

**IN THE MATTER OF AN OPPOSITION  
by Wyant & Company Limited / La Compagnie  
Wyant Limitee (now G.H. Wood + Wyant Inc.)  
to application No. 690,235 for the trade-mark  
HYCLEAN filed by LaCour (Canada) Inc.**

On September 24, 1991, the applicant, LaCour (Canada) Inc., filed an application to register the trade-mark HYCLEAN based on proposed use in Canada with the following wares:

janitorial products, namely paper towels, bathroom tissues, facial tissues, paper and textile wipers, soaps, and dispensers for the above products.

The application was advertised for opposition purposes on October 28, 1992.

The opponent, Wyant & Company Limited / La Compagnie Wyant Limitee (now G.H. Wood + Wyant Inc.), filed a statement of opposition on December 29, 1992, a copy of which was forwarded to the applicant on February 2, 1993. The first ground of opposition is that the applicant's trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the following 23 trade-marks of the opponent registered for paper products such as paper towels, facial tissue and bathroom tissue and, in some cases, dispensers:

<u>Registration No.</u>	<u>Trade-mark</u>	<u>Registration No.</u>	<u>Trade-mark</u>
390,000	HYRAK	124,854	HY-SORB CHEM-TOWELS
378,585	HY-LO	378,589	HY-VAL
379,009	HYLUXE	380,989	HYCEL
380,990	HYPAK	380,991	HYMAT
381,386	HYSTAR	381,387	HYTOO
381,389	HYSERV	381,385	HYSOFT
381,388	HYCAM	384,042	HYDOWN
384,384	HYTWIN	384,985	HYROL
387,890	HY-MARK	389,792	HYREEL
389,997	HYPLUS	389,998	HYZIP
389,999	HYFORCE	391,184	HY-SAN
389,996	HYNET		

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 each of the above-noted trade-marks which had been previously used or made known in Canada by the opponent. The third ground is that

the applicant is not the person entitled to registration because the applied for trade-mark was confusing with the following nine trade-marks which had previously been used or made known by the opponent:

<u>Application No.</u>	<u>Trade-mark</u>	<u>Application No.</u>	<u>Trade-mark</u>
648,253	HY-TEX	653,189	HYMAX
670,495	HYCHEM	673,100	HYDEES Design
675,634	HYFAST	675,636	HYTOP
675,633	HYRAG	651,231	HYSORB
658,699	HYMOR		

The fourth ground of opposition is that the applicant is not the person entitled to registration because the applied for trade-mark was confusing with each of the nine trade-marks listed above for which applications had previously been filed. The fifth ground is that the applicant's trade-mark is not distinctive.

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of Donna Harris evidencing the opponent's 23 registrations and seven of its nine applications. As its evidence, the applicant filed an affidavit of its General Manager, John D. Wright. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

In its written argument, the opponent withdrew its second and third grounds of opposition. Those two grounds are therefore unsuccessful.

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.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, 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. Finally, the most pertinent of the opponent's registered

marks is No. 381,388 for the trade-mark HYCAM and thus a consideration of the issue of confusion between that mark and the applicant's mark will effectively decide the outcome of the first ground.

As for Section 6(5)(a) of the Act, the opponent's mark HYCAM does not have any readily apparent suggestive connotation in relation to the registered wares. The mark is therefore inherently distinctive. Since the opponent has failed to file evidence of use of its registered mark, I must conclude that it has not become known at all in Canada.

The applicant's mark is also inherently distinctive although the component CLEAN describes the function of the applicant's wares. Thus, the applicant's mark is not inherently strong. The Wright affidavit evidences some minor use of the mark HYKLEAN but no use of the applied for mark HYCLEAN. I must therefore conclude that the applicant's mark has not become known at all in Canada.

The length of time the marks have been in use is not a material circumstance in the present case. As for Sections 6(5)(c) and 6(5)(d) of the Act, the opponent's registered wares are "paper towels, bathroom tissues, facial tissue and paper serviettes" which are identical to many of the applicant's wares. Presumably the trades of the parties would, or could, overlap.

The applicant submitted that since the opponent did not evidence the nature of its trade, it must be assumed that the opponent's trade could not cover janitorial products. I disagree. The opponent's statement of wares is not restricted to any particular channel of trade and it is the opponent's statement of wares that governs: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). Thus, I consider that the opponent's statement of wares encompasses all usual channels of trade for its products including the janitorial products trade.

As for Section 6(5)(e) of the Act, there is a fair degree of resemblance between the marks at issue. Both marks commence with the prefix HY and end with a one syllable word beginning with the letter C.

The opponent has submitted that the existence of its family of HY-prefixed trade-marks increases the likelihood of confusion occurring in the present case. Ordinarily, in accordance with the decision in McDonald's Corp. v. Yogi Yogurt Ltd. (1982), 66 C.P.R.(2d) 101 (F.C.T.D.), I would find that the opponent has failed to establish its alleged family or series of marks since it did not evidence any use of the family members. However, given the large number of HY-prefixed marks registered and applied for by the opponent and the absence of evidence of similar marks owned by third parties, I am prepared to infer that at least a few of the opponent's marks are in active use. By way of analogy, see 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.

The inferences to be drawn in this case are weaker, of course, because all of the marks are owned by a single party. Thus, I am only able to infer that the opponent has used a very small family of HY-prefixed marks for paper towels, facial tissue, bathroom tissue, dispensers and the like. Nevertheless, to the extent that the average consumer would be aware of the opponent's small family of HY-prefixed marks, he would be more likely to assume that a new HY-prefixed mark is a trade-mark of the opponent.

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 has failed to satisfy the legal burden on it to show that its proposed mark HYCLEAN is not confusing with the opponent's registered mark HYCAM. The first ground of opposition is therefore successful and the remaining grounds need not be considered.

**In passing, I wish to note that it is somewhat surprising that the opponent did not seek leave to amend its statement of opposition after the applicant filed its evidence. Since the Wright affidavit shows that the applicant has been using the trade-mark HYKLEAN rather than the mark HYCLEAN, it would appear that the opponent could have relied on a ground of opposition based on non-compliance with one or more subsections of Section 30 of the Act.**

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

**DATED AT HULL, QUEBEC, THIS 20th DAY OF FEBRUARY, 1996.**

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