IN THE MATTER OF AN OPPOSITION
by Cuno Incorporated to application No. 592,496 for the trade-mark AQUA-PURE filed by Albac Enterprises Inc.

On September 29, 1987, the applicant, Albac Enterprises Inc., filed an application to register the trade-mark AQUA-PURE for "potable water" based on proposed use in Canada. The application was advertised for opposition purposes on October 19, 1988.

The opponent, Cuno Incorporated, filed a statement of opposition on February 20, 1989, a copy of which was forwarded to the applicant on March 3, 1989. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark AQUA-PURE registered under No. 184,959 for

> filtering apparatus and components thereof including filter cartridges for filtering and purifying fluids.

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the registered trade-mark AQUA-PURE previously used in Canada by the opponent or its predecessor in title AMF Incorporated in association with the wares set forth in the registration and in association with "reverse osmosis units which produce purified water for use in the home." The third ground is that the applicant's trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of John G. Hritz and Rick Kelly. The applicant filed the affidavit of Debbie Valois. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As a preliminary matter with respect to the first ground of opposition, it should be noted that the applicant took the position throughout this opposition that the opponent was precluded from relying on its trade-mark registration because it did not prove that registration. However, in accordance with the decision in Quaker Oats Co. of Canada Ltd. v. Menu Foods Ltd. (1986), 11 C.P.R.(3d) 410 (T.M.O.B.), I have checked the trade-marks register and confirmed that Cuno Incorporated is the current owner of registration No. 184,959. The register also reveals that AMF Canada was recorded as a registered user from January 17, 1974 to May 28, 1987 and that R-Can Distribution Inc. was recorded as a registered user from August 17, 1987 to April 17, 1988. R-Can Distribution Inc. was re-recorded as a registered user on November 2, 1990.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The applicant's mark AQUA-PURE is highly suggestive, if not descriptive, of potable water. Thus, it is an inherently weak mark. There being no evidence of use from the applicant, I must conclude that its mark has not become known at all in Canada.

The opponent's registered mark AQUA-PURE is highly suggestive of filtering apparatus, particulary apparatus for filtering water. Thus, the opponent's mark is also inherently weak.

In its written argument, the opponent contends that it has evidenced substantial Canadian sales of its AQUA-PURE products from 1981 on. The opponent's evidence, however, does not support that contention. Mr. Hritz, the Assistant Secretary of the opponent, was unable to provide any direct evidence of use of his company's mark in Canada.

Mr. Kelly identifies himself as the President of R-Can Distribution Inc. which he states is the opponent's Canadian distributor. He purports to provide sales figures for the years 1981 to 1985 but it is apparent from a review of the sample invoices appended as Exhibit B to his affidavit that his company did not make any such sales until 1986. Sales prior to that date appear to have been made by AMF Canada Limited. The registered user entries for registration No. 184,959 appear to confirm the foregoing. Thus, in the absence of some explanation from Mr. Kelly, the pre-1986 sales figures are hearsay coming from him. Unfortunately, both the Kelly affidavit and the Hritz affidavit are far from satisfactory in describing the history of the opponent's business in Canada.

Mr. Kelly does go on to state that his company's sales from 1986 to 1988 have been greater than $1.65 million per year. However, the sample packaging appended as Exhibit F to the Kelly affidavit arguably shows R-Can Distribution Inc. as the source of the wares rather than simply as the opponent's distributor. On the other hand, R-Can Distribution Inc. was recorded as a registered user for at least part of that period such that any use that might arguably have been by R-Can would be deemed to have been use by the opponent. Furthermore, after being cancelled as a registered user on April 17, 1988 due to the expiry of the period of permitted use, R-Can was re-registered on November 2, 1990. This suggests that the opponent's intention may have been to maintain R-Can as a registered user throughout the period. In any event, I am able to conclude that at least some of the use of the mark AQUA-PURE in Canada was use by the opponent such that I can conclude that the opponent's mark has become known at least to a limited extent in Canada.

The length of time the marks have been in use favors the opponent. The opponent's wares comprise water filters for home and commercial use. The applicant's proposed ware is potable water. Thus, the wares at issue are not the same. However, there does appear to be a connection between them, namely, that the opponent's water filter could be used to produce potable water. Furthermore, one might expect that a retailer of water filters would also sell water coolers, containers for such coolers and possibly even water for such coolers. Thus, it may be that the trades of the parties are related. I suspect that they may not be, but unless the applicant adduces evidence on point, I am left to assume that they are. The marks themselves are identical in all respects.

As an additional surrounding circumstance, the applicant relied on an expunged third party registration for the trade-mark AQUA-PURE for water. However, that expunged registration is of no significance in assessing the issue of confusion between the applicant's mark and the opponent's mark in the marketplace as of the material time. Unlike the situation in S.C. Johnson & Son, Ltd. v. Marketing International Ltd. (1979), 44 C.P.R.(2d) 16 (S.C.C.), there is no evidence in the present case that the opponent made any self-limiting representations respecting the third party registration for the trade-mark AQUA-PURE in obtaining its own trade-mark registration.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I have also considered that the applicant's mark is a proposed mark and there is no indication that it has committed itself to that mark

by commencing use of it. In view of my conclusions above, I find that I am left in a state of doubt respecting the issue of confusion. Given that the onus is on the applicant, I must resolve that doubt against it. Consequently, the first ground of opposition is successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 30th DAY OF November , 1992.

David J. Martin,
Member,
Trade Marks Opposition Board.