



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

Citation: 2012 TMOB 203
Date of Decision: 2012-10-31

**IN THE MATTER OF AN OPPOSITION
by General Paint Corp. to application
No. 1,334,684 for the trade-mark
BECKERS & Design in the name of
Aktiebolaget Wilh. Becker.**

[1] On February 9, 2007 Aktiebolaget Wilh. Becker (the Applicant) filed an application to register the trade-mark BECKERS & Design (the Mark), shown below, in respect of the following wares:

(1) Paints, industrial paints, paint coatings, colorants; powder coatings. (2) Varnishes and lacquers; primers; enamels for painting; preservatives against rust and against deterioration of wood; mordants; metals in foil and powder form for painters.



[2] The application is based on use in Canada since at least as early as 2000 on wares (1), and proposed use in Canada on wares (2).

[3] Colour is claimed as a feature of the Mark as follows:

The word Beckers is coloured black. The outermost semicircular band is coloured red; the next inner band is coloured orange; the next inner band is coloured yellow; the next inner band is coloured green; the innermost band is coloured blue and the semicircle is coloured white.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 24, 2008. A statement of opposition was filed by the Opponent on January 16, 2009; the Applicant filed its counterstatement on March 31, 2009. Leave was granted to the Opponent to file an amended statement of opposition on October 15, 2009.

[5] The Opponent filed the affidavit of Todd Lewis sworn on July 30, 2009. The Applicant filed the affidavits of Pellegrino Fiorillo, sworn on November 27, 2009, Thomas K. Rudland, sworn on November 27, 2009, and Carla Edwards sworn on November 25, 2009. No cross-examinations were conducted. Both parties filed written arguments and were represented at an oral hearing.

Grounds of Opposition pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act)

[6] The grounds of opposition are summarized below; the relevant date with respect to assessment of each ground is included.

Section 38(2)(a) and Section 30

[7] The Applicant has not used the Mark in Canada since the date indicated in the application or in the manner alleged in association with wares (1), and therefore is non-compliant with section 30(b).

[8] The Mark as advertised is not an accurate representation of any mark actually used by the Applicant and its predecessors, if any, and therefore is non-compliant with section 30(h).

[9] The Applicant did not comply with section 30(e), in that it did not intend to use the Mark in Canada with the alleged wares (2), in view of the Applicant's business operations and activities.

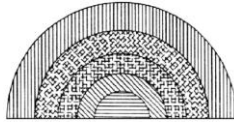
[10] The relevant date for determining compliance with section 30 is the date of filing the application, namely February 9, 2007 [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B); *Canadian National Railway Co. v. Schwauss* (1991), 35 C.P.R. (3d) 90 (T. M.O.B.)].

Section 38(2)(b) and Sections 12(1)(a) and (d)

[11] The application is not registrable as it is primarily merely the name or surname of an individual who is living or had died within the preceding 30 years and does not meet the requirements of section 12(1)(a).

[12] The application is not registrable in that it is confusing with the Opponent's registered trade-marks (below) and therefore does not meet the requirements of section 12(1)(d):

(a) TMA265, 909 RAINBOW DESIGN



Wares: Interior and exterior latex and alkyd paints, alkyd, chlorinated rubber, vinyl, epoxy, and polyester enamels.

(b) TMA273,896 GENERAL PAINT & RAINBOW DESIGN



Wares: Interior and exterior latex and alkyd paints, alkyd, chlorinated rubber, vinyl, epoxy, and polyester enamels.

(c) TMA519,790 GENERAL PAINT & RAINBOW DESIGN



Services: Operation of a store selling paints, stains, decorative coatings, protective coatings, specialty coatings, thinners, wallpaper, decorating-related products and all accessories, supplies and application tools relating to all such wares

(d) TMA554, 361 – GENERAL PAINT AND PAINT EXPERTS & RAINBOW DESIGN



Services: Operation of a store selling paints, stains, decorative coatings, protective coatings, specialty coatings, thinners, wallpaper, decorating-related products and all accessories, supplies and application tools relating to all such wares.

(e) TMA 557,474 GENERAL PAINT AND THE PAINT EXPERTS & RAINBOW DESIGN.



Wares: Interior and exterior coatings, namely latex, oil-based and alkyd paints.

[13] I note that the Opponent's trade-marks above, as reproduced from the Register, are lined for colour according to section 28(2) of the *Trade-Marks Regulations*; this accounts for the difference in appearance when compared to the representation of the Mark which is not lined for colour; rather the application includes only a descriptive colour claim pursuant to section 28(1).

[14] The relevant date for determinations under section 12(1)(a) of the Act is generally considered to be the date of filing of the application, namely February 9, 2007, [*Calvin Klein Trade-mark Trust v. Wertex Hosiery Inc.* (2004), 41 C.P.R. (4th) 552 (T.M.O.B.); *Jurak Holdings Ltd. v. Matol Biotech Laboratories Ltd.* (2006), 50 C.P.R. (4th) 337 (T.M.O.B.)].

[15] The relevant date for determinations under section 12(1)(d) of the Act is the date of 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.)].

Section 38(2)(c) and section 16(1)(a) and section 16(3)(a)

[16] With respect to section 16(1)(a), the allegation is that the Applicant is not entitled to registration of the Mark in that at the filing date, the Mark was confusing with the Opponent's trade-marks that had been previously used in Canada as set out above. I note that this ground applies only in respect of wares (1) in association with which the Mark has been used in Canada since 2000.

[17] With respect to section 16(3)(a), the allegation is that the Applicant is not entitled to registration of the Mark in that prior to and at the filing date the Mark was confusing with the Opponent's trade-marks that had been previously used in Canada as set out above. I note that this ground applies only in respect to wares (2) in association with which the application is based on proposed use in Canada.

[18] The relevant date for determinations of entitlement under section 16 is the date of filing of the application, namely, February 9, 2007. In accordance with section 16(5) the Opponent must establish that its marks had not been abandoned at the date of advertisement of the subject application.

Section 38(2)(d)/(2) of the Act – Non-Distinctiveness

[19] The Opponent alleged that at the date of filing of the application, the Mark was not distinctive because it is not capable of distinguishing the Applicant's wares from the Opponent's wares, namely, "interior and exterior latex and alkyd paints, oil-based paints, alkyd, chlorinated rubber, vinyl, epoxy and polyester enamels", and services, namely "operation of a store selling paints, stains, decorative coatings, protective coatings, speciality [sic] coatings, thinners, wallpaper, decorating related products and all accessories, supplied and application tools relating all such wares". The Opponent also alleges that the Mark is not adapted to distinguish them because the Mark has been used by entities other than the owner or approved licensee.

[20] The material date for this ground is the date the opposition was filed, namely, January 16, 2009.

Onus and Evidential Burden

[21] The legal burden lies on the Applicant in an opposition proceeding; the Applicant must establish 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, which means that in order for a ground to be considered at all, there must be 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 CPR (3d) 293 (FCTD) at 298].

Grounds that may be summarily dismissed

[22] With respect to the allegation pursuant to section 30(b), I find that the Opponent has not met its initial burden. While the Opponent may rely upon the Applicant's evidence to meet its initial burden [which is lighter than usual, see *Molson Canada v. Anheuser-Busch Inc.* (2003), 29 C.P.R. (4th) 315 (F.C.T.D.)], the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd. v. ICON Health & Fitness Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)]. The Opponent alleged that the wares (1) sold by the Applicant since 2000 were not associated with the Mark in accordance with section 4(1) of the Act; however, there is ample evidence of sales of the wares bearing the Mark. Although the Opponent refers to a previous opposition proceeding regarding a similar trade-mark in which the application was voluntarily abandoned by the Applicant, the facts in that case are not in evidence in this proceeding, and therefore cannot be used to argue inconsistency with the Applicant's claim in this case. This ground is therefore dismissed.

[23] Similarly, I am not satisfied that the evidence adduced in the present case is sufficient to meet the opponent's evidential burden under section 30(e). The Opponent has not directed attention to any facts that would cast doubt on the Applicant's intention to use (either by itself or through a licensee) the Mark at the date it filed its application in association with the applied for wares (2). This ground is therefore dismissed.

[24] In addition, the Opponent's reliance on section 30(h) of the Act may be summarily dismissed in that it is considered that the wording of this section, read with the preamble in section 30, simply requires (unless the trade-mark is in words only or words not depicted in special form), that accurate representations of the trade-mark, *as applied for*, be contained in the Application. As such is the case, this ground is dismissed.

[25] With respect to the allegation under section 12(1)(a) the Opponent has provided no support for its allegation that the Mark is primarily merely a surname; nor did it advance any arguments on this issue. Consequently, this ground is dismissed.

Remaining Grounds of Opposition

[26] The remaining grounds of opposition turn on the issue of confusion between the trade-marks at issue; as such, a determination on the likelihood of confusion will resolve grounds raised with respect to registrability, entitlement and non-distinctiveness. The key evidence in this regard is summarized below.

Opponent's Evidence

[27] The affidavit of Todd Lewis, Category Manager of General Paint Corp. (General Paint or the Opponent) sets out that he has been employed by the Opponent since 1986 and is directly involved in the Opponent's use of trade-marks in advertising, marketing and other materials, and in the monitoring of sales of paint products.

[28] The affiant provides that the Opponent is the owner of 6 applications and 91 registrations in Canada, among these are the five registrations that incorporate a rainbow design relied on in this proceeding (the Rainbow Design trade-mark).

[29] The company and its predecessor in title have been in existence producing paints since 1911. In 1930 the company name was changed to General Paint Corporation of Canada, and by the 1970's the Opponent alleges that it was the largest paint company west of Toronto. Eventually it assumed the current name, General Paint Corp.

[30] The adoption of the rainbow logo to reflect the broad array of colours available from General Paint commenced in 1980; the initial trade-mark registration incorporating the Rainbow Design was obtained in January of 1982. Copies of product information pages, bearing the Opponent's trade-mark, as printed from the Opponent's website on July 23, 2009 are attached as Exhibit G.

[31] Over the past five years the Opponent's annual Canadian sales revenue averaged approximately \$150 million; 60 to 70% of which were sales in association with the Rainbow Design trade-mark. This includes both retail and industrial sales;

[32] The affiant provides that in a typical year, the Opponent sells approximately 16-17 million litres of paint in association with the Rainbow Design. The Opponent stocks in excess of 900-1000 different product labels incorporating the Rainbow Design, for different types, container sizes, and colours of paint. Approximately 50% of sales are to contractors, 15-20% are consumer retail sales, 10-15% are industrial sales and the balance of sales are to dealers. The Opponent sells its products through its own corporate stores, dealer stores and through salaried sales representatives.

[33] The Opponent has 87 stores plus a dealer network of approximately 300 stores, located throughout Western Canada and Ontario. Some of the Opponent's products sold in association with the Rainbow Design are also sold through a private label customer, which has more than 200 outlets. I note that there is no mention that these outlets are in Canada.

[34] The Opponent makes industrial sales through its corporate stores and sales representatives, and industrial sales staff. Industrial sales are made to steel fabricators, pulp mills, saw mills, BC Ferries; sales are also made for light industrial applications such as for use on dumpsters.

[35] The affiant asserts that the Rainbow Design trade-mark is the Opponent's main trade-mark, it is used on labels for paints, and all related marketing and advertising materials. Sample labels for paint containers are included in the materials attached as Exhibit I. Over the past five years, the Opponent spent an average of \$2 million a year in advertising in Canada; this includes advertising in flyers, mailers, billboards, newspaper ads, magazine ads, directory listings,

contests, etc, samples of which are also included in Exhibit I. I note that generally in the marketing and promotional material the trade-mark appears as in TMA 557,474; whereas on the actual product labels, and depictions of the cans of paint in the promotional material, the words GENERAL PAINT are placed before the Rainbow rather than beneath it.

Applicant's Evidence

[36] The Affidavit of Carla Edwards establishes that she is a secretary employed by the Applicant's agent for more than nine years. The affidavit appears directed towards establishing that third party paint suppliers utilize fan decks and images of fan decks and the like, spread out to resemble an open fan in a colourful rainbow-like manner.

[37] On November 25, 2009 Ms. Edwards accessed the webpage at www.atoptics.co.uk/rainbows/primcol.htm and provides a screen print (Exhibit A) of a graphic image of a digital colour chart showing "primary rainbow colours". The affiant states that she also accessed the website at www.warminteriors.com and provides a printout of that page as Exhibit B. This Exhibit shows a fan deck spread out to a complete circle and which is described as a useful tool for choosing paint colours.

[38] Similarly, Ms. Edwards provides colour photographs of paint fan decks for various brands of paint as Exhibit C; these depict fan decks opened up halfway to form a semi-circle. Ms. Edwards does not explain how these photographs were obtained.

[39] Exhibits D and E are print outs of web pages depicting paint fan decks of third parties as items one can purchase on line.

[40] I note that the Opponent did not object to the printouts of web pages as hearsay. Although they cannot be considered as evidence of the truth of their contents, I am prepared to give them some weight as support for the simple fact that fan decks seem to be associated with the sales of paint. I also note that Ms. Edwards purchased one third party paint fan deck personally; Exhibit F is a copy of a receipt for purchase of a BENJAMIN MOORE paint fan purchased in Pickering, Ontario on November 5, 2009.

[41] The Affidavit of Pellegrino Fiorillo establishes, *inter alia*, that he is the President/Managing Director of Becker Acroma Inc. and has held his position since January, 2005; Mr. Fiorillo has been with the company since July, 2000.

[42] The affiant provides that the Applicant is wholly-owned by Lindéngruppen AB, a Swedish company, and that the Applicant acts as the parent company with operations carried out by its various divisions throughout the world. He states that Becker Acroma manufactures liquid industrial paints under the Mark for various industrial applications such as home furniture, office furniture, kitchen and bathroom cabinets and doors, flooring, exterior applications such as windows, doors, garden furniture, joinery and millwork such as doors, mouldings, beading, skirting board and staircases as well as for the board industry.

[43] The affiant states that since 2000, Becker Acroma has been selling liquid industrial paints in Canada in association with the Mark pursuant to a license agreement between the Applicant and Becker Acroma. The Applicant has care and control over the nature and quality of the liquid industrial paints sold in Canada in association with the Mark.

[44] Mr. Fiorillo further provides that since 2000, sales have averaged in excess of \$15 million CAD annually.

[45] Mr. Fiorillo attaches copies of Becker Acroma's various brochures which target the office furniture, home furniture, kitchen and bath and flooring sectors; also attached are "hook sheets" that Becker Acroma makes available to potential customers (Exhibit B). The Mark is clearly visible on all these exhibits.

[46] Becker Acroma exhibits at the Wood Machinery Show held every other year and attends the Association of Woodworking & Furnishings Suppliers (AWFS); Exhibit D is a picture of Becker Acroma's booth at the 2009 AWFS trade show in Las Vegas, Nevada. The affiant also provides printouts of the membership list/directory for the Canadian Kitchen Cabinet Association as well as the Architectural Woodwork Manufacturers Association of Canada, which lists Becker Acroma as one of its members (Exhibit E1-E2).

[47] Exhibit F is a copy of the Becker Acroma North America Marketing Campaign used by Becker Acroma to target the wood finishing market for both direct and distributor channels.

[48] Mr. Fiorillo states that since Becker Acroma first began using the Mark in Canada and in the U.S. in association with its products, it has averaged in excess of \$200,000 CAD annually in advertising expenditures of which approximately 40% may be attributed to Canadian expenditures.

[49] The affidavit of Thomas K. Rudland establishes that he is the Director of Finance for Becker Industrial Coatings Inc. (Beckers BIC) and that he has held his position since April 2, 2009, prior to which he had been the Manager of Finance since May 2000.

[50] The affiant states that the Applicant is wholly-owned by Lindéngruppen AB and acts as the parent company with respect to various divisions, including Beckers BIC. Beckers BIC has been selling liquid coatings in Canada in association with the Mark since 2000.

[51] Pursuant to a license agreement between the Applicant and Beckers BIC, the Applicant maintains care and control over the nature and the quality of the liquid coatings made and sold in Canada by Beckers BIC in association with the Mark.

[52] Beckers BIC manufactures liquid coatings under the Mark for the industrial finishing of metal and plastic substrates as well as supplies “special coatings” to companies in many major industrial sectors including the automotive sector and consumer electronics. Operations may be divided into two business areas: the services of coil coaters and their customers in the architectural, building, transport, domestic appliance fields as well as other fields; and the special coatings area which supplies mobile phone, consumer electronics, transport and other companies with special coatings for metal and plastic substrates.

[53] The affiant states that typically, Beckers BIC sells its liquid coatings in Canada in pails, drums and bulk totes, and provides a sampling of labels showing the Mark as it would normally be applied to the goods as Exhibit A. Beckers BIC has averaged sales of such products in excess of \$12 million CAD annually since 2000.

[54] Exhibit B is a copy of Beckers BIC product brochures that are made available with product data sheets to potential customers. Exhibit C is a panel envelope that shows use of the Mark; these envelopes are typically applied to sample products sent to its customers for their approval of the sample. Exhibit D is a copy of an advertisement also displaying the Mark that

appeared in SDI: Steel Dynamics' Coil-Coating Line Commemorative Journal dated November/December 2003.

[55] Mr. Rudland also states that Becker's BIC has exhibited at several trade shows such as the semi-annual National Coil Coaters Convention as well as the annual Metalcon International Trade Show and provides a photo of Beckers BIC's booth at Metalcon 2002 as Exhibit E.

[56] Mr. Rutland further provides that since Becker's BIC first began using the Mark in Canada in 2000 in association with liquid coatings, it has averaged in excess of \$20,000 CAD annually on advertising expenditures relating to advertisements, brochures, product data sheets, sample panel envelopes, promotional items and the operation of its website at *www.beckercoatings.com*.

Confusion Pursuant to Section 12(1)(d) of the Act

[57] The principal ground of opposition relates to confusion pursuant to section 12(1)(d) of the Act. An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if one or more of the registrations relied upon are in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the registrations for the trade-marks relied on by the Opponent are extant and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden to demonstrate that there is no likelihood of confusion between the trade-marks at issue.

[58] 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.

[59] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 CPR (4th) 321 (SCC) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR (4th) 361 (SCC).]

[60] With respect to the Opponent's trade-marks, I am of the view that they are substantially similar to each other; the rainbow design remains dominant in each and moreover, the text portions are small and contain virtually identical information. I consider that use of any one of the trade-marks is use of the other. In particular, I note that the Opponent's original registration is for the rainbow design only, and further that this is the Opponent's strongest case for the purposes of analysis under section 12(1)(d) and section 6(5) of the Act.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[61] In most instances, the dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)]. Recently, in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.), the Supreme Court of Canada considered the importance of the s. 6(5)(e) factor in conducting an analysis of the likelihood of confusion (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[62] In the present case, the Mark and the Opponent's trade-mark are substantially similar in appearance; that is to say, the dominant rainbow design portions are identical. The trade-marks differ only in that the Mark has an additional text portion - BECKER'S. However, I do not consider that text portion to be more prominent than the design, taking into consideration the proportion of the rainbow design in the Mark when viewed as a whole.

[63] The Mark incorporates the Opponent's trade-mark in its entirety. Clearly, the marks differ when sounded, in that the Mark can be sounded and the Opponent's trade-mark cannot; however, I am of the view that since the design portion is the dominant feature of the Mark, the difference when sounded is not a significant factor.

[64] With respect to the ideas suggested by the respective trade-marks, the Applicant argued that the rainbow design was suggestive of a paint fan used in the trade for choosing colours. I do not agree. Given that the colours claimed in both designs are the traditional colours of the rainbow, in my view it is more reasonable to think that the average consumer would simply see the design as a rainbow suggesting the colourfulness of paint. The idea suggested by the Mark is Becker's colourful paint; the idea suggested by the Opponent's trade-mark is - colourful paint (wares) and sales of colourful paint (services).

[65] On balance, given that the design portions are identical, and the trade-marks as a whole, are substantially similar, given the dominance of the design portion, I find that this factor favours the Opponent. Thus, the other surrounding circumstances take on added significance.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[66] The trade-marks at issue do not have a strong degree of inherent distinctiveness as a rainbow in association with paint is highly suggestive of the colorfulness of paint. However, the Mark has more inherent distinctiveness since it also incorporates a word portion. I note that Becker's does not appear to be a common dictionary word, and although the Opponent alleged that it was a surname, no evidence was advanced in this regard.

[67] Trade-marks can acquire distinctiveness through use. Sales and advertising figures have been provided for both trade-marks at issue; however, it is clear from the evidence that the

Opponent's annual sales figures provided for the past five years (60% - 70% of total sales of 150 million CAD), exceed the annual sales of the Applicant (12 million CAD for Becker Acroma; 10 million CAD for Beckers BIC). Further, taking into consideration the Opponent's 87 retail stores, dealer network of 300 stores and sales through 200 other third party outlets, I am prepared to infer that the Opponent's trade-mark has acquired more distinctiveness than the Mark.

Section 6(5)(b)- The length of time each has been in use

[68] It appears that the Mark has been in use since 2000, with respect to wares (2) "paints, industrial paints, paint coatings, colorants; powder coatings". On the other hand, the Opponent's alleges that its trade-mark was first used in 1980, some twenty years more than the subject Mark. The Applicant argues that the documentary evidence provided does not support this allegation, and I would agree that sales and advertising figures and samples provided relate only to the five year period prior to the filing of the evidence. However, the Opponent has had a registration for its Rainbow Design since 1982, from which I am prepared to infer at least *de minimis* use during the preceding years [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. As such, although the Opponent has failed to provide direct evidence to supports its allegation of use going back to 1980, the evidence nonetheless establishes that its trade-mark has been used for a longer period of time than has the Mark. The overall consideration of this second factor thus favours the Opponent [*Lise Watier Cosmétiques Inc. v. Villoresi* 76 C.P.R. (2009) (4th) 196 (T.M.O.B.)].

Section 6(5)(c) and (d) - The nature of the wares, services or business; the nature of the trade

[69] The nature of some of the wares is virtually identical; the Opponent's wares, taking into consideration the sum of its registrations are: Interior and exterior latex and alkyd paints, alkyd, chlorinated rubber, vinyl, epoxy, and polyester enamels. Interior and exterior coatings, namely latex, oil-based and alkyd paints. The Mark is applied for in association with virtually identical wares, some of which are more specifically defined, including paint powder, varnishes and lacquers. I have noted that some of the Applicant's wares are expressly described as being industrial paints; however, I see nothing in any of the Opponent's descriptions of wares that precludes sales of its products for industrial uses.

[70] The Opponent's services are: Operation of a store selling paints, stains, decorative coatings, protective coatings, specialty coatings, thinners, wallpaper, decorating-related products and all accessories, supplies and application tools relating to all such wares. I would again observe that nothing in this description precludes the sales of paint related products to the industrial sector.

[71] In sum, I find that the nature of the wares and the business are overlapping, although it appears that the Applicant's are more far reaching, they definitely include those of the Opponent.

[72] Accordingly I consider that this factor favours the Opponent.

Conclusion

[73] Taking into consideration all of the foregoing, in particular the fact that the trade-marks at issue are virtually identical as are the associated wares, I find that on a balance of probabilities there is a likelihood of confusion within the meaning of section 12(1)(d) and section 6(5) of the Act. Accordingly the Opponent is successful on this ground of opposition.

[74] As the Opponent has been successful under this main ground of opposition, there is no need to consider the remaining grounds.

Disposition

[75] In view of all of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

P. Heidi Sprung
Member, Trade-marks Opposition Board
Canadian Intellectual Property Office