

IN THE MATTER OF AN OPPOSITION
by Renfrew Tape Limited to application No. 808,048
for the trade-mark RENEWRAP filed by
Mosinee Paper Corporation

On March 25, 1996, Mosinee Paper Corporation filed an application for the trade-mark RENEWRAP for the following wares: “Paper material for packaging paper”. The application was based on proposed use of the mark in Canada. The mark was advertised for opposition purposes on December 25, 1996.

The opponent, Renfrew Tape Limited, filed a statement of opposition on February 17, 1997. The applicant filed and served a counter statement. The opponent filed as its evidence in chief a notarized copy of trade-mark registration No. TMA453,673 for the trade-mark RENWRAP. The applicant filed the affidavit of Tobey Kuecker, Sales and Service Manager of Mosinee Converted Products. As its evidence in reply, the opponent filed the affidavit of Martin Lemoine, Sales Specialist with Scapa Tapes North America Ltd. (formerly called Renfrew Tape Limited). Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

The first ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereinafter the Act) because the applicant could not have been satisfied that it was entitled to use the applied for trade-mark in view of the opponent’s mark “RenWrap”, registered February 9, 1996, under No. TMA 453,673. The second ground is that the applied for trade-mark is not registrable pursuant to Section

12(1)(d) of the Act because it is confusing with the opponent's above noted trade-mark. The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act since at the date of filing, the applicant's trade-mark was confusing with the above noted trade-mark of the opponent which had been previously used in Canada by the opponent and has not been abandoned. The fourth ground of opposition is that the applied for trade-mark is not distinctive in that it is not capable of distinguishing the wares of the applicant from the wares of others including the opponent, in view of the opponent's previous use of its trade-mark mentioned above.

As a preliminary matter, the applicant's agent raised two issues about the opponent's evidence. First, the applicant's agent submitted that the opponent did not comply with Rule 41 of the *Trade-mark Regulations* in that the notarized copy of the opponent's registered mark that it filed as its evidence in chief is not proper evidence pursuant to Section 54 of the Act. Section 54 of the Act provides that evidence of any document in the official custody of the Registrar may be given by the production of a copy thereof purporting to be certified to be true by the Registrar. I agree with the applicant's agent that the notarized copy of the opponent's registered mark filed by the opponent does not comply with Section 54 of the Act. However, as the opponent's agent submitted, where an opponent does not submit a copy of its registration as part of its evidence in this opposition, the Registrar does have the discretion, in view of the public interest to maintain the purity of the register, to check the register in order to confirm the existence of the registration relied upon by the opponent (see **Quaker Oats Co. of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.** (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)). In my view, it is clear that the opponent in the

present case sought to rely on the existence of its registration to support its grounds of opposition. Therefore, although the notarized copy of the opponent's registration does not comply with Section 54 of the Act, I am prepared to exercise my discretion to check the register to confirm the existence of the registration relied upon by the opponent.

The second preliminary issue raised by the applicant's agent was that the Lemoine affidavit was not proper reply evidence as required by Rule 43 of the *Trade-Mark Regulations*. I agree with this objection of the applicant's agent in part. The Kuecker affidavit supported the applicant's position that there would be no likelihood of confusion between the marks at issue in view of the nature of the trade associated with the applicant's trade-mark. Therefore, Mr. Lemoine's evidence about the nature of the opponent's wares and its channels of trade could arguably be considered as a proper reply to the applicant's evidence.

At paragraphs 4 and 5 of his affidavit, however, Mr. Lemoine refers to two Canadian trade-marks and one American trade-mark of the opponent that were not pleaded by the opponent in its statement of opposition. As these marks were not referred to in any of the grounds of opposition pleaded by the opponent, I am precluded from considering them (see **Imperial Developments Ltd. v. Imperial Oil Ltd.** (1984), 79 C.P.R. (2d) 12 at 21 (F.C.T.D.)). In any case, I would have agreed with the applicant that this evidence does not constitute evidence "strictly in reply" as is required by Rule 43. Therefore, I will not have regard to paragraphs 4 and 5 of Mr. Lemoine's affidavit.

The first ground of opposition is not a proper ground in that the opponent did not allege that

the applicant was aware at the date of filing its application that its applied for mark was confusing with the opponent's trade-mark. Thus, the first ground is unsuccessful.

With respect to the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decisions in **Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.** (1991), 37 C.P.R. (3d) 413 (F.C.A.) and **Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers** (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Further, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, neither the applicant's nor the opponent's mark is inherently strong because both marks include the word WRAP which, in relation to the wares, suggests something used for packaging. With respect to the extent to which the trade-marks have become known, this factor does not favour either party. In this regard, Mr. Lemoine's evidence is more or less a bare statement that the opponent has used its mark since at least early 1995, and the applicant's mark is based on proposed use in Canada. Although Mr. Kuecker states that, to the date of his affidavit (i.e. June 4, 1998), the applicant "has sold and shipped products bearing the trade-mark to Canada to a total weight of 40,665 pounds", without further information this evidence is insufficient to show the extent to which the applicant's mark has become known in Canada. As for

Section 6(5)(b) of the Act, the length of time the marks have been in use favours the opponent, albeit slightly, for the same reasons just noted.

As for the wares and trades of the parties, it is the applicant's statement of wares and the opponent's statement of wares in its registration that govern: see **Mr. Submarine Ltd.** v. **Amandista Investments Ltd.** (1987), 19 C.P.R. (3d) 3 at 10-11 (F.C.A.); **Henkel Kommanditgesellschaft** v. **Super Dragon** (1986), 12 C.P.R. (3d) 110 at 112 (F.C.A.) and **Miss Universe, Inc.** v. **Dale Bohna** (1994), 58 C.P.R. (3d) 381 at 390-392 (F.C.A.). However, these statements must be read with a view to determining the probably type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in **McDonald's Corporation** v. **Coffee Hut Stores Ltd.** (1996), 68 C.P.R. (3d) 168 at 169 (F.C.A.).

The applicant's wares are comprised of "Paper material for packaging paper". The applicant's product is described by Mr. Kuecker in his affidavit as follows:

5. RENEWRAP protects large rolls of other paper products during shipping and storage. Other, more traditional, paper mill packaging uses wax or polyethylene laminated between layers of kraft paper. The RENEWRAP product also protects against scuffing and moisture, but unlike the traditional wax or polyethylene wrap, it is made of material that can be recycled with other papers.
6. The RENEWRAP paper is of interest to end-users not only because of its specific packaging functions, but also because it can be recycled. If the paper packaging is a wax or polyethylene laminate, then when it is discarded by the end-user, it must be separated from other waste, and baled and disposed of separately. But RENEWRAP, which uses a coating/laminate that is water-soluble, can be recycled with regular papers, at a significant saving in labour and expense.

The opponent's wares, on the other hand, are comprised of "Pipeline coating products and materials,

namely, rubber base prima paints and polymer tapes”. Mr. Lemoine does not state anything about the nature of the opponent’s product except for the following statement at paragraph 6 of his affidavit:

“Although products manufactured and sold by Scapa Tapes in association with the trademark “RenWrap” *are intended for protective wrapping of pipelines*, the opponent has always made other tapes and protective products for other purposes....” (emphasis added)

Mr. Lemoine then goes on to describe the other wrapping and protective products of Scapa Tapes such as polyethylene athletic tape, automotive electrical harness wrapping, surface protective films for cars and appliances, and electrical splicing tape. He further states that Scapa Tapes makes and sells products to the pulp and paper industry, including a two-sided adhesive tape which is used to start a run of paper on a roll or to splice two ends of a length of paper on a roll in the manufacturing process.

In my view, although some of the opponent’s wrapping and protective products may arguably be similar to the applicant’s applied for wares, as stated above, it is the applicant’s statement of wares and the opponent’s statement of wares in its registration that govern. The essential nature of the opponent’s wares registered under its mark RENWRAP are rubber base prima paints and polymer tape. The fact that the applicant’s product, as described by Mr. Kuecker, may be considered a “specialty” paper comprised of different materials than traditional packaging does not, in my view, change the fact that the essential nature of the applicant’s wares is paper, and the applicant’s application is restricted in this regard. Further, the use to which the opponent’s wares appear to be put (i.e. pipeline coating) is different from the use for the applicant’s wares (i.e. packaging large rolls of paper). I therefore consider the nature of the parties’ wares in the present

case to be different.

With respect to Section 6(5)(d) of the Act, the Registrar must consider the channels of trade which the average consumer would normally consider as being associated with the wares set forth in the applicant's application and the opponent's registration since it is these wares which determine the respective monopolies being claimed by the parties in relation to their respective trade-marks. The applicant's evidence is that its product is sold primarily through direct sales calls by salesmen to the customers. Typical customers of the applicant's product are paper mills and converters of paper. The opponent, on the other hand, does not describe what its channels of trade are for its RENWRAP product but does provide evidence that the opponent sells other products to the pulp and paper industry. The opponent submits that the evidence of Mr. Lemoine shows that Renfrew Tape is known in the paper industry as a company that makes tape.

In my view, the fact that the opponent manufactures a variety of products under different trade-marks that may pass through the same channels of trade as the applicant's product is of little relevance to the determination of the likelihood of confusion between the applied for mark and the opponent's registered mark RENWRAP. Given that the opponent has not shown that there would be any overlap between the channels of trade for its RENWRAP product and the channels of trade for the applicant's product, and having regard to the fact that the opponent's registered wares are restricted to the category "pipeline coating products and materials" while the applicant's wares are restricted to "paper material for packaging paper", I do not consider that the applicant's wares are the type that would likely be sold in the same channels of trade as the opponent's RENWRAP

product.

As for Section 6(5)(e) of the Act, there is a high degree of visual resemblance between the marks as both marks begin with the letters “REN” and end with the letters “WRAP”, although RENWRAP as registered has distinctive lettering. There is less resemblance between the marks as sounded, however, as the middle component of the applicant’s mark may be pronounced “new” and the applicant’s mark has three syllables while the opponent’s mark has only two. The ideas suggested by the marks are similar as they both suggest wrapping of some kind although the applicant’s mark also suggests a type of wrap that has been or can be renewed in some way while the component “ren” has no meaning with respect to the opponent’s mark.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the differences in the nature of the parties’ wares and channels of trade, I consider that the applicant has satisfied the onus on it to show that its mark is not confusing, or likely to be confused, with the opponent’s RENWRAP mark. Thus, the second ground of opposition is also unsuccessful.

The third and fourth grounds of opposition also turn on the determination of the issue of the likelihood of confusion between the applicant’s mark and the opponent’s mark, although the material date for assessing the likelihood of confusion in respect of the s.16(3)(a) ground is the applicant’s date of filing (i.e. March 25, 1996) and the material date in respect of the non-distinctiveness ground is the date of opposition (i.e. February 17, 1997). In my view, the differences in material dates do

not have a significant impact on the determination of the issue of confusion between the applied for trade-mark and the opponent's trade-mark. Thus, my findings above that the trade-marks at issue are not confusing, or likely to be confused, likewise applies to these grounds of opposition which are therefore unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 20th DAY OF December, 2001.

C.R. Folz,
Member,
Trade Marks Opposition Board