



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

Citation: 2015 TMOB 136
Date of Decision: 2015-08-04

IN THE MATTER OF AN OPPOSITION

3M Company	Opponent
and	
Integrity Supply Incorporated	Applicant
1,577,869 for the trade-mark THERMSULATE	Application

Background

[1] On May 16, 2012, the Applicant filed application No. 1,577,869 for the trade-mark THERMSULATE (the Mark).

[2] The application is based upon proposed use in association with “polyurethane chemicals for producing foam insulation and air sealing for residential and commercial buildings; polyurethane, acrylic and silicone coatings for use in the construction industry; insulation, namely, spray on foam insulation and foam insulation for use in building and construction”.

[3] The Opponent is the owner of four registrations for the trade-mark THINSULATE: registration No. TMA246,164, which covers “thermal insulation made of non-woven synthetic fibers for use in clothing, sleeping bags, and the like”; registration No. TMA521,799, which covers “acoustical insulation, namely, acoustical insulation for buildings, motor vehicles, water craft, appliances and audio speakers”; registration No. TMA603,314, which covers “comforters,

bed sheets, mattress covers, pillows, pillow covers, and bed blankets; socks”; and registration No. TMA602,106, which covers “clothing, namely, jackets, coats, vests, pants, snowsuits, ski suits, mittens; footwear namely shoes and boots; gloves and headgear namely, hats and caps”.

[4] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* of January 2, 2013 and on June 3, 2013 the Opponent opposed it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based upon sections 12(1)(d), 16(3)(a) and 2 (distinctiveness) of the Act.

[5] The Applicant filed a counterstatement on August 30, 2013, denying each of the allegations set out in the statement of opposition.

[6] On October 8, 2013, the Opponent requested leave to file an amended statement of opposition in order to correct a minor typographical error and leave was granted.

[7] As evidence in support of its opposition, the Opponent filed the affidavit of Aleem Abdulla, sworn December 27, 2013 (the Abdulla affidavit). Mr. Abdulla was not cross-examined.

[8] As evidence in support of its application, the Applicant filed the affidavit of Robert Gray, affirmed April 21, 2014 (the Gray affidavit) and the affidavit of Terri Beckman, sworn April 22, 2014 (the Beckman affidavit). Neither of the affiants was cross-examined.

[9] Both parties filed a written argument. No hearing was held.

Onus

[10] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Analysis

Non-entitlement – Section 16(3)(a)

[11] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of its prior use of its THINSULATE trade-marks. There is an initial burden on the Opponent in respect of this ground to evidence use of its trade-marks prior to the filing date of the application for the Mark and to establish that it had not abandoned its trade-marks as of the date of advertisement of the Applicant's application [section 16(5)]. The only evidence the Opponent has provided in this case is the Abdulla affidavit, which consists of certified copies of the Opponent's registrations and print-outs from the Opponent's website which purportedly provide information about the nature of the Opponent's THINSULATE brand sound insulation. The print-outs are dated December 23, 2013, which is well after the material date for assessing this ground of opposition. Furthermore, the print-outs do not constitute evidence of use in association with goods within the meaning of section 4 of the Act. Since the Opponent has not provided any evidence of use of its trade-marks, this ground of opposition is dismissed.

Non-distinctiveness – Section 2

[12] The Opponent has pleaded that the Mark does not distinguish and is not adapted to distinguish the Applicant's goods from those of the Opponent, in association with which it has used and registered its THINSULATE trade-marks.

[13] In order to satisfy its initial burden with respect to a distinctiveness ground of opposition, an opponent's evidence must show that its trade-marks had become known sufficiently as of the commencement of the opposition to negate the distinctiveness of the applied-for trade-mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC) and *Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[14] As previously discussed, in this case, the Opponent has not filed sufficient evidence to enable me to conclude that its trade-marks have become known to any extent. It has therefore failed to meet its initial burden in respect of this ground.

[15] Accordingly, this ground of opposition is also dismissed.

Non-registrability - Section 12(1)(d)

[16] The Opponent has pleaded that the Mark is not registrable because it is confusing with its THINSULATE trade-marks (registration Nos. TMA246,164; TMA521,799; TMA603,314; and TMA602,106).

[17] The material date to assess a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[18] The Opponent has filed copies of its registrations as part of its evidence [see paras 2 to 5 and Exhibits “A”-“D” of the Abdulla affidavit] and I have exercised my discretion to check the register to confirm that they are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial burden with respect to this ground. As the Opponent’s evidentiary burden has been satisfied, the Applicant must establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s THINSULATE trade-marks.

[19] I find that registration No. TMA521,799, which covers “acoustical insulation...for buildings...” represents the Opponent’s best chance of success, as the goods which are covered by the Opponent’s other registrations all primarily relate to clothing and linen related goods or insulation for such goods. I will therefore focus on this registration in my confusion analysis.

[20] The test for confusion is one of first impression and imperfect recollection. 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[21] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 goods, 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. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Section 6(5)(a) – the inherent distinctiveness and the extent to which the marks have become known

[22] Both of the parties' trade-marks consist of coined terms and possess some degree of inherent distinctiveness. The distinctiveness of a trade-mark may be further increased through promotion or use.

[23] As previously discussed, the Opponent has not filed any evidence of use of its trade-mark and its evidence does not enable me to draw any meaningful conclusions with respect to the extent to which its trade-mark has become known, if at all.

[24] Similarly, the application for the Mark is based upon proposed use in Canada and although the Gray affidavit provides some information about the nature of the Applicant's business and goods and includes photographs of goods bearing the Mark [see paras 2 to 8 and Exhibit "A"], it is silent with respect to whether the Applicant has actually offered for sale or sold any products bearing the Mark. Thus, I am also unable to conclude that there has been any use of the Mark within the meaning of section 4 of the Act.

[25] Mr. Gray also does not indicate whether there has been any advertising or promotion of the Applicant's goods in association with the Mark. As Exhibit "B" to his affidavit, Mr. Gray has attached a National Research Council ("NRC") Evaluation Listing issued by the Canadian Construction Materials Centre ("CCMC"). According to Mr. Gray, the listing displays trade-marks for certain Spray Applied Rigid Polyurethane Foam Insulation, including the Mark.

[26] Contrary to what the Applicant has submitted, I do not find this listing to constitute use of the Mark within the meaning of section 4 of the Act. Moreover, although Mr. Gray states that manufacturers, specifiers, regulators, architects, contractors and engineers use these evaluations, there is no evidence regarding how many have actually do so and in particular, how many have

accessed the particular evaluation listing which shows the Mark [Gray affidavit, paras 6 to 8, Exhibits “B” and “C”].

[27] In view of the foregoing, I do not find that this factor, which is a combination of the inherent distinctiveness of the marks and the extent to which they have become known, favours either party.

Section 6(5)(b) – the length of time each has been in use

[28] As I am only able to infer *de minimus* use from the existence of the Opponent’s registration [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430] and the Applicant has not provided any definitive evidence that the Mark has been used, I do not find that this factor significantly favors either party.

Sections 6(5)(c) and (d) – the nature of wares, services or business and trade

[29] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods in the application for the Mark and the statement of goods in the Opponent’s registration that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. Those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. Evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[30] The application for the Mark covers “polyurethane chemicals for producing foam insulation and air sealing for residential and commercial buildings; polyurethane, acrylic and silicone coatings for use in the construction industry; insulation, namely, spray on foam insulation and foam insulation for use in building and construction”.

[31] The Opponent's registration covers "acoustical insulation, namely, acoustical insulation for buildings, motor vehicles, water craft, appliances and audio speakers".

[32] Attached to the Abdulla affidavit are print-outs from the Opponent's website which Mr. Abdulla states have been provided in an effort to identify information about its THINSULATE brand of sound insulation [Abdulla affidavit, para 4, Exhibit "E"]. It has been held that print-outs from websites cannot be relied upon as truth of their contents [*Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FCTD), rev'd on other grounds (2008), 64 CPR (4th) 431(FCA)]. I note that the print-outs are of little assistance to the Opponent in any event, as they contain little more information than what is already contained in the statement of goods in the Opponent's registration.

[33] There is some information regarding the nature of the Applicant's goods in the Gray affidavit. According to Mr. Gray, the Applicant's products are used for heat insulation purposes and the Applicant does not sell any products related to sound or acoustical insulation [Gray affidavit, paras 3 to 5; Exhibit "A"]. The Applicant's product comes in a 45 gallon drum and is a two part system. It is pumped to a proportioner, mixed in a gun and then sprayed and applied [Gray affidavit, para 3].

[34] In support of these statements, Mr. Gray relies upon the NRC Evaluation Listing and information about the CCMC, which are attached as Exhibits "B" and "C" to his affidavit. According to Mr. Gray, the listing displays trade-marks for Spray Applied Rigid Polyurethane Foam Insulation, including the Mark and it indicates that it is used for thermal insulation purposes. There is no mention that it is for acoustical or sound purposes [Gray affidavit, paras 6 to 8; Exhibits "B" and "C"].

[35] While the parties' goods may be used for different purposes (i.e. heat insulation versus sound insulation), the fact remains that their goods are both insulation products and they are both intended for use in buildings. In addition, I note that the statement of goods in the application for the Mark does not specify that the Applicant's insulation products are for heat insulation purposes. I therefore find it reasonable to conclude that the parties' goods are of a similar nature and in the absence of any evidence to the contrary, I also find it reasonable to conclude that the parties' channels of trade would be similar.

Section 6(5)(e) – the degree of resemblance between the trade-marks

[36] In *Masterpiece Inc v Alavida Lifestyles Inc et al* [supra], the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the parties' trade-marks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC), at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)]. If the parties' trade-marks do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion.

[37] In *Masterpiece*, the Supreme Court observed that even though the first word of a trade-mark may be the most important, for the purpose of distinctiveness [*Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)], the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[38] In the present case, both parties' trade-marks consist of single coined words and I do not find that any one part of either of them stands out as being more striking or unique. The latter part of the parties' marks may be recognized as being a derivative of "insulate" and due to the presence of THIN and THERM which appear in the dominant first positions of the parties' trade-marks, I do not find there to be a particularly high degree of resemblance between them. In my view, the first part of the marks causes them to look and sound quite different and to suggest different ideas. In this regard, I note that THIN is an ordinary dictionary word which is used to describe the thickness of something and THERM, if anything, would likely be seen as being a derivative of "thermal", which suggests the idea of heat [*Canadian Oxford English Dictionary* (2d)]. I can take judicial notice of dictionary definitions [see *Envirodrive Inc v 836442 Alberta Ltd.*, 2005 ABQB 446 (CanLII); *Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB.) at para. 29].

Surrounding Circumstance

[39] As an additional surrounding circumstance, the Applicant has submitted state of the register evidence to show that SULATE is a component of other trade-marks which currently co-

exist on the trade-mark register for various insulation related products [see Beckman affidavit, paras 2 to 7 and Exhibits “A” to “F”].

[40] While state of the register evidence can be useful to assess the commonality or distinctiveness of a trade-mark or portion of a trade-mark in relation to the register as a whole, it is only relevant insofar as inferences may be made with respect to the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[41] Ms. Beckman located only six trade-marks containing SULATE on the register and not all of them are associated with goods which are similar to those of the parties [Beckman affidavit, paras 2-8, Exhibits “A” to “F”].

[42] In my view, this is insufficient to make any inferences about the state of the marketplace.

Conclusion on the Likelihood of Confusion

[43] I am of the view that the differences between the trade-marks in the present case are sufficient to avert confusion. There is no evidence to establish that either of the parties’ trade-marks has been used or become known to any extent. Although there is some overlap in the nature of the parties’ goods and services and channels of trade, I find that the differences between the trade-marks in appearance, sound and suggested idea are sufficient to avoid any reasonable likelihood of confusion. Having considered all of the surrounding circumstances, I have therefore concluded that, on a balance of probabilities, there is no likelihood of confusion between the trade-marks at issue.

[44] Accordingly, the section 12(1)(d) ground of opposition is also unsuccessful.

Disposition

[45] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

No Hearing Held

Agents of Record

Osler, Hoskin & Harcourt LLP

For the Opponent

Taylor McCaffrey LLP

For the Applicant