



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 105
Date of Decision: 2010-07-22

**IN THE MATTER OF AN OPPOSITION
by Wiley Publishing, Inc. to application
No. 1,223,742 for the trade-mark
TROUSSE DE PISCINE POUR LES
NULS in the name of Hall-Chem Mfg.
Inc.**

THE RECORD

[1] On July 12, 2004, Hall-Chem Mfg. Inc. filed an application to register the trade-mark TROUSSE DE PISCINE POUR LES NULS based on proposed use of the mark in Canada in association with

chemicals, namely, algaecides, calcium, hypochlorite, isocyanuric compounds, alkalinity adjusters and PH adjusters, packaged with a pamphlet containing instructions for their use for the care and maintenance of swimming pools.

[2] The application was subsequently amended to disclaim the right to the exclusive use of the term TROUSSE DE PISCINE. The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated March 30, 2005 and was opposed by Wiley Publishing, Inc. on May 30, 2005. The Registrar of Trade-marks forwarded a copy of the statement of opposition to the applicant on June 30, 2005 as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The counter statement also pleads the applicant's ownership of trade-mark

registration no.TMA617,386 for POOL KIT FOR DUMMIES, that is, the English version of the applied for mark.

[3] The opponent's evidence consists of the affidavit of Marc Mikulich. The applicant's evidence consists of the affidavit of Hans Parik and certified copies of the applicant's trade-mark registrations for the marks POOL KIT FOR DUMMIES (referred to earlier) and THE EASY ALL IN ONE DUMMIES POOL KIT & Design. The opponent elected to not submit reply evidence. Mr. Parik was cross-examined on his affidavit, the transcript thereof and exhibits thereto forming part of the evidence of record. The transcript of cross-examination indicates about 23 questions taken under advisement and 2 undertakings for further response. The file record indicates that the applicant did not respond further to answer the undertakings nor the questions taken under advisement. Only the opponent submitted a written argument. Neither party requested an oral hearing.

STATEMENT OF OPPOSITION

[4] The first and second grounds of opposition are based on s.30(e) and s.30(i) of the *Trade-marks Act* alleging that "the Applicant could not state it was satisfied it was entitled to use the trade-mark in Canada in association with the wares described in the application and wrongly stated that it intended to use the mark with the wares set out in the application."

[5] The third ground, pursuant to s.12(1)(d) of the *Act*, alleges that the applied for mark TROUSSE DE PISCINE POUR LES NULS is confusing with the opponent's registered marks, namely: PCS FOR DUMMIES; DOS FOR DUMMIES; MACS FOR DUMMIES; POUR LES NULS; FOR DUMMIES; MUTUAL FUNDS FOR DUMMIES. The opponent uses its marks in association with instructional books.

[6] The fourth ground, pursuant to s.16(3), alleges that the applicant is not entitled to register the applied for mark because, at the date of filing the application, the mark TROUSSE DE PISCINE POUR LES NULS was confusing with the opponent's above-mentioned marks previously used in Canada. The fifth ground, pursuant to s.2, alleges that the applied for mark is not adapted to distinguish the applicant's wares from those of the opponent.

OPPONENT'S EVIDENCE

Marc J. Mikulich

[7] Mr. Mikulich identifies himself as Vice President of Brand Management for the opponent company. By the early 1900s the opponent Wiley had established itself as a leading publisher of books dealing with scientific and technical subjects. In 2001, the opponent acquired Hungry Minds, Inc., a publisher of various brands of books including FROMMER'S travel guides, BETTY CROCKER cookbooks and the FOR DUMMIES "how to" publications. The first "how to" publications in 1991 dealt with computers and technology but gradually expanded to include various topics such as cooking, gardening, managing finances, running a business, planning a trip and proper eating. The POUR LES NULS mark was adopted in 1993. The opponent's FOR DUMMIES and POUR LES NULS publications are sold in Canada by retailers specializing in books as well as by retailers of general merchandise including Walmart, Canadian Tire, Costco, Staples, Chapters, Indigo, Renaud Bray, Archambault and Bureau en Gros. The marks FOR DUMMIES and POUR LES NULS appear prominently on the cover page of the opponent's publications (as corroborated by exhibit materials).

[8] The opponent has also worked with partners to have FOR DUMMIES and POUR LES NULS books developed for particular topics for distribution to the partner's clients or customers. Such partners include Merck Frost, Pitney Bowes, Black's Photography and Hamilton Beach. Yearly sales in Canada of FOR DUMMIES books have averaged about 4.5 M\$ for each of the fiscal years 2003 - 2006, while yearly sales in Canada of POUR LES NULS books have averaged about \$500,000 for each of the fiscal years 2003 - 2006. Yearly promotion and advertising expenses in Canada for FOR DUMMIES books have averaged about \$88,000 for each of the fiscal years 2003 - 2006, while yearly promotion and advertising expenses in Canada for POUR LES NULS books have averaged about \$30,000 for each of the fiscal years 2003 - 2006.

[9] The opponent began a licensing program for the marks FOR DUMMIES and POUR LES NULS in the mid 1990s, which program is still in effect, for a wide range of consumer products including housewares, DVDs, videos and culinary kits. The licensed products are sold through various retailers including Zellers and Walmart. Revenues derived from the sale in Canada of licensed products sold under the mark POUR LES NULS averaged about \$500,000 for each of the fiscal years 2002 - 2006.

[10] The final paragraph of Mr. Mikulich's affidavit is reproduced, in part, below:

. . . when the initial FOR DUMMIES publication DOS FOR DUMMIES was being marketed many bookstores did not want to

carry the book at all claiming that FOR DUMMIES insulted their customers and readers in general. Only through the efforts of [the opponent] was this resistance overcome with the result that there are more than 900 titles on the market today and over 150 million copies of FOR DUMMIES and POUR LES NULS books in print . . . it is primarily because of the brand recognition . . . for the FOR DUMMIES and POUR LES NULS marks in Canada that other traders, such as the present Applicant, desire to adopt marks which include the words DUMMIES or NULS.

APPLICANT'S EVIDENCE

Hans Parik

[11] Mr. Parik identifies himself as the General Operations Manager with the applicant company. His affidavit evidence may be summarized as follows. The applicant is a Canadian manufacturer and distributor of chemicals. The applicant has been in operation for more than 27 years with offices in Montreal, Quebec City and Toronto. The applicant specializes in swimming pool chemicals and industrial products, sold under the applicant's brand names or through customer private label brands or through licensing and co-packaging arrangements.

[12] The applicant is the owner of the mark POOL KIT FOR DUMMIES (registered on August 24, 2004 under No. TMA617,386) for use in association with the same wares as specified in the subject application. The applicant is also the owner of the mark THE EASY, ALL IN ONE DUMMIES POOL KIT & Design (registered on November 7, 2006 under No. TMA676,559) for use in association with

water treatment chemicals; pool and accessories therefor, namely filter cartridges, skimmers, skimmer baskets, electric motors, pump bases, filter bases, pressure gauges, sight glasses for filters, filter plates, hose, hose adapters, multiport valves and knife valves.

[13] The applicant has sold pool cleaning kits under its above-mentioned marks through various retailers including Toys "R" Us, Walmart, Zellers, Home Hardware and Canadian Tire. One side of the packaging for the pool kit sold under the mark POOL KIT FOR DUMMIES displays the applied for mark TROUSSE DE PISCINE POUR LES NULS (presumably the applied for mark was not in use prior to July 12, 2004). Wholesale revenues for the applicant's pool kits amounted to about \$16,000 in 2005 and about \$8,000 in 2006. The exhibit material attached to Mr. Parik's affidavit indicates that the applicant's pool kits retail in the range of \$20 to \$30.

[14] Mr. Parik's transcript of cross-examination provides further details of the applicant's business operation and clarifies and corrects evidence in his affidavit. For example, the pool kits sold by the applicant are for smaller above ground pools rather than for large in-ground pools. The pool kits are intended for swimming pools which consumers would assemble by themselves and which would be sold by retailers such as Sears or Canadian Tire. The applicant's pool kits were sold only through Toys "R" Us and Home Hardware and only in the calendar years 2005 and 2006. The applicant's mark THE EASY, ALL IN ONE DUMMIES POOL KIT & Design, referred to earlier, was in fact never used in Canada.

LEGAL ONUS AND EVIDENTIAL BURDEN

[15] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

MAIN ISSUE & MATERIAL DATES

[16] The main issue raised in the statement of opposition is whether the applied for mark TROUSSE DE PISCINE POUR LES NULS is confusing with one or more of the opponent's marks. The legal onus on the applicant is to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below, between the applied for mark and any of the opponent's marks:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured . . . or performed by the same

person, whether or not the wares or services are of the same general class.

[17] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of the applicant's kit for cleaning small swimming pools, sold under the mark TROUSSE DE PISCINE POUR LES NULS, as being a product provided by, or endorsed by, the opponent.

[18] The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability: see *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) 413 at 424 (F.C.A.); (ii) the date of filing the application, in this case May 27, 2005, with respect to the ground of opposition alleging non-entitlement: see s.16(3)(a) of the *Trade-marks Act*; (iii) the date of opposition, in this case, May 30, 2005, in respect of the ground alleging non-distinctiveness: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R.(3d) 418 (F.C.T.D.). In the circumstances of the instant case, nothing turns on whether the issue of confusion is assessed at a particular material date.

Test for Confusion

[19] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in s.6(5) of the *Act*: the inherent distinctiveness of the 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; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

Consideration of Section 6(5) Factors

[20] The opponent's marks FOR DUMMIES and POUR LES NULS possess a fair degree of inherent distinctiveness as they are terms that would attract the attention of the average consumer. Similarly, the applied for mark possesses a fair degree of inherent distinctiveness owing to the component POUR LES NULS. I infer from the opponent's evidence that the opponent's marks had acquired a fair reputation in Canada as of the earliest material date and continued to acquire reputation through to the later material dates. The applied for mark POUR LES NULS did not acquire any reputation as of the earliest material date, but had acquired a minimal reputation as of the later material dates. The length of time that the marks in issue have been in use favours the opponent as it began to use its marks FOR DUMMIES and POUR LES NULS at least 10 years prior to the filing date of the subject application. The nature of the parties' wares and trades are different as the opponent's main focus is publishing books while the applicant's main focus is chemicals for cleaning. However, since 2001 the opponent has used its marks on various household items through licensing agreements. It appears to me that pool kits such as those sold by the applicant would be a natural area of expansion for the opponent's licensing business.

[21] The applied for mark TROUSSE DE PISCINE POUR LES NULS incorporates the whole of the opponent's mark POUR LES NULS and therefore the parties' marks resemble each other to a fair degree in all respects, that is, in appearance, sounding and in ideas suggested. Further, bilingual Canadians would recognize POUR LES NULS as the English equivalent of the opponent's mark FOR DUMMIES while Canadians speaking only English would recognize the resemblance between the opponent's mark POUR LES NULS and the applied for mark TROUSSE DE PISCINE POUR LES NULS in appearance and sounding if not in ideas suggested. That is, bilingual Canadians and unilingual French speaking Canadians would recognize the resemblance between the opponent's marks and the applied for mark to a greater extent than unilingual English speaking Canadians.

[22] Another consideration is that generally the first portion of a mark is the more important for the purposes of distinction: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 C.P.R.(2d) 183 at p.188 (F.C.T.D.). However, when a word is a common, descriptive word, its importance diminishes. In the present case, there would be a tendency to discount the importance of the descriptive words TROUSSE DE PISCINE in the applied for mark and to focus more on the distinctive term POUR LES NULS (see, for

example, *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.) at p. 263), which tends to increase the resemblance between the parties' marks.

[23] At paragraph 24(g) of its written argument, the opponent notes that the packaging adopted for the applicant's pool kits is similar in colour and design to the yellow and black colour scheme featured on the opponent's wares, which makes confusion more likely. I agree with the opponent's observation and conclusion. The opponent also submits that the applicant "did not fulfill the undertaking that it made to substantiate its claim that the resemblance between its kits and the Opponent's wares was merely coincidental" and requests that I make a negative inference that the applicant intentionally attempted to trade on the reputation of the opponent's marks. Without the benefit of an explanation from the applicant concerning its default in answering the undertaking, I have drawn the inference requested by the opponent.

[24] I would also mention that the applicant's mere ownership (rather than use) of the registered marks POOL KIT FOR DUMMIES and THE EASY, ALL IN ONE DUMMIES POOL KIT & Design is irrelevant in this proceeding. In this regard, the owner of a trade-mark registration has no automatic right to obtain any further registrations no matter how closely they may be related to the prior registration: see *Groupe Lavo Inc. v. Proctor & Gamble Inc.*, 32 C.P.R. (3d) 533 at 538 (T.M.O.B.).

DISPOSITION

[25] Considering all of the above, and taking into account in particular the inherent distinctiveness of the opponent's marks and the reputation they have acquired, and that the public is aware that the opponent cooperates with third parties to provide household items, I find that it is likely that the public, at all material times, will assume that the applicant's pool kit sold under the mark TROUSSE DE PISCINE POUR LES NULS was approved, licensed, or sponsored by the opponent. It follows that the applied for mark is confusing with the opponent's trade-marks LES NULS and FOR DUMMIES: see *Glen-Warren Productions Ltd. v. Gertex Hosiery Ltd.* (1990), 29 C.P.R.(3d) 7 at 12 (F.C.T.D.). I would add that the outcome would have been the same had I not drawn a negative inference against the applicant (see para. 23, above).

[26] In view of the foregoing and pursuant to the authority delegated to me under s.63(3) of the *Trade-marks Act*, the subject application is refused.

Myer Herzig
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office