

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

Citation: 2011 TMOB 258
Date of Decision: 2011-12-16

**IN THE MATTER OF AN OPPOSITION
by 24 Hour Glass Ltd. to application
No. 1,320,485 for the trade-mark ON SET
GLASS & Design in the name of On Set
Glass Inc.**

[1] On October 17, 2006, On Set Glass Inc. (the Applicant) filed an application to register the trade-mark ON SET GLASS & Design (the Mark), shown below.



[2] The application for the Mark was filed based on use in Canada since at least as early as July 1998 for the following services:

Wholesale and retail sales of flat, tempered, automotive, mirrored and storefront glass products, glass tinting products and theatrical glass products used in the production of motion pictures and television; glass supply, repair and installation services (the Services).

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 19, 2008.

[4] On August 19, 2008, 24 Hour Glass Ltd. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Pursuant to s. 38(2)(a) and 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the application does not conform with the requirements of s. 30(b) of the Act in that the Applicant did not use the Mark in Canada as of the alleged date of first use in association with the Services.
- Pursuant to s. 38(2)(a) and 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Services, having regard to, among other things, the fact that the Mark is clearly descriptive of the Services and therefore unregistrable as described in greater detail below in the other grounds of opposition.
- Pursuant to s. 38(2)(b) and 12(1)(b) of the Act, the Mark is not registrable in that when depicted, written or sounded, it is clearly descriptive or deceptively misdescriptive in English and/or French of the character or quality of the Services.
- Pursuant to s. 38(2)(d) and 2 of the Act, the Mark is not distinctive in that it does not distinguish, nor is it adapted to distinguish, the Services from those of others, having regard to, among other things, the fact that the Mark is clearly descriptive of the character and quality of the Services.

[5] 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.

[6] In support of its opposition, the Opponent filed an affidavit of Aaron Dunne, the co-owner of the Opponent, sworn January 23, 2009 with Exhibits A – F and an affidavit of Nova Alberts, sworn January 29, 2009. Mr. Dunne was cross-examined on his affidavit and the transcript and responses to undertakings were filed. Ms. Alberts, however, failed to appear for cross-examination and as a result her affidavit has been removed from the record.

[7] In support of its application, the Applicant filed the following affidavits:

- Dale Brooks, sworn May 21, 2009, Exhibit A – V. Mr. Brooks is the co-owner and Vice President of the Applicant.
- Glenn Woodruff, sworn May 21, 2009. Mr. Woodruff is the owner of Woodruff Developments Ltd. and works as a construction coordinator in the film industry. Mr. Woodruff is a customer of the Applicant.
- Tom Blacklock, sworn May 21, 2009. Mr. Blacklock has worked in the film industry since 1989 and has known Mr. Brooks, of the Applicant, for most of that time. Mr. Blacklock is a customer of the Applicant.

- Ronald James Harvie, sworn May 21, 2009 with Exhibit A. Mr. Harvie is the General Manager of Vancouver Management Ltd., a real estate and property management company. Mr. Harvie was the Applicant's neighbour in July 1998.
- Larry McGregor, sworn May 21, 2009, with Exhibits A – C. Mr. McGregor is the graphic designer who redesigned the Applicant's logo to create the Mark.
- Kevin D. Ludlow, sworn May 21, 2009, with Exhibit A. Mr. Ludlow is a former employee of 24 Hour Emergency Glass Ltd. Mr. Ludlow states that he has been aware of the Applicant since 1998.
- Lisa Saltzman, sworn April 2, 2009 with Exhibit LS-1. Ms. Saltzman is the director of the trade-mark searching department with Onscope, a division of Marque d'Or Inc. Ms. Saltzman provides results for common law and dictionary searches for the term ON SET.

[8] All of the Applicant's affiants were cross-examined with the exception of Ms. Saltzman. Transcripts and responses to undertakings were filed for all of the cross-examinations.

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

Onus and Material Dates

[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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

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

- s. 38(2)(a)/30(b) and (i) - the date of filing the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)].
- s. 38(2)(b)/12(1)(b) - the date of filing the application [see *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.)].
- s. 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Non-compliance with Section 30 of the Act

Sections 30(b) of the Act

[12] The application for the Mark claims a first use date of July 1998 which is interpreted as July 31, 1998. Section 30(b) of the Act requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the date of filing of the application [see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.) at 262].

[13] The initial burden on the Opponent is light respecting the issue of non-conformance with s. 30(b) of the Act, because the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v. Mr. P.'s Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) at 89]. This burden may be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 at (F.C.T.D.) at 230]. While the Opponent may rely upon an Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is "clearly" inconsistent with the Applicant's claims as set forth in its application [see *Ivy Lea Shirt Co. v. 1227624 Ontario Ltd.* (1999), 2 C.P.R. (4th) 562 at 565-6 (T.M.O.B.), *aff'd* 11 C.P.R. (4th) 489 (F.C.T.D.)].

[14] The Opponent makes three main submissions in an effort to meet its burden under s. 30(b) of the Act.

[15] The Opponent's first main submission relates to documents obtained from the WorkSafe B.C. website suggesting that the Applicant only obtained workmen's compensation insurance coverage on January 1, 2002 and thus was not insured as of the claimed date of first use (Dunne affidavit, Exhibits D, E). The Opponent submits that this evidence suggests that the Applicant could not have been using the Mark consistently since the claimed first use date since it did not possess the appropriate insurance at that time.

[16] There are a number of deficiencies with this evidence. Firstly, on cross-examination it became apparent that these documents were obtained by Mr. Dunne's wife (Q103), not

Mr. Dunne himself. No information was given as to the necessity of having Mr. Dunne swear to materials found by his wife or why Mr. Dunne's wife could not herself have sworn an affidavit attaching these documents [see *Labatt Brewing Co. v. Molson Breweries, A Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)]. Secondly, the Applicant submitted that the documents are from 2009 and no information was provided as to what the insurance requirements in British Columbia would have been back in 1998. Lastly, and most importantly, the Applicant submits, and I agree, that at most the documents evidence the fact that the Applicant did not obtain workmen's compensation insurance coverage until January 1, 2002, a fact that has been admitted by the Applicant in any event. Specifically, Mr. Brooks states in his affidavit that he was not familiar with the insurance requirements upon commencing his business and that he did indeed initially neglect to file with the Workmen's Compensation Board for insurance and was penalized for doing so. Mr. Brooks attaches to his affidavit as Exhibit F materials evidencing the Applicant's registration as an employer with the Workmen's Compensation Board in January 2002 in which the Applicant listed the employment commencement date for its employees as June 23, 1998, the date of incorporation for the Applicant.

[17] I accept the Applicant's submissions and as a result I will not place any weight on the WorkSafe B.C. documents or the Opponent's submissions relying thereon.

[18] The Opponent's second submission relates to alleged inconsistencies in the Applicant's own evidence regarding use of the Mark which the Opponent suggests are sufficient to enable it to meet its evidential burden. The Opponent submits that the Applicant's evidence does not support a finding of continuous use of the Mark since the date claimed by relying on the following pieces of evidence:

- On cross-examination, Mr. McGregor, the designer of the logo for the Mark, stated that he did not personally provide the photo of the Mark attached to his affidavit as Exhibit A and he was unable to recall the exact month when he designed the Mark for the Applicant. (Q16, 25-29; 36)
- On cross-examination, Mr. Ludlow contradicted the statement in his affidavit that he had been aware of the Applicant since it started in 1998. Specifically, Mr. Ludlow was unable to provide a date for when he thought the Applicant had started its business or the approximate date when he first saw the Mark on one of the Applicant's vehicles or promotional materials. (Q41-44)

- On cross-examination, Mr. Blacklock contradicted the statement in his affidavit that he had been aware of the Applicant since it was incorporated. Specifically, Mr. Blacklock was unable to recall when he first saw the Applicant's service vehicles (Q46). He undertook to provide documents supporting statements made in his affidavit but ultimately did not produce them.
- Mr. Brooks failed to provide quantitative sales numbers for the year 1998.

[19] At the oral hearing, the Applicant submitted that it was not surprising that the Applicant's affiants had difficulty remembering the exact dates when they first saw the Mark, or when specific events had occurred. Specifically, the Applicant stressed that the affiants were being questioned about events that had taken place at least 11 years prior to the cross-examinations. The Applicant submits, and I agree, that the fact that the affiants, all of whom were unfamiliar with and uncomfortable in the cross-examination environment, may have had some difficulty when put on the spot to recall specific dates is not sufficient to discredit their affidavit evidence. I do not find that any of the affiants' statements on cross-examination were sufficient to call into question the sworn statements made in their affidavits regarding their awareness of the use of the Mark. The Applicant submits that the affidavits, which were sworn under oath, when read in their entirety, all support the claimed date of July 1998. I agree.

[20] The Applicant disagreed with the Opponent's submission that the Applicant's evidence does not support a finding of continuous use of the Mark since the claimed date and summarized its evidence as follows:

- In his affidavit, Mr. Brooks states that the Applicant was incorporated in June 1998 and the Mark was created in July 1998. The Mark was then applied to various items used in delivering the Services, including on service vehicles in July 1998. Mr. Brooks provides sales figures, advertising expenditures as well as documentary evidence showing the Mark as applied to various promotional materials used by the Applicant as well as on wooden crates used by the Applicant to deliver its glass products. This evidence will be discussed in further detail below in the analysis of the non-distinctiveness ground of opposition.
- In his affidavit, Mr. McGregor states that Mr. Brooks contracted him to design the Mark in July 1998. Mr. McGregor also states that he personally applied the Mark to the Applicant's service vans in July 1998.
- In his affidavit, Mr. Harvie, the Applicant's former neighbour, states that the Applicant moved into the premises next to his premises in July 1998 and that he

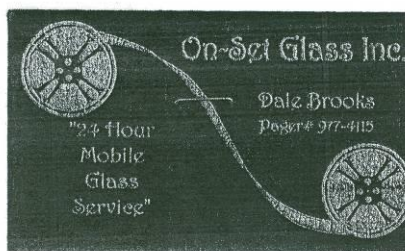
became aware of the Applicant's service vehicle displaying the Mark sometime thereafter.

- Mr. Blacklock and Ludlow both state that they are customers of the Applicant's services and have used the Applicant's services since 1998.

[21] I accept the Applicant's submissions. However, I acknowledge that the Brooks affidavit fails to provide quantitative sales figures for 1998, that some of the Applicant's affiants had difficulty recalling specifics on cross-examination and that the Brooks affidavit provides documentation only from 2001 due to the Applicant's document maintenance program. Despite this, when the evidence is viewed as a whole, I am satisfied that it is not clearly inconsistent with the claimed use date of July 1998. Based on the foregoing, I am not satisfied that the Opponent has succeeded in establishing that the Applicant's evidence is clearly inconsistent with the claimed first use date.

[22] The Opponent's third submission relates to the presence of variations in the manner in which the Mark is displayed throughout both parties' evidence. The Opponent submits that the presence of these variations suggests that the Applicant could not have been using the Mark as applied for continuously from the claimed date of first use. The Opponent relies on the following pieces of evidence to support this submission, all of which are found in Exhibit F to the Dunne affidavit:

- A business card for the Applicant's business which displays a variation of the Mark, shown below.



- Archived versions of the Applicant's website from 2003 and 2008 obtained from Wayback Machine displaying the variation of the Mark, shown below.



- A copy of an advertisement from the third-party directory “Reel West Digest” from 2004 which shows a variation of the Mark, shown below.



- A printout from the Applicant’s website from 2009 which shows the same variation of the Mark as that displayed in the “Reel West Digest” advertisement.

[23] With respect to the business card, I note that on cross-examination, Mr. Dunne admitted that he did not obtain the business card from the Applicant directly, but rather, it had been provided to him by a third party company upon acquisition of this third party company by the Opponent. I note that the evidence is unclear as to the date of the business card. On cross-examination, Mr. Brooks stated that the variation of the Mark seen on the business card was the Applicant’s original trade-mark which was redesigned sometime between June and July 1998 by Mr. McGregor. However, the Opponent submits that it acquired this business card in 2006. There is no indication as to when the business card was originally acquired from the Applicant by the third party who provided it to the Opponent. As a result, I am unable to determine the actual date of the business card.

[24] I note that the Applicant has not objected to the admissibility of the excerpts from the Applicant’s website attached to Mr. Dunne’s affidavit on the ground that they constitute hearsay. While I appreciate that evidence of a third party’s website cannot be relied upon as evidence of the truth of its contents, it seems to me that a different conclusion is appropriate where the owner of the website, being a party, has the opportunity to refute the evidence being tendered. Thus, I find that the websites adduced in Exhibit F to the Dunne affidavit are relevant and admissible. Furthermore, I note that archived web pages produced by WayBack Machine indicating the state of websites in the past have been found to be generally reliable [see *ITV Technologies, Inc. v. WIC Television Ltd.* (2003), 29 C.P.R. (4th) 182 at 192 (F.C.T.D.), affirmed (2005), 38 C.P.R.

(4th) 481 (F.C.A.) and *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.); reversed on other grounds 2008 F.C.A. 100].

[25] In response to the Opponent's submissions regarding the variations of the Mark demonstrated in the evidence, the Applicant submitted that there is no prohibition against the Applicant using other marks in carrying out its business. Specifically, the Applicant submitted that it owns another mark, namely OSG ON SET GLASS & Design (registration No. TMA767,453), shown below, which it submits it is permitted to use, among others.



[26] The Applicant submitted that the fact that it may have used other marks at various times, be they the Applicant's other registered mark, or other unregistered trade-marks, does not support a finding that the Applicant had not used the Mark as applied for continuously since the claimed date of first use of the Mark.

[27] In the presence of evidence of use of the Mark as applied for since the claimed use date (as discussed above, and as will be discussed further below in the analysis of the non-distinctiveness ground of opposition), I am not satisfied that the evidence showing variations of the Mark as discussed above is sufficient to enable the Opponent to meet its evidential burden under s. 30(b) of the Act.

[28] Based on the foregoing, I am dismissing the ground of opposition based on s. 30(b) of the Act on the basis that the Opponent has failed to meet its evidential burden.

Section 30(i) of the Act

[29] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the s. 30(i) ground is accordingly dismissed.

Non-registrability Ground of Opposition – s. 12(1)(b) of the Act

[30] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Services must be considered from the point of view of the average purchaser of the Services. Further, “character” means a feature, trait or characteristic of the Services and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co. of Canada Ltd v. American Home Products Corp.* (1968), 55 C.P.R. 29 (Ex. Ct.) at 34]. The Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at 186]. Finally, the purpose of the prohibition in s. 12(1)(b) is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [see *Canadian Parking Equipment Ltd. v. Canada (Registrar of Trade-marks)* (1990), 34 C.P.R. (3d) 154 (F.C.T.D.) at para. 15].

[31] I note that the Applicant has acknowledged the clearly descriptive nature of the word GLASS by disclaiming the right to the exclusive use of that word apart from the Mark in the application.

[32] There is an initial evidential burden on the Opponent to adduce sufficient evidence which would support its allegation that the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Services. The Opponent submits that the words ON SET GLASS are clearly understood to mean glass or glass services offered “on set”, meaning on a movie or television production set. The Opponent relies on the following evidence in support of its submissions:

- In his affidavit, Mr. Dunne states that the term ON SET is used in the film industry to refer to products and/or services relating to the production of a movie or television program.
- Mr. Dunne attaches to his affidavit invoices which the Opponent submits evidence use of the term ON SET in relation to glass services (Exhibit B).

- Mr. Dunne attaches to his affidavit printouts evidencing various third party references to ON SET as referring to movie or television productions (Exhibit C).
- On cross-examination, Mr. Blacklock (Q48), Mr. Woodruff (Q34-39) and Mr. Brooks (Q85) all stated that the term ON SET is commonly used in the film industry to refer to being on the set of a movie or a film.
- An excerpt from the Applicant's website displaying the term "set dec" which the Opponent presumes means "set decoration" (Exhibit U to the Brooks affidavit).
- An article obtained from the Applicant's website attached to Mr. Brooks' affidavit as Exhibit V which states "It's 9:30 on a week day morning and Dale Brooks of On Set Glass has been up since 5 a.m. attending to three film sets [...]. It's his job to install glass that stunt men can safely jump through, to replace tinted glass windows with clear glass so the camera can shoot clear images of the actors inside and to make sure that on-set glass is gimbaled or tilted so it doesn't create a glare." (Emphasis by Opponent's agent).

[33] I note that the only instances of use of the term ON SET in the invoices attached to Mr. Dunne's affidavit as Exhibit B refer to the location where labour is provided (e.g. p. 009 "Labour 1 man on set 5.5 hours") or the location where the glass was installed (e.g. p. 0013 "5mm clear tempered and aluminum all installed on set for New York set at Byrne Road") (emphasis is mine). Furthermore, on cross-examination, Mr. Dunne admitted that these invoices do not display the term ON SET GLASS and that an invoice for a windshield, even if installed "on set" would be invoiced as a "windshield" (Q37).

[34] With respect to the third party uses of the term "on set" found in Exhibit C to Mr. Dunne's affidavit, firstly, I note that these documents constitute hearsay and I am not willing to rely on them as evidence of the truth of their contents [see *Candrug, supra*]. Secondly, I note that on cross-examination Mr. Dunne admitted that none of these documents refer to a product or service called ON SET GLASS in any event (Q92). Furthermore, I note that none of the documents in Exhibit C relate to glass products or services. At most I am willing to rely on this evidence to support a finding that the term ON SET is used in relation to the film production industry, generally.

[35] With respect to the Opponent's submission regarding the presence of the term "set dec" on the Applicant's website, I note that there is no evidence to support a finding that "set dec" means "set decoration".

[36] The Applicant countered the Opponent's submissions and relied on the following evidence to support its submission that the Mark is not clearly descriptive or deceptively misdescriptive of the character or quality of the Services:

- In his affidavit, Mr. Brooks states that in his 23 years in the glass industry he has never heard the term ON SET GLASS used other than to refer to the Applicant.
- In their affidavits, Mr. Woodruff, Mr. Ludlow and Mr. Blacklock all state that in the 15, 10 and 19 years, respectively, that they have operated in the film industry they have never heard anyone use the term ON SET GLASS except to refer to the Applicant.
- The Applicant acknowledges that multiple affiants admitted that the term ON SET has an accepted usage in the film industry but submits that this does not establish that the term ON SET GLASS is clearly descriptive of glass services, in particular given the fact that the Services are also offered to commercial and residential customers completely unrelated to the film industry.
- The Applicant submits, and I agree, that I am unable to place any weight on Mr. Dunne's speculation regarding what Mr. Brooks would be aware of.
- In his affidavit, Mr. Dunne states that the Opponent has sold ON SET GLASS and/or provided ON SET GLASS SERVICES and takes the position that ON SET GLASS means glass services relating to the film industry (Dunne affidavit, paras 1-7). However, in his affidavit, Mr. Dunne describes his own services as "customization, installation and repair of glass and glass products, glass tinting and mylaring, sandblasting, and etching of glass and/or glass products". He does not refer to "on set glass products" or "on set glass services". The same is true of the Opponent's advertisements attached to Mr. Dunne's affidavit as Exhibit B (Q43).

[37] Citing *Provenzano v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 288 (F.C.A), the Applicant submits that in order for a mark to offend s. 12(1)(b) of the Act, it must be clearly descriptive of an intrinsic character or quality of the associated product or service. In *Provenzano*, the applicant applied for the trade-mark KOLD ONE in association with beer. The Court held that the word KOLD referred only to the temperature at which the beer may or may not be used. The Federal Court of Appeal held that "[t]he temperature at which beer may be used

is unrelated to the character or quality of the beer itself” and refused to find the mark to be clearly descriptive. The Applicant submits that the same is true for the Mark. The Applicant submits that the Services are not restricted to any particular location. The Applicant submits that even if we were to assume that the term ON SET is a reference to a film production set, this is at most one possible location where the Services could be provided. As a result, the Applicant submits that the words ON SET do not describe an intrinsic quality or character of the Services.

[38] On reply, however, the Opponent highlighted the fact that the Services themselves make reference to “...theatrical glass products used in the production of motion pictures and television” suggesting that, at least for these services, the location where they are offered is intrinsic to the services themselves. I agree.

[39] I conclude that, when sounded, the words “on”, “set” and “glass”, when used together, are clearly descriptive or deceptively misdescriptive of the “wholesale and retail sales oftheatrical glass products used in the production of motion pictures and television” (the Film Services). Firstly, I find that the evidence supports a finding that the term ON SET is commonly used in association with the production of movies and television programs. Secondly, with respect to the Film Services, the location is intrinsic to the services themselves.

[40] With respect to the remainder of the Services, however, I agree with the Applicant that the location where the glass services are provided is not intrinsic to the nature of the services themselves. The *Provenzano* case was discussed in *Société des Produits Nestlé S.A. v. Pacanowski* (1997), 77 C.P.R. (3d) 386 (T.M.O.B.), wherein it was decided that the word “frappé” was clearly descriptive or deceptively misdescriptive of “iced coffee” but would not be so for regular “coffee”. After setting out in the principle discussed above from *Provenzano*, Member Martin stated the following:

I agree with Mr. Justice Heald’s finding and, if the present application had been for “coffee” a similar finding could have been made in the present case. However, the present application is not for coffee but instead covers “iced coffee” and “iced coffee mix” such that the word “frappé” does point to an intrinsic character of the product itself in the case of “iced coffee” and to the sole product intended to be produced in the case of “iced coffee mix.”.... In the present case, an essential characteristic of iced coffee is its iced state. Thus the word “frappé” does clearly describe a character of the applicant’s wares in the French language.

[41] I am of the view that this reasoning can be applied to the present case with respect to the remainder of the Services. With respect to the Film Services, the location where the glass services are provided is intrinsic to the nature of the services. The same is not true for the remainder of the Services which do not include specification as to where they are provided. As a result, I am of the view that the location where they are provided is not a character or quality which is intrinsic to the glass services themselves. Based on the foregoing, I am not satisfied that the evidence supports a finding that the Mark is clearly descriptive or deceptively misdescriptive of an intrinsic character or quality of the services, and I dismiss the ground of opposition with respect to the remainder of the Services [see *Provenzano, supra*].

[42] Having found that the phrase ON SET GLASS, when sounded, is clearly descriptive of the Film Services, the question is whether the Mark is still registrable in view of the design components. The Mark is a composite one containing the words ON SET GLASS and design features in the form of a movie camera and film reel, stylized lettering and two horizontal lines.

[43] The registrability of composite marks with respect to s. 12(1)(b) has been dealt with in *Best Canadian Motor Inns Ltd. v. Best Western International Inc.* (2004), 30 C.P.R. (4th) 481 (F.C.). Pursuant to *Best Canadian Motor Inns*, when dealing with composite marks, one must assess the visual impression created by the word and design elements of the mark. Where the design element of the mark does not stimulate visual interest, the word element will be deemed dominant. In situations where you have a composite mark that, when sounded, contains word elements that are clearly descriptive or deceptively misdescriptive and are also the dominant feature of the mark, the mark will not be registrable pursuant to s. 12(1)(b) of the Act.

[44] The Opponent submits that the word element is the dominant portion of the Mark. In support of this, the Opponent relies on a series of decisions in which composite marks were found to be clearly descriptive or deceptively misdescriptive despite the significant design elements to the marks.

[45] By contrast, the Applicant submits that it cannot be said that one element of the Mark is more dominant than the others. Rather, the Applicant submits that each element of the Mark carries equal weight. The Applicant submitted that this is supported by Mr. Harvie's statement

on cross-examination: "...I just remember seeing the vehicle and I was impressed with the logo they had on it, thinking well, that's interesting" (Q36).

[46] I agree with the Applicant that the design and word elements of the Mark are of equal visual interest. However, I also agree with the Opponent's submissions that the design of a movie camera or film reel cannot be found to be distinctive of any one party, since they too are descriptive of the film industry. As a result, I find that the design elements are not sufficient to save the Mark from offending s. 12(1)(b) of the Act with respect to the Film Services. I therefore find that the Mark as a whole, and as a matter of immediate impression, is clearly descriptive when sounded of the Film Services in Canada and therefore offends s. 12(1)(b) of the Act.

[47] I note that, despite having filed evidence of use of the Mark since 1998, the Applicant did not attempt to overcome the s. 12(1)(b) ground of opposition through reliance on s. 12(2) of the Act.

[48] Based on the foregoing, the s. 12(1)(b) ground is successful with respect to the Film Services.

Non-distinctiveness Ground – s. 38(2)(d) of the Act

[49] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Services 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.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[50] At the oral hearing the Opponent reiterated its submissions regarding the s. 12(1)(b) ground of opposition in support of its non-distinctiveness ground of opposition. Given that I found that the Mark was not clearly descriptive or deceptively misdescriptive of the services: "wholesale and retail sales of flat, tempered, automotive, mirrored and storefront glass products, glass tinting products ...; glass supply, repair and installation services", I am dismissing this ground of opposition as well since I do not find that the difference in material dates is sufficient to change anything.

[51] With respect to the Film Services, I found the Mark to be clearly descriptive. A mark that is clearly descriptive is necessarily not inherently distinctive. A mark can, however, acquire distinctiveness through use. I will now assess the Applicant's evidence to determine whether the Mark had become distinctive of the Applicant with respect to the Film Services through use and/or promotion of the Mark as of the date of filing the statement of opposition.

[52] In his affidavit, Mr. Brooks states that from 1998 to 2008 the Applicant's gross revenue has steadily increased. I note that Mr. Brooks does not provide quantitative sales figures but rather expresses yearly sales as ratios with 1998 as the base year. In support of these sales Mr. Brooks attaches sample invoices dated from 2001-2008 for the provision of the Services to various commercial and residential customers as well as film production companies (Exhibits K, L, M). Mr. Brooks explains that invoices for the years 1998-2000 are unavailable as the Applicant only retains invoices for the previous seven years. Based on a review of the evidence as a whole, I am satisfied that the Applicant made sales of the Services in Canada from 1998 to the date of filing the statement of opposition.

[53] Mr. Brooks provides photographs showing the Mark displayed on service vans and trucks used by the Applicant in providing its services, as well as on wooden crates used by technicians (who themselves wear t-shirts displaying the Mark) to transport glass in the provision of the Services (Exhibits N, O, P). Mr. Brooks also provides various documentation used in carrying out the Services (e.g. letterhead, envelopes, business cards, etc.) all of which display the Mark (Exhibit Q).

[54] Mr. Brooks states that to further promote its services, the Applicant gives clothing and merchandise, including hats, jackets, pants, shirts and golf bags to its customers, all of which display the Mark (Exhibit S). Mr. Brooks states that from 2001-2009 the Applicant ordered over \$27,000 worth of clothing and merchandise featuring the Mark from Western Athletic Ltd. (Exhibit R).

[55] Mr. Brooks provides advertising expenses for the promotion of the Services which ranged from \$998 in 1998 to a high of \$14,782 in 2006 with expenses of \$8,798 and \$5,275 in 2007 and 2008, respectively.

[56] Based on a review of the evidence as a whole, I am satisfied that the Applicant has met its burden of establishing that the Mark was distinctive of the Applicant with respect to the Film Services as of the date of filing the statement of opposition and the non-distinctiveness ground of opposition is dismissed accordingly.

Disposition

[57] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application for the Mark with respect to the Services “wholesale and retail sales of ... theatrical glass products used in the production of motion pictures and television” and I reject the opposition with respect to the remainder of the Services pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) as authority for a split decision].

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