

IN THE MATTER OF AN OPPOSITION by Flextile Ltd. to application No. 557,293 for the trade-mark ULTRA/FLEX filed by Mapei Canada Inc., now Mapei Inc.

On February 13, 1986, Mapei Canada Inc. filed an application to register the trade-mark ULTRA/FLEX based upon proposed use of the trade-mark in Canada in association with "ciment colle polymère pour carreaux de céramique". The applicant disclaimed the right to the exclusive use of ULTRA apart from its trade-mark. During the opposition, Mapei Canada Inc. changed its name to Mapei Inc.

The opponent, Flextile Ltd., filed a statement of opposition on April 8, 1988 in which it alleged that the applicant's trade-mark ULTRA/FLEX is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the applicant's trade-mark is confusing with the opponent's following registered trade-marks which had been previously used in Canada by the opponent in association with floor and wall tiles, flooring and carpeting, and cements, thin set mortar, adhesives and compounds for caulking, setting, sealing and protective coating:

<u>Trade-mark</u>	<u>Registration No.</u>
FLEXACHROME	48/12850
MIRCO-FLEX	149,147
FLEX-SLATE	151,520
FLEXTILE	273,672
FLEXGLO	286,995
FLEXILASTIC	292,345

The opponent further challenged the applicant's entitlement to registration and the distinctiveness of the applicant's trade-mark ULTRA/FLEX, alleging that the applicant's mark is confusing with the opponent's trade-name Flextile Ltd. which had been previously used in Canada in association with the wares noted above.

The applicant served and filed a counter statement in which it denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of G.T. Engman who was cross-examined on his affidavit, the transcript of the cross-examination and the undertakings furnished by the opponent forming part of the opposition record. The applicant submitted as its evidence the affidavits of: Jean-Jacques Joubert; Thomas Golany; Ross Keltie; Walter Reichle; Morton Alpert; Giuseppe Panzera; George Volpato; Pierre Dion; J.M. Font; Jean Claude Labbé; Lucie Cloutier; Chantal Poirier; Réal Brunet; Sophie Dufresne; and Gino Ramacieri. The affiants Joubert, Dufresne, Labbé, Volpato, Dion, Font, Panzera, Alpert, Reichle, Keltie and Golany were cross-examined on their affidavits, the transcripts of their cross-examinations and the related undertakings, as well as the exhibit to the cross-examination of Volpato, comprising part of the record in this opposition. Gino Ramacieri failed to attend for cross-examination on his affidavit and his affidavit was deemed not to form part of the applicant's evidence pursuant to Rule 46(5) of the Trade-marks Regulations.

The applicant also requested and was granted leave to file additional evidence pursuant to Rule 46(1) of the Trade-marks Regulations, the additional evidence comprising certified copies of ten trade-mark registrations including the element FLEX, as well as a certified copy of an application filed by the opponent to extend the statement of wares of registration No. 273,672 for the trade-mark FLEXTILE, together with a certified copy of the NUANS search report on file in relation to the opponent's extension of wares application.

At the oral hearing, the opponent's agent noted that the application to extend registration No. 273,672 to cover "Grout and mortar for use with ceramic tile", a certified copy of which had been filed by the applicant, had been filed in error and was subsequently withdrawn by the opponent. The agent further noted that the original extension of wares application had been based upon proposed use of the trade-mark FLEXTILE in Canada whereas the replacement extension of wares application claimed use of the trade-mark FLEXTILE in association with grout and mortar for use with ceramic tiles since 1983.

Both parties filed written arguments and both were represented at an oral hearing.

At the oral hearing, the applicant requested that it be granted leave to adduce as further evidence in this opposition pursuant to Rule 46(1) of the Trade-marks Regulations eight additional certified copies of trade-mark registrations. The applicant's agent argued that, as the material date

for determining the Section 12(1)(d) ground is the date of decision in view of the Park Avenue case, it should be entitled to adduce evidence at the hearing relating to the state of the register as of that date. The opponent objected to the applicant's request, pointing out that it had not previously been advised that the applicant intended to adduce such evidence at the hearing and was therefore caught by surprise by the applicant's request.

As the opponent would be effectively precluded from responding to the additional evidence were the applicant granted leave at the hearing stage to file additional evidence, and considering further the lateness of the applicant's request, I advised the parties that I was refusing the applicant's request for leave to adduce the additional certified copies.

Much of the applicant's evidence comprises affidavits from several of the applicant's distributors, each of whom states that he is unaware of any instances in which his company's employees or its clients have believed that the applicant's ULTRA/FLEX wares are somehow associated with the opponent or the opponent's wares. The opponent raised a number of technical objections to the form and content of these affidavits. However, most of the objections were relatively minor in nature and, in any event, the opponent cross-examined each of the distributors on their respective affidavits. Further, certain of the errors contained in their affidavits were corrected by the affiants at the time of their cross-examinations. As a result, I have not ruled any of the affidavits inadmissible on the basis of the technical objections raised by the opponent.

The transcripts of the cross-examinations of the applicant's distributors establish that the distributors sell the applicant's wares to various types of customers, including architectural designers, tile contractors, general contractors, construction companies, and retail stores including carpeting stores, tile stores, hardware stores and commercial retail chains such as Beaver Lumber and Federated Co-op. As well, in those cases where the distributor has a showroom which it open to the public, the distributors also deal directly with do-it-yourselfers. Further, most of the applicant's distributors indicated that they were aware of the opponent and its products even though they did not currently sell the opponent's products to their clients.

The affidavits from the applicant's distributors lend support for the conclusion that, at the wholesale level, those in the construction trades such as contractors and tile installers, are unlikely to confuse the trade-marks at issue. However, as pointed out by the opponent agent, they do not deal directly with the issue of confusion at the retail level where the average home owner or do-it-yourselfer may encounter the wares of both the applicant and the opponent in the same retail outlet,

such as a tile or carpeting store or Beaver Lumber. While a number of the applicant's distributors had showrooms where their products could be purchased by do-it-yourselfers, the distributors did not sell the opponent's ceramic tile adhesives to their customers.

The Dufresne affidavit purports to provide evidence relating to sales to the general public by retail outlets specializing in ceramic tiles. However, Ms. Dufresne's evidence is limited to her observations concerning one customer in one retail store who requested information concerning tiles and adhesives prior to making his purchase. The affiant also provided evidence relating to a telephone survey which she undertook based on entries she located in the Yellow Pages of the Montreal Telephone Directory. However, Ms. Dufresne has not qualified herself as having any expertise in relation to the conducting of surveys and, being hearsay evidence, the results of her investigation can be given little weight in this opposition.

The applicant raised an objection with respect to the reliability of the sales figures provided by Mr. Engman in his affidavit, the applicant submitting that the opponent ought to have provided invoices and other supporting evidence which would confirm the accuracy of the figures provided by Mr. Engman. However, the sales figures provided by Mr. Engman are based on internal financial statements and no evidence has been furnished by the applicant which might point to those figures being inaccurate. As a result, the opponent was not obliged to file invoices or other documentation from which such figures are derived in order to substantiate those figures.

With respect to the non-entitlement grounds of opposition, there is an initial burden on the opponent in view of Sections 16(5) and 17(1) of the Trade-marks Act to establish its alleged prior use of the trade-marks and trade-name relied upon in its statement of opposition, as well as non-abandonment of the trade-marks and trade-name as of the date of advertisement of the applicant's application in the Trade-marks Journal (March 9, 1988). In this regard, the Engman affidavit establishes the prior use and non-abandonment by the opponent of the trade-name Flextile Ltd. and the trade-marks FLEXGLO in association with vinyl composition tiles, FLEX-SLATE in association with vinyl asbestos floor tiles, FLEXILASTIC as applied to thin set mortar and FLEXTILE in association with ceramic tile adhesives, cements, caulking compounds, sheet vinyl adhesives, thin set mortar additives and carpet adhesives. While the opponent's evidence also establishes use of the trade-mark FLEXTILE in association with floor and wall grout, the opponent has not relied upon prior use of the trade-mark FLEXTILE in association with these wares in its statement of opposition. Nevertheless, such evidence may be of relevance as a surrounding circumstance in respect of the issue of confusion between the applicant's mark and the opponent's trade-marks as applied to those

wares covered in its statement of opposition.

The main issue in this opposition is whether the applicant's trade-mark ULTRA/FLEX as applied to the wares covered in its application is confusing with one, or more, of the opponent's registered trade-marks or the opponent's trade-name. In determining whether there would be a reasonable likelihood of confusion between the trade-marks and trade-name at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark ULTRA/FLEX and the trade-marks and trade-name of the opponent as of the material dates in this opposition. In this regard, the material date with respect to the grounds of opposition based on Section 12(1)(d) of the Trade-marks Act is the date of my decision (see Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)) while the material dates with respect to the non-entitlement and non-distinctiveness grounds are respectively the applicant's filing date (February 13, 1986) and the date of opposition (April 8, 1988).

Initially, I would note that the opponent's registration for the trade-mark FLEXACHROME, registration No. 48/12850, was expunged from the register pursuant to Section 45 of the Trade-marks Act and that registration is therefore no longer of relevance to the Section 12(1)(d) grounds of opposition.

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark ULTRA/FLEX, when considered in its entirety, is inherently distinctive when considered in its entirety even though the element ULTRA is descriptive of the character or quality of the applicant's wares and has, in fact, been disclaimed by the applicant apart from its trade-mark. Likewise, the opponent's trade-marks MICRO-FLEX, FLEX-SLATE, FLEXTILE, FLEXGLO and FLEXILASTIC, as well as the opponent's trade-name Flextile Ltd., are inherently distinctive when considered in their entireties even though the elements TILE and SLATE add little inherent distinctiveness to these marks.

Considering the extent to which the trade-marks and trade-name at issue have become known, the applicant's trade-mark ULTRA/FLEX has become known in Canada particularly amongst the applicant's distributors and their clients. In this regard, the Brunet affidavit points to sales of the applicant's ULTRA/FLEX polymer cement adhesive to its distributors exceeded \$275,000 between

June of 1986 and March of 1988. On the other hand, the Engman affidavit establishes that the opponent's trade-mark FLEXTILE and trade-name Flextile Ltd. have become well known in Canada as applied to products relating to the installation of tiles, including ceramic tiles. Further, the evidence establishes that its trade-marks FLEXGLO and FLEX-SLATE also have become known in this country in association with vinyl tiles while the mark FLEXILASTIC has become known to a minor extent in association with thin set mortar.

The length of time that the trade-marks and trade-name at issue have been in use favours the opponent in this opposition in relation to its use of the trade-mark FLEXTILE and trade-name Flextile Ltd.

As for the wares of the parties, the opponent's ceramic tile adhesives are essentially the same as the applicant's ceramic tile polymer cement adhesive in that both are used for the same purpose. While the composition and therefore the cost of the ceramic tile adhesives of the parties may differ, these matters are not particularly relevant to the issue of confusion. On the other hand, the applicant's ceramic tile adhesive differs from the opponent's vinyl tiles associated with its marks FLEXGLO, MICRO-FLEX and FLEX-SLATE. Further the channels of trade associated with the wares of the parties are overlapping to the extent that their wares might well be sold side-by-side through retail stores specializing in ceramic tiles and carpeting, as well as in chain stores like Beaver Lumber. However, the wares of the parties are not wares which would be purchased in a hurried manner and without due consideration prior to making the purchase.

The applicant has submitted that its trade-mark ULTRA/FLEX is always associated with its trade-name MAPEI on its packaging and that the colour of its packaging and printing therein differs from the opponent's packaging. As a result, the applicant submitted that there would be no likelihood of confusion between the trade-marks at issue in the marketplace. However, such matters as these are of no relevance to the Section 12(1)(d) grounds of opposition. In this regard, I would refer to the following comments of Thurlow, C.J. in Mr. Submarine Ltd. v. Amandista Investments Ltd., 19 C.P.R. (3d) 3 (F.C.A.), at pages 10-12:

With respect to the degree of resemblance between the trade-marks and trade-name at issue, there is a fair degree of similarity in appearance and some resemblance in sounding between the applicant's trade-mark ULTRA/FLEX and the opponent's trade-marks FLEXTILE and MICRO-FLEX and its trade-name Flextile Ltd. On the other hand, I consider there to be somewhat less similarity in appearance and in sounding between the applicant's mark and the opponent's trade-marks FLEXGLO, FLEXILASTIC and FLEX-SLATE. All of the trade-marks at issue, as well as the opponent's trade-name, suggest the idea of flexibility.

As a surrounding circumstance in respect of the issue of confusion, the applicant adduced evidence of the state of the register. However, only three of the trade-mark registrations relied upon by the applicant cover wares similar to those of the parties and only one registration for the trade-mark LASTIFLEX specifically covers tile adhesives. Additionally, no evidence has been adduced by the applicant that any of the third party trade-marks is in use in Canada. As a result, little, if any, weight can be attributed to the applicant's evidence relating to the state of the register.

As yet a further surrounding circumstance in respect of the issue of confusion, the opponent relied upon its alleged family of trade-marks including the element FLEX. However, there is an onus on a party seeking to rely upon the presumption of the existence of an alleged family of trade-marks to establish that it is the only person who has registered and used the trade-marks which incorporate the common characteristic of the series (see McDonald's Corporation et al v. Yogi Yogurt Ltd. et al., 66 C.P.R. (2d) 101). On the other hand, and as pointed out by the learned trial judge in the Yogi Yogurt case, the presumption of the existence of a series or family of mark is rebuttable if the applicant can establish the registration and use of other trade-marks standing in the name of other persons whose marks share the element or elements common to the trade-marks comprising the

alleged series of marks relied upon by the opponent.

In the present case, the Engman affidavit evidences the existence of registrations for the trade-marks FLEXACHROME, FLEXTILE, FLEXFLO, FLEXILASTIC, MICRO-FLEX and FLEX-SLATE while the opponent's letter of undertaking (dated August 3, 1990) also refers to its trade-mark FLEX-EXOPY which was registered subsequent to the opponent's opposition. However, the trade-mark FLEXACHROME has been expunged from the register and the opponent's registrations for the trade-marks MICRO-FLEX, FLEXGLO and FLEX-SLATE cover vinyl tiles only. The opponent's evidence also indicates that there has been very little use of the trade-mark MICRO-FLEX and relatively limited use of the trade-mark FLEXILASTIC in association with thin set mortar while no evidence of any sales have been provided by the opponent with respect to its FLEX-EPOXY epoxy mortar emulsion (see Exhibit J to the Engman affidavit). Additionally, the applicant has evidenced the existence of registrations for the trade-marks LASTIFLEX, FLOR-FLEX and FLEXI-FLOR for wares which appear to be similar to those of the parties. As a result, the opponent has failed to meet the burden upon it of establishing that it is the only person who has registered trade-marks including the element FLEX as applied to wares similar to those associated with the opponent's alleged family of registered FLEX marks.

As a further surrounding circumstance in respect of the issue of confusion, the opponent sought to establish that there is a tendency for the public to refer to it as Flex. However, Questions 124 to 132 and the related responses from the transcript of the Engman cross-examination indicate the tendency of a few contractors to refer to the opponent as Flex. However, the opponent's evidence does not establish that the average do-it-yourselfer would likewise abbreviate the opponent's name or mark FLEXTILE to Flex. I therefore do not consider that much weight can be attributed to this evidence in assessing the issue of confusion.

Apart from the above, I am mindful of the fact that, despite the parties being in direct competition, there has been no evidence furnished by the opponent of actual confusion between the applicant's trade-mark ULTRA/FLEX and its trade-marks and trade-name. However, the applicant's evidence points to sales of the applicant's ULTRA/FLEX product between July of 1986 and March of 1988 of \$275,000. Had those sales been significantly larger over a longer period of time, the absence of evidence of actual confusion between the trade-marks at issue might have been a significant surrounding circumstance in deciding the outcome of this opposition.

Having regard to all of the above, I have concluded that the applicant has failed to meet the

legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark ULTRA/FLEX and the opponent's registered trade-mark FLEXTILE. In this regard, the trade-marks ULTRA/FLEX and FLEXTILE bear a fair degree of similarity in appearance, sounding and in the ideas suggested and are applied to wares which are essentially the same. Further, the ceramic tile adhesives of the parties could well be sold side-by-side in retail ceramic tile stores, hardware stores or the like, such that the channels of trade of the parties do overlap. Additionally, there is little evidence of adoption and no evidence of use by any direct competitors of the parties of any trade-marks or trade-names including the element FLEX as applied to ceramic tile adhesives. As a result, I have concluded that the average consumer such as the do-it-yourselfer might be left in a state of doubt as to the source of the wares were he or she to see the marks ULTRA/FLEX and FLEXTILE on ceramic tile adhesives.

In view of the above, I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF NOVEMBER 1993.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.

identical wares. the wares and channels of trade of the parties are clearly overlapping and the applicant and opponent are major competitors throughout Canada. Even considering that the home owner or do-it-yourselfer is not likely to purchase the wares of the parties in a hurried manner and without due consideration, and even assuming that it were necessary to inform himself as to the type of adhesive which he might require for a particular application, the wares at issue

In the transcript of the Volpato cross-examination, Mr. Volpato states that he saw an advertisement for the opponent's FLEXITILE VERSATILE 52 in a trade magazine called "Tile". Also, Mr. Volpato had a contractor obtain two bags of the FLEXITILE VERSATILE 52 adhesive from the opponent's distributor, Olympia. As well, at page 10, Volpato states that the magazine which contained the opponent's ad has "tile companies that advertise in her, and you even have the MATEI products advertised in this magazine.

22% of Volpato's sales are directly to the public.

At page 15, Volpato states that he has clients who specifically ask for FLEXITILE products.

U/F is mostly for contractor and a professional who knows how to use it ... its not the major selling product for tile adheson. It is hpwever three times less expensive than KERALASTIC (Volpato p. 22)

Dion sell FLEXITILE products and has been aware of those products for 5 years (Dion p. 6).

Flextile have a line of products that compete with Mapei products (Font, p. 4)

Labbe p. 18 do not recommend U/F product to consumers who do the work themselves. Consumers ask for advice.

Some of his clients (retail customers) sell both applicant's and opponent's products. (p. 21 x-examn)

Golany's company has showrooms open to the public including do-...

Keltie's company sells FLEXITILE vnyl tiles p. 6

Reichle has showroom where products available to do-it... p.3 His company used to sell some FLEXITILE products but do not at this time.

Alpert has showroom available to public.

Joubert

p. 23 Flextile is a direct competitor of the applicant in the adhesives section for ceramic tiles and adhesives for ceramic tiles comprises the ulk of the applicant's business.

pgs. 30-31 talking about possible confusion that may ensue from terms FLEXILASTIC and ULTRA/FLEX because FLEXILASTIC cpntains the word FLEX and the term sounds lke , or is similar to, the term U/F. However, products are marketed in dfferent ways n that the packaging differs and FLEXILASTIC has 2 components one powder and one liquid whle U/F is only a powder

p. 34 distributors have a tendency to be more exclusive with one manufacturer. Olympa, which does major distribution for opponent, does not buy Mapei products. That will diminish any possible confusion that may arise.

rely upon evidence that Mr. Engman states in his affidavit that the opponent's often refer to Flextile Ltd. as simply "FLEX". In the transcript of Mr. Engman's cross-examination, the following questions and answers appear concerning this matter:

124. Q. In the next paragraph you state that your customers often refer to Flextile as simply Flex. Have you personally heard your customers refer to Flextile as Flex?

A. Yes.

125. Q. How many times?

A. I don't know. It's certainly more than once but it's happened when I've been talking to contractors. And n talking to distributors they indicate that contractors often just use the contraction of our name.

126. Q. Can you repeat that for me again?

A. I said that ---

127. Q. When you talk to customers they say that the contractors they sell to ---

A. Yes.

128. Q. So personally could you say that you heard it 10 times, 5 times, an estimate? Is it more than 10?

A. Well, I don't have that much direct contact with contractors. On the occasions when I have heard them use the term, it's been at one of the seminars that's been put on.

129. Q. That you would be giving?

A. Yes.

130. Q. So personally you have not heard your customers refer to Flextile as Flex? You have heard one of your customers saying that he has heard ---

A. No, no. I told you that I personally heard contractors.

131. Q. In seminars?

A. Yes.

132. Q. Can you give me the name of this customer ---

A. No.

While this evidence does