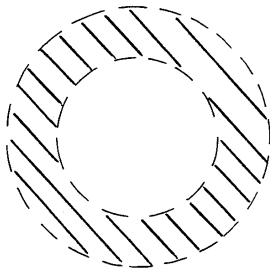
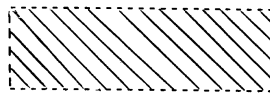


**IN THE MATTER OF OPPOSITIONS by
3M Company to applications Nos. 1,062,739;
1,062,740 and 1,062,931 for the trade-marks
COLOUR GREEN # 1, COLOUR GREEN # 2
and COLOUR GREEN # 3 filed by Tape
Specialities Limited and subsequently assigned
to Henkel Canada Corporation**

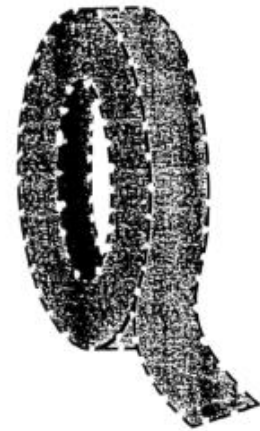
On June 9, 2000, Tape Specialities Limited filed applications to register the trade-marks COLOUR GREEN # 1, COLOUR GREEN # 2 and COLOUR GREEN # 3 for “masking tape” based on use in Canada since 1993. The three marks are shown below.



1,062,739



1,062,740



1,062,931

The description of the first trade-mark reads as follows:

The trade-mark consists of the colour green applied to the whole of the visible surface of the particular roll of masking tape depicted in the drawing. The trade-mark is lined for the colour green.

The description of the second trade-mark reads as follows:

The trade-mark consists of the colour green applied to the whole of the visible surface of the particular piece of masking tape depicted

in the drawing. The trade-mark is lined for the colour green.

The description of the third trade-mark reads as follows:

The trade-mark consists of the colour green applied to the whole of the visible surface of the particular roll of masking tape depicted in the drawing with the exception of the inner edge.

The first two applications were advertised for opposition purposes on June 5, 2002 and the third was advertised on June 12, 2002. The applications were subsequently assigned to Henkel Canada Corporation, the current applicant of record.

The opponent, 3M Company ("3M"), filed essentially identical statements of opposition on November 5, 2002. Copies of the first two were forwarded to the applicant on December 17, 2002 and a copy of the third was forwarded on November 19, 2002. Leave was later granted on May 9, 2006 to amend the statements of opposition in view of the assignment of the trade-mark applications.

The first ground in each case is that the applicant is not the person entitled to registration pursuant to Section 16(1)(a) of the Trade-marks Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the trade-mark GREEN COLOUR TAPE previously used in Canada by the opponent with adhesive tape products. The second ground in each case is that the applicant's trade-mark is not distinctive in view of the use by others of the color green as applied to adhesive tape products including the opponent and Canadian Technical Tape Ltd.

The applicant filed and served counter statements respecting the first two oppositions on January 14, 2003. The applicant filed a counter statement respecting the third opposition on December 23, 2002 and served a copy on the opponent on December 17, 2002. Leave was later granted to amend the three counter statements in view of the assignment of the applications.

As its evidence in each case, the opponent submitted the affidavits of Mark Rozon, Jason Paul Thomas McKenzie, Dana George, John Frederick Mullen, Kenneth Robert Arnott and Georges Albert Menard. All of those affiants except Dana George were cross-examined on their affidavits and the transcripts of those cross-examinations form part of the record of all three oppositions. As its evidence in each case, the applicant submitted an affidavit of Harry Young. Mr. Young was cross-examined on his affidavit and the transcript of that cross-examination forms part of the record of each opposition. Both parties filed a written argument in each case and an oral hearing was conducted at which both parties were represented.

THE OPPONENT'S EVIDENCE

The Rozon, McKenzie and George affidavits evidence purchases in the latter part of 2002 of CANTECH PAINTPRO green masking tape in a hardware store in New Brunswick and in Wal-Mart stores in various locations in four other provinces. That evidence suggests that this product was likely widely available throughout Canada at that time.

In his affidavit, Mr. Mullen identifies himself as Manager, Legal Services and Chief

Privacy Office of 3M Canada Company (“3M Canada”), a subsidiary of the opponent. He states that 3M sells pressure sensitive adhesive tape products including masking tape. According to Mr. Mullen, 3M filed an application to register a trade-mark comprising the color green as applied to the whole of the visible surface of masking tape on March 17, 1999 claiming use of the mark in Canada since March of 1998. After the application was opposed by Tape Specialities Limited, it was withdrawn. Mr. Mullen states that subsequent enquiries revealed that 3M had sold its green tape much earlier than the date of first use claimed.

On cross-examination, Mr. Mullen conceded that pressure sensitive tape can include different types of tape including electrical tape, duct tape, sealing tape and masking tape. He further stated that he was aware that 3M has a registration for the color blue as a trade-mark for masking tape. Mr. Mullen admitted that he was unaware of any instance of actual confusion between 3M's products and the applicant's product but he said that it would be unusual for him to hear about any such instances.

In his affidavit, Mr. Arnott identifies himself as the Marketing Manager of the Automotive Aftermarket Division of 3M Canada. He states that, for several years, his division has manufactured green-colored, pressure-sensitive adhesive tape designated as 3M 233+ tape. That tape has been offered for sale in Canada since 1998, primarily for use in the automotive painting market.

Exhibit A to the Arnott affidavit comprises a product brochure which shows a

product box bearing a picture of a partially unwound roll of green tape. The back of the brochure includes the wording "Scotch and the colour green are trademarks of 3M." However, the sample roll of tape appended as Exhibit B contains no trade-mark notice for the color green. According to Mr. Arnott, more than \$100,000 was spent promoting the 3M 233+ tape since 1998 and Canadian sales up to the date of his affidavit (i.e. August 6, 2003) were in excess of \$10 million.

On cross-examination, Mr. Arnott conceded that the largest user of 3M 233+ tape is auto body shops. According to Mr. Arnott, 3M Canada doesn't sell that product to Colour Your World retail paint stores. He was unaware if anyone was confused as between the applicant's tape and the opponent's 233+ tape.

In his affidavit, Mr. Menard identifies himself as Senior Marketing Manager for the Industrial Tape and Specialty Division of 3M Canada. Mr. Menard states that 3M Canada has sold a wide range of adhesive tapes in Canada for more than forty years. Since 1980, his division has distributed in Canada green-colored, pressure-sensitive adhesive tape designated as 3M 218. This tape is used primarily as masking tape in the automotive and aerospace painting markets. However, Mr. Menard did not specifically evidence sales of this tape prior to the applicant's claimed date of first use of 1993. Furthermore, there is nothing on the sample roll of 218 tape appended as Exhibit D to the Menard affidavit to indicate that the color green is claimed or functions as a trade-mark.

Mr. Menard also discusses his company's 2060 tape which is used for lacquer

coatings. This tape has been distributed in Canada since 1995 and is sold primarily for use in the home painting market. It is sold through retail paint and hardware stores such as Colour Your World and Canadian Tire. On cross-examination, Mr. Menard indicated that retail paint stores such as Sherwin-Williams and General Paint also carry this product.

Mr. Menard discusses a number of other green, pressure-sensitive adhesive tapes manufactured and sold by his company which fall within the broad category of masking tapes. Those different tapes tend to each have their own specialized use such as 3M 471 tape for sealing, patching and masking, 3M 8402 and 3M 8403 tape used for splicing and various 500 series tapes which comprise adhesive sheets and wide tapes used for stencilling applications. Sales for the latter two groups for the period 2001 to the date of Mr. Menard's affidavit (i.e. - August 12, 2003) were more than \$55,000 and \$65,000, respectively.

Although the 3M 218 tape is primarily for automotive applications, on cross-examination, Mr. Menard stated that commercial painters will use the 218 tape when they want an extremely fine line. Furthermore, he stated that the 218 tape was, at one time, sold to retail paint stores such as Colour Your World and Sherwin Williams when they were trying to expand to the retail automotive paint market. According to Mr. Menard, the 471 tape is sold to various retail paint store chains although the principal customers for that product are those who paint vehicles.

THE APPLICANT'S EVIDENCE

In his affidavit, Mr. Young states that he is retired but that he was formerly the

President of the original applicant, Tape Specialities Limited, until 2004. Mr. Young describes the various uses for pressure-sensitive tapes and the basic features of paint-grade masking tapes. He states that the auto, marine and residential trades are separate respecting the types of tapes used and that, even within the paint trade, there are different types of tapes.

Mr. Young states that Tape Specialities Limited began manufacturing masking tape in 1982, initially using the color beige. The company developed its green tape in September of 1993 and began selling it under the trade-mark PAINTERS MATE. At that time, the company stopped selling its beige tape. Tape Specialities Limited sold primarily through distributors, retail chains and paint stores. Sales for 1995 were greater than 500,000 units, sales for 1998 exceeded one million units and 2001 sales were in excess of 2.8 million units.

Mr. Young states that there is no competition between the applicant's product and non-paint-grade tapes or paint-grade tapes for auto or marine applications. He acknowledges that Canadian Technical Tape ("Cantech") started selling green paint-grade masking tape in 1998 in association with the trade-mark PAINT PRO. In 2000, Tape Specialities Limited commenced an action against Cantech in Federal Court. However, on cross-examination, Mr. Young conceded that his company was unsuccessful in stopping Cantech from selling its green PAINT PRO product.

In his affidavit, Mr. Young states that his company sent a letter to 3M asking them to stop selling their 233+ and 2060 green tapes. However, on cross-examination, he conceded

that he was unaware of any further steps having been taken against 3M and he assumed that the two products were still being sold in Canada. In fact, at page 19 of the transcript, he acknowledges that 3M 2060 tape was sold in Sherwin-Williams stores in Canada and that 3M 233+ tape was sold in Canadian Tire stores, both prior to April of 2004.

THE GROUNDS OF OPPOSITION

As for the first ground of opposition in each case, there was an initial burden on the opponent to evidence use of its green-colored tape as a trade-mark prior to the applicant's claimed date of use which is taken to be December 31, 1993. The opponent has failed to meet that evidential burden. In the first place, the opponent's evidence does not specifically establish that 3M or 3M Canada sold green pressure-sensitive adhesive tapes prior to the applicant's claimed date of first use. In his affidavit, Mr. Menard makes general statements about 3M Canada having sold green tapes for more than 40 years or since 1980. However, he does not support those general statements with specific evidence of use.

In any event, even if the opponent had clearly established sales of green masking tape prior to December 31, 1993, there is nothing in the evidence to suggest that purchasers at that time recognized the color green for a roll of masking tape as a trade-mark claimed and used by the opponent or its subsidiary 3M Canada. The color green for any roll of tape is an inherently extremely weak trade-mark and there is not even any evidence of product literature or labelling in which the opponent notified the public of its claim that the color green was its trade-mark. Thus, on two counts, the opponent has failed to meet its initial evidential burden respecting the first ground of opposition and it is therefore unsuccessful.

As for the second ground of opposition in each case, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the oppositions (i.e. - November 5, 2002): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

In the present case, the opponent has met its evidential burden. It has established that the third party Cantech has been selling green, paint-grade masking tape for a number of years. The opponent was able to establish that Cantech's green PAINTPRO product was available in the latter part of 2002 in stores in five different provinces. The applicant sought to characterize this evidence as merely establishing the purchase of five single rolls of tape but the geographical spread of those five sales suggests that the product was widely available at that time. Mr. Young, on cross-examination, confirmed that Cantech began selling its product in 1998 and, despite Tape Specialities Limited's efforts to halt those sales, was still selling its product as of the date of the cross-examination (i.e. - October 17, 2005).

Also of note are the sales by 3M Canada of its various green masking tapes. The Arnott affidavit establishes significant sales of the 3M 233+ tape from 1998 on. Although the primary market for this tape is automotive painting, it is nevertheless a masking tape and the applicant has not restricted its statements of wares beyond the term “masking tape.”

The Menard affidavit evidences sales of another green 3M tape, the 218 tape, which is primarily used as a masking tape in the automotive and aerospace painting markets. However, the evidence establishes that the 218 tape is also used by commercial painters. Furthermore, at one time, the 218 tape was sold through Colour Your World and Sherwin-Williams outlets, the very type of store that would sell the applicant’s product.

Mr. Menard also evidenced minor use of the 3M 2060 tape. Since it is used for lacquer painting and is sold through retail paint supply chain stores, there is an overlap in the channels of trade of the parties respecting this product. Mr. Menard also evidenced sales of several other 3M green masking tapes although they were for fairly specialized non-painting applications. Nevertheless, they are masking tapes and the applicant’s statement of wares in each case is broadly worded.

Since the opponent has met its evidential burden, it was incumbent on the applicant to show that its three trade-marks actually distinguish its green tape from those of others. The applicant’s evidence is insufficient to meet the legal burden on it. Although the applicant has evidenced not insubstantial sales of its green masking tape, sales alone are insufficient to establish distinctiveness of a mark, particularly such extremely weak marks

as the three applied for by the applicant. Given the fairly extensive sales of the Cantech PAINTPRO green product and the sales of various 3M green masking tapes, I find that the applicant's trade-marks are not distinctive of its product in Canada. Thus, the second ground of opposition in each case is successful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's applications.

DATED AT GATINEAU, QUEBEC, THIS 11th DAY OF JULY, 2008.

**David J. Martin,
Member,
Trade Marks Opposition Board.**