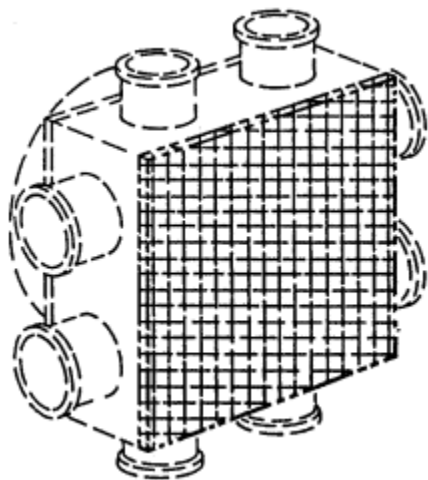


**IN THE MATTER OF AN OPPOSITION by The  
Lamson & Sessions Co. to application No.  
1,094,356 for the trade-mark Junction Box Colour  
Plate Device (yellow) in the name of Royal Group,  
Inc.**

On February 28, 2001, Royal Group Technologies Limited d.b.a. Royal Pipe Company filed an application to register the trade-mark Junction Box Colour Plate Device (yellow) [the “Mark”]. The Mark is shown in the drawing below.



The trade-mark consists of the colour yellow applied to a face plate of a junction box. The drawing is lined for the colour yellow.

The application is based upon proposed use of the Mark in Canada in association with electrical junction boxes.

The application is currently in the name of Royal Group, Inc. and the term “Applicant” will be used to refer to both Royal Group Technologies Limited d.b.a. Royal Pipe Company and Royal Group, Inc.

The application was advertised for opposition purposes in the Trade-marks Journal of January 21, 2004. On June 14, 2004, The Lamson & Sessions Co. [the “Opponent”] filed a statement of

opposition. The grounds of opposition are summarized below:

1. The Applicant's Mark is not registrable pursuant to s. 12(1)(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the "Act"] because it is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used because it clearly describes or deceptively misdescribes that the electrical junction boxes in association with which it is proposed to be used are for use in association with telecommunications/safety and gas related applications.

2. The Mark is not registrable under s. 12(1)(e) of the Act because the Mark is a mark the adoption of which is prohibited by s. 10 of the Act. The colour yellow used in association with electrical junction boxes constitutes a mark (the "Yellow Mark") which has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind of electrical junction box in association with which it is used. In particular, the Yellow Mark is recognized in Canada as designating that the electrical junction boxes in association with which it is used are of a kind which is appropriate for telecommunications/safety and gas related applications. The opposed mark either consists of the Yellow Mark or so nearly resembles the Yellow Mark as to be likely to be mistaken therefor.

3. The Applicant is not the person entitled to registration of the Mark under s. 16(3) of the Act because, at the date of filing of the application, the Mark was confusing with a trade-mark consisting of the colour yellow as applied to electrical junction boxes which had been previously used in Canada or made known in Canada by another person or persons.

4. The Applicant's Mark is not distinctive because it does not actually distinguish and is not adapted to distinguish the Applicant's wares from the wares and services of others because it is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used, because it is a mark the adoption of which is prohibited by s. 10 of the Act and/or because it is confusing

with a mark previously used in Canada or made known in Canada by another person or persons.

The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

In support of its opposition, the Opponent filed the affidavits of Steven Randall Whaley and Simon Jeffery Charles Williams. The Applicant obtained an order for the cross-examination of Mr. Whaley and a copy of the transcript of the cross-examination has been filed.

The Applicant elected to not file any evidence.

Each party filed a written argument.

The Applicant originally requested an oral hearing, but subsequently withdrew its request.

#### Onus and Material Dates

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].

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

- s. 12(1)(b) - the date of filing of the application [see *Havana Club Holdings S. A. v. Bacardi & Company Limited* (2004), 35 C.P.R. (4<sup>th</sup>) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4<sup>th</sup>) 60 (F.C.T.D.)];
- s. 12(1)(e) - the date of my decision [see *Canadian Olympic Association v. Allied Corporation* (1989), 28 C.P.R. (3d) 161 (F.C.A.) and *Canadian Olympic Association v. Olympus Optical Company Limited* (1991), 38 C.P.R. (3d) 1 (F.C.A.)];
- s. 16(3) - the filing date of the application [see s. 16(3)];

- non-distinctiveness - 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.T.D.)].

### Summary of Evidence

#### *Whaley Affidavit*

Mr. Whaley has been the Canadian/International Sales Manager of the Carlon division of the Opponent since 1996. The Opponent is an American company that has a long history. At present, it claims to be “a leading producer in North America of thermoplastic conduit, enclosures, wiring devices and accessories for the construction, consumer, power and communications markets, and large diameter pipe for wastewater markets.” It has three primary business divisions, the largest being the Carlon division. The Carlon division “provides electrical and telecommunications raceway systems, non-metallic enclosures, outlet boxes and electric fittings to the electrical and telecommunications infrastructure markets.”

Mr. Whaley states:

- In Canada, the colour yellow is used as a safety colour in electrical systems and components.
- In the electrical and construction industries, the colour yellow applied to electrical enclosures and fittings, including junction boxes, is associated with indications of telecommunications, safety and gas-related applications.

(His affidavit was sworn on April 2, 2005.)

Mr. Whaley also states that other companies use the colour yellow in association with their junction boxes and related wares. In support of this statement, he provides the following materials:

- Exhibit A: copies of pages of available through the website of Hubbell Canada Inc. that promote that company’s banana boxes (yellow non-metallic outlet boxes), yellow marine grade dockside boxes and covers, and yellow pushbutton stations

One of the stated features of the pushbutton stations is “safety yellow enclosures for indoor and outdoor applications”.

(pages printed 3/20/2005)

- Exhibit B: pages from the website of Viking Electronics Inc. that advertise two models of weatherproof mounting, which appear to be cast aluminum doors to weather protect outdoor telephones; they are available in two colours: “safety yellow or emergency red” Canadian distributors are listed.

(pages printed 3/20/2005).

Two other exhibits have been provided by Mr. Whaley, namely advertisements by Royal Pipe Systems:

- an undated advertisement by Royal Pipe Systems, a member of the Royal Group of Companies, that displays color coded ENT slab boxes, including one with a yellow faceplate, with a legend indicating that yellow is for emergency lighting and exit signs
- pages available from the website of Royal Pipe Systems that advertise Ident-a-Box™ slab boxes and state:

We offer colour-coded lids on our Ident-a-Box™ slab boxes for easy identification of services both before and after the concrete is poured. They are available in grey, green, white, blue, yellow and red.

Typical uses for each colour:

Grey – generic

Green – security, cable, telephone

White – hydro 600 volt

Blue – hydro 120 volt

Yellow – emergency lighting and exit signs

Red – fire alarm systems

There is a picture of a box with a yellow faceplate.

(there is a copyright notice of 2004 on one of the pages)

On cross-examination, Mr. Whaley explained that slab boxes are a type of junction box.  
(Question 34)

### *Williams Affidavit*

Mr. Williams, an articling student, provides “yellow-coloured products for use in electrical systems” that he purchased at a Canadian Tire store in Toronto on April 4, 2005. The products appear to be some of Hubbell’s banana boxes.

### Preliminary Matter

In its written argument, the Opponent states:

Counsel for the Applicant requested the right to cross-examine Mr. Whaley on all his affidavits filed in respect of each of the five coloured junction box oppositions taken by the Opponent against the Applicant and counsel for the Opponent agreed. Therefore the transcript of the cross-examination discusses the affidavits and exhibits filed in respect of each of the oppositions. We therefore respectfully submit that we should be able to refer to the exhibits referred to in the transcript of the cross-examination in each of the written arguments filed in respect of these colour coded junction boxes.

However, I do not think that the single cross-examination ought to have the full effect proposed by the Opponent. The Opponent chose to file different affidavits for each opposition and its proposal appears to simply be an attempt to have evidence considered with respect to the present file that it perhaps now regrets not filing in respect of this application. In particular, the Opponent wishes to rely on a brochure filed as an exhibit with respect to another application because it predates the material date of June 14, 2004. However, the brochure in question was not entered as an exhibit to the cross-examination. In addition, the date of the brochure was not referred to during the cross-examination. So, even if all of the questions of the cross-examination are to be considered in each of the oppositions, the questions and answers provide no evidence that the brochure being discussed existed prior to June 14, 2004.

### Section 12(1)(b) Ground of Opposition

There is no evidence that the colour yellow described telecommunications/safety and gas related applications as of the material date of February 28, 2001. Accordingly, the Opponent has not met its initial burden and this ground is rejected.

### Section 16(3) Ground of Opposition

When considering a s. 16 ground of opposition, consideration must also be given to s. 17(1) of the Act, which reads in part as follows:

No application for registration of a trade-mark that has been advertised in accordance with section 37 shall be refused ... on the ground of any previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant for that registration or his predecessor in title, except at the instance of that other person or his successor in title ... [my underlines]

As the Opponent has not evidenced that it has used “a trade-mark consisting of the colour yellow as applied to electrical junction boxes”, its s. 16(3) ground cannot succeed.

### Section 12(1)(e) Ground of Opposition

The Opponent has pleaded that the Mark is not registrable because it is a mark that is prohibited by s. 10 of the Act. Section 10 reads as follows:

Where any mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services, no person shall adopt it as a trade-mark in association with such wares or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

The Opponent's evidence is insufficient to show that the colour yellow has an accepted meaning in the parties' industry. The Opponent has therefore not met its initial burden and this ground is rejected.

### Non-distinctiveness Ground of Opposition

There is no evidence of the use of the colour yellow on junction boxes and the like by third parties as of the material date of June 14, 2004. Nor is there evidence that the Mark was clearly descriptive or deceptively misdescriptive as of that date or contrary to s. 10. Therefore, the Opponent has not met its initial burden with respect to this ground and this ground is rejected.

I note that the Opponent has submitted in its written argument that the Mark is not distinctive because marks comprised of colour alone are not viewed as inherently distinctive and there is no

evidence that the Mark had acquired distinctiveness as of the material date. However, the distinctiveness ground was clearly pleaded as restricted to the issues of descriptiveness, s. 10 and confusion.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 17th DAY OF JULY 2008.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board