

**IN THE MATTER OF AN OPPOSITION by
TLV Co., Ltd. to application No. 885,012
for the trade-mark TRAPMASTER
filed by Tyco Flow Control, Inc.**

On July 21, 1998, Tyco Flow Control, Inc. filed an application to register the trade-mark TRAPMASTER. The application is based on proposed use of the trade-mark in Canada in association with the following wares and services:

Wares:

Computer programs to determine sizing and type of steam traps for use in steam systems in industries such as chemical processing, foods, paper, petroleum refining, and steam power generation; computer programs for use in the collection, storage, organization, and sorting of survey data of steam traps used in steam systems in industries such as chemical processing, foods, paper and petroleum refining, and steam power generation.

Services:

Training others using seminars, workshops, and management courses in the sizing, selection, and performance of steam traps used in steam systems in industries such as chemical processing, foods, paper and petroleum refining, and steam power generation; training others using classes and workshops to conduct diagnostic analysis on steam systems and steam traps used in industries such as chemical processing, foods, and paper and petroleum.

The applicant claimed convention priority based on an application filed in the United States of America on January 21, 1998.

The application was advertised for opposition purposes in the Trade-marks Journal of March 10, 1999. On May 10, 1999, the opponent, TLV Co., Ltd., filed a statement of

opposition. The applicant filed and served a counter statement.

The opponent filed evidence, namely the affidavits of Mr. James R. Risko and Ms. Karen E. Thompson. The applicant filed the affidavits of Mr. John J. Murphy and Ms. Linda Victoria Thibeault as its evidence.

Both parties filed a written argument and were represented at an oral hearing.

In its statement of opposition, the opponent claims ownership of the following eight trade-marks, three of which are the subject of Canadian trade-mark registrations and five of which are the subject of pending trade-mark applications.

<u>Trade-mark</u>	<u>Reg./Appln. No. and Date</u>	<u>Wares</u>
POWERTRAP	TMA443,381 Regd. May 26, 1995	Fluid operated pumps; fluid operated valves; steam traps; condensate pumps
QUICKTRAP Design	TMA501,245 Regd. September 25, 1998	Steam trap, gas trap, or air trap for discharging liquid from an airtight container which contains air or steam
TRAP MAN Design	TMA348,341 Regd. November 25, 1998	Operation judging machines for steam trap, vibration gauges and flowmeters
TRAPEXPLORER Design	841,645 filed April 8, 1997	Computer software for detecting or locating, testing, evaluating and managing the population of steam traps and/or steam valves in a steam system which may be used on single personal computers, local area networks and global computer networks
TRAPMANAGER Design	841,642 filed April 8, 1997	Computer software for detecting or locating, testing, evaluating and managing the population of

		steam traps and/or steam valves in a steam system which may be used on single personal computers, local area networks and global computer networks
TRAPMAP Design	841,644 filed April 8, 1997	Computer software for detecting or locating, testing, evaluating and managing the population of steam traps and/or steam valves in a steam system which may be used on single personal computers, local area networks and global computer networks
TRAPROUTE Design	841,643 filed April 8, 1997	Computer software for detecting or locating, testing, evaluating and managing the population of steam traps and/or steam valves in a steam system which may be used on single personal computers, local area networks and global computer networks
TRAPTABLE Design	841,646 filed April 8, 1997	Computer software for detecting or locating, testing, evaluating and managing the population of steam traps and/or steam valves in a steam system which may be used on single personal computers, local area networks and global computer networks

It relies on these trade-marks in support of grounds of opposition pleaded under paragraphs 38(2)(b), (c) and (d) of the *Trade-marks Act*. The material date for determining the likelihood of confusion with respect to the paragraph 38(2)(b) grounds of opposition (registrability under paragraph 12(1)(d)) is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]. The material date for determining the likelihood of confusion with respect to the paragraph 38(2)(c) grounds of opposition (entitlement under section 16)

is the convention priority filing date of the application, January 21, 1998. The material date with respect to the paragraph 38(2)(d) ground of opposition (non-distinctiveness) is the date of filing of the opposition, May 10, 1999 [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

Opponent's Evidence

Mr. Risko is the President of the opponent's North American distributor, TLV Corporation. He attests that the opponent manufactures the products listed in its registrations and applications in Japan. The products, affixed with the opponent's trademarks, are exported from Japan to his company in the United States of America for distribution. He explains that the opponent's products are for use in fluid flow and steam analysis and management, in such industries as chemical processing, foods, paper, petroleum refining and steam power generation. His company sells the products to distributors in Canada who then sell them to end-users. He states that the applicant is a main competitor of the opponent and his company.

The exhibits to Mr. Risko's affidavit include:

- copies of the three registrations and five applications relied upon by the opponent.
- brochures concerning the opponent's POWERTRAP, QUICKTRAP Design, TRAP MAN Design, and TRAPMANAGER Design products. The only dates provided concerning these are: TRAP MAN Design brochures used both prior to 1998 and from July 1999; TRAPMANAGER Design brochure used from July 1999.
- undated photographs showing TRAP MAN Design on the hardware component of the opponent's steam trap management system.

- **sample product packaging for the TRAPMANAGER software bearing that trade-mark as well as the trade-mark TRAP MAN Design. The copyright notice refers to 1998.**

Mr. Risko also provides his company's annual Canadian sales for the years 1995-99 for each of the POWERTRAP, QUICKTRAP Design, TRAP MAN Design and TRAPMANAGER Design products. In addition, Mr. Risko provides information concerning his company's advertisement of products sold under those trade-marks; however, it is difficult to determine the extent of advertisement within Canada.

Ms. Thompson, a trade-mark searcher, conducted a search of the Canadian Trade-marks Register in April 2000 for trade-marks containing the word TRAP and located eight such marks associated with "steam traps and related systems including machines and computer software therefore". The eight marks are the applicant's mark plus seven of the marks relied upon by the opponent. It is unclear why Ms. Thompson did not locate the eighth mark relied upon by the opponent, namely QUICKTRAP Design.

Applicant's Evidence

Ms. Thibeault, a trade-mark searcher, also conducted searches of the Canadian Trade-marks Register. In November 2000 she conducted a search to locate trade-marks incorporating the word TRAP in connection with "computer software and/or steam traps". In addition to the applicant's mark and the eight marks relied upon by the opponent, the most relevant marks located by Ms. Thibeault are: BEAR TRAP and BEAR TRAP &

Design registered by ITT Industries, Inc. for steam traps in 1994; ENDURATRAP registered by Clark-Reliance Corporation for steam traps and industrial steam traps in 1984. Ms. Thibeault also provides the result of a search that she conducted in November 2000 “to locate a sample listing of co-existing registered or pending and allowed trade-marks with identical or phonetically identical prefixes for wares included in Class 9 and owned by different entities.”

Mr. Murphy is the Vice President Marketing and Sales of Yarway Corporation, a company located in the United States of America that is apparently part of Tyco International, Inc. In the preamble of his affidavit, Mr. Murphy says that the Canadian application for TRAPMASTER was filed “by Tyco Flow Control, Inc., which is a holding company of Tyco International, Ltd., set up in part to oversee intellectual property rights related to flow control products.”

Mr. Murphy states, “In 1997, a steam trap management software program using the name TRAPMASTER was designed to update and revitalize steam trap systems. ... The TRAPMASTER steam trap management system has been used in the United States since 1998.” He provides a brochure that describes steam trap seminars offered in the United States in association with the trade-mark TRAPMASTER.

Registrability

Of the opponent’s three paragraph 12(1)(d) grounds of opposition, the one based on registration No. 348,341 for TRAP MAN Design is the strongest. I will therefore first

discuss the likelihood of confusion between TRAPMASTER and TRAP MAN Design.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the *Act*. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, 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. The weight to be given to each factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Both TRAPMASTER and TRAP MAN Design have some degree of inherent distinctiveness. However, neither is an inherently strong mark since they both refer to their fields of interest, namely traps. Although TRAPMASTER is a coined word, that mark as a whole suggests that the associated wares/services will help the user master its traps. The design feature of the TRAP MAN Design does not add to its inherent distinctiveness, as it is simply the presentation of the words in a specific, rather common font.

The applicant has not evidenced any use of TRAPMASTER in Canada. The opponent's affiant makes mention of the TRAP MAN Design mark being used in Canada from 1995 to

1999. In addition, the TRAP MAN Design registration refers to a declaration of use having been filed on October 12, 1988. Regardless of whether or not use of TRAP MAN Design was continuous between 1988 and 1995, a consideration of the length of time each mark has been used favours the opponent.

The parties are competitors and their marks are used in association with closely-related wares and services. I note that the wares in issue appear to be rather specialized and that they are used by a select group of industries. It thus appears that the parties' wares are sold to a sophisticated market. Moreover, the price of a single TRAP MAN Design product is stated to exceed \$12,000 U.S.

Consideration of the extent to which each mark has become known necessarily favours the opponent as there is no evidence of any reputation having been acquired by the applicant's proposed use trade-mark. According to Mr. Risko, sales of wares associated with the TRAP MAN Design mark in Canada amounted to over \$700,000 U.S. between 1995 and 1999. I note however that this amounts to only about 50 units as the individual price of each is in excess of \$12,000 to \$14,000 U.S.

When considered in their totalities, it is noted that TRAPMASTER differs from TRAP MAN Design in that it is three syllables versus two. Although both marks begin with the word TRAP, given that they are both associated with steam traps, that commonality will not necessarily result in confusion. While the first component of a mark is often considered more important for the purpose of distinction, when a word is a common, descriptive or

suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)]. The latter part of each mark does begin with the letters MA, but again, I do not consider that sufficient to result in confusion, given the plethora of words that start with MA in the English language and the fact that MAN and MASTER are significantly different in appearance, sound, and meaning. In any event, marks are not to be dissected when determining matters of confusion, but rather should be assessed in their entirety.

As mentioned earlier, the overall idea suggested by TRAPMASTER is that the product will help you master your traps. At first instance, I am not sure what overall idea is suggested by TRAP MAN Design. However, as the opponent's literature does state that the "TRAP MAN Computerized Trap Management System... has been developed to provide the most effective means of steam trap management", people in the relevant industries might respond to TRAP MAN Design as suggesting the idea that the product is useful for managing one's traps.

As a further surrounding circumstance, the opponent has claimed that it has a family of TRAP trade-marks. At page 21 of its written argument, it states, "the Opponent has in fact established a family of trade-marks which include the word TRAP in association with other words for use in association with various 'steam traps, fluid flow products and computer software related thereto'." However, the opponent has only provided evidence concerning

four marks, two of which use TRAP as a suffix and two of which use TRAP as a prefix. There is no evidence that POWERTRAP and QUICKTRAP Design are associated with the wares in the manner set out in section 4 of the *Trade-marks Act* and the number of each of the opponent's products sold in Canada has been small. Moreover, there are two other parties who have registered marks incorporating the word TRAP on the Canadian Trade-marks Register for wares similar to those of the opponent. Last but not least, the word which the opponent wishes to monopolize is clearly descriptive with respect to the wares and services at hand. Accordingly, I do not accord the alleged family any weight in my consideration.

Having considered all of the surrounding circumstances, I am satisfied that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the TRAPMASTER wares and services and the TRAP MAN Design wares as of today's date. I reach this conclusion primarily because the overall differences between the marks outweigh their common use of the descriptive word "trap". As stated in *Office Cleaning Services, Ltd. v. Westminster Window and General Cleaners, Ltd.* (1946), LXIII Reports of Patent, Design, and Trade Mark Cases 39 at page 43, "A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered." The same may be said about trade-marks and comparatively small differences may suffice to make confusion unlikely. [see also *Molson Companies Ltd. v. John Labatt Ltd.* (1994), 58 C.P.R. (3d) 527 (F.C.A.) at 529] The sophisticated nature of the associated wares, services and clientele reinforces my conclusion that the relevant public will not be confused.

Turning to the opponent's other two registered marks, POWERTRAP and QUICKTRAP Design, I note that the resemblance of each to TRAPMASTER is reduced, because of the position of the word TRAP therein and the distinct differences in the ideas suggested. In most instances, the most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70]. The differences here suffice to make confusion unlikely.

In summary, the applicant has satisfied the burden on it with respect to each of the paragraph 12(1)(d) grounds of opposition and these grounds are accordingly rejected.

Entitlement

Regarding the opponent's paragraph 16(2)(a) grounds of opposition, the strongest ground is once again that based on the TRAP MAN Design mark. However, the opponent's position with respect to this ground of opposition is less strong than with respect to its paragraph 12(1)(d) ground of opposition due to the earlier material date. As of January 21, 1998, the extent of use of TRAP MAN Design amounted to only about \$200,000 worth of sales or 15 units. Accordingly, for reasons similar to those set out above under the discussion of the registrability grounds of opposition, the paragraph 16(3)(a) grounds of opposition fail.

The strongest of the paragraph 16(3)(b) grounds of opposition is that based on the prior

application for the trade-mark TRAPMANAGER Design, since that mark resembles TRAP MASTER more than the other four marks. TRAPMANAGER Design is the only one of the opponent's five applied-for marks for which there is evidence of use but as such use postdates January 21, 1998, it is not relevant to my consideration of the likelihood of confusion under section 16. The degree of resemblance between TRAPMANAGER Design and TRAPMASTER is about the same as that between TRAP MAN Design and TRAPMASTER. Unlike TRAP MAN Design, TRAPMANAGER Design had acquired no reputation as of the material date. I therefore dismiss the paragraph 16(3)(b) grounds of opposition for reasons similar to those set out above with respect to the registrability grounds.

Distinctiveness

Regarding the distinctiveness grounds of opposition, the opponent can only rely on trade-marks that had acquired some reputation as of May 10, 1999, namely POWERTRAP, QUICKTRAP Design, TRAP MAN Design or TRAPMANAGER Design. For reasons similar to those set out above with respect to the likelihood of confusion, I am satisfied on a balance of probabilities that the applicant's TRAPMASTER trade-mark is adapted to distinguish its wares and services from the wares associated with each of the aforementioned marks of the opponent. Each of the distinctiveness grounds of opposition is accordingly rejected.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, pursuant to the provisions of subsection 38(8) of the *Act*, I reject the opposition.

DATED AT GATINEAU, QUEBEC THIS 4th DAY OF NOVEMBER, 2003.

Jill W. Bradbury
Member
Trade-marks Opposition Board