



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

Citation: 2013 TMOB 117
Date of Decision: 2013-06-28

**IN THE MATTER OF AN OPPOSITION
by Ecco Heating Products Ltd. to
application No. 1,446,089 for the trade-
mark SPIRAL ELBOWS in the name of
606381 Alberta Ltd.**

[1] On July 24, 2009, 606381 Alberta Ltd. (the Applicant) filed an application to register the trade-mark SPIRAL ELBOWS (the Mark) based on proposed use in Canada in association with the following wares and services:

Wares: Elbows for use in commercial hvac systems, commercial heating and cooling systems, ventilation, exhaust, dust, gas or fume collection systems.

Services: Custom manufacturing of elbows for use in commercial hvac systems, commercial heating and cooling systems, ventilation, exhaust, dust, gas or fume collection systems.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 27, 2010.

[3] On November 4, 2010, Ecco Heating Products Ltd. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Pursuant to sections 38(2)(a) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), at the filing date the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the wares and services because “it could not but have been aware that ‘spiral elbows’ is a generic term widely used in the HVAC systems manufacturing trade”.

- Pursuant to sections 38(2)(b) and 12(1)(b) of the Act, the Mark is not registrable because the term “spiral elbows” is clearly descriptive or deceptively misdescriptive of the character or quality of the wares and services or of the conditions of or the persons employed in their production or of their place of origin.
- Pursuant to sections 38(2)(b) and 12(1)(c) of the Act, the Mark is not registrable because the term “spiral elbows” is the name in English of the wares.
- Pursuant to sections 38(2)(d) and 2, the Mark is not distinctive because it is not capable of distinguishing the wares and services from those of others, particularly from spiral elbows manufactured and sold by many other entities in the HVAC trade, nor is it adapted to so distinguish them.
- Pursuant to sections 38(2)(d) and 2, the Mark is not distinctive because it has not been used by the Applicant for the purpose of distinguishing the wares from the wares and services of others in the marketplace.

[4] The Applicant served and filed a counter statement in which it denied the Opponent’s allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed two affidavits of Jennifer Marles, a lawyer employed by the Opponent’s agent (one dated May 13, 2011 filed as the Opponent’s evidence in chief and one dated October 18, 2011 filed as the Opponent’s evidence in reply), as well as an affidavit of Lauris Krisch, the Manufacturing Engineering Manager for ECCO Manufacturing, a division of the Opponent. Only Mr. Krisch was cross-examined on his affidavit and the associated transcript forms part of the record.

[6] In support of its application, the Applicant filed the affidavit of Henry Warkentin, a Director for the Applicant. Mr. Warkentin was not cross-examined on his affidavit.

[7] Both parties filed written arguments and were represented at an oral hearing.

Onus and Material Dates

[8] 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].

[9] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(b) - the filing date of the application [see *Fiesta Barbeques Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)];
- sections 38(2)(b)/12(1)(c) - the date of my decision [see *Park Avenue Furniture Corp v Wickes/Simpsons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Non-registrability Grounds of Opposition

Section 12(1)(c) of the Act – Is the Mark the name of the Wares in English?

[10] The Opponent submits that in order to be successful under a section 12(1)(c) ground of opposition, it is not necessary to establish that the Mark is **primarily** the name of the wares [see *Saputo Dairy Products Canada GP v Grande Cheese Co* (2011), 98 CPR (4th) 459 (TMOB)]. In other words, the name need not be “recognized throughout a country or universally as the name of the wares in a particular language” [see *Jordan & Ste-Michelle Cellars Ltd v Andres Wines Ltd* (1986), 11 CPR (3d) 252 (TMOB)]. It is sufficient merely for the Mark to be the name of the associated wares. I agree with the Opponent’s submissions regarding the scope of section 12(1)(c) of the Act.

[11] That being said, in order to meet its evidential burden, it is incumbent on the Opponent to evidence that the term “spiral elbows” has been accepted in the English language for the wares “elbows for use in commercial hvac systems, commercial heating and cooling systems, ventilation, exhaust, dust, gas or fume collection systems” [see *Boyer Candy Co v Hershey Canada Inc* (2001), 21 CPR (4th) 257 (TMOB); *Airos Systems Ltd v Windsurfing International, Inc* (1983), 75 CPR (2d) 74 (TMOB)].

[12] At the oral hearing the Opponent provided me with some basic terminology that I find to be of assistance in reviewing the evidence:

- the term “ductwork” refers to pipes that run through the walls and ceilings of buildings and serve to transfer heating or air-conditioning through buildings;
- the term “elbow” refers to bent pieces of ductwork used to attach horizontal ceiling ductwork to vertical wall ductwork; and
- the term “spiral pipe” refers to pipe with a continuous helical seam.

[13] The Applicant did not specifically object to this general terminology at the oral hearing.

[14] The Opponent submits that the evidence demonstrates that the Applicant, the Opponent and third parties in the HVAC field all use the term “spiral elbows” to refer to elbows for use in commercial HVAC systems. Specifically, in his affidavit Mr. Krisch states that historically the term spiral elbows has been used in the HVAC industry to refer to an elbow used to connect two pieces of spiral pipe (the “classical definition”). Mr. Krisch also explains that due to the recent development of a technology which enables the manufacture of an elbow from spiral pipe, “spiral elbows” has a new meaning as well (the “new definition”). Ultimately, Mr. Krisch states that regardless of which definition is adopted both refer to elbows which can be used to connect pieces of spiral pipe and thus are functionally equivalent.

[15] Both at the oral hearing and in their written arguments, the parties focused their submissions on these two definitions for the term “spiral elbow”. I am satisfied that the evidence demonstrates that both definitions refer to functionally equivalent products. Furthermore, I am satisfied that, regardless of which definition is adopted, the evidence supports a finding that the term “spiral elbows” is used to refer to elbows that are used in the HVAC industry and thus the Mark is contrary to section 12(1)(c) of the Act with respect to the Wares. I will discuss the evidence supporting this finding in the paragraphs that follow.

[16] The Opponent’s strongest evidence comes from the Applicant’s own website (Krisch affidavit, Exhibit D). While it is true that printouts from third party websites are generally considered hearsay and cannot be relied upon as evidence of the truth of their contents, I am satisfied that some weight may be placed on Exhibit D as the website belongs to the Applicant and the Applicant had the opportunity to respond to it if there was a concern as to the content.

[17] The Opponent submits that the Applicant uses the term “spiral elbows” in a generic or descriptive sense on its website. In particular, “spiral elbows” are listed as a product category in the Applicant’s listing of “Products” alongside other product categories such as “round fittings”, “square fittings”, “oval fittings”, “miscellaneous” and “specialty”. The Opponent also points to other generic uses of the term on the Applicant’s website (e.g. “the spiral elbow offers a significant reduction in labour costs...”; “one of the key benefits of the spiral elbow is the labour savings...”; “the spiral elbow is made using the same seam as spiral pipe”; see Krisch affidavit, Exhibit D). I am satisfied that this evidence supports a finding that the term “spiral elbows” is the name of the wares.

[18] In his affidavit Mr. Krisch states that the Opponent also uses the term “spiral elbows” to refer to a type of elbow that it sells. In support of this statement Mr. Krisch provides a printout of an advertisement from the Opponent’s website (Exhibit E) which clearly displays the term “spiral elbows” being used to refer to a type of elbow used in the HVAC industry. I am satisfied that the evidence supports a finding that the Opponent also uses the term “spiral elbows” as the name of a type of elbow used in the HVAC industry.

[19] The Opponent also provides printouts from third party websites which it submits show third parties using the term “spiral elbows” as a generic term for a type of elbow used in the HVAC field (Exhibits A, B, C, E). Of these websites the Opponent highlighted Exhibit A which is the website of a manufacturer of a “spiral elbow line”. The Opponent submitted that this is a US manufacturer of equipment used to manufacture spiral elbows from spiral pipe. The Opponent submits that both the Opponent and the Applicant have purchased equipment from this manufacturer. The Opponent submitted that Exhibit B to the Krisch affidavit (a copy of an online article from a publication entitled SNIPS) supports a finding that the Applicant had purchased this equipment in June 2009.

[20] As I indicated previously, evidence from third party websites is considered hearsay and I am not willing to rely on it as evidence of the truth of the contents thereon [see *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FCTD), reversed (2008), 64 CPR (4th) 431 (FCA)]. Thus the Opponent’s submissions regarding third party use of the term “spiral elbows” which are based on this hearsay evidence are of limited importance.

[21] That being said, I remain satisfied that the Opponent has met its evidential burden based on the clear evidence of generic use of the term “spiral elbows” by both parties to refer to elbows used in the HVAC industry. The onus now shifts to the Applicant to demonstrate that the Mark is registrable.

[22] The Applicant submits that Mr. Warkentin’s evidence is sufficient to support a finding that the Mark is not a generic term used in the HVAC industry to refer to a type of elbow. In his affidavit, Mr. Warkentin states that he has been working in the HVAC industry for 40 years and the authoritative voice in the industry is the Sheet Metal and Air Conditioning Contractors’ National Association (SMACNA). Mr. Warkentin states that SMACNA does not recognize a category of elbow known as a “spiral elbow”. He further states that the term “spiral elbow” has no meaning to SMACNA members apart from the promotional activities of the parties with respect to their respective products.

[23] Firstly, I note that Mr. Warkentin’s statements about SMACNA constitute hearsay. The Applicant has not provided any evidence or submissions to explain why a representative from SMACNA could not have provided this evidence directly. I am not satisfied that it was necessary for Mr. Warkentin to provide this evidence

[24] Even if I was willing to accept Mr. Warkentin’s statement on this matter, I note that the only supporting documentation he provides is an “excerpt from the handbook which illustrates the categories of elbows that are recognized” (Exhibit B). This document is undated and is merely titled “FIGURE 3-4 ROUND DUCT ELBOWS - HVAC Duct Construction Standards Metal and Flexible – Third Edition”. Nowhere in this document does it indicate that this is an exhaustive list of the types of elbows recognized by SMACNA.

[25] At the oral hearing, the Applicant submitted that on cross-examination Mr. Krisch admitted that it would not be sufficient for a consumer to merely request a “spiral elbow” from a retailer. Rather, consumers would be required to provide further specifications in order to obtain the desired product. It may be true that further specifications are required when placing an order for elbows. However, I do not consider this sufficient to avoid contravention of section 12(1)(c) of the Act. As an analogy, I note that the word “screwdriver” refers to a type of tool used by a handyman. While it is true that when purchasing a screwdriver at a hardware store a handyman

would be required to specify the type (i.e. Phillips, Robertson, etc.) in order to acquire the exact type of screwdriver they desire, this does not alter the fact that the product the consumer is seeking to purchase is a screwdriver (i.e. the name of the product). Thus, the trade-mark SCREWDRIVER would not be registrable for use with screwdrivers, contrary to section 12(1)(c) of the Act.

[26] Furthermore, I note that the wares are defined relatively broadly as “elbows for use in commercial hvac systems, commercial heating and cooling systems, ventilation, exhaust, dust, gas or fume collection systems”. The exact details of the elbows covered by the Wares (for example made from spiral pipe or not made from spiral pipe) are not contained in the specification of wares.

[27] Based on the foregoing, I am not satisfied that the Applicant has met its onus of establishing that the Mark is registrable.

[28] At the oral hearing I pointed out that, as pleaded, the ground of opposition based on section 12(1)(c) appears to relate only to the wares and thus if successful would only result in refusal of the application with respect to the wares. The Opponent submitted that as the Services are merely the manufacture of the wares the ground should apply to both. I disagree. I am of the view that, as pleaded, this ground is restricted to the wares. Thus, this ground of opposition is successful with respect to the wares, only. That said, as pointed out by the Opponent at the oral hearing, the remaining grounds of opposition are clearly based on the wares and the services and thus if at least one other ground of opposition is successful the application as a whole will be refused.

Section 12(1)(b) of the Act – Is the Mark clearly descriptive or deceptively misdescriptive of the character or quality of the Wares and Services?

[29] At the oral hearing, the Opponent referred me to the following passage from the recent judgment of the Federal Court of Appeal in *Ontario Teachers’ Pension Plan Board v Canada* (2012), 99 CPR (4th) 213 (FCA) which clearly summarizes the test to be applied when assessing whether a trade-mark violates section 12(1)(b) of the Act [*Ontario Teachers’*, *supra* at para 29]:

It is trite law that the proper test for a determination of whether a trade-mark is clearly descriptive is one of first impression in the mind of a normal or reasonable person. ... One should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the immediate impression created by the trade-mark in association with the wares or services with which it is used or proposed to be used. In other words, the trade-mark must not be considered in isolation, but rather in its full context in conjunction with the wares and services.

[30] Further, I note that “character” means a feature, trait or characteristic of the wares and services and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[31] As a preliminary matter I note that any comments made below with respect to the wares apply equally to the services which are merely the custom manufacture of the wares.

[32] In his affidavit, Mr. Krisch makes the sworn statements that “conventionally, in the HVAC field, the term ‘spiral elbow had referred to an elbow that is used to join two pieces of spiral pipe” (para 6); and “[the Opponent] and other companies in the HVAC industry now use the term ‘spiral elbow’ to generically describe spiral elbows made using this new technology [the spiral elbow is made from a piece of spiral pipe]” (paras 7 and 8). Mr. Krisch has worked in the HVAC field since 1987 and makes these statements based on his own knowledge of the industry. That being said, I am unable to place any weight on these opinion statements made by Mr. Krisch as he is biased by virtue of his employment by the Opponent.

[33] The Opponent also points to statements made by the Applicant in the prosecution of its US application for the trade-mark SPIRAL ELBOWS (Exhibit A to the first Marles affidavit). In the context of the US prosecution, the Applicant admitted that the Mark could be considered descriptive of the wares and therefore asked that it be registered on the supplemental register. The supplemental register allows for a second tier of trade-mark registrations, including descriptive trade-marks. The Opponent asks that I take this admission of the descriptiveness of the Mark as being an admission against interest in the present proceeding.

[34] At the oral hearing, the Applicant submitted that I should not take these statements as admissions against interest in light of the differences in the law and practice before the USPTO and the Canadian Intellectual Property Office. I agree with the Applicant and thus I will not treat

the statements made by the Applicant in the context of the prosecution of its US application as admissions against interest in the present proceeding.

[35] The Opponent submits that even if the term “spiral elbows” is not considered to be a recognized dictionary word, it is still a combination of two terms with clearly settled meanings in the HVAC field. Specifically, “spiral pipe” is a pipe made with a continuous helical seam; “elbow” is a bent piece of ducting used to join two other pieces of ducting (Krisch affidavit, paragraphs 4 and 5). The Applicant does not appear to dispute these definitions. Hence the term “spiral elbow”, as a composite term, clearly describes an elbow made from a piece of spiral pipe. The Opponent submits that a composite word comprising two words can still be clearly descriptive [see *A Lassonde Inc v Canada (Registrar of Trade-marks)* (2000), 5 CPR (4th) 517 at paras 35-37 (FCTD); aff’d 15 CPR (4th) 384 (FCA)].

[36] I may refer myself to a dictionary to determine the meaning of words [see *Insurance Co. of Prince Edward Island v Prince Edward Island Insurance Co.* (1999), 2 CPR (4th) 103 (TMOB)]. I note that the *Canadian Oxford English Dictionary* includes the definition “a short piece of pipe bent at a right angle” for the word “elbow”. This definition clearly supports the Opponent’s evidence that the word “elbow” refers to a bent piece of ducting used to join two other pieces of ducting. The word “spiral” includes the definition “winding continuously along or as if along a cylinder, like the thread of a screw” which again supports the Opponent’s evidence regarding spiral pipe.

[37] As with the submissions made in support of the ground of opposition based on section 12(1)(c) of the Act, the parties focused on the issue of the two definitions for SPIRAL ELBOWS (i.e. the classical definition being an elbow used to join two pieces of spiral pipe and the new definition being an elbow manufactured from a single piece of spiral pipe). The Applicant submits that the presence of more than one definition for a term necessarily means that it cannot be found to be contrary to section 12(1)(b) of the Act. By contrast, the Opponent points out that both definitions are clearly descriptive or deceptively misdescriptive of the character or quality of the wares and services. Furthermore, the Opponent reiterated the fact that the definitions relate to products which are functionally equivalent (i.e. elbows which can be used to connect spiral pipe).

[38] Finally, I note that the Federal Court of Appeal recently reaffirmed the importance of applying a “common sense approach” when assessing whether a mark is contrary to section 12(1)(b) of the Act. In other words, one must consider not only the evidence of record but also have regard to common sense [see *Ontario Teachers’*, *supra*].

[39] In light of my finding on the section 12(1)(c) ground of opposition and the Opponent’s submissions regarding the meaning of the component words, along with my review of the *Canadian Oxford English Dictionary*, and an application of the common sense approach, I am satisfied that the Opponent has met its burden of showing that the Mark is clearly descriptive of the character or quality of the wares and services at the earlier material date. I am not satisfied that the Applicant has met its onus of establishing that the Mark is registrable.

[40] Based on the foregoing, the ground of opposition based on section 12(1)(b) of the Act is also successful.

Remaining grounds of opposition

[41] As I have already refused the application under two grounds, I will not address the remaining grounds of opposition alleging non-compliance with section 30(i) and non-distinctiveness.

Disposition

[42] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office