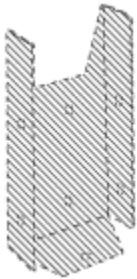


**IN THE MATTER OF OPPOSITIONS by
Simpson Strong-Tie Company, Inc. to
applications Nos. 1228067 and 1228068 for
the trade-marks GREEN FENCE CLIP
DESIGN and GREYISH GREEN FENCE
CLIP DESIGN filed by Peak Innovations
Inc.**

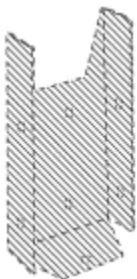
On August 24, 2004, Peak Innovations Inc. (the “Applicant”) filed applications to register the trade-marks GREEN FENCE CLIP DESIGN and GREYISH GREEN FENCE CLIP DESIGN shown below (the “Marks”) based upon proposed use of the Marks in association with “fence clips” (the “Wares”). The applications were advertised for opposition purposes in the Trade-marks Journal issues of July 27 and June 22, 2005 respectively. The Marks as advertised are described as follows:

- GREEN FENCE CLIP DESIGN:



“The mark consists of the colour green as applied to the whole of the visible surface of the particular object shown in the drawing. The drawing is lined for the colour green.”

- GREYISH GREEN FENCE CLIP DESIGN:




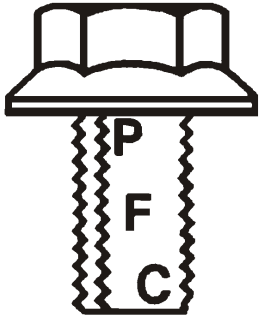

“Colour is claimed as a feature of the trade-mark. The mark consists of the colour

greyish green (PANTONE*5635C) as applied to the whole of the visible surface of the particular object shown in the drawing. The drawing is lined for the colour greyish green. *PANTONE is a registered trade-mark.” It is to be noted that there is an error in the description of the mark as advertised in that the first sentence “Colour is claimed as a feature of the trade-mark” was withdrawn from the revised description filed by the Applicant on April 29, 2005 in response to an Examiner’s Report at the examination stage.

Simpson Strong-Tie Company, Inc. (the “Opponent”) filed essentially identical statements of opposition on September 27 and November 21, 2005 against each of the applications for the GREEN FENCE CLIP DESIGN and the GREYISH GREEN FENCE CLIP DESIGN marks respectively. The grounds of opposition in each statement can be summarized as follows:

1. The Marks are not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act* (R.C.S. 1985, c.T-13, as amended) (the “Act”) because they are confusing with the following registered trade-marks:

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>
382999	 <p data-bbox="461 1591 971 1730">“The colour yellow/gold and green is claimed as a feature of the trade-mark. The post outline shown in dotted lines does not form part of the mark.”</p>	Metallic fence posts.

245786		Industrial and commercial fasteners of all kinds, namely bolts, nuts, screws, rivets, pins, cotter pins.
382998	 <p data-bbox="461 1024 972 1161">“The post outline shown in dotted lines does not form part of the mark but colour yellow/gold is claimed as a feature.”</p>	Metallic fence posts.

2. The Applicant is not the person entitled to registration of the Marks pursuant to s. 16(3)(a) and 16(3)(b) of the Act since, at the filing date, the Marks were confusing with unspecified similarly shaped and coloured construction products previously used in Canada by the Opponent and unidentified third parties and with the trade-mark TECHNO METAL POST & Design shown below for which application No. 1218092 had previously been filed in Canada by a third party:



3. The applications for the Marks do not conform to the requirements of s. 30(i) of the Act because the Applicant was aware or ought to have been aware of the Opponent’s use and the use by others of a similarly shaped product;

4. The Marks are not distinctive in view of the facts alleged in support of the first two grounds;
5. The fifth ground of opposition in each statement reads as follows: *“The Offending Mark is not the proper subject matter for a trade-mark within the meaning of the Act contrary to Section 30(b) and Sections 2 and 4, in that the Offending Mark as described and shown in the application is not capable of being a trade-mark as defined in Section 2 of the Act, nor is it capable of being distinctive of the Applicant. As well, the Offending Mark of the Applicant was not intended to be used by the Applicant as a trade-mark within the meaning of Section 4 of the Act, and the colour and shaping of the Offending Mark is functional and utilitarian and the granting of a registration would unreasonably limit the development of the industry of the Applicant and Opponent contrary to Section 13 of the Act”*;
6. The Marks are not registrable pursuant to s. 10 and 12(1)(e) of the Act because they are marks which had by ordinary and ‘bona fide’ commercial usage become recognized in Canada as designating the kind and quality of the applied for wares; and
7. The Marks are clearly descriptive of the character or quality of the applied for wares and are therefore contrary to s. 12(1)(b) of the Act. The shape and colour of the Marks are purely or primarily functional and do not serve to distinguish the Marks from the products of others or the trade-marks of others in Canada.

The Applicant filed and served a counter statement in each case in which it denied all grounds of opposition. As its evidence in each case, the Opponent submitted an affidavit of Elenita Anastacio, a trade-mark searcher. The Applicant chose not to submit evidence. Only the Applicant filed a written argument in each case. An oral hearing was requested but finally cancelled by the parties; the parties relying on their previous representations made during the oral hearing held in two related opposition files concerning applications Nos. 1227197 and 1227204 for the GREEN STAIR RISER DESIGN and GREYISH GREEN STAIR RISER DESIGN marks.

At a late stage in the proceedings, the Opponent requested leave to amend each of the statements of opposition to include a ground specifically based on non-conformance to the requirements of s. 30(h) of the Act and to amend the s. 12(1)(b) ground of opposition so as to add that the Marks are not the proper subject matter for a trade-mark. The Registrar refused that request.

Onus and relevant dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements of the Act. There is, however, an initial 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

The material dates for assessing each of the grounds of opposition in the present proceedings are as follows:

- Ground based on s. 12(1)(d) of the Act: the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Grounds based on s. 16(3)(a) and (b) of the Act: the filing date of the applications;
- Ground based on non-distinctiveness of the Marks: generally accepted as being the filing date of the statements of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)];
- Grounds based on s. 30(b) and (i) of the Act: the filing date of the applications [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) and *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)];
- Ground based on s. 12(1)(e) of the Act: the date of my decision [see *Allied Corp. v. Canadian Olympic Association* (1989), 28 C.P.R. (3d) 161 (F.C.A.)]; and
- Ground based on s. 12(1)(b) of the Act: the filing date of the applications [see *Fiesta*

Barbeques Ltd. v. General Housewares Corp. (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].

I will now analyze these grounds of opposition in turn in regard to the evidence filed in record.

Section 12(1)(d) ground of opposition

The Opponent's evidence in respect of this ground of opposition consists solely of the results of a trade-mark database search carried out by Elenita Anastacio. Ms. Anastacio attaches as Exhibit A to her affidavit, particulars of four registrations obtained from the CD NameSearch database, the first three being the registrations relied upon by the Opponent in support of the s. 12(1)(d) ground of opposition and the fourth one having issued on May 3, 2005 from the application relied on in the s. 16(3)(b) ground. I will deal with this latter registration later on in my decision when considering that second ground of opposition.

I have exercised my discretion to review the Register and confirm the details of those registrations. Registrations Nos. 382999 and 382998 were both expunged on November 23, 2006. Accordingly, they can no longer form the basis of a ground of non-registrability based on s. 12(1)(d) of the Act. As for registration No. 245786 for the PFC & Design mark, it is still current and is standing in the name of a third party namely H. Paulin & Co. Limited (hereinafter "H. Paulin"). The s. 12(1)(d) ground of opposition therefore remains to be decided on the issue of confusion between that mark and the Marks.

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.

In applying the test for confusion, the Registrar must have regard to all the surrounding

circumstances, including those listed at 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 the trade-marks have 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. This list is not exhaustive and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (C.S.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée and al* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (C.S.C.) for a thorough discussion of the general principles that govern the test for confusion].

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

The GREEN FENCE CLIP DESIGN mark consists of the colour green as applied to the whole of the visible surface of the “*particular object*” shown in the drawing of the mark. The GREYISH GREEN FENCE CLIP DESIGN mark consists of the colour greyish green (PANTONE*5635C) as applied to the whole of the visible surface of the “*particular object*” shown in the drawing of the mark.

None of the descriptions for the Marks specify what the “*particular object*” shown in the Applicant’s applications is. If it were not for the reading of the descriptive references that both the Applicant and the Canadian Intellectual Property Office (“CIPO”) use to refer to the Marks and the description of the Wares, it is questionable whether one would necessarily understand the Marks to consist of the colours green and greyish green respectively as applied to the whole of the visible surface of a fence clip. I will revert to the indefiniteness of the Applicant’s descriptions of the Marks later on in my decision when addressing the Opponent’s fifth ground of opposition. For the purpose of determining the inherent distinctiveness of the Marks, I will consider the Marks as consisting of the colours green and greyish green respectively as applied to the whole of the visible surface of a fence clip.

According to the case law and CIPO's position, trade-marks consisting of one or more colours applied to the whole of the visible surface of a particular three-dimensional object are registrable as ordinary trade-marks (unless they form part of a mode of wrapping or packaging wares) [see *Smith, Kline & French v. Registrar*, [1987] 2 F.C. 633; and CIPO's Practice Notice entitled *Three-Dimensional Marks* dated December 6, 2000]. However, as for trade-marks consisting only of initials, trade-marks consisting of colours are generally considered to possess low inherent distinctiveness. That said, I consider the Marks at issue to have relatively low inherent distinctiveness.

As for the registered mark PFC & Design, it is comprised of initials and a representation of one of the wares. Thus, although the said mark is inherently distinctive, it is not an inherently strong mark.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use. There is however no evidence that the Applicant's proposed use Marks have become known to any extent. There is also no evidence that H. Paulin has used or promoted its PFC & Design mark in Canada to date. The most that can be inferred from the mere existence of the registration for the PFC & Design mark is *de minimis* use that is not sufficient to conclude that the mark has become known in Canada [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)].

Accordingly, this first factor favours neither party.

(b) the length of time the trade-marks have been in use

As there is no evidence for concluding to continuous use of the cited mark since the claimed date of first use in the registration, I find this factor is of no significance.

(c) the nature of the wares, services or business; and (d) the nature of the trade

Considering the type of wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the registration referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording.

The Applicant's Wares consist of fence clips whereas H. Paulin's wares described in the PFC & Design registration consist of industrial and commercial fasteners of all kinds, namely bolts, nuts, screws, rivets, pins, cotter pins.

While there is no evidence of the actual trades of the parties, it is fair to say that as both parties' wares pertain to building materials, they could be sold through similar outlets such that there may be some overlap in their respective trades. Also, it appears that H. Paulin's fasteners may be the type of items that could be used in conjunction with the Applicant's fence clips, although there is no evidence that the parties' wares would be sold in close proximity.

Accordingly, these third and fourth factors tend to favour the Opponent.

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

The marks under review bear no resemblance when sounded. They also bear little resemblance if any, in appearance and in ideas suggested by them. The only thing the said marks somewhat share in common is the fact that they comprise items used in construction, but not the same

items: the Marks consist of the colour green / greyish green as applied to the whole of the visible surface of a fence clip whereas H. Paulin's mark consists of a drawing of a bolt with the letters P F C flowing downwardly the length of the shaft of the bolt. I consider that the differences existing between the marks under review outweigh largely the said common fact.

Accordingly, this fifth factor favours the Applicant.

Conclusion re likelihood of confusion

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the inherent weakness of the marks under review, the absence of acquired reputation for H. Paulin's PFC & Design mark and the differences existing between the marks in appearance and sound and in the ideas suggested by them, I find that, on a balance of probabilities, the average consumer having an imperfect recollection of H. Paulin's PFC & Design mark would not likely be confused as to the source of the Wares upon seeing the Marks. Accordingly, the s. 12(1)(d) ground of opposition is unsuccessful.

Sections 16(3)(a) and (b) grounds of opposition

The Opponent has also pleaded that the Applicant is not the person entitled to registration of the Marks pursuant to s. 16(3)(a) and (b) of the Act since at the filing date of the Applicant's applications, the Marks were confusing with unspecified similarly shaped and coloured construction products previously used in Canada by the Opponent and unidentified third parties and with the trade-mark TECHNO METAL POST & Design for which application No. 1218092 had previously been filed in Canada.

The s. 16 grounds of opposition are unsuccessful, as they do not raise proper grounds of opposition. Except for application No. 1218092, the Opponent failed to identify the allegedly

confusing marks being relied upon. The Opponent further failed to evidence use of the said allegedly confusing marks prior to the Applicant's filing date and non-abandonment of these marks as of the Applicant's advertisement dates. It is to be noted also that although application No. 1218092 was filed prior to the Applicant's filing date, it was not pending as of the Applicant's advertisement dates, contrary to s. 16(4) of the Act. Furthermore, in view of the provisions of s. 17(1), the Opponent is precluded from relying on third parties' use of allegedly confusing marks in support of a ground of prior entitlement pursuant to s. 16(3).

Section 30(i) ground of opposition

The s. 30(i) ground of opposition is also unsuccessful, as it does not raise a proper ground of opposition. The mere fact that the Applicant may have been aware of the existence of a "similarly shaped product" does not preclude it from truthfully making the statement required by s. 30(i) of the Act. Even if that ground had been properly pleaded, where an Applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional circumstances 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.)]. There is no such evidence in the present cases.

Non-distinctiveness ground of opposition

The non-distinctiveness ground of opposition is also unsuccessful as the Opponent failed to discharge the initial burden upon it to prove the allegations of fact in support of this ground.

As indicated above, no evidence of any use or reputation for any of the allegedly confusing marks relied on in the first two grounds of opposition and being referred to in the Opponent's pleading of non-distinctiveness has been adduced in the present case. Unlike decisions rendered in many of the pharmaceutical colour, shape and size cases referred to by the Opponent, the burden has not shifted to the Applicant in the present proceedings to show that its Marks are

distinctive or capable of becoming distinctive.

As indicated above, the Marks are considered to be ordinary trade-marks, not distinguishing guises. As such, the Applicant needs not show that its Marks are distinctive unless the distinctiveness of the Marks has properly been put into issue. Despite the fact that I consider the Marks at issue to have relatively low inherent distinctiveness, I am left with no proof at all negating the distinctiveness of the Marks.

Fifth ground of opposition – Not proper subject matter contrary to s. 30(b)

The Opponent pleads that the Marks are not the proper subject matter for a trade-mark within the meaning of the Act contrary to s. 30(b) and 2 and 4 of the Act. The granting of a registration for the Marks would unreasonably limit the development of the industry of the Applicant and Opponent contrary to s. 13 of the Act.

This fifth ground of opposition appears to be based on the general allegations that the applications do not comply with s. 2 of the Act because the Marks as described and shown in the applications are not capable of being a trade-mark, nor can they be used to distinguish the Wares from those of others in the marketplace. I do not consider these allegations as pleaded, to raise a proper ground of opposition based upon non-conformance with the requirements of s. 30(b) of the Act. Furthermore, the applications having been filed on the basis of proposed use of the Marks as opposed to actual use of the Marks in Canada, I fail to see the relevancy of s. 30(b) of the Act.

It is to be noted also that there is no evidence at all in support of the Opponent's pleading that the colour and shaping of the Marks is functional and utilitarian and that the granting of a registration would unreasonably limit the development of the industry of the Applicant and Opponent contrary to s. 13 of the Act.

At the oral hearing held in the two related opposition files referred to above concerning applications Nos. 1227197 and 1227204 for the GREEN STAIR RISER DESIGN and GREYISH GREEN STAIR RISER DESIGN marks, the Opponent attempted to take advantage of the somewhat vague formulation of virtually the same fifth ground of opposition to submit and develop various arguments. Considering the similarity of the issues raised in these latter cases and the present cases, I wish to refer to the decision I rendered in these two cases on May 8, 2008.

In the said two cases, the Opponent had argued that the marks shown in the applications were not capable of being a trade-mark as defined in s. 2 of the Act because the shape of each of the marks claimed was not properly defined and delimited by the descriptions and the drawings of the marks. More particularly, the Opponent contended that it was not possible to determine what the Applicant's marks were from reading the descriptions and viewing the drawings. However, the statement of opposition in each case did not include a specific pleading to that effect or a ground based on non-conformance to the requirements of s. 30(h) of the Act. As in the present cases, the Opponent had attempted to amend its statements of opposition to include such a ground of opposition but the Registrar refused such amendment. Thus, I failed to see how the Opponent could resubmit the same argument at the hearing stage. Had the Opponent properly pleaded such a ground, I would likely have found that the Opponent had met its evidential burden and it would then have been incumbent on the Applicant to establish that the applications did provide definite depictions or descriptions of the marks in compliance with s. 30(h). The same comments apply to the present cases.

In the said two cases, the Opponent had also argued that the fact that the Applicant had applied for the registration of some other twenty-nine trade-marks consisting of the same colours green and greyish green applied to various construction products (all of these applications besides, being opposed by the Opponent) cast sufficient doubt on the Applicant's intention to use the applied for marks within the meaning of s. 4 of the Act. As in the present cases, such pleading was not raised specifically and properly in the statements of opposition. Furthermore, the mere

fact that there were some other twenty-nine applications pending before the Registrar was not by itself found sufficient to cast doubt on the Applicant's intention in the said two opposition cases. The same comments apply to the present cases.

The Opponent further submitted at the said oral hearing that it was unfair to require the Opponent to meet an evidential burden respecting the issue of distinctiveness in cases such as these. The Opponent made an analogy with cases where an applicant is applying to register a distinguishing guise and must evidence that the applied for guise has become distinctive in Canada. As in the present cases, the marks at issue were considered to be ordinary trade-marks, not distinguishing guises. As such, the Applicant needed not show that its marks were distinctive unless the distinctiveness of the marks had properly been put into issue. The same comments apply to the present cases. That said, I wish to refer to the following passage in one of the decisions rendered by my colleague David J. Martin in two of the other twenty-nine opposition cases mentioned above, to which I concur:

“Notwithstanding the foregoing, I sympathize with the opponent's position. Given the inherently weak nature of a trade-mark consisting solely of a color applied to the entire visible surface of an object, either such a mark should be considered to be a shaping of the wares and thus a distinguishing guise or the Act should have a provision akin to Section 12(2) or 13(1) to ensure that distinctiveness in fact is established before granting a registration. Furthermore, as discussed in the Novopharm Limited decision, it would be preferable to require greater specificity regarding a trade-mark consisting of color in order to restrict the exclusive rights to be granted by any eventual registration. In the case of the applicant's second application, the reference to PANTONE 5635C may suffice.” (*Simpson Strong-Tie Co. v. Peak Innovations*, 2007 CarswellNat 5176, at paragraph 28, decision under appeal before the Federal Court of Canada)

Sixth ground of opposition - The Marks are not registrable pursuant to s. 10 and 12(1)(e) of the Act

The sixth ground of opposition is that the Marks are not registrable pursuant to s. 10 and 12(1)(e) of the Act because they are marks which had by ordinary and 'bona fide' commercial usage become recognized in Canada as designating the kind and quality of the applied for wares.

The Opponent failed to adduce any evidence to support its contention that the Marks have become recognized in Canada as designating the kind and quality of the applied for wares. Since the Opponent failed to meet its evidential burden, the sixth ground of opposition is also unsuccessful.

Seventh ground of opposition - The Marks are not registrable pursuant to s. 12(1)(b) of the Act

The seventh ground of opposition is that the Marks are not registrable pursuant to s. 12(1)(b) of the Act because, being purely or primarily functional, they are clearly descriptive of the character or quality of the applied for wares.

As stated above, although there is a legal burden upon the Applicant to show that its Marks are registrable, the Opponent must first adduce sufficient evidence to support its claim that the Marks are clearly descriptive or misdescriptive. Again, there is no such evidence in the present cases. Indeed, there is no evidence at all establishing the purely or primarily ornamental or functional nature of the applied for colours green and greyish green in the context of the Wares.

Disposition

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the Opponent's oppositions.

DATED AT MONTRÉAL, QUEBEC, THIS 12th DAY OF MAY 2008.

Annie Robitaille
Member, Trade-marks Opposition Board