

IN THE MATTER OF AN OPPOSITION by Amtrol Inc.
to application No 530,656 for the trade-mark
FLEXTROL Dessin filed by Expanflex Inc. and
presently standing in the name of Les Placements
Ham-Gar (1987) Inc./Ham-Gar Investments (1987) Inc.

On October 30, 1984, the applicant, Expanflex Inc., filed an application to register the trade-mark FLEXTROL Dessin, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with "reservoirs avec diaphragme pour systeme de chauffage, eau potable, solaire, anti-belier systeme de climatisation et glycol".

The opponent, Amtrol Inc., filed a statement of opposition on August 20, 1985 and, in response to an objection raised by the Opposition Board, an amended statement of opposition on September 30, 1985. In its amended statement of opposition, the opponent alleged that the applicant's application is not in compliance with Section 29 (now Section 30) of the Trade-marks Act because the applicant does not intend to use the trade-mark FLEXTROL in Canada. Further, the opponent alleged that the applicant's trade-mark is not registrable in that the applicant's trade-mark FLEXTROL Dessin is confusing with the opponent's registered trade-marks WELL-X-TROL, registration No. 165,948 and HAMMERTROL, registration No. 123,042. The opponent also challenged the applicant's entitlement to registration and the distinctiveness of the applicant's trade-mark in view of the prior user in Canada by the opponent of its trade-name Amtrol Inc. and its trade-marks WELL-X-TROL, HAMMERTROL, EX-TROL, MINITROL, DIATROL, FILL-TROL and PURGERTROL in association with wares which the opponent has identified in its statement of opposition.

The applicant served and filed a counter statement in which it denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Gunter Neumann while the applicant submitted the affidavits of Claude Garneau, Alan Booth and A. Yates Dowell, III. As evidence in reply, the opponent submitted two affidavits of Jacques Desjardins.

During the opposition proceeding, the application was assigned to Hamlet & Garneau Inc. which submitted evidence of a change of name to Les Placements Ham-Gar (1987) Inc./ Ham-Gar Investments (1987) Inc., the present applicant of record. The date of the assignment was November 17, 1986, more than one year subsequent to the date of the opponent's opposition, the material date

in respect of the opponent's Section 12(1)(d) and non-distinctiveness grounds of opposition and two years after the filing date of the applicant's application, the material date in respect of the non-entitlement grounds of opposition.

The opponent withdrew its ground of opposition based on Section 30 of the Trade-marks Act at the oral hearing and that ground need not therefore be considered.

The remaining grounds of opposition are based on allegations of confusion between the applicant's trade-mark and one, or more, of the opponent's trade-marks and its trade-name. In this regard, the opponent has relied upon its registered trade-marks HAMMERTROL and WELL-X-TROL, its trade-name Amtrol Inc, as well as upon its trade-marks EX-TROL, MINITROL, DIATROL, FILL-TROL and PURGERTROL. Of these marks, the most pertinent in my view is the trade-mark EX-TROL and the opponent by its evidence has established its prior user of the trade-mark EX-TROL and non-abandonment of the trade-mark as of the date of advertisement of the applicant's application in the Trade-marks Journal (March 20, 1985). Likewise, the opponent has met the burden upon it under Sections 16(5) and 17(1) of the Trade-marks Act in respect of the trade-marks MINITROL, DIATROL, FILL-TROL and PURGERTROL.

With respect to the issue of confusion, the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark FLEXTROL Dessin and the opponent's trade-marks and trade-name. In determining whether there would be a reasonable likelihood of confusion between the trade-marks and trade-name at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Act.

I consider the applicant's trade-mark FLEXTROL Dessin and each of the opponent's trade-marks to be coined words and, as such, are inherently distinctive. No evidence has been adduced by the applicant in respect of its use of its proposed trade-mark FLEXTROL Dessin, such that the applicant's trade-mark must be considered as not having become known to any extent in Canada as of either the filing date of its application or as of the date of opposition. On the other hand, the opponent's evidence establishes that its trade-marks and, in particular, its trade-mark EX-TROL had become known in Canada in association with diaphragm-type storage tanks. Likewise, the length of time that the trade-marks have been in use clearly favours the opponent in respect of its trade-mark EX-TROL which has been in use in Canada since 1957.

The wares of the parties are identical in respect of diaphragm-type storage tanks and the channels of trade through which these wares would be sold to the consuming public in Canada are identical. With respect to the wares of the parties, it is clear that they are relatively sophisticated in nature and are therefore not wares which would be purchased in a hurried manner by the prospective purchaser.

As to the degree of resemblance between the trade-marks FLEXTROL Dessin and EX-TROL, the trade-marks are similar in appearance and very similar in sounding although the trade-marks do not suggest any particular idea in common.

As a further surrounding circumstance, the applicant relied upon the state of the register to establish the the suffix TROL was common to the trade which is associated with the wares of the parties. However, a detailed consideration of the state of the register evidence adduced by way of the Booth affidavit revealed the existence of only two registered trade-marks covering pressure vessels of any kind and, in particular, the registered trade-marks JANITROL and CLIMATROL which cover boilers. A number of the registrations cover equipment such as float valves for toilet tanks, water faucets, water softener controls, pumps and fittings, chlorinators for swimming pools, flush valves, pressure valves, mixing valves, water pollution equipment, pilot mechanisms for valves, air eliminating devices for hot water heating systems, and electronic controls to regulate impurity concentrations in water. While the registrations associated with these wares were relied upon by the applicant as being trade-marks which were broadly associated with wares having some relation to water, I do not consider these wares to be particularly relevant to the wares of the parties. Further, a number of the registered trade-marks covered various types of controls and equipment used in control systems of various kinds. However, these registrations cover wares which differ considerably from those of the applicant and the opponent. While the Garneau affidavit introduced into evidence brochures from a number of manufacturers, Mr. Garneau did not indicate that any of the wares associated with the trade-marks identified in the brochures were wares of the type distributed by his company which could have supported the conclusion that these wares are associated with the wares of the parties. In any event, only five of the trade-marks identified by Mr. Garneau were trade-marks disclosed by the state of the register search and the Desjardins affidavit of February 25, 1988 indicates that the wares associated with the trade-marks MAGNETROL and LEVEL-TROL are not used in conjunction with diaphragm expansion tanks while wares associated with the trade-mark SPARCO-TROL were not introduced into the Canadian marketplace until 1986.

In view of the above, and while I agree that the suffix TROL has been adopted by a number

of traders in association with numerous wares, I do not consider that any of the registrations cover wares which are identical to diaphragm tanks. Further, none of the trade-marks disclosed by the search were as similar to the applicant's trade-mark as is the opponent's trade-mark EX-TROL.

In addition to the above, the opponent's evidence does disclose the existence of a series of trade-marks including the suffix TROL and its trade-name Amtrol Inc. which further supports the opponent's position in respect of the issue of confusion between its trade-mark EX-TROL and the applicant's trade-mark FLEXTROL Dessin. However, a number of the opponent's series of TROL trade-marks cover wares which are not diaphragm expansion tanks, thus diminishing the significance of the opponent's family of trade-marks insofar as deciding the outcome of this opposition.

The opponent submitted that the assignment of the present application to Hamlet & Garneau Inc. was a further surrounding circumstance in this opposition in that Hamlet & Garneau was the exclusive Canadian distributor of the opponent in Canada for more than twenty-five years. In particular, the opponent submitted that clients of Hamlet & Garneau (now Les Placements Ham-Gar (1987) Inc.) would associate diaphragm expansion tanks associated with the trade-mark FLEXTROL Dessin as being another in the line of the opponent's wares in view of the number of years which the applicant was exclusive distributor of the opponent in Canada. However, the assignment of this applicant to Hamlet & Garneau occurred more the one year after the date of opposition and I do not consider that I can have regard to it except to the extent that I can infer that, as of the material dates, the the channels of trade associated with the wares of the parties would be identical. However, such a conclusion follows from the fact that the wares are identical in any event.

In view of the above, I have concluded that the applicant has failed to discharge the burden upon it in respect of the issue of confusion between its trade-mark FLEXTROL Dessin and the opponent's trade-mark EX-TROL as applied to diaphragm expansion tanks. Accordingly, the applicant is not the person entitled to registration of the trade-mark FLEXTROL Dessin which is not distinctive of the applicant's wares.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF JANUARY 1989.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.