

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 139

Date of Decision: 2020-12-17

IN THE MATTER OF AN OPPOSITION

MAAX BATH INC.

Opponent

and

MAAX HARDWARE INC.

Applicant

1,722,907 for MAAX

Application

INTRODUCTION

[1] MAAX BATH INC. (the Opponent), is a leading manufacturer of bathware products for the residential market in Canada. It opposes registration of the trademark MAAX (the Mark), set out below, that is the subject of application No. 1,722,907 filed by MAAX HARDWARE INC. (the Applicant), a company founded in 2013 in Burlington, Ontario, on the basis of proposed use of the Mark in association with the following goods, as revised by the Applicant:

The logo consists of the letters "MAAX" in a bold, stylized, black font. The letters are thick and blocky, with a slightly irregular, hand-drawn appearance. The "M" and "A"s are connected at the top, and the "X" is formed by two intersecting lines.

- (1) Mechanical metal lock sets used to secure a door inside a building, containing levers, knobs, escutcheons, latches, strikes, cylinders and keys.
- (2) Metal hinges used to hang a door inside a building.

(3) Metal exit devices used to secure an egress door inside a building, namely, rims, surface vertical rods, and concealed vertical rods, and consisting of touch bars, cross bars or recessed bars.

(4) Metal Door closers, non-electric, used to control a door inside a building, namely, surface mount, concealed and floor closers.

(5) Architectural door ironmongery, namely, metal door stops, metal door holders, metal door trims, metal door pulls, metal door push plates, metal door kick plates, metal flush bolts, metal surface bolts, metal thresholds, metal door seals, metal door hooks, metal door knockers, metal door viewers.

(6) Electric locks, electronic locks, electromagnetic locks, and biometric fingerprint locks used to secure a door inside a building and electronically controlled.

(7) Electrified exit devices used to secure an egress door inside a building and electronically controlled.

(8) Electrified door closers, electromagnetic door holders, and electric door operators used to control a door inside a building and electronically controlled.

(9) Electric strikes, electric monitoring strikes, electric position switches, electrified hinges, and electric power transfer hinges used to electronically control the exit/entry of a door opening inside a building.

(Hereinafter sometimes collectively referred to as the Goods)

[2] For the reasons that follow below, I find the application ought to be refused.

THE RECORD

[3] The application for the Mark was filed on April 8, 2015 and advertised for opposition purposes in the *Trademarks Journal* on July 20, 2016.

[4] On September 12, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). This Act was amended on June 17, 2019. All references herein are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date).

[5] The Opponent raises grounds of opposition based upon sections 30 (non-compliance of the application); 12 (non-registrability of the Mark); 16 (non-entitlement of the Applicant); and 2 (non-distinctiveness of the Mark) of the Act. The section 30 grounds of opposition are essentially based on technical challenges to the application or alleged deficiencies in the

application, whereas the sections 12, 16 and 2 grounds of opposition revolve around the issue of the likelihood of confusion between the Mark and either one or more of the Opponent's trade names MAAX BATH INC., BAIN MAAX, and MAAX and family of MAAX trademarks as set out in the attached Schedule A.

[6] On February 9, 2017, the Applicant filed a document entitled "Statement of counter opposition", which was ultimately served on the Opponent on February 27, 2017, with permission granted by the Registrar by way of Office letter dated March 14, 2017. The "Statement of counter opposition" contained, beside denials of the grounds of opposition, various allegations and materials which will be disregarded for the purpose of this decision. Evidence must be filed by way of affidavit or statutory declaration at specific periods of time (or with leave to file after the prescribed deadlines if leave is requested and it is in the interest of justice to do so).

[7] In support of its opposition, the Opponent filed four affidavits, which are summarized below. In support of its application, the Applicant filed one affidavit, which is also summarized below. None of the parties' affiants were cross-examined on their affidavits.

[8] Both parties filed written submissions and the Applicant alone attended an oral hearing.

[9] On the day of the hearing, the Applicant submitted a document entitled "Argument – Hearing (Case 1)". As this document was not properly served on the Opponent, nor did the Applicant seek leave from the Registrar in the prescribed manner, I advised the Applicant that this document could not be made of record. In the days following the hearing, the Applicant wrote to the Registrar to seek leave to file further evidence in support of its application, which request was objected to by the Opponent. By way of Office letter dated July 27, 2020, I advised the Applicant that its request could not be considered as it was not filed in the prescribed manner and was incomplete. In this regard, I note that at various points at the proceeding, the benefit of obtaining representation was drawn to the Applicant's attention.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[10] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of

opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

OVERVIEW OF THE EVIDENCE

The Opponent's evidence

[11] As indicated above, the Opponent's evidence is comprised of four affidavits, which are summarized below and are further discussed in the analysis of the grounds of opposition.

The affidavit of André Deland sworn June 22, 2017

[12] Mr. Deland is the Vice President Marketing and New Product Development of the Opponent.

[13] The Opponent is a leading manufacturer of bathware products for the residential market in Canada. At the time of swearing of Mr. Deland's affidavit, the Opponent had:

- more than 1,300 employees in North America, including 850 in Canada;
- 8 manufacturing plants;
- 3 research and development centers;
- 5 customer care centers in North America;
- over 5,000 points of sale in North America, including more than 3,000 in Canada alone.

[paras 3, 5-6]

[14] The Opponent has been offering a broad range of bathtubs, showers and shower doors for decades. Its different product lines are offered to consumers, designers and builders [paras 7-8].

[15] Mr. Deland indicates that the Opponent has developed a family of MAAX trademarks and protected them by registering them, as appears from the certified copies of these registrations attached to the Parent affidavit (discussed below). I note that these registrations include the 16 registrations listed in the attached Schedule A and further include two registrations obtained by the Opponent in respect of the two pending applications listed therein. Mr. Deland indicates

that the MAAX family of marks which are used in Canada by the Opponent are those described in these 18 registrations [paras 10-11]. Mr. Deland indicates that the Opponent has also developed and uses several business names incorporating the MAAX trademark, as appears from the certificate of compliance from the Quebec enterprise register attached to the Janelle affidavit (discussed below).

[16] Mr. Deland attaches to his affidavit as Exhibit AD-1 what he describes as examples of uses of the Opponent's various MAAX trademarks in Canada that are consistent with the use that the Opponent has made of the marks for years. I note at this point of my analysis that except for a very few photographs of bathtubs and shower doors displaying the stylized trademarks MAAX COLLECTION (as depicted in registration No. TMA656626), Utile by MAAX (as depicted in registration No. TMA931050) or MAAX MODULR (the two words appearing on two separate lines and in different fonts and colors), the only trademark depicted in this exhibit is the trademark MAAX. In this regard, I further note that I am satisfied that all uses made of either one of the MAAX trademarks as depicted in Exhibit AD-1 and in the other exhibits discussed below (some of which also depicting the stylized trademarks MAAX ENJOY THE EXPERIENCE and MAAX VIVEZ L'EXPÉRIENCE in which the word MAAX is given great prominence over the phrases "ENJOY THE EXPERIENCE" and "VIVEZ L'EXPÉRIENCE"), amount to use of the MAAX word mark as the word MAAX sufficiently stands out from the other word(s) and/or design element(s) [per *Registrar of Trade-marks v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc v Prodesign* (1984), 2 CPR (3d) 535 (TMOB)].

[17] The MAAX branded goods have been promoted and advertised in Canada in a variety of ways, including via printed inserts, magazine advertising and web campaigns, Canadian promotional tours, and social media. Annual advertising figures for the Opponent's MAAX branded products in Canada for the years 2013 to 2016 ranged between \$650,000 and \$1,25 million per year [paras 15-21]. Various examples of such promotion and advertising bearing the trademark MAAX for the years 2013 to 2016 are included as Exhibits AD-2 to AD-8 to Mr. Deland's affidavit, together with circulation figures, number of impressions, etc.

[18] The MAAX branded goods are offered in thousands of points of sale across Canada. These include renovation centers, showrooms and wholesalers [paras 22-24]. Various examples of these points of sale displaying either one of the MAAX branded goods are included as Exhibits AD-9a to AD-9f to Mr. Deland's affidavit. Mr. Deland also indicates that the Opponent sells shower door parts online via its website at *parts.maax.com* [para 18].

[19] Since 2011, total annual sales of MAAX branded goods in Canada have varied between \$147 million and \$155 million, and the specific annual sales figures for doors bearing either of the MAAX trademarks have varied between \$25 million and \$29 million. Representative invoices from the sale of the Opponent's goods bearing the trademark MAAX for the years 2013 to 2016 are included as Exhibit AD-10 to Mr. Deland's affidavit.

The affidavit of H  l  ne Parent sworn on June 1, 2017

[20] The affidavit of Ms. Parent, a trademarks assistant employed by the agent for the Opponent, has been submitted for the sole purpose of attaching to her affidavit, as Exhibit HP-1, certified copies of the Opponent's aforementioned 18 registrations.

The affidavit of Johanne Janelle sworn on June 19, 2017

[21] The affidavit of Ms. Janelle, a paralegal employed by the agent for the Opponent, has been submitted for the sole purpose of attaching to her affidavit, as Exhibit JJ-1, a copy of the aforementioned certificate of compliance relating to the Opponent.

The affidavit of C  line B  langer sworn June 8, 2017

[22] Ms. B  langer is a researcher at Cogniges inc. She provides printouts of the website of the Applicant at *www.maaxhardware.com* as this website existed at the time of swearing of her affidavit [Exhibit CB-1] as well as archived pages of this website from the Internet Wayback Machine's Internet Archive, as they appeared on March 3 and 4, 2014 [Exhibits CB-2 and CB-3] and July 22, 2016 [Exhibit CB-4]. The website describes the Applicant as:

[...] an independent sales agency representing manufacturers in the field of architectural doors, door hardware, vehicle and pedestrian equipment, safety and security systems, as well as other building specialties for use in commercial construction projects.

[23] The website further provides examples of the products for which the Applicant “specif[ies] and provide[s] product representation”.

The Applicant’s evidence

[24] As indicated above, the Applicant’s evidence is comprised of only one affidavit, which is summarized below and is further discussed in the analysis of the grounds of opposition.

The affidavit of Wissam Ay Toughlo sworn October 23, 2017

[25] Mr. Toughlo identifies himself as a Deputy Director at the Applicant and a partner founder of the Applicant since May 10, 2013. His affidavit is very brief comprising only three substantive statements and one exhibit, as reproduced below:

3. I hereby submit that [the Applicant] is currently selling its goods of Commercial Duty Door Mortise Locks (M7 Series) and Commercial Duty Door Closers (C Series) to its customers outside Canada under the [Mark], and have the intention to use the same inside Canada, for which the Applicant has [filed the present application].

4. I hereby enclosed the Applicant’s catalogs for Mortise Locks – M7 Series, and Door Closers – C Series. The catalogs of these products are technical support to the Applicant’s statement of counter opposition.

5. The Applicant has also applied for other goods under the [Mark]; such goods are: Exit Devices, Electric Locks, Electronic Locks, Electrified Exit Devices, Electric Strikes, etc. These goods are not yet exist. The Applicant has decided to hold the availability of these goods waiting for the Registrar approval on the [present application].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Ground of opposition based on section 12 of the Act (non-registrability of the Mark)

[26] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the Opponent’s registered trademarks set out in the attached Schedule A.

[27] Unless indicated otherwise, I will focus my analysis on the Opponent’s registration No. TMA591327 for the word mark MAAX. This registration represents the Opponent’s strongest case in terms of the degree of resemblance and the degree of overlap in goods when

compared to the Applicant's application. If the Opponent is not successful with this mark, it would not achieve a more favourable result with its other registered marks.

[28] I have exercised my discretion to check the register to confirm that this registration is in good standing as of today's date, which is the material date to assess this ground of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317]. Hence, the Opponent has met its evidential burden in respect of this ground of opposition. The Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trademark.

The test for confusion

[29] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that 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, leased, hired 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.

[30] Thus, section 6(2) of the Act does not concern the confusion of the trademarks themselves, but of the goods or services from one source as being from another. In the present case, the question is essentially whether a consumer, with an imperfect recollection of the Opponent's MAAX trademark, who sees the Applicant's Goods in association with the Mark, would think that they emanate from, are sponsored by or approved by the Opponent.

[31] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. This list is not exhaustive, and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v*

3894207 *Canada Inc* 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion].

[32] In *Masterpiece, supra* at paragraph 49, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar [...]. As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[33] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them

[34] The parties' marks are virtually identical in all respects. While the Applicant's Mark is written in a stylised script, it is to be reminded that in accordance with the principle set out in paragraph 55 of the *Masterpiece* case, *supra*, the registration of the MAAX word mark allows the Opponent to use it in "in any size and with any style of lettering, color or design". Thus, nothing would prevent the Opponent from depicting its trademark MAAX in a similar style of lettering of that found in the Mark.

[35] As a result, this factor strongly favours the Opponent.

The inherent distinctiveness of the trademarks and the extent to which they have become known

[36] I assess both parties' marks to have a similar degree of inherent distinctiveness in the context of their associated goods and/or services.

[37] In his affidavit, Mr. Deland indicates that the Opponent's trademark MAAX was coined from: "M" for Modern fiber glass, "A" for Acrylica, "A" for Archimedes, and "X" for expected growth [para 4]. However, there is no evidence that the majority of consumers, whether Anglophones or Francophones, would be aware of such meaning.

[38] The degree of distinctiveness of a trademark may be increased by means of it becoming known through promotion or use. However, there is no evidence that the Applicant's proposed use Mark has been used in Canada in association with the Goods pursuant to section 4 of the Act or that it has become known in Canada to any extent. In contrast, the evidence of use of the Opponent's trademark filed through the Deland affidavit establishes extensive use of the MAAX word mark by the Opponent in association with a broad range of bathtubs, showers and shower doors in Canada.

[39] The sales figures provided for the years 2011 to 2016, which amount to more than \$909 million (of which \$160 million for the showers' doors only), together with the advertising and promotion of the MAAX trademark by the Opponent for the years 2013 to 2016 and accompanying exhibits attached to the Deland affidavit support the Opponent's contention that its trademark MAAX has deeper roots and has become known to a significant extent in Canada in association with a broad range of bathtubs, showers and shower doors.

[40] In light of the foregoing, the overall consideration of this factor favours the Opponent.

The length of time the trademarks have been in use

[41] For the reasons given above, this factor favours the Opponent insofar as its bathtubs, showers and shower doors are concerned.

The nature of the goods, services or business; and the nature of the trade

[42] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods and services in the registration relied upon by the Opponent [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (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. Evidence of the parties' actual trades is useful in this respect [*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 Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[43] For ease of reference, the goods and services listed in the Opponent's registration are set out below:

[TRANSLATION]

Goods:

(1) Bathtubs, showers, shower-tubs, whirlpool baths, shower-tubs with massage systems, aprons for bathtubs, bath surrounds. (2) Showers with massage systems. (3) Shower doors, bathtub doors. (4) Sinks. (5) Faucets. (6) Bathroom vanities. (7) Medicine cabinets, vanity counters and tops. (8) Spas.

Services:

Promotion of and electronic information services on bathroom products and merchandise (bathtubs, showers, showertubs, whirlpool baths, aprons for bathtubs, bathtub surrounds, shower doors, bathtub doors, sinks, faucets, bathroom vanities, medicine cabinets, vanity counters and tops).

[44] The Opponent takes the position that the evidence clearly shows that the goods of the respective parties under their respective trademarks can overlap. It submits that the Applicant's Goods are basically hardware accompanying the installation of doors and that both the Applicant's and the Opponent's goods are bound to be sold in the same type of store, namely hardware stores. The Opponent further submits that the website of the Applicant confirms that it is selling doors [Bélanger affidavit, Exhibit CB-1] and that older versions of this website even confirm that the Applicant is selling toilet and shower accessories among which are shower doors [Bélanger affidavit, Exhibits CB-2, CB-3 and CB-4]. I will return to this point.

[45] With respect to the channels of trade, the Opponent points out that its clientele is composed of designers, architects, manufacturers/builders, plumbers and retailers [Deland affidavit, para 9] and that the retailers the Opponent is doing business with are numerous

and well-known (Home Hardware and Home Depot being only two of a long list) [Deland affidavit, para 24]. The Opponent submits that, given the nature of the respective goods intended to be offered by each party to this proceeding, the nature of the trade of the parties is expected to be the same.

[46] The Opponent submits that the scope of protection which is to be afforded to a senior mark is particularly strong when the mark, which the Applicant is seeking to register, is identical, and is in an overlapping field. Therefore, the average consumer would likely be deceived and unable to distinguish the goods of the respective parties in the marketplace. The Opponent stresses that it is immaterial in deciding confusion whether consumers are able to differentiate between the parties' marks used in connection with their respective goods. It is whether the average consumer would likely conclude the goods originate from the same source. The Opponent further submits that even if Canadian consumers would not think that the Applicant's Goods are those of the Opponent, they would be led to believe that the Opponent had licensed or otherwise consented to the use of the Mark by the Applicant, which is not the case.

[47] In contrast, the Applicant takes the position that the parties' goods are totally different. It submits that the Goods essentially consist of mechanical locks, door closers, panic bars, electric locks, door operators, which goods are listed under "Division 8 – Openings, Section 087100 – Door Hardware" of the Canadian National Master Construction Specifications (NMS) and are installed on doors of internal and external openings of industrial, commercial, institutional, or residential buildings. The Applicant submits that the Opponent's goods are listed under "Division 10 – Specialties, Section 102116 – Shower and Dressing Compartments, and Section 102810 – Toilet and Bath Accessories" of the NMS and are installed inside bathrooms of residential homes. At the oral hearing, the Applicant added that the Applicant's Goods are required to fulfill the requirements of the National Building Code of Canada including particular standards for fire doors and other opening protectives and life safety codes, while the Opponent's goods are not required to fulfill any of these codes. However, as indicated to the Applicant at the hearing, neither the NMS nor the National Building Code have been put into evidence. The Applicant further stressed that the Applicant's types of architectural door hardware products cannot be technically installed on bath and shower doors.

[48] As defined in the Applicant's application and the Opponent's registration, the parties' goods overlap in that they both consist of construction/renovation products that can be installed in a variety of situations (residential properties, hotels, institutions). That said, I agree with the Applicant that the parties' goods are different in terms of their specific nature and precise applications. In this regard, I agree with the Applicant that on the face of the statement of Goods itself, its different types of door hardware products do not appear to be intended for bath and shower doors. Still, many of them could be for use in bathrooms (for example, hinges, handles, metal locks).

[49] With respect to the channels of trade, the Applicant submits that the parties' respective goods are two different industries in that:

Buyers of the two different industries are the General Contractors, the distributors, the installers and the individuals. General Contractors are professional entities and are not likely to be confused in buying or using the goods of these two different industries. Distributors and installers of the two different industries are also professional entities specialized in either industries; they do not deal with, nor buy or use the goods of these two different industries together. Individuals usually buy the goods of these two industries through specialized distributors and installers. Even individuals who wish to buy the goods of these two different industries directly from the department stores, they are not likely to be confused as they will not see the goods of these two different industries displayed in one location.

[50] At the hearing, the Applicant further submitted that the Applicant supplies its door hardware goods to a network of distributors and security integrators who sell their goods and services to the general contractors/builders in the construction industry who construct new and renovated buildings such as schools, hospitals, office buildings, retail buildings and institutional buildings.

[51] Upon review of the Applicant's catalogs attached to the Toughlo affidavit, I note that the Applicant's door hardware goods appear indeed to be directed to those in the construction industry who construct new and renovated industrial, commercial, institutional, or residential buildings, as per the descriptions: "Choose the C4000 closer for interior and exterior doors in commercial and institutional buildings such as banks, restaurants, hotels, conference buildings, courthouses and medical facilities", "This closer [...] is ideal for interior and exterior door openings with light traffic in commercial and residential applications, including apartments,

offices, shops, storerooms and retirement rooms”, “We know that every product you specify has to stand up to constant use and abuse”, “The safety and security of your clients’ buildings is something we take very seriously”, etc. I further note that these catalogs appear to be intended for distributors of the Applicant’s Goods, as per the white sticker bearing the mention “Distributor” appearing on the left hand side of the cover page of the catalogs, and some of the descriptions or headings found therein, like “How to order”.

[52] However, the Applicant’s evidence does not provide any further information with respect to its alleged network of distributors and security integrators. What is more, the statement of Goods of the application for the Mark is by no means limited to a particular form of sales such as “wholesale” or “retail”. In fact, as acknowledged by the Applicant, both in its written submissions and at the hearing, the Goods may also be sold to individuals through retail stores. Notably, the Applicant’s aforementioned catalogs include various handle sets for “residential entry doors application”, “residential interior door with passage, privacy, or dummy combo application” and “residential entry, multi-family unit entry”, etc. Furthermore, while I agree with the Applicant there is no evidence that the parties’ goods would be sold in close proximity in these retail stores, it remains that the parties’ clientele and channels of trade would appear to overlap at least to some extent. As indicated above, the Opponent’s evidence is that its goods are sold not only at retail stores but also wholesale and to designers, architects, manufacturers/builders, and retailers.

[53] Finally, returning to the printouts of the Applicant’s website attached to the Bélanger affidavit, the Applicant submitted at the hearing that it was planning, at one point in time, to be a sales representative for manufacturers in the field of architectural doors and door hardware, etc. Yet, the Applicant submitted that this has never materialized and that the said web pages would have since been deleted. I note that the Applicant’s intention to use the Mark in association with the Goods is expressly confirmed by Mr. Toughlo in his affidavit. However Mr. Toughlo has not commented on Ms. Bélanger’s search results attached as Exhibits CB-1 to CB-4 to her affidavit. Whether the web pages were deleted or not, I find the evidence of the Applicant’s intention of carrying on its own brand of door hardware under the applied-for Mark is consistent with my conclusions above that there is potential for overlap in the parties’ channels

of trade and in the general nature of the goods (even if the specific goods are different). It is unnecessary to have regard to the web pages to find this.

Surrounding circumstances

Coexistence of the parties' marks

[54] At the oral hearing, the Applicant stressed that the parties' marks would already coexist on both the Canadian register and the United States Patent & Trademarks Office (USPTO) register as well as in the marketplace.

[55] More particularly, the Applicant submitted that it is now "fully functional" and that some of the goods covered by these registrations are actually part of the Goods listed under the present application.

[56] However, I am precluded from considering these additional surrounding circumstances as the Applicant has failed to adduce sufficient admissible evidence to establish those facts.

State of the register evidence

[57] The Opponent submits that while it did not provide state of the register evidence to the distinctiveness of the Opponent's trademark, in the interest of the public, the Registrar has the discretion to check the Canadian trademark register to maintain the purity of the register. The Opponent submits that its use of the word MAAX is a unique word not commonly used in the industry and, therefore, should be considered distinctive entitling the Opponent to a wider scope of protection.

[58] While it has been established that the Registrar has the discretion to check the register, in view of the public interest to maintain the purity of the Register [*American College of Chest Physicians v Medical Education Network (Canada) Inc* (unreported) [2006] TMOB No. 170 (October 23, 2006)], the Registrar does not exercise discretion to take cognizance of his own records except to verify whether the claimed trademark registrations/applications are extant [*Quaker Oats Co of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd*

(1986), 11 CPR (3d) 410 (TMOB); *Sandoz Nutrition Ltd v Sirois* (2002), 27 CPR (4th) 570 (TMOB)]. I therefore do not consider this to be a relevant surrounding circumstance.

Opponent's family of marks

[59] As indicated above, the Opponent indicates that it has developed a family of MAAX trademarks.

[60] While the Opponent has evidenced use of its MAAX trademark, it did not break down any of the Opponent's sales revenues by its different MAAX trademarks but instead only provided aggregate figures. As such, it is difficult to assess the extent to which a family of trademarks would be recognized by the consumer. I therefore do not consider this to be a relevant surrounding circumstance.

Conclusion on the likelihood of confusion

[61] As per my analysis above, except for the differences existing between the parties' goods, all of the remaining factors favour the Opponent. The question thus becomes whether these differences are sufficient by themselves to outweigh the overall consideration of the section 6(5) factors discussed above.

[62] Based on the evidence of record, I find that the balance of probabilities is evenly balanced between a finding of confusion as to the source of the parties' goods and a finding of no confusion. Specifically, the longstanding and extensive use and promotion of the Opponent's virtually identical trademark MAAX and the potential overlap in the parties' channels of trade, lead me to conclude that the Applicant has not met its legal onus to show, on a balance of probabilities, that it is not reasonably likely that an individual who has an imperfect recollection of the Opponent's trademark in association with the Opponent's bathware products, would not, as a matter of first impression, conclude that the Applicant's Goods come from the same source or that some form of authorization exists between the parties.

[63] In my view, while upon reflection, a consumer may conclude that the Goods would be unlikely to come from the same source, this would not necessarily happen as a matter of first impression given that the parties' goods all consist of the same general category of

construction/renovation products that can be installed in a variety of buildings with bathrooms, including for some even in the bathrooms themselves.

[64] As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant. Accordingly, the section 12(1)(d) ground of opposition succeeds.

Ground of opposition based on section 2 of the Act (non-distinctiveness)

[65] The Opponent has pleaded that the Mark is not distinctive of the Goods of the Applicant, within the meaning of section 2 of the Act, since the Mark does not actually distinguish nor is it adapted to distinguish these goods from those of the Opponent. Specifically, the Mark is not distinctive considering the prior and continuing use of certain trade names and trademarks of the Opponent including those previously referred to in the attached Schedule A.

[66] The material date for the section 2 ground of opposition is the date of filing the statement of opposition, namely September 12, 2016. In order to meet its initial evidential burden under this ground of opposition, the Opponent needs to have shown that one of its relied upon MAAX trademarks or trade names had a substantial, significant or sufficient reputation in Canada in association with relevant goods and/or services so as to negate the distinctiveness of the Applicant's Mark [*Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657].

[67] In my view, the Opponent's evidence of its use of the trademark MAAX in association with a broad range of bathtubs, showers and shower doors discussed above with respect to the section 12(1)(d) ground of opposition is sufficient to meet the Opponent's burden with respect to the section 2 ground of opposition. For the most part, my analysis respecting the section 12(1)(d) ground of opposition is also applicable to the section 2 ground of opposition. Therefore, the section 2 ground also succeeds.

Remaining grounds of opposition

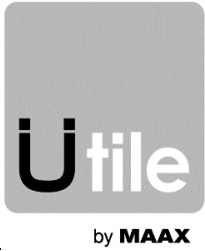


[68] Having already refused the application under two grounds, I will not discuss the remaining grounds of opposition with respect to this application.

DISPOSITION


[69] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.


Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

#	Trademark	TM Details	Goods / Claims
1	MAAX MODULR	REGISTERED App 2014-12-17 Reg 2016-04-15 Reg TMA935021	(1) Shower doors, shower base, bath tubs. Declaration of Use filed March 31, 2016 on wares marked (1)
2	 by MAAX	REGISTERED App 2014-11-06 Reg 2016-03-09 Reg TMA931050	(1) Showers, bath tubs, shower enclosures, tub enclosures. Used in CANADA since at least as early as October 22, 2014 on wares marked (1)
3	 par MAAX	REGISTERED App 2014-11-06 Reg 2016-03-09 Reg TMA931048	(1) Showers, bath tubs, shower enclosures, tub enclosures. Used in CANADA since at least as early as October 22, 2014 on wares marked (1)
4	SOFT CLOSE BY MAAX	REGISTERED App 2012-11-15 Reg 2014-12-18 Reg TMA892624	(1) Showers, shower kits, shower enclosures, shower doors, tub showers, tub enclosures. Declaration of Use filed December 05, 2014 on wares marked (1)
5	MAAX ENJOY THE EXPERIENCE	REGISTERED App 2010-12-10 Reg 2011-10-18 Reg TMA809412	(1) Baths, namely bathtubs, whirlpool baths and bath cubicles; showers, namely shower bases, shower doors, shower enclosures, shower heads, shower panels, shower platforms, shower stands, shower tubs and cubicles. Used in CANADA since June 01, 2010 on wares marked (1)
6	MAAX SPAS	REGISTERED App 2009-12-02 Reg 2011-01-27 Reg TMA788851	(1) Whirlpool baths and spas. Used in CANADA since at least as early as August 2009 on wares marked (1)
7		REGISTERED App 2007-11-22 Reg 2009-08-12 Reg TMA745118	(1) Shower doors, shower-bath doors, tub enclosures, shower enclosures, mirrors and medicine cabinets. Used in CANADA since at least as early as May 2006 on wares marked (1)

8	MAAX COLLECTION	REGISTERED App 2005-01-11 Reg 2006-01-16 Reg TMA656626	(1) Bathtubs, showers and shower-baths either with or without built-in water jets, air jets and/or steam features, skirts for bathtubs, bathtub enclosure walls, shower doors, bathtub doors, medicine cabinets and faucets. Kitchen cabinets custom and semi custom, vanity cabinets custom and semi custom and ready to assemble kitchen and vanity cabinets. Used in CANADA since June 01, 2001 on wares marked (1)
9	MAAX Vivez l'expérience	REGISTERED App 2003-08-21 Reg 2004-11-09 Reg TMA625094	(1) Bains, baignoires, douches, bains-douches et baignoires-douches, avec ou sans système de massage par air, tourbillon, combiné air et tourbillon, steamax ou multijet, cuve de lavage, contours de bains, le tout en acrylique et/ou en fibre de verre. Declaration of Use filed September 02, 2004 on wares marked (1)
10	MAAX Enjoy. Every day	REGISTERED App 2003-08-21 Reg 2004-10-29 Reg TMA624014	(1) Bains, baignoires, douches, bains-douches et baignoires-douches, avec ou sans système de massage par air, tourbillon, combiné air et tourbillon, steamax ou multijet, cuve de lavage, contours de bains, le tout en acrylique et/ou en fibre de verre. Declaration of Use filed September 02, 2004 on wares marked (1)
11	MAAX IES	REGISTERED App 2002-10-24 Reg 2003-12-16 Reg TMA597740	(1) Système de jet d'eau pour douches et bains douches. Used in CANADA since at least as early as August 22, 2002 on wares marked (1)
12	MAAX VILLA	REGISTERED App 2001-12-19 Reg 2003-10-16 Reg TMA592420	(1) Marchandises: bains, baignoires, douches, bains-douches et baignoires-douches, avec ou sans système de massage par air et/ou tourbillon, combiné air et tourbillon et/ou avec générateur de vapeur, le tout en acrylique et/ou en fibre de verre, portes de douches et de bains-douches en acrylique et/ou fibre de verre, cuve de lavage en acrylique.

			Used in CANADA since at least as early as November, 2001 on wares marked (1)
13	MAAX	REGISTERED App 2000-12-12 Reg 2003-10-02 Reg TMA591327	<p><i>(1) Baignoires, douches, bains-douches, bains tourbillon, bains-douches avec système de massage, tabliers pour baignoires, contours de baignoires. (2) Douches avec système de massage. (3) Portes de douches, portes de baignoires. (4) Évier. (5) Robinets (6) Vanités de salle de bains. (7) Pharmacies, comptoirs et dessus de vanités. (8) Spas.</i></p> <p>Used in CANADA since at least as early as June 01, 1987 on wares marked (1) Used in CANADA since at least as early as June 01, 1992 on wares marked (2) Used in CANADA since at least as early as August 01, 1993 on wares marked (3) Used in CANADA since at least as early as June 01, 1997 on wares marked (4) Used in CANADA since at least as early as May 01, 2000 on wares marked (5) Used in CANADA since at least as early as September 01, 2000 on wares marked (6) Used in CANADA since at least as early as October 01, 2000 on wares marked (7) Used in CANADA since at least as early as January 01, 1997 on services Declaration of Use filed September 13, 2003 on wares marked (8)</p>
14		REGISTERED App 1999-12-10 Reg 2004-03-24 Reg TMA606130	<p><i>(1) Baignoires; douches; bains-douches avec système de massage; bains-douches; bains tourbillon; bains tourbillon avec système de massage; spas; portes de douches; portes de baignoires; armoire de pharmacie; évier; tabliers pour baignoires; contours de baignoires; tabliers pour douches; contours de douches; comptoirs de salle de bains; robinets; pomme de douche.</i></p> <p>Used in CANADA since at least as early as September 15, 1999</p>

15	ADVANTA BY MAAX	REGISTERED App 1999-12-10 Reg 2002-06-04 Reg TMA562991	<i>(1) Baignoires; douches; baignoires avec système de massage; baignoires; baignoires tourbillon; baignoires tourbillon avec système de massage; spas; portes de douches; portes de baignoires; armoire de pharmacie; éviers; tabliers pour baignoires; contours de baignoires; tabliers pour douches; contours de douches; comptoirs de salle de bains; robinets; pomme de douche.</i> Used in CANADA since at least as early as September 15, 1999
16		REGISTERED App 1992-10-06 Reg 1993-12-17 Reg TMA421196	<i>(1) Bains et douches en fibre de verre et en acrylique. (2) Baignoires et douches en ABS (acrylate, butadiène et styrène) ainsi que des portes de baignoires et de douches.</i> Used in CANADA since at least as early as July 01, 1993 on wares marked (2) Declaration of Use filed September 27, 1993 on wares marked (1)
17	U TILE BY MAAX	PENDING App 2014-06-17 App 1681694	(1) Showers, bath tubs, shower enclosures, tub enclosures. Proposed use in CANADA on wares marked (1)
18	U TILE PAR MAAX	PENDING App 2014-06-17 App 1681695	(1) Showers, bath tubs, shower enclosures, tub enclosures. Proposed use in CANADA on wares marked (1)

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

HEARING DATE 2020-06-18

APPEARANCES

No one appearing	For the Opponent
Mohammad Al Nabelsi	For the Applicant

AGENTS OF RECORD

Fasken Martineau Dumoulin LLP	For the Opponent
No agent appointed	For the Applicant