



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

Citation: 2014 TMOB 86
Date of Decision: 2014-04-25

**IN THE MATTER OF AN OPPOSITION
by Red-White Valve Corp. to application
No. 1,395,375 for the trade-mark
EASYGRIP in the name of America-
inner Plumbing Technologies Inc.**

[1] On May 13, 2008, America-inner Plumbing Technologies Inc. (the Applicant) filed an application to register the trade-mark EASYGRIP (the Mark) in association with the wares “plumbing supplies, namely, push fit fittings, push fit ball valves and push fit angle valve” (the Wares) based on use in Canada since January 5, 2008.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 10, 2010.

[3] On May 7, 2010, Red-White Valve Corp. (the Opponent) filed a statement of opposition. The statement of opposition as pleaded includes a non-registrability and a non-entitlement ground of opposition that are based on confusion with the Opponent’s US trade-mark registration for EZGRIP and use of that mark in the US. These grounds of opposition are dismissed on the basis that they are not proper grounds of opposition. The remaining grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the application does not comply with section 30(b) of the Act because the Applicant has not used the Mark in Canada since January 5, 2008;

- pursuant to sections 38(2)(b) and 12(1)(b) of the Act, the Mark is not registrable as it is clearly descriptive or deceptively misdescriptive of the character or quality of the Wares;
- pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable as it is confusing with the Opponent's registered trade-mark EZGRIP owned and used by the Opponent subject to registration No. TMA764,605 covering the following wares: "manually operated metal valves for fluid control for commercial, industrial and domestic plumbing use; plumbing fittings, namely fluid control valves for showers and tubs" (the Opponent's Wares);
- pursuant to sections 38(2)(c) and 16(1)(a) of the Act, the Applicant is not entitled to registration of the Mark as it is confusing with the trade-mark EZGRIP owned by the Opponent and used in Canada;
- pursuant to sections 38(2)(c) and 16(1)(b) of the Act, the Applicant is not entitled to registration of the Mark as it is confusing with the Opponent's trade-mark EZGRIP an application for which was filed March 7, 2008 (1,386,566); and
- pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive in that it does not actually distinguish nor is it adapted to distinguish the Wares from the wares of others, including those of the Opponent.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed affidavits of Daniele Degiovanni, the Financial Manager for VIR Valvoindustria Ing. Rizzio S.p.A.; Jan Rich Neal, the Vice President of Administration for the Opponent; Xin Xu, a legal assistant for the Opponent's agent as well as certified copies of the Opponent's Canadian and US registrations for the trade-mark EZGRIP (TMA764,605 and 3609771 respectfully). The Opponent also filed affidavits of R. Antonia Viera and Xin Xu as its evidence in reply.

[6] In support of its application, the Applicant filed affidavits of Qifu Xie, the Applicant's President; Jean Lee, an articling student employed by the Applicant's agent and Lynda Palmer, a trade-mark searcher contracted by the Applicant's agent to conduct a search. Only Mr. Xie was cross-examined.

[7] Only the Opponent filed a written argument and an oral hearing was not held.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[9] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- sections 38(2)(b)/12(1)(b) - the date of filing the application [see *Fiesta Barbeques Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)];
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(1) - the date of filing the application [see section 16(1) of the Act]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Section 12(1)(d) of the Act – Is the Mark confusing with the Opponent’s registered trade-mark EZGRIP?

[10] An opponent’s initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the Opponent’s registration for the trade-mark EZGRIP (TMA764,605) remains valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[11] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[12] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[13] Both parties' marks are coined words made up of the words EASY (or the phonetic equivalent EZ) and GRIP. I am of the view that the parties' marks share the same degree of inherent distinctiveness.

[14] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[15] The Applicant has established use of the Mark in Canada since December 8, 2007 with not insubstantial sales figures for the years 2007 – 2011. The Opponent has established use of its EZGRIP mark in Canada since June 26, 2008 with similar sales figures to those of the Applicant from 2008 - 2010.

[16] Based on the foregoing, when considered as a whole this factor does not significantly favour either party.

Section 6(5)(b) – the length of time each has been in use

[17] As discussed in more detail above in the analysis of the section 6(5)(a) factor, the Applicant has used the Mark in Canada since December 8, 2007 and the Opponent has established use in Canada of its EZGRIP mark since June 26, 2008. Thus this factor does not significantly favour either party.

Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade

[18] When considering the nature of the parties' wares, services and business and the nature of the parties' trade, it is the statements of wares in the application and the Opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is ambiguity as to the wares or services covered in the application or registration at issue [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); *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[19] I agree with the Opponent that the parties' wares share a significant degree of similarity. Both parties offer plumbing supplies. There is in fact direct overlap between the parties' wares as they both include valves for plumbing. The parties' channels of trade also overlap. The evidence shows that both parties sell their wares to wholesale suppliers of plumbing supplies to plumbers. These factors thus favour the Opponent.

Section 6(5)(e) – the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[20] I agree with the Opponent that the parties' marks are phonetically identical. There are some differences between the marks in terms of appearance. However, the ideas suggested by

them are identical (both marks suggest the idea that the associated valves/pipes fit into and grip each other easily).

[21] Based on the foregoing, this factor favours the Opponent.

Conclusion

[22] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, I find that the similarity in the nature of the services and the significant degree of resemblance between the marks at issue (in particular in sound and ideas suggested) overwhelmingly favour the Opponent. The other factors do not significantly favour either party. As a result, the Applicant has failed to satisfy its onus of establishing on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's EZGRIP trade-mark. Based on the foregoing, the ground of opposition based on section 12(1)(d) of the Act is successful.

Non-distinctiveness Ground of Opposition – sections 38(2)(d) and 2

[23] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[24] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition (May 7, 2010), its pleaded EZGRIP mark had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[25] As discussed more fully in the analysis of the section 12(1)(d) ground of opposition, the Opponent was successful in establishing that its EZGRIP mark had become known to some extent in association with the Opponent's Wares as of the date of filing the statement of opposition and as a result the Opponent has met its evidential burden.

[26] The difference in material dates is not significant such that this ground of opposition is successful for the same reasons as those identified above in the analysis of the section 12(1)(d) ground of opposition. Thus, I am satisfied that the Applicant has failed to discharge its burden of showing, on a balance of probabilities that there is no reasonable likelihood of confusion between the parties' marks. Accordingly, the non-distinctiveness ground is also successful.

Remaining Grounds of Opposition

[27] As I have already refused the application under two grounds, I will not address the remaining grounds of opposition.

Disposition

[28] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application for the Mark pursuant to section 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office