

IN THE MATTER OF AN OPPOSITION
by Diversey Wyandotte Inc. to
application No. 562,273 for the
trade-mark SPECTRUM filed by
The Clorox Company, a California
Corporation (now The Clorox
Company, a Delaware Corporation)

On May 9, 1986, The Clorox Company, a California Corporation, filed an application to register the trade-mark SPECTRUM for "household laundry bleach" based on use and registration (No. 1,385,687) in the United States. The application was advertised for opposition purposes on October 8, 1986. As a consequence of a merger, the application now stands in the name of The Clorox Company, a Delaware Corporation.

The opponent, Diversey Wyandotte Inc., filed a statement of opposition on November 7, 1986, a copy of which was forwarded to the applicant on December 18, 1986. The grounds of opposition are that the applied for trade-mark is not registrable and is not distinctive and the applicant is not the person entitled to registration because its mark is confusing with the opponent's previously used trade-mark SPECTRUM registered under No. 229,073 for "quarternary [sic] liquid ammonia disinfectant."

The applicant filed and served a counterstatement. As its evidence, the opponent filed the affidavit of Larry John Couse. The applicant elected not to file evidence. Both parties filed written arguments and an oral hearing was conducted at which both parties were represented.

As for the opponent's first ground of opposition, the material time for considering the circumstances respecting the issue of confusion arising pursuant to Section 12(1) (d) of the Trade-marks Act is as of the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks of the parties. 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.

The marks of both parties are inherently distinctive, the word "spectrum" having no apparent relation to the nature of the associated wares. The applicant submits that the appearance on the trade-marks register of a number of third party registrations for the word "spectrum" for various wares establishes that it is inherently weak as a trade-mark in the hands of any particular trader. However, the applicant failed to evidence the state of the register and, in general, the Registrar in opposition proceedings will not have regard to the state of the register unless proved by evidence: see, for example, the opposition decision in Realestate World Services (1978) Ltd. v. O'Connor (1989), 24 C.P.R. (3d) 95 at 98.

In view of the absence of evidence from the applicant, I must conclude that its mark had not become known at all in Canada as of the material time. The opponent's mark, on the other hand, has been continuously used in Canada for a number of years. However, given the limited sales and the limited market, I can only ascribe a limited reputation for the opponent's mark within such areas of commerce as the food processing industry and the food service industry.

The length of time the marks have been in use clearly favors the opponent. The wares of the parties are not the same but they are related. The opponent's SPECTRUM product is a "liquid quaternary ammonium disinfectant/sanitizer" (see Exhibit B to the Couse affidavit) with various applications in the food industry and in restaurants, taverns and the like. The applicant's product is a "household laundry bleach" and, as stated by Mr. Couse, bleach is a disinfectant and can be used for the same purposes as liquid quaternary ammonium disinfectant.

The applicant submits that the applicant's product doesn't contain chlorine and is therefore useless as a disinfectant. However, there is no evidence to indicate the particular type of household laundry bleach the applicant will be selling. More importantly, the applicant's statement of wares is unrestricted as to the particular type of bleach for which registration is sought. The issue of confusion in this case is to be assessed based on the statement of wares in applicant's application, not on the particular wares which the applicant may subsequently sell.

The applicant also sought to distinguish the trades of the parties on the basis that the opponent, to date, has been selling to the institutional trade whereas "household laundry bleach" would be sold through ordinary retail grocery stores. However, the statements of wares in the opponent's registration and the applicant's application are not so restricted. In other words, the scope of the opponent's registration allows for the opponent to sell its wares through ordinary retail channels. Furthermore, it is quite possible that at least some of the opponent's current institutional customers could also be purchasers of the applicant's product. Finally, Mr. Couse states in paragraph 9 of his affidavit that the opponent is engaged in the manufacture and sale of products in the nature of disinfectants and bleaches. Thus, there is a potential overlap in the trades of the parties. In this regard, reference may be made to the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R. (3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R. (3d) 110 at 112 (F.C.A.).

As for Section 6(5) (e) of the Act, the marks of the parties are identical in all respects.

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 noted above, and particularly in view of the identity between the marks, the similarity in the natures of the wares and the potential overlap in the trades of the parties, I find that the applicant has failed to satisfy the onus on it to show no reasonable likelihood of confusion. Thus, the first ground of opposition is successful and the remaining grounds need not be considered.

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

DATED AT HULL, QUEBEC, THIS 31st DAY OF May, 1990.

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