

**IN THE MATTER OF OPPOSITIONS
by Simpson Strong-Tie Company, Inc. to
applications Nos. 1,186,835; 1,205,986 and
1,226,913 for the trade-marks Green Post Holder,
Greyish Green Post Holder and Greyish Green
Threaded Rod Post Holder filed by Peak Innovations Inc.**

On August 18, 2003, the applicant, Peak Innovations Inc., filed an application to register the trade-mark Green Post Holder (shown below) for “post supports, namely post holders” based on use in Canada since June 1, 2003. The application was advertised for opposition purposes on March 2, 2005. The mark as advertised is described as follows:

The mark consists of the colour green as applied to the whole of the visible surface of the particular object shown in the drawing.

The drawing is lined for the colour green.



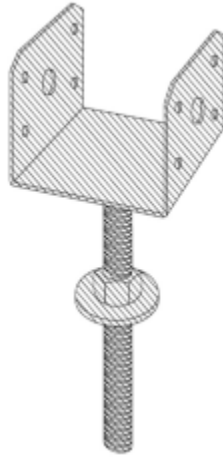
On February 11, 2004, the applicant filed an application for the trade-mark Greyish Green Post Holder (shown below) for “post supports, namely post holders” based on use in Canada since June 1, 2003. The application was advertised for opposition purposes on May

26, 2004. The mark as advertised is described as follows:

The mark consists of the colour greyish green (PANTONE* 5635C) as applied to the whole of the visible surface of the particular object shown in the drawing. The drawing is lined for the colour greyish green. *PANTONE is a registered trade-mark.


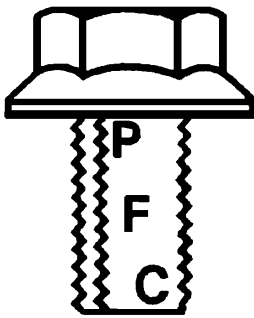



On August 16, 2004, the applicant filed an application for the trade-mark Greyish Green Bolt Threaded Rod Post Holder (shown below) for “post supports, namely threaded rod post holders” based on use in Canada since April 28, 2004. The application was advertised for opposition purposes on July 27, 2005. The mark as advertised is described in the same terms as the third application.



The opponent, Simpson Strong-Tie Company, Inc., filed essentially identical statements of opposition on August 2, 2005 respecting the first application, on October 26, 2004 respecting the second application and on September 27, 2005 respecting the third application, copies of which were forwarded to the applicant on October 4, 2005; November 9, 2004 and November 1, 2005, respectively. The first ground of opposition in each case is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the following registered trade-marks:

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>
382,999		metallic fence posts

		
245,786		industrial and commercial fasteners of all kinds, namely bolts, nuts, screws, rivets, pins, cotter pins
382,998 (the opponent misidentified the number as 362,998 in one of the oppositions)		metallic fence posts

The second ground of opposition in each case is that the applicant is not the person entitled to registration pursuant to Sections 16(1)(a) and 16(1)(b) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with

unspecified trade-marks previously used in Canada by the opponent and unidentified third parties and with the trade-mark TECHNO METAL POST & Design (shown below) for which an application (No. 1,218,092) had previously been filed in Canada.



The third ground of opposition is that the applicant's application does not conform to the requirements of Section 30(i) of the Act because the applicant was aware or ought to have been aware of the opponent's use and the use by others of a similar product. The fourth ground of opposition is that the applied for trade-mark is not distinctive in view of the facts alleged in support of the first two grounds.

The fifth ground of opposition reads as follows:

The Offending Mark is not the proper subject matter for a trade-mark within the meaning of the Act contrary to Section 30(b) and Sections 2 and 4, in that the Offending Mark as described and shown in the application is not capable of being a trade-mark as defined in Section 2 of the Act, nor is it capable of being distinctive of the Applicant. As well, the Offending Mark of the Applicant has not been used by the Applicant as a trade-mark within the meaning of Section 4 of the Act, and the colour and shaping of the Offending Mark is functional and utilitarian and the granting of a registration would unreasonably limit the development of the industry of the Applicant and Opponent contrary to Section 13 of the Act.

The sixth ground of opposition is that the applied for trade-mark is not registrable pursuant to Sections 10 and 12(1)(e) of the Act because it is a mark which had by ordinary and 'bona fide' commercial usage become recognized in Canada as designating the kind and

quality of the applied for wares. The seventh ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because, being purely or primarily functional, it is clearly descriptive of the character or quality of the applied for wares. The eighth ground is that the applicant's application does not conform to the requirements of Section 30(b) of the Act because the applicant did not use the applied for trade-mark in Canada since the date claimed.

The applicant filed and served a counter statement in each case essentially denying the various grounds of opposition. As its evidence in each case, the opponent submitted an affidavit of Elenita Anastacio, a trade-mark searcher. The applicant chose not to submit evidence. Only the applicant filed a written argument in each case but an oral hearing was held on November 19, 2007 at which both parties were represented.

At a late stage in the proceedings, the opponent requested leave to amend the statement of opposition to include a ground specifically based on non-conformance to the requirements of Section 30(h) of the Act. That request was refused in each opposition by a ruling dated September 25, 2007.

THE OPPONENT'S EVIDENCE

In her affidavit, Ms. Anastacio states that she conducted a search in the CD NameSearch trade-marks database to obtain full particulars of four registrations, the first three being the ones relied on in the opponent's first ground of opposition in each case and

the fourth having issued from the application relied on in the second ground. Exhibit A to her affidavit comprises the results of her search. Ms. Anastacio also states that she conducted an Internet search for the applicant's design mark and that she found no use of that design. Ms. Anastacio did not provide the parameters of her search or any other details about it except in her affidavit filed in the first opposition where she stated that her search included "the Applicant's website."

THE APPLICANT'S EVIDENCE

As previously noted, the applicant did not file any evidence.

THE GROUNDS OF OPPOSITION

As for the first ground of opposition in each case, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show on a balance of probabilities no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

In view of the decision in Quaker Oats Co. of Canada Ltd. v. Menu Foods Ltd. (1986),

11 C.P.R.(3d) 410 at 411 (T.M.O.B.), I have checked the trade-marks register respecting the three registrations relied on by the opponent. Registrations Nos. 382,998 and 382,999 were both expunged on November 23, 2006 and can therefore no longer form the basis of a ground of non-registrability based on Section 12(1)(d) of the Act. As for registration No. 245,786, it is still current and the first ground in each case therefore remains to be decided on the issue of confusion between that mark and the applicant's mark.

As for Section 6(5)(a) of the Act, the registered mark PFC & Design is comprised of initials and a representation of one of the wares. Thus, although the registered mark is inherently distinctive, it is not an inherently strong mark. The applicant's mark comprises a specific color of a particular object and is therefore an inherently weak mark. Based on the evidence of record, neither mark has acquired any reputation in Canada.

Given the absence of evidence on point, the length of time the trade-marks have been in use favors neither mark. As for Sections 6(5)(c) and 6(5)(d) of the Act, it is the applicant's statement of wares in its applications and the statement of wares appearing in registration No. 245,786 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 rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the

actual trades of the trade-mark owners is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

The wares at issue differ, the applicant's wares being post supports and the registrant's wares being various kinds of industrial and commercial fasteners. However, it appears that the registrant's fasteners may be the type of items that could be used in conjunction with the applicant's post supports. On the other hand, the applicant's wares appear to be for residential use whereas the registrant's are specifically described as being for industrial and commercial use. Nevertheless, it may well be that the wares of both parties could be sold through similar outlets such that there may be some overlap in the respective trades.

As for Section 6(5)(e) of the Act, I find there to be no resemblance between the marks when sounded. Visually, there is little resemblance except to the limited extent that both marks comprise items used in construction. Likewise, there is a limited degree of resemblance in the ideas suggested.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the inherent weakness of the marks, the absence of any acquired reputation for the registered mark and the limited degree of resemblance, I find that none of the applicant's marks is confusing with the registered mark PFC & Design. Thus, the first

ground of opposition in each case is unsuccessful.

The second ground in each case fails to raise a proper ground of opposition. The opponent is precluded from relying on third party uses of allegedly confusing marks and it has failed to identify any of its own marks that it has previously used in Canada. As for application No. 1,218,092, it cannot form the basis of a ground of opposition pursuant to Section 16(1)(b) of the Act because it was not filed prior to the applicant's claimed date of first use in each case. Thus, the second ground of opposition is also unsuccessful.

The third ground in each case also does not raise a proper ground of opposition. The mere fact that the applicant may have been aware of a "similar product" does not preclude it from truthfully making the statement required by Section 30(i) of the Act. Thus, the third ground of opposition is also unsuccessful.

As for the fourth ground of opposition in each proceeding, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - August 2, 2005 in the first case, October 26, 2004 in the second case and September 27, 2005 in the third case): see Re 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) 412 at 424 (F.C.A.).

Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The opponent's fourth ground in each case is essentially based on allegations of confusion with the three registered marks relied on and the applied for mark TECHNO METAL POST & Design. However, there is no evidence of any use or reputation for any of those marks. Thus, the fourth ground of opposition is also unsuccessful.

Although worded in a somewhat vague fashion, it appears that the fifth ground of opposition in each case is that the applied for mark is not a proper trade-mark since it is merely functional and utilitarian. However, color applied to the whole of the visible surface of an object can function as a trade-mark: see Smith, Kline & French v. Registrar of Trade Marks [1987] 2 F.C. 633 (F.C.T.D.). Since the opponent has failed to submit any evidence establishing the solely or primarily functional nature of the applicant's mark, the fifth ground of opposition is also unsuccessful.

At the oral hearing, the opponent's agent submitted that the fifth ground is that the applicant's applied for mark is not capable of being a trade-mark because it is not distinctive. In this regard, he contended that it is not possible to determine what the applicant's trade-mark is from reading the description and viewing the drawing.

The opponent's agent submitted that the shape of the trade-mark claimed is not properly defined by the description and the drawing of the mark is deficient in that it does not provide an adequate view of the entire surface of the object shown. The opponent's agent further submitted that there is no indication in any of the three applications as to the size or specific physical dimensions of the object shown in the drawing and the drawing does not illustrate all facets of that object. However, the statement of opposition in each case does not include a specific pleading to that effect or a ground based on non-conformance to the requirements of Section 30(h) of the Act. Thus, I am precluded from considering any such ground in these proceedings. In any event, a reasonable interpretation of the drawing in each case suggests that the object shown is symmetrical such that the single view provided is adequate. Furthermore, there is no requirement for the applicant to restrict the mark claimed to a specific size. So long as the wares are adequately described and defined, color alone can function as a trade-mark as in the case, for example, of a single color for a sheet of fiber glass insulation.

The opponent's agent relied on the reasons in Smith, Kline & French wherein Mr. Justice Strayer stated as follows at paragraph 7 of the reported decision:

.....the trade mark whose registration as sought is a particular colour of green applied to a particular size and shape of tablet.

However, it appears that Mr. Justice Strayer's statement was simply a reflection of the description that the applicant adopted for its mark (see paragraph 4 of the reported decision) and not a pronouncement on size as a necessary element of the mark. Alternatively, it may be that Mr. Justice Strayer was implicitly restricting the trade-mark

claimed in that case to the dimensions of the specimen tablet on file. It has since been held that a specimen cannot form part of the trade-mark: see Calumet Manufacturing Ltd. v. Mennen Canada Inc. (1991), 40 C.P.R.(3d) 76 at 87 (F.C.T.D.). All that is required in such cases is to define the color and shape of the trade-mark claimed in relation to the applied for wares: see Apotex Inc. v. Searle Canada Inc. (2000), 6 C.P.R.(4th) 26 (F.C.T.D.).

In previous related cases, the opponent also contended that its fifth ground included the assertion that the applicant's mark is not registrable because it is, in fact, a distinguishing guise. However, it is not apparent that the opponent raised a ground of opposition based on Sections 13 and 32 of the Act. If it did, such a ground would be unsuccessful, in any event, since the Smith, Kline & French decision supports the position that the applicant's mark qualifies as an ordinary trade-mark. (For an alternate interpretation of Smith, Kline & French, see the opposition decision in Novopharm Limited v. Hoffman-La Roche Limited (2006), 55 C.P.R.(4th) 226 at 235.)

Notwithstanding the foregoing, I sympathize with the opponent's position. Given the inherently weak nature of a trade-mark consisting solely of a color applied to the entire visible surface of an object, either such a mark should be considered to be a shaping of the wares and thus a distinguishing guise or the Act should have a provision akin to Section 12(2) or 13(1) to ensure that distinctiveness in fact is established before granting a registration. Furthermore, as discussed in the Novopharm Limited decision, it would be

preferable to require greater specificity regarding a trade-mark consisting of color in order to restrict the exclusive rights to be granted by any eventual registration. In the case of the applicant's second and third applications, the reference to PANTONE 5635C may suffice.

As for the sixth ground of opposition in each case, the opponent has failed to provide any evidence to support its contention that the applied for mark has become recognized in Canada as designating the kind and quality of the applied for wares. Since the opponent failed to meet its evidential burden, the sixth ground is also unsuccessful.

As for the seventh ground of opposition in each proceeding, in view of the decision in Fiesta Barbeques Limited v. General Housewares Corporation (2003), 28 C.P.R.(4th) 254 (F.C.T.D.) which relies on the decision of the Supreme Court of Canada in Lightning Fastener Co. v. Canadian Goodrich Co. [1932] S.C.R. 189, it appears that the material time for assessing a ground based on Section 12(1)(b) of the Act is, and always was, the filing date of the application. Furthermore, the issue under Section 12(1)(b) of the Act is to be determined from the point of view of an everyday user of the wares. Finally, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

It appears that the opponent's position is that the applied for mark consists of the shape and color of the applied for wares and is therefore purely or primarily functional. However, as previously noted, there is no evidence of record establishing the purely or primarily functional nature of the applied for color in the context of the wares. Furthermore, in view of the Smith, Kline & French decision, it is apparent that color applied to the entire visible surface of an object does qualify as an ordinary trade-mark. Thus, the seventh ground is also unsuccessful.

As for the opponent's eighth ground in each opposition, the onus or legal burden is on the applicant to show that its application conforms to the requirements of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-conformance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent's evidential burden can be met by reference to the applicant's own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230

(F.C.T.D.).

At the oral hearing, the opponent's agent relied on the decision in See You In - Canadian Athletes Fund Corporation v. Canadian Olympic Committee (2007), 57 C.P.R.(4th) 287 (F.C.T.D.) in support of his contention that there should be no evidential burden on the opponent respecting this ground. That decision dealt with the requirements in respect of a request to publish an official mark pursuant to Section 9(1)(n)(iii) of the Act. At page 298 of the reported decision, Mr. Justice Phelan states as follows:

“...if a requestor [sic] for an official mark is required to establish that it is a ‘public authority’ it must also establish its ‘adoption and use’.”

The opponent's agent contended that a similar approach should apply to a trade-mark applicant claiming use of its mark in Canada and that all an opponent need do in an opposition proceeding is raise the issue of non-conformance to Section 30(b) of the Act. Although the opponent's argument is not without merit, I am unaware of any authority or any provision in the Act that requires an applicant to support its claim to use of its mark during the examination process or during an opposition without at least some evidence of record bringing that claim into doubt.

The opponent's agent submitted that an applicant's claim in its application to have used its mark is simply an unsworn statement which should be supported with actual evidence of use. However, in the case of a proposed use application, once it is allowed, all

that is required from the applicant is an unsworn declaration that use of the mark has commenced (see Section 40(2) of the Act). It would be unfair to impose a heavier burden on an applicant claiming use than on one whose application is based on proposed use. Similarly, an applicant who bases its application on foreign use and registration is, in the usual case, only required to provide a certified copy of the foreign registration and not evidence of use in a foreign jurisdiction (see Section 31(1) of the Act). It may be that Mr. Justice Phelan considered that a different approach should apply to a request to publish an official mark given that there is no opportunity for others to challenge such a request by way of an opposition.

The opponent relied on Ms. Anastacio's Internet search for the applicant's design mark in each case. As noted, Ms. Anastacio provided no details about the parameters of her search except in her affidavit in the first opposition where she stated that her search included the applicant's website. However, she failed to indicate the address for that site and she did not provide any details about that aspect of her search. Furthermore, her search in each case was conducted well after the material time (i.e. - the filing date of the application). Thus, the opponent has failed to satisfy its evidential burden and the eighth ground in each case is also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's oppositions. Similar decisions have issued on related oppositions between the parties, the first such decision having issued on June 21,

2007 respecting applications Nos. 1,187,491 and 1,205,529.

DATED AT GATINEAU, QUEBEC, THIS 26th DAY OF NOVEMBER, 2007.

**David J. Martin,
Member,
Trade Marks Opposition Board.**