

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 019

Date of Decision: 2023-02-06

IN THE MATTER OF AN OPPOSITION

Opponent: Kimberly-Clark Worldwide, Inc.

Applicant: Koninklijke Philips N.V.

Application: 1763969 for VIVA COLLECTION

INTRODUCTION

[1] Koninklijke Philips N.V. (the Applicant) applied to register the trademark VIVA COLLECTION (the Mark) on January 19, 2016 (the Filing Date) on the basis of proposed use in Canada. The application was given number 1763969 (the Application) and was advertised in the Trademark Journal of February 20, 2019.

[2] The statement of goods is reproduced below, together with the associated Nice classes (CI) (collectively, the Goods):

CI 11 (1) Ovens

CI 21 (2) Household or kitchen utensils and containers, namely, cooking utensils, cooking pots, beverage containers, food storage containers;

glassware and porcelain, namely table glassware, glass bowls, porcelain dishes and bowls, and earthenware.

[3] Kimberly - Clark Worldwide, Inc. (the Opponent) filed and served a statement of opposition on November 20, 2019 opposing registration of the Mark. In sum, the grounds of opposition allege the application does not comply with the requirements in the *Trademarks Act*, RSC 1985, c T-13 (the Act) as the Mark is confusing with the Opponent's trademarks which had been previously used and registered in Canada, and the Applicant is not entitled to register the Mark. The Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[4] For the reasons that follow, I refuse the application in respect of the goods "beverage containers, food storage containers" and reject the opposition in respect of the remaining goods.

THE RECORD

[5] The grounds of opposition raised by the Opponent are based on sections 30(e), 30(i), 12(1)(d), 16(3)(a) and 2 of the Act. A summary of these grounds as set out by the Opponent in the statement of opposition is attached as Appendix A.


[6] A counterstatement was filed and served on January 27, 2020 in which the Applicant admitted none of the allegations raised by the Opponent.

Evidence

[7] The Opponent filed the affidavit of Natalia Surina (the Surina Affidavit) on July 17, 2020.

[8] The Surina Affidavit contains, *inter alia*, the following facts and exhibits:

- The Opponent is the owner in Canada of the following registrations in Canada:

Trademark	Particulars	Goods and Services	Status
VIVA	Reg. no.: TMA179701 Filing Date: Nov. 2, 1970 Reg. Date: Nov. 26, 1971	(1) Paper towels. (2) Bathroom tissue. (3) Paper napkins.	Registered
VIVA-MULTI-SURFACE-CLOTH	Reg. no.: TMA1069144 Filing Date: Mar. 7, 2018 Reg. Date: Jan. 13, 2020	(1) Paper towels.	Registered
VIVA Design 	Reg. no.: TMA884601 Filing Date: Aug. 18, 2008 Reg. Date: Aug. 22, 2014	(1) Paper towels.	Registered
VIVA VANTAGE	Reg. no.: TMA927541 Filing Date: Feb. 28, 2013 Reg. Date: Jan. 28, 2016	(1) Paper towels.	Registered

- The above listed trademarks (the Opponent's Marks) and registrations, are used under licence in Canada with the goods contained in the above registrations (the Opponent's Goods) with the Opponent maintaining control over the character and quality of such goods.
- The Opponent's Marks have been used in Canada for at least 18 years and are "prominently featured" on the Opponent's Goods either on the goods or their packaging (paras 19-21 and 24, and Exhibits "B-1" and "B-2" of the Surina Affidavit). Canadian sales revenues for the Opponent's Goods, and advertising expenditures for the years 2014-2019 are provided (paras 27 and 28 of the Surina Affidavit).

- Examples of advertisements for the Opponent's Goods and images of the Opponent's Goods for sale at retail stores and on-line are also included (Exhibit "C-2" (para 36)).

[9] The Applicant requested a cross-examination order of the Opponent's affiant by letter dated September 17, 2020.

[10] An order for cross-examination of Ms. Surina issued on September 18, 2020. No cross-examination was ultimately held and the Applicant advised by notice dated March 18, 2021 that it would not be filing any evidence.

Written Arguments

[11] The Opponent filed and served its written arguments on May 25, 2021.

[12] The Applicant advised by notice filed and served on July 26, 2021 that it would not be filing written arguments.

Oral Hearing

[13] The Applicant advised by notice dated August 25, 2021 that it did not request an oral hearing, however intended to participate by video conference in English, if the Opponent requested a hearing.

[14] The Opponent filed its request for an oral hearing by video conference in English on August 26, 2021.

[15] The requested hearing was held at 10:00 am December 12, 2022 with only the Opponent appearing.

PARTIES' RESPECTIVE BURDEN OR ONUS

Onus

[16] The legal onus is on the Applicant to show that the Application complies with the provisions 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. Once this initial burden is

met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd*, (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29].

PRELIMINARY MATTERS

Grounds of Opposition Summarily Dismissed

Section 30(e)

[17] The Opponent alleges that the Application does not conform to the requirements of section 30(e) of the Act, specifically that at the time the Application was filed [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475], the statement that the Applicant, by itself or through a licensee, intended to use the Mark in Canada in association with the Goods was false and inaccurate.

[18] While the evidential burden on the Opponent may be lighter than other grounds [see *Molson Canada v Anheuser-Busch Inc*, 2003 FC 1287], it is not non-existent. The Opponent has filed no evidence to support this ground and no evidence was filed by Applicant upon which the Opponent can rely. The Opponent has therefore failed to meet its evidentiary burden and this ground of opposition is summarily dismissed.

Section 30(i)

[19] The Opponent alleges that, as of the Filing Date [*Georgia-Pacific Corp, supra*], the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as the Applicant knew, is deemed to have known, or should have known of the rights and reputation attaching to the Opponent's Marks in Canada. Further, the Opponent alleges use of the Mark is unlawful as it contravenes or is likely to contravene sections 7, 20 and 22 of the Act.

[20] In support of this ground, the Opponent argues that a combination of sections 30(i) and 7(b) of the Act, which the Opponent refers to as a "statutory codification of the common law action of passing off" precludes the Applicant from entitlement to the

registration and refers to the three part test for passing off, namely i) the existence of goodwill, ii) deception of the public due to a misrepresentation; and (iii) actual or potential damage [*Ciba-Geigy Canada Ltd v Apotex Inc* (1992) 44 CPR (3d) 289].

[21] As there is no evidence that the Applicant has made any misrepresentations or has engaged in any deception of the public, the Opponent has not met its burden in respect of the ground of opposition rooted in section 7(b) of the Act.

[22] The section 30(i) ground of opposition further alleges that the Applicant could not have been satisfied that it was entitled to use or register the Mark in Canada in association with the Goods given the Opponent's registrations and use in Canada and sections 7, 19, 20, and 22 of the Act. The Opponent has not filed any evidence to support this ground of opposition. Specifically, each of the sections relied upon by the Opponent require there to have been actual use of the Mark by the Applicant or, in the case of section 7, some other action on the part of the Applicant, none of which have been established by evidence. The Opponent's evidential burden for this ground has therefore not been met and this ground of opposition is also summarily dismissed.

ANALYSIS OF GROUNDS OF OPPOSITION

[23] The remaining three grounds of opposition are all rooted in the assertion of a reasonable likelihood of confusion.

Section 16(3)(a)

[24] The Opponent has alleged that the Applicant is not entitled to registration of the Mark because, as of the Filing Date, the Mark was confusing with the Opponent's Marks that had previously been used in Canada.

[25] The material date for a section 16(3)(a) ground of opposition is the Filing Date (see section 16 of the Act).

[26] Under this ground of opposition, the Opponent has the initial burden to establish use of the Opponent's Marks prior to the Filing Date and that such use was not abandoned at the advertisement date (February 20, 2019, see section 16(5) of the Act).

[27] The Opponent's evidence contains various references to initial dates of first use for the Opponent's Marks including November 26, 1971, being the earliest registration date for one of the Opponent's Marks, namely registration No. TMA179,701, September 1967 as the date the VIVA brand was first introduced to the Canadian marketplace and "for at least the last 18 years" and "well prior to 2016" as stated in the Surina Affidavit which was executed in 2020. However, there is no documentary evidence to support the September 1967 date of first use or the other referenced dates and the only dates for which actual evidence of continuous use has been provided are the years 2014 to 2019.

[28] In this regard, the Opponent has evidenced how the Opponent's Marks have appeared on "paper towels" or on their packaging for at least 18 years, and has also provided sales revenues and advertising expenses for the Opponent's Goods for the years 2014-2019. I am satisfied that the evidence establishes that the Opponent's Marks have been used in Canada only with the goods "paper towels", since at least as early as 2014 and had not abandoned such use on February 20, 2019. The question is whether this use precludes the Applicant from being entitled to a registration for the Mark based on a reasonable likelihood of confusion with the Opponent's Marks.

[29] The test for confusion is one of first impression and imperfect recollection in the mind of a casual consumer in somewhat of a hurry and who does not pause to give the matter detailed consideration or scrutiny, nor closely examine the similarities and differences in the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20]. Section 6(2) of the Act provides that 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] 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 trademarks and the extent to which they have become known (often referred to as acquired distinctiveness); (b) the length of time each has 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, including in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight and degree of resemblance is often considered to be the most important of these factors, but is not alone conclusive of the issue of confusion [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot, supra*; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

[31] In coming to my decision I have considered all of the evidence and submissions made in respect of this opposition which, in this case, was only provided by the Opponent.

[32] I will now turn to the assessment of confusion based on the section 6(5) factors.

Degree of Resemblance

[33] There is a significant degree of resemblance in appearance and sound between the Opponent's Marks and the Mark, specifically the Opponent's VIVA mark which I consider to represent the Opponent's strongest case in this opposition and which I will focus on in this analysis, in that the entire word element of the Opponent's VIVA mark is the first word of the Mark. However, when considering the degree of resemblance, the law is clear that marks must be considered in their totality, not side by side, pointing out differences in the marks as per *Gianfranco Ferré SpA v FEMAS METAL SANAYI VE TICARET ANONIM SIRKETI*, 2022 TMOB 243. In the present case I agree with the Opponent that VIVA is the more distinctive element of the Mark. The word COLLECTION is a common word which does not impart a high level of differentiation to the Mark, although it does impart a different idea suggested to some extent, namely that the goods are part of a larger grouping of associated goods. Nonetheless, this factor favours the Opponent.

Inherent and Acquired Distinctiveness

[34] The Opponent has asserted that the dominant element of the Opponent's Marks is the word VIVA, that VIVA has no known dictionary meaning in English or French and is an original expression that has no particular meaning when considered in association with the Opponent's paper towels.

[35] The Opponent has also asserted that the word COLLECTION, being a common English word, clearly describes the Goods as being part of a "specific identifiable collection" and lacks any inherent distinctiveness.

[36] While a review of the *Canadian Oxford Dictionary of English* (3rd ed on-line version 2015) shows that "viva" does have an English language definition, I agree with the Opponent that the Opponent's Marks are inherently stronger than the Applicant's VIVA COLLECTION trademark.

[37] Further, while the Opponent has filed evidence of use of the Opponent's Marks in Canada suggesting a level of acquired distinctiveness, no evidence of use of the Mark is of record.

[38] This factor therefore favours the Opponent in both inherent and acquired distinctiveness.

Length of Time the Trademarks Have Been in Use

[39] As the Applicant did not file evidence in this proceeding in support of its proposed use Application, there is no basis on which to find there has been any use of the Mark in Canada.

[40] Having already concluded that the Opponent has used its marks since at least as early as 2014 continuously to at least 2019 and considering the applicable relevant date, I find this factor favours the Opponent.

Nature of the Goods and Business or Trade

[41] To summarize at the outset, the Opponent's arguments in respect of these aspects of the test for confusion are essentially two-fold: 1) as the goods of both parties are used in households, primarily the kitchen, the goods of the parties may be used in close proximity to each other for dining and entertaining, and 2) the Goods as set out in the application could embody disposable items, meaning there could be overlap with the Opponent's paper towels which are, by their nature and as argued by the Opponent, disposable.

[42] The issue of the nature of the goods and business or trade of the parties is a key issue in this opposition and formed a significant part of the arguments put forth by the Opponent.

[43] To demonstrate a connection between the goods of the parties, the Opponent has included an image of VIVA branded paper towels with decorative markings, folded on a plate as part of a plate setting as well as an image of a toaster being cleaned with paper towels. It is not clear however that these images contained at paragraph 23 of the Surina Affidavit are actually representative of paper towels that have been sold in Canada or advertisements that appeared in the Canadian market. The images appear to instead be advertising mark ups with no indication that the images were used for anything but the Opponent's internal purposes. None of the exhibits to the Surina Affidavit show patterned paper towels for sale, nor do the advertisements focus primarily on use of the Opponent's paper towels in kitchens as suggested in the Surina Affidavit.

[44] The advertisements and website screen shots in the exhibits to the Surina Affidavit instead contain images of general household use of the Opponent's paper towels including on yard furniture, on a bathroom counter, cleaning a picture frame and wiping off a dog. Only one image in the Opponent's evidence is indicative of use in kitchens, namely, that of a cutting board and food. This evidence demonstrates that the Opponent's paper towels are marketed and sold for general cleaning use as opposed to focusing on kitchen cleaning and/or dining and entertaining.

[45] This is made more clear in Exhibit B of the Surina Affidavit which contains photos of the Opponent's paper towels on shelves at a Home Depot store location in Canada exclusively in the cleaning product section of the store. There is no indication that they are also found in other areas of stores, such as those containing housewares or those related to dining or entertaining. Accordingly, while the Opponent's paper towels may be used in kitchens and for dining/entertainment, the Opponent's evidence does not support that the Opponent's paper towels are advertised in a manner that in any way emphasizes use in household kitchens and/or for dining and entertainment purposes.

[46] The Opponent further submits, correctly, that nothing in the statement of goods in the Application precludes the Goods from being disposable. With no evidence on file regarding the Applicant's business, actual nature of the Goods or associated channels of trade it is not possible to infer its channels of trade, specific nature of the Goods or scope of business. However, applying common sense, the only Goods that could reasonably be considered as potentially being disposable are the goods "beverage containers, food storage containers". The remaining goods either specify the material they are made from (such as glass, porcelain and earthenware) or indicate an intended use that is inconsistent with being disposable in nature (i.e. "cooking utensils", "cooking pots" and "ovens").

[47] The Opponent acknowledges the goods of the parties do not overlap, yet most of the cases relied upon in its arguments are cases where the goods of the parties do directly overlap at least in part and, in addition, are also directly related. At the oral hearing, the Opponent relied on *Rona Inc v RONA, as – organizacni slozka, 2014 TMOB 188* where the goods were found to be closely related because they could be potentially be used together by consumers in close proximity on a dining room table. However, it was also found in *Rona, supra* that not only were there directly overlapping goods at issue, but the remaining goods of the applicant were closely related to those of the opponent. In this regard the applied for goods were various forms of glassware compared to the opponent's registered goods which were kitchen accessories including dishes, kitchen utensils and cutlery. I consider this case quite distinguishable from the current situation of ovens, cooking utensils, glassware and porcelain dishware

compared to paper towels that are marketed and sold as general household cleaning products.

[48] In its arguments the Opponent also relies on a concept of “natural zone of expansion” to assert that since the Opponent’s Goods are disposable by nature and for use in kitchens, it is essentially foreseeable for the Opponent to expand into other disposable items for use in kitchens. I refused to take judicial notice of a natural zone of expansion for goods of the Opponent under its VIVA marks during the hearing due to lack of evidence of any such zone and likewise maintain that refusal now for the same reason.

[49] I therefore find that this factor somewhat favours the Opponent but only in respect of the goods that could reasonably be considered disposable, namely, “beverage containers, food storage containers”.

Additional Surrounding Circumstances - Assertion of Family of Marks

[50] At the oral hearing, counsel for the Opponent referred to the Opponent’s Marks as a “family of marks”. It is well established that in order to rely on a family of trademarks an opponent must prove use of each trademark of the alleged family [*McDonald’s Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD)]. In the present case, the evidence of sales of the Opponent’s Goods does not break down the sales figures associated with each mark in the “family”. Opponent’s counsel conceded that the evidence on record did not support the required elements for establishing a family of marks. Family of marks will accordingly not be considered as a surrounding circumstance for the purposes of this decision.

Conclusion

[51] In light of the above, and in considering all of the evidence and arguments submitted as well as any relevant surrounding circumstances, I find the Opponent has met its evidential burden under section 16(3)(a) in respect of the goods “beverage containers, food storage containers” as such goods could potentially encompass disposable items and, given the absence of evidence from the Applicant it has failed to

show on a balance of probabilities that there is not a reasonable likelihood of confusion between the parties' marks. The opposition is rejected under this ground in respect of all remaining goods in the Application as a clear connection between the Opponent's paper towels and the Applicant's Goods has not been established.

Section 12(1)(d)

[52] The relevant date for this ground of opposition is date of the Registrar's decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd*, (1991), 37 CPR (3d) 413 (FCA)]. I have also exercised my discretion to confirm that the registrations relied on by the Opponent remain owned by the Opponent and extant and that the goods in those registrations directly overlap with the goods for which the Opponent has filed evidence of use, namely "paper towels" [*Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Nonetheless, as my above finding with respect to confusion applies equally to this ground of opposition, the Application is also refused in respect of the goods "beverage containers, food storage containers" and the opposition is rejected in respect of all other goods.

Section 2

[53] The relevant date for this ground of opposition is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[54] In order to meet its burden in respect of this ground, the Opponent must show that the reputation of its mark(s) prevents the Applicant's mark from being distinctive [*Hilton Worldwide Holding LLP v Solterra (Hastings) Limited Partnership*, 2019 TMOB 133 citing *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657]. The Opponent has met its initial burden with the evidence filed and described above.

[55] Determination of this ground however also rests upon the assessment of the likelihood of confusion between the marks at issue [*Hilton, supra*].

[56] As the different relevant date for this ground does not materially affect my assessment of confusion as set out above for section 16(3)(a), this ground is also

maintained in respect of the goods “beverage containers, food storage containers” and rejected in respect of all other goods.

DISPOSITION

[57] In view of the above and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application for the goods “beverage containers, food storage containers” and reject the opposition with respect to the other goods pursuant to section 38(12) of the Act.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Schedule A

Summary of Grounds of Opposition

- a. Paragraph 38(2)(a) and subsection 30(e), namely as of the filing date, the statement that the Applicant, by itself or through a licensee, or by itself or through a licensee, or by itself and through a licensee, intends to use the Mark in Canada in association with the Goods was false and inaccurate, as 1) the Applicant had used the Mark prior to the filing date of the Application; 2) the Applicant did not intend, by itself and/or through a licensee, to use the Mark in association with the Goods or at all; and/or 3) the Applicant did not intend to use the Mark as a trademark, as defined in Sections 2 and 4 of the Act.
- b. Paragraph 38(2)(a) and subsection 30(i), namely that, as of the filing date, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada. The Applicant knew, is deemed to have known or should have known of the rights and reputation attaching to the Opponent's Marks (as defined in the Statement of Opposition) in Canada, which have been extensively used in Canada since at least as early as March 28, 2010 and September 12, 2011. Further, use of the Mark is unlawful as it contravenes or is likely to contravene Sections 7, 20 and 22 of the Act.
- c. Paragraphs 38(2)(b) and 12(1)(d), namely that the Mark subject to the Application is not registrable as it is and was, at all material times, confusing with the Opponent's Registrations (as defined in the Statement of Opposition).
- d. Paragraph 38(2)(c) and para 16(3)(a), namely, that the Applicant is not the person entitled to register the Application in Canada, since as of the filing date, the Mark was confusing with the Opponent's Marks, previously used in Canada by the Opponent.

- e. Paragraph 38(2)(d) and section 2, namely that the Mark is not distinctive of the Applicant's goods and/or is not adapted to distinguish the Goods from the goods of the Opponent.

Appearances and Agents of Record

HEARING DATE: 2022-12-12

APPEARANCES

For the Opponent: Jeff Gordon

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Borden Ladner Gervais LLP

For the Applicant: Smart & Biggar LLP

Schedule A

Summary of Grounds of Opposition

- f. Paragraph 38(2)(a) and subsection 30(e), namely as of the filing date, the statement that the Applicant, by itself or through a licensee, or by itself or through a licensee, or by itself and through a licensee, intends to use the Mark in Canada in association with the Goods was false and inaccurate, as 1) the Applicant had used the Mark prior to the filing date of the Application; 2) the Applicant did not intend, by itself and/or through a licensee, to use the Mark in association with the Goods or at all; and/or 3) the Applicant did not intend to use the Mark as a trademark, as defined in Sections 2 and 4 of the Act.
- g. Paragraph 38(2)(a) and subsection 30(i), namely that, as of the filing date, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada. The Applicant knew, is deemed to have known or should have known of the rights and reputation attaching to the Opponent's Marks (as defined in the Statement of Opposition) in Canada, which have been extensively used in Canada since at least as early as March 28, 2010 and September 12, 2011. Further, use of the Mark is unlawful as it contravenes or is likely to contravene Sections 7, 20 and 22 of the Act.
- h. Paragraphs 38(2)(b) and 12(1)(d), namely that the Mark subject to the Application is not registrable as it is and was, at all material times, confusing with the Opponent's Registrations (as defined in the Statement of Opposition).
- i. Paragraph 38(2)(c) and para 16(3)(a), namely, that the Applicant is not the person entitled to register the Application in Canada, since as of the filing date, the Mark was confusing with the Opponent's Marks, previously used in Canada by the Opponent.

- j. Paragraph 38(2)(d) and section 2, namely that the Mark is not distinctive of the Applicant's goods and/or is not adapted to distinguish the Goods from the goods of the Opponent.