

**IN THE MATTER OF AN OPPOSITION
by Cincinnati Milacron Inc. to application
No. 710,702 for the trade-mark CITCOOL
filed by Citgo Petroleum Corporation**

On August 11, 1992, the applicant, Citgo Petroleum Corporation, filed an application to register the trade-mark CITCOOL for “machine tool coolant and cutting fluid” based on use of the mark in Canada since February, 1991. The effective filing date of the application is February 11, 1992 in view of the applicant’s priority claim based on its corresponding application filed in the United States. The application was advertised for opposition purposes on February 16, 1994.

The opponent, Cincinnati Milacron Inc., filed a statement of opposition on July 18, 1994, a copy of which was forwarded to the applicant on August 19, 1994. The first ground of opposition is that the applicant’s application does not comply with the provisions of Section 30(i) of the Trade-marks Act. In this regard, the opponent alleges that the applicant could not have been satisfied that it was entitled to register the applied for mark because it was aware that its mark was confusing with the opponent’s registered trade-marks CIMCOOL and CIMCOOL FIVE STAR.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent’s trade-mark CIMCOOL registered under No. 179,568 for “water soluble compound for use as a coolant in forming, shaping and cutting operations” and the opponent’s trade-mark CIMCOOL FIVE STAR registered under No. 283,720 for “fluid concentrate for metal cutting and grinding.” The third ground is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant’s claimed date of first use, the applied for trade-mark was confusing with the trade-marks CIMCOOL and CIMCOOL FIVE STAR previously used in Canada by the opponent. The fourth ground is that the applicant’s trade-mark is not distinctive because it is confusing with the opponent’s two marks.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Karen E. Thompson and Mark Griffiths. As its evidence, the applicant submitted the affidavits of Charles A. Mattei and Gay Owens. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

All four grounds of opposition turn on the issue of confusion between the marks of the parties. Although the material time to consider the circumstances respecting that issue differs from ground to ground, it matters little which material time is used in this case. Thus, a consideration of the issue of confusion between the applicant's mark and the opponent's registered marks pursuant to Section 12(1)(d) of the Act will effectively decide the outcome of this proceeding.

The opponent's first trade-mark is CIMCOOL which is registered under No. 179,568 for "water soluble compound for use as a coolant in forming, shaping and cutting operations." The material time for considering the circumstances respecting the issue of confusion with that registered 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.

As for Section 6(5)(a) of the Act, the marks at issue are both coined words and are therefore inherently distinctive although the component COOL is highly suggestive of the associated wares. In his affidavit, Mr. Griffiths identifies himself as the Vice-President of Operations of the opponent's Canadian subsidiary and attests to continuous sales for many years by his company in Canada of CIMCOOL product originating with the opponent. According to Mr. Griffiths, total sales since 1986 have exceeded \$10 million. The applicant submitted that since one of the representative invoices appended to the Griffiths affidavit was for a CIMCOOL recovery unit rather than for CIMCOOL coolant, it is impossible to determine what portion of the opponent's total sales relate to CIMCOOL coolant. However, on a fair reading of that affidavit, it is apparent that most of the sales attested to by Mr. Griffiths relate to CIMCOOL coolant. As noted by the opponent's agent, there must have been significant sales of CIMCOOL coolant to justify the purchase of a CIMCOOL recovery unit at a price of \$7,500 (U.S.). Thus, the opponent's trade-mark CIMCOOL has become known in Canada, at least within the metalworking trade.

In his affidavit, Mr. Mattei identifies himself as Vice-President, Lubes and Specialty Products of the applicant and states that sales of CITCOOL machine tool coolant and cutting fluids for the period 1992 to 1995 totalled 1210 gallons. Given that the representative label appended as Exhibit A to Mr. Mattei's affidavit indicates that the product is sold in a 55 gallon drum, the applicant's total sales for 1992 to 1995 amounted to only 22 drums. Thus, there has been only minimal use of the applicant's mark in Canada and I cannot ascribe any reputation of note to the mark CITCOOL in this country.

The length of time the marks have been in use favors the opponent since CIMCOOL coolant has been continuously sold in Canada since at least 1960. As conceded by the applicant at page seven of its written argument, "...the trade-marks appear to be applied to very similar wares." Presumably, the trades of the parties would overlap since the products of both parties are to be used as a coolant in metalworking operations.

As for Section 6(5)(e) of the Act, the marks at issue bear a high degree of resemblance both visually and phonetically. The marks are identical except for the third letter. There is also some resemblance between the ideas suggested by the two marks but that is due exclusively to the inherently weak component COOL.

As an additional surrounding circumstance, the applicant has relied on the state of the register evidence in the Owens affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

Ms. Owens' search revealed thirteen third party registrations (owned by eleven different owners) for trade-marks which include the word COOL or KOOL registered for coolants or lubricants. In view of the number of registrations located, I am able to conclude that at least a few of those marks are in active use. Thus, consumers in the machining or

metalworking field would be somewhat accustomed to seeing marks for coolants which include the component COOL or KOOL and would therefore be more likely to distinguish such marks based on their other components. However, that conclusion does not greatly assist the applicant's case given the inherent weakness of the component COOL or KOOL and the fact that the remaining components in the two marks at issue are very similar.

As an additional surrounding circumstance, the applicant pointed to the contemporaneous use of the parties' marks and the absence of any evidence of incidents of actual confusion. However, given the token use of the applicant's mark evidenced to date, it is not surprising that there has been no actual confusion between the marks at issue.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, trades and marks of the parties, I find that the applicant's mark CITCOOL is confusing with the opponent's registered mark CIMCOOL. In view of my earlier comments, it therefore follows that all four grounds of opposition based on the opponent's mark CIMCOOL are successful. It is therefore unnecessary to consider the four grounds insofar as they rely on use or registration of the opponent's trade-mark CIMCOOL FIVE STAR.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 21th DAY OF NOVEMBER, 1997.

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