IN THE MATTER OF AN OPPOSITION by Schlegel Corporation to application No. 767,947 for the trade-mark FINSTRAL & Design filed by Finstral S.P.A.

On November 4, 1994, the applicant, Finstral S.P.A., filed an application to register the trade-mark FINSTRAL & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada and use and registration of the trade-mark in Italy in association with "Door and window frames (all being nonmetallic)." The applicant claimed the following colours as a feature of its trade-mark: the square before FINSTRAL is blue and white and the word FINSTRAL is orange.

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of September 6, 1995 and the opponent, Schlegel Corporation, filed a statement of opposition on February 5, 1996, a copy of which was forwarded to the applicant on February 22, 1996. The applicant served and filed a counter statement on June 20, 1996. The opponent filed as its evidence the affidavits of LeRoy Overacker, Harold R, Gibson and Grant Skippen, together with a certified copy of registration No. 255,634 and a certified copy of extracts from the prosecution file of the present application. The applicant submitted as its evidence the affidavits of Gaétane Lepage, Marylène Gendron, Oberrauch Hans and two affidavits of Carole Delisle. Both parties filed a written argument and both were represented at an oral hearing.

The opponent has alleged that the present application does not conform to Subsections 30(a) and 30(d) of the ***Trade-marks Act***. The legal burden or onus is on the applicant to show that its application complies with Section 30. This includes both the question as to whether or not the applicant has filed an application which formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the opponent relies on allegations of fact in support of its Section 30 grounds, there is an

evidential burden on the opponent to prove those allegations [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see ***John Labatt Limited v. The Molson Companies Limited***, 30 C.P.R. (3d) 293, at p. 298]. Further, the material time for considering the circumstances respecting the issue of the applicant's compliance with Section 30 of the ***Act*** is the filing date of the application [see ***Georgia-Pacific Corp. v. Scott Paper Ltd.***, 3 C.P.R.(3d) 469, at p. 475].

With respect to the Subsection 30(a) ground, the opponent has asserted that the present application does not contain a statement in ordinary commercial terms of the specific wares in association with which the mark is alleged to have been used and is proposed to be used because the applicant sells doors and windows (and not door frames and window frames). However, no evidence has been furnished by the opponent in support of its allegation that the applicant intends to sell doors and windows and not door frames and window frames. Furthermore, while the opponent may rely upon the applicant's evidence to meet its initial evidential burden, the applicant's evidence is not, in my view, clearly inconsistent with its claim that it intends to use the trade-mark FINSTRAL & Design in Canada in association with door frames and window frames. In particular, in paragraph 8 of his affidavit, Mr. Hans states that the applicant manufactures and commercialises complete systems of windows and doors and semi-finished products under its trade-marks and that, in the case of semi-finished products, the applicant's clients assemble the doors and windows themselves. As semi-finished products could well include door frames and window frames, I find that the opponent has not met its evidential burden in respect of this ground and have therefore rejected the Subsection 30(a) ground of opposition.

The second Section 30 ground is based on Subsection 30(d) of the ***Act***, the opponent alleging that the application contains a false statement that the mark FINSTRAL & Design has been used in association with door and window frames (all being non-metallic). Again, no evidence has been furnished by the opponent in support of its allegation and, as noted above, the applicant's evidence is not clearly inconsistent with its claim that it has used the trade-mark FINSTRAL & Design in Italy

in association with door frames and window frames. This ground is also unsuccessful.

The next ground of opposition is based on Paragraph 12(1)(d) of the ***Trade-marks Act***, the opponent alleging that the applicant's trade-mark is not registrable in that the trade-mark FINSTRAL & Design is confusing with its registered trade-mark FIN-SEAL, registration No. 255,634, covering weather stripping and weather seals of the pile type. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Subsection 6(2) of the ***Trade-marks Act***, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Subsection 6(5) of the ***Act***. Furthermore, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date for assessing the Paragraph 12(1)(d) ground [see ***Park Avenue Furniture Corporation* v. *Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering initially the inherent distinctiveness of the trade-marks at issue [Paragraph 6(5)(a)], the applicant's mark FINSTRAL & Design is inherently distinctive in that it is neither descriptive nor suggestive of the applicant's wares, nor does it possess any other connotation which would detract from its inherent distinctiveness. The opponent's trade-mark FIN-SEAL, on the other hand, is descriptive of the character of its weather stripping, that is, that the weather stripping incorporates a fin and provides a weather seal. While the applicant submitted that the opponent's mark FIN-SEAL is the name of its wares, I do not agree. The opponent's wares might well be identified as "finned weather stripping" or as a "finned weather seal" and even possibly as a "finned seal". However, I would not expect the average consumer to refer to those wares as FIN-SEAL. In any event, the opponent's trade-mark FIN-SEAL is a weak mark and, in the absence of significant evidence of acquired distinctiveness, would only be entitled to a narrow ambit of protection.

The opponent has submitted that its evidence establishes that its trade-mark FIN-SEAL is well known in Canada in association with weathers stripping. In this regard, Mr. Skippen, Sales Manager, Building and Construction of Schlegel Canada Inc., states that his company, which is a

wholly-owned subsidiary and licensee of the opponent, has sold over 35 million feet annually of FIN-SEAL weather stripping in Canada over the seven years prior to the date of his affidavit [January 17, 1997] and that this has been used to seal over a million windows and doors. However, the opponent's evidence does not establish that its trade-mark FIN-SEAL is directly associated with its weather stripping at the time of the transfer of property in or possession of the wares in the normal course of trade. Rather, the opponent's wares have been sold in association with an FS code which refers to the colour, pile height and backing width of the weather stripping. The FS code has been used since prior to 1990 and is identified in the opponent's catalogues as referring to FIN-SEAL weather stripping, the code appearing on gummed labels affixed to rolls of the opponent's weather stripping which is sold to its customers. Apart from its catalogues which have been distributed to customers and potential customers in Canada, there is relatively little evidence relating to advertising or promotion of the opponent's FIN-SEAL weather stripping. Thus, while the opponent's evidence establishes that its weather stripping is well known in Canada, I am not convinced that the trade-mark FIN-SEAL has been shown to be well known even amongst the opponent's customers [see Overacker affidavit, para. 9].

As no evidence has been furnished by the applicant relating to use of its trade-mark in Canada, the trade-mark FINSTRAL & Design must be considered as not having become known to any extent in Canada. Thus, the extent to which the trade-marks at issue have become known in Canada [Paragraph 6(5)(a)] weighs in the opponent's favour. Likewise, the length of time the trade-marks have been in use [Paragraph 6(5)(b)] is a further factor favouring the opponent, the latter having used its FIN-SEAL trade-mark in Canada since at least 1985 whereas the applicant has yet to commence use of its trade-mark FINSTRAL & Design in Canada.

As for the nature of the wares of the parties [Paragraph 6(5)(c)] and their respective channels of trade [Paragraph 6(5)(d)], the applicant's door and window frames (all being nonmetallic) differ from the applicant's weather stripping and weather seals of the pile type. However, the wares of both parties are directed to the same channels of trade in that the opponent's wares are sold primarily to manufacturers of window and doors and the applicant's door and window frames would also be sold to these same manufacturers. Further, the applicant's door frames and window frames would

most likely incorporate weather seals or weather stripping once the windows and doors are assembled by the manufacturer and might possibly incorporate the opponent's FIN-SEAL weather stripping.

Considering the degree of resemblance between the trade-marks at issue [Paragraph 6(5)(e)], the trade-marks FINSTRAL & Design and FIN-SEAL bear some similarity in appearance and sounding when considered in their entireties although the marks do not convey similar ideas.

As a further surrounding circumstance in respect of the issue of confusion, the applicant relied upon evidence of the state of the register. However, the Gendron affidavit disclosed only five registrations which I consider to be of relevance to the issue of confusion in this proceeding, these being for the trade-marks: FIN-ALL; FINAR; FINACLEAN; FINAPRENE; and FINYL VINYL. From the Lepage affidavit, it would appear that the trade-mark FINYL VINYL is not in use in Canada and, apart from the issue of the Delisle affidavits being hearsay, they do not otherwise provide evidence from which it could be concluded that the trade-marks FINACLEAN and FINAPRENE are in use in Canada. Further, while the Lepage affidavit, which also is largely hearsay evidence, does indicate that the FIN-ALL and FINAR marks may be in use in Canada, no evidence has been furnished by the applicant to show that the wares associated with these marks would travel through the same channels of trade as the wares of the parties. Consequently, this evidence is of little assistance to the applicant in this opposition.

Considering that the opponent's trade-mark FIN-SEAL is descriptive when applied to weather stripping and is therefore a weak mark and has not been shown to have acquired any significant measure of distinctiveness in Canada, and considering that there is only a limited degree of similarity in appearance and sounding between the trade-marks FINSTRAL & Design and FIN-SEAL when considered in their entireties, and bearing in mind that the wares of the parties do differ although they would certainly travel through the same channels of trade, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion and have therefore rejected the Paragraph 12(1)(d) ground of opposition.

The opponent also alleged that the applicant is not the person entitled to registration of the trade-mark FINSTRAL & Design because, as of the applicant's filing date, the applicant's mark was confusing with its trade-mark FIN-SEAL which has previously been used in Canada in association with weather stripping and weather seals. The opponent has met the burden upon it under Subsections 16(5) and 17(1) of the ***Trade-marks Act*** of establishing its prior use of the trade-mark FIN-SEAL in Canada in association with weather stripping, as well as showing that it had not abandoned its trade-mark as of the date of advertisement of the present application. Accordingly, the legal burden is upon the applicant to show that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the applicant's filing date. My previous comments concerning the surrounding circumstances in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) ground also apply to the assessment of the likelihood of confusion in respect of the non-entitlement ground even though the material date is the applicant's filing date. Consequently, this ground is also unsuccessful.

In view of the foregoing, I do not propose to consider the opponent's final ground relating to the distinctiveness of the applicant's trade-mark in detail. However, I would have found that the applicant has met its legal burden of showing that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of opposition, the material date for considering this ground. I have therefore dismissed this ground of opposition.

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

DATED AT HULL, QUEBEC THIS 12th DAY OF NOVEMBER, 1998.

G.W. Partington
Chairperson
Trade-marks Opposition Board