

**IN THE MATTER OF AN OPPOSITION  
by Rust-Oleum Corporation to application  
No. 1,165,586 for the trade-mark WE STOP  
RUST filed by Kpr Adcor Inc.**

---

**On January 27, 2003, the applicant, Kpr Adcor Inc., filed an application to register the trade-mark WE STOP RUST based on use in Canada since August 1, 1997 with the following wares:**

corrosion inhibiting and removal chemicals and compositions in the form of lubricants, fluids, vapours and other compounds; packaging materials incorporating the same; surface coating and sealant compositions for rustproofing vehicles and other metal surfaces; electronic rust and corrosion prevention devices

**and with the following services:**

operation of a business with respect to the rust inhibiting services and servicing, namely product selection and application of rust inhibiting compounds to motor vehicles and other metal surfaces, water treatment, corrosion control evaluations and engineering, development of corrosion control systems; analysis and testing for corrective action relating to preparation and use of corrosion protecting solutions; technical consultation and research in the field of corrosion and rust prevention, namely packaging design, custom corrosion removal and prevention techniques and products.

**The application was amended to include a disclaimer to the words STOP RUST and was subsequently advertised for opposition purposes on June 30, 2004.**

**The opponent, Rust-Oleum Corporation (“Rust-Oleum”), filed a statement of opposition on November 29, 2004, a copy of which was forwarded to the applicant on December 21, 2004. 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 in that the applicant could not have been satisfied that it was entitled to use the applied for mark in Canada in view**

**of the opponent's use, registration and making known of its trade-mark STOPS RUST. The second ground is that the applicant's application does not conform to the requirements of Section 30(b) of the Act because the applicant did not use its applied for trade-mark in Canada since the date claimed in the application.**

**The third ground of opposition 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 trade-mark STOPS RUST registered under No. 383,346 for the following wares:**

surface coating compositions - namely, rust-preventative paint and enamel surface coating compositions for the protection of metal surfaces, including ferrous metal surfaces, from corrosion; rust-preventative, chemical-resistant paint and enamel surface coatings, rust-preventative heat resistant paint and enamel surface coatings; rust-preventative water-resistant paint and enamel surface coatings; and rust-preventative acid-resisting paint and enamel surface coatings.

**The fourth ground is that the applicant is not the person entitled to registration pursuant to Section 16(1)(a) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the trade-mark STOPS RUST previously used in Canada by the opponent. The fifth ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's trade-mark STOPS RUST.**

**The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Tasha Charette and Michael T. Murphy. The applicant elected not to submit evidence. Only the opponent filed a written argument and an oral hearing was conducted at which only the opponent was represented.**

### **THE OPPONENT'S EVIDENCE**

**The Charette affidavit serves to introduce the results of searches conducted by Ms. Charette regarding the incorporation records for the applicant. Those records indicate that the applicant was incorporated on July 28, 1997.**

**In his affidavit, Mr. Murphy identifies himself as the Corporate Counsel for Rust-Oleum which he states is a subsidiary of RPM International Inc. ("RPM"). He further indicates that various trade-mark registrations including No. 383,346 were assigned by Rust-Oleum to Rust-Oleum Brands Company ("Rust-Oleum Brands") on March 7, 2003. Mr. Murphy states that RPM is the parent of Rust-Oleum and Rust-Oleum Brands and of Tremco International, whose Canadian division, Tremco Canada, is managed by Rust-Oleum. He further states that Rust-Oleum Consumer Brands Canada is a division of Tremco Canada.**

**Mr. Murphy states that the trade-mark STOPS RUST has been used in Canada since 1951 with a variety of paint and coating products. Exhibit B to his affidavit comprises depictions of labels which include the trade-mark STOPS RUST. However, those labels do not indicate the source of the goods. Furthermore, every instance of the mark STOPS RUST includes the French language equivalent immediately below thereby underscoring the descriptiveness of the mark.**

**Although Mr. Murphy is vague about which company or division actually produces and sells the products, he indicates that all use of the mark STOPS RUST is subject to the strict**

control of Rust-Oleum Brands, the current owner of registration No. 383,346. Industrial products are sold through industrial distributors including Acklands-Grainger whereas consumer-directed products are sold through hardware and home renovations chains such as Home Depot, Home Hardware and Canadian Tire as well as through mass merchandisers like Wal-Mart. Gross wholesale consumer sales for the period June 1, 2001 to December 2004 were in excess of \$2.3 million. According to Mr. Murphy, Rust-Oleum spent more than \$117,000 on advertising and merchandising in relation to STOPS RUST products in Canada since 2001.

#### THE APPLICANT'S EVIDENCE

As previously noted, the applicant did not file any evidence.

#### THE GROUNDS OF OPPOSITION

The first ground does not raise a proper ground of opposition. The mere fact that the opponent may have used and registered its trade-mark in Canada does not preclude the applicant from truthfully making the statement required by Section 30(i) of the Act. Thus, the first ground is unsuccessful.

As for the opponent's second ground of opposition, the onus or legal burden is on the applicant to show that its application conforms to the requirements of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting

the issue of non-conformance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent's evidential burden can be met by reference to the applicant's own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

The opponent contended that the fact that the applicant's date of incorporation was only four days prior to its claimed date of first use is sufficient evidence to meet the opponent's light evidential burden. However, I do not see how that fact is necessarily inconsistent with the applicant's claimed date. The opponent relied on the opposition decision in Gould Inc. v. Gould Fasteners Ltd. (1998), 85 C.P.R.(3d) 549 at 558. However, that case is distinguishable since it was a situation where the date of incorporation and the date of first use were the same. Thus, the second ground is also unsuccessful.

As for the third 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 decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show on a balance of probabilities no reasonable likelihood of confusion between the marks at issue. Finally, 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, the marks of both parties are highly suggestive, if not descriptive, of the associated wares and/or services. The fact that the opponent's registration indicates that registrability was recognized under Section 14 of the Act and the further fact that the mark invariably appears in conjunction with the French translation of the words "stops rust" on the product labels underscores the inherent weakness of the opponent's mark.

Since there is no evidence from the applicant, I must conclude that its mark has not become known at all in Canada. Given the use and advertising evidenced for the opponent's mark, I am able to conclude that it has acquired a reputation in Canada although, given the weakness of the mark, that reputation is not particularly extensive.

The length of time the marks have been in use favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, it is the applicant's statements of wares and services and the statements of services appearing in the opponent's two registrations 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, 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. 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.).**

**There is an overlap in the wares, some of them being identical. Furthermore, the remaining wares are all similar in nature since they all relate to rust proofing or corrosion inhibition. Likewise, the applicant's services are all related to rust inhibiting services and are therefore related to the opponent's wares. In the absence of evidence from the applicant, I assume that there is, or could be, an overlap in the channels of trade of the parties.**

**As for Section 6(5)(e) of the Act, I consider that there is a fairly high degree of resemblance between the two marks in all respects. In fact, the second and third components are virtually identical to the opponent's registered 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 resemblance between the wares, services, trades and marks of the parties and the fact that the opponent's mark has acquired some reputation in Canada, I find that the applicant has failed to satisfy the onus on it to show that its applied for mark is not confusing with the opponent's registered mark. Thus, the third ground of opposition is successful.**

**As for the fifth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and 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.). Furthermore, the material time for**

considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - November 29, 2004): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The fifth ground of opposition essentially turns on the issue of confusion between the applicant's mark and the opponent's mark. My conclusions respecting the third ground are generally applicable to the fifth ground as well. Thus, I find that the applicant failed to show that its applied for mark was not confusing with the opponent's mark as of the filing of the opposition. Thus, the fifth ground is also successful.

In view of my conclusions respecting the third and fifth grounds, it is unnecessary to consider the remaining ground of opposition.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT GATINEAU, QUEBEC, THIS 16<sup>th</sup> DAY OF MAY, 2007.

David J. Martin,  
Member,  
Trade Marks Opposition Board.