



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

Citation: 2013 TMOB 209
Date of Decision: 2013-12-02

**IN THE MATTER OF AN OPPOSITION
by Ebel Quarries Inc. to application
No. 1,469,908 for the trade-mark
ERAMOSA in the name of Owen Sound
Ledgerock Limited**

FILE RECORD

[1] On September 22, 2010, Owen Sound Ledgerock Limited (“OSL”) filed an application to register the mark ERAMOSA, based on use in Canada since at least as early as 1979 in association with the wares

dimensional and natural stone products for building, landscaping, masonry, tile, and paving namely wall stone, window sills, copings, treads, door sills, stone carvings and mouldings, stone tiles, stone blocks, facing stones and panels for buildings, patio stones and path slabs, paving stones, paving tiles and paving blocks.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated March 30, 2011 and was opposed by Ebel Quarries Inc. on May 30, 2011. The Registrar forwarded a copy of the statement of opposition to the applicant on June 21, 2011, as required by s.38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of the affidavits of Andrew Negus, A. Dawn Forbes, Mark Ebel, Rodney J. Gibson, Scott Howell and Carl Barfoot. The applicant's evidence consists of the affidavits of Michael I. Gauthier, Thomas Stobbe, and William Chamberlain. Both parties filed a written argument, however, neither party requested an oral hearing. Accordingly, this decision has issued without the benefit of oral submissions.

STATEMENT OF OPPOSITION

[4] The main issues are succinctly pleaded in paragraphs 3a, c, d and e of the statement of opposition, shown in full below:

a. The Application does not conform to the requirements of sub-section 30(b) of the Act. More specifically, the alleged trade-mark which is the subject of the Application has not been continuously in use in Canada as a trade-mark, in the ordinary course of trade, in association with the claimed wares for the purpose of distinguishing or so as to distinguish the wares of the Applicant from those manufactured or sold by others since the alleged date of first use claimed, namely, 1979.

c. ERAMOSIA is not registrable as it is the name, in English, of the wares in conjunction with which it is used as set out in the Application. Specifically, the word ERAMOSIA is a recognized term in the stone industry identifying a specific variety of dolomite.

d. ERAMOSIA is not registrable as it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is used or of their place of origin. Specifically, ERAMOSIA is a term widely recognized as identifying a rock formation which is particularly accessible in the Bruce Peninsula area of Ontario. The stone is recognized by its composition, colour and overall appearance.

e. The alleged trade-mark claimed in the subject Application is not distinctive as it does not actually distinguish the claimed wares of the Applicant from the wares of others, nor is it adapted so as to distinguish them. More specifically, the alleged trade-mark claimed in the subject Application is clearly descriptive of the character and quality of the wares claimed therein and/or their place of origin as set out at paragraph 3 of this Statement of Opposition. The Opponent notes that ERAMOSIA is a descriptive term common in the industry used by the Opponent and others in relation to stone and stone products of

the variety covered under the subject Application. ERAMOSA cannot distinguish the wares of the Applicant from the wares of any other party, nor has it been adapted so as to distinguish them.

OPPONENT'S EVIDENCE

Mark Ebel

[5] Mr. Ebel identifies himself as the Vice President and part owner of the opponent company. The opponent's company is located in Wiarton at the southern end of the Bruce Peninsula in Ontario, not far from the quarry operated by the applicant. Attached as Exhibit A to his affidavit is a partial copy of a 1964 report prepared by the Ontario Department of Mines. An extract from page 13 reads as follows:

Ebel Quarries are located . . . 1.8 miles west of Wiarton . . .

A seven-foot section of medium brown aphanitic thin to medium bedded Eramosa dolomite is exposed. Quarry faces worked are 2 to 3 feet in height . . . The stone is quarried by cutting the beds into rectangular blocks using portable 12- to 18-inch electric diamond saws. Stone is moved by front end fork lift trucks. The stone is cut by diamond saw or guillotine.

[6] The opponent's quarry is located on the geological formation known as the Eramosa Member. The opponent extracts and processes stone for indoor and outdoor use including pavers, copings and block stone. Clients include landscape architects, landscapers, home owners and builders.

[7] Paragraph 6 of Mr. Ebel's affidavit is shown in full below because of its probative value to the issues in this opposition:

In my 40 years of experience in the stone industry, I have become accustomed to the manner in which others in the industry use and understand the term Eramosa with respect to stone products. In the industry, when one encounters the term Eramosa the type of stone to which reference is being made is immediately understood. Landscape designers, architects and other project designers will specifically use the term Eramosa in the specifications for a particular project if that is the type of stone they want for the job. It is my understanding that other quarries and stone distributors also use the term Eramosa to describe a stone type. Attached hereto as Exhibit "D" are copies of websites

from various quarries and stone distributors showing how they use the term to describe a type of stone.

[8] Aside from Exhibit A discussed above, several other exhibits provide support for Mr. Ebel's testimony. For example, Exhibit C consists of copies of invoices from the opponent to the applicant, dated 2001 and 2002, showing the term Eramosa being used to describe blocks of stone sold to the applicant. Exhibit F is an academic paper published in 1978 by the Michigan Basin Geological Society which uses the term Eramosa to describe a certain type of stone (that is, one of the types of stones found in the area of Wiarnton).

Andrew Negus

[9] Mr. Negus identifies himself as President and CEO of Block and Stone Resource Group Inc. ("BSRG") and a former employee, from 1997 to 2008, of the applicant. BSRG operates the Bluewater Quarry in Wiarnton, Ontario where the company quarries and processes different types of limestone including Eramosa limestone. BSRG also purchases Eramosa limestone for processing from several local suppliers which Mr. Negus names in his affidavit.

[10] Mr. Negus testifies that the term Eramosa describes the geological formation called the Eramosa Member and the stone contained therein. The term is used in the marketplace to describe stone that is being marketed and sold.

[11] The remainder of his affidavit essentially references exhibits which support his testimony. For example, Exhibit A to his affidavit consists of correspondence from customers inquiring about Eramosa stone. Exhibit F consists of documents from other companies in the stone industry using the term Eramosa in a descriptive manner. Exhibit H is a Government of Ontario directory, dated 2003, of Ontario stone producers listing the type of stone they produce. Eramosa is listed as a type of stone along with, for example, black marble, limestone, and dolostone. Exhibit I is a Government of Ontario

information brochure published in 2003. The extract below is found on page 1:

The largest concentration of dimension, building and landscape stone quarries in the province is at Warton. Ontario's most recognized building stone, Eramosa Marble, is currently extracted from 13 quarries, employing over 410 area residents.

[12] Exhibit J is a geographical survey produced in 1988 by the Ministry of Northern Development and Mines of Ontario. The following excerpt is found on page 1:

The Eramosa Member is a thin-bedded dolostone which has been quarried on the Bruce Peninsula since at least the turn of the century for a wide variety of building and landscaping stone products. The main objectives of this project were to (1) geologically define the Eramosa Member, and (2) determine its regional potential as a building stone resource. Currently, a few quarries produce added-value products, such as polished tile, on a custom basis, from certain portions of the Eramosa Member.

[13] Mr. Negus' interest in this opposition is stated at paragraph 12 of his affidavit:

If Owen Sound Ledgerrock Limited were granted a trade-mark registration for the term Eramosa in association with stone products, it would have a harmful effect not only on the business of BSRG, but also other businesses involved in or related to the stone industry who use the term as a stone description. If BSRG were precluded from using the word Eramosa to describe our products we would be severely prejudiced because that is the term that is commonly used in the industry to describe a type of stone.

A. Dawn Forbes

[14] Ms. Forbes identifies herself as a co-owner of a quarry not far from the opponent's quarry. Her evidence parallels Mr. Negus' evidence. She and her customers use the term Eramosa to describe a particular type of stone extracted from her quarry. She explains that the term "Eramosa" is the name of a particular type of rock formation in Southwestern Ontario from which stone products are extracted. Exhibit materials attached to her affidavit corroborate her testimony.

Carl Barfoot

[15] Mr. Barfoot identifies himself as the President of a quarry operating in Warton, Ontario not far from the quarry operated by the applicant. At paragraphs 5 and 6 of his

affidavit Mr. Barfoot explains, with some precision, that the term Eramosa is used geologically to identify a distinct band of dolomite [a rock consisting mostly of calcium magnesium]:

5. Eramosa is found in the Bruce Peninsula in the Guelph unit of what is known as the middle Silurian stone formation . . . in some places there is an additional formation which is known as the Eramosa unit. There are four (4) distinct stone types located in this formation:

- (a) Brown Eramosa Unit;
- (b) Black Eramosa Unit;
- (c) Dark Brown Dolostone; and
- (d) Light Brown Dolostone.

6. Those stone types are differentiated by colour, lamination and grain size. The Eramosa unit of this deposit . . . is the mainstay of most quarries in the Bruce Peninsula region. The Eramosa portion of this deposit is also known as Eramosa marble. This includes a distinct band of stone that is eight (8) to eleven (11) feet thick with no interbedding of other stone types. This stone is highly laminated and fine grained and yields all types of stone products depending on the separation of laminations which is determined mostly by how far down the Eramosa unit is in any given quarry. . .

[16] At paragraphs 7 and 8 of his affidavit Mr. Barfoot further explains that:

7. The term Eramosa is widely used within the industry to describe a particular type of stone. This allows stone buyers to know that the products they buy are from this unique deposit of stone, regardless of how the stone was later processed or finished and regardless of the business that quarried the products. Any customer that requests Eramosa could be requesting anyone of 15 to 20 different products, but those products are all made from the distinct Eramosa band of stone.

8. . . . Eramosa is used in the industry to define the material the product is made of, not what they are made into. If businesses in the industry are unable to use the term Eramosa, those businesses will not be able to adequately describe the raw materials their end products are made of. This is important for all those in the industry. All products are identified by the band of stone that those products are made from. This identification is crucial for installers, architects, landscape and building contractors . . .

(emphasis added)

Rodney J. Gibson

[17] Mr. Gibson identifies himself as the President of a quarry operating in Wiarton. His evidence corroborates the evidence of Messrs. Ebel, Negus, Barfoot and Ms. Forbes. I do not see that anything is to be gained by a detailed review of his evidence.

Scott Howell

[18] Mr. Howell identifies himself as the Sales Manager of a quarry operating in Wiarton. His evidence corroborates the evidence of Messrs. Ebel, Negus, Barfoot, Gibson and Ms. Forbes. I do not see that anything is to be gained by a detailed review of his evidence.

APPLICANT'S EVIDENCE

Thomas Stobbe

[20] Mr. Stobbe identifies himself as the majority owner and President of the applicant company, previously owned by his father. Mr. Stobbe began to work full time for the applicant in the early 1980s, at which time there were only two other businesses [the opponent and the quarry now operated by Mr. Gibson] quarrying stone from the Guelph formation. Those businesses were only quarrying upper layers of stone and they used the terms "dolostone" or "dolomite," that is, technical geological names, to describe the stones extracted at their sites.

[21] In the early 1980s Mr. Stobbe began to experiment with polishing stone. It turned out that a certain band of dolostone was aesthetically pleasing when polished. At first this new polished stone was called "Ground Brown" then changed to "Eramosa Marble" or "Eramosa." Mr. Stobbe testifies that he "coined this term by truncating the term 'Eramosa Member' used by Geologists[sic] to describe a geological formation within the Guelph Formation." The difficulty was that the stone suitable for polishing was found at 6 to 8 feet below ground rather than at ground level.

[22] Until the mid 2000s the applicant was the only company using the mark ERAMOSIA because (1) other quarries were not quarrying deep enough to obtain

suitable stone, (2) no other quarry had equipment capable of quarrying large blocks, and (3) no other quarry had the polishing capabilities to handle medium or large scale products.

[23] Mr. Ebel was employed with the applicant for a period of about 9 years from the late 1970s to the mid 1980s and again from March 1998 to September 1999. It was not until Mr. Ebel left the applicant for the second time that the opponent began to use the mark ERAMOSIA to identify stone extracted at the opponent's quarry.

[24] From my own review of the exhibit material attached to Mr. Stobbe's affidavit, it is not entirely clear when the applicant used the term Eramosa in a trade-mark sense and when the term was used in a descriptive sense to identify stone extracted from a particular layer in a particular geological formation.

Michael I. Gauthier

[25] Mr. Gauthier identifies himself as the Human Resources Manager for the applicant company. A substantial portion of his testimony reiterates Mr. Stobbe's evidence. Mr. Gauthier further testifies, at paragraph 6 of his affidavit, that:

There is no significant documentation prior to 2006 that shows Eramosa as being a trade mark associated with architectural or ornamental (polished) stone products by any stone producer other than Owen Sound Ledgerock Limited.

I note that Mr. Gauthier's affidavit was sworn in April 2012. It begs the question why Mr. Gauthier did not address the circumstances that existed between 2006 and 2012.

[26] According to Mr. Gauthier, the opponent did not use the term Eramosa until "the past 5 or 10 years," that is, until after viewing the applicant's success using the trade-mark ERAMOSIA.

[27] From my own review of the exhibit material attached to Mr. Gauthier's affidavit, it is not entirely clear when the applicant used the term Eramosa in a trade-marks sense

and when the term was used in a descriptive sense to identify stone extracted from a particular layer in a particular geological formation.

[28] Mr. Gauthier further asserts that Mr. Negus only began “to use the term Eramosa subsequent to his departure” from the applicant.

William Chamberlain

[29] Mr. Chamberlain identifies himself as a former employee of the opponent, from 1984 to 1999. His testimony is that, as of September 1999, the opponent had not quarried from the deeper layers that would be considered Eramosa limestone.

FIRST GROUND OF OPPOSITION

Does the Application Comply with s.30(b)?

[30] In my view the evidence of record supports the opponent’s submissions regarding s.30(b) found at pages 16 – 18 of its written argument, shown below:

73. The Applicant's evidence establishes that it was not until "the early 1980s" (i.e. after the claimed date of first use of 1979) that the Applicant through Mr. Stobbe himself allegedly "began attempting to polish" a certain type of stone to determine if it was "aesthetically pleasing".⁸² Since Mr. Stobbe did not start full time with the Applicant until May 1982, it can be safely assumed that these attempts did not take place until sometime during or after May 1982 at the earliest. According to Mr. Stobbe, their efforts "'in the early 1980s" showed that it was suitable to polish and at that point (i.e. sometime during or after 1982[sic]) the Applicant began calling the product "Ground Brown".⁸³ It was not until later that the Applicant began to call this product "Eramosa".⁸⁴

74. It is clear from Mr. Stobbe's evidence that the Applicant had not used "Eramosa" as a trade-mark with the goods in the Application since the 1979 claimed date of first use. The evidence of Mr. Gauthier, the Applicant's Sales and Marketing Manager, corroborates Mr. Stobbe's evidence to the extent that he consistently refers to the "early 1980s" (and not 1979) when discussing the Applicant's first use of "Eramosa" to describe a type of stone.⁸⁵

75. . . . The only evidence on record with respect to the alleged date of first use clearly contradicts the Applicant's claim in the Application that it first began using the mark in 1979. The Applicant's evidence shows that it was not until well after 1979 that it even "coined" the term "Eramosa" so it obviously could not have been used

in a trade-mark sense as of the date claimed by the Applicant in the Application.

[31] The opponent therefore succeeds on the ground of opposition alleging non-compliance with s.30(b) of the *Trade-marks Act*. It is therefore not necessary to consider the remaining grounds of opposition.

[32] I would add, however, that the opponent would likely have succeeded on the ground of opposition alleging that the applied-for mark ERAMOSIA was not distinctive of the applicant's wares. In this regard, in my view the weight of the evidence shows that Mr. Ebel's testimony at paragraph 7 above was factually correct as of the material date May 30, 2011. Further, the applicant has not shown that its mark ERAMOSIA had, at any material time, acquired sufficient distinctiveness for the applicant to claim proprietary rights to the mark. The term Eramosa was not distinctive of the wares of any one trader in stones as of May 30, 2011.

DISPOSITION

[42] In view of the foregoing, the application is refused. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office