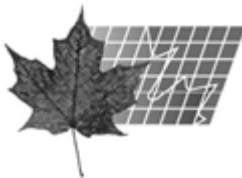


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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 137

Date of Decision: 2020-12-02

IN THE MATTER OF AN OPPOSITION

Fiber-Shield (Toronto) Ltd.

Opponent

and

Henkel Corporation

Applicant

**1,749,227 for FIBRE SHIELD
TECHNOLOGY**

Application

SUMMARY

[1] The Sun Products Canada Corporation applied to register the trademark FIBRE SHIELD TECHNOLOGY (the Mark) in association with laundry detergents. This trademark application was subsequently assigned to Henkel Corporation (the Applicant).

[2] Fiber-Shield (Toronto) Ltd. has opposed this application on the basis that the Mark is confusing with its registered trademark FIBER-SHIELD with the following goods and services:

Goods

(1) Chemicals used in providing a protective coating to fabric materials.

Services

(1) Treating fabric materials such as carpets, rugs, upholstery, furniture, draperies, spreads, wall coverings, pillows and automobile interiors with a protective coating, and providing cleaning and maintenance services to the above materials.

[3] In this case, the fact that the trademarks are highly suggestive of the parties' goods and services impacts the confusion analysis. Where trademarks are weak, consumers are expected to be more on their guard to the differences between them and their associated goods and services. In view of this and the other circumstances discussed below, I find that there is not a reasonable likelihood of confusion between the Opponent's trademark FIBER-SHIELD and the Mark. Accordingly, this opposition is rejected.

FILE RECORD

[4] On October 6, 2015, The Sun Products Canada Corporation filed an application to register the Mark on the basis of its proposed use in association with laundry detergents.

[5] On October 4, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based upon sections 12(1)(d), 16 and 2 (distinctiveness) of the Act (as it read prior to June 19, 2019).

[6] In support of its opposition, the Opponent filed the affidavit of Jennifer Leah Stecyk who attaches a certified copy of the Opponent's Canadian trademark registration No. TMA412,105 for FIBER-SHIELD. In support of its application, the Applicant filed the affidavit of Shannon Uhera, an articling student employed by its agent, and Mary P. Noonan, a trademark searcher employed by its agent. These affidavits relate to the state of the Register and marketplace evidence of use of FIBER SHIELD or FIBRE SHIELD and examples of co-existing identical (or nearly identical) trademarks owned by different parties where the goods pertains to cleaners, detergents, soaps and the like.

[7] Only the Applicant filed a written argument and attended a hearing.

FOUNDATIONS OF OPPOSITION

Section 12(1)(d) Ground of Opposition

[8] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 at 422 (FCA)].

[9] I have exercised my discretion and checked the Register to confirm that the Opponent's registration No. TMA 412,105 is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Applicant now has the legal onus of proving on a balance of probabilities that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trademark.

When are trademarks confusing?

[10] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold . . . or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification

[11] Thus, the issue is not confusion between the trademarks themselves, but confusion of goods and services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of laundry detergent sold with the Mark would believe that it was produced, authorized or licensed by the Opponent.

[12] 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 section 6(5) of the Act. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, (2006) 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, (2011), 92 CPR (4th) 361 (SCC) at para

49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Inherent Distinctiveness and Extent Known

[13] This factor favours neither party as both trademarks possess little inherent distinctiveness as both suggest a characteristic of the associated products and services. The Mark suggests laundry detergent that protects clothing fibres and the Opponent's trademark suggests cleaning chemicals and services for textiles which are protective of the textiles' fibres.

Length of Time in Use

[14] This factor favours neither party as there is no evidence relating to the use of the Opponent's trademark or the Mark in Canada.

Nature of the Goods, Services or Business and Trade

[15] While the parties' goods overlap in that both broadly relate to the cleaning and/or protection of textiles, I consider there to be differences in the nature of the goods, services and trades of the parties. Laundry detergents are sold to consumers to clean clothes. In contrast, the Opponent's product is in the nature of a chemical treatment or coating, rather than a detergent product, and the services of the Opponent appear to be directed at different textiles (rugs, draperies, *etc*). Furthermore, there is no evidence that the Opponent's goods and services would be sold in the same channels of trade as laundry detergents.

Degree of Resemblance

[16] The trademarks resemble each other to a high degree visually and as sounded given that the Mark incorporates the Opponent's trademark as its first component. This factor therefore strongly favours the Opponent. The ideas suggested by the trademarks may also be similar –that the parties' goods and services have protective properties for clothing or fabric materials and in particular their fibres. This concept, however, cannot be the subject of a monopoly [see *American Assn of Retired Persons v Canadian Assn of Retired Persons/Assoc Canadienne des Individus Retraites* (1998), 84 CPR (3d) 198 (FCTD) at para 34].

Surrounding Circumstance: State of the Register and Marketplace Evidence

[17] The state of the Register and marketplace evidence filed by the Applicant does not assist it. The evidence of Ms. Noonan and Ms. Uhera with respect to the use of other FIBERSHIELD trademarks is too limited to result in an inference that consumers would be able to distinguish between the Opponent's registered trademark and the Mark. Further, Ms. Noonan's trademark search revealing examples of co-existing identical or nearly identical trademarks owned by different parties in the cleaners, detergents and soap fields does not result in the inference that consumers can distinguish between the two trademarks at issue.

Surrounding Circumstance: Jurisprudence Concerning Weak Trademarks

[18] The jurisprudence on weak trademarks favours the Applicant. It is well accepted that comparatively small differences will suffice to distinguish between weak trademarks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 15 CPR (4th) 345 (FCTD) at para 66]. As explained in *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2005), 46 CPR (4th) 112 (FCTD) at para 31:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used ...

A party adopting a weak trademark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 10 CPR 101 at 115-116 (SCC)]. While it is possible for the degree of distinctiveness attributed to a weak trademark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) at para 6], there is no evidence that this is the case here.

Conclusion

[19] Considering the factors in section 6(5) of the Act, and taking into account that the Opponent's trademark is a weak trademark and there is no evidence that it is in use, I conclude that the Applicant meets its legal onus. The balance of probabilities on the issue of a reasonable

likelihood of confusion between the Mark and the Opponent's registered trademark falls in favour of the Applicant. Even though the degree of resemblance is high, given the weakness of the trademarks the other factors assume a greater importance. Accordingly, the section 12(1)(d) ground of opposition is rejected.

Remaining Grounds of Opposition Can be Summarily Rejected

[20] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark because it was confusing with the trademark FIBER-SHIELD and trade names FIBER-SHIELD and FIBER-SHIELD TORONTO, previously used by the Opponent (the section 16(3)(a) and 16(3)(c) grounds of opposition). The Opponent also pleads that the Mark is not distinctive because it does not and is not adapted to distinguish the goods of the Applicant from the goods and services of the Opponent (section 2 ground of opposition).

[21] The section 16(3)(a), section 16(c) and section 2 grounds are rejected because the Opponent has not met its initial evidential burden. The Opponent has not evidenced that any of its trademark or trade names were used or made known or had any reputation in Canada as of the applicable material dates. Although the Opponent's registration for its trademark refers to use, that is not sufficient for the Opponent to meet its burden for these grounds of opposition [*Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268].

DISPOSITION

[22] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2020-09-24

APPEARANCES

Kevin Sartorio FOR THE APPLICANT

No one appearing FOR THE OPPONENT

AGENTS OF RECORD

GOWLING WLG (CANADA) LLP FOR THE APPLICANT

OSLER, HOSKIN & HARCOURT LLP FOR THE OPPONENT