



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

Citation: 2011 TMOB 81
Date of Decision: 2011-06-23

**IN THE MATTER OF AN OPPOSITION
by AES Properties LLC to application
No. 1303704 for the trade-mark
POWERSHIELD in the name of Les
Industries Harnois Inc.**

[1] On June 1, 2006, Les Industries Harnois Inc. (the Applicant) filed an application to register the trade-mark POWERSHIELD (the Mark), based upon use in Canada since at least as early as June 1, 2002, in association with “woven fabric for covering prefabricated steel structures to form a multi-purpose building” (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 2, 2007. On October 2, 2007 a statement of opposition was filed by AES Properties LLC (the Opponent). The Applicant filed and served its counter statement on November 22, 2007.

[3] The Opponent filed the affidavit of Azhar Janjua; the Applicant filed the affidavit of Caroline Forest. The Applicant filed written submissions and both parties were represented at an oral hearing.

[4] The statement of opposition commences with a preamble statement of facts, in which the Opponent lists “representative members of the family of trade-marks”, as shown below:

Trade-mark	Registration No.
POLAR 10	TMA473,956
POLAR CAP	TMA518,248
POLARFLEECE	TMA292,776
POLARKIDS	TMA451,401
POLARPILE	TMA384,704
POLARPLUS	TMA360,832
POLARQUEST	TMA428,002
POLARSTRETCH	TMA461,681
POLARSYSTEM	TMA386,359
POLARTEC POWERSTRETCH	TMA478,955
POLARTEC	TMA394,303
POLARTEK	TMA369,114
POLARTUFF	TMA369,115

[5] The wording of the ground of opposition as pleaded pursuant to s. 38(2)(b) is: “the trade-mark, is not registrable in that, contrary to Section 12(1)(d) of the *Trade-marks Act*, it is confusing with the trade-marks owned, registered and used by the opponent in association with identical products, as *aforesaid*” [emphasis mine]. The Opponent alleged that it was a leading manufacturer of identical goods (to the Applicant’s), but the respective lists of wares were not reproduced in the statement of opposition. However, exercising the Registrar’s discretion to check the Register, I would observe that the wares in these registrations are specific items of

clothing, and/or fabric piece goods for use in “manufacturing” of clothing or in “conjunction” with clothing; in some cases the wares comprise both clothing and fabric for clothing.

[6] The Opponent has also pleaded that pursuant to s. 38(2)(a) of the Act the application does not comply with the requirements of s. 30. Pursuant to s.30(i) the Applicant cannot be satisfied that it is entitled to use the Mark in Canada in association with the wares listed in the application, since, “the wares of the opponent, and the opponent’s trade-marks *stated above* are well known in Canada and throughout the United States of America” [emphasis mine].

[7] The Opponent has also pleaded that pursuant to s. 38(2)(c) the Applicant is not the person entitled to registration of the Mark because “in accordance with s. 16(3) at the date of filing of the application, it was confusing with the “trade-marks shown above, which had been previously used in Canada by the opponent.” In this connection I note that s. 16(3) governs entitlement with respect to trade-mark applications based on proposed use, and since the subject application is based on prior use in Canada, this ground of opposition does not apply and will therefore not be considered.

[8] Finally, the Opponent pleaded that pursuant to s. 38(2)(d), the Mark is not distinctive of the Applicant because “it does not actually distinguish, nor is it adapted so to distinguish the wares of the applicant from the wares and services of others or from the wares and supporting services of the opponent used in association with the opponent’s trade-marks which comprise POLAR.”

[9] The statement of opposition raises three main issues: the first is compliance with s. 30(i), the second is confusion with the Opponent’s POLAR trade-marks within the meaning of s. 12(1)(d), and s. 6(5) of the Act, and the third is the distinctiveness of the Mark within the meaning of s.2 of the Act. The reason for the emphasis (*italicized*) above on certain wording of the Opponent’s pleadings will become clear as the issue of an additional trade-mark registration, put into evidence but not pleaded by the Opponent in its statement of opposition, comes to light.

Opponent's Evidence – Affidavit of Azhar Janjua

[10] Mr. Janjua is a contract researcher for the Opponent's law firm. His affidavit relates mostly to a trade-mark registration not referenced in the statement of opposition; however, some of the evidence also relates to one of the Opponent's POLAR trade-marks - POLARTEC.

[11] More particularly, the affiant attaches particulars of Canadian trade-mark registration TMA642,028 and United States Application 76/204,749 both for the trade-mark POWER SHIELD, for use in association with:

Textile fabrics for use in the manufacture of clothing and home furnishings, upholstery, and housewares, namely furniture and furnishings, carpets and floor coverings, wall coverings, fabrics and textiles, blankets, pillows, and bed, bath and kitchen linens; textile fabric piece goods sold as a component of clothing and clothing, namely coats, jackets, parkas, raincoats, pullovers, shirts, sports jerseys, trousers, pants, dresses, skirts, pajamas, underclothing, scarves, shawls, gloves, mittens, headwear, namely hats, caps, heabands[sic], and visors, footwear, namely sport and leisure shoes, slippers, socks, tights, stockings, and hosiery.

[12] As noted above, this registration was not referred to in any of the grounds of opposition. I also take this opportunity to underline the fact that the language in the opposition pleadings consistently refers back to the Opponent's list of POLAR trade-marks (as set out above with my use of italics).

[13] At the hearing the Opponent submitted that the grounds as pleaded in the opposition should be read as including other trade-marks of the Opponent. This submission seems grounded in the wording of the preamble of background facts relating to the list of POLAR trade-marks, which wording introduces the list of trade-marks as follows: "*representative* members of the family of marks are shown below". The Opponent argued that, by virtue of the word "representative", it is implied that it has other, additional, trade-marks. Further, the Opponent argued that its s. 2 non-distinctiveness pleading states that the Mark is confusing with the trade-marks of others and that "others" should be read to include its POWER SHIELD trade-mark. In addition, the Opponent argued that the Applicant was aware of this registration since it was cited against the subject application; this was a "doubtful case" where notice was sent from CIPO to

the Opponent under s. 37(3) advising it of the approval for advertisement of the subject application.

[14] I cannot agree that the wording of the statement of opposition should be read to include registrations not referenced therein, as not to know the case it has to meet would be highly prejudicial to an applicant. This is particularly so, in a case such as this, where a comprehensive list of trade-marks (described as a “family of marks”) is provided by the Opponent, and consistently referred to in its pleadings. I am of the view that in such a case the Applicant should be entitled to rely on the list as being complete. In any event, as a matter of common sense, I fail to see how POWER SHIELD could be considered part of the family of POLAR trade-marks listed above.

[15] Furthermore, the Applicant’s purported awareness of the Opponent’s registration of POWER SHIELD is not relevant. I fail to see how awareness of a trade-mark would necessarily imply its involvement in a proceeding, since in some circumstances there may be reasons why an opponent chooses not to rely on one of its trade-marks. For example, where a trade-mark might be the subject of ongoing litigation and the opponent wishes to avoid any rulings on the trade-mark, and/or where the opponent may be in the process of transferring the mark to another owner, etc. In this regard I note, in exercising the Registrar’s discretion to confirm the status of this POWER SHIELD registration, that it was assigned to a third party on March 12, 2007; the transfer of title was registered on February 25, 2010. No acknowledgement or clarification of the transfer has been provided by the Opponent, and although Mr. Janjua purports to provide some evidence of use of this trade-mark, no evidence of licensed use by the Opponent subsequent to the assignment date has been provided.

[16] In any event, I find it self-evident that any trade-mark relied on by the Opponent needs to be identified in its pleadings; it is not for the Applicant to “guess” what the Opponent’s case might be, nor what might be read into the pleadings. Accordingly, I am not prepared to accept the registration for POWER SHIELD as support for the ground of confusion under s. 12(1)(d) or non-distinctiveness under s. 2. In so finding I would observe that the Opponent had ample opportunity to request leave to amend its statement of opposition to include this registration.

[17] I will continue with Mr. Janjua's affidavit, as it provides some evidence regarding one of the POLAR trade-marks pleaded, as well as information about the nature of the wares and trade of the Opponent. A brief summary of the evidence with respect to its POWER SHIELD trade-mark is also included, since, even if I am wrong in disregarding this registration, I am of the view, based on the evidence herein, that the outcome of this proceeding would be the same.

[18] The affiant states that the Opponent has entered into a number of license agreements, whereby the Opponent's fabrics bearing the trade-mark POWER SHIELD are used by third parties in the manufacture of a "range of goods" for sale in Canada. He attaches to his affidavit a spreadsheet which "contains the names of a number of companies". I note that the Exhibit lists "customer name", "lic #" and "expiration date"; and it appears as though some of the agreements would be in existence at the date of this decision. Although this information tends to support the existence of licence agreements, there is no confirmation that use by these entities complies with s. 50 of the Act, namely, that such use was under the direct or indirect control of the Opponent. Furthermore, as stated above there is no evidence that use by the Opponent subsequent to the assignment of POWER SHIELD (March 12, 2007) was under licence and in accordance with s. 50 of the Act. In any event, I note that Mr. Janjua is not an employee of the Opponent; rather he is a researcher for the Opponent's Law Firm. He has not explained how the list of licensees came into his possession, or how he has any knowledge of the licensing arrangements; I am therefore inclined to consider that this is hearsay evidence and consequently to give it very little weight.

[19] With respect to evidence relating to use by the Opponent of its trade-marks, the affiant states that he visited the Opponent's website on June 23, 2008 at *www.polartec.com* and attaches printouts from the site, whereby some technical details of the Opponent's POWER SHIELD fabric used to manufacture clothing are explained. The trade-mark POWER SHIELD appears on the web pages in association with a range of clothing items and descriptive information about the fabric with which the clothing is manufactured. Also attached are printouts of various other websites, some of which are stated to be owned by the Opponent with similar information. I note that the trade-mark is displayed in relation to clothing items that appear to be for sale through the respective websites. For the most part POWER SHIELD® appears together with POLARTEC®, although in a few instances it appears alone. It is unclear if the clothing items themselves are

marked with POWER SHIELD or whether the trade-mark appears only on the respective web pages. In this regard, I further observe, that although the websites appear to be interactive and offer online purchasing, no evidence has been provided of any actual sales of clothing, or fabric, marked with either POWER SHIELD or POLARTEC POWER SHIELD, to persons in Canada.

Applicant's Evidence – Affidavit of Caroline Forest

[20] Ms. Forest is the Vice-President of Communications and Marketing of the Applicant. The Applicant is in the business of the design and construction of temporary buildings and structures, and has been since 1965. The Applicant has been using the Mark since at least as early as April 2002 in association with fabric membranes for covering its buildings and temporary structures. Attached as Exhibit 2 are two brochures describing the product sold in association with the Mark; the Mark appears throughout the brochures, and it is clear that the products are membranes made from polyethylene fabric used to cover structures used for a variety of industrial and commercial purposes.

[21] Ms. Forrest states that customers for the Applicant's product are municipal, provincial and federal government departments, as well as other users such as agricultural/equestrian farms. The structures and membranes are used for a variety of purposes including, sand and gravel storage, livestock housing, feed and fertilizer storage, equipment and machinery storage, workshops, construction sites, as well as indoor sports fields, indoor riding arenas and coverage of skating rinks.

[22] The affiant attaches a list of more than 250 clients that have purchased the product in 2008; many appear to be Canadian corporations or organizations. Two examples of product warranties are also attached, one dated June 6, 2002 and the other in effect since 2008. Warranties are included with the sale of the Wares and accompany the product on delivery; I note that the Mark appears on the pages of warranties in multiple locations and paragraphs.

Analysis of Grounds of Opposition

Section 38(2)(a) – S. 30(i)

[23] The material date that applies to grounds of opposition under s. 30 is the filing date of the application, namely June 1, 2006 [see *Delectable Publications Ltd. v. Famous Events Ltd.* (1989), 24 C.P.R. (3d) 274 (T.M.O.B.); *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B)].

[24] 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.)].

[25] With respect to the ground of opposition based on s. 30(i) of the Act, no evidence was filed demonstrating that the Applicant was aware of any prior rights of the Opponent when it filed its application. Even if the Applicant was aware of the Opponent's use in Canada of the Opponent's trade-marks, that alone would not prevent the Applicant from making in good faith the statement required. Where an applicant has provided the statement required by s. 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. As the Opponent has not evidenced any bad faith on behalf of the Applicant, this ground is dismissed.

Section 38(2)(b) - S. 12(1)(d)

[26] It has been clearly established that the material date for assessing a ground of opposition based on s. 12(1)(d) is the date of the decision of the Registrar [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[27] The Opponent alleges, in its statement of opposition, that the Mark is confusing with its trade-mark registrations for its POLAR family of trade-marks; the Opponent has satisfied its initial burden under this ground as these registrations are in good standing. The burden of proof therefore now lies with the Applicant to convince the Registrar, on a balance of probabilities,

that there is no reasonable likelihood of confusion between its Mark and each of the Opponent's POLAR trade-marks.

[28] The test for confusion is one of first impression and imperfect recollection on the part of a hurried consumer. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[29] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[30] This list is not exhaustive; all relevant factors are to be considered, the weight to be given to each factor depends on the circumstances [see in general *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349; *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.)]. However, in most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, (F.C.T.D.), *aff'd* (1982), 60 C.P.R. (2d) 70 (F.C.A.)]. I will therefore commence with the consideration of this factor, as this will influence the need for analysis under the other factors.

[31] With respect to s. 6(5)(e) and the Opponent's aforementioned POLAR family of trade-marks, clearly the degree of resemblance between the trade-marks in appearance, sound or in the ideas suggested is minimal. None of the Opponent's trade-marks at issue bear any similarity to the Mark, except that they all start with the letter P.

[32] With respect to the other factors, I am inclined to infer that the Applicant's Mark has acquired more distinctiveness through use, as the Opponent's evidence only shows website promotion of clothing under one of its POLAR trade-marks, namely POLARTEC; however, no sales in Canada of products in association with this trade-mark have been evidenced. Certainly, it cannot be said that the Opponent has established a family of trade-marks. With respect to the wares and channels of trade, I agree with the Applicant that the Opponent's wares (clothing and/or fabric for clothing) are completely different from fabric for covering multi purpose buildings. The Applicant is selling its Wares for industrial and commercial structures and buildings, and, as its evidence demonstrates, these do not appear to have any relation to the clothing industry. Therefore, in the absence of evidence demonstrating that the channels of trade would overlap, I think it is reasonable to conclude that they would not. I therefore see no necessity in continuing the analysis of confusion with respect to POLARTEC or any other POLAR trade-marks. This ground of opposition with respect to the trade-marks listed above is dismissed.

[33] Since I have already ruled that the Opponent should not be entitled to rely on its POWER SHIELD trade-mark, this mark need not be considered under this ground of opposition. However, if I am wrong in failing to consider this mark, I would simply observe that in the absence of evidence to the contrary, the nature of the wares (fabric and textile piece goods used in clothing and furniture coverings as compared to coverings for multi-purpose buildings) and the respective channels of trade are sufficiently different so as to outweigh the fact that the trade-marks are virtually identical. As a result, I am of the view that there would be no reasonable likelihood of confusion in this regard.

Section 38(2)(d)/S.2 – Non-distinctiveness

[34] The Opponent has an initial burden to prove the allegations of fact supporting its ground of distinctiveness. The Opponent needs to have shown that as of the filing of the opposition, its trade-mark(s) had become known sufficiently to negate the distinctiveness of the applied-for Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.), *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 (F.C.A.); *Bojangles International, LLC v Bojangles Café Ltd* (2006), 48 C.P.R. (4th) 427)]. In view of the findings under the s. 12(1)(d)

ground, with respect to the lack of any similarity between the Mark and any of the POLAR trade-marks, as well as the fact that the Opponent's POWER SHIELD trade-mark is excluded from consideration, the Opponent has clearly not met its initial burden and this ground must be dismissed.

[35] Even if I were to consider the POWER SHIELD trade-mark here, based on the previous observation regarding the absence of a likelihood of confusion, and in any event, in the absence of evidence regarding use in Canada at the date of the filing of the opposition (or at any time), I would be unable to find that it had become known sufficiently in Canada to negate the distinctiveness of the Mark.

Disposition

[36] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office