



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

Citation: 2011 TMOB 182
Date of Decision: 2011-09-30

**IN THE MATTER OF AN OPPOSITION
by Trévi Fabrication Inc. to Application
No. 1,189,889 for the trade-mark TREVI
in the name of Masco Corporation of
Indiana**

[1] On September 4, 2003, Masco Corporation of Indiana (the Applicant) filed an application to register the trade-mark TREVI (the Mark) in association with plumbing products based on the Applicant's use and eventual registration in the United States. The wares were subsequently amended to plumbing fixtures, namely, faucets and replacement parts therefore and the basis of the application changed to proposed use.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 31, 2005. On May 31, 2006, Trévi Fabrication Inc. (the Opponent) filed a statement of opposition. On July 6, 2006, the Applicant filed a counterstatement denying the Opponent's allegations. The Opponent filed the Affidavits of Josée Bélec (sworn February 6, 2007) and Philippe Kattan (sworn February 5, 2007) and certified copies of various trade-mark registrations and applications consisting of or containing the term TREVI. The Applicant filed the Affidavit of John Sznawajs (sworn September 19, 2007). Both parties filed written submissions and were represented at the oral hearing.

[3] On March 16, 2011, the wares were restricted to plumbing products, namely, kitchen and bathroom faucets and replacement parts therefore (the Wares).

Grounds of Opposition

[4] The Opponent's statement of opposition includes the grounds summarized below:

1. contrary to s. 30(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the application does not contain a statement in ordinary commercial terms of the specific wares in association with which the Mark has been or is proposed to be used;
2. contrary to s. 30(e) of the Act, the application does not contain a statement that the Applicant intends to use the Mark in Canada;
3. contrary to s. 30(i) of the Act, the application does not contain a statement that the Applicant is satisfied that it is entitled to use the Mark in Canada and the Applicant could not have been satisfied that it was so entitled;
4. contrary to s. 12(1)(d) of the Act, the Mark is not registrable because it is confusing with seven trade-marks registered by the Opponent, each including the word TREVI;
5. contrary to s. 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because, at the filing date of the application, the Mark was confusing with thirteen applied-for and registered trade-marks of the Opponent, each including the word TREVI, which had been previously used in Canada;
6. contrary to s. 2 of the Act, the Mark is not distinctive of the Applicant.

Onus

[5] 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 support each ground of opposition [*John Labatt Ltd. v. Molson Companies Ltd.*, (1990) 30 C.P.R. (3d) 293 (F.C.T.D.)].

Material Dates

[6] The material dates with respect to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(3) - the filing date of the application;
- s. 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30 Grounds of Opposition

[7] The Opponent has pleaded that the application is contrary to s. 30(a), 30(e) and 30(i) of the Act.

[8] There is no evidence that supports the grounds of opposition based on s. 30(a) and 30(e) of the Act. Consequently these grounds are dismissed on the basis that the Opponent has not satisfied its initial burden.

[9] The s. 30(i) ground alleges that the application does not contain a statement that the Applicant is satisfied as to its entitlement to use the Mark in Canada and could not have been properly satisfied that it was so entitled, since “the Applicant was well aware of the Opponent’s trade-marks described herein and the Opponent’s continued use thereof;”. As drafted, the ground of opposition is insufficiently pleaded. The fact that the Applicant is aware of the Opponent’s trade-marks does not prevent it from making the statement required under s. 30(i). In any event, a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances in this case, the s. 30(i) ground is dismissed.

Section 12 (1)(d) Ground of Opposition

[10] The Opponent has pleaded that the Mark is not registrable because it is confusing with one or more of the following trade-marks registered by the Opponent:

1. TRÉVI & Design Reg. No. TMA370,040;
2. TRÈVI Reg. No. TMA367,173;
3. TRÉVI LE NO. 1 DE LA PISCINE & Design Reg. No. TMA518,532;
4. TRÉVI & Design Reg. No. TMA502,616;
5. TRÉVI TOP NAME IN POOLS & Design Reg. No. TMA518,548;
6. TRÉVI TOP NAME IN POOLS & Design Reg. No. TMA524,608; and
7. TRÉVI LE NO. 1 DE LA PISCINE & Design Reg. No. TMA524,609.

Throughout my decision I will refer to TREVI, TRÉVI and TRÈVI as “TREVI”.

[11] The Opponent has met its initial burden of proof under this ground of opposition by filing certified copies of each of these registrations. I have exercised my discretion and checked the register to confirm that each are extant [*Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)].

[12] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with one or more of the Opponent’s registered trade-marks. I consider that the Opponent’s best case scenario is Reg. No. 502,616 (the TREVI & Sun Design Trade-mark). The particulars of this mark are set out below. If the Opponent is not successful under this registration, it would also be unsuccessful with respect to its remaining registrations. I consider use of the composite marks (Reg. Nos. TMA518,532; TMA518,548 and TMA524,609) to be use of the TREVI & Sun Design Trade-mark as illustrated hereinafter:



Wares: In-ground and above-ground swimming pools, whirlpool baths, equipment and accessories for pools, namely filtering apparatus, filters, pumps, water heaters, pool covers, ladders, diving boards, railings,

chemicals for pool maintenance, outdoor furniture.

Services: Operation of a business for the sale, installation and maintenance of in-ground and above-ground swimming pools, and whirlpool baths, outdoor furniture, equipment and accessories for pools, chemicals.

[13] The test to determine the issue of confusion is set out in s. 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[14] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 (S.C.C.) at para. 54]. I also refer to the recent decision *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27 at para. 49, where the Supreme Court of Canada states that s. 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis. While I have examined the criteria in the order in which they appear, I have taken into account the Supreme Court's comments with respect to the importance of s. 6(5)(e).

6(5)(a) - the inherent distinctiveness of the trade-marks and the extent to which they have become known

[15] The Mark and the TREVI & Sun Design Trade-mark have a similar degree of inherent distinctiveness the TREVI & Sun Design Trade-mark being slightly more distinctive due to its design elements.

[16] The distinctiveness of a trade-mark may be increased by its use or if it has become known in Canada. The evidence of the Opponent's affiant, Ms. Bélec, Director, Publicity and Marketing for the Opponent, provides the following:

- Since 1987 the Opponent has sold swimming pools, spas and related products and services. Since 1992 the Opponent has manufactured its own products for sale (Bélec Affidavit, para. 2).
- Ms. Bélec provides examples of the TREVI & Sun Design Trade-mark on products, packaging and labels and on store signage, in brochures and advertising and on contracts for the purchase and installation of pools and spas (Bélec Affidavit, Exhibits JB-1,4-6, 8-9).
- The TREVI & Sun Design Trade-mark is used in association with the sale and installation of pools, whirlpools, spas, solariums and related products sold through TREVI stores and distributors including Sears and Costco (Bélec Affidavit, para. 5, Exhibits JB-2-3).
- For the period between 2003 and 2006, sales of TREVI pools, whirlpools, spas, solariums and related products in Canada have been in excess of \$34 million annually and between \$25 and \$68 million annually between the years 1987 and 2002 (Bélec Affidavit, para. 6).
- The Opponent has spent approximately \$2 million per year on advertising expenditures for TREVI pools, whirlpools, spas, solariums and related products in Canada (Bélec Affidavit, para. 8).
- The TREVI trade-marks, including the TREVI & Sun Design Trade-mark, have been extensively advertised and marketed in Canada in a variety of mediums including newspaper advertising, direct mail advertising, outdoor advertising and radio advertising (Bélec Affidavit, para. 8).

[17] The evidence of the Applicant's affiant, Mr. Szniewajs, Vice-President of the Applicant, provides the following:

- The TREVI trade-mark was first used in United States and Canada since at least as early as 2002 as part of the BRIZO product line.
- Mr. Szniewajs provides examples of the TREVI trade-mark appearing on a label affixed to packaging for a bathroom faucet and in product catalogues (Szniewajs Affidavit, para. 5, Exhibits B-C). I note that the product catalogues confirm that BRIZO is a division of the Opponent.

- The sales revenue associated with the sale of TREVI brand kitchen and bath plumbing faucets, fixtures and accessories in Canada is \$440,188 USD in 2005 and 2006 (Sznewajs Affidavit, para. 9).
- Advertising expenditures incurred for TREVI kitchen and bath plumbing faucets, fixtures and accessories in North America have totaled approximately \$426,756 from 2002-2007 (Sznewajs Affidavit, para. 6). No expenditures specific to Canada have been provided.
- TREVI kitchen and bath plumbing faucets, fixtures and accessories are available primarily in high-end plumbing boutiques in Canada (Sznewajs Affidavit, para. 7, Exhibit D).
- The TREVI kitchen and bath plumbing faucets, fixtures and accessories have appeared in magazines, newspapers and on the Internet including in the following publications: The Detroit News, Interior Design, Canadian Home & Country, Remodeling, Times Colonist and The Toronto Star (Sznewajs Affidavit, Exhibits E-F). No circulation figures have been provided. I am prepared to take judicial notice of the fact that *The Toronto Star* has circulation in Canada and the *Times-Colonist* has some circulation in Victoria, British Columbia and the surrounding area [*Milliken & Co. v. Keystones Industries (1970) Ltd.*, 12 C.P.R. (3d) 166 (T.M.O.B.) at 168].

[18] As Mr. Sznewajs has not provided advertising expenditures specific to Canada and there are no circulation figures provided for the majority of the articles attached to his Affidavit, I am not prepared to give any weight to Mr. Sznewajs discussion of “consumer impressions” in para. 9 of his Affidavit:

It should be noted that in the sale of a single item, the interactions between the customer on the one hand, and the distributor, retailer, online or print catalogs on the other hand, may generate dozens of consumer exposures to the TREVI mark. Thus, inherent in the sales of \$440,188 are many **millions** of consumer impressions of the TREVI mark.

[19] Based on the foregoing information, I conclude that this factor favours the Opponent as the TREVI & Sun Design Trade-mark is more known than the Mark.

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

[20] Section 6(5)(b) favours the Opponent as its evidence establishes use of the TREVI & Sun Design Trade-mark in Canada since at least as early as March 1993 (Bélec Affidavit, Exhibit JB-6), whereas the Applicant establishes use of the Mark since at least as early as 2003 (Sznewajs Affidavit; Exhibit F).

6(5)(c) and (d) - the nature of the wares, services, business and trade

[21] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark applications or registrations that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)].

[22] However, 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. The evidence of the parties' actual trades is useful in this respect [*McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[23] Although both parties' activities are related to water, it is clear that the nature of the wares and services and channels of trade of the Opponent and Applicant are different.

[24] The most relevant wares in the TREVI & Sun Design Trade-mark include pools, whirlpools, and related products. The relevant services include the sale, installation and maintenance of these products. The Opponent's brochures, advertisements and contracts indicate that the Opponent's products are for use outside. There is no evidence showing the sale or installation of indoor water related products for use in bathrooms or kitchens by the Opponent or evidence showing the use of faucets in conjunction with the Opponent's goods. The Opponent's products are sold through its own TREVI stores and other retailers including a number of different pool stores and Sears and Costco (Bélec Affidavit, Exhibit 3).

[25] In contrast, the Applicant's goods are plumbing products, namely kitchen and bathroom faucets and replacement parts therefor. The Applicant's TREVI kitchen and bathroom faucets are typically sold at plumbing boutiques (Sznewajs Affidavit, para. 7, Exhibit D).

[26] Despite the differences in their businesses, the Opponent submits that the parties' interests clearly overlap. To support its assertion the Opponent has filed the Affidavit of Mr. Phillippe Kattan, a student-at-law with the Agents for the Opponent at the time his Affidavit was

sworn. Mr. Kattan states on February 5, 2007 he visited and obtained print-outs of the Applicant's web-site *www.masco.com* (Kattan Affidavit, Exhibit PK-1) and the following web-sites: *www.kohler.com* and *www.jacuzzi.com* (Kattan Affidavit, Exhibits PK-2-3). The print-outs of *www.masco.com* states the Applicant is in the business of "manufacturing faucets, plumbing fittings and valves; showerheads and hand showers; bathtubs and shower enclosures and spas".

[27] In its Written Argument, the Opponent argues based on the evidence of Mr. Kattan that "several famous product manufacturers and distributors such as Kohler and Jacuzzi, have expanded their line of products to include faucets and spas" (para. 61). I find, however, the print-outs of the *www.kohler.com* and *www.jacuzzi.com* web-sites to be hearsay and should be accorded very little weight if any [*ITV Technologies Inc. v. WIC Television Ltd.* (2003), 29 C.P.R. (4th) 182 (F.C.) at para. 12-18]. If I am wrong, I do not find that the Kattan Affidavit supports the conclusion that the Applicant's Wares clearly overlap with the Opponent's goods based solely upon evidence from two manufacturers and without evidence that the products referenced on the web-sites are available through the same channels of trade or otherwise viewed as related by consumers.

[28] With respect to the print-outs of the *www.masco.com* web-site, I do not consider that the print-outs demonstrate that the channels of trade of the parties overlap. I note that on the page entitled "Masco Corporation. Our Companies by Product Segment." thirteen different companies are listed under the heading "North American" and eleven different companies are listed under the heading "International". This evidence suggests that the Applicant has a very diverse range of interests. Without evidence showing that the Wares travel in the same channel of trade as spas, I do not find that these print-outs evidence overlap in the parties' channels of trade.

[29] The Opponent also argues that the Applicant's and Opponent's products are offered in the same channels of trade "including specialized stores and super stores, such as Costco." In the absence of evidence showing that specialized stores selling pools, spas and related equipment also sell kitchen and bathroom faucets and replacement parts or that general retailers tend to display pools, spas and related equipment in the same general area as kitchen

and bathroom faucets and replacement parts therefore, I am not prepared to infer that the channels of trade overlap.

[30] Rather, I find that the Wares are intrinsically different and occupy a different market niche than the Opponent's goods and services particularly when considered as a matter of first impression [*Heinz Italia S.R.L. v. Furlani's Food Corp.* (2008), 72 C.P.R. (4th) 356 (T.M.O.B.) at 367; *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 at para. 86)]. As such this factor favours the Applicant.

6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[31] The Mark is virtually identical to Reg. No. TMA367,173 for TREVI and the word components of the TREVI & Sun Design Trade-mark and Reg. No. TMA367,173. This factor favours the Opponent with respect to these registrations. However, given the differences in the nature of the wares and services, I am not persuaded that the resemblance results in a likelihood of confusion.

[32] With respect to the remaining registrations of the Opponent, each of which include the additional components "TOP NAME IN POOLS" or "LE NO. 1 DE LA PISCINE", I find that due to the additional components and the resulting visual differences and the differences in ideas suggested, the Mark is distinguishable.

Conclusion

[33] Therefore I conclude that the Applicant has met its burden to prove, on a balance of probabilities, there is no likelihood of confusion between the Mark and the TREVI & Sun Design Trade-mark. It follows that the Applicant has also met its burden with respect to the remaining relied-upon registrations. This ground of opposition is therefore dismissed.

Remaining Grounds of Opposition

[34] The grounds of opposition based on entitlement (s. 16(3)(a)) and distinctiveness (s. 2) also turn on a determination of the issue of the likelihood of confusion between the Mark and

the Opponent's marks as discussed above and those set out below for which there is evidence of use (Bélec Affidavit, Exhibits JB-5-6,9) at the material dates. Furthermore, the Opponent has met its onus of proving that its trade-marks had not been abandoned at the date of advertisement (s. 16(5)).

- TREVI LE FABRICANT-INSTALLATEUR – Appl. No. 1,254,029;
- TREVI LE FABRICANT-INSTALLATEUR & Design – Appl. No. 1,254,030; and
- TREVI THE MANUFACTURER INSTALLER – Appl. No. 1,254,035.

[35] Neither the difference in material dates, nor the additional trade-marks relied on by the Opponent have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are not likely to be confused applies to these grounds of opposition which also fail.

Disposition

[36] Therefore, pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Darlene H. Carreau
Chairperson
Trade-marks Opposition Board
Canadian Intellectual Property Office