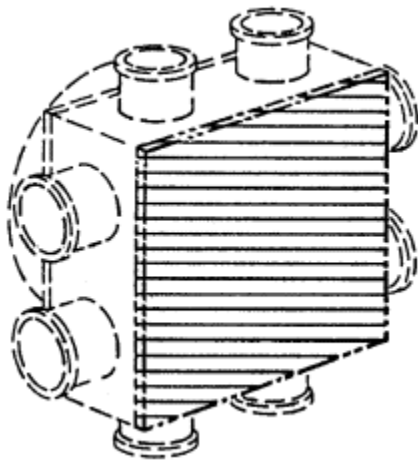


**IN THE MATTER OF AN OPPOSITION by The
Lamson & Sessions Co. to application No.
1,094,354 for the trade-mark Junction Box Design
(green) in the name of Royal Group, Inc.**

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



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

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 14, 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 landscaping and/or agricultural 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 green used in association with electrical junction boxes constitutes a mark (the "Green 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 Green 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 landscaping and/or agricultural applications. The opposed mark either consists of the Green Mark or so nearly resembles the Green 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 green 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 affidavit of Steven Randall Whaley. 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. (4th) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 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 green used in association with electrical junction boxes is recognizing that the electrical junction boxes in association with which it is used are of a kind which is appropriate for landscaping and/or agricultural applications. The colour green in the electrical industry is also used to identify a ground or grounding part.”

“Electrical boxes and junction boxes that are used outdoors are normally coloured green.”

(paragraphs 6 and 10, Whaley affidavit, sworn April 2, 2005)

In support of the above statements, Mr. Whaley provides the following materials:

- Exhibit A: copies of pages of Canadian Standards Association’s 2002 Canadian Electrical Code
 - Rule 4-036 states that insulating grounding or bonding conductors shall have a continuous outer finish that is either green or green with one or more yellow stripes
 - Rule 10-510 states that a bonding conductor which is run with circuit conductors as a part of a cable assembly and which may be uninsulated, but, if provided with an individual covering, the covering shall be finished to show a green or a green/yellow combination

(pages printed 3/20/2005)

- Exhibit B: undated pages from the website of Nordic Fiberglass, Inc. of Minnesota that advertise the following products with “Munsell green gel-coat for superior weatherability”: ground sleeves for sectionalizing cabinets; box pads for single phase transformers; box pads for air-insulated & oil-filled switchgear; hand holes; etc.
- Exhibit C: an advertisement for Nordic Fiberglass Products from the February 2005 edition of *Utility Products* trade magazine; the displayed products are green in colour. There is no evidence that this magazine circulated in Canada.
- Exhibit D: undated pages from the website of Lew Electric Fittings Company of Illinois that advertise floor boxes, the bottom portion of which are green

Two other exhibits have been provided by Mr. Whaley, namely:

- an undated advertisement by Royal Pipe Systems, a member of the Royal Group of Companies, that displays color coded ENT slab boxes; although there is no picture of a green box, there is a legend indicating that green is for security, cable, telephone
- 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 green face plate.

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

Section 12(1)(b) Ground of Opposition

There is no evidence that the colour green described landscaping and/or agricultural 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 green 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 green has an accepted meaning in the parties' industry; instead it shows that green is used by various parties to indicate different things. 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 green 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 25th DAY OF JUNE 2009.

Jill W. Bradbury
Member
Trade-marks Opposition Board