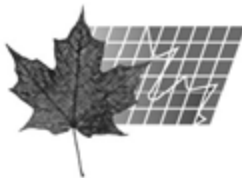


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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 30**

**Date of Decision: 2021-02-19**

**IN THE MATTER OF AN OPPOSITION**

**Horizon Marketing International  
Limited**

**Opponent**

**and**

**James Ashton**

**Applicant**

**1,697,649 for Imagine Fiberglass Pools**

**Application**

**INTRODUCTION**

[1] On October 10, 2014, James Ashton (the Applicant) filed application No. 1,697,649 (the Application) to register the trademark Imagine Fiberglass Pools (the Mark). The Application is based on use of the Mark in Canada since August 1, 2014 in association with the following goods (the Goods):

Manufactured fiberglass swimming pools; manufactured fiberglass hot tubs;  
manufactured fiberglass swim spas; manufactured fiberglass counter-current swimming  
pools; manufactured fiberglass plunge pools; manufactured fiberglass garden pools;  
manufactured fiberglass spas.

[2] The Application was advertised for opposition purposes in the *Trademarks Journal* on April 6, 2016. On September 6, 2016, Horizon Marketing International Limited (the Opponent)

filed a statement of opposition against the Application pursuant to 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). I note that the Opponent was granted leave to file an amended statement of opposition dated January 4, 2019 that corrected minor typographical errors which are of no consequence to assessing the merits of this matter.

[3] The Opponent raises grounds of opposition based on non-entitlement under sections 16(1)(a) and (c), non-distinctiveness under section 2, and non-compliance with section 30(b) of the Act. The non-entitlement and non-distinctiveness grounds of opposition (set out in paragraphs 1(b) through (d) of the statement of opposition) are based on an alleged likelihood of confusion with the Opponent's trademarks and trade names which include or are comprised of the term "Imagine", including IMAGINE, IMAGINE POOLS, IMAGINE POOLS AND WATERSCAPES and Imagine Pools and Waterscapes Ltd. The Opponent pleads prior use of these trademarks and trade names by the Opponent and/or the Opponent's predecessor in title, Imagine Pools and Waterscapes Ltd.

[4] Paragraph 1(e) of the statement of opposition includes an additional non-distinctiveness ground of opposition based on an allegation that the Applicant was solely a retailer or distributor of goods such that use of the Mark did not enure to the Applicant. However, I have no evidence or submissions regarding the distinctiveness ground of opposition in paragraph 1(e) of the statement of opposition, and so it is dismissed and I will not discuss it further.

[5] The Applicant filed a counter statement on February 7, 2017 denying the grounds of opposition. Both parties submitted evidence and written representations and were represented at a hearing.

[6] For the reasons that follow, the Application is refused.

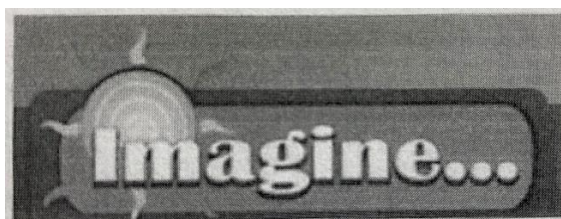
## EVIDENCE

[7] The Opponent filed the affidavit of Ron Yavis sworn on May 30, 2017 (the Yavis Affidavit). The Applicant filed an affidavit in his own name sworn October 15, 2017 (the Ashton Affidavit). Both affiants were cross-examined on their respective affidavits and the transcripts and exhibits from those cross-examinations form part of the record. The parties' evidence is summarized below and is further discussed in the analysis of the grounds of opposition.

### **Opponent's Evidence – The Yavis Affidavit**

[8] Mr. Yavis is the president of Imagine Pools and Waterscapes Ltd. (hereinafter "IPW"). IPW was incorporated in British Columbia on May 14, 2004 and has been carrying on business continuously since that date as a designer, fabricator, constructor and installer of swimming pools and spas. Continuously since its incorporation, IPW has also engaged in the retail sale of swimming pools, spas, pool and spa supplies and accessories, and in the maintenance and repair of swimming pools and spas. IPW serves customers throughout the Okanagan Valley in British Columbia.

[9] Mr. Yavis states that since 2004, IPW has been using the trademarks and trade names IMAGINE, IMAGINE POOLS, and IMAGINE POOLS AND WATERSCAPES in association with its business, including on signage, business cards and invoices. Since at least as early as October 1, 2012, IPW has displayed the following logo on its website at *www.imaginepools.ca*:



[10] Exhibits "B" and "C" to the Yavis Affidavit include printouts of current and archived pages from IPW's website, each page bearing the trademark IMAGINE and the trade name Imagine Pools and Waterscapes Ltd.

[11] Mr. Yavis indicates that since its founding, IPW has sold and built approximately 120 pools and provided maintenance on numerous other pools, all in association with the trademarks

IMAGINE, IMAGINE POOLS, and IMAGINE POOLS AND WATERSCAPES. IPW's annual revenues in Canada each year since 2010 have exceeded \$400,000.

[12] In 2005, IPW received a "Gold Award by the Pool & Tub Council of Canada" for a pool which it fabricated and installed. The award identifies the recipient by the trade name Imagine Pools & Waterscapes Ltd., and this pool was featured in an industry magazine in 2006.

[13] Mr. Yavis states that, pursuant to an agreement dated September 2, 2016, IPW transferred all of its rights in and to the above-referenced trademarks and trade names to the Opponent, and that IPW continues to use the trademarks and trade names under license from the Opponent in circumstances in which the character or quality of the goods and services is under the control of the Opponent.

#### **Applicant's Evidence – The Ashton Affidavit**

[14] Mr. Ashton is the president, director, sole officer and owner of Ashton Pools, Ponds and Spas Inc. (Ashton Pools). He holds those same roles at Ashton Hot Tubs & Fitness Inc. (Ashton Hot Tubs) and Imagine Fiberglass Products Inc. (Imagine Fiberglass). Mr. Ashton refers to these three entities collectively as the "Ashton Companies".

[15] Mr. Ashton attests that the Ashton Companies use the Mark in association with the Goods under license from him in circumstances in which the character and quality of the Goods are under his control.

[16] Mr. Ashton attaches as exhibits to his affidavit various brochures and flyers bearing the Mark promoting swimming pools. Also included as Exhibit "F" is a photograph taken on March 16, 2015 of an Ashton Hot Tubs booth promoting swimming pools in association with the Mark at the National Home Show in Toronto, Canada. Exhibits "G" through "I" include multiple photographs of the promotion of swimming pools in association with the Mark at trade fairs in the United States.

[17] Exhibit "M" to the Ashton Affidavit is described by Mr. Ashton as representative invoices, from 2014 to the present, for sales of the Applicant's Goods bearing the Mark. I note that none of the documents in Exhibit "M" display the Mark. Exhibit "N" is a warranty

document bearing the Mark which Mr. Ashton states accompanies the Goods at the time of installation.

[18] Mr. Ashton provides annual revenues for the years 2014 through 2017 for Goods sold in association with the Mark “in Canada and the United States”. It was confirmed on cross-examination that these figures relate to sales in both Canada and the United States, and that the Ashton Affidavit does not provide sales revenues specific to Canada [see cross-examination transcript Q136].

#### ONUS AND MATERIAL DATES

[19] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[20] The material dates for the grounds of opposition are as follows:

- Sections 38(2)(a)/30 of the Act - the filing date of the Application, namely, October 10, 2014 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(c)/16(1)(a) and (c) of the Act – the claimed date of first use of the Mark, namely, August 1, 2014; and
- Sections 38(2)(d)/2 of the Act - the filing date of the opposition, namely, September 6, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

#### ANALYSIS

##### **Section 30(b) Ground of Opposition**

[21] With a ground of opposition based on section 30(b) of the Act, it is well established that if the date of use claimed in the application is earlier than the applicant’s actual date of first use

of the trademark in Canada, the section 30(b) ground of opposition is successful [see *Scenic Holidays (Vancouver) Ltd v Royal Scenic Holidays Ltd*, 2010 TMOB 63].

[22] An opponent's initial burden under section 30(b) is light [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89] and can be met by reference not only to the opponent's evidence but also to the applicant's evidence [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. However, an opponent may only successfully rely upon the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claim set forth in the application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 30-38].

[23] In the present case, the Application includes a claim that the Mark has been used in Canada since August 1, 2014 in association with the Goods. The Opponent did not file any evidence which calls that claimed date into question. Consequently, since the Opponent did not file evidence on this issue, it is worth noting that the Applicant was not obliged to submit any evidence to substantiate its claim to use of the Mark since August 1, 2014.

[24] The Opponent seeks to rely on the Applicant's own evidence to meet the Opponent's initial evidential burden for the section 30(b) ground. In particular, at the hearing the Opponent argued that a statement in paragraph 5 of the Ashton Affidavit is clearly inconsistent with the August 1, 2014 claimed date of first use. In paragraph 5 of the Ashton Affidavit, Mr. Ashton discusses the use of the Mark under license and states "Further, the Goods are manufactured to my specifications by Imagine Fiberglass". This is noteworthy because Exhibit "C" to the Ashton Affidavit indicates that Imagine Fiberglass was incorporated in 2016 and thus could not have been manufacturing the Goods as of August 1, 2014.

[25] However, given that the above statement in paragraph 5 of the Ashton Affidavit is worded in the present tense, I do not consider this statement to preclude the possibility of the Mark being used by the Applicant directly or via one of the other Ashton Companies prior to the incorporation of Imagine Fiberglass. Indeed, the Ashton Affidavit includes multiple examples of the display of the Mark in 2015 prior to the incorporation of Imagine Fiberglass (see page 3 of Exhibit "E" and Exhibit "F" to the Ashton Affidavit).

[26] Ultimately, I do not consider there to be anything in the Ashton Affidavit that is inherently inconsistent with the August 1, 2014 date of use claimed in the Application, nor did Mr. Ashton make any statements on cross-examination that would call that date into question. Accordingly, I find that the Opponent has not met its initial evidential burden for the section 30(b) ground of opposition, and this ground is dismissed.

### **Grounds of Opposition Based on Alleged Confusion**

[27] The non-entitlement and non-distinctiveness grounds of opposition each turn on the question of whether there is a likelihood of confusion between the Mark and the Opponent's trademarks and trade names which include the term "Imagine".

#### Preliminary Issue – Assignment to the Opponent

[28] The Applicant contends that the Opponent has not demonstrated any use of the trademarks and trade names on which it relies, because the Opponent only acquired the trademarks and trade names via assignment from IPW four days before the statement of opposition was filed. The Applicant also notes that Mr. Yavis did not include a copy of the assignment document as part of his affidavit. However, Mr. Yavis has attested that the assignment transferred all rights in the trademarks and trade names to the Opponent, and that after the assignment IPW continued to use the trademarks and trade names under license from the Opponent, pursuant to which the Opponent had control over the character or quality of the goods and services. In my view, none of these facts attested to by Mr. Yarvis were undermined on cross-examination. Based on the evidentiary record in this case, I see no reason why the Opponent, as a successor in title to IPW, cannot rely on IPW's prior use of the trademarks and trade names for the purposes of the non-entitlement and non-distinctiveness grounds of opposition. Accordingly, I reject the Applicant's submissions on this issue.

#### Opponent's Initial Evidential Burden

[29] I am satisfied that the Opponent has met its initial evidential burden for the non-entitlement grounds under section 16(1)(a) and 16(1)(c) of the Act, by virtue of the evidence of use of its trademark IMAGINE and trade name Imagine Pools and Waterscapes Ltd.,

respectively, prior to the Applicant's claimed date of first use of August 1, 2014. I am also satisfied that the Opponent has met its initial evidential burden for the non-distinctiveness ground of opposition under section 2, by virtue of the evidence of use and reputation in its trademark IMAGINE in British Columbia prior to the filing of the statement of opposition.

[30] While the material dates differ for the non-entitlement and non-distinctiveness grounds of opposition, in my view, the different material dates have no impact on the outcome of the confusion analysis. Also, while the Opponent relies on a variety of trademarks and trade names in this proceeding, for ease of reference in conducting the confusion analysis I will focus on the Opponent's trademark IMAGINE, as in my view it represents the Opponent's best case.

#### Test for confusion

[31] The test for confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[32] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 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.

[33] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

*Inherent distinctiveness of the trademarks and extent to which they have become known*

[34] In my view, the parties' trademarks share the same degree of inherent distinctiveness. With both parties' trademarks, it is the word "Imagine" that is the most striking element and that provides inherent distinctiveness, as that word does not describe any aspect of the relevant goods or services. The remaining component of Applicant's Mark, namely, "Fiberglass Pools", is descriptive and does not contribute to the inherent distinctiveness of the Mark.

[35] With respect to the extent that the parties' trademarks have become known, only the Opponent has provided evidence which persuasively speaks to this point. For example, the Opponent's evidence provides annual sales revenues in Canada in association with its trademark IMAGINE as well as the number of pools installed. I am satisfied that the Opponent's trademark is known to at least some degree in British Columbia, and in particular the Okanagan Valley region, in association with the Opponent's goods and services.

[36] The Applicant has provided sales figures in association with the Mark, but those sales are attributable to both Canada and the United States, such that I have no sales figures specific to Canada. In addition, while the Applicant has included examples of brochures bearing the Mark and the display of the Mark at a trade show, I have no distribution or attendance data related to those displays of the Mark. In my view, I do not have sufficient evidence to conclude that the Applicant's Mark is known in Canada to any meaningful extent.

[37] Taking into account both the inherent distinctiveness of the parties' trademarks and the extent to which they have become known, on balance, this factor slightly favours the Opponent.

*Length of time the trademarks have been in use*

[38] The evidence indicates that the Opponent has been using its trademark IMAGINE in Canada since 2004, including the use of a design version of that trademark since at least 2012. The Applicant has been using its Mark in Canada since 2014. Therefore, this factor also favours the Opponent.

*Nature of the goods; nature of the trade*

[39] Both parties are in the business of selling and constructing swimming pools, and thus the nature of the parties' goods and channels of trade are effectively identical. I note that the evidence suggests that the parties operate in different geographic regions of Canada (the Opponent in British Columbia and the Applicant in Ontario); however, that is immaterial for the purposes of this opposition given that the Applicant is seeking registered rights across Canada [see *Masterpiece*, *supra* at para 30].

[40] Thus, this factor favours the Opponent.

*Degree of resemblance*

[41] There is a high degree of resemblance between the parties' trademarks. The most striking aspect of both parties' trademarks is the first word "Imagine". The result is that both parties' trademarks have a similar appearance and sound, and convey a similar idea. I do not consider the remaining element of the Applicant's Mark, namely, "Fiberglass Pools" to be a significant distinguishing element, given that it simply describes the Goods. Consequently, the degree of resemblance factor favours the Opponent.

Conclusion regarding confusion

[42] Having considered all of the surrounding circumstances, I conclude that the Applicant has not satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties' trademarks. I reach this conclusion considering that each of the statutory factors favours the Opponent, and in particular given the degree of resemblance between the parties' trademarks and the direct overlap in the nature of the parties' goods and businesses.

[43] As noted above, I conducted the confusion analysis with reference to the Opponent's trademark IMAGINE. However, in my view, the outcome of the confusion analysis is the same when considering the Opponent's trademark IMAGINE POOLS AND WATERSCAPES and the Opponent's trade name Imagine Pools and Waterscapes Ltd. With the latter trademark and trade name, in my view, the most striking element remains the word "Imagine", since the component "Pools and Waterscapes" would be viewed as descriptive of the Opponent's goods and services.

[44] In view of the above, the Opponent succeeds with respect to its grounds of opposition based on non-entitlement under sections 16(1)(a) and (c) and non-distinctiveness under section 2 of the Act.

#### DISPOSITION

[45] 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.

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Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2020-11-30

**APPEARANCES**

Donna White

For the Opponent

Lorraine Fleck

For the Applicant

**AGENTS OF RECORD**

Osler, Hoskin & Harcourt LLP

For the Opponent

Fleck Innovation Law

For the Applicant