



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

Citation: 2013 TMOB 19
Date of Decision: 2013-02-06

**IN THE MATTER OF AN OPPOSITION
by BSH Home Appliances Corporation to
application No. 1,476,618 for the trade-
mark ECOCLEAN in the name of
Controladora Mabe, S.A. de C.V.**

FILE RECORD

[1] On April 12, 2010, Controladora Mabe, S.A. de C.V. filed an application to register the trade-mark ECOCLEAN based on proposed use of the mark in association with the wares

dishwashers and washing machines.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated October 6, 2010 and was opposed by BSH Home Appliances Corporation on November 25, 2010. The Registrar forwarded a copy of the statement of opposition to the applicant on December 16, 2010, 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.

[3] The opponent's evidence consists of a certified copy of its trade-mark registration No. TMA748,635 for the mark ECOCLEAN covering the following wares:

feature of domestic cooking ovens, electric and gas ranges, electric and gas cooktops, warming drawers sold as parts of ovens, ranges and cooktops, microwave appliances, namely, microwave ovens;

ventilation devices, namely, ventilators sold as parts of hoods for ranges, ovens and cooktops;

grease filters sold as parts of hoods for ranges, ovens and cooktops.

I note that the opponent's above-mentioned Canadian registration is based on use and registration (No. 3,531,879) of its mark ECOCLEAN in the United States of America.

[4] The applicant's evidence consists of the affidavits of George A. Seaby; Todd A. Denys; and Samira Ali (accepted as additional evidence). Neither party submitted a written argument and neither party requested an oral hearing.

STATEMENT OF OPPOSITION

[5] 1. The first ground of opposition, pursuant to s.12(1)(d) of the *Trade-marks Act*, alleges that the applied-for mark ECOCLEAN is not registrable because it is confusing with the opponent's registered mark ECOCLEAN.

2. The second ground of opposition, pursuant to s.16(3) of the *Act*, alleges that the applicant is not entitled to register the mark ECOCLEAN because, at the date of filing the application, the applied-for mark was confusing with the opponent's mark ECOCLEAN which was previously used in Canada in association with ovens.

3. The third ground, pursuant to s.2, alleges that the applied-for mark ECOCLEAN is not adapted to distinguish the applicant's wares from the wares of the opponent having regard to the use and advertisement by the opponent of its trade-mark ECOCLEAN.

[6] The second and third grounds of opposition are based on the opponent having used or advertised its mark in Canada. However, as the opponent has not evidenced such use or advertising, the second and third grounds are not in issue and are therefore rejected. Of course, the opponent's evidence of a certified copy of its trade-mark registration suffices to sustain the first ground.

SUMMARY OF APPLICANT'S EVIDENCE

Todd Denys

[7] Mr. Denys identifies himself as a lawyer in the State of New Jersey. His affidavit serves to introduce into evidence, by way of an exhibit, the complete file wrapper for the

opponent's United States trade-mark registration No. 3,531,879 (referred to in para. 3, above).

[8] Without the benefit of written submissions or oral argument from the applicant, I am unable to ascertain the probative value of Mr. Denys' evidence. In this regard, I would note that the validity of the opponent's Canadian trade-mark registration, which is based on the above-mentioned American registration, is not in issue in this proceeding. That is, even if there was some impropriety in basing the Canadian registration on the United States registration, this Board would not look behind the Canadian registration to question its validity.

George Seaby

[9] Mr. Seaby identifies himself as a registered Canadian trade-mark agent. On September 9, 2011, he conducted a search of the Canadian Trade-marks register for "the term ECOCLEAN or ECO and CLEAN." The results of his search are attached as Exhibit A to his affidavit.

[10] My inspection of Exhibit A indicates that, apart from the subject application and the opponent's registration, there are 9 such marks (4 registrations and 5 applications) standing in the names of 7 different owners. The nine marks cover a diverse range of wares and services including, for example, hydraulic fluids, coolants, small animal feeders, and carpet cleaning.

[11] Presumably, the applicant seeks to rely on the state of the register evidence to establish that the term ECOCLEAN is a common trade-mark and for that reason have this Board conclude that the ambit of protection accorded to the opponent's mark ECOCLEAN should be restricted. However, I do not consider Mr. Seaby's evidence to be of much probative value because (i) only a few ECOCLEAN marks have been located and (ii) no ECOCLEAN marks for use in association with wares similar to the opponent's wares have been evidenced.

Samira Ali

[12] Mr. Ali identifies himself as an "investigator" with the firm King-Reed & Associates LP. He investigated whether the third party marks located by Mr. Seaby were

in fact in actual use in Canada. A detailed report of his findings is attached as Exhibit A to his affidavit. In summary, two parties were actually using the mark ECOCLEAN (in the oil and gas extraction industry and in the fuel additive industries) and another party was about to commence use of the mark ECOCLEAN (for bird feeders).

[12] I do not consider Mr. Ali's evidence to be of much probative value since his findings do not relate to the domestic appliance industry.

FIRST GROUND OF OPPOSITION

[13] The material time to consider the first ground of opposition is the date of my decision: see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130 (FCA) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 CPR (3d) 413 at 424 (FCA). The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below:

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.

[14] Thus, s.6(2) concerns 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 dishwashers and washing machines to be sold in association with the applied-for mark ECOCLEAN as being sold, licensed or endorsed by the opponent.

Test for Confusion

[15] 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 "all the surrounding circumstances including" those specifically mentioned in s.6(5)(a) to s.6(5)(e) 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 and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as 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 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Consideration of s.6(5) Factors

[16] The marks in issue have equal degrees of inherent distinctiveness as they are identical. Further, there is no evidence that either mark has become known in Canada. The first factor therefore favours neither party. Similarly, the second factor favours neither party because there is no evidence from either party relating to use of their marks in Canada.

[17] In the absence of evidence from the opponent, I conclude from the description of wares in the opponent's registration that the opponent deals in components for ovens and ranges and the like, rather than in completely assembled appliances. The parties' wares are therefore quite different although both parties are involved in the field of large domestic appliances. In the absence of evidence to the contrary, I assume that the nature of the parties' businesses and trades are more different than alike because the parties' wares are more different than alike. The third and fourth factors, considered together, therefore favour the applicant. Of course, the last factor favours the opponent since the parties' marks are identical.

Jurisprudence

[18] I have also been guided by the approach taken in *Coventry Inc. v. Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) wherein the opponent was relying on its mark SARAH. The opponent's mark was not inherently strong and had not acquired significant distinctiveness through use or advertising or other means (at para. 6):

The trade mark SARAH is a commonly used female Christian name and as such offers little inherent distinctiveness: *Bestform Foundations Inc. v. Exquisite Form Brassiere (Canada) Ltd.* (1972), 34 C.P.R. (2d) 163. Such marks are considered to be weak marks and are not entitled to a broad scope of protection: *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 7 C.P.R. (2d) 1, [1972] F.C. 1271; and *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154. . . . However, the degree of distinctiveness attributed to a weak mark may be enhanced through extensive use: *GSW Ltd. v. Great West Steel, supra.*
(underlining added)

[19] Similarly, in the instant case, the opponent is relying on a weak mark since the term ECOCLEAN is suggestive of “ecologically friendly” products. Further, the opponent has not submitted any evidence to show that the low inherent distinctiveness of its mark has been so enhanced by use and advertising that it is entitled to a broadened scope of protection, that is, beyond the wares specified in its registration.

[20] In view of the foregoing, I find that the applicant has met the legal onus on it to show, on a balance of probabilities, that at this time there is no reasonable likelihood of confusion between the applied-for mark ECOCLEAN and the opponent’s registered mark ECOCLEAN. Accordingly, the first ground of opposition is rejected.

DISPOSITION

[20] In view of the foregoing, the opposition is rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

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