



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2011 TMOB 170**  
**Date of Decision: 2011-09-21**

**IN THE MATTER OF AN  
OPPOSITION by ACM  
Chemistries Inc. to application  
No. 1,263,246 for the trade-mark  
COLOR SCAPES & Design in the  
name of Royal Group Inc.**

FILE RECORD

[1] On June 30, 2005, Royal Group Technologies Limited filed an application to register the trade-mark COLOR SCAPES & Design, illustrated below, based on proposed use of the mark in Canada in association with the wares “vinyl siding.” During the course of this proceeding the applicant changed its name to Royal Group Inc..



[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated May 3, 2006 and was opposed by ACM Chemistries Inc. on October 3, 2006. The Registrar of Trade-marks forwarded a copy of the statement of opposition to the applicant on October 19, 2006 as required by s. 38(5) of the

*Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent elected not to file any evidence. The applicant's evidence consists of a certified copy of its trade-mark registration No. TMA 670,816 for the word mark COLORSCAPES. I note that the aforementioned registration, like the subject application, covers the wares "vinyl siding" and issued from a proposed use application filed concurrently with the subject application. Only the opponent submitted a written argument. An oral hearing was not conducted.

#### STATEMENT OF OPPOSITION

[4] 1. The first ground of opposition, pursuant to s.30(i) of the *Trade-marks Act*, alleges that the applicant cannot be satisfied that it is entitled to register the applied for mark COLOR SCAPES & Design in view of the applicant's knowledge of the opponent's prior use and/or making known of its mark COLORSCAPE in Canada.

2. The second ground, pursuant to s.16(3)(a) of the *Act*, alleges that the applicant is not entitled to registration because, at the date of filing the application, the applied for mark was confusing with the opponent's mark COLORSCAPE previously used and/or made known in Canada by the opponent in association with "a chemical additive for use in the manufacture of paving stones . . ."

3. The third ground, pursuant to s.16(3)(b), alleges that the applicant is not entitled to registration because, at the date of filing the application, the applied for mark was confusing with the opponent's mark COLORSCAPE "for which an application for registration had been previously filed in Canada by the Opponent, well prior to the Applicant's filing date . . ."

4. The fourth ground, pursuant to s.2, alleges that the applied for mark is not distinctive of applicant since it does not nor is it adapted to distinguish the applicant's wares from the opponent's wares.

#### LEGAL ONUS AND EVIDENTIAL BURDEN

[5] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of

opposition. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298 (F.C.T.D.). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

#### *First Ground of Opposition*

[6] With respect to the first ground of opposition, s.30(i) applies if fraud is alleged on the part of the applicant or if specific federal statutory provisions prevent the registration of the mark applied for: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155 and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 C.P.R. (3d) 221. In the instant case the pleadings do not support a ground of opposition based on s.30(i) and it is therefore rejected.

#### *Second Ground of Opposition*

[7] With respect to the second ground, pursuant to s.16(3)(a), it was incumbent on the opponent to establish that it had in fact used or made known its mark in Canada, and that its mark had not been abandoned as of the date of advertisement of the applied for mark. As the opponent has not established such use or making known or non-abandonment, the opponent has failed to meet the evidentiary burden on it to put the second ground in issue. The second ground is therefore rejected.

#### *Third Ground of Opposition*

[8] With respect to the third ground, pursuant to s.16(3)(b), it was incumbent on the opponent to establish that it had in fact filed a trade-mark application for the mark COLORSCAPE prior to the applicant's filing date. Ordinarily, the opponent would file a certified copy of its application or an affidavit attaching the application as an exhibit.

Alternatively, if the application is identified by its file number in the statement of opposition, then the Registrar would exercise discretion to confirm the application: see *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R.(3d) 525 at 529 (TMOB). In the instant case, the opponent has not evidenced its application or identified its file number in the statement of opposition. Consequently, the opponent has failed to meet the evidentiary burden on it to put the third ground in issue. The third ground is therefore rejected.

#### *Fourth Ground of Opposition*

[9] With respect to the fourth ground alleging non-distinctiveness, it was incumbent on the opponent to establish a reputation for its mark COLORSCAPE through use or advertising of the mark. However, the opponent has not evidenced any use or advertising of its mark and has therefore failed to meet the evidentiary burden on it to put the fourth ground in issue. The fourth ground is therefore rejected.

#### OPPONENT'S WRITTEN ARGUMENT

[10] At page 4 of its written argument, the opponent urges me to consider the issue of confusion with its registered mark COLORSCAPE which registration had not issued at the time that the statement of opposition was submitted:

The Opponent is the owner of the trade-mark COLORSCAPE, which was filed on December 12, 2003, and now registered under No. TMA678,158, upon which it is relying to support its grounds of opposition, particularly the grounds pursuant to Sections 38(2)(c) and 38(2)(d).

It is a well-established principle that the Registrar has the discretion to check the Register to determine whether a registration pleaded in the statement of opposition was, as of the date of the filing of the opposition, on the Register. For example, as noted in *Broadway Sound Plus Ltd. v. M & K Stereo Plus Ltd.* (1984), 3 C.P.R. (3d) 410 at 412, which was quoted with approval below by Chairman Partington in *Holland Imports Inc. v. Group Val Royal Inc.* (1990), 31 C.P.R. (3d) 128 at 240:

Since the registrar is charged with the care of the register, he has the discretion to himself check the register and determine whether a particular registration exists: see in this regard *G.H.*

*Mumm & Cie et al. v. Registrar of Trade-marks* (1982), 64 C.P.R. (2d) 233 at p. 227. The general position of the registrar is that, having regard to the realities of available manpower, he will not in opposition proceedings exercise his discretion and have regard to anything appearing on the register that is not properly proved by evidence. However, where, as in this case, reference is made in the statement of opposition to a trade-mark registration and that registration forms the basis of an allegation that the applicant's trade-mark is not registrable pursuant to s. 12(1)(d), the registrar, having regard to the potential public interest in having such a ground of opposition raised, does consider it appropriate to exercise his discretion to check the register.

In this case, the Opponent's trade-mark was allowed on May 13, 2005, well prior to the filing of the statement of opposition on October 3, 2006, and it registered very shortly thereafter on December 6, 2006. It is respectfully submitted that insofar as the fundamental reason underlying the Registrar's discretion to check the Register and recognize the existence of a particular registration is, as established by the jurisprudence, to uphold the potential public interest in having a ground of opposition raised that is based upon confusion with a prior third party mark, it is not reasonable for the Registrar to limit his discretion to recognizing registrations existing at the time an opposition is filed. Where, as here, the registration exists at the time the Registrar is called upon to make a determination on the issue of confusion, and the particulars of such registration clearly show as a matter of public record the facts that are relevant to the issue of determining the grounds of opposition raised based on confusion and entitlement pursuant to Section 16, it is respectfully submitted that the Registrar ought to exercise his discretion to check the Register and determine the existence of the registration and of the particulars therein for the purpose of assessing the issue of confusion. It is further respectfully submitted that this determination is sufficient to discharge the burden upon the Opponent with respect to all the grounds of opposition that are based on, or determined by a finding of, a likelihood of confusion between the parties' trade-marks.

See also *Automaxi S.A. v. UAP Inc.* (1991), 39 C.P.R. (3d) 550 (TMOB); aff'd 47 C.P.R. (3d) 158; aff'd 59 C.P.R. (3d) 82.

[11] I do not agree with the opponent that, in the instant case, it is appropriate for me to exercise discretion to confirm the opponent's registration for the mark COLORSCAPE. In this regard, the opponent has not pleaded confusion with a registered mark, pursuant to s.12(1)(d), as a ground of opposition. Had the opponent amended its

statement of opposition to include a new ground based on s.12(1)(d), as permitted by Rule 40 of the *Trade-marks Regulations*, then I would have exercised my discretion in accordance with Board practise as discussed above by former Chairman Partington. Alternatively, the opponent might have requested leave under Rule 44 of the *Trade-marks Regulations* to submit evidence of its registration.

[12] In any event, even if I had considered the issue of confusion with the opponent's registered mark, it is doubtful that the subject application for COLORSCAPE & Design would have been refused. In this regard, it appears that the opponent's product namely, "a chemical additive for use in the manufacture of paving stones" is quite different from the applicant's wares namely, "vinyl siding." In the absence of evidence to the contrary, I would assume that the opponent's wares are sold in bulk to industrial clients while the applicant's wares would be sold retail to the average consumer. Thus, there would be no overlap in the parties' channels of trade and therefore little likelihood of confusion, particularly as the opponent has not established any reputation for its mark.

#### DISPOSITION

[12] In view of the foregoing, the opposition to COLORSCAPE & Design is rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

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Myer Herzig  
Member  
Trade-marks Opposition Board