



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

**Citation: 2014 TMOB 36**  
**Date of Decision: 2014-02-20**

**IN THE MATTER OF AN OPPOSITION  
by Rodam International Inc. to  
application No. 1,454,434 for the trade-  
mark RONBOW in the name of Ronbow  
Corporation**

Introduction

[1] This opposition relates to an application filed on September 25, 2009 by RonBow Materials Corp. (RonBow), which subsequently changed its name for Ronbow Corporation (Ronbow) (both RonBow and Ronbow indistinctively referred to as the Applicant) to register the trade-mark RONBOW (the Mark). The application covers: sinks; lavatories; bathroom vanities; wood furniture; and countertops related to bathroom furniture and bathroom cabinets (the Wares). It is based on use of the Mark since August 5, 2005.

[2] The application was advertised on November 24, 2010 in the *Trade-marks Journal*. Rodam International Inc. (the Opponent) filed a statement of opposition on January 24, 2011.

[3] The grounds of opposition raised by the Opponent are based on sections 30(a), 30(e), 30(i), 12(1)(d), 16(1)(a) and (c), and section 2 (distinctiveness) of the *Trade-marks Act* RSC 1985, c T-13, (the Act). The specific grounds of opposition are detailed in Schedule A annexed to this decision.

[4] The Applicant in its counterstatement raised the issue of the sufficiency of the pleadings in respect to grounds of opposition relating to sections 30(a) and (b) of the Act and requested an

interlocutory ruling. For reasons unknown, the Registrar did not issue an interlocutory decision. As it will appear from this decision the Applicant will not suffer a prejudice from this situation.

[5] The Opponent filed as its evidence the affidavit of André Madore and certified copies of Canadian registrations TMA547642 for RAINB’O and design; TMA621441 for RAINB’O & Design; TMA697442 for DUAL RAINB’O MASSAGE; and TMA697443 for RAINB’O MASSAGE. An order for the cross-examination of Mr. Madore was issued but the Applicant chose not to proceed. The Applicant filed the affidavits of Jason Chen and Ryan Viterbo.

[6] Only the Applicant filed a written argument and there was no hearing.

[7] The first issue is to determine if the Opponent has met its evidential burden; if so then I must assess whether the Applicant has met its legal onus.

[8] For the reasons detailed hereinafter, I conclude that the Opponent did not meet its evidential burden with respect to the grounds of opposition based on sections 30(a), (b) and (i) of the Act. While the Opponent met its evidential burden with respect to the remainder of its grounds of opposition, the Applicant has satisfied its onus. Therefore all of the Opponent’s grounds of opposition are dismissed.

#### Legal Onus and Burden of Proof

[9] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached in favour of the Applicant once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

### Preliminary Remarks

[10] In coming to my decision I have considered all of the evidence and submissions made by the parties; however, only the portions of the evidence and submissions which are directly relevant to my findings will be discussed in the body of my decision. Also any ambiguities in the evidence filed will be interpreted against the party who filed that portion of the evidence [see *Footlocker Group Canada Inc v Steinberg* (2005), 38 CPR (4th) 508].

### Grounds of Opposition Summarily Dismissed

[11] Section 30(i) of the Act only requires the Applicant to declare itself satisfied that it is entitled to use the Mark in Canada in association with the wares and services described in the application. Such a statement is included in this application. An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[12] As for the ground of opposition based on section 30(a) of the Act, the Opponent has not provided any evidence that would support that ground of opposition.

[13] With respect to the section 30(b) ground of opposition again the Opponent has not filed any evidence that would support it. Moreover the Applicant's evidence, which could be used by the Opponent to meet its initial burden, is not clearly inconsistent with the alleged date of first use claimed by the Applicant in its application.

[14] Consequently the grounds of opposition based on section 30(a), (b), and (i) of the Act are dismissed because the Opponent failed to meet its initial evidentiary burden.

### Ground of Opposition based on Section 12(1)(d) of the Act

[15] The relevant date to assess this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[16] The Opponent has filed a Certificate of Authenticity for the following registered trade-marks:

RAINB'O MASSAGE, TMA697443 for bath and shower products and accessories, namely shower massagers, shower heads, shower arms, hand-held shower units, shower arms, shower bath, shower bath with massage systems, hot tub with massage systems, spa, and faucets;

DUAL RAINB'O MASSAGE, TMA697442 for bath and shower products and accessories, namely shower massagers, shower heads, shower arms, hand-held shower units, shower arms, shower bath, shower bath with massage systems, hot tub with massage systems, spa, and faucets;

RAINB'O and design, shown below, TMA547642 for shower products and accessories: namely hooks, brackets, pressure balancers, fittings, inverters, drain plugs, shut-off valves, adjustable yokes, shower arms, shower heads, bath faucets; shower massagers; shower pipes:



RAINB'O & Design, shown below, TMA621441 for shower products and accessories: namely hooks, brackets, pressure balancers, fittings, inverters, drain plugs, shut-off valves, adjustable yokes, shower arms, shower heads, bath faucets; shower massagers; shower pipes:



[17] I have exercised my discretion to check the register and note that all of these registrations are extant. Therefore the Opponent has met its initial burden with respect to this ground of opposition [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[18] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have 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 or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight but the most important factor is often the degree of resemblance between the marks [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[19] The test under section 6(2) of the Act 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 section 6(2) is whether a consumer who sees the Applicant's Wares bearing the Mark, would think they emanate from or sponsored by or approved by the Opponent.

[20] For the purpose of this analysis I shall compare the Mark to the Opponent's registered trade-marks RAINB'O & Design and RAINB'O MASSAGE. If the Opponent is not successful under any of those two registered trade-marks, it would not achieve a better result by comparing the Mark to its other two registered trade-marks.

*Inherent distinctiveness of the trade-marks and the extent to which they have become known*

[21] The Mark is a coined word, so is the word component RAINB'O, part of the Opponent's registered trade-marks. However the pronunciation of the latter is identical to the word 'rainbow'. The design feature of RAINB'O & Design adds to the distinctiveness of that mark. As for RAINB'O MASSAGE I believe that it is less inherently distinctive than the Mark as it is suggestive of a shower massage, when used in association with the Opponent's products listed under that registration and enumerated above.

[22] Any mark may acquire distinctiveness through extensive use. I shall now describe the evidence filed by the parties with respect to the use of their trade-marks.

[23] Mr. Chen has been the Applicant's President since 2002. He states that the Applicant is an American bathroom furnishings company that designs and manufactures decorative bathroom

furniture, including, sinks, vanities, cabinets and countertops. He filed product catalogues illustrating those wares in association with the Mark going back to 2008. He alleges that the Applicant's products are distributed around the world, including Canada wherein the Applicant has 73 authorized distributors. He provides a list of those distributors.

[24] Mr. Chen alleges that the Applicant has been using the Mark in Canada in association with the Wares since August 2005. To support such contention he filed an invoice dated August 5, 2005. He states that wholesale sales of the Wares in association with the Mark to Canadian distributors and retailers in Canada have totalled over \$2.2 million since 2005.

[25] Mr. Chen explains that the Mark is displayed on the Wares by way of a metal plate which is fixed to the inside of each cabinet sold by the Applicant in Canada. He filed a picture of such plate. He also filed a picture (exhibit E to his affidavit) of a packing box marked 'Ronbow Corp' in which the Wares are shipped by the Applicant to Canada. However this illustration constitutes evidence of use of the Applicant's trade name and not the Mark.

[26] Mr. Chen asserts that the Mark has been advertised and promoted throughout Canada through the Applicant's website which is accessible to Canadians but no information has been provided on the number of Canadian visitors. The Mark appears on the Applicant's letterhead. The Applicant also distributes product booklets, pamphlets and adhesive labels to Canadian sales representatives and dealers on which the Mark is printed. There are in-store point-of-purchase advertisements bearing the Mark that are distributed to sales representatives and dealers in Canada.

[27] Mr. Chen affirms that the Mark has also been advertised and promoted:

- at industry trade-shows that are attended by Canadian bathroom furnishing manufacturers, distributors and retailers but he has not identified those shows; where and when they were held;
- on television such as on HGTV and the Designing Spaces television show aired on January 1, 2007 but we have no information as to whether it was broadcasted in Canada and if so, how many Canadians viewed those advertisements;

- on the Internet through YouTube and he filed a disk containing four video advertisements but we have no information on their viewing by Canadians;
- on the radio in Canada but we have no information on which station(s), when, where and how many Canadians listened to those radio advertisements; and
- in magazine advertising. He lists the magazines but none of them are so well known (for example *Metropolitan Home*, *Traditional Home*, *Elle Décor*) that I can take judicial notice of their circulation in Canada. We have no information on the scope of their circulation in Canada.

[28] Mr. Chen states that the Applicant has spent over \$1 million on print advertising of the Wares bearing the Mark from 2008 to 2010 in North America, including Canada. However we have no breakdown for Canada.

[29] From all this evidence, in view of the deficiencies outlined above about the extent of the promotion of the Mark in association with the Wares in Canada, I can only rely on the sales figures mentioned above to conclude that the Mark is known to some extent in Canada.

[30] Mr. Madore is the Opponent's President, a company located in Laval, Quebec. He alleges that the Opponent is in the business of the sale of bath and shower products and accessories including shower massagers, shower heads, shower arms and shower pipes, sinks and cabinets. He filed extracts of the Opponent's website as well corporate brochures describing the Opponent's business activities. I note that the documentation filed refers mainly to the trademark RAINB'O & Design in association with shower massagers, shower heads, shower arms and shower pipes. There are illustrations of various cabinet models on a brochure filed as exhibit 2 to his affidavit but bathroom cabinets and vanities are not covered by any of the Opponent's registrations mentioned above.

[31] As noted by the Applicant in its written argument Mr. Madore uses defined terms in his affidavit such as 'Produits' to refer to the various products sold by the Opponent as well as 'Marques de ma Compagnie' to refer to the Opponent's registered trade-marks, as only the Opponent's registered trade-marks are included under that defined term. Therefore when Mr.

Madore states for example that his company sells ‘les Produits sous les Marques de ma Compagnie’ there is no breakdown per product and per trade-mark. Such ambiguity shall be interpreted against the Opponent. In order to use terms similar to those mentioned in Mr. Madore’s Affidavit, I shall utilize the terms ‘Products’ for ‘Produits’ and ‘the Opponent’s registered trade-marks’ for ‘Marques de ma Compagnie’.

[32] Mr. Madore affirms that the Opponent’s Products are available in Canada in retail stores such as Rona, Reno Dépôt, Groupe B.M.R., Home Hardware, Linen Chest, to name some of them. He filed as exhibit 3 to his affidavit pictures of various packaging. They bear the trade-mark RAINB’O MASSAGE and/or RAINB’O & Design. They are packages for shower massagers, shower heads, shower arms and shower pipes. There is no reference in exhibit 3 to cabinets and sinks.

[33] Mr. Madore provides the approximate annual sales figures of the Products bearing one of the Opponent’s registered trade-marks since 2001, varying between approximately 1 million dollars to 3 million dollars. Again there is no breakdown per product and per trade-mark.

[34] Mr. Madore alleges that the Opponent has been spending approximately \$100,000 per year in promoting and advertising the Products bearing the Opponent’s registered trade-marks. He alleges that advertisements appeared in various magazines. He filed samples of some advertisements of various models of shower heads, shower massagers and shower arms in association with the trade-mark RAINB’O & Design. However we have no information on the circulation figures of the magazines listed in paragraph 9 of Mr. Madore’s affidavit (for example *Décoremag*, *Chez Soi*, *Votre Maison*) nor the frequency of those advertisements.

[35] Mr. Madore filed numerous invoices from November 2003 to March 2011 for the sale of various shower products and accessories; shower heads, shower massagers, shower arms and shower pipes. There are approximately one hundred invoices filed. Mr. Madore explains that the abbreviation ‘RAI’ appearing beside the description of the items listed on the invoices stands for RAINB’O products.

[36] Four invoices include the sale of bathroom vanities and cabinets. None of them have the abbreviation ‘RAI’ beside them. The abbreviation used is either ‘VAN’ for vanity or ‘MIR’ for



mirror. Therefore there is no evidence of a sale of vanities or cabinets in association with the Opponent's trade-marks RAINB'O & Design or RAINB'O and design. Mr. Madore did file extracts of the Opponent's website dated June 8, 2011 illustrating basins and vanities. There is a reference to the unregistered word mark RAINB'O but not to either RAINB'O & Design or RAINB'O and design.

[37] From all this evidence I conclude that the trade-mark RAINB'O & Design is known in Canada to some extent but only in so far as shower products and accessories; shower heads, shower massagers and shower pipes are concerned.

[38] Overall this factor slightly favours the Opponent because of its volume of sales since 2001.

*The length of time the trade-marks have been in use*

[39] Mr. Chen, as stated above, affirms that the Applicant began using the Mark in August 2005 while Mr. Madore has provided sales figures of the Opponent's Products since 2001 and invoices going back to July 2003. Consequently this factor favours the Opponent.

*The nature of the wares, services, or business; the nature of the trade*

[40] Under section 12(1)(d) ground of opposition I must compare the Wares as described in the application with the wares covered by the Opponent's registrations [See *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determine the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[41] The Opponent's registration TMA621441 for RAINB'O & Design covers shower products and accessories: namely hooks, brackets, pressure balancers, fittings, inverters, drain

plugs, shut-off valves, adjustable yokes, shower arms, shower heads, bath faucets; shower massagers; shower pipes. The present application covers sinks; lavatories; bathroom vanities; wood furniture; and countertops related to bathroom furniture and bathroom cabinets. Consequently we have on one hand shower products and accessories and on the other hand bathroom furniture. The parties' products differ in their general nature.

[42] This factor favours the Applicant.

[43] As for the channels of trade, it would appear that there could be some overlap as the Applicant's distributors (see exhibit B to Mr. Chen's affidavit) include plumbing retailers (for example York West Plumbing Supply, Inc., Knowles Plumbing Ltd., Plumbing Warehouse, etc...). Consequently this factor favours the Opponent.

#### *The degree of resemblance*

[44] As stated earlier, in its judgment in *Masterpiece* the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks. The appropriate test is not a side by side comparison but the imperfect recollection in the mind of a Canadian consumer of the Opponent's marks.

[45] Registration TMA621441 for RAINB'O & Design has the following features: a sea horse, a triangle design, the word RAINB'O and the presence of an apostrophe between the letters 'b' and 'o'. Consequently RAINB'O & Design is visually different than the Mark. The ideas suggested by the marks are also different. The sea horse design combined with the phonetic equivalent of the word 'rainbow' suggests the idea of water. As for the Mark it is a coined word resulting of the combination of the first name 'Ron' with the word 'bow'. Consequently the marks in issue differ in appearance and in the ideas suggested by them.

[46] Phonetically they are not similar as the Mark starts with 'Ron' (x-ON), while the Opponent's trade-marks start with the component 'rain' (x-ANE).

[47] As for a comparison with registration TMA697,443 for RAINB'O MASSAGE, overall the Mark is still phonetically and visually different for the reasons explained previously as well

as because of the presence of the additional word ‘massage’. The ideas suggested by the marks in issue also differ. The trade-mark RAINB’O MASSAGE when used in association with shower products suggests the idea of a shower massage.

*Additional surrounding circumstances*

[48] Mr. Viterbo has been a law clerk employed by the Applicant’s agent firm. He was asked to obtain printouts of various trade-mark registrations and/or applications. From exhibits D to Y inclusive I consider only the following citations to be relevant:

RONA, certificate of registration TMA724249 for *inter alia* shower products, cabinets and vanities;

RONDO, certificate of registration TMA139337 for wash basins and lavatories;

AMBIENT RAIN, certificate of registration TMA731056 for *inter alia*, showers;

RAINDANCE, certificate of registration TMA649848 for *inter alia*, showers;

RAINFOREST, certificate of registration TMA537450 for *inter alia*, showers;

RAGING RAIN, certificate of registration TMA624350 for *inter alia*, pulsating shower head;

RAINMAKER, certificate of registration, TMA741383 for *inter alia*, shower heads.

[49] I purposely omitted other citations as the marks covered by these registrations differ visually or phonetically or the wares covered by the registrations are different (for example: ROI DU BAIN, RP ROMAGNAPLASTIC BUILT-IN KITCHEN SOLUTIONS & DESIGN).

[50] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large number of relevant registrations are located [see *Maximum Nutrition Ltd v Kellogg Salada*

*Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. The number of relevant citations does not enable me to infer that consumers are accustomed to see the term ‘rain’ as part of trade-marks used in association with shower products and/or bathroom cabinets and vanities.

[51] Mr. Viterbo also filed extracts of Waterpik’s website on which appears the trade-mark RAINFALL+ in association with shower heads. Finally Mr. Viterbo filed extracts of numerous websites relating to the use of the word ‘rainbow’ in association with shower systems and shower heads. However for this last portion of Mr. Viterbo’s affidavit I have no evidence that the products illustrated on the webpages filed have been sold and/or available in Canada. For example, the prices of some of these products are in foreign currency. Finally this portion of the evidence might constitute hearsay evidence [see *Envirodrive Inc v 836442 Canada Inc* 2005 ABQB 446].

#### *Conclusion*

[52] I conclude, with respect to section 12(1)(d) ground of opposition, that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent’s registered trade-marks RAINB’O MASSAGE and RAINB’O & Design.

[53] I reach this conclusion based on the fact that the parties’ marks do not resemble one another visually, phonetically and in the ideas suggested by them. Also their respective wares are different.

[54] Consequently the ground of opposition based on section 12(1)(d) is dismissed

#### Grounds of Opposition based on Section 16 (1)(a) and (c)

[55] With respect to the ground of opposition based on section 16(1)(c) of the Act, the Opponent must establish use of its trade name Rodam International Inc. in Canada prior to August 5, 2005, the claimed date of first use of the Mark, and non- abandonment thereof at the advertisement date of this application (November 24, 2010) [see sections 16(1) and (5) of the Act].

[56] There is no definition in the Act of what constitutes use of a trade name. The topic was discussed in the case of *Mr. Goodwrench Inc v General Motors Corp*, (1994) 55 CPR (3d) 508 (FCTD) wherein Simpson J. stated:

There are no provisions in the Act which define and describe the use of a trade name. However, in his decision in *Professional Publishing Associates Ltd. v. Toronto Parent Magazine Inc.* (1986), 9 C.P.R. (3d) 207 Mr. Justice Strayer considered the problem and held that the principles in ss. 2 and 4(1) of the Act apply to trade name use. In this regard, His Lordship said:

While there is no definition in the Trade Marks Act of "use" in relation to trade names, I am satisfied that consistent with the purposes of the Act such "use" would have to be in the normal course of trade and in relation to the class or classes of persons with whom such trade is to be conducted.

Accordingly, use in the normal course of trade will be the test applied in these reasons.

[57] The Opponent's trade name appears on the invoices filed by Mr. Madore as exhibit 6 to his affidavit. As mentioned before the earliest one goes back to May 2003. There are invoices bearing the Opponent's trade name from 2003 to March 2011 inclusive. As such, I consider that the Opponent has met its initial burden with respect to this ground of opposition. Consequently I have to determine if there is any likelihood of confusion between the Mark and Rodam International Inc.

[58] Even though there is some evidence of use of the Opponent's trade name in association with bathroom cabinets and vanities (four invoices), there is no resemblance between Rodam International Inc. and RONBOW except to say that they both start with the letters 'RO'. This is certainly not sufficient to conclude that there is some degree of resemblance when we look at the Opponent's trade name and the Mark in their entirety. They do not resemble visually and in sound. As for the ideas suggested by them, both 'Rodam' and 'Ronbow' are coined words with no particular meaning when used in association with the parties' respective wares.

[59] Consequently the ground of opposition based on section 16(1)(c) is dismissed.

[60] As for the ground of opposition based on section 16(1)(a) of the Act, the Opponent had the initial burden to show prior use of its registered trade-marks as well as the word mark RAINB'O and that such use had not been abandoned at the advertisement date of the present application (November 24, 2010) [see section 16(5) of the Act].

[61] The only distinction I can make with the ground of opposition of registrability (section 12(1)(d) of the Act) is that I have to take into consideration the sales of the Opponent's bathroom cabinets and vanities. However I have no evidence that they were sold in association with the trade-mark RAINB'O & Design or RAINB'O.

[62] Finally the analysis of the degree of resemblance between the parties' respective trade-marks done under that former ground of opposition would still apply here and thus favours the Applicant in so far the Opponent's registered trade-marks are concerned. As for the Opponent's word mark RAINB'O, the Mark still does not resemble it visually, phonetically and the ideas suggested by the parties' marks are different. RAINB'O suggests a 'rainbow' while the Mark is a coined word with no suggestive meaning.

[63] For reasons similar to those expressed under the ground of opposition of registrability I conclude that the Applicant has met its burden to show that the Mark is not confusing with any of the Opponent's trade-marks. I therefore dismiss the ground of opposition of entitlement based on section 16(1)(a) of the Act.

#### Distinctiveness

[64] The relevant date generally accepted for this ground of opposition is the filing date of the statement of opposition (January 24, 2011) [see *Andres Wines Ltd v E&J Gallo Winery* (1975), 25 CPR (2d) 126 (FCA)].

[65] The Opponent has the initial evidential burden to prove that at least one of its trade-marks had become sufficiently known in Canada on January 24, 2011 to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. Once this initial burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely creating confusion with the Opponent's trade-marks at the relevant date such that it was adapted to distinguish or actually did distinguish throughout Canada the Wares from the Opponent's wares [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[66] The Opponent's volume of sales mentioned earlier is sufficient to conclude that the Opponent has met its initial burden. The difference in the relevant dates under this ground of opposition and those examined previously (entitlement under section 16(1) and registrability under section 12(1)(d) of the Act) would not alter the conclusions I already reached on the issue of likelihood of confusion between the parties' marks. Consequently I conclude that the Mark was distinctive and was apt to distinguish the Wares from the Opponent's wares at the relevant date.

[67] The ground of opposition under distinctiveness is also dismissed.

#### Disposition

[68] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## Schedule A

The grounds of opposition raised by the Opponent can be summarized as follow:

1. The application does not comply with the requirements of section 30(a) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the application does not contain a statement in ordinary commercial terms of the specific wares with which the Mark has been used;
2. The application does not comply with the requirements of section 30(b) of the Act in that the application does not contain the date of first use of the Mark in Canada. Moreover even if the Mark has been used in Canada at the alleged date of first use, the Mark has not been used in association with each of the Wares and has not been continuously used since that date;
3. The application does not comply with the requirements of section 30(i) of the Act in that the Applicant could not have been satisfied and cannot be satisfied that it is entitled to use the Mark in Canada in association with the Wares as at the filing date of the application the Applicant was aware of the Opponent's use of its trade-marks;
4. The Mark is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the Opponent's registered trade-marks:
  - RAINB'O and design, certificate of registration TMA547642 owned by the Opponent in association with shower products and accessories: namely hooks, brackets, pressure balancers, fittings, inverters, drain plugs, shut-off valves, adjustable yokes, shower arms, shower heads, bath faucets; shower massagers; shower pipes;
  - RAINB'O & Design, certificate of registration TMA 621441 owned by the Opponent for shower products and accessories: namely hooks, brackets, pressure balancers, fittings, inverters, drain plugs, shut-off valves, adjustable yokes, shower arms, shower heads, bath faucets; shower massagers; shower pipes
  - DUAL RAINB'O MASSAGE, certificate of registration TMA697442 owned by the Opponent for bath and shower products and accessories, namely shower massagers, shower heads, shower arms, hand-held shower units, shower arms, shower bath, shower bath with massage systems, hot tub with massage systems, spa, and faucets;à
  - RAINB'O MASSAGE, certificate of registration TMA697443 owned by the Opponent for bath and shower products and accessories, namely



shower massagers, shower heads, shower arms, hand-held shower units, shower arms, shower bath, shower bath with massage systems, hot tub with massage systems, spa, and faucets;

5. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(1)(a) of the Act in that at the claimed date of first use of the Mark it was confusing with the trade-marks mentioned above as well as RAINB'O in association with bath and shower products and accessories, namely shower massagers, shower heads, shower arms, hand-held shower units, shower arms, shower bath, shower bath with massage systems, hot tub with massage systems, spa, and faucets, kitchen and bathroom furniture that had been previously used in Canada since January 1994 in association with the wares mentioned above as well as in association with the business of offering for sale and distribution those products;
6. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(1)(c) of the Act in that at the claimed date of first use of the Mark it was confusing with the Opponent's trade name Rodam International Inc. used in Canada since at least January 1994 in association with the wares and services of the Opponent described above;
7. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive of the wares or services of the Applicant since the Mark does not actually distinguish nor is adapted to so distinguish the Wares of Applicant from the wares or services of the Opponent in association with which the Opponent has used in Canada its trade-marks and trade name mentioned above.