



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

**Citation: 2012 TMOB 16**  
**Date of Decision: 2012-1-24**

**IN THE MATTER OF AN OPPOSITION  
by 395925 Alberta Ltd. and Can-Cell  
Industries Inc. to application  
No. 1,358,677 for the trade-mark  
WEATHER SHIELD & Design in the  
name of Home Hardware Stores Limited**

[1] On August 3, 2007, Home Hardware Stores Limited (the Applicant) filed an application to register the trade-mark WEATHER SHIELD & Design (the Mark), which is shown below:



[2] The application is based on use of the Mark in Canada since at least as early as January 2006 in association with the following wares:

roof coatings, namely, patching cement, all-weather plastic cement, fibrated and non-fibrated roof coatings, plastic cement, aluminum fibrated roof coating, mobile home coating and N.I.S. cement cold processed roofing; coatings, cements, sealers and fillers, namely, non-fibrated foundation coating, roof cement, pressure wood foundation preservative coating, acrylic driveway sealer, charcoal filler, crack filler, concrete sealer and brick and block sealer.

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

[4] 395925 Alberta Ltd. and Can-Cell Industries Inc. (collectively the Opponent) filed a statement of opposition against the application for the Mark on October 20, 2008. 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 certified copies of two trade-mark registrations: TMA551,510 and TMA551,638.

[6] In support of its application, the Applicant filed certified copies of four trade-mark registrations: TMA330,055; TMA272,564; TMA611,976; and TMA399,640.

[7] Only the Opponent filed a written argument but both parties participated in an oral hearing.

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

[8] The grounds of opposition pleaded by the Opponent pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) are summarized below:

1. contrary to s. 30(b), the Applicant has not used the Mark with the wares since the date of first use alleged;
2. contrary to s. 12(1)(d), the Mark is not registrable because the Mark is confusing with the trade-marks WEATHERSHIELD and WEATHERSHIELD & Design registered by 395925 Alberta Ltd. under Nos. TMA551,510 and TMA551,638 respectively (collectively the Opponent's Marks); Can-Cell Industries Inc. is licensed by 395925 Alberta Ltd. to use such trade-marks;
3. contrary to s. 16(1)(a), the Applicant is not the person entitled to registration of the Mark because the Mark was, at the date of filing of the application, confusing with the Opponent's Marks, which were previously used in Canada by 395925 Alberta Ltd. and/or its licensee;
4. contrary to s. 16(1)(b), the Applicant is not the person entitled to registration of the Mark because the Mark was, at the date of filing of the application and at the date of first use alleged therein, confusing with the Opponent's Marks, previously filed by 395925 Alberta Ltd.;

5. contrary to s. 2, the Mark is not adapted to and does not distinguish the wares of the Applicant from those of 395925 Alberta Ltd. because the marks are confusing and the Opponent's Marks had been extensively used in Canada as of the date of filing of the opposition;
6. contrary to s. 30(i), the Applicant could not have been satisfied of its entitlement to use the Mark because the Applicant was aware of the Opponent's Marks when it filed its application.

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

- s. 12(1)(d) - the date of my decision [see *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. 16(1) – the Applicant's claimed date of first use;
- s. 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.)];
- s. 30 - the date of filing of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475].

### Onus

[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].

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

[11] An opponent's initial burden is met with respect to a s. 12(1)(d) ground of opposition if the registration upon which it relies is extant at the date of my decision. Each of the pleaded registrations is currently extant and so the Opponent has met its initial burden. The Applicant must therefore establish, on a balance of probabilities, that as of today's date there is not a reasonable likelihood of confusion between the Mark and either of the Opponent's Marks.

[12] The Opponent's WEATHERSHIELD & Design mark is shown below:



[13] Each of the Opponent's Marks is registered for the following wares and services, based on use in Canada:

wares - cellulose fibre insulation;

services - distribution to others and commercial application of cellulose fibre.

[14] As the Opponent's word mark is more similar to the Mark than is the Opponent's design mark, it presents the Opponent's stronger case. I shall therefore focus on the likelihood of confusion between the Mark and WEATHERSHIELD.

[15] 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.

[16] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion, the Registrar 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.), *Veuve Cliquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

*the inherent distinctiveness of the marks*

[17] Neither party's mark is inherently strong because in the context of their associated wares/services they are predominantly comprised of suggestive, ordinary dictionary words. The design features of the Mark add little to the distinctiveness of the Mark.

*the extent to which each mark has become known*

[18] A mark's distinctiveness may be increased through use and promotion but neither party has provided evidence that its mark has acquired distinctiveness.

*the length of time the marks have been in use*

[19] According to its registration, the Opponent has used WEATHERSHIELD in Canada since at least July 21, 1977, which is approximately 9 years prior to the Applicant's alleged first use. However, this factor is not significant in the present case because the Opponent has not established continuous use of its mark since the date claimed.

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

[20] When considering the wares and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [see *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.)].

[21] While the parties' wares are not identical, they may all qualify as home building products with the result that they may be sold through similar channels of trade and to similar consumers.

*the degree of resemblance between the marks*

[22] The Applicant has incorporated the Opponent's mark in its entirety into its Mark and merely added a surrounding rectangle. There is accordingly a high degree of resemblance between the marks in appearance, sound and ideas suggested.

*other surrounding circumstances*

*i) other marks owned by the Applicant*

[23] The Applicant has introduced evidence that it has previously registered four marks that include the words WEATHER SHIELD, namely:

1. TMA330,055



2. TMA272,564



3. TMA611,976

WEATHER SHIELD LEAK STOP

4. TMA399,640



[24] However, I do not consider the aforementioned registrations to be a significant additional circumstance as they do not give the Applicant the automatic right to obtain a further registration no matter how closely it may be related to existing registrations [see *American Cyanamid Co. v.*

*Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 571 (T.M.O.B.) at 576 and *Courtyard Restaurant Inc. v. Marriott Worldwide Corp.* (2006), 2006 CarswellNat 5371 (T.M.O.B.) at para. 58]. In addition, I note that each of the four registered marks is more distinguished from the Opponent's WEATHERSHIELD mark than is the Mark.

*ii) co-existence without evidence of confusion*

[25] An adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by the opponent [see *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) at para. 19]. However, in the present case, no adverse inference can be drawn as there is no evidence that there has been other than *de minimis* use of either mark.

*iii) state of the register*

[26] At the oral hearing, the Applicant's agent asked me to consider certain third party marks that are on the register. I declined, citing the Registrar's practice of only exercising his discretion to check the register to confirm the existence of registrations or applications that have been pleaded as the basis for a s. 12(1)(d) or s. 16 ground of opposition [see *Quaker Oats 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.) and *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.) at 529].

*conclusion*

[27] Having considered all of the surrounding circumstances, I find that the Applicant has not established, on a balance of probabilities, that confusion is not likely between the marks. I reach this conclusion primarily because there is a high degree of resemblance between the marks and both marks are associated with home building products. While it is true that the words WEATHER SHIELD or WEATHERSHIELD are not inherently strong, the mere addition of a rectangle does not serve to distinguish the Applicant's Mark from the Opponent's WEATHERSHIELD mark. Contrary to the Applicant's submission, I do not consider it significant that in one instance WEATHERSHIELD is one word and in the other it is two words.

[28] The s. 12(1)(d) ground accordingly succeeds insofar as it is based on registration No. TMA551,510. In addition, because the Mark is orally identical to the mark registered under No. TMA551,638, the s. 12(1)(d) ground also succeeds for similar reasons based on registration No. TMA551,638.

#### Remaining Grounds of Opposition

[29] The Applicant has submitted that the remainder of the grounds of opposition should be dismissed on the basis that the Opponent has not met its initial burden in respect thereof. I agree for the reasons set out below.

[30] In support of its s. 16(1)(a) ground of opposition, the Opponent was required to show that it had used its marks in Canada prior to January 2006 in order to meet its initial burden; it has not done so. Similarly, in support of its distinctiveness ground of opposition, the Opponent was required to show that its marks were known to some extent at least as of October 20, 2008 in order to meet its initial burden; it has not done so. I note that the mere filing of a certificate of registration of a trade-mark is not sufficient to meet the initial onus on an opponent under grounds of opposition of entitlement and distinctiveness [see *Rooxs, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) 265 (T.M.O.B.)].

[31] In support of its s. 16(1)(b) ground of opposition, the Opponent was required to show that the applications on which it relied had not only been previously filed but were also still pending at the date of advertisement of the Applicant's application as required by s. 16(4); neither of the Opponent's applications were then pending, as each had already issued to registration [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].

[32] An opponent's initial burden with respect to a s. 30(b) ground of opposition can be met by reference not only to the opponent's evidence but also to the applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at p. 230]. However, there is nothing in the evidence of record that supports the Opponent's allegation that the Applicant did not use the Mark as claimed. At the oral hearing, the Opponent's agent asked me to take notice of what it considered to be significant information in



another application/registration on the register. I declined, citing the Registrar's practice to only check the register in very limited circumstances, as referred to above.

[33] Finally, 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]; there is no such evidence here.

#### Disposition

[34] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

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