

**IN THE MATTER OF AN OPPOSITION by
Elastogran GmbH to Application No. 1226342
for the trade-mark eLastropene filed by Solplast
Inc.**

I The Proceedings

On September 9, 2004 Solplast Inc. (the “Applicant”) filed an application to register the trade-mark eLastropene (the “Mark”) based on use in Canada since at least May 2004 in association with rubber, combined with plastic extruded for use in the manufacturing of thermo plastic elastomers (the “Wares”).

The application was advertised August 24, 2005 in the *Trade-marks Journal* for opposition purposes. Elastogran GmbH (the “Opponent”) filed a statement of opposition on January 18, 2006 and the Registrar forwarded it on February 23, 2006 to the Applicant.

The Applicant filed on March 21, 2006 a counter statement denying essentially all grounds of opposition pleaded.

The Opponent filed the affidavit of Kerry Bowman. The Applicant filed no evidence. Both parties filed written arguments. An oral hearing was held and only the Opponent was present.

II The Grounds of Opposition

The grounds of opposition are:

1. The application does not conform to the requirements of s. 30 of the Trade-marks Act R.S.C. 1985, c. T-13, (the “Act”) in that:
 - a) The Applicant never used the Mark in Canada;
 - b) Alternatively or cumulatively, the use of the Mark, if any, in whole or in part, is not a continuous one;
 - c) It is falsely that the Applicant has claimed to be satisfied to use the Mark in Canada in view of the facts hereinafter referred to, including the Applicant’s knowledge of the Opponent’s rights as herein alleged and of the unlawfulness of said use.

2. The Mark is not registrable pursuant to the provisions of s. 38(2)(b) and 12(1)(d) of the Act since it is confusing with the following registered trade-marks:

CELLASTO, registration TMA441017
ELASTOCELL, registration TMA512860
ELASTOCOAT, registration TMA429782
ELASTOFLEX, registration TMA429329
ELASTOFOAM, registration TMA433238
ELASTOLIT, registration TMA429781
ELASTOPAN, registration TMA430539
ELASTOPOR, registration TMA430835
(collectively referred to as the “Opponent’s registered trade-marks”)

3. The Applicant is not the person entitled to the registration of the Mark in view of the provisions of s. 38(2) (c) and 16(1)(a) of the Act as:

At the claimed date of first use of the Mark, it was confusing with the above mentioned registered trade-marks previously used in Canada or made known in Canada by the Opponent or its predecessors in title in association with the wares covered by the respective registrations or in association with wares of the same nature as those covered by the opposed application.

4. The Applicant is not the person entitled to the registration of the Mark in view of the provisions of s. 38(2)(c) and 16(1)(b) of the Act as:

At the claimed date of first use of the Mark, it was confusing with the trade-marks in respect of which an application for registration had been previously filed in Canada by the Opponent or its predecessor in title, namely:

ELASTOCLEAR: application number 1185500;
ELASTOSHORE: application number 1104231;
ELASTOSTAB: application number 1141816.

5. Pursuant to s. 38(2)(d) of the Act, the Applicant’s Mark is not distinctive of the Wares having regard to s. 2 of the Act since:

- a. The Mark does not actually distinguish the Applicant’s Wares from the wares of others including the Opponent nor is it adapted to distinguish them;
- b. Because of the transfer of the Mark, there were subsisting rights of use of the Mark into two or more entities and those rights were exercised by those entities concurrently, contrary to the provisions of s. 48(2) of the Act;
- c. The Mark is used outside the scope of protection governing licensed use of a trade-mark as defined in s. 50 of the Act.

II General Principles Applicable to all Grounds of Opposition

The Applicant has the legal onus to show that its application complies with the provisions of the Act, but there is however 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 still has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

The Opponent has not adduced any evidence to support the grounds of opposition described in paragraph 1 above as well as grounds of opposition detailed in paragraphs 5(b) and (c). As for paragraph 5(a) it is not sufficiently pleaded and thus contravenes s. 38(3) of the Act. Therefore all those grounds of opposition are dismissed.

III The relevant dates

The relevant date for the analysis of each of the remaining grounds of opposition varies:

- The registrability of the Mark under s. 12(1)(d) of the Act: The date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A)];
- Entitlement to the registration of the Mark, where the application is based on use: The date of first use alleged in the application (May 2004) [see s. 16(1) of the Act];

IV Registrability of the Mark

The Opponent is alleging that the Mark is not registrable pursuant to s. 12(1)(d) of the Act as it is confusing with its registered trade-marks listed above. The Opponent has not filed certified copies of these registrations. However when an opponent raises as a ground of opposition s. 12(1)(d) and has not filed the certificate(s) of registration relied upon, the Registrar can use its discretion and check the register which I did [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. The Opponent is the owner of the following registered trade-marks:

CELLASTO, registration TMA441017, is registered in association with raw plastic materials (in liquid and granular form); wares made of plastic, namely spring washers, gears, wheels,

leaf and disk springs, bearings and sleeves, washers, disk breakers, brake pad slides, skid slides, fan belts, all aforesaid goods for vehicles and machines;

ELASTOCELL, registration TMA512860, is registered in association with plastics in the raw state (in the form of granules, powders, liquids or pastes); technical parts made of resilient plastics for agricultural vehicles, namely spring rings, spring shells, bearing cages, bearing sleeves, bearing shells, disk buffers, friction coatings for flat belts, insert layers for rings, V-belts, profiled belts, spring washers, springs, mountings and bearing blocks, bumpers, mounting buffers, crane buffers, sliding runners; technical parts made of resilient plastics for machines, namely spring rings, spring shells, bearing cages, bearing sleeves, bearing shells, disk buffers, friction coatings for flat belts, insert layers for rings, V-belts, profiled belts, spring washers, springs, mountings and bearing blocks, bumpers, mounting buffers, crane buffers, sliding runners; moldings as seals for bearings and articulated heads, stop springs and auxiliary springs, vibration, end-position and friction dampers; pipe and tube supports, coupling elements, rollers, grinding wheels; semi-finished products made of plastic (in the form of sheets, bars, blocks, pipes, cylinders, tubes, rings, boards); insulants made of plastic against heat, cold, impact and/or sound (in the form of boards, beads, moldings, chips or shreds); sealants, packing cords, gaskets.

ELASTOCOAT, registration TMA429782, is registered in association with chemical products used in industry, namely chemicals and auxiliaries for use in the processing of plastics, artificial resins, synthetic resins and plastics, all unprocessed, in the form of powders, liquids or pastes;

ELASTOFLEX, registration TMA429329 is registered in association with unprocessed plastics (in the form of powders, liquids or pastes);

ELASTOFOAM, registration TMA433238, is registered in association with foamed plastics, unprocessed, in the form of chips and granules; sheeting, boards, rods and blocks of foamed plastics (semi-manufactures);

ELASTOLIT, registration TMA429781, is registered in association with chemical products used in industry, namely raw materials for the production of plastics; unprocessed plastics; footstep-sound insulating materials in the form of boards or moldings for use in structural and civil engineering, all aforementioned goods not containing organo-(poly) siloxanes;

ELASTOPAN, registration TMA430539, is registered in association with unprocessed plastics in the form of liquids, granules or pastes; chemicals for the production of plastics; plastics as semi- manufactures in the form of sheeting, boards, tubes or rods; all the foregoing wares excluding finished products for use as roofing materials; shoe parts made from plastics, namely soles, heels;

ELASTOPOR, registration TMA430835, is registered in association with unprocessed plastics in the form of powders, liquids or pastes; sheeting, boards, rods and blocks of plastic (semi-manufactures); plastic foams used as thermal and refrigeration insulation for walls, roofs and pipes; all the foregoing wares excluding finished products for use as roofing materials.

Therefore the Opponent has met its initial burden with respect to this ground of opposition. Next I have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's registered trade-mark ELASTOPOR as I consider it to be the best case scenario

for the Opponent. If the Opponent were not successful under that trade-mark, it would also be unsuccessful when considering any of its other registered trade-marks.

The test to determine this issue is set out in s. 6(2) of the Act and I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or in the ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)]. I also refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under s. 6(5) of the Act to determine the likelihood of confusion between two trade-marks in these words:

Within the “all the surrounding circumstances” test, s. 6(5) of the Act lists five factors to be considered when making a determination as to whether or not a trade-mark is confusing. These are: “(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; (b) the length of time the trade-marks or trade-names have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them”. The list of circumstances is not exhaustive and different circumstances will be given different weight in a context-specific assessment. See *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.). In opposition proceedings, as stated, the onus is on the applicant (here the respondent) to show on a balance of probabilities that there is no likelihood of confusion.

(...)

What, then, is the perspective from which the likelihood of a “mistaken inference” is to be measured? It is not that of the careful and diligent purchaser. Nor, on the other hand is it the “moron in a hurry” so beloved by elements of the passing-off bar: *Morning Star Co-Operative Society Ltd. v. Express Newspapers Ltd.*, [1979] F.S.R. 113 (Ch. D.), at p. 117. It is rather a mythical consumer who stands somewhere in between, dubbed in a 1927 Ontario decision of Meredith C.J. as the “ordinary hurried purchasers”: *Klotz v. Corson* (1927), 33 O.W.N. 12 (Sup. Ct.), at p. 13. See also *Barsalou v. Darling* (1882), 9 S.C.R. 677, at p. 693. In *Delisle Foods Ltd. v. Anna Beth Holdings Ltd.* (1992), 45 C.P.R. (3d) 535 (T.M.O.B.), the Registrar stated at p. 538:

When assessing the issue of confusion, the trade marks at issue must be considered from the point of view of the average hurried consumer having an imperfect recollection of the opponent's mark who might encounter the trade mark of the applicant in association with the applicant's wares in the market-place.

It is with these general principles in mind that I shall review the pertinent evidence and assess each relevant factor identified above.

The Mark is inherently distinctive. It is a coined word; so is the Opponent's trade-mark ELASTOPOR. Both marks comprise the prefix "elasto" which may suggest "elastomer" in the context of the parties' respective wares.

The degree of distinctiveness of a trade-mark can be enhanced through use or if made known in Canada. The Applicant has not file any evidence. Therefore there is no evidence of use of the Mark.

Mr. Bowman is the Business Director for BASF Canada Inc ("BASF") since October 2004. He states that the Opponent is a German corporation. Both the Opponent and BASF are wholly owned subsidiaries of their parent company BASF AKTIENGESELLSCHAFT ("BASF AG").

The Opponent's commercial activities are concentrated in the business sector of "plastics". It is a major supplier of polyurethane systems and polyurethane special elastomers. He alleges that BASF is the commercial representative in Canada for the wares bearing any of the Opponent's registered trade-marks. He further alleges that the Opponent has direct or indirect control over the quality and character of the wares produced and sold in association with the Opponent's registered trade-marks.

At paragraph 15 of his affidavit, Mr. Bowman sates that "the wares associated with the Opponent's registered trade-marks are chemical products that can be offered in liquid or granules form. They can also result from the combination of two (2) or more products in specifically designed processing machine. Such polyurethane resins are therefore sometimes sold in pails, drums, totes, tank trucks and rail cars. Products labels can be affixed to pails, drums and totes.

The trade-marks are also associated with the products at the time of transfer when they appear on invoices, price letters, contracts, data sheets and material safety data sheet.”

The trade-mark ELASTOPOR is typically applied to two (2) component urethane systems used to produce thermal polyurethane insulation. It is used in combination with aluminium or paper in housing construction for sloping, flat-roof and floor insulation. The products bearing the trade-mark ELASTOPOR are also used in the insulation of refrigerators and freezers as well as pipe insulation. Resins sold in association with such trade-mark are used in the manufacture of entrance and garage doors, commercial refrigeration panels and building panels. He filed a product label bearing the trade-mark ELASTOPOR. The trade-mark was first used in Canada in 1994. He also filed a sample of an invoice dated August 27, 2002 wherein there is reference to such trade-mark. We do not have the extent of the sales made in Canada of wares bearing the trade-mark ELASTOPOR. However there is some evidence of use of the mark and as such I conclude that the trade-mark ELASTOPOR was known in Canada at least to a limited extent.

The length of time the trade-marks in issue have been used also favours the Opponent.

The Applicant does make comments in its counter statement and its written argument in order to distinguish the parties’ respective wares and channels of trade. However there is no evidence filed by the Applicant to support such contention. I must disregard any conclusion of facts if such conclusion is drawn from facts not part of the evidence in the file.

It is the Applicant’s statement of wares and the statement of wares and services in the Opponent’s registration that govern: see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 at 10-11 (F.C.A.), *Henkel Kommanditgesellschaft v. Super Dragon* (1986), 12 C.P.R. (3d) 110 at 112 (F.C.A.) and *Miss Universe, Inc. v. Dale Bohna* (1994), 58 C.P.R. (3d) 381 at 390-392 (F.C.A.). 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. In this regard, evidence of the actual trades of the parties is useful [see *McDonald’s Corporation v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 at 169 (F.C.A.)].

Mr. Bowman explains the relationship between the Wares and the Opponent's products sold in association with its registered trade-marks. He asserts that some of the products sold by BASF AG are used in the industry to replace or as a better solution to rubber. Based on his experience the deponent alleges "...one can logically expect that the Opponent and its parent company BASF AG... could also offer urethane products used in the fabrication of wares to replace rubber." He alleges that some of the products sold in association with the Opponent's registered trade-marks are also chemical products used in the fabrication of various rubber-like products such as silicone rubber roof coating.

He states that customers may choose the Opponent's products because of their long-term flexibility, better tear strength, greater design flexibility and better give to broad temperature scales. Consequently, customers interested in purchasing the Applicant's Wares could also logically consider buying the Opponent's products or at least compare both of them.

The deponent also alleges that plastics and rubber are often part of the same category of products; they are also discussed in the same publications or international conferences. Both the Applicant and the Opponent or its parent company BASF AG are sometimes part of the same associations or participate in similar events. Finally when it comes to analyzing physical properties of both rubber and polyurethane products, the same standard test method (the American Standard Test Methods) is used in the industry. Therefore the Applicant's Wares could be tested in the same manner as the Opponent's products.

All this evidence has not been contradicted. I must conclude therefore that there is a possibility of overlap in the parties' respective wares and channels of trade. Such factors favor the Opponent.

With respect to the degree of resemblance, Mr. Justice Cattanach stated in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70:

“Realistically appraised it is the degree of resemblance between the trade-marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.”

The marks in issue resemble one another phonetically and visually primarily because the first portion of each mark is identical. Although the first component of a mark is often considered more important for the purpose of distinction, when it is a common, descriptive or suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)]. In this instance the first component is the term “elasto” which refers to “elastomer”. However the Opponent is arguing that it owns a family of trade-marks beginning with the term “elasto”. Therefore in view of the connexity of the parties’ respective wares, a consumer having a recollection of the Opponent’s registered trade-marks will associate the Mark with the Opponent rather than with the Applicant.

An opponent, who wants to prevail itself of a wider ambit of protection because it claims the benefit of a family of trade-marks, must show use of those trade-marks [see *MacDonald’s Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)]. The Opponent’s trade-marks are listed above. There is evidence in the record of use of the following trade-marks: ELASTOFLEX, since at least December 2003, ELASTOCOAT, since at least September 2004, ELASTOFOAM, since at least May 2004, ELASTOLIT since at least February 2001. There is no evidence of use of the other cited trade-marks. With the trade-mark ELASTOPOR, those trade-marks create a family of at least five (5) trade-marks with the prefix “elasto”. There is no evidence of use of such prefix in the marketplace by third parties in association with related wares.

Overall, I conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that the Mark is registrable. There is some overlap in the wares and their channels of trade; the Mark resembles the Opponent’s trade-mark ELASTOPOR in that the prefix of both marks is the same; and the Opponent is the owner of a family of trade-marks having as a prefix

the term “ELASTO”. Consequently the second ground of opposition is maintained.

V Remaining grounds of opposition

The Opponent is arguing that the Applicant is not entitled to the registration of the Mark as at the claimed date of first use of the Mark, it was confusing with its registered trade-marks previously used in Canada in association with wares of the same nature as of the Wares. As discussed above, the Opponent has shown prior use of at least five of its registered trade-marks including ELASTOPOR. It has therefore discharged its initial burden of proof. The Applicant must therefore show, that it is the person entitled to the registration of the Mark.

The conclusions reach on the likelihood of confusion between the Mark and the Opponent’s registered trade-mark ELASTOPOR, when determining if the Mark would be registrable under s. 12(1)(d) of the Act, are equally applicable under entitlement. Consequently the third ground of opposition is also maintained.

As for the fourth ground of opposition, it is not necessary to dispose of it as the Opponent has already been successful under two separate grounds of opposition.

VI Conclusion

Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act

DATED IN BOUCHERVILLE, QUEBEC, THIS 13th DAY OF FEBRUARY 2009.

Jean Carrière,
Member, Trade-marks Opposition Board