

IN THE MATTER OF AN OPPOSITION by Holland Imports Inc., sometimes trading as Brico Tool Company, to application No. 533,720 for the trade-mark BRICO filed by Provigo Inc., subsequently assigned to Brico Centre (Canada) Inc., and presently standing in the name of Groupe Val Royal Inc.

On December 21, 1984, the original applicant, Provigo Inc., filed an application to register the trade-mark BRICO based upon proposed use of the trade-mark in Canada. The applicant assigned its rights in the trade-mark BRICO to Brico Centre (Canada) Inc. and the statement of wares contained in the original application was restricted to cover the following wares: "Peintures, colles, cires, vernis, solvants, nettoyeurs à brosses et pinceaux; articles de tuyauterie, nommément: tuyaux, raccords pour tuyaux, drains et robinets et leurs pièces constitutives".

The opponent, Holland Imports Inc., sometimes trading as Brico Tool Company, filed a statement of opposition on June 4, 1987 in which it alleged that the applicant's application does not comply with Section 29(a) (now Section 30(a)) of the Trade-marks Act in that the applicant's "statement of wares does not specifically describe all of the wares". Further, the opponent alleged that the applicant's application is not in compliance with Section 29(i) (now Section 30(i)) of the Act in that the applicant could not have been satisfied that it was entitled to use the trade-mark BRICO in Canada in that, as of the applicant's filing date, the applicant should have been aware of the opponent's trade-name Brico Tool Company and its trade-mark BRICO and its use thereof. Next, the opponent claimed that the applicant's trade-mark is not registrable in that it is confusing with the opponent's registered trade-mark BRICO, registration No. 253,895. The opponent also asserted that the applicant is not the person entitled to registration of the trade-mark BRICO in view of the prior use by the opponent of its trade-mark BRICO in association with the wares identified in its statement of opposition, as well as its prior use of its trade-name Brico Tool Company in Canada in association with the sale of certain wares which are also identified in its statement of opposition. Finally, the opponent alleged that the applicant's trade-mark is not distinctive.

The applicant served and filed a counter statement in which it asserted that its application complies with Section 30 and that its trade-mark BRICO is not confusing with the opponent's trade-mark BRICO and trade-name Brico Tool Company.

During the opposition proceeding, the applicant assigned its rights in the trade-mark BRICO to Groupe Val Royal Inc., the present applicant of record.

The opponent failed to file evidence in a timely manner in this opposition and, as a result,

the applicant elected not to file any evidence.

The applicant alone filed a written argument and both parties were represented at an oral hearing.

As no evidence was filed by the opponent, the opponent has failed to meet the evidential burden upon it in respect of its Section 30 and non-distinctiveness grounds of opposition. Further, with respect to the Section 16 ground of opposition, the opponent has failed to discharge the burden upon it under Sections 16(5) and 17(1) of the Trade-marks Act of establishing its prior use of its trade-mark BRICO and trade-name Brico Tool Company in Canada, as well as non-abandonment of the trade-mark and trade-name as of the date of advertisement for opposition purposes of the applicant's application in the Trade-marks Journal. Accordingly, these grounds of opposition are rejected.

The only remaining ground of opposition is based on Section 12(1)(d) of the Act, the opponent alleging that there would be a likelihood of confusion between its registered trade-mark BRICO, registration No. 253,895 and the applicant's trade-mark BRICO. In its written argument, the applicant alleged that there was no evidence filed in this opposition evidencing the existence of the opponent's registered trade-mark BRICO. In Broadway Sound Plus Ltd. v. M. & K. Stereo Plus Ltd., 3 C.P.R. (3d) 410, the hearing officer commented as follows at page 412 in respect of a similar submission presented by the applicant in that case:

In the present case, I have checked the register and determined that registration No. 253,895 for the registered trade-mark BRICO is and was, as of June 4, 1987, the date of filing of the opponent's statement of opposition, on the register.

In determining whether there would be a likelihood of confusion between the trade-marks at issue as of the material date, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of opposition.

Both of the trade-marks at issue are inherently distinctive as they are neither descriptive nor suggestive of the respective wares of the parties, nor do they possess any significance which would detract from their inherent distinctiveness.

As no evidence has been filed by the parties, neither the extent to which the trade-marks have become known nor the length of use of the trade-marks at issue are relevant criteria in assessing the issue of confusion between the trade-marks at issue in this opposition.

As the trade-marks are identical, the only remaining criteria which must be considered under Section 6(5) of the Trade-marks Act are the nature of the wares and the respective channels of trade associated with the wares of the parties. The opponent's registration covers tube cutters and flaring tools which are used in plumbing and therefore would be closely related to the applicant's "articles de tuyauterie". However, there are no wares covered in the opponent's registration which are at all similar to the applicant's "peintures, colles, cires, vernis, solvants, nettoyeurs à brosses et pinceaux". On the other hand, I consider that such wares as paints, glues, waxes, varnishes, thinners and paintbrush cleaners are wares which would be sold in hardware stores or in the hardware department of department-type stores and therefore in close proximity to such wares as hand tools or hand operated tools which are covered in the opponent's registration. Further, if such were not the case, the burden was on the applicant to satisfy the Registrar that the potential channels of trade associated with the wares of the parties would differ.

Having regard to the above, and bearing in mind that no evidence has been adduced by the applicant in support of its application, I have concluded that the applicant has failed to discharge the

legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the identical trade-marks BRICO as applied to the wares covered in the applicant's application and the opponent's registration. As a result, the applicant's trade-mark is not registrable in view of Section 12(1)(d) of the Trade-marks Act.

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

DATED AT HULL, QUEBEC THIS 31ST DAY OF MAY 1990.

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