

IN THE MATTER OF AN OPPOSITION by Augerscope, Inc. to
application No. 627,192 for the trade-mark DURABLE MARCO
Design filed by Les Produits Qualité Équipement Inc.

On March 13, 1989, Les Produits Qualité Équipement Inc. filed an application to register the trade-mark DURABLE MARCO Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with "des sacs à outils, ceintures à outils, porte-outils, étuis à outils".

The opponent, Augerscope, Inc., filed a statement of opposition on November 17, 1989 in which it alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in view of the registration and prior user by the opponent of its registered trade-marks MARCO, registration No. 276,404 and MARCOSCOPE, registration No. 270,513. According to the opponent, the applicant's trade-mark DURABLE MARCO Design is confusing with its registered trade-marks MARCO and MARCOSCOPE.

The applicant filed a counter statement in which it effectively denied the allegations set forth in the statement of opposition. Further, in its counter statement, the applicant alleged that it has used its trade-mark DURABLE MARCO since February 29, 1988 as a result of having purchased rights in the mark by way of a Bulk Sales Agreement. However, no evidence was filed by the applicant by way of affidavit or statutory declaration pursuant to Rule 44 of the Trade-marks Regulations in support of these allegations.

The opponent filed as its evidence the affidavit of Lawrence F. Irwin while the applicant failed to file either evidence or a statement, as required by Rule 44 of the Regulations, that it did not intend to adduce evidence in this opposition.

Neither party filed a written argument and neither party requested an oral hearing.

The opponent's grounds of opposition all turn on the issue of confusion between the applicant's trade-mark DURABLE MARCO Design and the opponent's registered trade-marks

MARCO and MARCOSCOPE. With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 (FCA) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538 (TMOB)). The material dates with respect to the non-entitlement and non-distinctiveness grounds are respectively the applicant's filing date (March 13, 1989) and the date of opposition (November 17, 1989).

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, 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.

While the opponent has not filed copies of its registrations as evidence, the Registrar does have the discretion to check the register in order to confirm the existence of the registrations relied upon by the opponent (see Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd., 11 C.P.R. (3d) 410). In doing so, I noted that both registrations are still in force and that registration No. 276,404 for the trade-mark MARCO covers "plumbing tools and component parts thereof" while registration No. 270,513 for the trade-mark MARCOSCOPE covers "manually operated closet auger".

With respect to the inherent distinctiveness of the trade-marks at issue, the opponent's trade-mark MARCO has a given name significance and, as a result, possesses relatively little inherent distinctiveness. On the other hand, the opponent's mark MARCOSCOPE is inherently distinctive. The applicant's trade-mark DURABLE MARCO Design possesses some measure of inherent distinctiveness when considered in its entirety despite the given name significance of the element MARCO and the descriptive connotation of the word DURABLE as applied to the applicant's wares.

The Irwin affidavit establishes that the opponent's trade-marks MARCO and MARCOSCOPE have become known in Canada in association with pipe cleaning tools including plumbing snakes and related equipment. On the other hand, no evidence has been furnished by the applicant by way of affidavit of statutory declaration that it has commenced use of its trade-mark in Canada and its trade-mark DURABLE MARCO Design must therefore be considered as not having become known to any extent in this country. As a result, both the extent to which the trade-marks

at issue have become known and the length of time that the marks have been in use favour the opponent in this opposition.

The applicant's "sacs à outils, ceintures à outils, porte-outils, étuis à outils" differ from the wares covered in the opponent's registrations, namely, plumbing tools and their component parts, and closet augers. While no evidence has been furnished by the parties on point, I would expect that plumbing tools and tool bags, tool belts, tool caddies and tool boxes might well be sold through the same types of retail outlets, such as hardware stores or building supply outlets. In any event, and if such is not the case, the burden was on the applicant to establish by way of evidence that the channels of trade associated with the respective wares covered in the present application and the opponent's registrations would not overlap.

The only remaining criterion for consideration under s. 6(5) is the degree of resemblance between the trade-marks at issue in appearance, sounding and ideas suggested. In this regard, the trade-marks DURABLE MARCO and MARCO are very similar in appearance and sounding. However, the degree of similarity is far less in the case of the applicant's mark and the opponent's registered trade-mark MARCOSCOPE. Further, I would note that the applicant has adopted the entirety of the opponent's registered trade-mark MARCO as an element of its mark. In this regard, Cattanach, J. in Conde Nast Publications Inc. v. Union des Editions Modernes, 46 C.P.R. (2d) 183, at page 188, commented as follows:

Apart from the above, the applicant has taken no active steps in this opposition subsequent to filing its counter statement even though the legal burden is on it to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue. As a result, and having regard to the degree of resemblance between the trade-marks DURABLE MARCO Design and

MARCO as applied to wares travelling through the same channels of trade, I have concluded that the applicant has failed to meet the legal burden on it of establishing that there would be no reasonable likelihood of confusion between the trade-marks at issue.

In view of the above, I refuse the applicant's application pursuant to s. 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF March, 1993.

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