

**IN THE MATTER OF AN OPPOSITION by
Protek Paint Limited to Application
No. 780701 for the Trade-mark PROTEK PRODUCTS filed
by Protek Products, a corporation of Michigan**

On April 19, 1995, Protek Products, a corporation of Michigan (the «Applicant»), filed an application to register the trade-mark PROTEK PRODUCTS (the «Mark») in association with:

« Sealing and cleaning products for paving stones, namely cleaners; sealants; rust remover; paint, tar and rubber remover for paving stones, bricks, masonries and concrete» (the «Wares»)

based on use in Canada since late March 1995, and based on proposed use in association with:

« Waterproof sealant for concrete and masonry (silicone based) and wood sealant for bitumen based and tar-based sealants for wood». (the «Proposed Use Wares»)

The Applicant disclaimed the right to the exclusive use of the words «PRODUCTS» apart from the trade-mark as a whole. The application was advertised on May 22, 1996 for opposition purposes in the *Trade-marks Journal*.

On June 5, 1996, Protek Paint Limited (the «Opponent») filed a Statement of Opposition. The Applicant served and filed on December 24, 1996 a Counter Statement in response to the Statement of Opposition, in which it denied each and every ground of opposition raised by the Opponent in its Statement of Opposition.

The Applicant filed an amended application to delete the Proposed Use Wares from its original application. Both parties filed written arguments and a hearing took place on September 2nd, 2003 during which both parties made oral representations.

The grounds of opposition have been described in the Opponent's written argument as follow and reflect the amendment to the original application:

a) The Mark applied for is not registrable in view of section 38(2)(a) of the Trade-marks Act (the «Act»), as the Mark does not comply with the requirements of section 30.

In particular:

- i. The Applicant could not have been satisfied under section 30 (i) that it was entitled to use in Canada the trade-mark applied for in association with the Wares, as the Applicant had, or should have had, knowledge as of the date that the application was filed of the Opponent's prior use in Canada of its trade-marks PROTEK and PROTEK & Design;
- ii. The Applicant could not have been satisfied under section 30(i) that it was entitled to use in Canada the Mark applied for in association with the Applicant's Wares, as the Applicant had, or should have had, knowledge as of the date that the application was filed of the Opponent's prior use in Canada of the trade-names PROTEK PAINT LIMITED, PROTEK PAINT and PROTEK PAINT & VARNISH;
- iii. The Applicant could not have been satisfied under section 30(i) that it is entitled to use in Canada the Mark applied for in association with the Applicant's Wares, as the Applicant has not used and did not intend to use the Mark, as of the date that the Application was filed;
- iv. The application does not comply with section 30(a) in that it does not contain a statement in ordinary commercial terms of the specific wares with which the Mark has been used;
- v. The application does not comply with section 30(b) in that the Applicant did not use the Mark in Canada as of the date of first use set out in the application; and
- vi. The application does not comply with section 30(e) in that it does not contain a statement that the Applicant, by itself or through a licensee, intends to use the Mark in Canada

- b) The Mark applied for is not registrable in view of section 38(2)(c) in that the Applicant is not the person entitled to registration of the Mark under section 16(1). In particular, as of the date on which the Mark was allegedly first used, and at all other material times, the Mark was confusing with, or likely to be confusing with:
- i. The Opponent's trade-marks PROTEK and PROTEK & Design, which has been previously used in Canada by the Opponent and its predecessors-in-title; and
 - ii. The Opponent's trade names PROTEK PAINT LIMITED, PROTEK PAINT and PROTEK PAINT & VARNISH, which has been previously used in Canada by the Opponent and its predecessors-in-title.
- c) The Mark applied for is not registrable in view of section 38(2)(d) as the Mark is not, and at all material times has not been and could not be, distinctive of the Wares of the Applicant. In particular:
- i. Having regard to section 2, the Mark -being confusing with, or likely to be confusing with, the Opponent's trade-marks PROTEK and PROTEK & Design and with the Opponent's trade names PROTEK PAINT LIMITED, PROTEK PAINT and PROTEK PAINT & VARNISH- is not adapted to and does not distinguish the Applicant's Wares from the wares, services and business of the Opponent; and
 - ii. Having regard to section 50, the Applicant has allowed the Mark to be used in Canada without the appropriate licence and, accordingly, the Mark should not be deemed to have been used by the Applicant and, thereby, is not distinctive of the Applicant's Wares.

The Applicant filed on December 24, 1996 a detailed Counter Statement to Opposition in which, besides denying each and every ground of opposition described above, stated that:

- a) the Mark is distinctive as it is adapted to distinguish the Wares from the wares sold by the Opponent in association with the trade-marks PROTEK and PROTEK & DESIGN , on the one hand, and under the trade names PROTEK PAINT LIMITED, PROTEK PAINT and PROTEK PAINT & VARNISH on the other hand, and is adapted to distinguish them in light of the provisions of article 6(5) of the Act.(the Applicant did explain in details, by analysing each criteria set out in article 6(5), why the Mark could not cause confusion with the Opponent cited trade-marks and trade names).

- b) «the state of the Register revealed the existence of several registrations using the words PROTEK, PROTECTOR, PROTEX, PRO-TECH, PRO TEK, and C-PROTEC, used alone or with other words, suffixes and prefixes, such as PROTEK PRODUCTS (no.780701),PROTEC 2000 (no. 747950), PROTECTOR PLUS (TMA 680337), PRO-TECH SEAL (TMA 139968), PROTEX PLUS (TMA 328890), PRO TEK UCP (TMA 286411), PROTEK (No. 816035) and PROTEK & DESIGN (No. 816036), which indicates the weak distinctive character of such registered trade-marks and, as such, these trade-marks only have limited protection, that is to say, less significant protection than in the case of a trade-mark such as KODAK or a trade-mark of one word only;»

The evidence filed by the Opponent consists of the affidavit of Randall Rogers, sworn on December 22, 1997. The Applicant filed the affidavits of Roger F. Soulliere sworn January 12, 1999 and of Dan Tasson sworn January 19, 2000 (It would appear that an error was made in the date as he was cross-examined on his affidavit in June of 1999 as detailed hereinafter). The Board advised the Applicant, by letter dated August 31, 1998, that the documentation it filed on July 21 1998 didn't

constitute proper evidence. Messrs. Soulliere and Tasson were cross-examined on June 4, 1999. Mr. Rogers filed a second affidavit dated November 24, 1999 as reply evidence. The Applicant objected to the filing of such affidavit into the record as it considered its content not proper reply evidence but additional evidence filed without leave. I shall deal with this issue when reviewing its content.

I shall now summarize the pertinent evidence filed by both parties. Mr. Rogers stated that he has been employed by the Opponent for 20 years and is now its President. As such he has personal knowledge of the Canadian sales of PROTEK and PROTEK & Design branded products dating back to at least the late 1970's. Mr. Rogers alleged that the Opponent's predecessors in title were Protek Paint & Varnish Co., which began using such business name in 1951, and Protek Paint and Varnish Ltd., which was incorporated on October 15, 1971, as per a copy of the certificate of incorporation filed as Exhibit B to his affidavit. The Opponent was incorporated on December 22, 1994 and a copy of the articles of incorporation was filed as Exhibit C to his affidavit. There is however no documentation to support the allegation that those entities constitute the predecessors-in-title of the Opponent. Therefore I shall restrict my analysis of the Opponent's evidence to its own use in Canada, since its inception, of the trade-marks PROTEK, PROTEK & Design and PROTEK PAINT & Design in and the trade names PROTEK PAINT LIMITED and PROTEK PAINT in association with paints, varnishes, stains, and sealers (the «Products»).

The Opponent operates a retail store under the trade name Protek Paint Limited in Etobicoke, Ontario that is offering for sale and selling the Products in association with the trade-marks PROTEK, PROTEK & Design and PROTEK PAINT & Design. The sales of the Products by the Opponent during 1995 and 1996 totalled \$668,700 and \$722,700 respectively. A sample of a label bearing the trade-mark PROTEK PAINT & Design was filed as Exhibit E2 to Mr. Rogers' affidavit. There is evidence (Exhibit D to Rogers' affidavit) of use of the corporate name PROTEK PAINT LIMITED as it appears on invoices issued by the Opponent. Since 1995, the Opponent has spent from \$5,000 to \$10,000 on advertising. A representative sample of printed advertising was filed as Exhibit H to Rogers' affidavit. The Opponent has had a 1-888-7PROTEK telephone number as well as an email address store@protekpaint.com.

Mr. Soulliere is the president of the Applicant since May 1991. The Applicant was incorporated under the laws of Michigan and is located in Utica, Michigan as per the certificate of incorporation filed as Exhibit A to Soulliere's affidavit. He filed as Exhibit B a sample of a label bearing the Mark and alleged that the Mark was used in Canada in association with the Wares since March 1995. Filed as Exhibit E to Soulliere's affidavit are invoices issued by the Applicant to Canadian customers. There is no evidence as to the terms and conditions of each of these sales and as such, since the Applicant's place of business is located in the United States, it is impossible to conclude that these sales occurred in Canada. Moreover the earliest invoice is dated April 24, 1995. Mr. Soulliere filed as Exhibit F to his affidavit invoices from Link Customs Services Ltd. to establish that the Wares bearing the Mark were imported in Canada. I shall comment further on these documents as they are an important piece of evidence filed by the Applicant to substantiate its use of the Mark in Canada as from the claimed date of first use mentioned in its application to register the Mark. The Opponent participated in various trade shows in Canada in 1993, 1996 and 1997. There is however no documentary evidence of sales of the Wares in association with the Mark during those trade shows even though price lists were distributed.

The Opponent concluded on January 1st, 1997 an agreement entitled Trademark License Agreement with Royal Group Distributing (exhibit I to Soulliere's affidavit) by which the latter was appointed the exclusive licensee and distributor in Canada of the Wares sold in association with the Mark. Representative invoices for the years 1997 and 1998 from the Opponent to Royal Group Distributing («RGD») were annexed as Exhibit K to Soulliere's affidavit. A corporative brochure sent to customers in Canada was filed as Exhibit O to Soulliere's affidavit but there is no information as to the time period when the Opponent or RGD sent such brochure to customers in Canada. Pamphlets and postcards were filed as Exhibit P to Soulliere's affidavit, which were distributed in Canada in 1995 and 1996 in order to promote the sale of the Wares in association with the Mark.

Soulliere filed as Exhibit R to his affidavit a report done by Paint Research Associate of an analysis of a product bought at the Opponent's place of business. The Opponent objected to the filing of such report on the basis that it constitutes hearsay evidence. By not filing an affidavit sworn by the person who drafted such report, the Opponent is denied the opportunity to examine the author of such report. I agree with the Opponent's position and I shall therefore disregard such report. The

Applicant failed to prove that such document is reliable and necessary in order to be considered as proper hearsay evidence.[see *R. v. Khan*, [1990] 2 S.C.R. 531 and *R. v. Smith*[1992]S.C.R. 915].

During his cross-examination Mr Soulliere admitted that:

- (i) He was not personally familiar with sales by retailers in Canada of the Applicant's wares to an end user.
- (ii) After being confronted with the fact that the label Exhibit B to his affidavit did not contain both official languages and metric measurements requirements, he didn't know how long such label had been used or whether it was still being used in Canada.
- (iii) The evidence appended at Exhibit F to his affidavit shows that sample products entered in Canada, not products destined for sale in Canada.
- (iv) The evidence appended at Exhibit G, H, K, and L to his affidavit does not show use of the Mark in Canada.

Mr Tasson is the general manager of RGD and has held such position since January 1st, 1996. He also filed as Exhibit A to his affidavit a copy of the Trademark License Agreement effective since January 1st, 1997 and concluded with the Applicant. He filed as Exhibit B to his affidavit a copy of a label on the containers of the Wares bearing the Mark used in Canada by RGD. He stated that he is aware that the Opponent used its corporate name in Canada continuously on labels of the Wares' containers. He doesn't state however since when such use occurred. RGD's sales of the Wares bearing the Mark in Canada were \$40,000 in 1997 and \$120,000 in 1998 and filed as Exhibit C to his affidavit were representative invoices of such Canadian sales. RGD channels of distribution include driveway sealer companies, lawn care companies, landscape contractors, retail accounts such as Canadian Tire and Home Hardware, paving stone manufactures and paving stone wholesalers. RGD spent \$15,500 in 1997 and \$18,500 in 1998 in advertisement for the promotion of the sale of

the Wares in association with the Mark. He filed as Exhibit D to his affidavit a copy of an advertisement published in the May 1998 edition of the magazine called 'Canadian Living'. Another label bearing the Mark and affixed on the containers of the Wares was filed as Exhibit F to his affidavit.

He stated in paragraph 13 of his affidavit that he is not aware of any instances of confusion between the Applicant's wares bearing the Mark and the Opponent's wares bearing the trade-mark PROTEK and PROTEK AND DESIGN. He visited the Applicant's premises and purchase a product bearing a label having the following inscription: Wood-finishes-Seal-Tek. On the label Exhibit G to his affidavit appears the corporate name 'Protek Paint and Varnish Ltd.'. He filed as Exhibit H to his affidavit a publicity folder of the products sold by the Opponent, which contains the words 'Protek Paint'. He learned from the Opponent's employees that its products are mainly sold in the Toronto area and are not sold in stores such like Home depot, Canadian Tire, Réno-Depot and Rona.

He filed a Dun and Bradstreet report and for the same reasons outlined above with respect to the report of Paint Research Associate such document is inadmissible hearsay evidence. Finally the comments made in paragraph 20 of his affidavit are also inadmissible evidence as being arguments as opposed to facts [see *Cadbury Schweppes Inc. v. Najm*, 41 C.P.R. (3d) 112]

During his cross-examination Mr. Tasson admitted that:

- (i) He had no knowledge of the Applicant's Wares being sold in Canada prior to 1997.
- (ii) None of the invoices filed as Exhibit C to his affidavit showed use of the Mark.
- (iii) Sealants, like the Opponent's wares, intended for use with wood, and sealants, like the Applicant's wares, intended for use with pavers, masonries and concrete, are often sold together at the same retail outlets.
- (iv) The sample label used in Canada appears on the illustration of the container depicted on the pamphlet Exhibit E to his

affidavit while the label filed as Exhibit B to his affidavit is a label used in the United States.

The Opponent filed a second affidavit of Mr. Rogers as reply evidence. The fact that he is not aware that the documents filed as Exhibits N, O and P to Soulliere's affidavit were circulated in Ontario or elsewhere in Canada doesn't mean that they were not circulated at all in such territory. In paragraph 10 of his affidavit, he stated that he is aware of instances of confusion and described what was reported to him by another person. The Applicant objected to such evidence on the basis that it is not proper reply evidence. A similar argument was raised in *Horn Abbott v. 120192 Canada Ltd. (1987) 12 C.I.P.R. 245* and it was considered as proper reply evidence but in the present case it does constitute inadmissible hearsay evidence for the same reasons outline above with respect to the report of Paint Research Associate. The allegations contained in paragraphs 14 (a), (b), (c) and (e) do not constitute reply evidence but argumentation [see *Cadbury Schweppes Inc* supra]while the allegations contained in paragraph 14 (d) do constitute inadmissible hearsay evidence.

The material time for considering the circumstances respecting the issues of non-compliance with Section 30 of the Act is the filing date of the application (April 19, 1995)[see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475] while the issue of non-entitlement based on section 16(1) of the Act must be address as of the claimed date of first use by the applicant (March 31, 1995) [Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the opposition (June 5, 1996) [see *Andres Wines Ltd. and E&J Gallo Winery (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.)* and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A)*].

The legal burden is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of such grounds of opposition. Once this initial burden is met, the burden shifts to the Applicant who must prove that the particular grounds of opposition should not prevent 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; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293]

The Applicant deleted in its amended application the request for registration of the Proposed Use Wares. Therefore, the basis of the registration is solely on use in association with the Wares since March 1995. As such, the ground of opposition based on section 30 (e) is moot.

It must be remembered that an opponent who claims that the applicant has not complied with section 30(b) of the Act has a light evidential burden while the applicant has the legal burden to show compliance with such provision [see **John Labatt Ltd v. Molson Companies Ltd (1990) 30 C.P.R. (3d) 293 at 298**]. Moreover the opponent can rely on the evidence filed by the applicant to discharge this initial burden. [*Tune Masters c. Mr. P's Mastertune Ignition Services Ltd. (1986) 10 C.P.R. (3d) 84 (T.M.O.B.)*, *Hearst Communications Inc. c. Nesbitt Burns Corp., (2000) 7 C.P.R. (4th) 161 (T.M.O.B.)*, *Labatt Brewing Co. c. Molson Breweries, a Partnership (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) et Williams Telecommunications Corp. c. William Tell Ltd., (1999) 4 C.P.R. (4th) 107 (T.M.O.B.)*]

The Opponent has raised the following:

- (i) There is no clear evidence of use of the Mark in Canada by the Applicant as of March 31, 1995
- (ii) The unilingual label raised doubts as to its commercial use in Canada
- (iii) The Applicant's licensee lack of knowledge of the use of the Mark in Canada prior to 1997
- (iv) The documents filed as Exhibit F to Soulliere first affidavit, namely from Revenu Canada Customs, Excise and Taxation contain the mention «FOR PROTEK PRODUCTS SAMPLES ENTERING CANADA» which raise doubts as to the commercial use of these products while the other documents emanating from RGD suggest use of the mark after January 1st, 1997.

These facts are sufficient to shift the burden on the Applicant to prove that it has used the Mark in Canada in association with each and every Wares since March 1995. The evidence in the record doesn't support such contention and as such I must maintain the Opponent's ground of opposition based on section 30 (b) of the Act.

I will however analyse the grounds of opposition based on distinctiveness and section 16(1) of the Act. As for the ground of opposition based on section 50 of the Act, it is dismissed as the evidence clearly establishes the existence of a license between the Applicant and RGD as of January 1st, 1997 and as such any use of the Mark by RGD is deemed to be use of the Mark by the Applicant. Despite the well thought arguments of the Opponent's agent, the amended application does contain a statement in ordinary commercial terms of the specific wares. I shall deal with the consequence of such conclusion in my analysis of the nature of the wares and the channel of trade when determining if the Mark is likely to cause confusion with the Opponent's trade-marks and trade names.

In order to assess these grounds of opposition it is helpful to cite the relevant sections of the Act:

'2. In this Act,

distinctive", in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;

"trade-mark" means

a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured sold, leased, hired or performed by others'

16. (1) Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with wares or services is entitled, subject to section 38, to secure its registration in respect of those wares or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

(c) a trade-name that had been previously used in Canada by any other person.

In order to determine whether trade-marks are confusing, subsection 6(5) of the Act directs that the Registrar is to have regard to all of the surrounding circumstances, including:

i) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

ii) the length of time the trade-marks or trade-names have been in use;

iii) the nature of the wares, services, or business;

iv) the nature of the trade; and

v) the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

The burden of proof lies on the Applicant who must convince the Registrar that there is no likelihood of confusion between the Mark and the Opponent's trade-marks at the abovementioned relevant dates [*see Sunshine Biscuits Inc. c. Corporate Foods Ltd. (1982), 61 C.P.R.(2d) 53*].

The Federal Court of Appeal stated in the case of *Christian Dior, S.A. et Dion Neckwear Ltd [2002]3 C.F.405*:

«...the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier...

The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he need not be satisfied beyond doubt that confusion is unlikely. Should the "beyond doubt" standard be applied, applicants would, in most cases, face an unsurmountable burden because certainty in matters of likelihood of confusion is a rare commodity. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favour of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a registrar should avoid resorting to it.»

The grounds of opposition based on subsection 30(i) of the Act to the effect that the Applicant could not have been satisfied that it was entitled to use in Canada the Mark in association with the Wares is tied in with the question whether the Mark is likely to cause confusion with the Opponent trade-marks or trade name as the evidence in the record doesn't allowed me to conclude that the Applicant was aware of the Opponent's trade-marks or trade name.[see *Sapodilla Co. V. Bristol-Myers Co. (1974), 15 C.P.R. (2d) 152* at page 155]

I shall apply these principles to the evidence summarized hereinabove.

i. inherent distinctiveness

The Applicant in its written argument has argued that the trade-mark PROTEK lacks inherent distinctiveness as it is a word commonly used to suggest the nature or quality of the wares in association with which it is used. The Applicant refers to the state of the Register in Canada and in the United States which would reveals the existence of nineteen (19) trade-marks on the Register and more than thirty (30) pending, abandoned or registered trade-marks on the United States Patent and

Trademark Office to support such contention. There is however no evidence in the record of the existence of these trade-marks and more important that they are used in Canada in association with wares of the same general class of the wares of the Opponent's wares.

The Opponent's mark is a coined word that might be considered suggestive of the characteristics of the wares sold in association with it but it doesn't mean that it lacks inherent distinctiveness as suggested by the Applicant. The sales figures of the Applicant's wares in association with the trade-mark PROTEK leads me to conclude that such trade-mark has acquired some distinctiveness. Moreover the trade-mark PROTEK and Design is inherently distinctive because of the design feature consisting of a stylized PROTEK with the drawing of a paint brush.

ii) length of time of use of the mark

The Opponent has established use of the trade-marks PROTEK, PROTEK and Design and of the trade names PROTEK PAINT LIMITED and PROTEK PAINT since at least December 22, 1994 while the evidence on record shows at best an earliest date of first use of the Mark by the Applicant of January 1st, 1997.

iii) nature of the wares

The Applicant tried to distinguish the nature of the wares of the parties by arguing the difference between its sealants, which is for use on paving stones, bricks, masonries, and concrete, while the Opponent's sealants are used on wood. I must compare the general class of the wares described in the Applicant's application and not focus on some of the wares. The application does refer to the use of the Mark in association with sealants without any restriction. Moreover the Opponent's licensee admitted during cross-examination that the Wares could be sold in hardware stores and retail stores such as Canadian Tire and Home Hardware, as well as the Opponent's wares sold in association with the trade-marks PROTEK and PROTEK and Design. In any event, wares need not be identical in order to be a reasonable likelihood of confusion between trade-marks. Rather, the wares need only be such that the average consumer of average intelligence would be likely to believe that the wares emanate from the same source. In the present matter, I consider the wares

associated with the trade-marks at issue to be overlapping in that they all belong to the same general class of wares.

iv) nature of the trade

As stated by Teitelbaum J, in *Everex Systems Inc. v. Everdata Computer Inc.*, (1992) 44 C.P.R. (3d) 175 at 182:

Considering the nature of trade, it is not necessary that one prove that the wares in question are, or have, in the past, been sold in the same places. Rather, one may properly look at whether the wares could eventually be sold in the same places. As stated by Mr. Justice Dubé in *Cartier Inc. v. Cartier Optical Ltd./Lunettes Cartier Ltée* (1988), [20 C.P.R. \(3d\) 68](#) (F.C.T.D.) at 74:

However, so as to establish the likelihood of confusion, it is not necessary to prove that the wares are sold in the same places, provided they are of the same general class, could eventually be sold in the same places, and the parties are entitled to do so: [see *Eminence, S.A v. Registrar of Trade Marks* (1977), [39 C.P.R. \(2d\) 40.](#)]

v) degree of resemblance

The addition of the word PRODUCTS to the word PROTEK is not sufficient to enable a consumer with an imperfect recollection of the trade-marks PROTEK and PROTEK and Design and the trade names PROTEK PAINT LIMITED and PROTEK PAINT to distinguish the wares sold in association with such marks from the Wares sold in association with the trade-mark PROTEK PRODUCTS. Moreover the first portion of a trade-mark should be treated as being of particular importance. [See *Molson Companies Ltd. v. John Labatt Ltd.* (1990), 28 C.P.R. (3d) 457 at 461]

Having analysed the relevant evidence in the context of the surrounding circumstances, I come to the conclusion that the Mark is confusing with the Opponent's trade-marks PROTEK, PROTEK and Design and the trade names PROTEK PAINT LIMITED and PROTEK PAINT when used in

association with the Wares. As such I also maintain the grounds of opposition based on distinctiveness and subsection 16(1) of the Act.

Accordingly, having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I refuse the Applicant's amended application to register the Mark pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 15 DAY OF SEPTEMBER 2003.

Jean Carrière
Hearing Officer
Trade-marks Opposition Board