



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

**Citation: 2015 TMOB 59**  
**Date of Decision: 2015-03-31**

**IN THE MATTER OF AN OPPOSITION  
by Kohler Co. to application  
No. 1,571,821 for the trade-mark CIRCE  
in the name of Brasstech, Inc.**

Introduction

[1] Brasstech, Inc. (the Applicant) has applied to register the trade-mark CIRCE based on proposed use in Canada in association with lighting fixtures and bathroom mirrors.

[2] Kohler Co. (the Opponent) has opposed the application primarily on the basis that there is a reasonable likelihood of confusion between this trade-mark and the Opponent's previous use of its registered mark CIRCE in Canada in association with baths, namely bathtubs, metal pipes for plumbing purposes. The Opponent also alleges technical grounds of opposition based on non-compliance of the application under section 30 of the Act.

[3] For the reasons that follow, I refuse the application.

Background

[4] On April 4, 2012, the Applicant filed application No. 1,571,821 for the registration of the mark CIRCE (the Mark) based on proposed use in association with lighting fixtures and bathroom mirrors.

[5] The application was advertised on March 27, 2013, and the Opponent filed a statement of opposition on August 7, 2013, based on the following grounds of opposition set out under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act): non-compliance with sections 30(a), 30(e), 30(i), non-registrability under section 12(1)(d), non-entitlement under section 16(3)(a), and non-distinctiveness under section 2. As noted above, the determinative issue in this proceeding is the likelihood of confusion between the Mark and the Opponent's CIRCE mark, registration No. TMA730,356.

[6] In support of its opposition, the Opponent filed a certified copy of its registration No. TMA730,356. The Applicant elected not to file any evidence.

[7] Both parties filed a written argument.

[8] No oral hearing was held.

#### Onus

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

#### Grounds of Opposition Summarily Dismissed

[10] The Opponent has pleaded six grounds of opposition and has not met its initial burden with respect to the following five:

- section 30(a): there is no evidence that the application does not contain a statement in ordinary commercial terms of the specific goods in association with which the Mark is proposed to be used;

- section 30(e): there is no evidence that the Applicant did not intend to use the Mark in Canada prior to the filing date of the application;
- section 30(i): there is no evidence that the Applicant could not have been satisfied that it was not entitled to use the Mark in Canada;
- section 16(3)(a): there is no evidence that the Opponent's trade-mark CIRCE had been used in Canada prior to the filing date of the application - the mere filing of a certified copy of an opponent's registration will not support the Opponent's evidential burden with respect to a ground of opposition based on an allegation of non-entitlement [*Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]; and
- section 2: there is no evidence that the Opponent's trade-mark CIRCE had been used or made known in Canada prior to the material date for this ground of opposition, i.e. the filing date of the statement of opposition (August 7, 2013) [*Entre Computer Centers, supra*].

[11] Accordingly, the five aforementioned grounds of opposition are dismissed.

Non-registrability- Section 12(1)(d)

[12] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act because the Mark is confusing with the trade-mark CIRCE registered in Canada by the Opponent under No. TMA730,356.

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

[14] The evidence shows that the Opponent's registration is in good standing. It issued to registration on December 8, 2008, based on a declaration of use filed November 7, 2008.

[15] 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 the Mark and the Opponent's trade-mark.

*test for confusion*

[16] 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 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. 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 goods, 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.

[17] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [*Mattel, Inc v 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)].

[18] In most instances, the dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [*Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145, conf. 60 CPR (2d) 70 (FCTD)]. In *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC), the Supreme Court of Canada considered the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion (see para 49):

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

[19] In this proceeding, it is self-evident with regard to section 6(5)(e), that the Opponent's CIRCE trade-mark and the Mark are identical in sound, appearance and in ideas suggested. I therefore conclude that on such basis a casual consumer observing the Mark and having no more than an imperfect recollection of the Opponent's mark would likely be confused into thinking that the source of the goods associated with the Mark was the same as the source of the goods associated with the Opponent's mark. The question now is whether any of the other circumstances reduce this likelihood of confusion to the point that confusion is not likely to occur.

*section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known*

[20] Each of the marks is inherently strong since neither of the marks are suggestive of the associated wares.

[21] The strength of a trade-mark may be increased by means of it becoming known through promotion or use, but there is no evidence that either party's mark has become known to any extent in Canada.

*section 6(5)(b) - the length of time each trade-mark has been in use*

[22] There is no evidence that the Mark has been used in Canada to date. While the Opponent's registration is based on use of its mark since 2008, the registration can establish no more than *de minimis* use [*Entre Computer Centers, supra*]. As a result, in the absence of evidence of use of the parties' marks, this factor does not favour either party.

*sections 6(5)(c) and (d) - the nature of the goods, services or business; the nature of the trade*

[23] It is the Applicant's statement of goods as defined in its application versus the Opponent's registered goods that govern my determination of this factor [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[24] The Opponent's registered goods are baths, namely bathtubs, metal pipes for plumbing purposes whereas the Applicant's goods are lighting fixtures and bathroom mirrors. Although I agree with the Applicant that bathroom mirrors are primarily a vanity product whereas bathtubs and metal pipes for plumbing purposes are typically functional, I find that the parties' goods are related insofar as they could both be used in bathrooms.

[25] In view that the parties' goods are related and could target the same consumer, in the absence of evidence to the contrary, it is presumable that the parties' channels of trade could overlap.

*conclusion*

[26] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees CIRCE on the Applicant's lighting fixtures or bathroom mirrors at a time when he or she has no more than an imperfect recollection of the Opponent's CIRCE trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot, supra*].

[27] In view of my findings above, and in particular the fact that the marks are identical and the goods are related, it seems to me that such a consumer would, as a matter of first impression, be likely to believe that the bathtubs and metal pipes for plumbing associated with the Opponent's CIRCE mark and the lighting fixtures and bathroom mirrors associated with the Applicant's CIRCE mark were manufactured, sold or performed by the same person.

[28] The section 12(1)(d) ground is therefore successful.

Disposition

[29] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Cindy R. Folz  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office