



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2014 TMOB 278
Date of Decision: 2014-12-16

**IN THE MATTER OF AN OPPOSITION
by NILFISK-ADVANCE, INC. to
application No. 1,574,315 for the trade-
mark AquaClean in the name of Barry
Munro**

I. Background

[1] Barry Munro (the Applicant) has applied to register the trade-mark AquaClean (the Mark), based upon use in Canada since April 1, 2012, in association with “organic and natural general purpose liquid cleaner”.

[2] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* on December 26, 2012 and on May 27, 2013, NILFISK-ADVANCE, INC. (the Opponent) opposed it by filing a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[3] The application for the Mark has been opposed on the grounds that: (i) it does not conform to the requirements of sections 30(a), 30(b) and 30(i) of the Act; (ii) the Mark is not registrable under section 12(1)(d) of the Act, as it is confusing with the Opponent’s registered trade-mark AQUA CLEAN, which is the subject of registration No. TMA462,351 for “commercial carpet cleaning machines”; (iii) the Applicant is not the person entitled to registration of the Mark under section 16(1)(a) of the Act in view of the Opponent’s prior use of

its trade-mark AQUA CLEAN in Canada in association with the aforementioned wares; and (iv) the Mark is not distinctive within the meaning of section 2 of the Act.

[4] A lengthy counterstatement containing argument and what might have been considered evidence had it been submitted in affidavit form, was filed by the Applicant on July 17, 2013. I will discuss this in more detail below.

[5] The Opponent filed a certified copy of its registration for AQUA CLEAN (registration No. TMA462,351) as its evidence under section 41 of the *Trade-marks Regulations* SOR 96/195 (the Regulations).

[6] The Applicant did not file any evidence under section 42 of the Regulations and instead submitted a statement that it intended to rely upon what it had previously submitted as its counterstatement.

[7] The Opponent filed its Written Argument on April 28, 2014.

[8] On June 12, 2014, the Applicant filed a request for leave to file additional evidence under section 44 of the *Trade-marks Regulations* in the form of the affidavit of Barry Munro, sworn June 12, 2014 (the Munro affidavit), as well as a request for leave to file a document entitled “counterstatement addendum”.

[9] The Applicant’s request for leave to file additional evidence was granted and the Munro affidavit was made of record. Mr. Munro was not cross-examined.

[10] The Applicant’s request for leave to file the document entitled “Counterstatement Addendum” was considered to be a request for leave to file written arguments under section 46(2) of the *Trade-marks Regulations* and the request was granted.

[11] A hearing was held on December 3, 2014 and both parties participated.

II. Onus

[12] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential

burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

III. Analysis

Grounds of Opposition Summarily Dismissed

Non-conformity - Section 30(i)

[13] Where an applicant has provided the statement required by section 30(i), a ground of opposition based upon this section should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, this ground is dismissed.

Non-entitlement - Section 16(1)(a)

[14] With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark prior to the Applicant's claimed date of first use and non-abandonment as of the date of advertisement of the Applicant's application [section 16(5)]. The Opponent has not provided any evidence of use of its trade-mark. The section 16(1)(a) ground of opposition is therefore dismissed on the basis that the Opponent has failed to meet its initial evidential burden.

Non-Distinctiveness – Section 2

[15] In order to satisfy its initial burden with respect to the distinctiveness ground of opposition, the Opponent's evidence must show that its trade-mark had become known sufficiently as of the commencement of the opposition to negate the distinctiveness of the applied-for mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections In.* (2004), 34 CPR (4th) 317 (FC) and *Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[16] The Opponent has not filed any evidence of use of its trade-mark. Moreover, I note that the mere filing of a certificate of registration of a trade-mark is not sufficient to meet the initial onus on an opponent under a distinctiveness ground [see *Rooxs, Inc v Edit-SRL* (2002), 23 CPR. (4th) 265 (TMOB)].

[17] Accordingly, the distinctiveness ground of opposition is also dismissed on the basis that the Opponent has failed to meet its initial evidential burden.

Analysis of Remaining Grounds of Opposition

Preliminary Matter

[18] At the outset, I wish to note that in coming to my conclusion in this matter, I have not had regard to any statements in the counterstatement dated July 17, 2013 which would ordinarily be considered to be evidence and which have not been entered into evidence in the form of a sworn affidavit [section 42(1)(a) of the Regulations]. For example, the state of the register information which was provided will be disregarded, as will the information pertaining to the cost of the parties' products and the Applicant's business plans.

Non-conformity - Section 30(a)

[19] The Opponent alleges that the application does not contain a statement in ordinary commercial terms of the wares in association with which the Mark has been used. However, the Opponent has not provided any evidence or provided any substantive submissions in support of this ground. The Opponent did not address this ground at all at the hearing and in its written submissions it only pointed to the fact that the wares are not listed in the Canadian Intellectual Property Office's *Wares and Services Manual*.

[20] This Board is not bound by administrative procedures followed in other sections of the Canadian Intellectual Property Office. That being said, I note that the *Wares and Services Manual* does in fact identify "all purpose cleaning preparations" as being an ordinary commercial term. The Applicant's wares are similarly described as "organic and natural general purpose liquid cleaner". In the absence of any compelling arguments or evidence to the contrary,

I am satisfied that the Applicant's wares are expressed in ordinary commercial terms. The section 30(a) ground of opposition is therefore unsuccessful.

Non-conformity - Section 30(b)

[21] The Opponent's section 30(b) ground of opposition has been pleaded as follows: "The Application does not comply with Section 30 of the Act insofar as the Applicant has not claimed, or proven their claim to, the date of first use of the Proposed Trademark in association with the general class of wares outlined in the application".

[22] The material date for assessing a ground of opposition under section 30(b) of the Act is the date of filing of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB); *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].

[23] The Opponent has not filed any evidence in support of this ground of opposition. While it's true that the Opponent may also meet its initial burden by relying upon the Applicant's evidence, it can only do so if it is able to show that the Applicant's evidence is "clearly" inconsistent with the claims in the application [*Labatt Brewing Co v Molson Breweries, A Partnership*, (1996), 68 CPR (3d) 216 (FCTD) at 230; *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply* (1999), 2 CPR (4th) 562 (TMOB) at 565-6, aff'd at (2001), 11 CPR (4th) 489 (FCTD)].

[24] The Applicant's evidence in this case consists solely of the Munro affidavit. At the hearing, the Opponent correctly pointed out that the Munro affidavit primarily focuses on events which occurred prior to the Applicant's April 1, 2012 claimed date of first use. For example, Mr. Munro explains that he was previously the Director, President and Recognized Agent for a Nova Scotia company known as Neptune's Balance Limited [Munro affidavit, para 4]. Attached as Exhibit "A" is a corporate profile for that company which appears to have been extracted from the Government of Nova Scotia's website. The company appears to have been incorporated and registered in 2009 and subsequently became inactive in August of 2012 [Munro affidavit, Exhibit "A"]. Mr. Munro states that he marketed products for the company Neptune's Balance Limited under the name Neptune's Balance AquaClean. Attached as Exhibit "B" are five invoices, which

Mr. Munro states precede April 1 2012. Attached as Exhibit “C” to Mr. Munro’s affidavit is a representative photograph showing bottles of Neptune’s Balance AquaClean products.

[25] At the hearing, Mr. Munro stated that he was under the mistaken impression that he was required to provide evidence of use pre-dating the April 1, 2012 claimed date of first use and that it was for this reason that he chose to include the particular exhibits which were attached to his affidavit.

[26] The Opponent takes the position that the Applicant has not established its claimed date of first use because all of the evidence pre-dates the claimed date of first use and appears to have been made by a third party or a predecessor which is not named in the application for the Mark.

[27] Although the Opponent is correct in this regard, the fact remains that the Opponent itself did not file any evidence in support of its section 30(b) ground of opposition. The onus only shifts to the Applicant to prove use once the Opponent’s initial burden has been met. Otherwise, the Applicant is under no obligation to file any evidence of use of its Mark.

[28] As mentioned previously, the Opponent can rely on the Applicant’s evidence to meet its initial burden, but only if it can be shown to be “clearly” inconsistent with the claims in the application [*Labatt Brewing Co v Molson Breweries, A Partnership supra*; *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply supra*].

[29] In this case, the fact that the Applicant has only provided evidence of use prior to the claimed date of first use in the application does not, in my view, amount to a “clear” inconsistency. Moreover, I note that at the beginning of his affidavit, Mr. Munro does state that he can “confirm the use of the mark ‘AquaClean’ to distinguish wares identified as “(1) Organic and natural general purpose liquid cleaner” in Canada since as early as April 1, 2012” [Munro affidavit, para 3]. Although he has not provided any evidence to support such a statement, the statement is consistent with what is in the application. In the absence of any evidence from the Opponent or a clear inconsistency in Mr. Munro’s affidavit, I must conclude that the Opponent has failed to meet its initial evidential burden.

[30] Accordingly, the section 30(b) ground of opposition is unsuccessful.

Registrability – Section 12(1)(d)

[31] The Opponent has pleaded that the Mark is not registrable because it is confusing with its trade-mark AQUA CLEAN, which is the subject of registration No. TMA462,351.

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

[33] The Opponent has filed a certified copy of its registration and I have exercised my discretion and checked the register to confirm that the Opponent's registration is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[34] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between its trade-mark and the Opponent's trade-mark.

[35] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[36] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

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

[37] The parties' trade-marks are almost identical. Overall, they do not possess a high degree of inherent distinctiveness. Both consist solely of a combination of the ordinary dictionary terms "aqua" and "clean", and notably, the term "clean" has been disclaimed in the Opponent's registration.

[38] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. However, the Opponent has not filed any evidence of promotion or use and the evidence which has been filed by the Applicant at best shows use by another entity prior to the claimed date of first use in the application for the Mark. In view of this, I cannot conclude that either of the parties' trade-marks has become known to any significant extent in Canada.

Section 6(5)(b) – the length of time each has been in use

[39] The application for the Mark is based upon use in Canada since April 1, 2012. However, as discussed in more detail above, the Applicant has not submitted any evidence of use which would enure to its benefit on or after the claimed date of first use in the application. The Opponent has provided a certified copy of its registration. However, this only enables the Registrar to assume *de minimus* use [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. Accordingly, this factor does not significantly favor either party.

Sections 6(5)(c) and (d) – the nature of wares, services or business and trade

[40] When considering sections 6(5)(c) and (d) of the Act, it is the statement of wares in the application for the Mark and the statement of wares in the Opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. Those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording.

Evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[41] The statement of wares in the Opponent's registration covers "commercial carpet cleaning machines" and the application for the Mark covers "organic and natural general purpose liquid cleaner".

[42] In its counterstatement dated July 9, 2013, the Applicant submitted that the parties' wares differ "in presentation, purpose, market and consumer appeal". The Applicant went into some detail regarding the differences in price and the differences in the parties' businesses. In addition, the Applicant reproduced photographs of what it purports to be the parties' wares to further illustrate their differences. However, the Applicant hasn't filed any evidence in the form of a sworn affidavit to support its submissions and explain where it obtained such information. I am therefore left with what is in the statement of wares in the Opponent's registration and what is in the statement of wares in the Applicant's application for the Mark in order to assess confusion.

[43] The parties' wares are only related to the extent that they are both used for cleaning purposes. Aside from that commonality, they differ entirely. The Opponent's wares are essentially commercial grade machines which are specifically intended to clean carpets, whereas the wares covered in the application for the Mark are simple liquid cleaning products which have a more general application.

[44] With respect to the channels of trade, the Opponent's registration specifically states that its carpet cleaning machines are for commercial purposes. The statement of wares in the application for the Mark does not specify whether its wares are intended for commercial or residential settings. In the absence of any evidence, it is difficult to draw any meaningful conclusions with respect to the channels of trade which are associated with the parties' wares. However, based upon the differences in the nature of the wares alone, it seems reasonable to conclude that the channels of trade would also differ.

Section 6(5)(e) – degree of resemblance between the trade-marks

[45] The parties' trade-marks AQUA CLEAN and AquaClean are almost identical.

Conclusion on the Likelihood of Confusion

[46] Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its onus to show that, on a balance of probabilities, confusion between the parties' trade-marks is unlikely. The parties' trade-marks are not particularly inherently distinctive and neither party has demonstrated any use or reputation in its trade-mark. While the trade-marks at issue are almost identical, the nature of the wares differs substantially and in the absence of any evidence to the contrary, it is reasonable to conclude that nature of the parties' trades would also differ.

[47] The section 12(1)(d) ground of opposition is therefore unsuccessful.

IV. Disposition

[48] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office