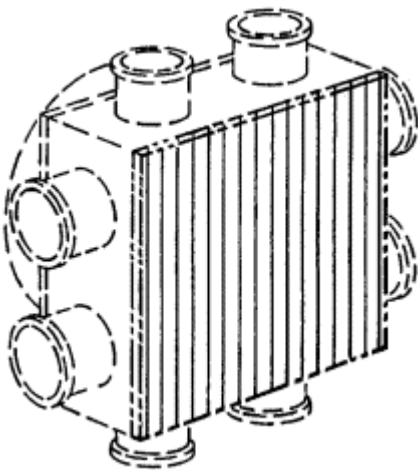


**IN THE MATTER OF AN OPPOSITION by The
Lamson & Sessions Co. to application No.
1,094,283 for the trade-mark Junction Box Colour
Plate (red) in the name of Royal Group, Inc.**

On February 28, 2001, Royal Group Technologies Limited d.b.a. Royal Pipe Company filed an application to register the trade-mark Junction Box Colour Plate (red) [the “Mark”]. The Mark is shown in the drawing below.



The trade-mark consists of the colour red applied to a face plate of a junction box. The drawing is lined for the colour red.

The application is based upon proposed use of the Mark in Canada in association with electrical junction boxes.

The application is currently in the name of Royal Group, Inc. and the term “Applicant” will be used to refer to both Royal Group Technologies Limited d.b.a. Royal Pipe Company and Royal Group, Inc.

The application was advertised for opposition purposes in the Trade-marks Journal of January 21, 2004. On June 14, 2004, The Lamson & Sessions Co. [the “Opponent”] filed a statement of opposition. The grounds of opposition are summarized below:

1. The Applicant's Mark is not registrable pursuant to s. 12(1)(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the "Act"] because it is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used because it clearly describes or deceptively misdescribes that the electrical junction boxes in association with which it is proposed to be used are for use in association with fire alarm related applications.

2. The Mark is not registrable under s. 12(1)(e) of the Act because the Mark is a mark the adoption of which is prohibited by s. 10 of the Act. The colour red used in association with electrical junction boxes constitutes a mark (the "Red Mark") which has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind of electrical junction box in association with which it is used. In particular, the Red Mark is recognized in Canada as designating that the electrical junction boxes in association with which it is used are of a kind which is appropriate for fire alarm related applications. The opposed mark either consists of the Red Mark or so nearly resembles the Red Mark as to be likely to be mistaken therefor.

3. The Applicant is not the person entitled to registration of the Mark under s. 16(3) of the Act because, at the date of filing of the application, the Mark was confusing with a trade-mark consisting of the colour red as applied to electrical junction boxes which had been previously used in Canada or made known in Canada by another person or persons.

4. The Applicant's Mark is not distinctive because it does not actually distinguish and is not adapted to distinguish the Applicant's wares from the wares and services of others because it is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used, because it is a mark the adoption of which is prohibited by s. 10 of the Act and/or because it is confusing with a mark previously used in Canada or made known in Canada by another person or persons.

The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

In support of its opposition, the Opponent filed the affidavit of Steven Randall Whaley. The Applicant obtained an order for the cross-examination of Mr. Whaley and a copy of the transcript of the cross-examination has been filed.

The Applicant elected to not file any evidence.

Each party filed a written argument.

The Applicant originally requested an oral hearing, but subsequently withdrew its request.

Onus and Material Dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is 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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

The material dates that apply to the grounds of opposition are as follows:

- s. 12(1)(b) - the date of filing of the application [see *Havana Club Holdings S. A. v. Bacardi & Company Limited* (2004), 35 C.P.R. (4th) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)];
- s. 12(1)(e) - the date of my decision [see *Canadian Olympic Association v. Allied Corporation* (1989), 28 C.P.R. (3d) 161 (F.C.A.) and *Canadian Olympic Association v. Olympus Optical Company Limited* (1991), 38 C.P.R. (3d) 1 (F.C.A.)];
- s. 16(3) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Summary of Evidence

Whaley Affidavit

Mr. Whaley has been the Canadian/International Sales Manager of the Carlon division of the Opponent since 1996. The Opponent is an American company that has a long history. At present, it claims to be “a leading producer in North America of thermoplastic conduit, enclosures, wiring devices and accessories for the construction, consumer, power and communications markets, and large diameter pipe for wastewater markets.” It has three primary business divisions, the largest being the Carlon division. The Carlon division “provides electrical and telecommunications raceway systems, non-metallic enclosures, outlet boxes and electric fittings to the electrical and telecommunications infrastructure markets.”

Mr. Whaley states, “In North America, the colour red is used on conduit, enclosures, wiring devices, fittings and other components in association with life safety systems, such as fire alarm or smoke detector installations.” In support of this statement, he provides the following materials:

- Exhibit A: copies of pages of Canadian Standards Association’s 2002 Canadian Electrical Code, which sets out in sections 24 and 32 that “all receptacles that are part of an essential electrical system shall be coloured red, and no other receptacles shall be so coloured” and that disconnecting means for the separate circuit supplying a fire alarm system shall be coloured red.
- Exhibit B: pages from the Government of the Northwest Territories’ Public Works and Services website relating to “Good Building Practice for Northern Facilities” that state that all junction boxes, pull boxes and their covers related to fire alarms must be painted red (pages printed on 3/20/2005)
- Exhibit C: an invitation to tender from the City of Prince George, British Columbia that requires that all fire alarm junction boxes, blank outlet cover boxes and conduit that pass through floors be painted red (the invitation has a closing date of September 11, 2003)
- Exhibit D: pages from the website of Hubbell Electrical Products, a division of Hubbell Incorporated promoting “RACO ® RED BOXES & Covers” which are large capacity

boxes and standard design steel wall boxes, extension rings and covers, that are described as “allow[ing] an inspector or building owner to immediately identify life safety systems” and “prevent[ing] the need for painting or labeling on the job site” (pages printed 3/10/2005)

- Exhibit E: an ad from the September 2004 edition of *The Electrical Distributor* magazine for the above-mentioned RACO red products, which reads “RACO introduces a custom series of products designed for the installation of alarm/fire or life safety systems” (Mr. Whaley states that this magazine is available to Canadian subscribers)
- Exhibit F: pages from the website of Wholesale Fire & Rescue Limited that advertises a red junction box (the date of these materials is not apparent)
- Exhibit G: pages from the website of Viking Electronics Inc. that advertise telecom boxes in “emergency red”; Canadian distributors are listed (pages printed 3/20/2005)
- Exhibit H: an undated advertisement by Royal Pipe Systems, a member of the Royal Group of Companies, for color coded ENT slab boxes, including a red one for fire alarm
- Exhibit I: pages from the website of Royal Pipe Systems that advertise Ident-a-Box™ slab boxes and state:

We offer colour-coded lids on our Ident-a-Box™ slab boxes for easy identification of services both before and after the concrete is poured. They are available in grey, green, white, blue, yellow and red.

Typical uses for each colour:

- Grey – generic
- Green – security, cable, telephone
- White – hydro 600 volt
- Blue – hydro 120 volt
- Yellow – emergency lighting and exit signs
- Red – fire alarm systems

(there is a copyright notice of 2004 on one of the pages).

On cross-examination, Mr. Whaley explained that slab boxes are a type of junction box.
(Question 34)

Preliminary Matter

In its written argument, the Opponent states:

Counsel for the Applicant requested the right to cross-examine Mr. Whaley on all his affidavits filed in respect of each of the five coloured junction box oppositions taken by the Opponent against the Applicant and counsel for the Opponent agreed. Therefore the transcript of the cross-examination discusses the affidavits and exhibits filed in respect of each of the oppositions. We therefore respectfully submit that we should be able to refer to the exhibits referred to in the transcript of the cross-examination in each of the written arguments filed in respect of these colour coded junction boxes.

However, I do not think that the single cross-examination ought to have the full effect proposed by the Opponent. The Opponent chose to file different affidavits for each opposition and its proposal appears to simply be an attempt to have evidence considered with respect to the present file that it perhaps now regrets not filing in respect of this application. In particular, the Opponent wishes to rely on a brochure filed as an exhibit with respect to another application because it predates all of the material dates. However, the brochure in question was not entered as an exhibit to the cross-examination. In addition, the date of the brochure was not referred to during the cross-examination. So, even if all of the questions of the cross-examination are to be considered in each of the oppositions, the questions and answers provide no evidence that the brochure being discussed existed prior to either June 14, 2004 or February 28, 2001.

Section 12(1)(b) Ground of Opposition

There is no evidence that the colour red described fire alarm related applications as of the material date of February 28, 2001. Accordingly, the Opponent has not met its initial burden and this ground is rejected.

Section 16(3) Ground of Opposition

When considering a s. 16 ground of opposition, consideration must also be given to s. 17(1) of the Act, which reads in part as follows:

No application for registration of a trade-mark that has been advertised in accordance with section 37 shall be refused ... on the ground of any previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant for that registration or his predecessor in title, except at the instance of that other person or his successor in title ... [my underlines]

As the Opponent has not evidenced that it has used “a trade-mark consisting of the colour red as applied to electrical junction boxes”, its s. 16(3) ground cannot succeed.

Section 12(1)(e) Ground of Opposition

The Opponent has pleaded that the Mark is not registrable because it is a mark that is prohibited by s. 10 of the Act. Section 10 reads as follows:

Where any mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services, no person shall adopt it as a trade-mark in association with such wares or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

In my view, the Opponent's evidence is sufficient to show that the colour red has an accepted meaning in the parties' industry, namely fire alarm related applications. The Opponent has therefore met its initial burden.

I find that the Applicant has not met its legal burden with respect to this ground. Accordingly, the ground succeeds.

Non-distinctiveness Ground of Opposition

The Opponent has met its initial burden with respect to this ground based on the evidence of the use of the colour red on junction boxes and the like to indicate fire alarm related applications as of the material date of June 14, 2004.

To meet its legal burden, the Applicant must satisfy me on a balance of probabilities that its Mark does distinguish or is capable of distinguishing its wares from those of others.

Marks comprised solely of colour are not inherently distinctive [see *AstraZeneca AB v. Novopharm Ltd.* (2003), 24 C.P.R. (4th) 326 (F.C.A.) at paragraph 18]. Moreover, in the present case, there is no evidence that the Applicant's proposed-use Mark had acquired distinctiveness through use or promotion as of the material date. Instead, there is evidence that others used, or

required the use of, red to indicate that wares such as those of the Applicant related to fire alarm applications. I therefore find that the Applicant has not met its legal burden and this ground of opposition accordingly succeeds.

I will add that the brochures in Exhibits H and I of Mr. Whaley's affidavit suggest that the colour of the Applicant's wares indicate their application, not their source, although I appreciate that such evidence postdates the material date and that one of the brochures includes the statement: "Royal color coded slab boxes are a registered trade mark of Royal Group Technologies."

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 17th DAY OF JULY 2008.

Jill W. Bradbury
Member
Trade-marks Opposition Board