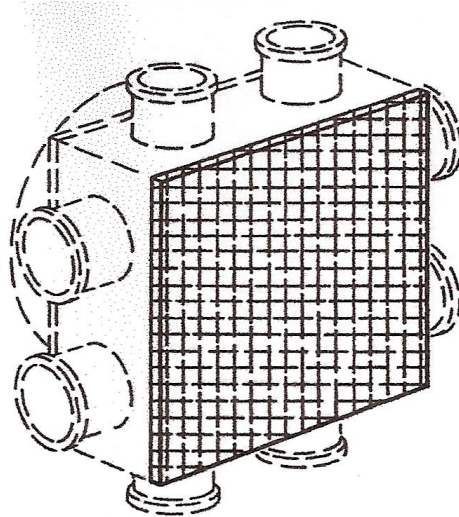


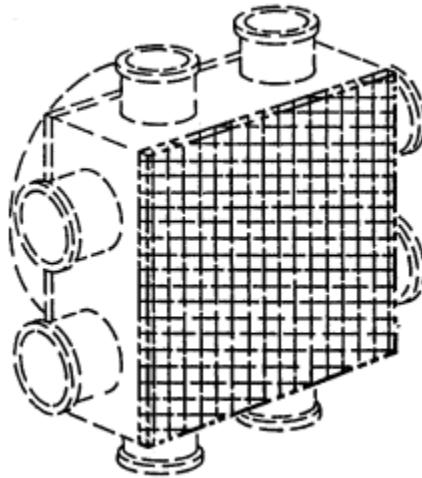
IN THE MATTER OF AN OPPOSITION by Ipex Inc. to application No. 1094356 for the trade-mark Junction Box Colour Plate Device (yellow) in the name of Royal Group, Inc.

[1] 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 Device (yellow) [the “Mark”] based upon proposed use of the trade-mark in Canada in association with electrical junction boxes. When the application was filed, the trade-mark was displayed and described as follows:



The trade-mark is shown in the drawing. The trade-mark consists of a yellow plate on a junction box. The drawing is lined for colour. The part of the drawing shown in dotted lines does not form part of the trade-mark.

[2] The application was advertised for opposition purposes in the Trade-marks Journal of January 21, 2004. The trade-mark was at that time displayed and described as follows:



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

[3] 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.

[4] On June 11, 2004, Ipex Inc. [the “Opponent”] filed a statement of opposition. The following statements are made in the preamble of the statement of opposition:

As stated in the verbal description of the advertisement under the above serial number, the applicant’s trade mark *as advertised* consists of “the colour yellow applied to a face plate of a junction box” (hereinafter referred to as the “Applicant’s Trade Mark as Advertised”). However, as stated in the verbal description of the Applicant’s application as originally filed, the applicant’s trade mark *as originally filed* consists of a “yellow plate on a junction box” (hereinafter referred to as the “Applicant’s Trade Mark as Originally Filed”).

[5] The pleaded grounds of opposition are reproduced below:

1. The Applicant's application does not comply with the requirements of Section 30 of the Trade Marks Act in that the application does not contain an accurate and true statement as to what the trade mark is in that when the application was originally filed the applicant said that the trade mark consists of "a yellow plate on a junction box" and showed the plate as part of the trade mark by using solid lines to show the plate in the drawing as originally filed; and the applicant improperly amended the application by changing the trade mark to "the colour yellow applied to a face plate of a junction box" and improperly changed the drawing to show the plate as not part of the trade mark by using dashed lines to show the plate in the drawing as advertised; and these changes altered the distinctive character of the trade mark and affected its identity contrary to Rule 31(b) of the Trade Marks Rules;

2. The Applicant's application was incorrectly and improperly advertised in view of the facts pleaded in paragraph 1... above;

3. The Applicant's application does not comply with the requirements of Section 30(e) in that the application does not contain an accurate and true statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the Applicant's trade mark, including both the Applicant's Trade Mark as Advertised and the Applicant's Trade Mark as Originally Filed, in Canada in that the Applicant did not intend and does not intend and did not propose and does not propose to use either the colour yellow applied to a face plate of a junction box or the yellow plate on a junction box for the purpose of distinguishing or so as to distinguish junction boxes made or sold by the Applicant from those made or sold by others, but rather the Applicant intended and proposed to, and does intend to and propose to, use the colour yellow applied to a face plate of a junction box and the yellow plate on a junction box as a clear indication or description of the intended or proposed purpose or function of the junction box;

4. The Applicant's Trade Mark as Originally Filed is a distinguishing guise and, therefore, the Applicant's Trade Mark as Originally Filed is not registerable having regard to Section 13(1) of the Trade Marks Act in that the Applicant's Trade Mark as Originally Filed (which was based on proposed use in Canada) had not been so used in Canada by the Applicant or its predecessor in title as to have become distinctive at the date of filing of the Applicant's application, namely February 28, 2001;
5. The Applicant's Trade Mark as Originally Filed is not registerable having regard to Section 13(2) of the Trade Marks Act in that the registration of the Applicant's Trade Mark as Originally filed interferes with the use of an utilitarian feature embodied in the distinguishing guise, namely the yellow plate and the colour yellow applied to a face plate of a junction box clearly indicating or describing the intended or proposed purpose or function of the junction box;
6. The Applicant's Trade Mark as Originally Filed is not registerable having regard to Section 13(3) of the Trade Marks Act in that the registration of the Applicant's Trade Mark as Originally filed would likely unreasonably limit the development of the industry in Canada involving the making and selling of junction boxes and the art and industry in Canada of using junction boxes;
7. The Applicant's trade mark, including both the Applicant's Trade Mark as Advertised and the Applicant's Trade Mark as Originally Filed, is not registerable having regard to Section 12(1)(b) of the Trade Marks Act in that whether depicted, written or sounded, it is either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares in association with which it is proposed to be used, namely electrical junction boxes, in that a yellow plate of a junction box and the colour yellow applied to a face plate of a junction box is proposed and intended to clearly indicate and describe, and does clearly indicate and describe, to potential purchasers and users that the junction box is intended to be used for a particular purpose or function;

8. The Applicant's trade mark, including both the Applicant's Trade Mark as Advertised and the Applicant's Trade Mark as Originally Filed, is not registerable having regard to Section 12(1)(e) of the Trade Marks Act in that the adoption of the trade mark is prohibited by Section 10 of the Trade Marks Act in that the Applicant's trade mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind and quality of junction boxes;

9. The Applicant's application as advertised does not comply with the requirements of Section 30(h) of the Trade Marks Act in that the application as advertised does not contain an accurate drawing of the Applicant's Trade Mark as Originally Filed in that the drawing as originally filed showed the face plate with solid lines and the trade mark was claimed as consisting of a yellow plate on a junction box, and the Applicant's Trade Mark as Originally Filed and as shown in the drawing as originally filed was improperly changed, contrary to Rule 31(b) of the Trade Marks Rules, in the drawing as advertised and in the verbal description as advertised as described above in paragraph 1...;

10. The Applicant's trade mark, including both the Applicant's Trade Mark as Advertised and the Applicant's Trade Mark as Originally Filed, is not distinctive of the Applicant's wares, having regard to Section 2 of the Trade Marks Act, in that the Applicant's trade mark does not, and is not adapted to, distinguish the wares of the Applicant from the wares of others:
 - (i) in that the Applicant did not intend and does not intend and did not propose and does not propose to use either the colour yellow applied to a face plate of a junction box or a yellow plate on a junction box for the purpose of distinguishing or so as to distinguish junction boxes made or sold by the Applicant from those made, manufactured or sold by others, but rather the Applicant intended and proposed to, and does intend to and

propose to, use the colour yellow applied to a face plate of a junction box and the yellow plate on a junction box as a clear indication or description of the intended or proposed purpose of the junction box;

- (ii) in that a yellow plate on a junction box and the colour yellow applied to a face plate of a junction box clearly indicate or describe to the relevant purchasers and users that the junction box is intended to be used for a particular purpose or function;
- (iii) in that a yellow face plate on a junction box and the colour yellow applied to a face plate of a junction box have by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind and quality of junction boxes in that a yellow face plate and the colour yellow applied to a face plate of a junction box indicate and describe to relevant purchasers and users that the junction box is intended for a particular purpose or function;
- (iv) in that since prior to the date of this Statement of Opposition and prior to the date of filing the Applicant's application, namely February 28, 2001, and continuously to date, third parties have used in Canada yellow face plates on junction boxes and the colour yellow applied to face plates of junction boxes to indicate and describe to relevant purchasers and users of the junction boxes that the junction boxes were intended for a particular purpose or function; and
- (v) in view of all of the facts and allegations pleaded in this Statement of Opposition.

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

[7] In support of its opposition, the Opponent filed the affidavits of Travis Lutes and Kim Parrott. The Applicant obtained an order for the cross-examination of Mr. Lutes and a copy of the transcript of the cross-examination has been filed together with Exhibit 1 to the cross-examination and answers to undertakings.

[8] The Applicant elected to not file any evidence.

[9] Each party filed a written argument.

[10] An oral hearing was held in which only the Opponent participated. At the start of the oral hearing, the Opponent's agent directed me to a number of colour references that required correction in its written argument.

Onus

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (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].

Summary of Evidence re the Colour Yellow

[12] As a number of grounds of opposition turn on the issues of whether the colour yellow has a particular meaning and whether yellow is commonly used in the industry, I will summarize the evidence relating to those issues.

[13] The only evidence with respect to these issues comes from Mr. Lutes, who was the Opponent's Market Development Manager from July 2002 to March 31, 2005. Prior to that he was the Opponent's Sales Manager for Plumbing Products for about two years. He states that

based on his employment with the Opponent since 1994, he is personally aware of “the state of the plastic pipe and fittings industry in Canada” from 1994 to 2005.

[14] Mr. Lutes provides the following information concerning the use of colour by the Opponent and others in the parties’ field.

[15] Since before February 28, 2001, the Opponent has made, advertised and sold electrical non-metallic tubing (“ENT”). ENTs are related to junction boxes in that an ENT connects into the circular connectors on the sides of junction boxes through which various cables and wire may be passed.

[16] At paragraph 27, Mr. Lutes attests that since well before February 28, 2001 the Opponent has marked the outer surface of its ENTs with either a longitudinal red, yellow or blue line to be used by workers to identify the intended purpose, function or application of the ENT connected to the junction box and that a yellow line indicates ENT for emergency lighting and exit signs. However, the date set out in the foregoing statement is contradicted by paragraph 29 where Mr. Lutes states that colour-coded ENT has been distributed in Canada by the Opponent since about late 2003 or early 2004. (The Opponent is a Canadian company.)

[17] In addition, Mr. Lutes’ paragraph 27 must be reconciled with Questions 75-77 of his cross-examination, wherein Mr. Lutes was asked if the sole purpose of the colour marking on the Opponent’s tubing is to indicate the intended function of the tubing. He replied: “It may or may not be. We make suggestions in our literature that red be for fire alarm, yellow for emergency lighting and blue for power, but it is also conceivable that someone on a job site may have three different power voltages and run it in various coloured tubings.” When asked if the purpose of the colour is to allow the worker to chose what wiring they want to put through the tubing, Mr. Lutes replied “yes”.

[18] The Opponent has submitted that yellow is used in the industry to indicate emergency lighting and exit sign applications and has provided examples of the Applicant’s advertising

materials which state that typical uses for yellow are emergency lighting and exit signs (Exhibit “C”, Lutes affidavit). However, a September 2000 brochure concerning the Opponent’s KWIKON brand of ENT reads, “Now you can use the KWIKON system for communications (yellow)...” (Exhibit “D”) It is my view that communications are not a subcategory of emergency lighting/exit signs. Therefore it appears that an industry colour standard does not exist since the Opponent and the Applicant have suggested that the same colour (yellow) be used for different purposes. In fact, as discussed further below, Mr. Lutes confirmed during cross-examination that there is no industry standard.

[19] I note that Mr. Lutes did not provide evidence detailing the extent of use of the colour yellow by the Opponent. Overall, the evidence of the Opponent’s use of the colour yellow is insufficient to conclude that the Opponent has acquired a reputation in association with the colour yellow.

[20] I turn now to Mr. Lutes’ information concerning third party use of the colour yellow.

[21] Paragraphs 31-32 of Mr. Lute’s affidavit read as follows:

31. Also, prior to February 28, 2001, and subsequently since then to date, I am aware of workers in the field in Canada spray painting electrical junction boxes, including the face plates and/or the circular connectors, with **orange** paint to indicate the intended purpose, function or application of that particular junction box. The workers on that particular site would be aware that the orange colour indicated a specific intended purpose, function or application for the particular junction box. Similarly, on that same site, the workers in the field would also use different colours of spray paint sprayed onto junction boxes, including the face plates and/or the circular connections, to indicate specific other intended purposes, functions or applications of other particular junction boxes. On that site, the workers would know what specific application the specific colours were intended to indicate. [emphasis added]

32. The following colours have been used by workers in the field in Canada, both prior to and subsequent to the Applicant filing the Applicant’s Applications, and continuing to date, to indicate the following intended purpose, function or application of the particular junction box (which were and are substantially the same as those adopted by the Applicant), namely:

| | |
|--------|-----------------------------------|
| yellow | emergency lighting and exit signs |
| red | fire alarm |

[22] I find paragraphs 31 and 32 to be somewhat contradictory because although Mr. Lutes first attests that he is personally aware that workers use orange spray paint to indicate a function (which he does not define), he then goes on to declare that workers use yellow to indicate emergency lighting and exit signs. The basis for that declaration is unclear to me, even though I am aware that Mr. Lutes indicated during his cross-examination that he has attended job sites.

[23] I reproduce below a portion of Mr. Lutes' cross-examination, which deals with the use of colours in general in the marketplace:

Q. 59 So, we can come back to paragraph 8, Mr. Lutes...well, maybe without coming back to paragraph 8, are you saying that in the marketplace red designates that the tubing and the junction boxes, that the purpose of the colour markings is to designate that the wiring inside is for a fire alarm system?

A. Yes. However, engineers and contractors, in a lot of cases, are at liberty to choose the colours they want. So, it would not be standard on each and every project. **There is no industry standard**, if that helps.

Q. 60 Yes, it helps. Are you saying that just in respect of red or all the colours?

A. Essentially all.

[emphasis added]

[24] Further to the cross-examination, Mr. Lutes provided brochures from another company (Allied Tube) that sells coloured ENT, in particular red and blue ENTs. Although the brochures indicate different suggested applications for the two different colours, each of the brochures also state that the colour is a trade-mark of Allied Tube. A brochure advertising red coloured ENT connectors and couplings of another company (Bridgeport) was also provided.

[25] Overall, I find that Mr. Lutes' evidence does not support a conclusion that the colour yellow had a defined meaning in the parties' industry as of any date.

Section 12(1)(b) Ground of Opposition

[26] The material date with respect to s. 12(1)(b) is the date of filing of the application [*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.)].

[27] There is no evidence that the colour yellow clearly described any particular purpose or function of electrical junction boxes as of the material date of February 28, 2001. Accordingly, the Opponent has not met its initial burden and the seventh ground of opposition is rejected.

Section 12(1)(e) Ground of Opposition

[28] 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.

[29] The material date with respect to s. 12(1)(e) is the date of my decision [*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.)].

[30] The Opponent's evidence is insufficient to show that the colour yellow has an accepted meaning in the parties' industry. The Opponent has therefore not met its initial burden and thus the eighth ground of opposition is rejected.

Section 13(1) Ground of Opposition

[31] The Act defines a distinguishing guise as follows:

"distinguishing guise" means

(a) a shaping of wares or their containers, or

(b) a mode of wrapping or packaging wares

the appearance of which 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

[32] The Opponent argues that the description of the Applicant's Mark when the application was originally filed described a distinguishing guise. Ms. Parrott has provided a certified copy of the prosecution file of this application and it indicates that there was a considerable dialogue between the Examiner and the Applicant as to the appropriate way to describe and portray the Mark. The Examiner did state at one point of time that if the Mark consists of the actual faceplate in a specific colour then the Mark might constitute a distinguishing guise but that if the Mark consists of a specific colour applied to the visible surface of a particular faceplate, the faceplate not forming a part of the Mark, then it would not be a distinguishing guise. Ultimately the Applicant chose to present its Mark in the latter style.

[33] The material date for considering whether a distinguishing guise is registrable under s. 13(1) is the application's filing date (see, for example, *Glaxo Wellcome Inc. v. Novopharm Ltd.* (2000), 8 C.P.R. (4th) 448 (F.C.T.D.)). However, as presently the Mark does not appear to be a distinguishing guise, s. 13 does not apply and its material date is irrelevant.

[34] The Opponent's pleading raises the interesting question of whether an amendment made during prosecution, which rectifies a problem or deficiency that existed in the original application, does so retroactively. This appears to be the case for example with respect to s. 30(a); in cases where the initial statement of wares was not specifically stated in ordinary commercial terms, an applicant who subsequently properly defines its wares will not be found to have not complied with s. 30(a), even though the material date regarding s. 30 is the date of filing (*Eaton Williams (Millbank) Ltd. v. Nortec Air Conditioning Industries Ltd.* (1982), 73 C.P.R. (2d) 70 (T.M.O.B.) at 77). In the present case, it seems appropriate to also consider the Mark as it currently stands, rather than how it stood at the time of filing. Although the Opponent may be correct in interpreting the original description of the Mark as describing a distinguishing guise,

namely a combination of the shaping of part of a ware with a colour claim, it is clear that the current description of the Mark (as advertised) does not describe a distinguishing guise.

[35] The fourth ground of opposition is therefore dismissed.

Section 13(2) and 13(3) Grounds of Opposition

[36] I do not think that s. 13(2) or 13(3) of the Act can form the basis of a ground of opposition under s. 38(2)(b) as they are directed to registrations, not applications, and do not refer to registrability. If I am wrong in this regard, the Opponent's fifth and sixth pleaded grounds of opposition would fail on the basis that the Opponent has not met its initial burden in respect thereof.

Section 30 Grounds of Opposition

[37] The material date with respect to s. 30 is the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475].

ii) first s. 30 ground of opposition

[38] The first ground pleaded under s. 30 is not a proper ground of opposition. In particular, the Opponent's allegations that the Mark was amended contrary to r. 31(b) of the *Trade-marks Regulations* and consequently improperly advertised do not plead a s. 30 ground of opposition. The first ground of opposition is accordingly dismissed.

[39] In the event that I am wrong in determining that the first ground does not plead a proper ground of opposition, I will add that, although the amendment by the Applicant of its trade-mark during prosecution was arguably contrary to r. 31(b), I do not consider the acceptance of the amendment by the examiner to be clearly an error of law nor has it been shown that there was a misinterpretation of the facts by the examiner which would justify my reconsidering the decision rendered by the examiner in the exercise of the Registrar's discretion. [See *Magill v. Taco Bell Corp.* (1990), 31 C.P.R. (3d) 221 (T.M.O.B.).]

ii) *s. 30(e) ground*

[40] Since the application contains a statement that the Applicant by itself and/or through a licensee intends to use the trade-mark in Canada, it formally complies with s. 30(e). The issue therefore becomes whether or not the Applicant substantially complied with s. 30(e), i.e. is the Applicant's statement that it intended to use the applied for mark true? [See *Home Quarters Warehouse, Inc. v. Home Depot, U.S.A., Inc.* (1997), 76 C.P.R. (3d) 219 (T.M.O.B.); *Jacobs Suchard Ltd. v. Trebor Bassett Ltd.* (1996), 69 C.P.R. (3d) 569 (T.M.O.B.).]

[41] Mr. Lutes has provided various advertisements for the Applicant's junction boxes, which indicate that the boxes are colour coded so that they can be used to identify various applications, e.g. yellow for emergency lighting and exit signs. [Exhibits "A", "B", and "C"] Although the Opponent relies on these materials in support of its claim that the Mark was not intended to be used as a trade-mark, the materials specifically state, "Royal color coded slab boxes are a registered trade mark of Royal Group Technologies". (Mr. Lutes attests that a "slab box" is a type of "junction box".) Thus it is apparent that it was the Applicant's intent to use the Mark as a trade-mark. To put it another way, the evidence indicates that the Applicant did not make a false statement of intent to use the Mark. The third ground of opposition is accordingly dismissed.

iii) *s. 30(h) ground of opposition*

[42] The s. 30(h) ground, as pleaded in the statement of opposition, is based on the alleged improper amendment of the Mark. The ninth ground of opposition is therefore dismissed for the reasons set out in my discussion above concerning the first s. 30 ground of opposition.

Non-distinctiveness Ground of Opposition

[43] The material date with respect to non-distinctiveness is the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

[44] There is no evidence of the use of the colour yellow on junction boxes by third parties as of June 14, 2004. Nor is there evidence that the Mark was clearly descriptive or deceptively

misdescriptive as of that date or contrary to s. 10. Furthermore, as discussed earlier, it is apparent that the Applicant did intend to use the Mark to distinguish its wares. Therefore, the Opponent has not met its initial burden with respect to those portions of the pleading of this ground of opposition.

[45] The Opponent has included in its pleading the catch-all claim that the Mark is not distinctive in view of all of the facts and allegations pleaded in the statement of opposition. I will not discuss whether or not all of the facts and allegations could support a claim of non-distinctiveness because this catch-all pleading necessarily fails on the basis that none of the other grounds of opposition have succeeded.

[46] Overall, the Opponent has not satisfied its initial burden with respect to the tenth ground of opposition and it is accordingly dismissed.

Disposition

[47] Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 25th DAY OF JUNE 2009.

Jill W. Bradbury
Member
Trade-marks Opposition Board