



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

**Citation: 2011 TMOB 27**  
**Date of Decision: 2011-02-15**

**IN THE MATTER OF AN OPPOSITION  
by General Paint Corp. to application  
No. 1,308,670 for the trade-mark HIGH  
PERFORMANCE BEAUTY in the name  
of Valspar Sourcing, Inc.**

[1] On July 11, 2006, Valspar Sourcing, Inc. (the Applicant) filed an application to register the trade-mark HIGH PERFORMANCE BEAUTY (the Mark) based on proposed use of the Mark in Canada. The Applicant has claimed a convention priority filing date of June 29, 2006.

[2] The Applicant's statement of wares currently reads: a full line of interior and exterior coatings, namely, paints, stains, varnishes and primers for wood, plastic, metal, fiberglass, plaster, concrete, glass, and paper surfaces, residential and commercial buildings, siding, and furniture.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 2, 2008.

[4] On May 30, 2008, General Paint Corp. (the Opponent) filed a statement of opposition. The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed an affidavit of Jennifer Powell, a trade-mark legal assistant with the Opponent's trade-mark agents. In support of its application, the

Applicant filed an affidavit of Gerald Gaunt, an articling student employed by the Applicant's trade-mark agents. Neither affiant was cross-examined.

[6] Both parties filed a written argument. An oral hearing was not requested.

#### Summary of Grounds of Opposition and Applicable Material Dates

[7] The Opponent has pleaded the following grounds of opposition pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act):

1. contrary to s. 38(2)(a) and 30(e), at the date of filing of the application, the Applicant never intended, by itself or through a licensee, or by itself and through a licensee, to use the Mark in Canada in association with all of the specified wares listed in the application;
2. contrary to s. 38(2)(a) and 30(i), at the date of filing of the application, the Applicant was not, and could not have been, satisfied that it was entitled to register the Mark in Canada in view of the Applicant's knowledge of the lack of distinctiveness of the Mark and of the existence of the prior rights of the Opponent;
3. contrary to s. 38(2)(b) and 12(1)(d), the Mark is not registrable because it is confusing with registered trade-marks, including, but not limited to, HI-PERFORMANCE 2000, subject of registration No. TMA547,761;
4. contrary to s. 38(2)(c) and 16(3)(a), the Applicant is not the person entitled to registration of the Mark because, prior to and at the date on which the Applicant filed the application, the Mark was confusing with the Opponent's trade-mark, namely HI-PERFORMANCE 2000, that had been previously used in Canada;
5. contrary to s. 38(2)(c) and 16(3)(b), the Applicant is not the person entitled to registration of the Mark because, prior to and at the date on which the Applicant filed the application, the Mark was confusing with the Opponent's trade-mark, namely HI-PERFORMANCE 2000, for which an application had been previously filed in Canada;
6. contrary to s. 38(2)(d) and 2, the Mark is not distinctive because it is not capable of distinguishing the Applicant's wares from the wares of the Opponent, nor is it adapted to so distinguish them, because the Mark is confusing with the Opponent's trade-mark HI-PERFORMANCE 2000.

[8] The material dates with respect to the grounds of opposition are as follows:

- s. 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 38(2)(b)/12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 38(2)(c)/16(3) - the convention priority filing date of the application;

- s. 38(2)(d)/2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

### Onus

[9] 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].

### Section 30(e) Ground of Opposition

[10] The s. 30(e) ground of opposition is dismissed because the Opponent has not met its initial burden in respect thereof. Contrary to the Opponent's submissions, the Applicant is not required to prove its intent to use the Mark in the absence of any evidence suggesting that the Applicant was lacking the necessary intent.

### Section 30(i) Ground of Opposition

[11] 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. [*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.

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

[12] The likelihood of confusion between HIGH PERFORMANCE BEAUTY and HI-PERFORMANCE 2000 is the basis of the remaining grounds of opposition. I will begin by assessing it under the s. 12(1)(d) ground as of today's date.

[13] The Opponent has met its initial burden because its registration for HI-PERFORMANCE 2000, No. TMA547,761, is extant. I note that the statement of wares in that registration reads "interior and exterior coatings, namely latex paints for industrial and semi-industrial use" and that the Opponent disclaimed the right to the exclusive use of the words HI-PERFORMANCE apart from the trade-mark.

[14] 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[15] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 wares, 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. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

*inherent distinctiveness of the trade-marks and the extent to which they have become known*

[16] Neither mark is inherently strong. The words HIGH PERFORMANCE, HI-PERFORMANCE and BEAUTY are all suggestive of the character or quality of the associated wares. Numbers, such as 2000, are inherently weak [see *Noxzema Chemical Co. of Canada Ltd. v. Estee Lauder Cosmetics Ltd.* (1975), 23 C.P.R. (2d) 214 (T.M.O.B.)].

[17] A trade-mark may acquire distinctiveness through use or promotion, but neither party has filed evidence to show use or promotion of its mark. While it is true that the Opponent's registration issued on the basis of use of the mark in Canada since at least as early as December 1995, at most this entitles me to assume only *de minimis* use of the Opponent's trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. *De minimis* use does not support a conclusion that the mark has become known to any significant extent.

*length of time each trade-mark has been in use*

[18] A consideration of the length of time that each mark has been in use technically favours the Opponent, but I do not consider this factor to be significant since there is no evidence that the Opponent continued to use its mark after its claimed date of first use.

*nature of the wares, services, business or trade*

[19] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application or registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)].

[20] The parties' statements of wares overlap and so, in the absence of evidence to the contrary, it is reasonable to conclude that their channels of trade could also overlap.

*degree of resemblance between the trade-marks*

[21] It is a well accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction. However, when a word is a common, descriptive or suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)].

[22] Both marks begin with phonetically identical words, followed by a distinctly different component.

[23] While there is a fair resemblance between HIGH PERFORMANCE BEAUTY and HI-PERFORMANCE 2000 in appearance and sound, there is less resemblance in the suggested ideas.

[24] I remark that I consider the Opponent's submission that the first syllable of BEAUTY and 2000 rhyme to be of no consequence in a consideration of the resemblance between the marks.

*additional surrounding circumstances*

*i) state of the marketplace*

[25] Mr. Gaunt has provided evidence of the following wares being available or promoted in the Canadian marketplace in 2009:

1. TREMCLAD high performance rust enamel
2. RUST-O-LEUM high performance enamel
3. DUPLI-COLOR high performance wheel coating
4. DUPLI-COLOR high performance textured metallic coating
5. CLOVERDALE PAINT high performance 100% acrylic solid hide stain
6. COLUMBIA hi-performance coatings
7. PRO-LINE high performance liquid paint marker
8. ICD high performance glass coatings
9. DEVOE high performance coatings

10. industrial and automotive coatings distributed by HPC HIGH PERFORMANCE COATINGS

[26] The above evidence reinforces the fact that HIGH PERFORMANCE is a term used to describe wares, such as the wares sold by the parties. Based on the ordinary meaning of the words “high (hi) performance”, as well as the evidence that the laudatory term “high performance” is commonly used in the relevant market, I accept that the first component of each party’s mark is an extremely weak component. I nevertheless agree with the Opponent that the Applicant’s evidence does not show that the words HIGH PERFORMANCE or HI PERFORMANCE have been commonly adopted as parts of trade-marks.

[27] Mr. Gaunt also provided pages from [www.generalpaint.com](http://www.generalpaint.com) dated 5/25/2009, which lists a number of products including “HP 2000 – a high performance waterborne coating” and HP 3000 – a low odour waterborne coating”. The Opponent’s HI-PERFORMANCE 2000 mark does not appear on the pages that have been provided.

[28] At paragraphs 29-30 of its written argument, the Applicant has made the following apt submissions, relying in part on *Culinar Inc. v. National Importers Inc.* (2005), 42 C.P.R. (4th) 180 (T.M.O.B.):

Descriptive elements of trade-marks are considered to be inherently weak and no single entity should be entitled to monopolize such words. In assessing the likelihood of confusion between marks which share a common word element, where the shared word is a descriptive, common or suggestive word, the significance of that shared element is diminished. Consumers will be likely to distinguish products sold in association with the shared element by reference to other words or indicia.

Where the element shared by two marks is descriptive, the fact that they share this element is not, in and of itself, sufficient to render the marks confusing. In this case, since HIGH PERFORMANCE/HI PERFORMANCE is such a common descriptive modifier, the fact that the marks at issue both contain that element should not be given a great deal of weight in the overall assessment of whether confusion is likely.

*ii) Examiner’s citation*

[29] The Opponent has evidenced that during the prosecution of this application, the Examiner cited the Opponent’s registration (the citation was withdrawn pursuant to submissions filed by

the Applicant). However, I do not consider this to be relevant as a decision by the Examination Section of the Canadian Intellectual Property Office is not binding on this Board and does not have precedential value for this Board.

### *Conclusion*

[30] In the circumstances of this case, I am satisfied that the differences between the final component of each mark in appearance, sound and idea suggested are sufficient that confusion between the marks as a whole is not likely. I note that while the trade-marks must be assessed in their entirety, it is still possible to focus on particular features that may be a determinative influence on the public's perception [see *Pink Panther Beauty Corp. v. United Artists Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.) at para. 34] and that, in the case of weak marks, small differences may suffice to distinguish one mark from the other [see for example: *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.); *Associated Brands Inc. v. Scott Paper Ltd.* (2004), 43 C.P.R. (4th) 361 (T.M.O.B.)].

[31] The s. 12(1)(d) ground is therefore dismissed.

### Distinctiveness Ground of Opposition

[32] The distinctiveness ground, as pleaded, relies solely upon a likelihood of confusion with the Opponent's mark. I am therefore disregarding the Opponent's submissions to the effect that the Applicant's Mark is not distinctive for other reasons.

[33] As stated previously, the date for considering the likelihood of confusion under the distinctiveness ground is earlier, namely May 30, 2008. The Opponent has not met its initial burden regarding the likelihood of confusion as of that date since it has not shown that its mark was known as of that date, let alone known sufficiently to negate the distinctiveness of the Applicant's Mark [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. The distinctiveness ground of opposition is therefore dismissed.



### Section 16(3)(a) Ground of Opposition

[34] In order to meet its initial burden under s. 16(3)(a), the Opponent must show that its mark was in use in Canada prior to June 29, 2006. As this has not been done, the s. 16(3)(a) ground is dismissed. (The mere allegation of use contained in the Opponent's registration does not satisfy the Opponent's evidential burden.)

### Section 16(3)(b) Ground of Opposition

[35] In order to meet its initial burden under s. 16(3)(b), the Opponent must evidence that its previously filed application was pending at the date of advertisement of the Applicant's application, namely April 2, 2008, as required by s. 16(4). As the Opponent's application issued to registration on July 6, 2001, the underlying application was not pending on April 2, 2008 [see *Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.) at 528]. The s. 16(3)(b) ground of opposition is therefore dismissed.

### Disposition

[36] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

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Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office