



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

**Citation: 2012 TMOB 82**  
**Date of Decision: 2012-04-27**

**IN THE MATTER OF AN OPPOSITION  
by Donald Durham Company to  
application No 1,405,289 for the trade-  
mark ROCKHARD filed by Calera  
Corporation**

File Record

[1] On July 29, 2008 Calera Corporation (the Applicant) filed application No 1,405,289 to register the trade-mark ROCKHARD (the Mark) based on proposed use in Canada. Subsequent to an office action the Applicant filed a revised application which covers the following wares:

Non-metallic construction materials, namely mineral-based cementitious materials, namely, portland, hydraulic, white, masonry, plastic, stucco, and oil well cement, other mineral-based cementitious materials and pozzolanic materials, namely, blast furnace slag, coal clinker and fly ash; cement mixes and patches, concrete, mortar, stone, aggregate, sand, mosaic, tiles, lime, plaster, gypsum, gravel, brick, roofing tiles, floor tiles, masonry units, segmental retaining wall systems, asphalt, felt paper, building materials made from concrete, namely, blocks, bricks, stones, walls, conduits, ducts, pavers, posts, pedestals, beams, partitions, barriers, pipes, modules, panels, columns, monuments, containers, curbs, bases, slabs, fences, beams, planks, boxes and basins (the Wares).

[2] The Applicant claims a priority date of January 29, 2008 based on an application filed in the United States of America (USA) on that date under No 77/383,687 for the

registration of the same or substantially the same trade-mark for use in association with the same kind of wares.

[3] The application was advertised on June 10, 2009 in the *Trade-marks Journal* for opposition purposes. Donald Durham Company (the Opponent) filed a statement of opposition on November 10, 2009 which was forwarded by the Registrar on December 22, 2009 to the Applicant.

[4] The Applicant denied all grounds of opposition in a counter statement filed on February 22, 2010.

[5] The Opponent filed as its evidence a certificate of authenticity of registration No TMA537,701 for the trade-mark ROCK HARD and the affidavit of Ronald D. Lindhart while the Opponent filed the affidavit of Lindsay E. Lanthier.

[6] Only the Opponent filed a written argument. Neither party requested a hearing.

#### The Grounds of Opposition

[7] The grounds of opposition pleaded by the Opponent can be summarized as follow:

1. The Mark is not registrable pursuant to section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as it is confusing with the Opponent's registered trade-mark ROCK HARD, registration No TMA537,701;
2. The Applicant is not entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act, as at the filing date of the application and at the priority date claimed by the Applicant, the Mark was confusing with the Opponent's trade-mark ROCK HARD which has been previously used in Canada by the Opponent or its predecessors in title in association with putty;
3. Pursuant to section 38(2)(d), the Applicant's Mark is not distinctive, nor is it adapted to distinguish the Wares of the Applicant in Canada from the wares "putty" of the Opponent previously and continuously sold in Canada in association with its aforesaid trade-mark ROCK HARD, because it is confusing with the Opponent's aforesaid trade-mark.

### Legal Onus and Burden of Proof in Trade-marks Opposition Proceedings

[8] The legal onus is upon the Applicant to show that the 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 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* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

### Registrability of the Mark under Section 12(1)(d) of the Act

[9] In order to meet its initial burden under this ground of opposition, the Opponent needs to establish the existence of the registration cited under this ground of opposition. As stated above the Opponent has filed a certified copy of registration No TMA 537,701 covering putty. I checked the register and such registration is extant [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats Ltée v Manu Foods Ltd*, 11 CPR (3d) 410].

[10] The Opponent has thus met its initial burden of proof. Consequently the Applicant has the burden to prove, on a balance of probabilities, that the use of the Mark in association with the Wares is not likely to cause confusion with the Opponent's registered trade-mark ROCK HARD.

[11] The relevant date is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd.* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[12] The test to determine this issue is set out in section 6(2) of the Act. I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks 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 in appearance, or sound or in the ideas suggested by them.

[13] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight. In its recent judgment in *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27 the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks. In this case the marks are virtually identical as the only difference is the absence of a space in the Mark between “rock” and “hard”. There is no evidence of use of the Mark in the file. The Applicant’s evidence, which I will comment later on, is limited to excerpts of the register included in Mr. Lanthier’s affidavit without any analysis provided nor the parameters used to obtain those results.

[14] Under these circumstances the only way the Applicant can be successful is by proving that there is no likelihood of confusion between the parties’ respective marks in view of the difference in the nature of the parties’ wares and their channels of trade.

[15] Mr. Lidhart has been the Opponent’s President since 1998. From 1994-1998, he was the Vice President and from 1978 to 1994 he was the Opponent’s Plant Manager.

[16] He states that the Opponent, located in Des Moines, Iowa, USA, was incorporated in 1924. The Opponent’s only product is a putty sold in association with the trade-mark ROCK HARD in the United States since 1932 and in Canada since at least as early as 1955. He states that the putty in association with which the Opponent uses the trade-mark ROCK HARD is a gypsum-based powder that becomes very hard when mixed with water. It is typically used to fill holes and cracks in wood, plaster, furniture, stone and concrete. Typical end users of the Opponent’s ROCK HARD putty in Canada include painters, decorators, woodworkers, electricians, carpenters, cabinet makers, plumbers, do-it-yourselfers, artists and hobbyists (End Users).

[17] Mr. Lindhart states that End Users in Canada purchase the Opponent’s ROCK HARD putty at independent hardware stores, lumber supply dealers and paint stores and at national chains such as Rona and Home Hardware (the Retailers). He explains that

Retailers purchase the Opponent's HARD ROCK putty from distributors who in turn purchase ROCK HARD putty from the Opponent. He has listed some of such distributors and has filed samples of invoices to evidence the sales by the Opponent of its product in Canada, the oldest one going back to September 6, 1990.

[18] Mr. Lindhart has provided the annual sales figures in Canada from 2000 to 2009 inclusive as well as the sales figures for 2010, known at the date of execution of his affidavit (June 16, 2010). He has filed reproductions of the 1-pound and 4-pound cans on which appears the Opponent's trade-mark HARD ROCK appears and has been sold in Canada. He filed examples of advertisements for the Opponent's HARD ROCK putty that appeared in magazines that circulated in Canada. He provides the circulation figures of those magazines but this constitutes hearsay evidence. Since I cannot take judicial notice that the magazines cited ever circulated in Canada, I have no evidence that those ads were viewed by Canadians.

[19] From this evidence I conclude that there is clearly an overlap between the Wares and the Opponent's putty. As I do not have any evidence from the Applicant on the nature of the channels of trade to be used by it, I have to assume from the nature of the Wares that they would be sold, through comparable Retailers, to End Users alike. Consequently not only the Mark is virtually identical to the Opponent's trade-mark HARD ROCK, but the nature of the parties' wares and their channels of trade are also similar.

[20] Unfortunately without a written argument or a hearing, the Applicant has not provided an analysis of the content of Mr. Lindsay's affidavit. There are 39 citations in exhibit A to his affidavit. It is in the best interest of a party supplying this type of evidence to make its own analysis of the results in order to present a sound argument in its favour. I looked at the citations and it does appear that the Applicant was trying to show that there are registrations or applications for trade-marks having as a component the words or elements "rock", "roc" or "hard". It is interesting to note that the list provided by Mr. Lindsay includes the Applicant's application but not the Opponent's registration. Moreover besides the Applicant's present application none of the citations

included in the Lindsay affidavit covers a trade-mark that is phonetically equivalent or identical to the Opponent's trade-mark ROCK HARD. Such evidence could not support the argument that consumers have become accustomed to the common use of trade-marks composed of the terms "rock" and "hard" in association with products used in connection with building construction and/or repair. Under these circumstances I do not see how this evidence could be of any help to the Applicant.

[21] Consequently, I conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that the Mark would not likely cause confusion with the Opponent's registered trade-mark ROCK HARD. The Mark is identical to the Opponent's registered trade-mark ROCK HARD. The parties' wares belong to the same category, namely building or construction materials, and would be sold through the same channels of trade.

[22] The first ground of opposition is maintained.

Entitlement under Section 16(3)(a)

[23] Under this ground of opposition the relevant date is the filing date of the application (July 29, 2008) [see section 16(3) of the Act]. The Opponent has discharged its initial burden by showing prior use of its ROCK HARD trade-mark in association with putty in Canada prior to the relevant date and that it had not abandoned such use at the advertisement date [see section 16(5) of the Act]. I refer to the summary of the Opponent's evidence described under the previous ground of opposition.

[24] This other ground of opposition is also based on the likelihood of confusion between the Mark and the Opponent's trade-mark ROCK HARD. The difference between the registrability ground of opposition based on section 12(1)(d) on one hand and entitlement under section 16(3)(a) of the Act is the earlier relevant date associated with the entitlement ground of opposition.

[25] The same conclusions reached under registrability would apply as well under this ground of opposition as the earlier relevant date would not have any favourable influence

for the Applicant in the analysis of the various factors listed in section 6(5) of the Act. Consequently I also maintain the second ground of opposition.

Distinctiveness

[26] Having ruled in favour of the Opponent on two separate grounds of opposition, it is not necessary to analyze this last ground of opposition.

Disposition

[27] Having been delegated authority by the Registrar of Trade-marks by virtue of section 63(3) of the Act, I refuse, pursuant to section 38(8) of the Act, the application for the registration of the Mark.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office