

**IN THE MATTER OF AN OPPOSITION by MAPEI INC. to
application No. 872,429 for the trade-mark ELASTO-BOND filed
by CHEMBOND LIMITED**

On March 26, 1998, the applicant, CHEMBOND LIMITED, filed an application to register the trade-mark ELASTO-BOND based upon use of the trade-mark in Canada by the applicant since at least as early as March 31, 1995 in association with “Chemical modified Portland powder cement premixed mortar, namely water mixed multi purpose floor and wall tile cement adhesive”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of December 8, 1999 and the opponent, MAPEI INC., filed a statement of opposition on January 17, 2000, a copy of which was forwarded to the applicant on February 8, 2000. The applicant served and filed a counter statement in response to the statement of opposition on June 8, 2000. The opponent submitted as its evidence certified copies of registration Nos. 457,555, 405,426, 236,702, and 414,442 for the trade-marks ELASTOCOLOR, EPO/BOND, KERABOND and ULTRA/COLOR, respectively, while the applicant elected not to file any evidence. The applicant alone filed a written argument and neither party requested an oral hearing.

As no evidence of use of any of its trade-marks has been adduced by the opponent, the opponent has failed to meet the initial burden on it in respect of its section 16 and non-distinctiveness grounds. Likewise, no evidence has been furnished by the opponent in support of its section 30 ground of opposition. As a result, these grounds of opposition are unsuccessful. Thus, the only remaining ground of opposition for consideration is based on paragraph 12(1)(d) of the

Trade-marks Act, the opponent alleging that the applicant's trade-mark ELASTO-BOND is not registrable in that it is confusing with its registered trade-marks ELASTOCOLOR, EPO/BOND, KERABOND and ULTRA/BOND, registration Nos. 457,555, 405,426, 236,702 and 414,442, respectively.

In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark ELASTO-BOND and one, or more, of the opponent's registered trade-marks, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark ELASTO-BOND and one, or more, of the opponent's registered trade-marks as of the date of my decision, the material date in relation to the paragraph 12(1)(d) ground [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

I would note initially that the opponent has misidentified either the trade-mark or the registration number of the mark which it has identified in its statement of opposition as being the registered trade-mark ULTRA/BOND, registration No. 414,442. Presumably, the opponent had intended to refer to the registered trade-mark ULTRA/COLOR, registration No. 414,442, as the opponent filed a certified copy of this registration as part of its evidence. However, as this aspect of the opponent's paragraph 12(1)(d) ground is ambiguous and is therefore contrary to paragraph 38(3)(a) of the *Trade-marks Act*, I have not considered the paragraph 12(1)(d) ground which is

based on the registered trade-mark ULTRA/BOND, registration No. 414,442.

As noted above, the opponent has submitted as its evidence certified copies of its registrations, the particulars of which are set out below:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares</u>
ELASTOCOLOR	457,555	Revêtement élastomère polymérique à un, deux ou trois composantes pour la protection et décoration des surfaces de béton et maçonnerie..
EPO/BOND	404,426	Liant à l'époxy pour le béton ainsi qu'un obturateur de fissure.
KERABOND	236,702	Cement glue.

With respect to the inherent distinctiveness of the trade-marks at issue [para. 6(5)(a)], the applicant's trade-mark ELASTO-BOND possesses some measure of inherent distinctiveness when applied to a floor and wall tile cement adhesive even though the element BOND is descriptive when applied to such wares in that the word "bond" is defined in *Merriam-Webster's Collegiate Dictionary* as, *inter alia*, an adhesive, cementing material, or fusible ingredient that combines, unites, or strengthens. The opponent's registered trade-mark ELASTOCOLOR possesses relatively little inherent distinctiveness in that it suggests an elastomer coloured coating and therefore is highly suggestive when applied to the wares covered in registration No. 457,555, identified above. On the other hand, the opponent's registered trade-marks KERABOND and EPO/BOND as applied to the wares covered in registration Nos. 236,702 and 404,426 possess some measure of inherent distinctiveness when considered in their entireties despite the descriptive significance of the element BOND which form components of each of these marks.

As the parties did not submit any evidence of use of their trade-marks, neither the extent to which the trade-marks at issue have become known [para.6(5)(a)] nor the length of time the marks have been in use [para.6(5)(b)] favours either the applicant or the opponent.

Considering next the nature of the wares of the parties [para.6(5)(c)] and the nature of the trade associated with the trade-marks at issue [para.6(5)(d)], it is the applicant's statement of wares and the statements of wares covered in the opponent's registrations identified above which must be considered in assessing the likelihood of confusion in relation to the paragraph 12(1)(d) ground [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R.(3d) 3, at pp.10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon*, 12 C.P.R.(3d) 110, at p.112 (F.C.A.); and *Miss Universe, Inc. v. Dale Bohna*, 58 C.P.R.(3d) 38,1 at pp.390-392 (F.C.A.)]. Furthermore, in assessing the likelihood of confusion between trade-marks in respect of a paragraph 12(1)(d) ground, the Registrar must have regard to the channels of trade which would normally be considered as being associated with the wares set forth in the applicant's application and the opponent's registrations.

In the present case, the applicant's "Chemical modified Portland powder cement premixed mortar, namely water mixed multi purpose floor and wall tile cement adhesive" differs from the wares covered in the opponent's registrations although the channels of trade associated with the applicant's tile cement adhesive could potentially overlap the channels of trade associated with the opponent's "cement glue" (regn. No. 236,702), its "liant à l'époxy pour le béton" (regn. No. 404,426), and its "Revêtement élastomère polymérique pour la protection et décoration des surfaces de béton et maçonnerie" (regn. No. 457,555).

As for the degree of resemblance between the trade-marks at issue [para.6(5)(e)], the applicant's trade-mark ELASTO-BOND bears some degree of similarity in appearance and in sounding to the opponent's registered trade-mark ELASTOCOLOR although the marks do not suggest any particular idea in common. Further, the applicant's mark bears only a minor degree of similarity in appearance and in sounding to the opponent's registered trade-marks KERABOND and EPO/BOND and bears no similarity in the ideas suggested to either of these marks.

Having regard to the foregoing and, in particular, to the limited degree of resemblance between the applicant's trade-mark ELASTO-BOND and the opponent's registered trade-marks KERABOND and EPO/BOND when these marks are considered in their entireties as a matter of immediate impression, and bearing in mind that the applicant's wares differ from the wares covered in registration Nos. 236,702 and 404,426, I find that there would be no reasonable likelihood of confusion between the applicant's trade-mark ELASTO-BOND and the opponent's registered trade-marks KERABOND and EPO/BOND. Further, there is some similarity in appearance and in sounding between the applicant's trade-mark ELASTO-BOND and the opponent's registered trade-mark ELASTOCOLOR and there might well be a potential overlap in the nature of the trade associated with the wares covered by these marks even though the wares themselves differ. On the other hand, the opponent's registered trade-mark ELASTOCOLOR is inherently weak and is therefore entitled to only a narrow ambit of protection. Consequently, I have concluded that there would be no reasonable likelihood of confusion between these marks.

As a result, and having concluded that there would be no reasonable likelihood of confusion

between the applicant's trade-mark and any of the opponent's registered trade-marks, I have rejected the opponent's paragraph 12(1)(d) ground of opposition. Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I have rejected the opponent's opposition pursuant to subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 12TH DAY OF DECEMBER, 2001.

G.W. Partington,
Hearing Officer.