



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

Citation: 2014 TMOB 77
Date of Decision: 2014-04-01

**IN THE MATTER OF AN OPPOSITION
by Pinkwood Ltd. to application
No. 1,377,746 for the trade-mark PINK IS
GREEN in the name of Owens Corning
Canada LP**

[1] On January 2, 2008, Owens Corning Intellectual Capital, LLC filed application no. 1,377,746 for the trade-mark PINK IS GREEN (the Mark). The application was subsequently assigned to the current applicant, Owens Corning Canada LP (the Applicant).

[2] The application is based upon proposed use in Canada in association with “insulating materials, namely, foam and glass fiber insulation for thermal and acoustical purposes; building materials, namely, roofing shingles, roofing vents, shingle underlayment, roofing flashing in the nature of ice and water barriers and gutter protector”.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 17, 2011. Pinkwood Ltd. (the Opponent) opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by filing a statement of opposition on January 3, 2012. The grounds of opposition are based upon sections 30(a), 30(e), 12(1)(b), 16(3)(a), 16(3)(b), 16(3)(c) and 2 of the Act.

[4] Neither of the parties filed any evidence. Only the Applicant filed a written argument and no hearing was held.

[5] For the reasons which follow, I am summarily dismissing all grounds of opposition.

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[6] 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 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition Summarily Dismissed for being Improperly Pleaded

[7] A statement of opposition must set out the grounds of opposition in sufficient detail to enable the applicant to reply [see section 38(3)(a) of the Act; *Faber-Gastell Can Inc v Binney & Smith Inc* (1991), 36 CPR (3d) 388 (TMOB); and *Benson and Hedges (Canada) Ltd v Imasco Ltd* (1976), 25 CPR (2d) 269 (FCTD)].

Section 30(a)

[8] The Opponent has pleaded that contrary to section 30(a) of the Act, the application does not contain a statement in ordinary commercial terms of the specific wares in association with which it is proposed to be used or in the alternative, a portion of the statement of wares in the application is not expressed in ordinary commercial terms.

[9] A ground of opposition based upon an allegation of non-compliance with section 30(a) of the Act that does not identify which wares are not defined in ordinary commercial terms is insufficiently pleaded [see *K-tel International Ltd v 1033064 Canada Inc* (1998), 86 CPR (3d) 122 (TMOB) and *Where Magazines International et al v Nystrom Division of Herff Jones, Inc* (2004) 42 CPR (4th) 271 (TMOB)].

[10] This ground of opposition is therefore summarily dismissed on the basis that it has not been properly pleaded.

Section 12(1)(b)

[11] The Opponent has pleaded that the Mark is not registrable, as 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.

[12] A pleading which merely reproduces the language of section 12(1)(b) of the Act and therefore merely pleads a conclusion of law, is insufficient for not providing any supporting allegations of fact [see *Faber-Gastell, supra*].

[13] Accordingly, this ground of opposition is also summarily dismissed for being improperly pleaded.

Grounds of Opposition Summarily Dismissed for Opponent's Failure to Meet Evidential Burden

Section 30(e)

[14] The Opponent has pleaded that contrary to section 30(e) of the Act, the Applicant "...did not intend, and never intended, to use the trade-mark as alleged, or at all, as a trade-mark in Canada".

[15] Section 30(e) of the Act requires an applicant to make a statement that it, either by itself or through a licensee intends to use the applied for trade-mark in Canada. The application contains such a statement. It therefore formally complies with section 30(e) of the Act. In view of this, and since there is no evidence of record to suggest any lack of intention to use the Mark on the part of the Applicant, the Opponent has not met its initial burden in respect of this ground.

[16] Accordingly, this ground of opposition is summarily dismissed.

Sections 16(3)(a) and (c)

[17] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the Opponent's prior use of its trade-marks PINKJOIST, PINKSHIELD and PINKWOOD, which had been used and made known in Canada by the Opponent prior to the filing date of the application for the Mark. In addition, the Opponent has pleaded that the

Applicant is not the person entitled to registration of the Mark in view of the Opponent's prior use of its trade name PINKWOOD.

[18] With respect to these grounds of opposition, there is an initial burden on the Opponent to evidence use of its trade-marks or trade-name prior to the Applicant's filing date and show that it had not abandoned its trade-marks or trade-name as of the date of advertisement of the Applicant's application [section 16(5)].

[19] The Opponent has not provided any evidence of use of its trade-mark or trade-name and it has therefore failed to meet its initial evidential burden in relation to the sections 16(3)(a) and (c) grounds of opposition.

[20] Accordingly, these grounds of opposition are dismissed.

Section 16(3)(b)

[21] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the Opponent's previously filed applications for PINKJOIST (application No. 1,465,208), PINKSHIELD (application No. 1,496,080) and PINKWOOD (application No. 1,465,210).

[22] In order to meet its initial burden under this ground of opposition, the Opponent must show that one or more of its applications had been filed prior to the Applicant's January 2, 2008 filing date for the Mark and had not been abandoned as of the August 17, 2011 date of advertisement.

[23] The Opponent has not filed any evidence of the applications which it relies upon in support of this ground of opposition. However, the Registrar has the discretion, in view of the public interest, to check the register for applications relied upon by an opponent [see *Royal Appliance Mfg Co v Iona Appliances Inc* (1990), 32 CPR (3d) 525 (TMOB)]. I have exercised my discretion to check the status of the applications relied upon by the Opponent and I confirm that as noted by the Applicant, all three of the Opponent's applications were filed after the August 17, 2011 filing date of the application for the Mark.

[24] In view of the foregoing, the Opponent has not met its initial burden in respect of its section 16(3)(b) ground of opposition.

[25] Accordingly, this ground of opposition is also summarily dismissed.

Section 2

[26] The Opponent has pleaded that the Mark does not distinguish and is not capable of distinguishing the Applicant's wares from those of others and in particular, those of the Opponent.

[27] In order to satisfy its initial burden with respect to the distinctiveness ground of opposition, an opponent's evidence must show that its trade-marks had become known sufficiently as of the commencement of the opposition to negate the distinctiveness of the applied-for trade-mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC) and *Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[28] The Opponent has not filed any evidence of use of its trade-mark. The Opponent has therefore failed to meet its initial burden.

[29] Accordingly, this ground of opposition is dismissed.

Disposition

[30] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office