. As for the TOUGH DUCK trademark, I read Mr. Huck's evidence to respond to Ms. Turton's statement, cited by the Registrar, that Bunzl and WPS sell their products at some of the same stores. Mr. Huck stated that to his knowledge, when WPS competed with Bunzl in the work clothing sector, it used the TOUGH DUCK mark and not the WORKHORSE mark. This is relevant evidence to the assessment of the channels of trade.

[25] WPS also contends that Bunzl's new evidence is not probative or material because it does not affect key determinations made by the Registrar in the confusion analysis. In particular, it points to the following conclusion of the Registrar:

With respect to the "outdoor winter clothing", "rainwear", and two types of applied-for "pants, shirts, bib overalls[,] coveralls, and aprons", on a balance of probabilities, I find that there is a reasonable likelihood of confusion between the Mark and the Opponent's Trademark. I reach this conclusion due to the resemblance between the trademarks, the overlap in the general nature of the parties' goods, the overlap in the parties' channels of trade, and notwithstanding the specialized nature of the applied-for goods.

[Emphasis added.]

[26] This paragraph relates to the goods the Registrar categorized as "clothing" goods. WPS argues that since the Registrar said they based their decision on the factors underlined above, Bunzl's evidence with respect to length and extent of use cannot affect the decision. I cannot accept this argument. The Registrar clearly set out each of the subsection 6(5) factors and addressed them in their confusion analysis. They referred to the evidence, or lack thereof, in

respect of each factor and their conclusions with respect to them. In this context, I read the statement reproduced above to mean the Registrar considered the identified factors to be particularly important in the confusion analysis with respect to the “clothing” goods based on the evidence before them. Indeed, it would be an error on the part of the Registrar if they had reached their conclusion based only on some subsection 6(5) factors without consideration of the others: *Group III International Ltd v Travelway Group International Ltd*, 2017 FCA 215 at para 34. A fair reading of the Registrar’s decision as a whole indicates they did not make such an error.

[27] In any event, to the extent the Registrar did not consider issues such as the length of use or the extent to which the marks are known, this does not mean that new evidence on those factors could not affect the analysis. The confusion analysis takes into account all factors under subsection 6(5). The Registrar may consider a factor less significant when, or because, there is no evidence on it. New and material evidence speaking to the factor may influence the significance of the factor and ultimately the outcome of the confusion analysis.

(b) *Reliability of the new evidence*

[28] WPS also argues Mr. Huck’s affidavit does not meet the materiality threshold because it is not reliable. As noted above, part of the preliminary assessment of evidence for materiality is a preliminary assessment of its reliability: *Caterpillar* at paras 36, 42. WPS points to the lack of documentary support for some of Mr. Huck’s evidence, the period of time it covers, and certain inconsistencies in the evidence. While there does appear to be one clear error in Mr. Huck’s

evidence, WPS has not convinced me that Mr. Huck's evidence is insufficiently reliable to constitute material evidence.

[29] As a preliminary comment, I accept WPS's submission that the fact that it did not cross-examine Mr. Huck on his affidavit does not, of itself, preclude it from raising issues with reliability that arise on the face of that evidence: see, *e.g.*, *Exeter v Canada (Attorney General)*, 2015 FCA 260 at para 9; *Caterpillar* at paras 30–31, 42; *Doyle Salewski Inc v Scott*, 2019 ONSC 5108 at paras 25–32. However, the decision not to cross-examine remains relevant to the assessment of evidence, and to the strength of arguments that a witness is unreliable and not credible, particularly in the absence of contradictory evidence: see, *e.g.*, *SSE Holdings, LLC v Le Chic Shack Inc*, 2020 FC 983 at para 58, citing *Harley-Davidson Motor Company Group, LLC v Manoukian*, 2013 FC 193 at para 37. Indeed, the first paragraph of WPS's memorandum of fact and law states that "it is important to note that the Applicant did not cross-examine Turton on her affidavit." The same can be said of Mr. Huck's affidavit.

[30] WPS's challenge to Mr. Huck's evidence begins with its observation that the evidence in Mr. Huck's affidavit goes back over 40 years, to when he was a young teenager. It argues such evidence, without documentary support, is unreliable. I see no reason why Mr. Huck should be unable to accurately recall aspects of his early years working for his father's company. Without any cross-examination on his affidavit, I am not prepared to conclude that Mr. Huck's evidence is unreliable simply because it speaks to matters from decades past.

[31] I note in this regard that Ms. Turton's affidavit, filed on behalf of WPS, similarly purports to state that WPS "has manufactured and sold vests, parkas, jackets, bib pants, overalls and coveralls [...] in association with the trade-marks WORKHORSE or WORK HORSE since at least October 31, 1980" and that such products "have been manufactured and sold in Canada by WPS every year since 1980." This statement is made without supporting documentary evidence from the 1980s even though Ms. Turton was not associated with the company until 2012. While Ms. Turton refers to WPS's trademark registration, her statements regarding use go beyond that registration. As WPS points out, this evidence was accepted by the Registrar as "uncontroverted" and that finding of fact is not challenged before this Court. However, WPS's criticisms of Mr. Huck's direct and personal evidence based on its age and lack of early documents are less persuasive in the context of its own evidence and its decision not to cross-examine Mr. Huck.

[32] WPS also criticizes the financial records attached to Mr. Huck's affidavit, noting the sales records do not state how the WORKHORSE trademark was marked on the goods or packaging, while representative sales invoices were reprinted from Bunzl's computer system in a manner that includes its current corporate name rather than its corporate name at the time the invoices were originally issued. Neither of these criticisms is persuasive. Mr. Huck explained the nature of the sales records in the body of his affidavit, stating that the product numbers in the documents related to WORKHORSE work gloves. He also addressed in his affidavit how the trademark was marked on goods, such that the absence of such information in the printout of sales records itself is not determinative.

[33] Mr. Huck similarly explained why Bunzl's computer system printed the invoices with the new corporate name. He did not purport to present them as original invoices, but as a reproduction of the invoices printed from Bunzl's computer records. Archived paper copies of original invoices might have been more direct evidence. However, an assessment of the evidence must take into account modern commercial realities. There is no evidence that the printed invoices are anything other than a reflection of the actual information in Bunzl's computer records, reflecting actual sales and invoices issued by Bunzl. Again, Mr. Huck was not cross-examined on any of these issues. I therefore reject WPS's contention that these invoices have been "altered" or "adulterated" in a way that affects their reliability or that of Mr. Huck's evidence more generally.

[34] I similarly reject WPS's contention that Mr. Huck went beyond his actual knowledge in his statements about the lack of actual confusion. To the contrary, Mr. Huck's affidavit expressly states that his evidence about the lack of actual confusion is "to my knowledge," and refers to his personal awareness based on his own experience and discussions with his father and others in the company. WPS's argument is unfounded on a plain reading of Mr. Huck's affidavit.

[35] At the hearing of this appeal, WPS raised three arguments not identified in their written submissions. As a general rule, this Court will be loath to entertain such arguments, although it retains a discretion to do so: *Rouleau-Halpin v Bell Solutions Techniques Inc*, 2021 FC 177 at para 33; *Vancouver Fraser Port Authority v GCT Canada Limited Partnership*, 2021 FCA 183 at paras 15–16; *Diaz Castillo v Canada (Citizenship and Immigration)*, 2021 FC 1118 at para 17; *SCDA (2005) Inc v Canada*, 2017 FCA 177 at paras 18–23. Bunzl did not object to these

arguments and was able to respond to them at the hearing. None of them persuade me that Mr. Huck's evidence as a whole is unreliable.

[36] The first of these arguments is based on McCordick Glove's application for its WORK HORSE BRAND & Design trademark, which WPS argues contradicts Mr. Huck's statement that use of WORKHORSE began in 1979. That trademark application was filed in December 1980 on the basis of proposed use, and an affidavit of use was filed in October 1982 in respect of *Work gloves, namely cotton gloves, cotton leather gloves, leather gloves, rubber and polyvinyl chloride gloves.*

[37] Under the *Trademarks Act* as it then stood, a trademark application could be filed based on past use or, if it had not yet been used, based on proposed use. WPS submits that an incorrect filing basis could have invalidated the trademark, or at least been a ground of opposition: see, *e.g., Société Nationale Elf Aquitaine v Spex Design Inc*, [1988] TMOB No 282. It therefore argues it is more likely that McCordick Glove's trademark agent filed the application on the correct basis, and that Mr. Huck is wrong about the date of first use. While this is an interesting argument, I agree with Bunzl that this is not an invalidation proceeding and that WPS has not sought to invalidate Bunzl's registered trademark, even assuming it could. I have no evidence before me of the contents of the affidavit of use or the basis for the decision to file on proposed use, and no cross-examination of Mr. Huck in which this question was put to him for explanation or response. In any case, the issue is not the validity of Bunzl's other trademark application, but the date on which it first used the WORKHORSE mark in Canada. With respect to that issue, I am left with the evidence of Mr. Huck from his personal knowledge that use began in 1979, and

nothing more than a potential point of cross-examination to the contrary. In the circumstances, I cannot conclude this renders Mr. Huck's evidence unreliable or affects its materiality.

[38] The second new argument relates to a picture of a McCordick Glove catalogue showing the WORK HORSE BRAND & Design mark. Mr. Huck states the catalogue dates from 1979. WPS notes that the catalogue refers to "McCordick Glove Inc," a company Mr. Huck says was incorporated after McCordick Glove first started operations as a division of Martin & Stewart Inc. Bunzl's registration for the WORK HORSE BRAND & Design mark shows that assignment of the trademark from Martin & Stewart Inc to McCordick Glove Inc was not recorded until 1984. Again, however, in the absence of any evidence as to the actual date of incorporation of McCordick Glove Inc, or any cross-examination that might help explain the corporate reference or otherwise confirm the date of the catalogue, I am left with Mr. Huck's challenged but uncontradicted statement that the catalogue is from 1979. This is particularly so since this issue was raised for the first time at the hearing.

[39] The third argument pertains to an exhibited picture of a trade show, which Mr. Huck labelled as "1995 Trade Show." As WPS points out, the picture shows work gloves on display, one of which carries a label saying "New 2004." I agree with WPS that given this reference, and even without cross-examination, the picture on its face appears to date from the mid-2000s and not from 1995. However, I cannot agree with WPS that this example shows more than an apparent error or oversight on Mr. Huck's part, particularly given that Bunzl's presence at trade shows in the 1990s or 2000s is not of central relevance in this matter. While the photo appears not to be from 1995 as Mr. Huck labelled it, I do not agree with WPS that this error, either alone

or in combination with the other issues raised by WPS, undermines the reliability of Mr. Huck's evidence as a whole.

[40] I therefore do not accept WPS's allegations that Mr. Huck's evidence is a "self-serving reconstruction of events," or that Mr. Huck shaped the evidence to meet his narrative. In the absence of cross-examination, and on the few examples WPS identifies, such allegations are unjustified.

(c) *Conclusion*

[41] In summary, in light of the nature, significance, probative value, and reliability of Mr. Huck's affidavit, I am satisfied there is sufficiently substantial and significant new evidence that would have affected the Registrar's decision. I will therefore review the decision of the Registrar on the issues to which the evidence speaks on a correctness standard, effectively conducting an appeal *de novo* on those issues. That said, as discussed further below, there are a number of issues, and a number of goods listed in the application, on which there is no new evidence. On such issues, I will apply the deferential appellate standard of palpable and overriding error to the Registrar's decision: *Caterpillar* at paras 35–36; *Smart Cloud* at paras 47–48, 62.

B. *Merits of the Appeal on the Applicable Standard*

[42] WPS's memorandum of fact and law filed on this appeal focuses exclusively on the credibility and materiality of Mr. Huck's evidence, making no alternative submissions regarding

the merits of the appeal if that evidence was accepted as reliable and material. At the hearing, WPS made the alternative submission that the Court should uphold the Registrar's decision even if the new evidence was found to be material. However, in WPS's submission, the appeal ultimately turns on Mr. Huck's affidavit and whether it is material.

[43] While I have concluded that the new evidence filed by Bunzl in the form of Mr. Huck's affidavit is material, this simply changes the standard on which the Registrar's decision is reviewed. It does not predetermine the outcome of the appeal or the confusion analysis relevant to WPS's grounds of opposition. The Court must still assess the grounds of appeal in light of the evidence as it now stands.

[44] The grounds of opposition under appeal each rely on the existence of confusion between WPS's WORKHORSE trademark and the WORKHORSE trademark applied for by Bunzl. There is no dispute between the parties that the relevant test for confusion is that set out in subsection 6(2) of the *Trademarks Act*, namely whether the use of both trademarks in the same area would be likely to lead to the inference that the goods associated with the trademarks are manufactured or sold by the same person, whether or not the goods are of the same general class or appear in the same class of the Nice Classification. In assessing confusion, all surrounding circumstances are considered, including those set out expressly in subsection 6(5) of the *Trademarks Act*. The test is applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the mark in association with the applied-for goods at a time when they have no more than an imperfect recollection of the opponent's trademark and does not pause to give the matter detailed consideration or scrutiny: *Veuve Clicquot* at para 20.

(1) Unaffected findings of the Registrar

[45] A number of the Registrar's findings remain unaffected by the new evidence. The first pertains to the resemblance between the marks. As the Registrar found, the parties' trademarks are identical, which favours a finding of confusion.

[46] The second pertains to inherent distinctiveness. The Registrar found the parties' WORKHORSE trademarks to be not entirely arbitrary, but rather "suggestive of clothing that is durable." Mr. Huck's evidence that his father adopted the mark "to express the durability and strength of the gloves" simply reinforces the Registrar's conclusion. Trademarks that are suggestive of the product sold have lower inherent distinctiveness; they are considered weak marks and are afforded a narrower range of protection: *Clorox* at para 46; *Man and His Home Ltd v Mansoor Electronics Ltd*, 1999 CanLII 7603 (FC) at para 14; *Distribution Prosol PS Ltd v Custom Building Products Ltd*, 2015 FC 1170 at paras 42–45.

[47] The Registrar's findings with respect to WPS's use of its trademark are similarly unaffected by the new evidence. Ms. Turton put forward evidence of WPS's use of the WORKHORSE trademark, sometimes appearing as WORK HORSE, and often appearing in association with a graphic element showing a locomotive. The Registrar accepted that WPS had used its mark since October 1980 in association with parkas and jackets, and accepted that WPS's use of WORK HORSE alone or with the locomotive design constituted use of its WORKHORSE trademark. The Registrar also found there was "evidence of significant sales of WORK HORSE-branded parkas and jackets to various retailers [...] as well as some evidence of

advertising in association with [WPS's] Trademark." How these findings in turn affect the acquired distinctiveness factor in light of the new evidence from Bunzl is addressed below.

[48] As discussed below, the Registrar's findings with respect to Bunzl's use of the WORKHORSE trademark in association with certain goods are also unaffected by Mr. Huck's evidence, since that evidence does not speak to all of the goods listed in the application.

(2) Length of time the trademarks have been in use

[49] As found by the Registrar and not challenged by Bunzl, WPS started using the trademark WORKHORSE in association with parkas and jackets in October 1980.

[50] On the basis of Mr. Huck's affidavit, I accept that Bunzl, through its predecessors in title, started using the trademark WORKHORSE in association with work gloves in 1979. I am satisfied that Bunzl's use of its WORK HORSE BRAND & Design trademark and its WORKHORSE & Design trademark constitutes use of the WORKHORSE word mark. The public, as a matter of first impression would perceive the use of WORK HORSE or WORKHORSE in combination with the design elements as being use of the WORKHORSE mark *per se* given its predominance in the design marks: *Caterpillar* at para 101; *Nightingale Interloc Ltd v Prodesign Ltd*, [1984] TMOB No 52, 2 CPR (3d) 535 at para 7; *Rothmans, Benson & Hedges, Inc v Imperial Tobacco Products Limited*, 2015 FCA 111 at para 6. The Registrar reached this conclusion with respect to WPS's use of its design mark and I agree with Bunzl that the same applies with respect to Bunzl's use of its design marks.

[51] Mr. Huck's affidavit provides the following evidence regarding the dates on which Bunzl began using WORKHORSE on the other goods at issue in the trademark application:

- Bunzl's expansion into work clothing such as rainwear and accessories such as safety goggles and other safety products came after the use on work gloves;
- the mark was used in association with socks in the "first decade" between 1979 and 1989, with exhibits identifying the trademark being used on socks in the 1983 to 1995 time period and thereafter;
- Bunzl's registration for the WORK HORSE BRAND & Design mark was amended to add "*socks; rainwear namely, hats, capes, coats, pants, boots; safety products, namely safety glasses, ear protection, face protection, namely masks*" after a declaration of use was filed in May 1992, and the mark was used on these goods, as well as work gloves, in the "second decade" between 1990 and 1999 and thereafter;
- beginning in 1995 or 1996, Bunzl expanded its product offerings sold in association with the WORKHORSE trademark in the "safety category," such as eye goggles, ear protectors, and face protectors, as well as traffic vests;
- Bunzl began using WORKHORSE on fire retardant coveralls, gloves and blankets in the "third decade" between 2000 and 2009, and later filed the WORKHORSE & Design mark in respect of these and other goods based on use since at least as early as 2000;
- also in this "third decade", Bunzl's sales materials show use of the trademark STORM FIGHTER BY WORKHORSE in association with rainwear, including rain

suits, jackets and pants, and rainwear made of “flame resistant” material (although not material “treated with fire retardants”);

- in the “fourth decade” between 2010 and 2020, Bunzl used the WORKHORSE mark on fire retardant clothing and other safety and protection products, in addition to gloves and socks.

[52] Beyond the reference in his affidavit to use of WORKHORSE “fire retardant coveralls, gloves and blankets” and the general reference to “fire retardant clothing,” Mr. Huck provides no evidence as to the date that Bunzl first used the WORKHORSE trademark on particular items of protective clothing, notably (i) *protective clothing treated with fire retardants, namely pants, shirts, bib overalls [...] and aprons for protection against fire*; (ii) *clothing treated with fire retardants, namely pants, shirts, bib overalls [...] and aprons*; (iii) *protective clothing treated with retardants for wear by welders, grinders, and mechanics for protection against flames, sparks and fire*; and (iv) *protective aprons; protective aprons made of poly, neoprene coated and pvc*. There is similarly no new evidence regarding Bunzl’s use of WORKHORSE in association with *rainwear, namely [...] hip and chest waders for use in connection with fishing and hunting*; in association with *outdoor winter clothing, namely [...] coveralls, overalls, bib pants, pants, ear muffs*; or in association with *hairnets*.

(3) Acquired distinctiveness

[53] As noted above, the Registrar concluded WORKHORSE was a suggestive mark.

However, given the evidence from Ms. Turton regarding WPS’s sales, and in the absence of

evidence from Bunzl, the Registrar concluded that the “extent to which the parties’ trademarks have become known” was a factor that favoured WPS.

[54] Mr. Huck’s affidavit provides new evidence of the extent to which Bunzl’s WORKHORSE trademark has been used and become known in Canada. This comes largely in the form of sales data and estimates, as well as information regarding Bunzl’s customer base among retailers and industrial customers. In particular, Mr. Huck presented a list of annual sales from 1979 to 2020, showing growth from \$350,000 in sales in 1979 to \$8 million in 1989, and continuing to grow to \$82 million in 2020.

[55] The sales data presented from 1979 to at least 2010, as well as some of the data from the subsequent period, are said to be estimates or approximations based on incomplete records, handwritten notes, and “the best of our knowledge.” Caution must therefore be exercised in placing too much reliance on these figures. However, in the absence of any cross-examination, I accept that Mr. Huck is able to provide at least a general approximation of sales over the years, as his ongoing involvement in the company would give him the ability to assess the company’s growth. In any event, the more recent sales data are drawn from computerized sales records, and shows that Bunzl has grown over time to the point that it is now selling tens of millions of dollars of product annually. Mr. Huck does not purport to break these sales down between work gloves and other products such as socks or the other products identified in the application, although it appears from the sales records and representative invoices that the majority of these sales are sales of work gloves.

[56] Ms. Turton's affidavit, accepted by the Registrar as showing "significant sales of WORK HORSE-branded parkas and jackets," similarly involves some reconstruction of earlier years, given the unavailability of accounting records. She gave evidence of total net sales in the period from 1998 to 2000 of slightly over \$500,000, and of net annual sales between 2009 and 2017 ranging between \$1.3 million (recorded in 2010) and \$338,000 (recorded in 2017). Jackets, parkas, and vests appear to represent about half of these sales.

[57] In my view, this evidence shows that Bunzl's WORKHORSE trademark has developed significant acquired distinctiveness in connection with its work gloves, with some acquired distinctiveness associated with other products. As the Registrar concluded, WPS's WORKHORSE trademark has also developed some acquired distinctiveness in association with its jackets and parkas as a result of its significant sales. With respect to each, however, it must be recognized that this acquired distinctiveness was being developed concurrently over a lengthy period of time while both parties had their different goods in the marketplace. This limits the extent to which this acquired distinctiveness could expand the scope of protection afforded to marks that are not inherently distinctive: *Distribution Prosol* at para 44. This is particularly so since the parties were apparently aware of each other, Bunzl having been a customer of WPS from at least 2009 to 2017.

(4) The nature of the goods, business, and trade

[58] Bunzl sought to distinguish its goods from those of WPS on the basis that its products are work and safety products catering to industrial and hazardous environments, while WPS offers "consumer" parkas and jackets for boys and men. I agree with WPS that the evidence does not

support Bunzl's distinction. While some of Bunzl's work gloves shown in the evidence appear to be for heavier industrial use, they also include "light duty" cotton gloves, gardening gloves, and rubber gloves for painting, cleaning, and dishwashing. Indeed, Bunzl's application includes *general purpose rubber and plastic gloves for domestic use*. The socks displayed similarly show a range of work socks. Bunzl's application does limit its full list of goods with the qualifier "all of the goods in the application for work and safety purposes." However, neither this limitation nor the evidence indicates that Bunzl's goods are limited to industrial or hazardous contexts as opposed to work and safety products for consumer or home use.

[59] Conversely, Ms. Turton's evidence shows sales of WORK HORSE parkas that include a "removable hard hat hood," suggesting some degree of workplace or industrial usage. The Registrar concluded that WPS's products "appear to be directed, at least in part, to workwear retailers" and I can see no palpable and overriding error in this conclusion. As the Registrar pointed out, WPS's registration for use in association with *Men's and boys' clothing, namely parkas, jackets*, contains no limitation and could cover both parkas for personal use and for use at an industrial workplace.

[60] With respect to the nature of the trade, there is no basis to disturb the Registrar's findings. Relying only on Ms. Turton's affidavit, the Registrar concluded there was evidence that the parties' goods are sold by the same third-party retailers. Mr. Huck's evidence confirms this, showing long-standing sales to TSC Stores, and listing glove sales to Peavey Mart, Rona, Red Apple, Federated Co-op, and Giant Tiger, all retailers that also sell WPS's WORKHORSE products. In this regard, while Mr. Huck states that to his knowledge, WPS competed with Bunzl

using the TOUGH DUCK mark and not the WORKHORSE mark, this evidence is not sufficient to overcome Ms. Turton's uncontroverted evidence, accepted by the Registrar, that WPS sells WORKHORSE products through the foregoing retailers.

[61] Nonetheless, there remain differences in the parties' goods. As the Registrar noted, none of the goods Bunzl applies for are specifically parkas or jackets. Ms. Turton recognizes this in her affidavit, indicating that the work gloves and safety products identified in Bunzl's WORK HORSE BRAND & Design registration and those in its WORKHORSE & Design registration are "not overlapping with the [WPS] WORKHORSE Products." I have no basis to disturb the Registrar's finding that these statements "do not amount to an admission that there is no confusion," they remain relevant evidence regarding how these goods are viewed in the particular business and trade of the parties.

[62] I will address the specific differences between the parties' goods further below in assessing the overall likelihood of confusion.

(5) Actual confusion

[63] WPS correctly argues that the relevant inquiry is whether there is a likelihood of confusion, and not whether there has been actual confusion in the marketplace: *Trademarks Act*, s 6(2). There is no requirement for WPS as opponent to Bunzl's application to demonstrate actual confusion. However, evidence of actual confusion, or the absence of such confusion despite extensive concurrent use, may be a relevant surrounding circumstance "to be thrown in the hopper": *Mattel* at paras 55, 90.

[64] In the present case, the evidence is that the coincidental use by Bunzl of WORKHORSE in association with work gloves and by WPS of WORKHORSE in association with parkas and jackets, including through sales to and by some of the same retailers, has continued since 1980. The same is true after the introduction of Bunzl's socks in around 1983 and rainwear in the 1990s. Mr. Huck's evidence is that to his knowledge, there has never been an instance of actual confusion in the form of a retailer, wholesaler, purchaser for a facility, or individual end user inferring a relationship between Bunzl and WPS or, for example, complaining to Bunzl about a defect in a WPS product or vice versa. Ms. Turton gives no evidence of actual confusion. This does not rule out the possibility that there was actual confusion that went unreported, and it is not determinative of the issue of a possibility of confusion. The lack of confusion may also be in part attributable to the parties' respective use of associated designs. However, given the lengthy period of sales without any identified instances of actual confusion, I agree with Bunzl that it is a relevant surrounding circumstance for consideration, particularly as it relates to the issue of confusion at the date of decision.

(6) Conclusions based on consideration of factors

[65] Based on the evidence before the Court, the situation is effectively the following. Bunzl started using WORKHORSE on work gloves in 1979. WPS then started using WORKHORSE on parkas and jackets in 1980. Bunzl subsequently expanded its use to socks in about 1983, with rainwear and certain safety products following in the 1990s and thereafter. The trademarks are identical. They are of low inherent distinctiveness, although each party has developed some acquired distinctiveness in their mark through its ongoing use and sales with particular products. The lengthy ongoing use of identical marks has apparently not caused confusion in this particular

business, a business in which WPS has recognized that work gloves, socks, rainwear, and certain safety products do not “overlap” with its parkas and jackets.

[66] In my view, WPS’s registered trademark for WORKHORSE should be given a narrow ambit of protection. It is a suggestive trademark that is generally entitled to a narrower scope of protection. Based on evidence that was not before the Registrar, I conclude that such distinctiveness as it has acquired owing to WPS’s use and sales has been acquired during a time when the same trademark was used by Bunzl in respect of other clothing goods, namely work gloves, with respect to which it was adopted before WPS first used its mark. That acquired distinctiveness can therefore only broaden the scope of protection in a limited fashion.

[67] The confusion analysis does not depend on whether goods are “of the same general class or appear in the same class of the Nice Classification”: *Trademarks Act*, s 6(2). At the same time, the more similar the goods, the more likely that a finding of confusion will result from use of the same or similar marks: *Reynolds Presto Products Inc v PRS Mediterranean Ltd*, 2013 FCA 119 at paras 26–30; *Mattel* at para 71. Thus, the resemblance of two trademarks should not be viewed in isolation but in conjunction with the nature of the wares and the trade: *Reynolds* at para 30. Here, both parties have each acquired some distinctiveness in connection with a suggestive mark in relation to goods that fall within the broad general category of “clothing.” Bunzl is the senior user in respect of its work gloves, while WPS has 40 years of use in respect of its parkas and jackets.

[68] The goods in Bunzl's application at issue in this appeal are not parkas or jackets, but are other clothing-related goods. I agree with the Registrar that they have varying degrees of similarity to parkas and jackets as clothing items. They also have different dates of first use. As set out below, these factors, combined with the other subsection 6(5) factors, result in different outcomes in the confusion analysis.

[69] For WPS's paragraph 12(1)(d) ground of opposition, the relevant date for the confusion analysis is the date of disposition: *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd*, 1991 CanLII 11769, 37 CPR (3d) 413 (FCA) at p 424. The new evidence filed by Bunzl does not specifically relate to the period between the Registrar's decision in April 2021 and the present, such that the relevant date as between the Registrar's date of decision and my own does not matter. With respect to all of the goods at issue, the trademarks are identical, the trademarks are not inherently distinctive, and the parties have overlapping channels of trade. However, there are differences in the goods, the Bunzl mark has been used for different lengths of time and has become known to a different extent. Considering the various confusion factors together, I reach the following conclusions with respect to the likelihood of confusion on the date of disposition:

- The use by Bunzl of the trademark WORKHORSE in association with work gloves would not cause confusion with WPS's registered trademark. Despite the fact that the marks are identical, the factors described above, including the length of use (Bunzl in this case being the senior user), the narrow scope of protection that the registered trademark warrants, and the nature of the goods, business, and trade, means that Bunzl's use of WORKHORSE on work gloves would not be likely to lead the consumer somewhat in a hurry to the inference that the work gloves were manufactured or sold by WPS. I would

therefore allow the appeal with respect to the paragraph 12(1)(d) ground as it pertains to *protective gloves for industrial use; [...] mesh safety gloves; [...] general purpose rubber and plastic gloves for domestic use; general work clothing, namely, general work gloves, namely, cotton gloves, cotton and leather gloves and leather gloves; latex gloves, rubber gloves, vinyl gloves and polyvinyl chloride gloves, nitrile gloves, poly gloves; [...] all of the goods in the application for work and safety purposes.*

- I reach the same conclusion with respect to the goods *socks*. While Bunzl’s first use of the trademark on socks postdates WPS’s first use on parkas and jackets, the length of Bunzl’s concurrent use, including use pursuant to its own registered trademarks, both of which list socks, is substantial. As there is some difference between the goods, recognized by WPS not to overlap, I conclude there would be no likelihood of confusion.
- I reach the opposite conclusion, however, with respect to *rainwear, namely rain suits, pants, hats, boots*. Although there is some new evidence of Bunzl’s use of WORKHORSE on such goods, the evidence is limited, the use commenced later, the extent of use is not established, and the goods are more similar to parkas and jackets, particularly since the evidence shows a *rain suit* to include both a rain jacket and rain pants. I would reject the appeal with respect to this opposition ground for these goods.
- With respect to the remaining goods at issue, I conclude that I have no material new evidence in respect of Bunzl’s use of the trademark WORKHORSE in association with these goods that goes to a relevant confusion factor. I must therefore apply the “palpable and overriding error” standard to the Registrar’s confusion finding on these goods. I am not satisfied that Bunzl has demonstrated the Registrar made such an error in its finding

of likely confusion with respect to these goods. The goods, with the possible exception of *ear muffs* and *hairnets*, are closer in nature to parkas and jackets, and there is no evidence of the length of use or extent of sales beyond the claimed date of first use. I would therefore reject the appeal on this ground for these goods, namely: *protective clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons for protection against fire; protective clothing treated with retardants for wear by welders, grinders, and mechanics for protection against flames, sparks and fire; [...] protective industrial boots; [...] rubber molded boots; [...] protective aprons; protective aprons made of poly, neoprene coated and pvc; safety boots; [...] rainwear, namely, [...] hip and chest waders for use in connection with fishing and hunting; clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons; outdoor winter clothing, namely gloves, coveralls, overalls, bib pants, ear muffs; hairnets*. I note that I include *outdoor winter clothing, namely, gloves* in this category despite the conclusions above regarding work gloves and despite the general *for work and safety purposes* limitation in the application, both because there is little evidence of Bunzl's sale of winter gloves in particular, and because of the greater connotative proximity of cold-weather gloves to parkas and jackets.

[70] For WPS's subsection 16(1) ground of opposition, the relevant date for the confusion analysis is the date the applicant's mark was first used: *Park Avenue* at p 422. Bunzl's application claims use since at least as early as December 31, 2000. Jurisprudence based on the pre-2019 *Trademarks Act* concluded that (a) a date of first use claimed by an applicant was to be accepted as true absent evidence to the contrary, and (b) an applicant may seek to rely on an

earlier date of first use, but bears an evidential burden to establish that use: *WiringPro Corporation Inc v Sensolutions Inc*, 2020 TMOB 128 at para 42; *DeCaria Hair Studio Ltd v Massimo De Berardinis et al*, [1984] TMOB No 39, 2 CPR (3d) 309 at para 6. As set out in paragraphs [51] and [52] above, I am satisfied that Bunzl has met that evidentiary burden in respect of certain goods but not in respect of others.

[71] Considering the various confusion factors together, I reach the following conclusions with respect to the likelihood of confusion at the date of first use:

- The use by Bunzl of the trademark WORKHORSE in association with work gloves would not cause confusion with the WPS's registered trademark. At the date of Bunzl's first use in 1979, WPS had neither used nor applied to register the WORKHORSE trademark. I would therefore allow the appeal with respect to the subsection 16(1) ground as it pertains to the same work glove goods listed above.
- With respect to the goods *socks*, Bunzl's first use of the trademark on socks postdates WPS's first use on parkas and jackets and its application to register the trademark by a few years. However, beyond Ms. Turton's statement that the mark had been used on goods since October 1980, there is no evidence of use or the extent of use in this period that could give any acquired distinctiveness to WPS's trademark, which remained a suggestive mark entitled to narrow protection, particularly in light of Bunzl's prior use on work gloves. Given the differences in the goods, recognized by WPS not to overlap with its parkas and jackets, I conclude there would have been no likelihood of confusion.

- With respect to *rainwear, namely rain suits, pants, hats, boots*, Bunzl adopted the WORKHORSE trademark on these goods somewhat later, in the early 1990s. Although Ms. Turton’s earliest direct evidence of WPS’s sales dates from the 1998 to 2000 period, I am prepared to infer based on the extent of those sales and the decade since the date of first use that there were significant sales that would give the trademark some acquired distinctiveness. Given this and the fact that the goods are more similar to parkas and jackets, I conclude there was a likelihood of confusion in the early 1990s and I would reject the appeal with respect to this opposition ground for these goods.
- With respect to the remaining goods at issue, as stated above, I again have no material new evidence in respect of Bunzl’s use of the trademark WORKHORSE in association with these goods that goes to either the date of first use or another relevant confusion factor. I must therefore apply the “palpable and overriding error” standard to the Registrar’s confusion finding on these goods. The Registrar applied their confusion findings from the paragraph 12(1)(d) ground to the subsection 16(1) ground notwithstanding the earlier material date. I am not satisfied that Bunzl has demonstrated the Registrar made a palpable and overriding error in doing so.

[72] For WPS’s section 2 ground of opposition, the relevant date for the confusion analysis is the filing date of the opposition, namely September 29, 2015: *Metro Goldwyn Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 at para 25. The Registrar did not make a direct determination as to whether WPS had met its evidential burden to establish it had a “substantial, significant or sufficient” reputation in Canada to prevent Bunzl’s mark from being distinctive: *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657 at para 34. Rather, the

Registrar simply said that even if they were to find that WPS had met its initial burden, they would come to the same conclusions as with respect to paragraph 12(1)(d) and subsection 16(1) grounds.

[73] Neither party made material submissions on this ground of opposition or suggested that the result on this ground should differ from those of the other grounds. WPS's section 2 ground is again based on allegations of confusion with its use and registration of WORKHORSE. My conclusions above are the same at the dates of first use prior to September 2015 and at the date of decision after September 2015. Like the Registrar, I see no basis for a different conclusion, regardless of the preliminary issue of whether WPS has met its evidential burden.

IV. Conclusion

[74] For the foregoing reasons, I would allow the appeal in part, and direct the Registrar to allow Bunzl's application with respect to those goods not struck out below:

First aid kits; protective safety equipment, namely, hard hats, safety glasses, safety goggles, ear plugs for soundproofing, face protection, namely, face shields not for medical purposes, respirators other than for artificial respiration, face masks not for medical purposes, and protective gloves for industrial use; protective clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons for protection against fire; protective clothing treated with retardants for wear by welders, grinders, and mechanics for protection against flames, sparks and fire; hearing protection headsets, not for medical use, radio-compatible hearing protection headsets, not for medical use; back support belts for workers; protective industrial boots; protective headgear, namely, hard hats and protective helmets; safety traffic cones; knee pads for workers; dust masks, rubber molded boots; protective sleeves; poly and pvc sleeves; protective aprons; protective aprons made of poly, neoprene coated and pvc; safety boots; mesh safety gloves; disposable bags; tool bags;

general purpose rubber and plastic gloves for domestic use; general work clothing, namely, general work gloves, namely, cotton gloves, cotton and leather gloves and leather gloves; latex gloves, rubber gloves, vinyl gloves and polyvinyl chloride gloves, nitrile gloves, poly gloves; socks; ~~rainwear, namely, rain suits, pants, hats, boots, and hip and chest waders for use in connection with fishing and hunting; clothing treated with fire retardants, namely, pants, shirts, bib overalls, coveralls, and aprons; outdoor winter clothing, namely, gloves, coveralls, overalls, bib pants, pants, ear muffs; hairnets; all of the goods in the application for work and safety purposes.~~

[75] Each party requested their costs of the appeal. Given the parties' divided success in the matter, in my view it is appropriate for each party to bear their own costs.

JUDGMENT IN T-1026-21

THIS COURT'S JUDGMENT is that

1. The appeal is allowed in part. The Registrar of Trademarks is directed to allow Application No 1,622,829 for the trademark WORKHORSE in respect of the following goods:

First aid kits; protective safety equipment, namely, hard hats, safety glasses, safety goggles, ear plugs for soundproofing, face protection, namely, face shields not for medical purposes, respirators other than for artificial respiration, face masks not for medical purposes, and protective gloves for industrial use; hearing protection headsets, not for medical use, radio-compatible hearing protection headsets, not for medical use; back support belts for workers; protective headgear, namely, hard hats and protective helmets; safety traffic cones; knee pads for workers; dust masks; protective sleeves; poly and pvc sleeves; mesh safety gloves; disposable bags; tool bags; general purpose rubber and plastic gloves for domestic use; general work clothing, namely, general work gloves, namely, cotton gloves, cotton and leather gloves and leather gloves; latex gloves, rubber gloves, vinyl gloves and polyvinyl chloride gloves, nitrile gloves, poly gloves; socks; all of the goods in the application for work and safety purposes.

2. There is no order as to costs.

“Nicholas McHaffie”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1026-21

STYLE OF CAUSE: BUNZL IP HOLDINGS, LLC v WINNIPEG PANTS &
SPORTSWEAR MFG LTD

PLACE OF HEARING: HELD BY VIDEOCONFERENCE

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JUDGMENT AND REASONS: MCHAFFIE J.

DATED: JUNE 3, 2022

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